

FC5 Trade Mark Law
FINAL Mark Scheme 2024

- **Half marks are available for answers insufficiently precise to attract a full mark.**
- **Section / article numbers are not required.**

Section A

Question 1 – Syllabus Area 1(b) - Well known marks

Ampoule SA, a French manufacture of lightbulbs, sells product across Europe. This includes three models sold under the signs ‘AH’, ‘BEY’ and ‘CEY’:

- AH is well-known both in the United Kingdom and France.
- BEY is well-known in France, but not well-known in the United Kingdom.
- CEY is not well-known in the France but is well-known in the United Kingdom.

Only BEY and CEY have been registered in France, and you should assume that French law provides no legal protection for the unregistered trade mark AH.

Explain whether AH, BEY and CEY could serve as ‘well known marks’ for the purposes of the UK Trade Marks Act.

4 marks

Answer

Article 6bis of the Paris Convention applies to imitations of marks considered well known in the country of registration **[1 mark]** as being already the mark of national/domicile of a Convention country such as France **[1 mark]**.

There is no requirement that the mark be registered in its home country **[1 mark]**.

Consequently, AH and CEY are protected, whilst BEY will not be **[1 mark]**.

4 marks

Question 2 - Syllabus Area 2(d) / 11(a) - Duration

Explain the effect (if any) on the renewal date of:

- a UK trade mark
- a Madrid Protocol trade mark designating the USA

if an earlier priority date was claimed in relation to these marks.

2 marks

Answer

- Under s41 TMA and Article 6 MP, the renewal date of both marks is calculated from the filing date **[1 mark]**, and hence claiming priority will have no effect on the term **[1 mark]**.

2 marks

Question 3 - Syllabus Area 3(a) – Member states of the Madrid Protocol

- a) Name two jurisdictions where an objection will be raised *ex officio* during examination if there is a conflicting earlier trade mark on the register.
- b) Name two jurisdictions (other than the UK) where a trade mark application will be published even if there is a conflicting earlier trade mark on the register.

2 marks

Answer (Note, examiner will need to check answers)

- a) China, Japan, Ireland, USA etc. **[2 x 0.5 marks]**
- b) EU, most civil law EU member states **[2 x 0.5 marks]**

2 marks

Question 4 - Syllabus Area 4(c) – Conversion

In the context of EU trade mark law, explain what is meant by 'conversion'.

Explain the circumstances where conversion is and is not available, but do not discuss procedure or timescales.

10 marks

Answer

Article 139 EUTMR provides:

The applicant for or proprietor of an EU trade mark may request the conversion of his EU trade mark application or EU trade mark into a national trade mark application **[1 mark]**:

- (a) to the extent that the EU trade mark application is refused **[1 mark]** withdrawn **[1 mark]**, or deemed to be withdrawn;

(b) to the extent that the EU trade mark ceases to have effect. **[1 mark]**

The national trade mark application resulting from the conversion of an EU trade mark application or an EU trade mark shall enjoy in respect of the Member State concerned the date of filing **[1 mark]** or the date of priority **[1 mark]** of that application or trade mark and, where appropriate, the seniority of a trade mark of that State claimed under Articles 39 or 40. **[1 mark]**

Conversion shall not take place:

- (a) where the rights of the proprietor of the EU trade mark have been revoked on the grounds of non-use **[1 mark]**, unless in the Member State for which conversion is requested the EU trade mark has been put to use which would be considered to be genuine use under the laws of that Member State **[1 mark]** ;
- (b) for the purpose of protection in a Member State in which, in accordance with the decision of the Office or of the national court, grounds for refusal of registration or grounds for revocation or invalidity apply to the EU trade mark application or EU trade mark. **[1 mark]**

10 marks

Question 5 - Syllabus Area 5(d) – Passing Off

Explain how ‘reverse passing off’ differs from more usual forms of passing off.

2 marks

Answer

Reverse passing off was explained in *Bristol Conservatories Ltd v Conservatories Custom Built Ltd*:

- Passing Off – a person misrepresents his own goods/services as being those of another.
- Reverse Passing Off – a person misrepresents someone else’s goods/services as being his own.

