

| Paper Ref  | Sheet          | Percentage Mark Awarded |
|------------|----------------|-------------------------|
| <b>FC5</b> | <b>1 of 28</b> | <b>64%</b>              |

Examiner's  
use only

### Question 1

In member states of the Paris Convention, the member state has the right to cancel or refuse registration, or prohibit use, of a mark identical to or likely to cause confusion with an existing mark well known in that country to be the mark of a person entitled to the rights of the convention. ✓<sup>1</sup>

Both the UK and France are party to the Paris Convention, so this provision applies.

We are told that Ampoule sells products across Europe under signs AH, BEY, CEY.

AH is well known both in the UK and France. Therefore, it seems that AH is a well-known mark in the UK, and I would expect this mark to serve as a well-known mark for the purpose of the UK trade marks act in the UK. AH will also be a well-known mark in France.

BEY is well known in France but not well known in the UK. As the mark is not well known in the UK, then I would not expect this mark to serve as a well-known mark for the purpose of the UK trade marks act in the UK. BEY will be a well-known mark in France.

CEY is not well known in France but is well known in the UK. Therefore, it seems that CEY is a well-known mark in the UK, and I would expect this mark to serve as a well-known mark for the purpose of the UK trade marks act in the UK. CEY is not a well-known mark in France. ✓<sup>1</sup>

**MARKS AWARDED: 3/4**

3

Page sub-  
total

| Paper Ref  | Sheet          |
|------------|----------------|
| <b>FC5</b> | <b>2 of 28</b> |

Examiner's  
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## Question 2

UK trade mark: There is no effect if an earlier priority date was claimed in relation to this mark. The renewal date runs from the filing date of the UK trade mark application. ✓1

Madrid Protocol trade mark designating the USA: Renewal date would still run from the filing date of the Madrid Protocol trade mark application, ✓1 but would need to file a declaration of use of the mark and evidence of use for the mark in relation to the goods and services from the earlier priority date (rather than filing date of the Madrid Protocol trade mark application).

**MARKS AWARDED: 2/2**

2

Page sub-  
total

| Paper Ref  | Sheet          |
|------------|----------------|
| <b>FC5</b> | <b>3 of 28</b> |

Examiner's  
use only

Question 3

a) Two such jurisdictions where an objection will be raised ex officio during examination if there is a conflicting earlier trade mark on the register include USA and Japan. ✓1

b) A Spanish Trade mark application and French Trade mark application will publish even if there is a conflicting earlier trade mark on the register. ✓1

**MARKS AWARDED: 2/2**

2

Page sub-  
total

| Paper Ref  | Sheet          |
|------------|----------------|
| <b>FC5</b> | <b>4 of 28</b> |

Examiner's  
use only

#### Question 4

Conversion of an EU trade mark or EU trade mark application is the process where the EU trade mark or EU trade mark application is converted into separate national trade marks or trade mark applications in each member state of the European Union. The EU trade mark or trade mark application can only be converted into a national trade mark or trade mark application in nations where the ground for objection does not apply. For example, if there was an absolute ground of objection that was specific to the English language, then the EU trade mark application could be converted into all EU states in which English is not an official language (so every EU state except Ireland or Malta).

Conversion is available where the EU trade mark application is refused, withdrawn, or deemed to be withdrawn. The latter two include surrendering the EU trade mark.

As eluded to above, the EUIPO examine the EU trade mark application, and if absolute grounds of objection are raised that are applicable in only certain member states of the EU, then conversion is possible in the national member states where such objection will not apply.

Conversion has several benefits, but the most important is arguably that the filing date of the EU trade mark or EU trade mark application is retained.

Disadvantages of conversion are that a conversion fee is payable, and it becomes administratively more complex than the previous EU trade mark or trade mark application. For example through monitoring of renewal deadlines and having to appoint multiple professional representatives.

