

LAW AND PRACTICE OF TRADE MARKS

EXAMINATION PAPER 2008

Time Allowed: 3 Hours

Answer **SIX** questions only. Any additional answers will be disregarded and **NOT** marked.

Candidates **MUST** answer at least **ONE** question from Section A, at least **ONE** question from Section B and at least **ONE** question from Section C.

In the event of a Candidate failing to adhere to the instructions set out above the examination paper of that Candidate will **NOT** be considered valid.

SECTION A

1. Write notes on any THREE of the following cases:
 - (a) Local Ireland Limited v. Local Ireland-Online Limited [2000] 4 IR 567.
 - (b) Jacob Fruitfield Food Group Ltd v. United Biscuits (U.K.) Ltd [2007] IEHC 368 (12th October 2007).
 - (c) Case C-291/00 LTJ Diffusion SA v. Sadas Vertbaudet SA, European Court of Justice, 20th March 2003.
 - (d) Cofresco Frischalterprodukte GmbH & Co. KG v. Controller of Patents, Designs and Trade Marks [2007] 2 ILRM 430.
 - (e) Unilever plc v. Controller of Patents, Designs and Trade Marks [2007] 2 ILRM 389

2. Teltzer Pharmaceuticals Limited markets a popular cold and flu remedy in Ireland and the United Kingdom under the registered trade mark DELGAN. In both countries the product is sold without prescription in small bottles containing 30 tablets. In all remaining European Union member states the product is sold under the registered trade mark DALGOT in boxes of 20 tablets that contain four blister strips holding five tablets each. Bonty Chemists Limited have discovered that it is possible to purchase quantities of the tablets from wholesalers in France at prices that work out at less than half the price being charged by the suppliers acting for Teltzer Pharmaceuticals Limited in Ireland. Bonty Chemists Limited intends to import tablets bearing the registered trade mark DALGOT into Ireland, remove the tablets from the boxes and the blister strips and place them in bottles containing 30 tablets each. Because Irish consumers would not recognise the product if it was sold under the name DALGOT, Bonty Chemists Limited intends

placing labels bearing the word DELGAN on the bottles. Those labels will be similar in size and colouring to those used by Teltzer Pharmaceuticals Limited, but will state 'Packaged in Ireland by Bonty Chemists Limited.'

Advise Bonty Chemists Limited.

3. While making detailed reference to relevant case law, define and discuss what is compassed within the concept of “bad faith” as provided for in section 8(4)(b) of the Trade Marks Act 1996.
4. While making detailed reference to relevant case law, consider the extent to which colours may be registered as trade marks.

SECTION B

5. (a) Set out the procedural steps which must be followed in order to oppose the registration of a trade mark.

AND

(b) Consider how and in what circumstances an appeal from a decision of the Controller in respect of an opposition can be made to the High Court and from there to the Supreme Court.

6. Explain the distinction between an action for infringement of a registered trade mark and an action for passing off, and in doing so identify the matters in respect of which evidence would have to be adduced in order to succeed in each.
7. Outline and discuss:
 - (a) The provisions of the Trade Marks Act 1996 that deal with removal of a trade mark from the register on the grounds of non-use.

AND

- (b) The use requirements necessary to avoid a trade mark being removed from the register on the grounds of non-use.

SECTION C

8. Padal SA, a French company, is the manufacturer of the famous “Besqualle” cheese (which is named after the village in France where the founder of Padal SA was born and first manufactured cheese). Besqualle cheese is now manufactured in a factory in Lyon. While it has used the name “Besqualle” for twenty-five years, Padal SA never registered it as a trade mark. Although it is popular on the

continent, “Besqualle” cheese has been sold in only five outlets in Ireland during the course of the last three years, with the average annual turnover from retail sales being approximately €45,000.

Carnmore Creameries Limited is about to start production of a cheddar cheese which is to be called “Beskill”. Carnmore Creameries Limited wishes to register “Beskill” as a Community Trade Mark and seeks your advice as to whether Padal SA could stand in its way.

9. Write notes on EACH of the following in the context of the Community trade mark system:
 - (a) Identifying the courts in which one should sue for infringement of a Community trade mark;
 - (b) Acquiescence in the use of a later Community trade mark;
 - (c) Applications to the Office for Harmonisation in the Internal Market for revocation and for declarations of invalidity regarding Community trade marks; and
 - (d) Appeals from decisions of the Office for Harmonisation in the Internal Market.
10. Explain the procedure to be followed in order to convert a Community Trade Mark application into an application for an Irish registered trade mark.