2 marks

Question 6 - Syllabus Area 6(a) 7(a) 9(b) – Opposition

Your client, Anouk, has been alerted to an EU Trade Mark application. She is aware that the mark is intended to be used solely in Denmark, Sweden and Finland.

Noting that Malta has a population of only 0.1% of that of the wider EU, and the number of Maltese speakers outside of Malta is too negligible to measure, explain whether an opposition to the EU Trade Mark application can be brought by Anouk on the following grounds:

- a) Anouk owns an earlier, identical, Maltese trade mark for identical goods. It has been used in Malta. However, the mark is not used in any second country of the EU, nor does Anouk engage in exporting.

1 mark

- b) The proposed mark is descriptive, in Maltese, of a characteristic of the goods at issue.

2 marks

- c) Maltese law prohibits the use, in Malta, of an element of the proposed EU Trade Mark, without Government approval.

1 mark

Total: 4 marks

Answer

- a) Yes. Under Article 8(2), a national trade mark, no matter the jurisdiction, can serve as the basis of opposition under Regulation 46 EUTMR **[1 mark]**.

1 mark

- b) Although a mark can be refused on absolute grounds notwithstanding that the grounds of non-registrability obtain in only part of the Union **[1 mark]** there is no general provision under Regulation 46 for raising opposition grounds in EU opposition proceedings **[1 mark]**.

2 marks

c) In contrast to UK trade mark law, this is not an absolute ground for refusal under the EUTMR **[1 mark]**.

1 mark

Total: 4 marks

Question 7 - Syllabus Areas 8(b) / 10(c) – Filing / Priority

On 2 June 2024, Marianne filed the following at the UKIPO:

- a request for the registration of a trade mark,
- her name and address
- a statement of the goods or services she was seeking to protect, and
- a representation of the trade mark

On 14 June 2024, Marianne filed an EU trade mark application, claiming priority from the UK application.

However, Marianne did not pay the necessary filing fee for the UK application, and the deadline for doing so has now passed.

Explain the effect (if any) of this oversight on the EU application.

4 marks

Answer

- The UK application will fail on grounds of not meeting the full requirements of section 32.
- Nevertheless, Marianne has established a filing date under s33 TMA **[1 mark]**.
- For the purposes of the Article 4 Paris Convention, the UK application can be used for the purposes of establishing a subsequent priority. **[1 mark]**.
- The EU application is valid and will benefit from the UK priority date of 2 June 2024. **[1 mark]**.

4 marks

Question 8 - Syllabus Areas 9(c) / 13(a) / 14 (a) – Opposition, revocation and infringement.

Set out precisely the dates between which it is necessary to demonstrate use of a trade mark, in order to:

a) bring opposition proceedings

3 marks

b) defend against revocation proceedings

5 marks

and

c) bring infringement proceedings.

2 marks

[Discuss only provisions in the Trade Marks Act 1994. Do not discuss use of variant signs or proper reasons for non-use].

Total: 10 marks

Answer:

a) Section 6A provides that relevant period means the 5 years ending with the date of the application for registration **[1 mark. Must be precise i.e. no reference to disregarded three month periods.]** or (where applicable) the date of the priority claimed for that application **[1 mark]**. Provided that the registration procedure for the earlier trade mark was completed before the start of the relevant period **[1 mark]**.

3 marks

b) Section 46 provides that the registration of a trade mark may be revoked if that within the period of five years following the date of completion of the registration procedure **[1 mark]** it has not been put to genuine use. Or if such use has been suspended for an uninterrupted period of five years **[1 mark]**. This does not apply if such use is commenced or resumed after the expiry of the five year period and before the application for revocation is made **[1 mark]** provided that, any such commencement or resumption of use after the expiry of the five year period but within the period of three months before the making of the application shall be disregarded **[1 marks]** unless preparations for the commencement or resumption began before the proprietor became aware that the application might be made **[1 mark]**.

