

## LAW AND PRACTICE OF TRADE MARKS

### EXAMINATION PAPER 2010

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) *Tommy Hilfiger Europe Inc. v. McGarry* [2008] IESC 36 (29<sup>th</sup> May 2008).
  - (b) *Guinness Ireland Group v. Kilkenny Brewing Co. Limited* [1999] 1 ILRM 531.
  - (c) *Sealed Air Corporation v. Controller of Patents, Designs and Trade Marks*, High Court, 29<sup>th</sup> July 2003 (Smyth J).
  - (d) *Allergan Inc. v. Ocean Healthcare Ltd* [2008] IEHC 189 (24<sup>th</sup> June 2008).
  - (e) *Cofresco Frischalterprodukte GmbH & Co. KG v. Controller of Patents, Designs and Trade Marks* [2008] 1 IR 582; [2007] 2 ILRM 430.
  
2. In 2000 Carlow Confectioners Limited registered the word “SURPRISE” as a trade mark in Class 30 respect of “ice creams and desserts”. For the preceding five years it had marketed a dessert consisting of ice cream and white chocolate called “Arctic Surprise.” Up to March 2009 “Arctic Surprise” was sold in a blue cardboard box bearing that name in large white letters along with an indication that it had been manufactured by Carlow Confectioners Limited. In March 2009 the cardboard packaging was replaced with a blue plastic tub. Last month Carlow Confectioners Ltd learned that the Brilliant Bakery is selling a cake with an ice cream filling which it calls a “Sundae Surprise”. Like all other products of the Brilliant Bakery, the “Sundae Surprise” is sold in a blue box which has the word “Brilliant Bakery” on it in white letters. Last week solicitors acting on behalf of Carlow Confectioners Limited wrote to Pat, the owner of the Brilliant Bakery, indicating that unless he desists from calling his product a “Sundae Surprise” and

selling it in a blue box, he would be sued for trade mark infringement and passing off.

Advise Pat.

3. While making detailed reference to relevant case law, consider what must be established in order to demonstrate successfully that an application for a trade mark has been made in bad faith.
4. Explain whether (and if so to what extent):
  - (a) Colours;
  - (b) Sounds;
  - (c) Slogans; and
  - (d) The names of geographical locations

can be registered as trade marks.

## **SECTION B**

5. Baldricka Inc. is a United States corporation which manufactures designer clothing. It is the registered owner of the trade mark "BALDRICKA" which is registered in Class 25 for "clothing, footwear and headgear". The mark was registered in 2004, but Baldricka Inc. has sold "BALDRICKA" jeans in Ireland and the United Kingdom since 1995. Baldricka Inc. has filed a Notice of Opposition in respect of an application by Extreme Sports Limited to register "BOLD TRICK" as a trade mark in Class 25 in respect of "running and training shoes" and "athletic and sports apparel". The principal grounds upon which that opposition has been mounted are that the application offends against sections 10(2) and 10(4)(a) (insofar as the latter refers to the law of passing off) of the Trade Marks Act 1996.

You have been instructed to deal with the presentation of the evidence which will be filed in support of the opposition. Set out in the form of a memorandum to Baldricka Inc.:

- (a) An explanation as to the form and manner in which the evidence will have to be presented for the purposes of the opposition; and
- (b) The type of information which you will need in order to present the opposition in as effective a manner as possible.

6. (a) Outline the approach that you would adopt when deciding on the class or classes in respect of which a trade mark should be registered.
- (b) While setting out your reasons, indicate the class or classes in which you would apply to register trade marks for the following:
- (i) Easter eggs.
  - (ii) Hand lotion.
  - (iii) A business providing personal security and bodyguards.
  - (iv) A nightclub.
  - (v) Drain cleaning services.
7. Outline and discuss the operation of the Madrid Protocol.

### **SECTION C**

8. Set forth the circumstances in which a Community Trade Mark may be:
- (a) Transferred; and
  - (b) Licensed
- and in each case identify the formal requirements that apply and the consequences (if any) of non-compliance.
9. Outline the circumstances in which decisions of OHIM in respect of Community Trade Marks can be appealed against and identify the tribunals to which such appeals lie.
10. 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.
- Carmore Creameries Limited is about to start production of a cheddar cheese which is to be called “Beskill”. Carmore 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.