Page sub-  
total

| Paper Ref  | Sheet          |
|------------|----------------|
| <b>FC5</b> | <b>5 of 28</b> |

**Examiner's  
use only**

Conversion is not possible where the EU trade mark has been revoked on the grounds of non-use. <sup>✓1</sup> Under EU trade mark law, the trade mark is vulnerable to revocation if:

- it is not put to genuine use by the proprietor or with his consent in relation to the goods or services for which it is registered in the period of 5 years following registration, unless there is a genuine reason;
- such use is suspended for an uninterrupted period of 5 years and there is no genuine reason to non use;
- in consequence of acts of inactivity of the proprietor it has become common nature in trade for the goods/services to which it relates;
- liable to mislead the public as to the nature, quality, or geographical origin of the goods and services.

**MARKS AWARDED: 6/10**

6

**Page sub-  
total**

| Paper Ref  | Sheet          |
|------------|----------------|
| <b>FC5</b> | <b>6 of 28</b> |

Examiner's  
use only

### Question 5

Passing off is where the public are deceived as to the origin of certain goods and services.

Conventional passing off is where one party offers goods and services they had made themselves under the pretence that they are the goods and services from another's undertaking. For example, if I was to sell shoes that looked similar to Nike's, but that I had made myself in my garage. ✓1

Reverse passing off is where one party offers goods and services from another's undertaking under the pretence that they are their own goods and services. For example, if I was to purchase Nike's shoes, and then sell them as if I had manufactured them myself. ✓1

**MARKS AWARDED: 2/2**

2

Page sub-  
total

| Paper Ref  | Sheet          |
|------------|----------------|
| <b>FC5</b> | <b>7 of 28</b> |

Examiner's  
use only

### Question 6

a) Malta is a member state of the EU. Use of a mark in any of the member states of the EU is citeable in opposition proceedings. One of the relative grounds for opposition of an EU trade mark is that the later filed mark (EUTM) is identical and registered for identical goods and services to the Maltese trade mark. Mark is used in Malta for those goods and services, therefore can bring an opposition under the relative ground of double identity. It does not matter that Maltese mark is only spoken by a small amount of people. ✓1

b) One of the absolute grounds for refusal is that the mark consists exclusively of signs or indications used to designate the kind, quality, quantity, intended purpose, value, geographical origin or time of production of goods or rendering of services (i.e. the mark is descriptive). We are told the mark is descriptive in Maltese. However, it is not possible to bring a ground for opposition on absolute grounds under EU trade mark law. It is only possible to bring grounds for opposition on relative grounds under EU trade mark law. ✓1

c) It appears that Maltese law requires use in Malta of an element of the proposed EU trade mark without government approval. In this case, we are told that the EU trade mark is intended to be used solely in Denmark, Sweden, and Finland. Therefore the EU trade mark does not appear to be used in Malta, and no opposition can be brought on this ground. ✓1

**MARKS AWARDED: 3/4**

3

Page sub-  
total

| Paper Ref  | Sheet          |
|------------|----------------|
| <b>FC5</b> | <b>8 of 28</b> |

Examiner's  
use only

### Question 7

The requirements for a filing date are:

- request for the registration of a trade mark
- name and address of applicant
- statement of goods and services for which protection is sought; and
- representation of the trade mark.

These requirements have all been met on the 2 June 2024 by Marianne in the UK filing. Therefore the date of 2 June 2024 will be the filing date of the UK trade mark application.

We are then told that Marianne filed an EU trade mark application claiming priority from the UK application on 14 June 2024.

The requirements for claiming priority are that it must be made by the same applicant for same or narrower goods and services and be made within 6 months of the filing date of the earlier application. Also need to provide number of UK application; jurisdiction; date of filing; and certified copy of priority application (within 3 months). Assume these have been met when filing the EU trade mark application.

The EU trade mark application is not affected by the status of the UK application.

It merely served the purpose of a priority application. As the EU trade mark application appears to have successfully claimed priority to the UK application. ✓1

The fact the UK application is now deemed withdrawn has no effect on the EU trade mark application. ✓1

Page sub-  
total

| Paper Ref  | Sheet          |
|------------|----------------|
| <b>FC5</b> | <b>9 of 28</b> |

**Examiner's  
use only**

The payment of the filing fee (and declaration of intent to use mark for goods and services) are only required in order for UK applications to enter the examination phase.

