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Question 1

A well-known mark is a mark that is of more than mere local significance in a territory as considered by the competent authority for the relevant goods/services, where the mark belongs to a proprietor entitled to received protection under the Paris Convention in that territory.

AH

‘AH’ is apparently well-known in the United Kingdom, assuming they have real and effective commercial/industrial establishment in the UK in the form of their sales, they should be entitled to protection of a well-known mark. If selling in the UK is not considered by the UKIPO as not real and effective industrial/commercial establishment, then they may not be entitled to this protection.

BEY

✓1

‘BEY’ is not well-known in the UK so will most likely not be able to serve as a well-known mark.

CEY

‘CEY’ is well known in the UK, which is the relevant territory, and assuming they have real and effective commercial/industrial establishment in the UK in the form of their sales, they should be entitled to protection of a well-known mark. If selling in the UK is not considered by the UKIPO as not real and effective industrial/commercial establishment, then they may not be entitled to this protection.

1

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Question 2

UK Trademark

- The UK trademark will remain on the register for 6 months after the renewal date, which is from date of registration not priority, known as the grace period, in which the mark can be renewed without any loss of right, with payment of the renewal fee and an additional fee. No declaration of use required.

MP Designating US

- Renewal date from date of filing. ✓¹
- The mark will need to have its renewal fees paid as well as an affidavit signed by the proprietor showing:
 - Declaring use
 - Providing specimens proving use
 - Stating reasons for non-use

MARKS AWARDED: 2/2

2

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Question 3

PART A

- UK, EU, examine based on absolute and relative grounds, but do not refuse the application. 0

PART B

- ^{✓_{1/2}} France, ^{✓_{1/2}} Italy, Spain as they only examine on absolute grounds.

MARKS AWARDED: 1/2

1

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Question 4

Conversion of a EUTM (European Trademark) application/registration is available when a mark is refused/cancelled due to some absolute or relative grounds of refusal, where this refusal applies to the unitary EUTM. Conversion allows the proprietor to apply for national trademarks and maintain the priority/filing date of the refused/cancelled/invalidated EUTM, maintaining the associated rights to this, in national territories covered by an EUTM **where the EUTM application/registration would have been valid at the time of filing of the EUTM**. For example, if a EUTM was successfully opposed in France on relative grounds but would have been valid Spain, then an owner can start a 'new' application for a national mark in Spain, while maintaining the EUTM priority/filing date.

- Can only apply for conversion in states covered by the EU.
- Must request Conversion at the EUIPO.
- Must be the proprietor of the EUTM that applies for conversion.
- Conversion request must be for an identical mark.
- Conversion request must be for identical classes of goods/services or for a narrower set of classes of goods and services, if they were all present in the initial EUTM application.
- Must pay the conversion fee.
- Conversion may be more expensive than applying for national marks at offices of choice but prevents the need for the applicant to:
 - Find representation to file an application at each national office.
 - File translations in the national language of each national office.

MARKS AWARDED: 4/10

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Question 5

Reverse passing off refers to a situation where a person removes a mark/sign designating the origin of a good/service and presents the good/service as originating from themselves. For example, they may remove the packaging of a good, repackage it with their own mark, and expose the good for sale as if they had produced the goods themselves. Taking the work of others and using it as their own. ✓1

MARKS AWARDED: 1/2

1

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Question 6

PART A

Anouk can oppose the EUTM based on the earlier Maltese trademark as they own it, and due to the unitary character of an EUTM, if the application/registration of the EUTM is anticipated in even one territory of the EU, then it can be opposed completely. **So, Anouk can oppose the mark on relative grounds.**

✓1

1

PART B

Due to the unitary character of an EUTM, if the application/registration of the EUTM is descriptive (in the language) in even one territory of the EU, then it can be **invalidated/revoked** completely. However, **there is no provision for opposing marks on absolute grounds at the EUIPO**, so will need to apply for invalidity of the mark. Could file an observation.

✓1

✓1

2

PART C

EUTM applications that are prohibited by national law in a member state of the EU are not eligible for registration, however this is an absolute ground, so Anouk cannot oppose the registration. Can file observations or apply for invalidity of the mark.

0

0

MARKS AWARDED: 3/4

3

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Question 7

In this case, the application from which priority can be claimed (convention application) is the application filed at the UKIPO.

