

LAW AND PRACTICE OF TRADE MARKS

EXAMINATION PAPER 2012

Time Allowed: 3 Hours

Candidates **MUST** answer **TWO** questions from Section A, **TWO** questions from Section B and **TWO** questions 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.

Any additional answers will be disregarded and **NOT** marked.

Candidates **MUST** obtain a pass mark in respect of **EACH** of the three Sections in order to gain an overall pass in respect of this examination.

SECTION A

1. Write notes on any **THREE** of the following cases:
 - (a) *Cofresco Frischalterprodukte GmbH & Co. KG v. Controller of Patents, Designs and Trade Marks* [2008] 1 IR 582.
 - (b) *McCambridge Ltd v. Joseph Brennan Bakeries* [2012] IEHC 368 (25th November 2011).
 - (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. Chuck Chaney has recently opened a restaurant in Donnybrook called “*THE MEMPHIS BISTRO*”. Last week he received a letter from solicitors acting for Koogal Limited, the registered proprietor of the trade mark “*MEPHISTO*” which, for the last six years, has been registered in Class 42 for “*catering and restaurant services*”. The letter states that the name “*THE MEMPHIS BISTRO*” is confusingly similar to “*MEPHISTO*” and that it constitutes both an infringement of the registered trade mark and passing off. Chuck has discovered that the only commercial activity undertaken by Koogal Limited in the State is the operation of a coffee shop in Temple Bar which, for the last four years, has traded under the name “*MEFISTO*”.

Advise Chuck as to the strength of the claims that are being asserted against him.

3. Outline and discuss the manner in which section 24 of the Trade Marks Act 1996 provides redress in the case of groundless threats of proceedings for infringement of a registered trade mark. Reference should be made to relevant decisions of the courts in Ireland, the United Kingdom and such other jurisdictions as are appropriate.
4. 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.

SECTION B

5. For ten years Safla Limited has manufactured washing powder which is sold in blue boxes. The company has a fleet of trucks by means of which it distributes its washing powder and these trucks are likewise painted blue. Safla Limited wants to register the colour blue as a trade mark.

Explain how you would go about preparing the application for registration, the precise subject matter which you would advise Safla Limited to register and the classes in respect of which registration should be sought.

6. Consider the role of limitations and disclaimers in achieving the registration of a trade mark.
7. (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) Alloy wheels for cars.
 - (ii) External hard drives for computers.
 - (iii) A lawn repair kit containing grass seed and fertiliser.
 - (iv) A lip filler for use in cosmetic surgery procedures.
 - (v) Services to be provided in a cosmetic surgery clinic.
8. Outline and discuss the operation of the Madrid Protocol.

SECTION C

9. 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.
10. Critically analyse, with reference to decided case law and relevant statutory provisions, the circumstances in which a parallel importer may apply a registered trade mark to goods without the consent of the registered proprietor of the mark.
11. Outline and discuss the steps to be taken in order to adduce evidence in support of a claim that the subject matter of an application for a Community Trade Mark has acquired distinctiveness through use and indicate the type and breadth of evidence typically required.
12. Funkmeyer Stinkleheim & Gassman are a long established and successful New York law firm who have built up connections with firms of lawyers throughout the world. Last year, on foot of applications made in 2008, they registered “FSG” and the “FSG” logo (which comprises a stylised intertwining of the three letters above a set of scales) as Community Trade Marks in respect of “*legal services*” in Class 42.

For the last ten years Francis S. Greenan has practiced as a solicitor in Waterford City. Both his notepaper and the sign outside his office bear the letters “FSG” along with a picture of a statue-like figure holding in one hand a sword and in the other a set of scales.

Last month it was announced that Funkmeyer Stinkleheim & Gassman were establishing a link with Kidder & Company, a large Dublin firm of solicitors. On visiting Kidder & Company’s website Francis S. Greenan discovered that they are now displaying the “FSG” logo registered as a Community Trade Mark by Funkmeyer Stinkleheim & Gassman. Francis S. Greenan has written to both Funkmeyer Stinkleheim & Gassman and Kidder & Company asserting that this amounts to passing off and a breach of his rights. Funkmeyer Stinkleheim & Gassman wrote back to Francis S. Greenan denying his claims and indicating that

the manner in which he has been carrying on business constitutes infringement of their Community Trade Marks.

Advise Funkmeyer Stinkleheim & Gassman.