

Paper Ref	Sheet	Percentage Mark Awarded
FC5	1 of 22	65%

Examiner's use only

Q1)

a) The application is incomplete, perhaps missing the necessary components to secure a filing date such as: a representation, a list of goods/services, the applicant's name and address, a request for registration of a trade mark. ✓1

1

b) The correct amount of fees have not been paid – missing the complimentary fee for example.

0

c) May object that the sign is devoid of distinctive character. ✓1

1

2

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Q2

Must have been used in the trade of more than mere local significance.

The use must have started before the earlier of:

The first use of the registered TM, or

The date of registration of the TM.

2

MARKS AWARDED: 2/4

2

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Q3)

a) Would likely be considered a bad faith filing and not allowed for all the goods/services as it is a clear tactic to prevent others from using the mark where Lisa actually has no intention of using it herself. Allow ✓1

1

b) Would likely be considered a bad faith filing and not allowed for all the goods/services as it is a clear tactic to prevent others from using the mark where Lisa actually has no intention of using it herself. ✓1

In the EU there would be a huge pool of grounds from which a member state could draw on objections due to the huge number of classes covered. Would be very likely to be refused.

1

c) Would likely be considered a bad faith filing and not allowed for all the goods/services as it is a clear tactic to prevent others from using the mark where Lisa actually has no intention of using it herself. ✓1

1

3

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Q4)

a) 'TM' is to be used with signs which are not registered but are being used as a trade mark (a badge of origin).

® is used only with registered trade marks. ✓^{1/2}

1/2

b) TM can be used relatively freely,

® may only be used if the mark it is applied to is actually registered ✓^{1/2}

1/2

c) There is no requirement to use them on the products ✓¹

1

d) The symbols alert consumers to the presence of a trade mark. They therefore would have less of a defence if trying to claim they made an application to register the same or similar mark without realising our client's mark was registered. More likely to have "bad faith" as a grounds for refusal. Allow ✓¹

1

3

MARKS AWARDED: 3/5

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Q5

- a) Observations can be made at anytime until registration. ✓½
- b) Making observations does not make the 'observer' party to the examination proceedings. The observations are effectively in the hands of the examiner, and will only be raised as objections if they see fit. ✓1

Whereas, filing an opposition does make the opposer party to the proceedings.

- c) Margaret can point out that her, identical, earlier right exists which is registered for identical products, and so a relative grounds argument can be brought forward. It seems that a likelihood of confusion is also very likely.
- Also, could propose an absolute grounds objection that a mark should not be registered if it is likely to deceive the public, as Margaret believes it is.

1½

MARKS AWARDED: 1.5/4

½

1

0

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Q6)

Priority claim has to be made within 6 months of first filing of the subject matter.

The 01 Feb 2023 application is therefore too old. (it was also withdrawn, making it unsuitable for a priority claim)

02 May 2023 cannot be claimed because, while it is within 6 months of today's date, the application was refused before making the claim.

✓1

Therefore, no priority can be claimed because the earliest filing of the subject matter which was not withdrawn is now refused and so can not be used as a priority claim.

1

1

MARKS AWARDED: 1/2

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Q7)

UK basic application needs to be renewed by 10 years from the date of filing, which is 02 July 2023. This has been missed, so must pay late with additional fee (within a further 6 month grace period) by **02 January 2024**. ✓½

The Madrid protocol filing will have a single renewal date, including for the subsequent designations. A single transaction is made at WIPO to cover renewals for all of the designations. ✓1 The date will be 10 years from the filing date (01 August 2013), which is **01 February 2024**. This can also be paid late by a further 6 months if necessary (01 August 2024) with an additional fee. ✓½

2

2

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Q8

a)

An assignment document should be drawn up, in writing, and signed by both of the parties (essentially for the UK, the assignor must sign). The document should detail who is assigning, and the assignees details (addresses, names).

Document should also cover the transfer of associated unregistered rights in the trade mark. In order for the protection afforded by 'passing off' to be transferred, the "goodwill" in the sign should also be listed as being transferred.

The assignment should then be recorded with the relevant IPO, ideally within 6 months of the transfer to ensure costs are paid in any infringement proceedings.

Ideally record this ASAP so that no contradicting transaction gets registered in the interim (these would be effective over the unregistered transaction).

b)

Licences are binding on successors in title as well as the current proprietor, unless any contradicting clause is included in the licence agreement. No action is required, the licence is still effective.

4½

MARKS AWARDED: 4.5/6

2½

2

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Q9)

Charlesmont has the registration covering “printed matter”, which a flyer would seem to fall under.

Infringing uses include:

“using the mark in company papers and in advertising”

And “using the mark in comparative advertising which is in breach of the ‘misleading advertising regulations’ ”

The flyers are not company papers, and they are not “comparative” either.

This does not appear to be an infringement, therefore. ✓1

1

1

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Q10

The sieckmann criteria are :

- Self contained
- Precise
- Objective
- Durable
- Intelligible
- Easily accessible
- Clear

a) Not self-contained as a person would have to go away and find out what mint smells like.

Not precise ^{✓1} as mint could have several smells based on several ^{✓1} factors.