5 marks

c) Section 11A provides the proprietor of a trade mark is entitled to prohibit the use of a sign only to the extent that the registration of the trade mark is not liable to be revoked pursuant to section 46(1)(a) or (b) at the date the action for infringement is brought. Consequently, the five criteria in part (b) above apply here too **[1 mark, or give: 0.5 marks for referencing 5 year period (with no 3 month period) and 0.5 marks for referencing either the priority date / registration criteria]**.

Separately, (and by implication, at an early stage in infringement proceedings), a defendant may require proof to be furnished that **in the five-year period preceding the date the action for infringement is brought [1 mark, if precise]** the trade mark has been put to genuine use (where the registration procedure for the trade mark was completed before the start of the period of five years ending with the date the action is brought).

2 marks

Question 9 - Syllabus Area 13(b) - Defences

In trade mark infringement proceedings, what criteria must be demonstrated in order to raise a successful defence of using one's own name?[Only address statutory requirements: there is no need to quote case law]

2 marks

Answer

Section 11(2) TMA provides:

- You must be an individual **[1 mark]**
- Use must be accordance with honest practices in industrial or commercial matters. **[1 mark]**

2 marks

Section B

Question 10 - Syllabus Area 6(a) – Absolute Grounds

Organge plc produces organic orange juice. Its head of marketing, explains that:

- most fruit juice producers sell juice in cuboid (brick-shaped) boxes, made of foil-laminated card with a plastic spout (see figure 1 overleaf).
- Organge recently launched a new box design (figure 2). The box has five differently-sized vertical sides, with the top and bottom forming an irregular pentagon.
- Organge wanted the boxes to pack together on pallets without leaving any gaps (figure 3). Mathematicians call this 'tessellation'.
- there are an infinite number of irregular pentagonal shapes, but only a small subset tessellate, namely ones with two parallel edges. Organge has chosen a set of angles that meet this criteria (edges AB and DE in figure 4) while maximising the differences in the respective lengths of each edge in order to make their box look 'as asymmetric and quirky as possible'.
- Organge has kept a record of references to its product on social media. Since the new box was launched five months ago, there have been nearly 2000 references to the product worldwide, all alone the lines of:

"Organge organic orange juice, in its unusual and eye-catching new box, tastes fantastic!"

- Organge wishes to prevent any competitor in the fruit-juice market adopting a five-sided box. If this is not possible, it wishes to prevent any competitor adopting a five-sided box with two parallel sides.

Draft a note for Organge explaining the likelihood of successfully obtaining a trade mark registration (for class 32, fruit juices). Address only 'absolute' grounds for refusal.

