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FC5	1 of 21	66%

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Question 1

The mark is well known in the UK, and therefore Eddie may have been able to prevent a trademark registration in the UK under Article 6bis.

However, an EU trademark does not cover the UK, and therefore Eddie's brand "GRANDEE" must be well known in the EU in order to oppose the registration of an EU trademark.

Since "GRANDEE" is not well known in the EU, it cannot be used to oppose the trademark. ✓1

✓1

2

MARKS AWARDED: 2/2

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Question 2

Shula must file her Madrid protocol application at her designated office of origin.

As she is a British national, she can file an application at the UKIPO using a UK trademark application/registration as the basic application/registration.

She could, however, use the EUIPO as the office of origin and the EU trademark as the basic registration if: she is either a) domiciled in the EU; or b) has a real and effective industrial or commercial establishment in the EU.

✓1

✓1

✓1

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Question 3

- a)
- i) At the time of filing the Madrid protocol application ✓½
- ii) The form MM18 is submitted when filing the Madrid protocol application, and therefore the form is submitted to the office of origin, who then forwards the application documents to the International Bureau/WIPO. ✓½
- b)
- i) A Declaration of Use and/or Excusable Nonuse is filed as an affidavit at various points during the lifetime of a US trademark registration. A first affidavit must be filed between the fifth and sixth anniversaries of the registration of the US trademark. ✓½
A second affidavit must be filed in the year preceding the 10th anniversary of the registration. ✓1
Subsequent affidavits must be filed in the year preceding every following 10th anniversary (i.e. in the year preceding the 20th, 30th, 40th etc. anniversaries). ✓1
- ii) The affidavits must be submitted to the US Patent and Trademark Office. ✓1
- c) For the section 71 declaration: ✓1
- Specimens showing evidence of use (i.e. labels, packaging, webpage printouts) ✓½
 - Pay the fee
 - A statement that the mark is in use

1

5

1½

7½

MARKS AWARDED: 7.5/10

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Question 4

EU trademark applications or EU trademarks can be converted into national trademark applications in selected member states to the extent that they are withdrawn, ^{✓ ½} deemed to be withdrawn, ^{✓ ½} refused or otherwise ^{✓ ½} cease to have effect.

The deadline for doing so is 3 months ^{✓ 1} from the date of withdrawal/refusal/cessation of the EU trademark application or registration. ^{✓ ½}

The EU trademark application/registration cannot be converted in countries where there exist grounds for refusal.

3

MARKS AWARDED: 3/6

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Question 5

a) UK trademarks cannot be used to invalidate EU trademarks that have been filed and registered after Brexit occurred (i.e. exit day - from 1 January 2021). Therefore, the UK trademark cannot be used as an earlier mark for invalidity proceedings. ✓1

1

b)

- For EUTMs that were registered prior to Brexit, use in the UK only counts for the period between registration of the mark and the exit day (up to 31 December 2020). ✓1
- Therefore, use of the EUTM in the UK only counts as use in the 6-month period of July to December 2020. No subsequent use in the UK counts as genuine use of the EUTM. ✓1
- Consequently, from 1 January 2026 it will be as if there has been no genuine use of the EUTM in the 5 year preceding period, and it will be susceptible to revocation in the EU (although the UK trademark will be fine, since it split off from the EUTM on exit day). ✓1
- As such, if invalidity proceedings are to be brought, it should be done before 1 January 2026.

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Question 6

- A person may decide to amend the application after receipt of a search report detailing some particularly pertinent prior art. Said person may decide to restrict the goods/services claimed so as to fall outside of the scope of protection of the earlier application/registration. ✓1
- The applicant may also decide to amend the application to include a disclaimer/limitation/statement. This is to satisfy the Examiner that the applicant is not claiming certain subject-matter. ✓1
- One may also request for changes and/or corrections in details present in the application, such as: The name and/or address of the applicant; the personal representative; errors in translation. ✓1
- In very few circumstances is it possible to amend the representation of the sign of a trademark application.

3

MARKS AWARDED: 3/6

3

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Question 7

For the EU trademark application, David cannot claim priority to either of the earlier applications.

The deadline for claiming priority under the Paris Convention is 6 months^{✓1} from the filing date of the earliest disclosure of that matter.