Not intelligible as mint is likely a sweeping term for many varieties of plants, not just “common garden mint”.

Un-clear as mint’s smell changes based on how it is prepared.

Would not meet the requirements of Sieckmann.

2

b) Not durable ^{✓1} as the scratch and sniff will fade over time. ^{✓1}

No easily accessible as would only be available for test at the IPO, people would have to travel far.

Not intelligible or clear as it is entirely up to interpretation what each individual smells mint as.

Would not meet the requirements of Sieckmann.

2

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c) Not self-contained, as while the mixture can be made up, it is not available
for test simply by reviewing the register. ✓1

Nor is it easily accessible as very few people would have the capability of
producing this concentration in air.

Not clear to people without an understanding of chemistry.

Would not meet the requirements of Sieckmann.

6

MARKS AWARDED: 6/6

2

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Q11

The absolute grounds for refusal are as below: *(comments in italics)*

3(1)a The mark does not meet the criteria of S.1(1):

Can not be represented on the register in a clear and precise manner for the registrar to understand.

Not capable of distinguishing the goods/services of one undertaking from those of another.

The word mark would not differentiate origin of the goods as the consumer would assume the branding on the shoe or box would designate the origin of the shoe.

The mark will be applied to all sorts of shoe marketing from several origins and so won't designate origin. ✓1

In respect of the lab services – because the word “passed” is used at the end of the mark, consumers will not associate it with a testing service, they will assume only that the test has been passed, but it may not have done so via this service.

OBJECTION WOULD BE RAISED

The non-traditional mark (red soles) may not be able to be recorded on the register clearly, as the ‘sole’ portion of a shoe can vary a lot depending on the style, it may be seen as unclear. Although the description does mention “totality” which addresses any lack of clarity in which part of the sole is coloured. ✓½

OBJECTION MAY BE RAISED

3(1)b The mark is devoid of distinctive character.

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use only

Both marks are devoid of distinctive character.

The word mark covers both walking boots and lab services. The average consumer would not recognise "1407Km Challenge Passed" as an origin of walking boots – in fact, it isn't the origin of the walking boots. ✓1

In respect of the lab services, the mark may be more distinctive as an origin of testing standards. ✓1

Would likely be objected to for Walking boots, but not for lab services.

The red soles are also lacking distinctiveness as the consumer would realise that any origin could produce shoes with a red sole, and so would not associate this with one undertaking. ✓1

3(1)c The mark consists solely of signs or indications which may be used in the trade to designate, kind, quality, geographical origin, date of manufacture, or other characteristics of the goods/services.

Arguably the word mark is a characteristic of the 'quality' of the goods. However, only those who have passed the test are permitted to use it, without deceiving the public. So, there is no need to keep the sign available for all to use – only the boots which pass may display it. ✓½

OBJECTION WOULD BE RAISED

3(1)d The mark consists solely of signs or indications which have become common place in the bonafide language of the trade.

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No Objections here.

The signs do not exclusively consist of common place language, "1407" for example. ✓1

Unless the mark has acquired distinctiveness through use (defence to 3(1)b-d objection).

Red soles may be able to acquire distinctiveness as they are as yet unused by other manufacturers. Would need to see evidence of marketing and widespread use though.

3(2)a The mark consists exclusively of the shape or other characteristic of the goods derived from the nature of the goods.

Red sole is not defined entirely by the nature of a boot. A boot sole can be any colour. ✓1

NO OBJECTION WOULD BE RAISED

3(2)b The mark consists exclusively of the shape or other characteristic of the goods necessary to achieve a technical function.

The colour red does not provide any technical effect, the technical features of the sole are left to the manufacturers to choose. So, the mark is entirely non-technical. ✓1

NO OBJECTION WOULD BE RAISED

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3(2)c The mark consists exclusively of the shape or other characteristic of the goods which adds substantial value to the goods.

The red sole will denote that the boot has passed a gruelling test and so is a good quality boot. If this is recognisable, then the mark does exclusively add substantial value to the product. A red soled boot will be worth more than a non-red soled boot which has not passed the test.

OBJECTION WOULD BE RAISED.

3(3) the mark is not against public policy or principals of morality,

Would not deceive the public.

No evidence of this, no objections here.

✓1 ✓1

3(6) The mark was not registered in bad faith.

No evidence of this, no objections here.

✓½ ✓½

11

MARKS AWARDED: 11/20

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Q12

Marjorie may be able to oppose based on relative grounds. Using her earlier mark as grounds.

Capability of the mark to be used in opposition

Marjorie's mark was registered around 10 years ago, so if she is to oppose will need to prove that the mark has been used, or will need to give proper reasons as to why not. ✓½

E – ½

Similarity of the signs

Aural

Both are 2 syllables.

Both contain the "Glo" sound at the start and the "smith" sound in the middle. ✓1

The possessive "s" in Glowsmith's is not prominently pronounced and so has less impact.

✓1

The 've' sound in glove is different to the 'W' in glow.

Same first Sound 'G'

Visual

Same number of letters.

Glowsmith is a device, albeit quite simple. With only basic text and a dark background. The visual elements are relatively undistinctive therefore.