20 Marks

Question 10 – Illustrations

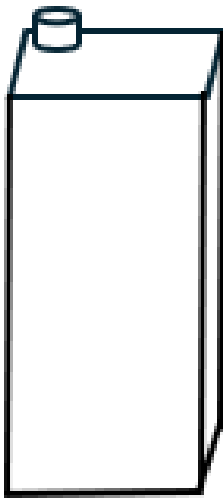


Figure 1

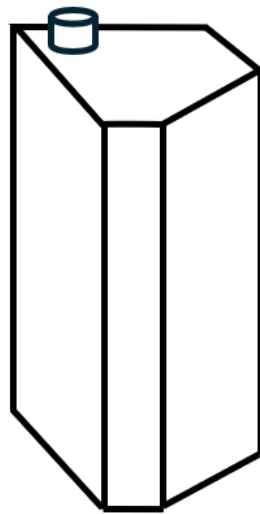


Figure 2

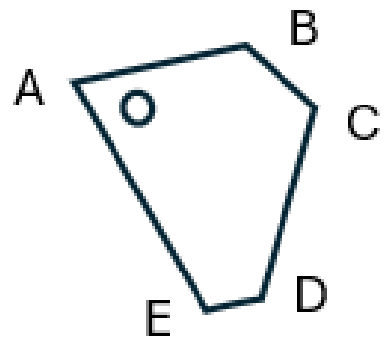


Figure 4

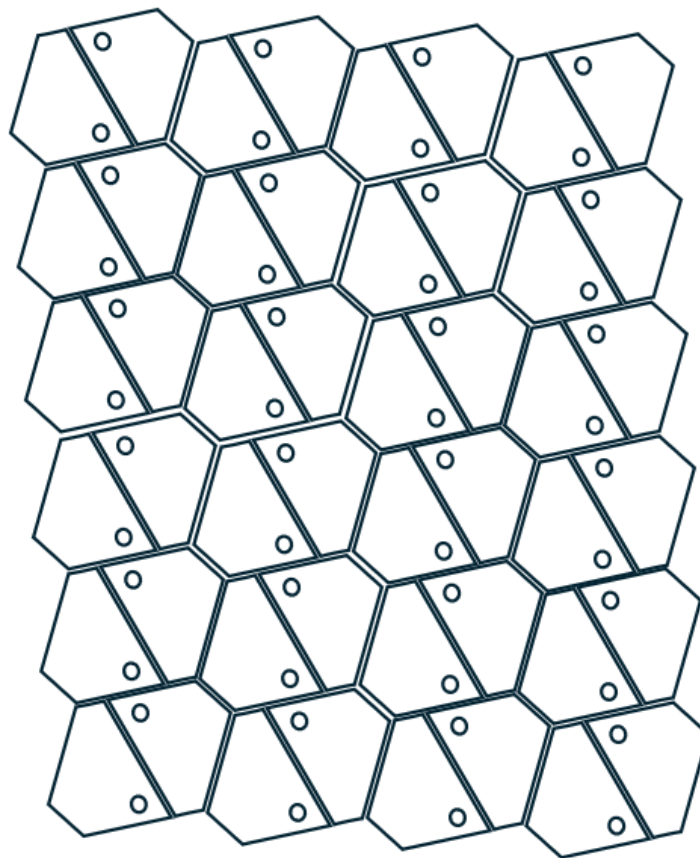


Figure 3

Answer:

Up to 1 mark for any suitable contribution towards the analysis (including the following), up to a total of 20 marks:

Section 3(1)(a):

- Capable of representation / *Sieckmann*: It is not going to be possible to protect five-sided boxes in general **[0.5 mark]**, nor one with two parallel sides **[0.5 mark]**, due to insufficient precision. **[0.5 mark]**. However, an application showing the box as illustrated in Figure 2 would be perfectly acceptable. **[0.5 mark]**
- Otherwise the box meets the fundamental definition of a trade mark, being capable of indicating the goods and services of one undertaking **[0.5 mark]**.

Section 3(1)(b)

- Consumers are unaccustomed to relying on the shape of product packaging alone (i.e. without any surface signage) to indicate trade origin. **[0.5 mark]**
- A 3D mark must comprise a substantial departure from the norm within the sector concerned **[0.5 mark]**
- Here, consumers might believe the five sided shape exists for aesthetic effect, rather than serving as an indication of origin. **[0.5 mark]**, there being no history of juice manufacturers using different shaped boxes to distinguish their products **[0.5 mark]**.
- Consequently the mark lacks inherent distinctive character. **[0.5 mark]**

Section 3(1)(c)

- Not descriptive of a characteristic per se. **[1 mark]**

Section 3(1)(d) –

- No indication that the name is use by anyone else, let alone has become customary **[1 mark]**

Total for 3(1) discussion – 7 marks

Section 3(2)(a) –

- The shape of packaging has no connection to the nature of fruit juice, a liquid – it is entirely arbitrary. **[1 mark]**

Section 3(2)(b) –

- The ability to tessellate is a technical result of the shape **[0.5 mark]**.
- Tessellation is a desirable technical result as it maximises the number of boxes on any one pallet, in turn maximising the number of boxes that can be carried in any one delivery. **[0.5 mark]**.
- Whilst in theory, in order for a five-sided box to tessellate, an infinite number of angle choices might be available to use, only a very limited number of sets of angles will be discernible to the average consumer **[0.5 mark]**.
- However, because the adoption of a five-sided box is an arbitrary design decision **[0.5 mark]** the sign does not exclusively **[0.5 mark]** consist of a shape necessary to obtain a technical result.

