

Foundation Certificate

FC5 Trade Mark Law

Wednesday 22 October 2025

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 pre-set 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 **8 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

Eddie, a British national who lives and works in the UK, manufactures garden ornaments under the brand GRANDEE, but holds no trade mark registrations.

Eddie's brand has, in the last three years, become very well known in UK design circles. However, he has become alarmed at a recent attempt to register an EU trade mark for an identical name, for garden ornaments.

Explain whether Eddie can use Article 6bis (*Well Known Marks*) of the Paris Convention to oppose this EU trade mark application.

2 marks

Question 2

Shula is a British national. Under what circumstance can she use the Madrid Protocol with an EU Trade Mark serving as the basic registration?

3 marks

Question 3

- a) Describe i) when and ii) to whom a Form MM18 (E) *Declaration of Intention to Use the Mark* must be submitted when seeking trade mark protection designating the USA via the Madrid Protocol.

2 marks

- b) Describe i) when and ii) to whom a Section 71 *Declaration of Use and/or Excusable Nonuse* must be submitted to maintain a Madrid Protocol trade mark designation for the USA.

5 marks

- c) Describe any additional information that must be submitted with either Form MM18E or a Section 71 Declaration.

3 marks

Total: 10 marks

Question 4

Set out the time limits (including the dates from which these are measured) for applying to convert an EU trade mark application or EU trade mark into national applications.

6 marks

Question 5

Your client is looking to initiate invalidity proceedings against an EU trade mark that was filed and registered in 2024.

Discuss the feasibility of the following proposals:

- a) To rely upon a UK trade mark that became fully registered in July 2020 as an 'earlier mark'. The trade mark has been in continuous use in the UK since its registration date.

1 mark

- b) To rely upon an EU trade mark that also became fully registered in July 2020 as an 'earlier mark'. The trade mark has been in continuous use in the UK since its registration date, but no evidence of use in another EU Member State is available.

3 marks

Total: 4 marks

Question 6

Set out the circumstances in which an application for a UK trade mark can be amended or restricted.

6 marks

Question 7

On 1 September 2012, David applied for a UK trade mark FIELDDBROOK, for apples, but it lapsed in 2022.

On 1 December 2024, David filed a fresh UK application for FIELDDBROOK, for apples and pears. He now wishes to apply for an EU trade mark.

Explain what priority date(s) (if any) David can claim.

3 marks

Question 8

Jennifer, owner of UK trade mark 42424242, has recently died. In her will, she appoints Usha as personal representative of her estate, with Adam as her sole beneficiary.

- a) Explain what documents need to be executed to fulfil the requirements of the *Trade Marks Act*, in order to allow Adam to become the new owner of the mark. (Do not discuss general probate documents not mentioned in the *Trade Marks Act*.)

2 marks

- b) Set out any statutory deadline under the *Trade Marks Act* for the filing of these documents with the UKIPO, and the consequences of not meeting the deadline(s).

2 marks

Total: 4 marks

Question 9

Under what circumstances may a court order a defendant to destroy their infringing goods?

2 marks

Total for SECTION A: 40 marks

SECTION B

Question 10

- a) 'Molly Malone' (also called 'In Dublin's Fair City') is a well-known song in the UK, recounting the life and death of an impoverished Irish fishmonger.

Your client, Twinkle Winkles plc, sells frozen shellfish throughout the UK. It plans to use the song 'Molly Malone', both with and without lyrics, in its TV and online adverts. Twinkle Winkles also occasionally sets up wheel-barrow-shaped promotional stands within supermarkets, and is planning to play 'Molly Malone' from speakers under the stands.

The sales director of Twinkle Winkles, Ruairi, has asked you to register the song 'Molly Malone' as a trade mark.

Twinkle Winkles currently sells mussels, winkles and clams, but wants protection for all edible sea molluscs and other similar seafood, as it can foresee having to harvest new species as sea temperatures rise in the coming years.

Advise Twinkle Winkles whether registration of the song, both with and without lyrics, is possible. Only address absolute grounds.

13 marks

- b) Ruairi says he is a little concerned. 'Molly Malone's chorus repeats the phrase '*Cockles and mussels, alive-alive-o*'. However, Twinkle Winkles presently does not sell cockles, nor does it sell live shellfish: rather its shellfish are killed during the flash-freezing process within minutes of being landed on the trawler.

Could this represent a problem for the proposed registration?

2 marks

- c) Ruairi is also concerned at a campaign being organised by a pressure group, No Hate in Ads. The group engages in civil disobedience and legal action to prevent advertisers using songs it does not approve of. No Hate in Ads has previously issued a press statement denouncing 'Molly Malone' as '*unacceptable*', as it '*perpetuates the sexualisation of exploited working poor under colonial rule*'.

Could this represent a problem for the proposed registration?

2 marks

- d) 'Molly Malone' comes from a genre of song called 'Music Hall' (or 'Vaudeville'). Music Hall was a popular form of entertainment before the advent of cinema; an aspect of which involved entertainers encouraging their audiences to sing along with them to catchy songs. 'Molly Malone' has been recorded many hundreds of times since.

Could this represent a problem for the proposed registration?

