

Examiner's Report 2024

FC5 – Trade Mark Law

Introduction

This paper retained the format used in previous years, with a set of short questions designed to demonstrate learning across the syllabus (generally one question for each area of the syllabus) plus four more complicated scenarios to analyse. As has been common, the latter included one scenario relating to absolute grounds, one relating to relative grounds, and a passing-off question. Candidates overall did moderately well, with a mean mark of 58% (somewhat down from last year) and a top mark of 86% (on a par with last year). Again, it appeared that a significant number of candidates were not ready for the examination and scored in the 25%-45% range.

One of the reasons why the mean mark was down this year was that the "relative grounds" question was answered significantly less well than usual. See the comments on Question 11 below. Recall of the detail of statutory provisions was also weaker than in previous years.

Questions

Part A

Question number	Comments on questions
Question 1	This question drilled into the precise requirements for the protection of Well Known Marks. There was a large spread of marks awarded.
Question 2	This was a simple question about calculating renewal dates. Most candidates scored full marks; however, it appeared that some candidates had not sufficiently prepared.
Question 3	This was a simple question on comparative legal systems. It caused few problems for many, but not all, candidates.
Question 4	This question was worth 10 marks and required recall of the provisions of the EUTMR on conversion. Most candidates were able to state most of the important provisions, but some candidates gave only a cursory description of the criteria.
Question 5	This was a straightforward question about an aspect of passing off law. Most candidates achieved full marks.
Question 6	This question concerned the grounds on which EUTMs can face opposition. Parts (a) and (b) required the recall of basic EU trade mark law, but there was nevertheless a disappointing number of incorrect answers. Part (c) was trickier, and required a good attention to detail regarding EU law.
Question 7	This was a difficult question on priority, albeit with most marks being available for showing one's working towards the answer rather than the final result. Most candidates did reasonably well.
Question 8	This question was worth 10 marks and required recall of the precise time periods for which "use" needs to be proven in various proceedings. The marks achieved were really disappointing given the importance of this area to trade mark practice. Time periods are a key part of the syllabus, and questions require both the time period and the date from which the period is counted to be recalled accurately.

Examiner's Report 2024

FC5 – Trade Mark Law

Question 9	This was simple question requiring the provisions of a defence to be recalled. For full marks candidates needed to be crystal clear that the name needed to be that of an individual rather than other types of legal "person", with many candidates dropping points for inaccuracy (or perhaps having learnt from an old textbook or unamended version of the Trade Marks Act).
-------------------	--

Part B

Question number	Comments on question
Question 10	Every candidate attempted this year's "absolute grounds" question which required the usual task of running through ss1 and 3 of the Trade Marks Act, including the Sieckmann criteria. It was reasonably well answered. The main weaknesses in answers are those which are evident every year: • The is still quite widespread mixing-up of the concepts of "capability" of a mark to distinguish (s1 TMA), and whether a mark enjoys "distinctive character" *(s3 TMA). • Provisions on shape marks that give "value" really only relate to shapes of high aesthetic merit, and not technical benefit or mere attractive design. • Candidates often state that acquired distinctiveness is available, when in fact the evidence of use and recognition is weak.
Question 12	This year's "relative grounds" question was tackled by all but one candidate. The standard of scripts was somewhat down this year, with many candidates failing to compare the goods as listed on the register. Rather, they looked into irrelevant matters such as the market segments and distribution channels targeted by the respective parties. Candidates generally did give assessment of the overall strength of the similarities of the marks and goods (i.e. weak, medium or strong), and so achieved the marks available for doing so. In the mark scheme, the analysis of the "average consumer" is shown near the beginning (rather than before the LOC analysis). Identifying the average consumer <i>before</i> the similarity-of-goods analysis is logical so that: • The commonality of customers can be considered as part of the SOG analysis; and • The attentiveness of customers can be considered as part of the LOC analysis.
Question 13	This was a passing-off question, which overall was not well answered. Most of the focus of the mark scheme is on the topic of "goodwill" and potential problems in establishing its existence. Here, the (lack of) evidence of goodwill in the UK was the main factor that needed to be explored. Marks were most commonly lost by dealing with Jules' position as an afterthought, or even treating "Kandy and Jules" as a single entity. Jules' position needed a full, separate, analysis. (In questions with two potential claimants, it is very likely that there is a fundamental difference in their individual circumstances that needs to be fully explored.)

Examiner's Report 2024
FC5 – Trade Mark Law

Question 14	This question required candidates to apply the panoply of portfolio management options (Madrid Protocol, EUTMs, priority, seniority, replacement) to the scenario. There were plenty of points that could be considered, and most candidates who answered this question did quite well. However, a number of candidates did not follow the instructions requiring the use of both the EU Trade Mark and Madrid Protocol systems, presenting schemes that used only one or the other. The use of tables was appreciated, as it made the proposed solutions clear. Recall of the qualification requirements for determining an “office of origin” was surprisingly weak, as was the application of the rules on priority.
--------------------	--