**MARKS AWARDED: 2/4**

2

**Page sub-  
total**

| Paper Ref  | Sheet           |
|------------|-----------------|
| <b>FC5</b> | <b>10 of 28</b> |

Examiner's  
use only

Question 8

(a)

Any person can bring opposition proceedings on absolute grounds, and as such no use of a trade mark is necessary.

To bring opposition proceedings on relative grounds, use does need to be demonstrated. It must be demonstrated that the earlier mark (forming the basis of the opposition) has been put to genuine use by the proprietor or with his consent, for the mark and goods and services which are to be opposed, in the 5 years preceding the date on which the grounds and notice of opposition are filed.

0

(b)

To defend against revocation proceedings, it is necessary for the proprietor to:

- demonstrate genuine use of the trade mark in relation to the goods and services for which it is registered by the proprietor or with his consent, in the 5 years following registration of the trade mark; ✓1
- demonstrate such use has not been suspended for an uninterrupted period of 5 years; ✓1
- demonstrate that the mark as not, in consequence of acts or inactivity of the proprietor, become common nature in the trade for the good or service to which it relates;
- demonstrate that the mark is not liable to mislead the public as to the nature, quality, or geographical origin of the goods and services.

2

Page sub-  
total

| Paper Ref  | Sheet           |
|------------|-----------------|
| <b>FC5</b> | <b>11 of 28</b> |

Examiner's  
use only

(c)

To bring infringement proceedings, the earlier mark (forming the basis of the infringement action) must be demonstrated to have been put to genuine use in relation to the goods and services against which the infringement action is brought in the 5 years immediately preceding the date on which the infringement action is brought. ✓1

1

**MARKS AWARDED: 3/10**

3

Page sub-  
total

| Paper Ref  | Sheet           |
|------------|-----------------|
| <b>FC5</b> | <b>12 of 28</b> |

Examiner's  
use only

Question 9

In order to raise a successful defence of using one's own name, the person must  
be using their own name and address. Such use must be in accordance with  
honest practice and the use must be in good faith. ✓<sup>1/2</sup> ✓<sup>1</sup>

MARKS AWARDED: 1.5/2

1½

Page sub-  
total

| Paper Ref  | Sheet           |
|------------|-----------------|
| <b>FC5</b> | <b>13 of 28</b> |

Examiner's  
use only

## SECTION B

### Question 10

Firstly, to meet the requirements for registration, the mark must be:

- Capable of graphical representation – clear and precise <sup>✓½</sup>

This is met. The mark itself would be the shape of the box. “the shape of goods or of their packaging” qualify for trade mark protection. Graphical representation met as mark can be represented graphically as it has on page 5. <sup>✓½</sup>

- Capable of distinguishing goods and services from one undertaking from those of other undertakings.

We are told most fruit-juice producers sells juice in cuboid boxes. The new shape does appear to distinguish the goods and services from Organge plc from other undertakings. <sup>✓½</sup>

These first requirements appear to be met.

The next set of requirements are that the mark cannot:

- (a) Be devoid of distinctive character.

This does not appear to be the case. Rather, the mark itself would appear to be distinctive. Evidence suggests from social media that there have been nearly 2000 references to product worldwide, indicating distinctiveness.

Issue is – would the consumer consider the shape itself to be a mark? Arguably not, as they would be more used to seeing the branding itself – e.g. logo and the like, and attributing this to the goods and services. <sup>✓½</sup> Although shape of goods or

Page sub-  
total

| Paper Ref  | Sheet           |
|------------|-----------------|
| <b>FC5</b> | <b>14 of 28</b> |

Examiner's  
use only

packaging can be registered, it may meet greater objection and may even be refused by an examiner. ✓<sup>1/2</sup>

(b) Consist exclusively of signs or indications used to designate the kind, quality, quantity, value, intended purpose, geographical origin, or time of production of goods or services (descriptive).

The mark is not descriptive. I do not think this ground would be raised. The shape itself is not descriptive of orange juice. ✓<sup>1</sup>

(c) Consists exclusively of signs or indications which are common in the language or bona fide and established practices of trade.

