| Paper Ref | Sheet | Percentage Mark Awarded |
|---|---|---|
| FC5 | 1 of 29 | 54% |

Examiner's use only

**Question 1**

UK, as a contracting state of the Paris Convention, has the right to refuse, cancel, or prohibit the use of a mark that translates, imitates, or replicates a well known mark in the UK.

Eddies mark seems to qualify as a well known mark.

He is a national of a contracting party, UK, and seems to qualify for a well known mark provision where before the registration of the EU trade mark, Eddie has used his UK mark in the course of the trade in the UK, and it is well known in the UK.

However an EU registration is not the same as a UK registration. An EU registration would not have the rights in the UK. So he cannot use a UK registration to oppose an EU trade mark application.

0

**MARKS AWARDED: 0/2**

0

Page sub-total

Examiner's use only

**Question 2**

As a British national if she is a domicile ✓1 or has real and effective ✓1 industrial or commercial establishment ✓1 in the EU contracting state e.g. Ireland or Germany, she could then file for the EU trade mark application as a base application, and then apply for Madrid protocol international application via the same office of origin of the EU trade mark application.

3

**MARKS AWARDED: 3/3**

3

Page sub-total

Examiner's use only

**Question 3, part a**

Separate declaration at the time of designation of the USA in the Madrid Protocol, submitted to WIPO. 0

Page sub-total

Examiner's use only

**Question 3, part b**

In the year preceding the 6th ✓1 anniversary of the trademark filing date, as well as in the year preceding the 11th anniversary of the trademark filing date, submitted to the US trademark office. ✓1

2

Page sub-total

Examiner's use only

**Question 3, part c**

The goods and services to which the use as well as the non-use relates to, as well as the marks to which use, and non-use is relating to. If there has been non-use but the proprietor would like to keep the goods and services category, a statement justifying with a proper reason why there was a non-use. Articles showing the use e.g. specimens of products ✓½ with trademarks on them for each relevant category. A prescribed fee. Allow ✓1 1½

**MARKS AWARDED: 3.5/10**

3½

Page sub-total

Examiner's use only

**Question 4**

Convert an EU trade mark application or EU trade mark into national applications. Time limits, dates from which measured.

- Can apply for conversion within 3 months from ✓1 the date the EU trade mark or EU trade mark application has been cancelled ✓½ or refused ✓½, provided the refusal reason is not extended to the country for conversion. 2

**MARKS AWARDED: 2/6**

2

Page sub-total

Examiner's use only

**Question 5 part a**

UK trade mark registered in July 2020 would be an earlier right, but only if the EU trade mark was to be extended to the UK, or vice versa. As UK is no longer part of EU, a UK only trademark cannot be used to invalidate an EU only trademark.

✓1 1

Page sub-total

Examiner's use only

**Question 5 part b**

It would qualify as an earlier right as it was registered in the EU before 2024, there is no use requirement in the EU at the time of application however, the EU trademark can be revoked on the grounds of non use after registration. Therefore, as the mark has not been used within 5 years in the EU since registration, it would not be considered an earlier right and could not be used for the invalidity proceedings. The use in the UK does not make a difference.

✓1

1

**MARKS AWARDED: 2/4**

2

Page sub-total

Examiner's use only

**Question 6**

Amended – anytime before or after grant of registration, for example if the proprietor would like to change applicants address, or there is a change of representative. Anytime before grant, there is an obvious mistake or correction, replacement of a goods and services class to a more appropriate one, provided that none of the changes affect the scope of the trademark application. ✓1

Restrict – before and after the registration, for example, during the prosecution before the actual grant of registration, the goods and services can be restricted in response to the objection raised by the examiner; after registration in response to the relative grounds objection; ✓1 after registration as a result of non use of a trademark for certain goods and services, the registration can be amended to remove the class of goods and services not in use.

2

**MARKS AWARDED: 2/6**

2

Page sub-total

Examiner's use only

**Question 7**

The first application filed 1 September 2012

The second application filed 1 December 2024

In order to make a valid priority claim, the subsequent application should be filed within 6 months of filing of the priority application. Both of Davids applications have been filed more than 6 months ago ✓1 and therefore do not qualify as application from which a valid priority claim can be made. ✓1 2

**MARKS AWARDED: 2/3**

2

Page sub-total

Examiner's use only

**Question 8, part a**

Transfer or assignment of the trade mark rights document should have been done ideally before Jennifer died. Such documents must be done in writing, signed by the assignor, in this case would be Jennifer before she died, and registered at the UK IPO, with a prescribed fee, no later than 6 months after the fact of signing occurred. ✓1 1