- Priority in subsequent applications must be claimed within 6 months of the date of filing of the Convention application.
- In this case the EU application was filed and claimed priority on the date of filing from the UKIPO application within 2 weeks, so the priority claim is valid. ✓¹
- As the 2-month deadline for paying the filing fee in the UK has passed, the UK trademark application will be deemed abandoned. ✓^{1/2}
- However, claims to priority are for establishing earlier rights, and the **fate of the application from which priority is claimed has no effect on the applications claiming priority from it, so the EUTM will maintain its priority date.** ✓¹

MARKS AWARDED: 2.5/4

2½

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Question 8

Assuming this can be both a registered and unregistered mark.

PART A

To bring opposition proceedings based on an earlier mark:

- There is no requirement for use as such. Opposition
- However, in a counterclaim, if the earlier mark was registered within 5 years of the opposition being filed. ✓1
- The defendant can ask that the owner of the earlier mark furnish proof that the mark has been used.
- If opposing based on an unregistered mark, the mark must have been used by the owner continuously in the locality that the unregistered mark applies to.

1

PART B

To prevent a mark being **revoked in the UK due to non-use for a continuous period of 5 years:**

- The mark must have been put to genuine use in the UK,
- By the proprietor,
- Or with the permission of the proprietor
- In the course of trade,
- For all the goods and services that the mark has been registered,
- Where the mark has only been put to use for some of the registered goods and services, then it will only be considered to have been put to

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use for those goods/services for the purpose of revocation (can't only use for some classes and keep for all).

0

PART C

To bring infringement proceedings based on an earlier mark:

- Proprietor must show genuine use in the UK as above.
- Within the 5 years period from the earlier of
 - o The date of priority of the application
 - o The date of filing of the application
 - o The date of registration of the application.

0

MARKS AWARDED: 1/10

1

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Question 9

To successfully mount a defence in infringement proceedings due to use of one's own name:

- Must show that this use is not taking unfair advantage of or damaging the distinctive character of the mark allegedly being infringed for the relevant goods/services.
- Must be used in accordance with honest practices as defined by Article 6 of the relevant directive. ✓1
- Must actually be their own name.

MARKS AWARDED: 1/2

1

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Question 10

Assuming we would try to register a (3D) representation of a five-sided box or the same with two parallel lines, as opposed to a wordmark for 'Five-sided box'. ^{✓½}

Distinguishing Undertakings

A mark needs to be able to allow the competent authority and relevant public to determine the clear and precise scope of protection that should be afforded to the proprietor, and to distinguish the goods and services from one undertaking from those of others.

Five-sided box

- A representation of a five-sided box in theory could allow people to determine the origin of goods against goods from a different origin, especially considering most people in this class use cuboid constructions.

Five-sided box with two parallel lines

- Similarly, a representation five-sided box with two parallel lines could allow users to distinguish goods and services from different undertakings.

Not likely to be rejected based on representation not allowing undertakings to be distinguished. ^{✓½}

Sieckmann Criteria

Sieckmann criteria provides that a mark should ideally be representable graphically and should conform to the following criteria.

- Clear
- Precise

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- Objective
- Self-Contained
- Durable
- Easily Accessible
- Intelligible

Five-Sided Box

- Intelligible, Durable, Objective, Easily Accessible, Self Contained.
- Not clear and precise, there are many ways to implement a five-sided box. ✓½
- Could be helped with multiple representations maybe. ✓½

Five-sided box with two parallel lines

- Intelligible, Durable, Objective, Easily Accessible
- Clear and precise if represented by angles and differences in the respective lengths of each edge in order to make their box look 'as asymmetric and quirky as possible'.

At risk of being refused depending on representation being used.

Descriptive

Marks that serve as indication as to the kind, nature, origin, time, or method of production, ..., or any other characteristic of good/service cannot be registered as they are descriptive of the goods.

Five-Sided Box

- This is not a characteristic of the goods the mark would be registered for (fruit juices)

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Five-Sided Box with two parallel lines

- This is not a characteristic of the goods the mark would be registered for (fruit juices)

✓1

No opposition based on descriptiveness.

Customary

Marks that are customary in the trade or are bona fide language for describing goods/services for which the mark would be registered are to be refused.

Five-Sided Box

- This representation seems arbitrary and so would not be opposed on this ground.

✓1

Five-Sided Box with two parallel lines

- This representation seems arbitrary and so would not be opposed on this ground.

