

### Question 1

You work for a firm of solicitors in the City of London. You have a client who did not conduct a trade mark search before their product was launched. They have now been successfully sued for trade mark infringement.

- a) What may they now be ordered by the Court to do? **(4 marks)**

Stop using the mark

Destroy/repackage existing stock

Pay the trade mark owner (damages/account of profits)

Contribute towards the other side's legal costs

- b) When would it be advisable to conduct a search in future? **(2 marks)**

Before adopting a new trade mark

Before launching an existing trade mark in a new jurisdiction

### Question 2

You have been requested to assist with the filing of an EU trade mark application in two classes, Classes 35 and 37 in the name of Ninanano B.V.

- a) You are aware that "Retail services" and "wholesale services" (Class 35) and "installation" and "repair" (Class 37) are not allowed in the EU unless they are further specified. Provide an example (for each) for the type of wording that might be allowed to qualify retail services and repair **(2 marks)**

"Retail services in relation to clothing" – accept other products after "in relation to" or "related to"

"Repair of motor vehicles" – accept other products after "of"

- b) Name three member states of the European Union that would be covered by an EU trade mark registration **(1 mark)**

3 from [N.B. Benelux is incorrect]:

Austria

Belgium

Bulgaria

Croatia

Republic of Cyprus

Czech Republic

Denmark

Estonia

Finland

France

Germany

Greece

Hungary

Ireland

Italy

Latvia

Lithuania

Luxembourg

Malta

Netherlands  
Poland  
Portugal  
Romania  
Slovakia  
Slovenia  
Spain  
Sweden

- c) What would the official fees be for an EU trade mark application filed in two classes? This would not be a Certification or Collective mark and would be filed through the direct route, not via the Madrid Protocol **(1 mark)**

€900

- d) The applicant is from the Netherlands. Can the application be filed in Dutch as the first language and English as the second language? **(1 mark)**

Yes

### Question 3

Who may apply for a UK trade mark application? **(3 marks)**

(mark free form, if a candidate makes three valid points then full marks)

Some salient points we'd be looking for are below.

Any natural or legal person, including authorities established under public law, may apply for a trade mark, irrespective of their nationality or domicile.

A registered trade mark and an application for registration are both personal property and so this means that an applicant must be an individual (a natural person) or some sort of legal person, capable of owning property in their own name.

Not a trading name or style.

Requiring an Address for Service in the UK, Channel Islands or the Isle of Man is an overseas applicant.

### Question 4

In the United Kingdom, a trade mark registration can be revoked if it is not used.

- a) What period of continuous non-use is required before a revocation action can be filed? **(1 mark)**

Five years

- b) From what date is this initial period calculated from? **(1 mark)**

The date of entry in the Register (the date the Certificate is issued).  
Accept Grant date.  
Do not accept Registration date.

- c) Explain the procedure after the filing of a TM26(N) Application to revoke a trade mark for reasons of non-use? **(4 marks)**

(1 mark) Counterstatement (accept TM8N or just TM8) within two months

(1 mark) If evidence of use (or reasons for non-use) does not accompany the Counterstatement, further two-month period to file evidence of use (or reasons for non-use)

(2 marks) Tribunal will set further periods for parties to file evidence and submissions – discretionary and no fixed periods or sequences, but usual sequence (and typically two-month deadlines set):

- 1) Proprietor files evidence of use
- 2) Revocation applicant files evidence/submissions
- 3) Proprietor files evidence/submissions in reply
- 4) Hearing or written submissions

### Question 5

You work in-house for Benny Lux, a global cosmetics business jointly headquartered in London (United Kingdom) and Amsterdam (the Netherlands).

- a) Your manager mentions that you can claim entitlement based on either HQ office. What territories could therefore form a base mark for filing under the Madrid System? **(3 marks)**

United Kingdom  
Benelux  
European Union

- b) Name a constituent country or the special municipalities of the Kingdom of the Netherlands that is not covered by a registration that provides protection for the Netherlands in Europe **(1 mark)**

One from:

Aruba

Curaçao

Sint Maarten

Bonaire, Sint Eustatius and Saba (alternatively referred to as the Caribbean Netherlands or the BES Islands)

- c) Part of your role is to ensure that any gaps in protection of their house mark are filled so they have full global protection.

Until now, your company has not published any Cautionary Notices. Provide a brief explanation of a Cautionary Notice **(1 mark)**

A process of putting third parties on notice of trade mark rights by publishing them in local newspapers/magazines/publications

- d) Name one territory where it may be necessary to publish a Cautionary Notice **(1 mark)**

One from:

[N.B. Myanmar is now incorrect]

Cook Islands

Eritrea

Maldives

Marshall Islands  
Micronesia, Federated States of  
Palau  
Somaliland  
Timor-Leste

e) To be effective, it is considered advisable to re-publish Cautionary Notices at regular intervals. How often do republications usually occur? **(1 mark)**

Re-publication periods of two, three and five years are most common

#### Question 6

The Madrid Protocol is a fundamental part of the trade mark landscape but possesses some differences to applications filed under national routes.

a) Explain when a registration/protection of a specific designation is tacitly assumed? **(1 marks)**

If no objections (Provisional Refusals) (or other notifications) are raised within the relevant 12 or 18-month examination periods, there is tacit protection

b) It is necessary to pay the Office of origin a 'handling fee'. What is this fee when filing at the UKIPO as Office of origin? **(1 mark)**

£40

c) The initial, non-substantive, examination from WIPO includes a thorough examination of classification. If a classification Irregularity Notice is issued, how is this responded to? **(1 mark)**

If WIPO issue an Irregularity Notice regarding classification it must be responded to via the Office of origin. Accept UKIPO

d) Explain what 'Central Attack' is including by making reference to dependency and what forms 'Central Attack' can take? **(3 marks)**

For **five years** from the date of International Registration, the protection resulting therefrom is dependent on the base mark it was based on.