Page sub-total

Examiner's use only

**Question 8, part b**

The deadline is that it must be registered at the UKIPO within 6 months ✓1 after the fact of signing occurred. If not done within this period, the transfer is not valid, and would not come into effect, so Adam would not be the sole beneficiary and would not benefit from remedies or damages that he otherwise would have been entitled to, e.g. in the course of infringement proceedings for infringing acts starting from the date of the transfer. Ie. He would not be able to bring infringement proceedings against anyone who committed infringing acts from the date of assignment. 1

**MARKS AWARDED: 2/4**

2

Page sub-total

Examiner's use only

**Question 9**

As a remedy if the defendant were to be found guilty of infringement, the court may then order the destruction of their infringing goods. The destruction of goods is usually ordered if damages are not possible as a remedy of right (for example, the defendant has not yet started selling the infringing product).

0

**MARKS AWARDED: 0/2**

0

Page sub-total

**Question 10, part A**

Section 1

A trademark to be registrable must be capable of being clearly and precisely ✓1 represented in the register (according to the Sieckman criteria).

The Sieckman criteria dictates that the mark must be clear, objective, precise, self-contained, intelligible, durable, and easily accessible.

Registration of a song without lyrics would be not clear, intelligible, or self-contained, as some people might not be able to read notes so would not understand what the melody is. Though the lyrics would be registrable subject matter. Allow ✓1

Registration of a song with lyrics, similarly to the above the sheet notes would be not clear, intelligible, or self-contained, as some people might not be able to read notes so would not understand what the melody is. Though the lyrics would be registrable subject matter.

Additionally, the trademark must be able to distinguish the goods and services of one undertaking from the goods and services of another undertaking. As the song and the lyrics are well known in the UK, the objection would be raised as it would not be able to distinguish goods and services of only Twinkle, as others have used the song before.

Section 3.1 b – marks devoid of any distinctive character

This song with or without lyrics, as it is already well known in the UK, would be perceived as something other than only the source of origin, ie. Twinkle. As people have heard this song and lyrics before, their association might only lead Allow ✓1

to Twinkle. So an objection would be raised that the trademark lacks distinctive character. Additionally, customers would likely not associate a song with or without lyrics as a trademarks, are customers are used to depend on more tradition marks such as words or logos. ✓1 This is a nontraditional mark so the song with or without lyrics will lack inherent distinctive character. ✓1

Section 3.1 c – marks comprising of a characteristic per se

It seems that the song is about the life and death of an impoverished Irish fishmonger, so not describing the characteristics of frozen shellfish. Therefore the objection with regards to the melody and lyrics would probably be not raised. Therefore the objection with regards to only melody would not raised. ✓1

Section 3.1 d – marks that are customary in the trade

There is nothing to suggest that the song with or without lyrics is customary in the frozen foods or sea food trade. No objection would be raised to either mark. ✓1

7+1 = 8

Section 3.2 a – shapes that result from the nature of goods

Not a shape mark. No objection would be raised to either mark. ✓½

Section 3.2 b – shapes that have a function

Not a shape mark. No objection would be raised to either mark. ✓½

Section 3.2 c – shapes that would make the product more valuable or attractive to customers

Not a shape mark. No objection would be raised to either mark. ✓½

Section 3.3 – marks against public policy, morality or deception

It might deceive the public into thinking that the song with or without lyrics was created by Twinkle if they own trademark rights to it, which is not true as they have not created the song. An objection might be raised.

Section 3.4 – marks that are illegal

No objection would be raised to either mark. ✓½

Section 3.6 – marks made in bad faith

No objection would be raised to either mark. ✓½

Acquired distrinctiveness

Where the mark lacks inherent distinctiveness, the objection under Section 3.1 b to 3.1 d could be overcome if there is acquired distinctiveness. According to Windsurfing criteria, to determine if the mark has acquired distinctiveness, the following needs to be considered:

- The size of the market share held by the mark
- The amount invested in promoting the mark
- How intensive, geographical widespread, and the use of the mark has been
- The proportion of relevant customers that recognise the source of origin based on the mark
- Statements from the commerce or other relevant trade organisations.

It seems that Twinkle has not yet used the song with or without lyrics in the course of the trade and therefore does not benefit from the acquired distinctiveness. ✓1

Examiner's use only

Overall, it is unlikely that Twinkle would succussed in registrating the song with or without lyrics as a trademark. ✓½

3

Total – 11

Page sub-total

Examiner's use only

**Question 10, part B**

Yes, under section 3.3, if the mark is deceiving customers then it would be objected to. Here the lyrics would claim something that is not true for the ✓1 products under the trademark and therefore some customers might be deceived. 1

Page sub-total

Examiner's use only

**Question 10, part C**

Yes, possibly under sections 3.3 (public policy, morality and deception) and section 3.4 (legality). If the ✓1 song contains lyrics that is against morality, then objection would be raised. And sexualisation of exploited working poor under colonial rule does sound like it is against morality. ✓1 2

Page sub-total

Examiner's use only

**Question 10, part D**

Yes, the trademark must be able to distinguish the goods and service of one undertaking from the goods and services of another's undertaking. If the song has been recorded and played hundreds of times since, the song would not be distinctive and would not identify Twinkle as a trademark. Therefore, it would lack inherent and also acquired distinctiveness.

