

Foundation Certificate

FC5 Trade Mark Law

Wednesday 11 October 2023

10:00 to 13:20 UK British Summer Time (GMT + 1 hour)

Examination time: 3 hours 20 minutes plus 10 minutes upload time

The 3 hours 20 minutes is allocated as follows:

10 minutes – Downloading and printing the question paper:

3 hours – Answering the questions:

10 minutes – Two screen breaks of 5 minutes each.

At 13.20 you MUST immediately stop answering the questions. You then have **10 minutes** in which to upload your Answer document to the PEBX system.

You MUST upload your Answer document to the PEBX system by 13.30. After 13.30 you will not be able to upload it and your examination will be void.

INSTRUCTIONS TO CANDIDATES

1. You should attempt **ALL** questions in Section A and any **three** questions in Section B.
2. The marks for each question in Section A are shown next to the question. Each question in Section B carries **20** marks.
3. If more than the required three questions are answered in Section B only the first three presented will be marked.
4. The total number of marks available for this paper is 100.
5. You must use the Answer document for your answers.
6. Do not attempt to change the font style, font size, font colour, line spacing or any other pre-set formatting in the Answer document.
7. Start each question on a new page. To begin a new page, press the control key and the enter key simultaneously.
8. When you begin a new question, type in the question number at the top of the page.
9. Do not state your name anywhere in your answers.

This question paper consists of **8 sheets** in total, including this sheet.

AT THE END OF THE EXAMINATION

10. Upload your Answer document to the PEBX system. You should upload it as a Word document. PEBX will automatically convert it to PDF.

SECTION A

Question 1

State an example of an objection that might be received from:

- a) the Office of Origin;
- b) the International Bureau; and
- c) a designated Contracting Party,

when making a Madrid Protocol application.

3 marks

Question 2

Set out the conditions an earlier non-registered mark must meet in order that it may be used for opposition purposes before the EUIPO.

4 marks

Question 3

Lisa-Marie is an up-and-coming Irish rock star, temporarily living in the UK. She believes that she will soon be extremely famous, and does not want any trader using her name in any area of industry whatsoever once she is. She therefore wishes to file a trade mark for every individual item listed in the Nice Classification, in each of the 45 classes. (This is called a 'defensive filing'.)

She is particularly keen on protecting her name in the Republic of Ireland.

Outline any issues that might arise from engaging in such a 'defensive filing':

- a) if filing directly at the Irish Intellectual Property Office.**

1 mark

- b) if filing for an EU Trade Mark.**

2 marks

- c) if applying for a Madrid Protocol application and designating Ireland.**

2 marks

(Do not discuss distinctiveness, relative grounds or costs.)

Total: 5 marks

Question 4

You have received an e-mail from your client's marketing director. **Write brief answers to her questions:**

Hi. We have noticed that there are two different trade mark symbols: TM and ®

- a) What is the difference between the two symbols? 1 mark

- b) Can we use them on our products? 1 mark

- c) Do we **have** to use them on our products? 1 mark

- d) What are the benefits of using these symbols on our products? 2 marks

Total: 5 marks

Question 5

Margaret has spotted a recent trade mark application on the IPO database. It is currently under examination at the IPO, but has not yet been advertised. Margaret says:

- 1) the mark in the application is identical to her well-known registered trade mark, and the application protects identical products; and that
- 2) the applicant is "*clearly likely to deceive the public*" into thinking that the applicant's goods are hers.

However, Margaret says that she is temporarily short of funds, but has read that the IPO permits 'observations' to be submitted for free.

Explain:

- a) **when (i.e. at what point in the lifecycle of a trade mark) observations can be made.** 1 mark

- b) **how observations differ from oppositions.** 2 marks

- c) **the observations (if any) that can be made in this case.** 1 mark

Total: 4 marks

Question 6

A search of the trade mark register shows your client has filed the following trade mark applications, all for 'cardboard boxes' (class 16).

Mark	Jurisdiction	Filing Date	Status
BEST	Germany	1 February 2023	Withdrawn voluntarily – 1 April 2023
BEST	Germany	2 May 2023	Refused – 2 September 2023
BEST	Spain	3 June 2023	Under examination
BEST	UK	4 September 2023	Withdrawn voluntarily – 4 October 2023

Your client now wishes to file a trade mark in the EUIPO, again for 'cardboard boxes'.

What priority (if any) can the application claim? Give reasons for your answer.

2 marks

Question 7

Abraham owns a UK trade mark. It was filed on 2 July 2013 and was registered on 1 September 2013.

On 1 August 2013, Abraham filed a Madrid Protocol application, which was registered on 1 September 2013. It was based on (and claimed priority from) its UK trade mark. It successfully designated the following jurisdictions:

- France – accepted by the French IPO – 1 October 2013.
- Germany – accepted by the German IPO – 2 October 2013.

On 1 July 2020, Abraham filed subsequent designations using the Madrid Protocol. The statuses of the designations are as follows:

- EUIPO – accepted by the EUIPO on 3 July 2023, with all available seniorities being claimed.
- Japan – accepted by the Japanese IPO on 2 July 2022.
- USA – still under examination.

Explain what renewal fees need to be paid, and the dates by which they can be paid.
(Amounts of fees are not required)

3 marks

Question 8

a) Explain what actions are required to fulfil a contractual obligation between two sole traders promising to assign a registered trade mark including any associated unregistered rights. Do not discuss assigning copyright or design rights.

4 marks

b) You notice the trade mark has a licence recorded against it on the register. Is additional action required? Explain your answer.