The **base mark** can be **lost** in the following ways:

- It is withdrawn
- It is allowed to lapse
- It is renounced
- It has been subject of a final decision of rejection, revocation, cancellation or invalidation (includes a successful opposition against the mark)

**If base mark lost = International registration cancelled**

#### Question 7

You have a client interested in trade mark protection in the USA.

If filing a national application, set down the four bases that are available for filing. Merely mentioning the sections of the Lanham Act is not sufficient for marks here. **(4 marks)**

N.B. Merely mentioning the sections of the Lanham Act is not sufficient for marks here.

Section 1(a): **Use in commerce** basis - you are currently using your mark in commerce with your goods and/or services.

Section 1(b): **Intent-to-use** basis - you have a bona fide intention to use your mark in commerce with your goods and/or services in the near future.

Section 44(d): **Foreign priority basis** – a priority claim.

Section 44(e): **Foreign registration basis** – based on a foreign registration of the same mark for the same goods and/or services from your country of origin (which means it is generally not available to a US applicant).

### Question 8

You have a protected US designation of an International Registration for the trade mark DOWNEES.

a) Explain the renewal and maintenance deadlines, including any grace periods available, faced by this designation in the first 10 years since it was granted protection in the United States. **(6 marks)**

Declaration of Use and/or Excusable Nonuse under Section 71 filed between the **5th and 6th years** of the date the USPTO issued the certificate of extension of protection (the LOCAL registration date))

**Six-month grace period**

Regular renewal of the (whole) International Registration handled with WIPO, **10 years** from International Registration date

**Six-month grace period**

Declaration of Use and/or Excusable Nonuse under Section 71 filed between the **9th and 10th years** of the date the USPTO issued the certificate of extension of protection (the LOCAL registration date))

**Six-month grace period**

b) If the trade mark has been in use for a continuous period of five years, what can be filed under Section 15 to enhance the rights? **(1 mark)**

Declaration of Incontestability

### Question 9

You work in private practice for Isambard, Kingdom and Brunel LLP under the supervision of the firm's senior partner, Gideon Soames, who has asked for you to prepare a Notice of Threatened Opposition on Form TM7A on behalf of your major client, Jumbo Manufacturing plc ("Jumbo"). Jumbo have a number of subsidiaries including Micro Products Limited and Intermediate Goods Limited.

Gideon Soames has instructed you that they would base any opposition on the client's MAHOOSIVE trade mark registration. On checking your records and cross-checking the UK Register, you note that this trade mark is owned by Jumbo Manufacturing plc.

a) Whose details would you enter for the potential opponent on the TM7A? **(1 mark)**

## Jumbo Manufacturing plc

b) Filing this form is considered notification to the applicant that an opposition might be filed. Does this need copying to the applicant (**1 mark**) and what does this mean in relation to costs in any resulting opposition proceedings? (**1 mark**)

No, it doesn't need copying to the applicant

If you win the opposition, you are likely to be receive an Award of Costs in your favour, where the losing party is ordered to contribute to your legal costs

c) How is a Form TM7A filed with the Intellectual Property Office (online, paper form, by e-mail)? List all available options. (**1 mark**)

Can only be filed online. Mark incorrect is any others are listed.

## Question 10

Provide four reasons to set up a trade mark watch. (**4 marks**)

(4 from)

Protect marks from third parties filing identical or confusingly similar marks

Identify potential counterfeiters and infringers

Ensure brands are not lost due to common use

Can provide early identification of a potential problem

Not all Trade Mark Offices examine applications on the basis of prior rights or provide notifications like the UKIPO and EUIPO do. Anyway, can we rely solely on the assessments of Examiners?

Large number of Registers makes it extremely difficult to individually monitor

Can be used to monitor competitors

## Question 11

You work on the Isle of Wight for Gallybagger Engineering Limited, an established manufacturer of combine harvesters and tractors.

One of the team, as part of their job to do so, has created a new design for a combine harvester. Knowing this market segment well, it is believed that this design is novel and original, has individual character and is not commonplace.

a) You are aware that the UK has forms of registered and unregistered design protection. What advantages are there to registering a design? (**3 marks**)

**Duration:** Registered Designs can last up to 25 years, subject to being renewed every five years.

**Wider scope:** Registered Designs protect against other designs even when the infringing design has been developed in good faith (i.e. by someone that had no idea of the existence of the earlier registered design).

**Easy proof of ownership and a date** - there will be a Registration Certificate. Use discretion e.g. searchable right, you can mark a design as registered, etc.

b) If you were to file a UK design application for this design online, how many views or representations can you upload in a single application? (**1 mark**)

12 views/representations

c) The new combine harvester is not expected to be launched until an agricultural fair takes place around Harvest time 2024. To keep the design a secret from competitors in the United Kingdom and European Union deferment of publication can be requested. What is the maximum period of deferment allowed in the United Kingdom and in the European Union? **(1 mark)**

Half a mark for each

UK = 12 months

EU = 30 months

d) In the meantime, an existing combine harvester design, registered under No. 4045672, remains on the market and is a market leader in the United Kingdom. Due to an oversight, while the business was focussed on the new design, you note this fell due for renewal on **6 February 2024**. Can this be late renewed and, if so, what is the final deadline for renewal? **(1 mark)**

Yes

6 August 2024

e) Once the new combine harvester design has been released, you have plans to licence the EU registration to be used by a local company in Romania and Bulgaria. Is this possible and can the licence be recorded on the EU Register? Provide a justification for your answer. **(2 marks)**

Yes and yes

Although an EUTM is a unitary right and cannot be typically split up by country, it can be licensed for only one or some EU countries.