

Suggested Answers to the Questions in Chapter 10

1. What is the process of registering UK trade marks?

The good answer will:

- Demonstrate knowledge of the registration process for UK trade marks.
- Indicate the steps in the registration process, as indicated in diagrams 10.1 and 10.2 and including the filing of the application (s.32 TMA), the examination (s.37), the issue of search and examination report, publication of the mark in the *Trade Marks Journal*, a weekly publication now available online (<https://www.ipo.gov.uk/t-tmj.htm>) and notification of the owners of any relevant community or internationally registered trade marks, and the opposition stage, with an initial period of two months, which can be extended by one month. If no opposition is filed, or if any opposition is overcome, the mark is registered for an initial period of ten years. The period of registration is calculated from the filing date. Registration is only *prima facie* evidence that the mark is valid (s. 72).

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2. The choice of the average consumer as the arbiter of registrability is uncertain and consequently unhelpful. Discuss.

The good answer will:

- Begin by pointing out that most areas of intellectual property depend on the use of a fictitious individual to determine key issues, and that the judicial use of such a person is in order to ensure objectivity. A brief comparison could be made with the skilled addressee of patent law and the informed user of design law.
- Identify the origins of the reasonable consumer test in the ECJ's ruling in the *Lloyd Schuhfabrik* case.
- Set out the characteristics of the reasonable consumer and note how these vary depending on the nature of the goods to which the trade mark is applied, giving examples of where the consumer may be more or less attentive to detail because, for example, of the price of the product or the strength of the senior mark (*Ruiz-Picasso v OHIM (PICASSO/PISSARO)*, *Les Editions Albert René Sarl v OHIM (MOBELIX/OBELIX)*, *Develey Holding GmbH v OHIM (shape of a sauce bottle)*, *Inter-Ikea Systems BV v OHIM (IKEA/IDEA)*).
- Set out when the reasonable consumer is used to determine key issues of trade mark law (whether something is a sign, whether it is capable of distinguishing, the absolute grounds of refusal (including acquired distinctiveness), the relative grounds of refusal, whether a mark has become generic or deceptive, whether there has been 'trade mark use', and trade mark infringement).
- Debate the issues in the question; that is, whether the use of the reasonable consumer is uncertain and unhelpful and if so, suggest a better alternative. It is expected that reference would be made to the academic literature listed in the annotated further reading for Chapter 10.

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3. What are the objectives and anticipated benefits of the abolition of the graphic representation requirement?

The good answer will:

- Explain that, up until recently, the *graphical* representation requirement of a mark was a *sine qua non* of the existence of the trade mark. Visual delineation of the mark was a simple yet essential condition ensuring that the mark would serve its basic function, namely to differentiate the origin of goods and services. Reference to relevant cases can be made.
- Indicate that with the multiplication of trade mark registrations over the years, finding available marks, such as words, figurative signs or colours, became increasingly difficult and resulted in exploration of alternative signs, such as smells or sounds, to function as indications of origin. Following these market trends, the law evolved by eliminating the graphical representation requirement which was to a large extent an impediment to registrability, whilst endorsing the ECJ jurisprudence, most notably *Sieckmann*.
- Explain that the new requirement will allow for a wider range of representations even though filing of specimens or samples seems to be excluded. Various different formats will now be allowed, including JPEG, MP3, MP4, OBJ, STL and X3D depending on the type of mark. This will have the effect that some forms of unconventional marks, such as sound marks, motion marks, multimedia marks and hologram marks, will now be easier to register. This includes colour marks, including single colour or colour combination marks, which however will have to include both the representation and in addition a reference to a generally recognised colour code, such as Pantone, Hex, RAL, RGB or CMYK.
- Consider one of the first cases that addressed the new representation requirement: Case R 200/2017-2 *Giro Travel Company v Andreas Stihl AG & Co KG*.

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4. Will the 2015 EU reform of the trade mark system have an impact on the registrability of certain marks, mostly unconventional trade marks?

The good answer will:

- Offer a comparison between the pre-2015 and the 2015 legal framework, focusing on the reform of the graphic representation requirement.
- Consider the impediments to the registrability of so-called unconventional trade marks, some of which were not capable of graphical representation, and refer to relevant case law (e.g. Sieckmann, Heidelberger Bauchemie, Shield Mark, etc).
- Explain that with the reformed requirement of clear and precise representations some forms of unconventional marks, such as sound marks, motion marks, multimedia marks and hologram marks, will now be easier to register, including single colour or colour combination marks (which will have to include both the representation and in addition a reference to a generally recognised colour code, such as Pantone, Hex, RAL, RGB or CMYK).
- The registrability of other unconventional marks, such as smells and tastes, will still however be too difficult to accomplish.