Acquired Distinctiveness

Some of the above grounds for refusal can be overcome if, through use, the mark has acquired distinctive character among a significant proportion of the population such that they link the mark to the undertaking of the proprietor, ✓½

- 2000 references to the product worldwide:
 - This is relatively small compared to the population of the UK, population close to 80 million. ✓½
 - References are worldwide, not just UK based, so likely to be even smaller number. ✓½

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Unlikely that the mark has acquired distinctive character. ✓½

Shapes

Marks that have shapes from which they derive substantial value, that are necessary to achieve a technical result, or are a result of the good themselves cannot be registered.

Five-Sided Box

- This shape does not derive its shape from the good itself. ✓1
- Could be considered necessary to achieve technical results but unlikely to be objected to as there are an infinite number of alternatives for this. Allow ✓½
- Depending on representation, could be considered as bestowing value on good, leading to refusal.

Five-Sided Box with Two parallel lines

- Doesn't matter if there are alternatives, alternatives are not infinite so could be considered required for the technical result of tessellation, ✓½ leading to refusal.
- '...in its unusual and eye-catching new box', could be refused for having substantial value due to appearance of good.
- This shape does not derive its shape from the good itself.

Contrary to accepted principles of morality.

- Marks do not seem to offend any publicly accepted principles of morality. ✓½

Contrary to Law

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- Marks do not seem to contravene an UK laws or international laws that the UK is a part of. ✓½

Bad Faith

- Marks do not seem to have been filed in bad faith. ✓½

Plant Varieties

- Marks do not reproduce a plant variety.

Traditional Specialties

- Marks do not reproduce a traditional specialty.

Geographic Designations of Origin

- Marks do not reproduce a geographical designation of origin.

Conclusion

Five-Sided Box

- Unlikely to be accepted due to lack of clarity and precision that a representation of this would have.

Five-Sided Box with Two parallel lines

- Likely to be rejected due to the technical requirement to achieve tessellation, as there are finite ways to achieve this with a five-sided box with two parallel lines (ref mentioned in Phillips vs Remington).

MARKS AWARDED: 9.5/20

9½

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Question 11

Enforceability of Mark and Formalities

- Need to file opposition by 1st December 2024.
- Mark has been used extensively in the UK so not at risk of being revoked for non-use.
- Even if it hadn't been used, mark was registered less than 5 years ago, so no renewal fees are due, it can serve as an earlier mark. ✓½

E – ½

Similarity of Marks

When assessing likelihood of confusion and the similarity of marks, need to take a global assessment of the distinctive character of the mark, accounting for the dominant and distinct features of the mark. Consider conceptual, aural, visual, syntactic features.

Conceptual

- Both marks refer to a geographical location Paris (reference to location not alone enough to prevent registration (Windsurfing Chiemsee)) but will both lead consumer to think of the same place. ✓1
- Conceptually very different in terms of their meaning, from information supplied, however, not relevant in the UK market considering it will be beyond French vocab of average Briton.
- Both are logos with words and a background referring to celestial bodies, so people will think of space when presented with both marks. ✓1

Conceptually, they are more similar than they are different.

Visually

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- Both are in monochrome.
- Fonts are different; however, both are black, capitalized, and take up a similar proportion of the logo. ✓1
- Both comprise at least one star, although the shape, size, orientation, and number of stars vary between the logos which could be a large point of difference.
- Optico has a moon which is more prominent than stars in the logo and is the same size as star in first logo. ✓½

Visually relatively similar.

Aurally

- When pronounced in a French or English accent, will sound very similar, apart from 'IE' symbol at end of defendant's mark. ✓1
- The inclusion of 'DE', which means 'from', may make a difference aurally but both marks still refer to the location Paris. ✓1

Aurally quite similar.

Syntactically

- Differ slightly in spelling, extra 'T' in client's mark, new mark has 'CIE' syllable and 'DE' as well.

Syntactically not very similar.

Enhanced Distinctiveness

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Enhanced distinctiveness means that a mark should enjoy a greater scope of protection, if through use and composition of distinctive dominant features, it has become strongly linked to goods and services that it is registered for.

Lesser similarity in marks can be offset by greater similarity in goods and services and vice versa.

As the client's mark is distributed widely throughout the UK, there is a chance it could enjoy enhanced distinctiveness and should be considered more likely to be confused with other marks. ✓1 – LOC

Considering there are quite a few similarities conceptually, visually, and aurally, it is more likely than not that there will be some confusion/association between the mark. ✓1

SOM
– 6½

Similarity of Goods and Services

Consumer does not need to know where the marks are manufactured, only that they have a source (Windsurfing Chiemsee).

More likely to be confusion if similarity of goods means that there is a likelihood of association leading to the relevant consumer believing that the goods come from the same or economically linked undertakings (Canon vs MGM).