We are told most producers sell juice in cuboid boxes. This is sold in irregular pentagon shaped boxes. Does not seem to be common in language or trade.

Unlikely to receive objection on this ground. ✓<sup>1</sup>

All of the objections (a)-(c) can be overcome if it can be shown that at the date of filing, the mark had acquired a distinctive character as a result of use made of it. ✓<sup>1/2</sup>

As per the Windsurfing case, such evidence of acquired distinctiveness includes market share, ✓<sup>1/2</sup> intensive use, ✓<sup>1/2</sup> geographically widespread, long standing use, amount invested, ✓<sup>1/2</sup> proportion of people identifying goods and services from this undertaking, ✓<sup>1/2</sup> and statements from trade of commerce. ✓<sup>1/2</sup>

Evidence including the 2000 references on social media to the product worldwide, recognising the unusual and eye-catching new box may help with demonstrating acquired distinctiveness.

These may be necessary if the examiner raises (a).

Page sub-  
total

| Paper Ref  | Sheet           |
|------------|-----------------|
| <b>FC5</b> | <b>15 of 28</b> |

Examiner's  
use only

The next set of objections are particularly relevant to this case:

- The mark solely consists of features of shape of other characteristics necessary to obtain a technical result.

Here, we are told that the irregular pentagon shape is chosen to pack together on pallets without leaving any gaps. Therefore, it does seem that the shape of the boxes are selected such that they achieve a technical result of packing in an efficient manner. I think it is very likely that this objection is raised. Possible argument that the mark does not solely consist of this feature, but is relatively weak.

- The mark solely consists of features of shape of other characteristics which are solely dictated by the nature of the goods themselves.

This objection will not apply. The goods are orange juices. These are liquids and can be stored in all sorts of receptacles.

- The mark solely consists of features of shape or other characteristic which impart substantial value to the goods.

I would also expect this objection to be raised. The shape of the packaging themselves has been chosen such that the dimensions enable tessellation while maximising differences in respective lengths. This tessellation pattern enables the efficient packaging. Therefore, more efficient packaging means that more boxes can be transported and sold – thus increasing the value of the goods.

For the first two objections, and the last three, demonstrating acquired distinctiveness will not overcome the objections.

Page sub-  
total

| Paper Ref  | Sheet           |
|------------|-----------------|
| <b>FC5</b> | <b>16 of 28</b> |

Examiner's  
use only

Other absolute grounds for refusal include:

- Contrary to public policy/accepted principles of morality ✓½
- Of such a nature as to deceive the public ✓½
- Prohibited by virtue of law
- Protected plant varieties
- Specialities guaranteed
- Protected emblems
- Made in bad faith ✓½

These will not apply in this case.

To summarise, I think that there may be difficulties in obtaining a trade mark registration. The first issue is that the perception of a shape of a box as a trade mark may be tricky to prove, as the public may not perceive the box to be a trade mark. That said, demonstrating acquired distinctiveness could overcome this objection. The more pressing objections will be:

- The mark solely consists of features of shape of other characteristics necessary to obtain a technical result; and
- The mark solely consists of features of shape or other characteristic which impart substantial value to the goods.

Demonstrating acquired distinctiveness will not be able to overcome these two objections.

Therefore, the five sided box, and five sided box with two parallel sides will be unlikely to be protected by UK trade marks.

**MARKS AWARDED: 12/20**

12

Page sub-  
total

| Paper Ref  | Sheet           |
|------------|-----------------|
| <b>FC5</b> | <b>17 of 28</b> |

Examiner's  
use only

Question 11

### Timeframe for Opposition

The Optico mark was published 1 September 2024. It is possible to file an opposition including grounds by the 1 November 2024, or alternatively file notice of intention to oppose by 1 November 2024 and the grounds by 1 December 2024.

Alamode mark was filed 1 May 2020. This is before the filing date of the Optico mark. Need to demonstrate use of Alamode mark for goods in class (9) to form the basis of a successful opposition. 0

Erf – 0

### Grounds for Opposition

The two marks are similar, and are registered for similar goods that fall in the same class of goods.