Section 3(2)(c)

- The precise shape of packaging (both as a five-sided box in general, and one where each side was of maximally-different size) was chosen primarily for its aesthetic appeal. **[0.5 mark]**

- However, juice is chosen for its taste, nutritional content and value. **[0.5 mark]**
Packaging would play only a minor role in affecting the consumer choice for the product **[0.5 mark]**
- Therefore the sign does not exclusively **[0.5 mark]** consist of a shape necessary to give substantial value **[0.5 mark]** to the goods.

Total for 3(2) discussion – 6 marks

Section 3(3) (Policy, morality, deception)

- No objection

Section 3(4), (4A-D) (Legality)

- No objection

Section 3(6) (Bad faith).

- No objection

[0.5 marks each]

Total for 3(3)-3(6) Discussion – 1 mark

Acquired Distinctiveness

- Section 3(1) provides that a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) (only) if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it **[0.5 mark]**
- It is necessary to demonstrate a significant proportion of relevant consumers have come to rely upon the mark so as to identify goods as originating from Organge. **[0.5 mark]**
 - This is inherently very difficult if the shape is being used alongside other signs, such as ordinary Organge branding. **[0.5 mark]**
- There has been some use of the mark. But use alone is insufficient. **[0.5 mark]**
Additional evidence is necessary to meet the *Windsurfing* criteria such as:
 - the market share held by the mark; **[0.5 mark]**
 - how intensive, geographically widespread and long-standing use of the mark has been **[0.5 mark]**;
 - There is no indication that use in the United Kingdom **[0.5 mark]**
 - There is no indication that 2000 comments is significant in the market in question **[0.5 mark]**
 - the amount invested by the undertaking in promoting the mark **[0.5 mark]**
 - the proportion of the relevant class of persons who, because of the mark, identify goods as originating from a particular undertaking **[0.5 mark]**;
 - There is no indication that the 2000 comments address the question of whether the shape of the sign is being used to **[0.5 mark]**
and
 - statements from chambers of commerce and industry or other trade and professional associations. **[0.5 mark]**

Total for Acquired Distinctiveness Discussion – 6 marks

Total: 20 marks

Question 11 - Syllabus Area 7(a) – Relative Grounds

Your client, Alamode Ltd, is the owner of the UK trade mark below.

Mark	Filing Date	Registration Date	Goods
	1 May 2020	1 October 2020	(9) Spectacle frames of plastic or metal.

Alamode has recently received notice of the publication of the following UK trade mark application, filed by Optico plc:

Mark	Date	Publication Date	Goods
	1 July 2024	1 September 2024	(9) Optical lenses

Your contact at Alamode explains:

- It uses the mark on spectacle frames specifically aimed at children, and sold exclusively through a single chain of UK high street opticians with stores in most towns in the UK.
- Investigations show that the application relates to very high end camera lenses aimed at professional photographers, and sold exclusively by mail order by Optico directly to its customers.
- Spectacle lenses, with the exception of non-prescription sunglass lenses, are always sourced from specialist suppliers, and not from frame manufacturers.
- An online French-English translation tool reveals that LUNETTES DE PARIS means 'Spectacles of Paris' and LUNE ET CIE means 'Moon and Co.'. However, they also appreciate these words are likely to be beyond the French vocabulary known by the average Briton.

Advise Alamode whether it can successfully oppose the trade mark application. Do not discuss marks with a reputation or passing-off.

20 marks

Answer

Up to 1 mark for any substantial contribution towards the analysis of this scenario (such as those indicated below), up to the total indicated:

Enforceability of the earlier mark

The earlier mark is in force. **[0.5 marks]**

The earlier mark has not been registered for more than 5 years, and consequently is enforceable. **[0.5 marks]**

1 mark

Average Consumer

Spectacle lenses and frames would be bought together by the average consumer (including parents when buying glasses for children). Camera lenses would be bought by the professionals and the general public.

There is no particular reason to assume that the average consumer would understand French.

All the items (frames, lenses, camera lenses) will be bought with the upmost care.