The first application for FIELDBROOK, for apples, was filed more than 10 years ago, far exceeding the allowable period for claiming priority. The deadline for claiming priority was 1 March 2013.^{✓1}

The second application, containing the first disclosure of FIELDBROOK for pears, was also filed more than 6 months ago. The deadline for claiming priority was 1 June 2025.^{✓1}

3

MARKS AWARDED: 3/3

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Question 8

a)

For a transaction to be effective, it must be signed by the assignor.

Since Usha is the personal representative, and acting on Jennifer's behalf, she must provide her signatures on the official forms filed at the UKIPO for registering the transaction. ✓1

If she does not provide her signature on the official form, then evidence of the transaction will need to be submitted alongside the official form in order for the transaction to be effective.

1

b)

If an infringement of the trademark occurs before the transaction is registered with the UKIPO then costs or expenses will not be awarded in infringement proceedings unless: a) it was registered within 6 months of the transaction having occurred; or if later b) as soon as practicable thereafter. ✓1 ✓1

Furthermore, until the transaction is registered at the UKIPO it is ineffective against later transactions leading to conflicting rights with the earlier transaction.

2

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Question 9

The court may order the destruction of infringing goods in infringement proceedings where it is likely that they will be utilised to commit further acts of infringement.

0

MARKS AWARDED: 0/2

0

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Question 10

a) Going through each section relating to absolute grounds in the UKTMA:

Section 1(1)/Section 3(1)(a)

- In order to be registrable as a trademark, the sign must enable the registrar to determine the clear and precise nature^{✓1} of the protection afforded to the proprietor (i.e. it must meet the Sieckmann criteria). It would appear to do so in this case. ✓½
- Objection - It must also be capable of distinguishing the goods/services of one undertaking from those of another. This is likely not possible, since the well-known nature of the song means that it is not likely to be associated with the undertaking but rather with the artist who made the song. This is true both with and without lyrics.

Section 3(1)(b) – devoid of distinctive character?

- Objection - since the song is well known in the UK, upon hearing the song the average person would not regard it as trademark significance^{✓1}. This is true for both with and without lyrics.

Section 3(1)(c) – descriptive?

- No objection - the mark is not descriptive since the goods and services do not relate to the life and death of impoverished Irish fishmonger. ✓1

Section 3(1)(d) – Customary in the current language/trade?

- Objection – this objection would likely only apply to the version of the song with lyrics.

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- The average person is probably familiar with some lines from the song, and therefore these lines are customary in the current language.

Acquired distinctiveness

- Could be used to overcome the objections to sections 3(1)(b) and (c) for the version without lyrics, and sections 3(1)(b), (c) and (d) for the version with lyrics.
- However, there is no evidence of acquired distinctiveness, particularly since the mark has not been used yet. ✓1

4½

Sections 3(2)(a) – (c): Shapes or other characteristics

- No objection - None of the characteristics of the song result from the nature of the goods, are necessary to achieve a technical result or give substantial value to the goods. This is true either with or without lyrics. ✓½

Section 3(3) – Contrary to public policy/morality, or likely to deceive?

- Objection - The song may deceive the public into thinking that the goods/services offered are sold by or approved by the artist that created the song 'Molly Malone'. This is true either with or without lyrics.

Section 3(4) – Contrary to law

- Objection - The song is protected by copyright law. This is true either with or without lyrics.

Allow
below

Section 3(6) – Bad faith

- Objection - the registration of the mark would take advantage of the reputation that it enjoys with the general public.

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- Could also potentially damage the image of the song, since it would then be associated with seafood.
- This is true either with or without lyrics.

Conclusion

- Registration would not be possible for the song either with or without the lyrics. ✓½

b)

This would lead to a further ground of refusal under section 3(3) for the version of the song with lyrics, since the song would be deceiving the public into thinking Twinkle Winkles sells live cockles and mussels. ✓1

c)

This could potentially be a further objection under section 3(3), since it would be contrary to accepted principles of morality to perpetuate the sexualisation of exploited working poor under colonial rule. ✓1

d)

This fact suggests it would be difficult for the version of the song with lyrics to overcome the objections under sections 3(1)(b), (c) and (d) with acquired distinctiveness. The use of the song would be difficult to associate with a specific undertaking, since it has been recorded so many times.

