

LAW AND PRACTICE OF TRADE MARKS

EXAMINATION PAPER 2011

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) *Masterfoods Limited v. Controller of Patents, Designs and Trade Marks* [2003] 3 IR 357.
 - (b) *Jacob Fruitfield Food Group Ltd v. United Biscuits (U.K.) Ltd* [2007] IEHC 368 (12th October 2007).
 - (c) *Sealed Air Corporation v. Controller of Patents, Designs and Trade Marks* (29th July 2003).
 - (d) *Allergan Inc. v. Ocean Healthcare Ltd* [2008] IEHC 189 (24th June 2008).
 - (e) *Compagnie Gervais Danone v. Glanbia Food Society Ltd* [2010] IESC 36 (Supreme Court, 19th May 2010)
2. The “*Fenit Fighters*” are an ice hockey team from County Kerry. When playing they wear blue costumes with the word “*FIGHTERS*” emblazoned across the front and back. Cobra Limited, the company which owns and manages the team, is the registered proprietor of the trade mark “*FIGHTERS*” which is registered in Class 25 for “*clothing, footwear and headgear*” and in Class 28 for “*toys, playthings and sports equipment*”. Perkow Toys Limited has launched a range of sporting action figures which include a set of dolls that represent three specific members of the “*Fenit Fighters*” team. The dolls (which are 20 centimetres in height) come with ice hockey equipment, including sticks, helmets and pads, and each is dressed in a replica of the “*Fenit Fighters*” costume worn by that team member. Accordingly, the costume bears the name and number of the player, but also the word “*FIGHTERS*” on the front and back.

Solicitors acting on behalf of Cobra Limited have written to Perkow Toys Limited threatening proceedings for trade mark infringement and passing off. On the assumption that the “*FIGHTERS*” trade mark has been validly registered and is not vulnerable to revocation, advise Perkow Toys Limited as to the strength or otherwise of the case against it and any specific defences which you believe may be of assistance.

3. While making detailed reference to relevant case law, discuss the nature and scope of the protection conferred by section 14(3) of the Trade Marks Act 1996 (as amended) and what must be established in order to invoke this provision successfully.
4. Explain whether (and if so to what extent):
 - (a) Shapes of goods;
 - (b) Personal names and surnames;
 - (c) Words in a foreign language; and
 - (d) The names of geographical locationscan be registered as trade marks.

SECTION B

5. Tysal Limited is an Irish registered company which is in the process of negotiating with a Padal SA, a French company, for sole distribution rights in Ireland of the latter’s 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. Tysal Limited is keen to ensure that if it obtains the distributorship which it seeks, its position in the Irish market is protected by means of a registered trade mark.

Advise Tysal Limited and Padal SA as to the most effective means of securing registered trade mark protection for “*Besqualle*” in Ireland and what formal agreements should be put in place between them in relation to any such registered trade mark.

6. (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.

7. Identify and discuss:

(a) The various matters regarding registered trade marks which are capable of being entered upon the Register of Trade Marks.

AND

(b) The function of the *Patents Office Journal* as regards trade marks and the various matters that are required to be published therein.

SECTION C

8. Write notes on **EACH** of the following in the context of the Community trade mark system:

(a) The preparation and submission of an application for a Community trade mark;

(b) Securing a filing date;

(c) Claiming and obtaining priority in respect of an earlier trade mark application; and

(d) Claiming and obtaining seniority in respect of an earlier registered trade mark.

9. Describe the function and parameters of the searches carried out in the context of an application for a Community trade mark.

10. Gulliva SpA is an Italian company which wishes to apply to register “*Gulliva*” as a Community trade mark in Class 38 for telecommunications. At present Gulliva SpA does not trade in Ireland, but it has a number of large multinational customers that have branches or subsidiaries in this country. Last month it discovered that an unconnected Irish company, Gulliver Limited, has been operating a shop in Dublin that sells and repairs mobile telephones and arranges for the installation of intercom systems in apartment and office blocks. Gulliver Limited has been trading in the Dublin area for three years and last year had an annual turnover of approximately €2,500,000.

Advise Gulliva SpA as to the relevance, if any, which Gulliver Limited's existence and activities will have in relation to its application for a Community trade mark and the respective rights which Gulliva SpA and Gulliver Limited would be able to assert if Gulliva SpA secured a Community trade mark for "*Gulliva*".