

| Paper Ref | Sheet | Percentage Mark Awarded |
|------------|----------------|-------------------------|
| FC5 | 1 of 20 | 54% |

Examiner's use only

Question 1:

- a. Lack of handling fee, payable to the office of origin ✓1
- b. Lack of basic fee, payable to IB
- c. If a statement or evidence of use is need, the declaration is missing.
Allow ✓1

1

0

1

2

MARKS AWARDED: 2/3

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Question 2:

The non-registered mark of the business has real and effective commercial or industrial establishment in one or the EU member, and has reputation in more than one member state other than the base member state.

The non-registered mark is in use by the business before the priority date of the EU trademark application.

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MARKS AWARDED: 0/4

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Question 3:

- a. For filing in Ireland, it is necessary to submit a declaration of use for each class. However, she is doing a “defensive filing” and she cannot provide such a declaration. ✓1 1
- b. Declaration of use is not needed for EU trade mark. However, after the registration, if any class of the trade mark is not used for 5 years, or the trade mark is not used for a continuous period of 5 years, then the mark, with respect to the classes in question, will be subject to invalidation. ✓1 2
- c. First, the Madrid Protocol application is subject to central attack if the base application in UK (or other jurisdictions) is subject to invalidation for non-use after 5 years (or 3 years in certain countries). Second, when designating Ireland, the declaration of use cannot be provided by Lisa. ✓1 1

4

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Question 4:

- a. TM refers to a trade mark; ® refers to a registered trademark ✓1
- b. If the trade mark is registered in the country, ® can be used in the products. ✓½
- c. It is not a must to use them ✓½
- d. In the event of a trade mark infringement, it is necessary to let the potential infringer aware of the trade mark (both registered or non-registered), in order to seek for damages and injunction. ✓½

1

½

½

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2½

MARKS AWARDED: 2.5/5

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use only

Question 5:

a. Observation can be filed to IPO during the two months after the publication of the trade mark ✓½

b. Any party may use "Observation" to provide evidence and information to the IPO for the trade mark examiner to consider with respect to the trade mark application. There is no compensation to Margaret for making the observation even if there is an infringement of her trade mark. ✓1

As for opposition, both parties will be required to present argument for opposing the trade mark application. There can be a "cooling off" period for them to resolve the matters. If they cannot resolve the matters, the IPO will review the arguments and make a decision. ✓1

c. Margaret can make an observation that a well-known mark exist which is identical to the trade mark for the identical products. The observation should provide information of the well-known mark, and the reasons.

2

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2½

MARKS AWARDED: 2.5/4

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Question 6:

1 February 2023 filing: not within 6-month Paris convention deadline, so cannot be used to claim priority

2 May 2023 filing: Germany is a member state of the Paris convention, so it is possible to claim priority even the application is refused, unless the refusal is related to those matters affecting the establishment of the filing date, such as missing Applicant information, missing a representation of the mark.

3 June 2023 filing: Spain is a member state of the Paris convention, so it is possible to claim priority even the application is pending.

4 September 2023: UK is a member state of the Paris convention, so it is possible to claim priority even the application is withdrawn.

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use only

Question 7:

The UK trade mark should be renewed 10 years from the registration date, which is 1 September 2023.

By claiming the seniorities in the EUIPO application, the France and Germany registration can be allowed to lapse. The renewal fee for EUIPO is 1 October 2023. ✓1

Japan: Renewal fee is to be paid by 2 July 2032.

USA: Not sure. Need to wait for the completion of examination. The renewal should be paid by 10 years from registration.

1

MARKS AWARDED: 1/3

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use only

Question 8:

- a. To assign a trade mark, an assignment signed by both contracting parties is needed. The assignment shall indicate the registered trade mark and any associated unregistered rights. The assignment shall be submitted to the IPO within 6 months, unless the submission is not possible due to certain limited legitimate reasons, such as serious illness or other unpredictable issues.
- b. There is another interested party in the trade mark, who has the right to reject this assignment if it detrimental to his benefit. In this case, the sole trader should obtain the consent from the licensee before coming into an agreement with the other sole trader.

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Question 9:

For an action of infringement, the infringing party uses the trade mark, without licence of the trade mark owner, to sell, offer to sell, import goods, export goods, providing services.

For class 40, there is no electricity generation at all by CleanEarth, so there is no prospect of infringement action.