To form the basis of a successful opposition, it will be necessary to demonstrate that there would be a likelihood of confusion on behalf of the public, including the likelihood of association, between the marks and services.

### Similarity of marks

In assessing likelihood of confusion, as per the Sabel v Puma case, we are taught to assess visual, aural, and conceptual similarities and differences between the two marks themselves.

Visual similarities

- Looking at the words, Alamode mark has 2 lines of text whereas Optico has 3 lines of text ✓1

Page sub-  
total

| Paper Ref  | Sheet           |
|------------|-----------------|
| <b>FC5</b> | <b>18 of 28</b> |

Examiner's  
use only

- LUNETTES vs LUNE ET share the first 4 letters at the start of the word.  
This is where the focus of the consumer would be.
- Separation of \_ET and additional E in LUNE ET, but this is in the middle of the word and consumer's attention would not be drawn to this section of the word. ✓1
- Additional S in LUNETTES vs LUNE ET but this is at the end of the word and consumer's attention would not be drawn to this – focus more on the start of the word.
- DE and CIE are different
- PARIS identical in both cases
- Single large star in Alamode mark vs crescent moon and two stars in Optico mark. Both relate to space related items so do share similarity here.
- Overall, I think there is a medium visual similarity between the two marks.

#### Aural Similarities

- Alamode mark has 5 syllables; Optico mark has 5 syllables. 4 of these are shared, 1 is different. ✓1 The singular different syllable is in the middle of the mark and may be overlooked, although there is a difference in sound between the “DE” and “CIE” in a hard D sound vs a softer C sound. ✓1
- Overall, I think there is a medium-high aural similarity between the two marks.

Page sub-  
total

| Paper Ref  | Sheet           |
|------------|-----------------|
| <b>FC5</b> | <b>19 of 28</b> |

Examiner's  
use only

### Conceptual Similarities

- We are told that LUNETTE DE PARIS means "Spectacles of Paris" and LUNE ET CIE Paris means "Moon and Co" Paris. Paris merely indicates where the brand is based, but is identical. "Spectacles of" and "Moon and Co" have no conceptual similarities. We are told that the average Briton would not know what these French words mean.
- Overall, I think there is a low conceptual similarity between the two marks. We do need to consider that the British consumer would not place much weighting on the conceptual similarity however.

Consider visual, aural and conceptual similarities, I think there is a medium degree of similarities between the two marks.

### Similarity of Goods and Services

Next, as per Canon v Metro, we are told that when assessing the likelihood of confusion, we must also consider the similarities of the goods and services.

In assessing the similarities of the goods and services we must consider:

- Nature

Alamode goods and services are spectacle frames of plastic or metal, whereas Optico goods and services are optical lenses for cameras.

The nature of the two are different.

- Purpose

SOM – 7

Page sub-  
total

| Paper Ref  | Sheet           |
|------------|-----------------|
| <b>FC5</b> | <b>20 of 28</b> |

Examiner's  
use only

Alamode spectacle frames are aimed at children and used to help a person see better, whereas Optico's camera lenses are used by photographers. ✓½

Therefore, purpose is different.

- Method of Use

Alamode spectacles worn by user on eyes, whereas Optico's camera lenses used in cameras.

Therefore, method of use is different.

✓½

- Channels of distribution/trade

Alamode spectacle lenses are sourced from specialist suppliers and not from frame manufacturers, and we are not told where Optico source their lenses from. Apparently non-prescription sunglasses lenses are not sourced from specialist suppliers. There could be overlap with Optico source for sunglasses lenses, but not for frame itself.

Alamode is sold through single chain of UK high street opticians with stores in most towns in UK, whereas Optico sold exclusively by mail order. These are very different.

✓½

Therefore, channels of distribution are different.

- The average consumer

Alamode spectacles will be worn by children, although they will be likely purchased by their parents/adults.

✓ AC ½

Optico consumer is a professional photographer. These take a high degree of care in products.

