

Foundation Certificate

FC5 Trade Mark Law

Wednesday 23 October 2024

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 preset 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 **9 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

Ampoule SA, a French manufacturer of lightbulbs, sells products 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 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

Question 2

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

Question 3

- 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.

1 mark

- 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.

1 mark

Total: 2 marks

Question 4

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

Question 5

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

2 marks

Question 6

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 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

Question 7

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

Question 8

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; and

5 marks

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

Question 9

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

Total for SECTION A: 40 marks

SECTION B

Question 10

Organge plc produces organic orange juice. Its head of marketing explains the following:

- 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 criterion (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 along 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

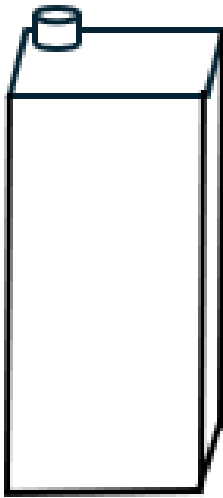


Figure 1

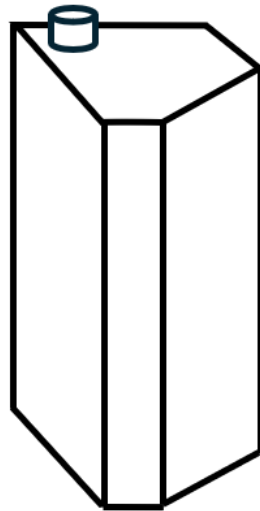


Figure 2

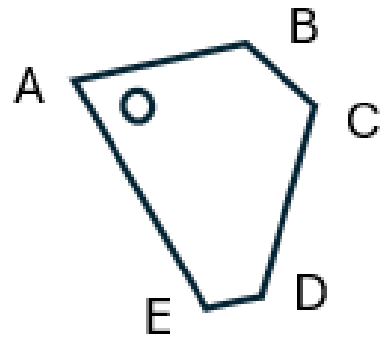


Figure 4

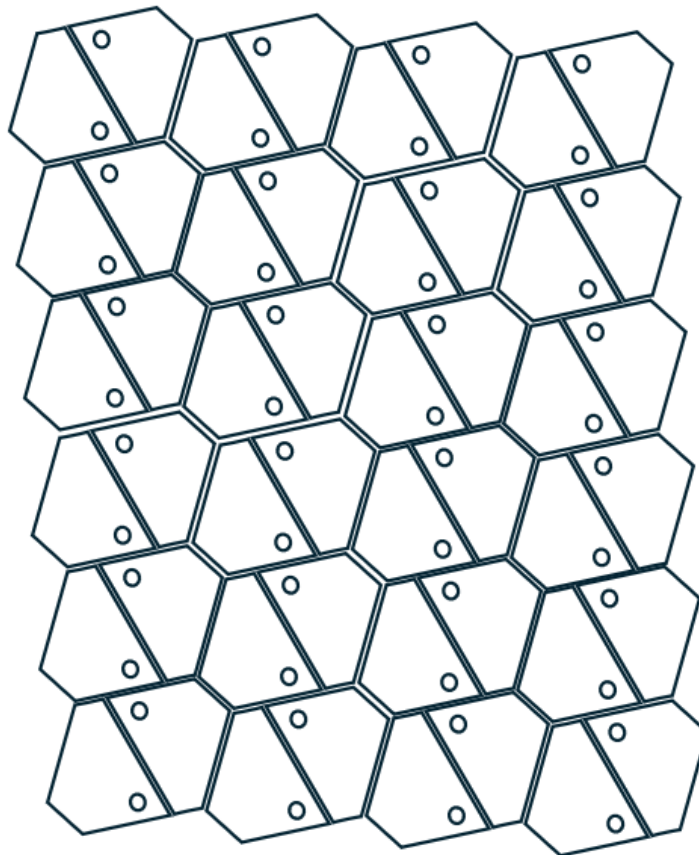


Figure 3

Question 11

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 the following:

- 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 sunglasses 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

Question 12

- 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; and
- iii) explain how each sum could be calculated in the circumstances described above.

6 marks

Total: 20 marks

Question 13

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 the following:

- 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

Total: 20 marks