As for class 16, this is the goods of "printed matter", which may be used to make the argument. However, the distribution of leaflets is not a sell of goods.^{✓1} So the infringement action is not possible. ✓1

2

MARKS AWARDED: 2/2

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Question 10:

- a. Cannot meet the requirements of Sieckmann. The description of "mint" is not clear and precise, ^{✓1} and it is descriptive. 1
- b. Cannot meet the requirements of Sieckmann. The deposition of sample of the vapour is not durable ^{✓1} and self-contained. 1
- c. Cannot meet the requirements of Sieckmann. The description of the chemical formula is not intelligible ^{✓1} and it is not clear and precise. 1

3

MARKS AWARDED: 3/6

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Examiner's
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Question 11:

The mark “1407 KM CHALLENGE –PASSED”

Section 3(1)(b): trademark which is devoid of distinctive character

The word mark is distinctive as it is not used by other walking boots or laboratory testing services.

Average consumers buying walking boots would distinguish one undertaking from the other by traditional trade mark. The word mark provides the distinctive character for identifying the subject matter protected.

As for the laboratory testing services, the average consumers are the shoes manufacturers. They will also be able to distinguish this laboratory from others. ✓¹

Section 3(1)(c): characteristics of goods or services

There is a description of the characteristics of the walking boots, which has passed the “1407 KM challenge”. This challenge is not a unique challenge, and it is a well-known test of endurance for hiking boots.

The description of this characteristics may prevent other undertaking from demonstrating that their walking boots can meet the same 1407 KM challenge. ✓¹

As for the laboratory testing services, this is not describing the test as passing a challenge. Therefore, the above-mentioned absolute ground refusal is not applicable for class 42. ✓¹

Section 3(1)(d): customary sign

There is no issue of customary sign. ✓¹

Acquired distinctiveness

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Examiner's
use only

The mark is not used before the trade mark application, so there is no acquired distinctiveness from prior use of the mark. ✓1

Section 3(2)(a): result of the nature of the goods or services

The description in the mark is not a result of the nature of the walking boots

Section 3(2)(b): essential for obtaining the technical features of the goods or services

There is no description of the technical features of the walking boots

As for the laboratory testing services, there is no description of the way how the test is performed. So, the mark is not essential for obtaining the technical features.

Section 3(2)(c): give substantial value to the goods or services

The mark stated that the walking boots can pass the 1407 KM challenge, which provides substantial value to the goods as to the endurance. An average consumer may find that, from this mark, the walking boots are less likely to be wearing out.

As for the laboratory testing services, the mark does not give substantial value to the testing service. So, there is no refusal for class 42. ✓½

Conclusion:

The mark "1407 KM CHALLENGE –PASSED" for class 25 will be refused in view of Section 3(1)(c) and Section 3(2)(c). However, for class 42, the mark will not be refused by Section 3. ✓½

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Examiner's
use only

The mark “The colour red applied to the totality of the sole of a walking boot.”

Section 3(1)(b): trademark which is devoid of distinctive character

The description of the colour red on the walking boot as a trade mark is a non-traditional mark, which lacks of distinctive character.

Average consumers buying walking boots would distinguish one undertaking from the other by traditional trade mark, such as word or logo. The red soles would not be considered by the consumers as a trade mark. This is considered as the style or design of the boots. ✓1

Section 3(1)(c): characteristics of goods

There is a description of the characteristics of the walking boots, which has red soles. Although the design of red soles is not common, the description of the use of red sole would be describing a feature of the goods, which is not allowed. ✓1

Section 3(1)(d): customary sign

There is no issue of customary sign. ✓1

Acquired distinctiveness

The mark is not used before the trade mark application, so there is no acquired distinctiveness from prior use of the mark. ✓1

Section 3(2)(a): result of the nature of the goods

The description in the mark is the nature of the walking boots, which has a red sole. ✓1

Section 3(2)(b): essential for obtaining the technical features of the goods

There are no technical features for having a red sole. ✓1

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Examiner's
use only

Section 3(2)(c): give substantial value to the goods

A red sole is purely a matter of design and preference. There is no substantial value added to the walking boots. ✓1

Conclusion:

The mark "The colour red applied to the totality of the sole of a walking boot." will be refused in view of Section 3(1)(b) and Section 3(1)(c). ✓½

13½

13½

MARKS AWARDED: 13.5/20

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Examiner's
use only

Question 12:

Similarities of the Trade Mark

Aural

GLOVESMITH and GLOWSMITH'S both have two syllables.

The ending "S" sound in GLOWSMITH'S obviously differs from GLOVESMITH, but easily omitted if the words are spoken quickly. ✓1

The middle sound "SMITH" is the same.

The starting sound "GLOW" and "GLOVE" are slightly different yet substantially similar. ✓1

Therefore, the aural of the two marks are similar.