2 marks

Similarity of Marks

Aural

The first two and last two syllables of the words are identical. However, the central syllable(s) of the words are entirely different in sound (even if the average consumer might not know precisely how the words are pronounced).

Less weight is afforded to differences in the middle of the word, but will nevertheless be noticeable.

2 marks

Visual

Both marks contain a prominent word element on top of simple light grey shapes, including stars.

Only the first three letters are identical, along with the last word "PARIS", although in the application the word PARIS is clearly not core to the design. The visual appearance of the centre of the names is entirely different in length and letters used.

2 marks

Conceptual

There is a shared conceptual similarity, namely text set about heavenly bodies. However, in the second mark, the central heavenly body is very different.

Both names would be recognised as being in French, even if consumers do not recognise what the words mean. "Paris" would be recognised but given little if any weight, as clearly used in both signs as an indicator of geographic origin.

2 marks

Overall

The visual aspect is likely to be given more weight in a retail environment, and because both marks are logos. However, the differences are such that the marks are likely to be regarded as having **very low similarity**.

1 mark

Total SOM – 7 marks

Similarity of Goods

It is important to address the goods as listed in the specification. Here “lenses” is sufficiently wide to encompass spectacle lenses, although thought needs to be given as to whether Optico could avoid an opposition by limiting its specification to camera lenses.

Users? Spectacle lenses and frames have identical users. Were Optico to limit its specification, the users are different (photographers vs general public).

Nature? (composition, functioning principle, appearance) – Identity - Lenses are made of glass or optical plastics. Were Optico to limit its specification, camera lenses will have additional housings, detracting from the identity.

Value? There will be an overlap in value – certainly no major disparity.

Purpose? Both items are used together to correct vision. Were Optico to limit its specification, both items have a more abstract common purpose.

Method of use? – Both items are used together to correct vision. Were Optico to limit its specification, both items would be used differently (everyday wear vs photography).

Complementary? Both items are used together to correct vision. Were Optico to limit its specification, use is not complementary (everyday wear vs photography)..

Competitive? Frames and lenses are not in competition. Were Optico to limit its specification, use is not competitive.

Distribution channels? Both are dispensed through opticians. Were Optico to limit its specification, entirely different distribution channels would be involved (opticians vs camera shops).

Manufacturing origin? We are told that only sunglasses are of common origin – however it would not be unreasonable for consumers to believe other lenses come from the same source. Were Optico to limit its specification, there is no common manufacturing origin.

6 marks

Overall –The differences between frames and lenses does not detract from the otherwise closely-shared characteristics of the products, and so these are **strongly similar**. Were Optico to limit its specification, there would be **very low** similarity between the goods.

1 mark

Total SOG – 7 marks

Likelihood of confusion

Enhanced distinctiveness – The mark is being used, but no evidence is presented.

A weak similarity of the marks is offset by a strong similarity of the goods. Because of the care afforded by the average consumer, confusion is unlikely. Were the specification limited to camera lenses, a weak similarity of the mark combines with a very weak similarity of the goods, meaning that confusion would not occur.

2 marks

Conclusion

Opposition is unlikely to be successful. Certainly, were the application limited to 'camera lenses', the action certainly should not be pursued further.

1 mark

Total: 20 marks

Question 12 - Syllabus Area 5 –Passing off

a) Khandy is a Senegalese model ordinarily resident in Paris. She is married to Jules, a French politician.

Borg Ltd, a UK-based information technology company, has created a facility allowing customers to upload photographs of mannequins (tailors' dummies) dressed in items of clothing. Using cutting-edge artificial intelligence, Borg then 'scrapes' video footage from the internet of individuals named by the customer, which it processes together with the photographs to fabricate realistic-looking moving video of those individuals wearing the items of clothing.

Celeste, a UK-based fashion designer, has used Borg's facility to create a video that depicts Khandy and Jules, together, walking along a catwalk. Both are shown as wearing Celeste's clothing. Celeste shows the video at a presentation at London Fashion Week. However, neither Khandy nor Jules have ever worn Celeste's clothing.