2 marks

Total: 6 marks

Question 9

Charlesmont PLC generates and supplies electricity to customers in the UK. It owns the following trade mark:

Mark	Goods/services
CHARLESMONT	Cl. 16 – Printed matter Cl. 40 – Electricity generation

A pressure group, CleanEarth, objects to Charlesmont's business. It has printed leaflets that it is handing out to people in the street outside Charlesmont's corporate headquarters. The leaflets say:

CHARLESMONT
Pollutes watercourses!
Has poor safety standards!
Treats its employees unfairly!
Boycott them now!

Explain whether CleanEarth is infringing Charlesmont's trade mark rights.

2 marks

Question 10

Lenny makes nuts and bolts, which he sells in sealed plastic jars. The jars are filled with a vapour comprising the chemical that gives common garden mint its characteristic smell.

Lenny proposes to apply to register one or more of the following as a 'non-traditional trade mark':

- a) 'The smell of mint'.
- b) 'The smell of mint, a reference sample of which has been impregnated into the "scratch and sniff" paper sheet attached to this application'.
- c) 'The smell of 5-methyl-2-(propan-2-yl)cyclohexan-1-ol at a concentration of 0.01 mol dm^{-3} in air'.

Which (if any) of these marks would meet the requirements of *Sieckmann*? Give reasons for your answer.

2 marks for each proposal

Total: 6 marks

SECTION A Total: 40 marks

SECTION B

Question 11

Seymour is an entrepreneur. Fed up with the soles of walking boots wearing out too quickly, he has been inspired to set up a scheme called the '1407 Kilometre Challenge', in which the boots of participating manufacturers are laboratory tested (for a fee) to ensure they can endure the equivalent of a 1407-kilometre hike on an abrasive surface.

Seymour plans that manufacturers whose boots pass the test will be permitted to:

- use the words '1407 KM CHALLENGE – PASSED' on their promotional material; and
- fabricate the boots' soles out of a polymer material to which a red dye has been added. This will ensure boots that have passed the Challenge will be readily identifiable from other boots when displayed in shops. However, the shape of the sole, configuration of the tread, and polymer from which the sole is made, will remain entirely for the manufacturer to choose.

Seymour explains that he chose '1407' kilometres because it is the distance between John O'Groats (the UK's most north-easterly point) and Land's End (the UK's most south-westerly point). Walking between these two points is a well-known test of endurance for dedicated hikers.

Furthermore, extensive research has shown that no manufacturer has ever made walking boots with red soles – with soles typically being brown or black.

In order to prevent manufacturers using these signs without having passed the test or paid the fee, Seymour recently filed two UK trade mark applications:

Mark		Goods/services	Filing date
1407 KM CHALLENGE – PASSED	Word only	Cl. 25 – Walking boots Cl. 42 – Laboratory testing services for walking boots	1 September 2023
The colour red applied to the totality of the sole of a walking boot.	Non-traditional mark	Cl. 25 – Walking boots	1 September 2023

Seymour did not use an attorney to file these applications, but, on reflection, fears that they might meet objection, and so now seeks your advice.

Explain (with reasoning) which 'absolute grounds' for refusal, as listed in Section 3 of the *Trade Marks Act 1994*, will apply to these applications, and which will not. (Assume the application offends no other rule of law or international agreement, nor contains any specially-protected emblem.)

20 marks

Question 12

Marjorie owns the following trade mark:

Mark		Goods	Filing date	Registration date
GLOVESMITH	Word only	Class 25 – Cycling gloves	1 September 2012	1 February 2013

Marjorie explains that cycling gloves are usually worn by cyclists engaged in sports or long-distance riding. They are typically fingerless, and characterised by a padded leather panel designed to protect the palm of the hand, both from abrasion (should the rider fall off their bicycle) and from blisters (resulting from prolonged contact with the handlebars).

Marjorie has recently noticed that the following trade mark application has been published:

Mark		Goods	Filing date
GLOWSMITH'S	Device	Class 11 – Bicycle lights	1 September 2023

Advise Marjorie whether she can successfully oppose this application. Do not discuss marks with a reputation or passing-off.

20 marks

Question 13

You act for United Breweries, who produce McDUFF beer. McDUFF is the second most consumed beer in Scotland, and in the top 6 of beers consumed in the United Kingdom as a whole. The brand is protected by a trade mark, which is still in force:

Mark	Goods	Registration date
McDUFF	Class 32 – Beers	10 June 1918

United Breweries has recently informed you that they have seen a product called McDUFF SAUCE. It is a spicy tomato ketchup, manufactured by Patty McDuff, a sole trader living in Newcastle. Patty has only recently started selling the sauce, which she explains in her promotional material is made to her grandmother's recipe. There is nothing in the list of ingredients that hints that beer is an ingredient.

After reviewing UKIPO and EU case law, you decide there is no prospect of United Breweries bringing a successful action based on confusion, as the goods are just too dissimilar. Nevertheless, United Breweries wants Patty's use of the McDUFF name stopped.

Advise what other actions (if any) can be taken by United Breweries under:

a) the *Trade Marks Act*; and

13 marks

b) common law.

7 marks

Total: 20 Marks

Question 14

Sanjay manufactures and sells parts for mechanical equipment, trading under the name KWIKPART. He supplies customers throughout south-east England.

Sanjay has recently received a letter from Agnes, explaining that Agnes has recently registered the name KWIKPART as a trade mark for identical goods, and demands Sanjay cease and desist from trading under the KWIKPART name.

Advise Sanjay.

20 Marks