✓1 mark
(carried over)

MARKS AWARDED: 8.5/20

8½

1
TOTAL –
5½

3

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Question 11

Enforceability of the earlier mark

In order to be an earlier mark to be valid for opposition purposes, the mark must have been utilised in the five years post-registration, or alternatively have been registered for less than 5 years before the filing/priority date of the subsequent application.

Since the earlier mark was filed on 1 April 2020, it can be assumed that it was registered some time after 1 June 2020. Therefore, the priority date of Phil's mark is less than 5 years after the registration of the earlier mark, and as such it does not need to meet the use requirements. Regardless, it would appear that the use requirements have been met by selling of the mass-produced cutlery sets. ✓1

1

Average consumer

The average consumer would for both goods be the average person. ✓1

When selecting glassware and cutlery the average consumer is typically not that picky/careful, since you can only go so wrong with glassware and cutlery. ✓1

However, for boutique glassware a person is likely to be far more observant than for cheap cutlery.

2

Similarity of the marks

Aural similarity

Both marks are word combinations having two words. Both words are present in both marks (i.e. they use the same words). ✓1

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Whilst the words in Phil's marks are in the opposite order to the order of the earlier mark, the use of the same words would still lead to some aural resemblance.

Still, the fact that the word combinations both start and end differently would be noticeable to the average person.

Both marks consist of four syllables, however, the ordering of the syllables is completely different due to the swapped order of the words.

The difference between "silver" and "silvery", whilst present, is not a large difference aurally. It does, however, add an extra syllable. ✓1

Similarly, the difference between "grace's" and "grace" is not a large difference, but does also add an extra syllable.

Overall, there is a small amount of aural similarity, this small amount being due to the use of the same words.

Visual similarity

The presence of both words in each mark plays a bigger role visually than it does aurally. The average person would not pay too much attention to the order of the words, simply that the words are present. ✓1

The difference between "silver" and "silvery" and between "grace's" and "grace" would not be noticeable, particularly since the average consumer of cutlery and glassware is not overly circumspect. ✓1

Overall, the marks are moderately visually similar.

Conceptual similarity

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Both marks are word marks.

For Phil's mark, "grace" is used as an adjective, and is a descriptive word. For the earlier mark, "grace" is used in the sense of a persons name. ✓1

As such, conceptually Phil's mark is referring to an action of "elegance", whereas the earlier mark is simply stating that the silver is "grace's".

✓1

Overall, there is little conceptual similarity.

Overall similarity of the marks

All three components of the mark are likely to be equally important, although perhaps conceptual similarity plays less of a role, since the average consumer is not of the mind to think in detail about the names of the glassware/cutlery they buy and considers more the appearance of said goods.

Overall, there is some similarity between the marks, leaning more towards the less side of similarity. ✓1

7

Similarity of the goods/services

When considering the goods/services it is to be noted that, whilst water, wine and decanters and cutlery are used in conjunction, vases are not. Vases are not associated with eating/drinking, which is a point of note.

Users

Both glassware and cutlery are used by the average person, particularly when eating/at the dinner table.

Similarly, most average people have at least one vase around their domicile.

The users are the same. ✓1

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Nature

Glassware is fundamentally different to cutlery.

Whilst cutlery may be made out of glass, this is certainly not what would spring to the mind of the average consumer, who would think of cutlery being metal or wood.

Little similarity in nature.

✓1

Value

Glassware and cutlery typically have similar values, since they are both considered to be essentials for eating. Therefore, as the goods appear in the registration, value is the same.

✓1

Clearly, however, there is a difference in value in the real world, where Phil's mark is associated with expensive items whereas the earlier mark is associated with cheaper goods. Perhaps Phil may amend his application such that the goods are limited to "boutique" glassware, or something which distinguishes his glassware as more special than simple "cheap" glassware.

Purpose

Both cutlery and glassware are utilised when eating a meal, which is relatively similar.

✓1

Furthermore, cutlery is typically associated with food, whereas glassware is typically associated with liquids.

The methods of use of cutlery and glassware is the same – i.e. picking up with hands to insert something (liquid or food) into the mouth.

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As such, there is some similarity between glassware and cutlery but not a substantial amount.

However, vases have a completely different purpose, holding flowers and items as such. There is no similarity for vases with cutlery.

Complementary

Glassware and cutlery are highly complementary, since a person eating a meal normally has a glass for drinking and cutlery to eat food.

However, vases are not complementary with cutlery.