3 marks

Total: 20 marks

Question 11

Your client Phil is a craftsman specialising in glass blowing and glass cutting. He makes very expensive water and wine glasses, decanters and vases, which he sells through boutique homeware stores throughout Europe.

Phil has applied to register the following UK trade mark:

Mark	Priority	Filing Date	Goods
SILVERY GRACE	EU Trade Mark 40302010 dated 1 June 2025	1 September 2025	Glassware (Nice class 21)

The trade mark has been examined, and the examiner has cited the following registration, owned by Grace & Co (Cutlers) Ltd:

Mark	Priority	Filing Date	Goods
GRACE'S SILVER		1 April 2020	Cutlery (Nice class 8)

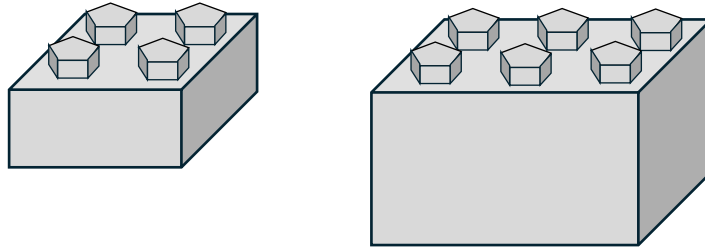
Phil understands that Grace & Co has been selling cheap mass-produced cutlery sets (i.e. of knives, forks and spoons), exclusively through 'Pound stores' - stores catering to budget shoppers, which charge a fixed £1 per item.

Advise Phil whether his application is vulnerable to opposition. Only discuss relative grounds. Do not discuss passing off or 'marks with a reputation'.

20 marks

Question 12

Jack manufactures interlocking toy bricks, selling them under the name PEGGIO. PEGGIO bricks are comprised with an array of pentagonal 'pegs', which engage with holes on the undersides of corresponding bricks in order that the bricks bind together. Examples of two bricks are illustrated here:



Jack explains that the PEGGIO bricks have been a huge commercial success in the USA. To date, UK buyers have had to order sets of bricks online from American sellers, but Jack has just signed a distribution deal with the UK's largest toy retailer, Play-With-Us plc, which will start selling PEGGIO bricks next month. Play-With-Us has been running a major TV and online advertising campaign 'counting down the days' until PEGGIO bricks will be available in its shops. The adverts tell customers to look out for the 'unique' pentagonal pegs, and promise that the bricks bind more tightly together than the market-leading bricks, allowing taller structures to be built, and wider spaces to be spanned.

However, Jack has discovered that a rival manufacturer, Duplico Ltd, has recently started manufacturing bricks with pentagonal pegs, and is distributing them for sale through independent toy stores. He believes Duplico has moved quickly to design, manufacture and distribute its bricks as soon as adverts for PEGGIO bricks started airing. Jack is also upset that DUPLICO bricks use cheap virgin plastic rather than recycled plastic, and so will have a lower retail price than PEGGIO bricks.

Advise Jack whether Duplico Ltd can be held liable for passing off. Do not discuss any other intellectual property right.

17 marks

Suggest the remedies that would be appropriate in a case such as this.

3 marks

Total: 20 marks

Question 13

You act for Farmbridge, a tractor manufacturer. When making its tractor seats, Farmbridge uses a forming machine made by Acme Inc. of the USA. A vital component of the machine, the jigger, will soon need replacing; however, no spares have been available in the UK for over a year. Original Acme Inc. jiggers are made of brass, with Acme's UK registered trade mark ACME stamped into them.

a) Satya, Farmbridge's production engineer, proposes a number of solutions:

- i) Import a jigger from Switzerland.
- ii) Import a jigger from the United States.
- iii) Laser-scan Farmbridge's current jigger, and use a 3-D printing machine to reproduce it exactly – noting that the ACME stamp will also be reproduced.
- iv) Refurbish a worn-out jigger sourced from the UK, noting that the stamp will remain on the product.

Advise Satya whether any of these options infringes the *Trade Marks Act*.

4 marks

b) Satya realises that other UK users of Acme's forming machine will also need replacement jiggers, and sees an opportunity for Farmbridge to sell these.

Advise Satya whether importing/reproducing/refurbishing 100 jiggers (as described in parts i) to iv) above) and selling them to UK users, infringes the *Trade Marks Act*.

10 marks

c) Satya believes that, as an alternative, Farmbridge can manufacture replacement jiggers from scratch using its CNC lathe, although the quality will not be as good as the original. Acme's stamp will not be reproduced, but Farmbridge would market these to other UK users of Acme forming machines using the statement:

ACME replacement parts, made by Farmbridge Ltd

Advise Satya on the suitability of this wording and, if necessary, suggest any improvements that could be made, giving reasons for your answer.

4 marks

d) Satya has just become aware of an existing trade mark for FARMBRIDGE protecting '*components for mechanical apparatus, including jiggers, gizmos and widgets*'. The mark is owned by Neil Farmbridge, of no relation to Farmbridge Ltd. Satya is concerned that Farmbridge Ltd will not be able to mark the CNC-made jiggers, or its packaging, with the FARMBRIDGE name.

Assuming the mark is valid and in use, advise Satya about this marking issue.

2 marks

Total: 20 marks