✓1

Glovesmith is word mark only, but the pattern of the letters is very similar.

Both start with "GLO"

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use only

W looks very similar to a V. ✓1

Conceptual

Both rely on the "smith" idea like 'blacksmith' or 'silversmith' in the sense that the brands work with and make the preceding element, gloves, or glow(lights). ✓1

Overall the signs are very similar ✓1

SOM – 6

Similarity of the goods

Competitive

Lights vs gloves, each for cycling. They are not competitive, as riders likely need both. ✓1

Complimentary

There is a very high likely hood that these goods would be used together, highly complimentary. Although, there is no necessity for one to have the other. ✓1

Nature

Both are cycling accessories. Relevant to safety. Lights help you see and the gloves protect hands. ✓1

User

Identical – average consumer cyclist. ✓1 – AC

Method of Use

Gloves are worn on the hands and protect them. Lights are mounted to the bike and illuminate the road. They are used differently. ✓1

Manufacturing origin

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Likely made in different factories, textile vs electronics.

✓1

Distribution channels

These would be very similar, as both are bike accessories, would both be sold in bike shops, perhaps in supermarkets, and at bike conventions.

✓1

Value

Could be similar or different, we do not have the information to say here.

The goods have some level of similarity overall.

✓1

SOG – 7

Average Consumer

Cyclists or perhaps friends of cyclists buying accessory type gifts.

The gloves may be more of a serious cyclist item, as there is no requirement to wear gloves while riding. Whilst riding in the dark legally requires lights, so there may be more consumers interested in the lights, than gloves.

Parents may buy for their children as safety aids.

AC – 1
+ 1 = 2

Likelihood of confusion

There is likely to be some level of care taken when purchasing both goods, as neither are so cheap that no care would be taken. There is the element of needing to ensure the goods 'fit' either to the bike or rider's hands. This causes more care to be taken.

✓1 – AC

Both would likely be sold with assistance from a bike sales representative who would reduce likelihood of confusion by being well experienced.

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There is a chance of association between the marks due to the “smith” element. Consumers may believe that the brands are economically linked and sell gloves under Glovesmith, and lights under glowsmith. With the common smith element.

✓1

LOC – 1
+ 1 = 2

Conclusion

There is certainly a high degree of similarity between the marks. The aural similarity and conceptual similarity take precedence here, as while glowsmith’s is a device mark with visual representation, it is highly indistinct.

The goods are different, but are connected by common users, and distribution channels, which in respect of on the shelf products is very relevant. The same people will be in the same shop looking for related products. There is some similarity in the goods.

The extreme imilarity of the signs can offset a lesser degree of similarity in the goods, and vice versa. ✓LOC – 1

There is therefore some likelihood of confusion. Consumers will likely make a connection between the undertakings.

Marjorie likely has a good chance of successfully opposing this application.

✓1 – C

C – 1

18½

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Q13)

Use of a trade mark which is identical or similar to a registered trade mark is an infringement of an earlier registered trade mark where,

The mark has a reputation in the UK, and use of the later mark would take unfair advantage of or be detrimental to the distinctive character or repute of the earlier mark.

This is regardless of the level of similarity between the goods or services which the marks are used for. ✓1

United Breweries (UB) could bring an infringement action against Patty based on the above point of law. McDUFF clearly has a reputation in the UK as being a top beer brand in the UK and Scotland, and it is a long standing brand which likely means the reputation is strong. ✓1

Patty may well take advantage of the McDuff mark as people will assume the beer is in the sauce (regardless of it actually not being there). Consumers will be used to seeing beers and spirits used in sauces in supermarkets. ✓1

Patty's use could also be detrimental if the sauce is not very nice, or if there is a safety issue with it. This could damage the reputation of UB via the Mc Duff brand. ✓½

However the own name defence may apply here:

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Use of ones own name is not an infringement of a registered trade mark.

As Patty (who is a natural person) is ^{✓1} using her surname for the sauce brand, she has a defence to infringement. ✓1

b)

The common law option would be to pursue passing off. Passing off requires that the trinity test be satisfied, which consists of: Goodwill, Misrepresentation and Damages.

Goodwill

For goodwill to apply, there needs to have been trade in the UK.

UB have long been selling beer in the UK to great success. There is clearly goodwill built up from the sale of McDUFF in the UK. ✓1

Misrepresentation

Patty is selling sauce under the name McDUFF SAUCE.

While it may not be a deliberate misrepresentation, the branding of her goods is likely to deceive the public as it will be assumed that the sauce is connected to the beer company, when it is not.

It may also be a misrepresentation that the sauce contains the beer when it does not. ✓1

Damages

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If the sauce is unsuccessful, it could damage the goodwill of UB.

Further, McDuff may otherwise have licenced use of their name to Patty and so would have collected a licence fee. There are therefore potentially some lost earnings here as well.

✓1

These damages are speculative, but this is sufficient to identify passing off.

Conclusion

Each item of the trinity test appears to be satisfied, there is therefore a good chance that passing off would be found.

✓1

9½

9½

MARKS AWARDED: 9.5/20

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