Draft a note to your supervising attorney, explaining whether under English law, an act of passing-off has occurred.

12 marks

b) Assume that an act of passing off has taken place. Advise whether Celeste could have avoided such an action by clearly labelling her video with the disclaimer:

"Images of Khandy and Jules generated artificially by AI by Borg Ltd. Khandy and Jules have played no part in the creation or approval of this video"

2 marks

c) Khandy and Jules understand that damages and an account of profits are available as two of the remedies for passing off. Assuming that their action is successful:

- i) explain the differences between damages and an account of profits
- ii) explain why it is not possible to claim for both remedies.
- iii) explain how each sum could be calculated in the circumstances described above.

6 marks

Total: 20 marks

Answer

Up to 1 mark for any substantial contribution towards the analysis of this scenario (such as those indicated below), up to the total indicated:

a)

Goodwill

Models are able to benefit from goodwill from repeat bookings **[1 mark]**

Or, if sufficiently famous, from the business of giving “endorsements” to wider products **[1 mark]**.

Goodwill is jurisdictional. Businesses (the booking of the model, or at least the modelling of the clothes) would need to occur within the United Kingdom for passing off law to be operative. **[1 mark]**

There is no evidence that Khandy has conducted business in the United Kingdom. This is fatal to the existence of goodwill. **[1 mark]**

There is no evidence to suggest Jules conducts any business in the UK, and therefore benefits from goodwill **[1 mark]** Politicians can benefit from goodwill in their fundraising, but that goodwill is not at issue here **[1 mark]** There is certainly no evidence to suggest Jules is engaged in modelling. **[1 mark]**.

Total for goodwill: 5 marks

Misrepresentation

When a well-known model agrees to wear a designers’ clothes, she is signalling to the average consumer that she, in effect, endorses that designer and their clothes. The glamour of the well-known model transfers to the clothing range. **[1 mark]**.

This is not the case with an unknown model. The consumer mind is on the clothes, and does not **[1 mark]**.

There is a clear misrepresentation, of sorts, that Khandy and Jules have agreed to wear Celeste’s clothes. However passing off requires more, namely that the misrepresentation is that Khandy is ‘endorsing’ Celeste’s clothing range. **[1 mark]**. Or alternatively, that Celeste’s business is of sufficient size and attractiveness to book Khandy. **[1 mark]** This cannot be implied, but requires evidence of Khandy’s fame.

There is unlikely to be a misrepresentation that Jules has entered into an agreement with Celeste to model his clothes. **[1 mark]**

Total for misrepresentation: 4 marks

Damage

If Khandy enjoys goodwill in the United Kingdom, then she has been deprived of the income she obtains by modelling clothing. **[1 mark]**

As Jules has no goodwill in the United Kingdom, no damage will have occurred to that goodwill. **[1 mark]**

Total for misrepresentation: 2 marks

Conclusion

It might be possible for Khandy. However this requires significant evidence of the extent of her modelling activities in the UK to date. There is no foreseeable prospect of Jules being successful. **[1 mark]**

1 marks

Subtotal: 12 marks

b)

Disclaimers generally address the issue of misrepresentation. **[1 mark]**.

However, the general rule is that "*thirsty folk want beer, not explanations*" and that disclaimer are likely to be overlooked by the average consumer and are consequently ineffective **[1 mark]**

2 marks

c)

i) Damages represent the financial loss incurred by the claimant. An account of profits represents the benefits enjoyed by the respondent. **[1 mark]**. Also, damages are a right, whilst an account of profits are an equitable remedy and so not always available (for example, in the cases of undue delay in bringing an action).**[1 mark]**

ii) The law does not permit claimants to be compensated twice. **[1 mark]**

iii) Damages would be calculated according to either:

- the normal fee Khandy or Jules would have obtained by agreeing to model Celeste's clothes and appear in a video **[1 mark]**, or
- any UK business (such as exclusivity) they would have lost from competitor fashion houses who did not book them because they were working for Celeste.**[1 mark]**