Association is not enough for confusion, however.

Competing/Complementary

- Spectacle frames and optical lenses are not necessarily in competition with each other. ✓1
- However, there is a high level of complementarity between the two, defeats the purpose of frames to not have lenses. ✓1

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Methods of Distribution?

We are told methods of distribution are different, one through supermarkets, and the other via mail order exclusively.

Consumer does not need to know where the marks are manufactured, only that they have a source (Windsurfing Chiemsee). So, sourcing of lenses may not be of importance, even if they could be from the same specialist supplier as the camera lenses. ✓½

SOG – 3½

Average Consumer

Average consumer should be considered reasonably knowledgeable and circumspect, and they rely on an imperfect picture of marks in their mind (LLOYDS vs LOINTS).

Spectacle Frames: Average consumer would be the parents of or the children who use these spectacle frames. Due to how expensive such products may be, more likely than not that these consumers would exercise higher than average caution when purchasing spectacle frames.

Optical lenses for Cameras: Average consumer would most likely be professional photographers. Due to how expensive such products may be, more likely than not that these consumers would exercise extreme caution when purchasing lenses. ✓1½

AC – 1½

Due to caution likely to be exercised by consumers and different methods of distribution, these goods are likely to be considered very different, regardless of complementarity of goods. ✓1 – LOC

LOC – 2

Conclusion

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Due to nature of the goods, very unlikely that consumers will confuse the two products, even if there is some similarity of the logos and complementarity of goods. Opposition not likely to succeed.

✓1

C – 1

MARKS AWARDED: 15/20

15

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Question 12

PART A

Requirements for passing off to have occurred.

There must have been:

- Goodwill in the good/service provided by the proprietor.
- Misrepresentation based on the Goodwill.
- Damage because of the misrepresentation.

Goodwill

- Goodwill is the reputation in the goods/services of a proprietor, that leads to (repeat) custom from actual or potential customers.
- It arises in the goods/services themselves, not the mark (in this case Khandy and Jules)
- Jules/Celeste do not seem to have trade in selling dresses.
- Goodwill can be generated if there is promotion of the good/service in a territory, so it depends if the couple:
 - o Sell dresses using their likenesses in the UK.
 - o Designs dresses in the UK.
 - o Has modelled in the UK (service of modelling) ✓1
 - o Have engaged in marketing of goods/services using their likenesses in the UK.

Unless they have engaged in the trade of clothing or modelling in the UK, then there is no goodwill that Khandy/Jules own, so no goodwill is being taken advantage of. ✓1 ✓1

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Misrepresentation

- Misrepresentation is where a person takes advantage of the goodwill of the claimant where the calculated actions of the defendant have led to the public being misled or deceived as to the origin of the goods/services.
- If there is goodwill in the goods/services of making and selling dresses and modelling, ^{✓1} then here will be a clear, direct method of passing off as Celeste is passing off the couple's likeness (equivalent to their mark) as a celebrity endorsement of her dresses. ✓1

Damage

- This is where there is damage to the goodwill of the couple due to the misrepresentation. Assuming there is misrepresentation, there would be clear damage in the form of
 - o Lost sales of dresses, proceeds of which are now going to Celeste as opposed to the couple. ✓1
 - o Loss of opportunity for modelling dresses (others may use Borg's facilities rather than hiring the couple) ✓1
 - o Blurring of uniqueness, arguable that easy of reproduction of their likeness may 'cheapen' their brand.
 - o Loss of reputation: Part of the couple's value may exist in the exclusiveness of the events they attend, which the London presentation may not conform to.

Conclusion

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It is unlikely that there has been passing off as there does not seem to be any goodwill that Khandy and Jules own. ✓1

8

PART B

If passing off has occurred, a disclaimer may be enough to avoid the action as it would serve as notice to the relevant consumer that the goods/services on display are not from the proprietor of the goods/services in which the goodwill subsists, eliminating any misrepresentation. ✓1

1

PART C

- i. Damages refer to losses to the claimant caused by passing off, whereas an account of profits refers to the benefit accrued by the defendant. ✓1
- ii. Damages can be sought only if it occurs before sales by the defendant, whereas accounts can only occur if there have been sales by the defendant.
- iii. Damages could be determined by a loss of future. ✓1
- iv. earnings/opportunities to Khandy/Jules in this industry. Accounts of profits could be determined by calculating sales made due to use of advertising her clothes based on Khandy's/Jules' image. ✓1

3

MARKS AWARDED: 12/20

12

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