Visual

The word mark covers different presentation styles of the word, including the shading shown in the GLOWSMITH'S mark. ✓1

The two words look similar. The letters "VE" looks very similar to the letter "W".

The ending "S" is a more noticeable difference visually. ✓1

Therefore, the two marks are slightly similar visually.

Conceptual

GLOVESMITH mark is used for cycling gloves. The concept is to combine the word "GLOVE", which is the goods selling, with the word "SMITH". A consumer would easily understand from the mark that this company is working on "the making of glove".

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Examiner's
use only

GLOWSMITH'S mark is used for bicycle lights. The concept is to combine the word "GLOW", which implies the light from the goods,^{✓1} with the word "SMITH". A consumer would easily understand from the mark that this company is working on "the making of certain kind of lighting device".^{✓1}

Conclusion

The two marks are substantially similar that may cause confusion or association.^{✓1}

SOM – 7

Similarities of Goods

Cycling gloves vs Bicycle lights

User: Both gloves and lights are used by cyclist. The gloves are more specifically used by long-distance riding. The light is also essential for long-distance riding, and also casual riding.^{✓1}

Market: Both gloves and lights are bicycle accessories.^{✓1}

Complimentary: They are not complimentary to each other.^{✓1}

Competitive: They are not in competition. The glove cannot replace the light.

Manufacturing facility: The light is an electronic device, which should not be made by the same manufacturing facility.^{✓1}

Conclusion: The glove and the lights are both used in cycling, but they share different markets and the likelihood of confusion is small. At most, there is a chance of association and consider that the two marks are from same company.^{✓1}

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Average Consumers

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The buyer of the gloves are professional cyclists. For the bicycle lights, it is from general cyclists. However, when buying bicycle accessories, it is reasonable to expect that they will compare the goods and brands carefully.

Conclusion

The dissimilarities in goods outweigh the similarities of the marks.

There may be association between the two marks but the chance of opposing the application is small.

MARKS AWARDED: 16/20

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Question 13:

a. The Trade Marks Act

The mark McDUFF is a registered trade mark under class 32. The spicy tomato ketchup, on the other hand, is obviously not under the class 32 as it is not beers.

The infringement action is also not possible if the mark used by Patty McDuff is the "surname" of the owner. This is an honest practice of using her own surname as the trade name in line with the industrial and commercial matters. ✓1

The infringing trade mark is used locally in Newcastle.

One possible action is related to the well-known mark.

For the well-known mark that is famous in one contracting state, the use of an identical mark in another contracting state for identical or similar goods or services is not allowed.

The mark McDUFF is famous in Scotland. IPO UK can prevent the use of the trade mark that is identical to the well-known mark liable to cause confusion.

The McDUFF has a reputation and famous in UK (top 6 in sales), and has a real manufacturing establishment in Scotland. It is necessary to argue that this is for the similar goods. As beer and spicy ketchup may both give certain excitation to the user, there is arguable.

Conclusion

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The use of "surname" can prevent McDUFF from enforcing the rights under the trade mark. However, there is still a reasonable prospect to argue using well-known mark.

b. Common law

Possible action can be taken based on the doctrine of passing-off

Goodwill

Goodwill can be obtained by sales of products. By selling the beer in UK, there is goodwill.

McDUFF beer are sold and is the top 6 beer consumed. It is reasonable to expect that there is a very strong argument on goodwill. There are repeat customers in order to achieve such a sale.

Other sales data would be helpful for supporting the goodwill.

✓1

Mis-representation

In this case, Patty McDuff did not intentionally claim the spicy tomato ketchup as product of McDUFF. However, mis-representation can also be unintentional.

There could be an argument of false endorsement.

As the average consumer may find that, with the same trade mark, the spicy tomato ketchup is endorsed by McDUFF.

✓1

There could also be an argument of ordinary pass-off, for implying the spicy tomato ketchup is the product of McDUFF. Investigation and survey can be

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performed to determine if average consumer would find the products of Petty McDuff are related to McDUFF. ✓1

Damage

There is no direct competition between McDUFF beer and the spicy tomato ketchup. Therefore, there is no diversion of sales.

However, Petty McDuff may gain advantage from the mis-representation or endorsement of the products. Average consumer may consider the spicy tomato ketchup is up to the standard of McDUFF beer. ✓1

Furthermore, if there is any quality issue with the products of Petty McDuff, the reputation of McDUFF beer may also be affected. ✓½

Conclusion

There is a good prospect to stop Petty from using the McDUFF name using the common law of passing-off. ✓1

6½

MARKS AWARDED: 6.5/20

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