✓1

Competition

Glassware and cutlery are not in competition, since they are used for different purposes. Cutlery is for eating, whilst glassware is for drinking (although it could potentially be envisioned that there exists glassware for eating).

✓1

Distribution channels

Both glassware and cutlery are usually sold in the same stores.

However, since Phil's goods are sold at boutique stores, and the earlier mark is utilised in cheap stores, this further reinforces the point that Phil could further specify the goods as being boutique to avoid an opposition based on the earlier mark.

Manufacturing origin

Different manufacturing origin, since glassware is typically a more delicate process than producing cutlery.

Overall similarity of the goods/services

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Substantially similar goods/services with respect to cutlery and glassware.

Little similarity in goods/services for vases and cutlery.

✓1

7

Conclusion

The lesser similarity of the marks is balanced by the greater similarity between the goods.

✓1

LOC – 1

An opposition would likely be successful, based on the goods listed presently on Phil's application.

✓1

C – 1

Phil could restrict the goods of his application to “boutique glassware”, or something similar distinguishing its value. If Phil were to do so, an opposition would likely not be successful.

Phil could also restrict the goods to just vases, although given he sells water and wine glasses, this is probably not a realistic option.

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Question 12

In order to ascertain whether Duplico Ltd. can be held liable for passing off it is necessary to perform the classic trinity test:

- Goodwill: Does Jack have protectable goodwill associated with the goods/services he supplies by association with the identifying get-up under which they are supplied.
- Misrepresentation: Duplico Ltd makes a misrepresentation that is likely to deceive the public (intentional or not) to believe that their goods are those of Jacks.
- Damage: Jack suffers, or is likely to suffer, damage as a result of the misrepresentation.

Goodwill

- In order there to be goodwill, and thus for there to be passing off, there must be customers or trade in the UK. ✓₁
- The “huge commercial success” therefore is irrelevant for assessing the extent to which goodwill has accrued in the UK. ✓₁
- Whilst the bricks have only been available in the UK from American sellers up to this point, it is stated that there have still been UK buyers. Therefore, there is clearly some goodwill associated with the PEGGIO bricks. ✓_½
- However, it is not clear to what extent goodwill has accumulated. For that, we would have to know information such as: the number of UK buyers/sales of PEGGIO bricks; the proportion of the relevant public in the UK who identify the bricks as being PEGGIO bricks; and the number of

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repeat customers (i.e. are buyers of PEGGIO bricks buying more afterwards?)

Misrepresentation

- Duplico Ltd. is making a misrepresentation by selling goods with pentagonal pegs, which are clearly associated with PEGGIO, and therefore with Jack.
- The fact that Duplico Ltd. started selling the bricks as soon as adverts started airing for PEGGIO bricks suggests that they are intentionally using the "major TV and online advertising campaign" as advertisement for their own bricks. Allow ✓1

Damage

- The damage that will have been suffered by Jack up until this point will be limited, since it is assumed that the number of UK buyers from American sellers is relatively small compared to the number of UK buyers there will be from Play-With-Us. Allow ✓1
- Regardless of this fact, the American sellers will have definitely lost business through there being less UK buyers, which subsequently results in a loss of business for Jack through reduced manufacturing demand and compensation for Jack. ✓1
- There is also certain to be a likelihood of damage to Jack in the future, as a result of a reduced number of sales of PEGGIO bricks by Play-With-Us, similarly resulting in a reduced manufacturing demand and therefore compensation for Jack.

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- Furthermore, there is likely to be a damage in reputation for PEGGIO due to the cheap plastic utilised by Duplico Ltd. This plastic is likely not only more breakable, but also is certainly worse for the environment. This inconsideration of the environment will be associated with PEGGIO, further damaging its reputation. ✓1

Conclusion

Duplico Ltd. is liable for passing off, and an action brought against them would most probably succeed. ✓1

7½

Remedies

- The remedies available to Jack are those available under common English law and through the jurisdiction of the courts.
- ✓½ Damages and ✓½ account of profits are mutually exclusive – can only select one. Since the damage sustained by Jack as of now is not large (as the full scale launch of the goods has not yet occurred), account of profits is probably most applicable.
- ✓½ Jack should also request an injunction preventing the Duplico Ltd from further selling the instruments of deception. Jack should also request that ✓½ Duplico deliver up or destroy any remaining product.

2

MARKS AWARDED: 9.5/20

9½

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