0

**MARKS AWARDED: 14/20**

14

Page sub-total

**Question 11**

For Phil's trademark application to be vulnerable to opposition, the proprietor of the earlier trademark right, Grace Co (Cutlers) Co would need to have a valid earlier right and basis for opposition.

a) Enforceability of Grace Co (Cutlers) Co

Grace Co (Cutlers) Co has been filed 1 April 2020, which is more than 5 years prior to the priority and filing of the Phil's mark (priority 1 June 2025, filed 1 September 2025). Therefore, for the Grace Co (Cutlers) Co mark to be enforceable it would have to have been put to genuine use within 5 years prior to the priority of the of the Phil's mark and opposition proceedings. It seems that from Phil's understanding that the Grace Co (Cutlers) Co have indeed been involved in the course of a trade in the UK through Pound Stores, though we are not told if the trademark has been used in substantially the same form as presented, and if it has been used continuously in the course of a trade in the period between 1 June 2020 and 1 June 2025. However, for the purpose of this answer I assume that the mark has indeed been used within 5 years prior to the 1 June 2025. The renewal fee is still not yet due until 1 April 2030, so we do not need to consider this aspect. ✓½ ½

b) Similarity of marks

Visual aspect

Visually both marks are word marks, composed of 2 words that are very but in reverse order. ✓1

SILVER (Grace Co (Cutlers) Co)

SILVERY (Phil)

The word SILVER is identical apart from an additional letter at the end of it for Phil, **Y**.

GRACE (Phil)

GRACE's (Grace Co (Cutlers) Co)

The word GRACE is identical apart from the apostrophe 's, which can be ignored as a mere grammatical feature. ✓1

Overall, visually the marks have some similarity due to being composed of substantially the same words, but the fact that they are in reverse order subtracts from their similarity visually.

Aural

Similarly, to above, the two marks are pronounced different due to the word position. ✓1

The mark of Phil contains 4 syllabus. While the first word contains 3 syllabi, and the second word contains 1.

The mark of Grace Co (Cutlers) Co also contains 4 syllabus. While the first word contains 2 syllabi, and the second word contains 2. ✓1

When pronouncing these marks, they sound different despite the individual words being the almost the same, due to their position the whole name sounds different.

Conceptual

The concept of these marks is very similar as there are word marks, each contain the name Grace, and each contain the word Silver, the variation of Phil mark of SilverY, still conveys the same concept of something containing or being made or looking like silver. Allow ✓1

Overall, the marks are moderately similar, but not overly similar when spoken out load and looked at a brief glance, though if the customer is to examine them more closely, the customer would see the conceptual link. ✓1 6

c) Similarity of goods and services

The marks should be assessed for the goods and services as registered and not as used.

Users

The intended users of both goods are similar – adults shopping for home goods, especially kitchen goods. ✓1

Nature

The nature of the goods is not similar, glassware vs cutlery, cutlery can be made of metal or ceramic or wood, while glassware can only be made of good. ✓1

Purpose

The general purpose of the goods is to be used in the kitchen though for different tasks, glassware for holding foods or liquids inside, while cutlery for picking food up or cutting it. ✓1

Value

Examiner's use only

Phil suggested that his glassware is sold in boutique stores at a higher price so higher value, while Grace Co are cheaper items sold at budget stores like Pound Store.

Competitive

These items are not directly competitive as a customer needing a cutlery object like a spoon would not replace it with a glassware object like a wine glass. ✓1

Complementary

These items can be complementary, though not necessarily. ✓1

Methods of Use

Both items can be used in the kitchen though in different ways. ✓1

Distribution channels

Different, as for Phil expensive stores, and Grace Co budget stores.

Manufacturing sources

Different, as for Phil craftsman specialising in glass blowing and glass cutting, and Grace Co mass produced probably in a factory.

Overall, the goods and services enjoy less than average similarity. ✓1

7

d) Average Consumer

✓1

The average consumer would be an adult person looking for home supplies. The average consumer of craftsman man glass item of Phil would pay more attention to detail and the mark than the average consumer of Grace Co buying a mass produced item.