Account of profits would be calculated from the amount of additional sales Celeste has managed to generate as a result of using Khandy and Jules' image. **[1 mark]**

6 marks

Question 13 - Syllabus Areas 1 / 2 / 3 / 4 - International filing strategy

Your client, Savonco SA, a company incorporated in France (from where it operates), owns the following applications and registrations for a trade mark:

Trade Mark	Jurisdiction	Filing Date	Registration Date	Goods (all class 3)
BONJOUR	France	1 July 2015	1 December 2015	Soap
BONJOUR	Italy	1 December 2020	1 March 2021	Soap
BONJOUR	UK	1 June 2023	1 October 2024	Soap
BONJOUR	Germany	1 June 2024	Not yet registered	Soap, toothpaste
BONJOUR	USA	1 June 2024	Not yet registered	Non-medicated bar soap
BONJOUR	China	1 June 2024	1 September 2024	Soap, toothpaste
BONJOUR	South Africa	1 June 2024	1 October 2024	Soap

Savonco wishes to reduce the administrative burden of renewing these trade marks by consolidating them using both the EU Trade Mark and Madrid Protocol systems. It also explains that:

- It has no real intention of selling toothpaste, but included this item in certain jurisdictions for defensive purposes.
- it recalls that the USPTO required the precise nature of the soap it was selling in the US to be described in the US trade mark application (as shown above).
- it does not wish to lose the protection of any filing dates it has already secured.

a) Set out two schemes/filing strategies that would achieve Savonco's aims.

(A pair of tables would be a useful way to convey this information to your client)

16 marks

b) Recommend one scheme/filing strategy, setting out the advantages and disadvantages over the other.

4 marks

Answer:

Mark as indicated, up to the totals indicated for each part.

a)

Option 1

Trade Mark	Jurisdiction	Designations	Goods	
BONJOUR	France (i.e. current mark retained)		Soap	[1 mark]
BONJOUR	France (i.e. a new application) Claiming partial priority for toothpaste from DE (1 June 2024) [1 mark]		toothpaste	[1 mark]
BONJOUR	South Africa (i.e. current application retained)		Soap, toothpaste	[1 mark]
BONJOUR	Madrid Protocol Using BOTH French base registration and application [1 mark] Claiming partial priority for toothpaste from DE (1 June 2024) [1 mark]		Soap, toothpaste [1 mark]	[1 mark]
		EU, claiming seniorities for FR, IT and DE [1 mark]		[1 mark]
		UK,	Limited to soap [1 mark]	[1 mark]
		US	Limited to non-medicated bar soap [1 mark]	[1 mark]
		CN		[1 mark]

UK, US and CN national marks are replaced **[1 mark]**

The FR, IT and DE national marks can be left to lapse **[1 mark]**

10 marks

Option 2

Trade Mark	Jurisdiction	Designations	Goods	
BONJOUR	EU, claiming seniorities for FR, IT and DE [1 mark] Claiming partial priority for toothpaste from DE (1 June 2024) [1 mark]		Soap Toothpaste [0.5 marks]	[1 mark]
BONJOUR	South Africa (i.e. current)		Soap, Toothpaste	[1 mark]
BONJOUR	Madrid Protocol, based on EU application [1 mark] claiming partial priority for toothpaste from DE (1 June 2024) [1 mark]		Soap, Toothpaste [0.5 marks]	[1 mark]
		UK,	Limited to soap	[0.5 marks]
		US	Limited to non- medicated bar soap	[0.5 marks]
		CN		[0.5 marks]

Again, the UK, US and Chinese national marks are replaced **[0.5 marks]**

The FR, IT and DE national marks can be left to lapse **[0.5 marks]**

6 marks

Total for part (a) – 16 marks

b)

The second scheme requires only the renewal of three trade marks, versus four, and only three designations under the Madrid Protocol **[1 mark]**

However, the Madrid Protocol application is at risk of central attack **[1 mark]** if the EU application meets objection, which is possible as it extends to new territories and consequently could conflict with national rights **[1 mark]**. Consequently, the first option is to be recommended **[1 mark]**.

4 marks

Total: 20 marks