Page sub-  
total

| Paper Ref  | Sheet           |
|------------|-----------------|
| <b>FC5</b> | <b>21 of 28</b> |

Examiner's  
use only

An adult purchaser of the spectacles could be a professional photographer, but unlikely/low chance.

Therefore, the two average consumers are different. ✓½

- Complimentary

Whilst lenses are complimentary to spectacle frames, camera lenses are different to spectacle lenses.

Therefore, they are not complimentary products. ✓½

- In competition

No they are not. A person in need of spectacle frames would not choose to purchase a camera lense instead. ✓½

Overall, low degree of similarity of goods and services. ✓½

SOG – 4

### Likelihood of confusion

Lloyd taught us that a similarity between goods and services can offset differences in the marks, and vice versa.

Evidence of likelihood of confusion could be submitted – e.g. surveys of the public.

Here however, I think the likelihood of confusion is relatively low due to the differences in goods and services. ✓1

AC – ½

LOC – 1

### Conclusion

Despite the medium similarities between the two marks, I do not think this is sufficient to overcome the significant differences in the goods and services.

Page sub-  
total

| Paper Ref  | Sheet           |
|------------|-----------------|
| <b>FC5</b> | <b>22 of 28</b> |

Examiner's  
use only

Therefore any opposition in my opinion would likely be unsuccessful, although it can certainly be argued either way. ✓1

**MARKS AWARDED: 13.5/20**

13½

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Page sub-  
total

| Paper Ref  | Sheet           |
|------------|-----------------|
| <b>FC5</b> | <b>23 of 28</b> |

**Examiner's  
use only**

Question 13

(a)

In both schemes:

- (1) It is possible to claim priority in respect of the same mark for identical/narrower goods and services in 6 months following the priority filing (not possible to claim priority to the UK mark);
- (2) For an EU trade mark, seniority can be claimed in respect of an earlier mark in a member state where the EU trade mark is the same mark and registered for the same or narrower goods or services. Has sole effect that when surrendered the proprietor has the same rights available to him as if mark in that country had continued to be registered.
- (3) South Africa cannot be designated by the Madrid Protocol.
- (4) Where filing a Madrid Protocol application, need to file basic application using French intellectual property office (as this is where Savonco SA must file at they have a real and effective place of business at which substantial business activity is carried out at in France).

**Page sub-  
total**

| Paper Ref  | Sheet           |
|------------|-----------------|
| <b>FC5</b> | <b>24 of 28</b> |

Examiner's  
use only

### Scheme 1

File an EU trade mark application for trade mark BONJOUR for SOAP: ✓<sub>1</sub>

| Jurisdiction | Goods | Actions                                                                                    |
|--------------|-------|--------------------------------------------------------------------------------------------|
| France       | Soap  | Claim seniority in respect of the earlier French mark (back to 1 July 2015) ✓ <sub>1</sub> |
| Italy        | Soap  | Claim seniority in respect of the earlier Italian mark (back to 1 December 2020)           |

File a Madrid Protocol application for trade mark BONJOUR for class 3 goods soap, toothpaste. Need to file basic application using French intellectual property office. Make a claim to priority of either German trade mark filing date of 1 June 2024 or Chinese trade mark filing date of 1 June 2024 (as we are within 6 months from filing these application). Would need to designate Germany, China in the Madrid Protocol Application.

| Jurisdiction | Goods | Actions |
|--------------|-------|---------|
|              |       |         |

Page sub-  
total

| Paper Ref  | Sheet           |
|------------|-----------------|
| <b>FC5</b> | <b>25 of 28</b> |

Examiner's  
use only

|                                       |                  |                                                                                            |
|---------------------------------------|------------------|--------------------------------------------------------------------------------------------|
| Germany ✓ <sup>1</sup> / <sub>2</sub> | Soap, toothpaste | File basic application at French IPO and claim priority on German trade mark filing date.  |
| China                                 | Soap, toothpaste | File basic application as French IPO and claim priority on Chinese trade mark filing date. |

Continue with prosecution of UK trade mark BONJOUR for SOAP and South Africa trade mark BONJOUR for SOAP. South Africa cannot be designated in Madrid Protocol. ✓<sup>1</sup>/<sub>2</sub>