1

Page sub-total

Examiner's use only

e) Likelihood of confusion

Provided, the low similarity in marks with the low similarity of goods and services, there is an unlikelihood of confusion from the customer as far as the items are not sold side by side. ✓1 If the price range and distribution channels change for either of the marks to match the other, this would drastically increase the likelihood of confusion. 1

f) Conclusion

Phil's application is most likely not vulnerable to opposition from the Grace Co. ✓1 1

**MARKS AWARDED: 16.5/20**

16½

Page sub-total

**Question 12, Part A**

In order to bring a passing off action, an earlier right needs to have enjoyed goodwill in the course of the trade in the UK, in a specific locality, and have been using the mark prior to the date, the earlier of:

The date of filing of a later trademark right

The date the trademark was first used in the course of a trade by the other party.

For a successful passing off action, the goodwill, misrepresentation, and damages need to be shown.

Goodwill

In this case, Jack clearly enjoys goodwill in the USA, however that is not enough ✓1, he must also show that he has goodwill in the UK. ✓1 He said that the UK customers used to order PEGGIO bricks from the USA, so it seems that he enjoyed goodwill in the UK in the course of a trade, where UK customers were purchasing his products ✓½ (even though other more available alternatives in the UK were available to them, so shows that the customers were really after Jacks bricks to go through the hurdle of ordering from the USA). Additionally, a UK based toy retailer Play With US, meaning it is incorporated in the UK as a domicile as having a real and effective industrial or commercial (commercial in this case) establishment, has been running a major TV and online advertising campaign for the PEGGIO bricks availability for sale at their stores. To further demonstrate that Jack enjoyed goodwill in PEGGIO bricks in the UK, he should demonstrate the history of the record of sales of PEGGIO bricks in the UK, as well as evidence if the relevant

customers in the UK associate the unique pentagonal pegs with PEGGIO bricks of Jack, and any other information that may strengthen his goodwill in the UK.

Misrepresentation

Would the customers associate or confuse the bricks of Duplico Ltd, as originating from or being endorsed by or be produced by Jack.

In the advertising campaign, it said that these bricks enjoyed a unique pentagonal pegs, which allowed them to bind more tightly together than other bricks, allowing for taller structure to be built and wider spaces to be spanned.

The fact that the advertisement said that these are unique, would signal to customers that only PEGGIO bricks has this feature and thus any other product with this feature must be also from PEGGIO, so here there is a high likelihood that the customers would either believe that there is an association between PEGGIO and any other brinks having this unique feature or a direct confusion that this is a PEGGIO product while in reality it belongs to Duplico. ✓1

However, the advertisement also said that this unique feature of pentagonal shape also has a potential function – bind more tightly together, allowing for a technical result of taller structures. According to the LEGO case law, any feature of a trade mark would result in a trademark being refused on the grounds of Section 3.2b (shapes resulting in a technical effect). Even if shape is not solely dictated by the technical function, and even if there are near to unlimited shapes that are available for this feature, if just one is for a technical result, the trademark right application would be refused. Therefore, in this case it is possible that the pentagonal shape might not enjoy the earlier rights as being not a

Examiner's use only

subject matter suitable for a trademark protection. So a passing off action might not be successful for Jack as he might not enjoy trademark protections rights, if refused on absolute grounds. Even if the PEGGIO brinks have a decorative element, that does not affect in any way the fact that one of the features of these brings i.e. pegs, have a functional result. Allow ✓½

Additional factor that can be considered is enhanced distinctiveness, trademarks that have enhanced distinctiveness have wider scope of protection and therefore are more easily associated in the minds of customers with identical marks for similar goods or identical marks for identical goods. PEGGIO might have enhanced distinctiveness.

Damages

It is not necessary to prove damages, their likelihood is enough for passing off.

Could be direct loss of sales (diversion of sales) of PEGGIO bricks due to customers choosing a cheaper Duplico bricks. ✓1

Additionally, damage to the reputation as the cheaper virgin plastic maybe of lower quality and may damage the reputation of pentagonal pegs.

Prevention of future sales as stores that bough from Duplico would now not buy from Jack.

5

Page sub-total

Examiner's use only

**Question 12, Part B**

As it seems that Duplico just started to distribute, an interim ✓½ or permanent injunction might be the most suitable to cease and desist infringing bricks. OR

Additionally, damages of loss ✓½ and diversion of sales of Jack due to Duplico sales can be calculated. OR

Additionally, an equitable remedy of account of profit made by Duplico in sale of the infringing bricks ✓½ can be calculated and awarded to Jack. OR

Deliver up ✓½ or destruction of the Duplico bricks. 2

**MARKS AWARDED: 7/20**

7

Page sub-total