

Patent Attorney Examiner comments 2014 Paper B

Overall, the answers to this paper were what was expected based on previous years. There were some really great papers and some not so good papers, and everything in between!

To assist candidates who did not pass, and other future candidates and tutors using this paper for study, set out below are some notes on the common reasons why candidates did or did not get good marks.

Question 1 – Registrability questions

Marks were generously awarded in this section to candidates who demonstrated an understanding of the legal issues and then gave reasoned answers on registrability. Some of the answers were impressive because they were right on point, reasoned and very succinct.

It is not sufficient to write "yes" or "no" to these questions. And you also cannot write "registrable" or "unregistrable" and expect to get the marks. Nor is it sufficient to write "on balance registrable" or "on balance not registrable" as the only answer.

It is recognised that there is often more than one right answer to some questions, and that there can be an element of subjectivity. But there must be plausible reasoning, albeit brief given the short time you have to answer each sub-question.

Also note that there were no marks given for a detailed exposition of the law without any application of that law to the question.

Question 2

This set of questions was generally answered well by most candidates. A few people were confused between the ownership issue involving a merger of companies on the one hand, and the situation involving a merger of trade mark registrations. These situations are quite distinct even though there is a "merger" involved in both scenarios. A merger of companies is when two companies become one company and so there is an assignment by virtue of the operation of the law (rather than a deed of assignment). A merger of trade marks occurs for example when trade mark registrations are merged together to form one registration with the same mark and the same owner.

A few people were also unsure of the difference between the legal effect of the recordal of a company's change of name as compared to the recordal of an assignment. The former does not involve an actual change of ownership, the entity is still the same, only its name has changed. The latter involves the transfer of a trade mark from one entity to another.

Question 3

Overall, this question was answered very well. However, here are some points to note as follows:

- Ensure that you set out all the relevant legal tests. But avoid setting out sections of the Trade Marks Act 2002 almost verbatim. You should set out the applicable legal tests from the case law relating to the comparison of marks, and also the comparison of goods and services. And you need to set out the tests for passing off and Section 9 of the Fair Trading Act 1986. Some candidates did not set out the tests at all, and

some candidates set out Section 25 of the Trade Marks Act almost in its entirety which would have been time consuming and quite unnecessary.

- Ensure that you address all the earlier trade marks raised in the question. Some candidates missed out discussing some earlier marks altogether. A few candidates did not discuss the domain names at all.
- When analysing the similarity of marks, it is not sufficient to simply state that a mark is visually, phonetically and conceptually the same or different. Marks were awarded for the reasoning that brought candidates to their conclusions. Without the reasoning it is unclear whether the candidate can apply the law and reason through to a conclusion.
- There were easy marks awarded in this question for raising and discussing the relevance of there being a co-existence of marks containing the element "mist" covering the same products but in the names of different owners. Only some candidates addressed this point and were awarded the marks for doing so.
- With domain names, it is not sufficient to deal with these by simply stating that "domain names don't create any common law rights unless they are used in the marketplace". You must analyse the domain name just as you would any other mark. If the mark is similar then you need to advise the client that further investigations may be required to determine any use in the marketplace and the sphere of interest.

Question 4

This question was also handled well by most candidates. The answers that did not do so well missed out important issues such as:

- Preliminary steps such as ownership searches, internet searches, raising questions about past or present disputes
- Copyright and trade mark issues relating to the "cool characters".
- Assignment of "goodwill".
- The possibility of overseas trade mark protection.

There was not always enough care given to identifying the rules that apply under the Trade Marks Act and Regulations. For example, when a registration has expired, it may be possible to restore that mark, but it also must still be renewed. Also, when applying for "continued processing", an applicant must respond within 2 months of the deadline expiring, and that response must also satisfy the issue raised by the examiner.

Question 5

This question required a thorough understanding of the law relating to the revocation of a trade mark based on non-use. Marks were generously awarded for knowing the law and then applying that law to the facts as set out in the question.

Marks were lost for not setting out the correct non-use period, not discussing "special circumstances" and whether they might apply in this case and so on. Also a number of candidates did not answer all of the question because they only looked at the position from one party's perspective. They did not look at the options for the other side.

Question 6

This question involved the difficult issues that can arise with shared goodwill. It was also a question where easy marks could be obtained for setting out the relevant legal tests and procedures. Quite a few candidates lost marks by not setting out the tests at all and not setting out the standard applicable legal procedures. For example, the facts of the question raised the possibility of applying for an interim injunction which a few candidates did not mention at all.

Finally, when answering a question such as this, bear in mind that there is often no single correct solution. There may be many different solutions that could be equally right. What is important is to identify the relevant laws and procedures and apply that to the facts while giving sound reasoning for all of your conclusions.