Continue with prosecution of US trade mark BONJOUR for NON-MEDICATED BAR SOAP. This is narrower than SOAP, but is not registered for toothpaste. Will need to give precise description of this mark, and file intentions and declarations to use this mark. Better to keep this separate. ✓<sup>1</sup>/<sub>2</sub>

|              |      |                                                        |
|--------------|------|--------------------------------------------------------|
| UK           | Soap | Continue with UK trade mark BONJOUR for soap           |
| South Africa | Soap | Continue with South Africa Trade mark BONJOUR for soap |

Page sub-  
total

| Paper Ref  | Sheet           |
|------------|-----------------|
| <b>FC5</b> | <b>26 of 28</b> |

Examiner's  
use only

|     |                        |                                                                                   |
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| USA | Non-medicated bar soap | Continue with US trade mark application<br><br>BONJOUR for non-medicated bar soap |
|-----|------------------------|-----------------------------------------------------------------------------------|

8

### Scheme 2

File a Madrid Protocol application by filing basic application at French IPO, <sup>✓½</sup>  
claiming priority on Chinese trade mark.

| Jurisdiction                                                           | Goods              | Actions                                                                                                           |
|------------------------------------------------------------------------|--------------------|-------------------------------------------------------------------------------------------------------------------|
| European trade mark<br>(covering France, Italy, Germany) <sup>✓½</sup> | SOAP <sup>✓½</sup> | Designate the EU; claim seniority on French, Italian and German trade marks to retain filing dates. <sup>✓½</sup> |
| China <sup>✓½</sup>                                                    | SOAP               | Designate China; claim priority on the Chinese trade mark for SOAP                                                |

|         |                     |                                                        |
|---------|---------------------|--------------------------------------------------------|
| Germany | Limit to Toothpaste | Continue with German Trade mark BONJOUR for toothpaste |
|---------|---------------------|--------------------------------------------------------|

Page sub-  
total

| Paper Ref  | Sheet           |
|------------|-----------------|
| <b>FC5</b> | <b>27 of 28</b> |

Examiner's  
use only

|       |                     |                                                         |
|-------|---------------------|---------------------------------------------------------|
| China | Limit to Toothpaste | Continue with Chinese trade mark BONJOUR for toothpaste |
|-------|---------------------|---------------------------------------------------------|

We are told toothpaste is included for defensive purposes, so can easily drop these marks if required.

Continue with prosecution of UK trade mark BONJOUR for SOAP and South Africa trade mark BONJOUR for SOAP. South Africa cannot be designated in Madrid Protocol. ✓½

Continue with prosecution of US trade mark BONJOUR for NON-MEDICATED BAR SOAP. This is narrower than SOAP, but is not registered for toothpaste. Will need to give precise description of this mark, and file intentions and declarations to use this mark. Better to keep this separate. ✓½

|              |                        |                                                                            |
|--------------|------------------------|----------------------------------------------------------------------------|
| UK           | Soap                   | Continue with UK trade mark BONJOUR for soap                               |
| South Africa | Soap                   | Continue with South Africa Trade mark BONJOUR for soap                     |
| USA          | Non-medicated bar soap | Continue with US trade mark application BONJOUR for non-medicated bar soap |

4

Page sub-  
total

| Paper Ref  | Sheet           |
|------------|-----------------|
| <b>FC5</b> | <b>28 of 28</b> |

Examiner's  
use only

b)

Scheme 1 may be preferable because:

- The EU trade mark would not be vulnerable to central attack on the basic registration. A successful attack on the basic application would result in transformation being necessary. Scheme 1 preserves the filing date of BONJOUR in France and Italy but does not let these become vulnerable to central attack. Can avoid costs associated with separate national applications then (renewals, appointing local professional representatives etc). ✓ $\frac{1}{2}$
- The disadvantage over scheme 2 are that the renewal fees will be split over different dates, as renewal fees due at the EUIPO will be due at the end of the month rather than on the anniversary of 10 years from filing date (as required by Madrid Protocol). Allow ✓1

**MARKS AWARDED: 13.5/20**

13½

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