

LAW AND PRACTICE OF TRADE MARKS

EXAMINATION PAPER 2016

Time Allowed: 3 Hours

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

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.

SECTION A

1. Write notes on any **THREE** of the following cases:
 - (a) *Falcon Travel Ltd v. Owners Abroad Group plc* [1991] 1 IR 175 (High Court – Murphy J).
 - (b) *The Irish Times Ltd v. Times Newspapers Ltd* [2015] IEHC 490 (High Court – Hedigan J).
 - (c) *Bus Eireann/Irish Bus v. Controller of Patents, Designs and Trade Marks* [2007] IEHC 221 (High Court – Laffoy J).
 - (d) *Aldi Stores (Ireland) Ltd v. Dunnes Stores (No. 2)* [2015] IEHC 551 (High Court – Cregan J).
 - (e) *Compagnie Gervais Danone v. Glanbia Food Society Ltd* [2010] 3 IR 711 (Supreme Court).

2. Aldos Motor Company manufactures luxury cars. It is the registered proprietor of the word mark ALDOS and a device mark consisting of a red letter A superimposed over a bolt of lightning. Both trade marks are registered in Class 12 for “*passenger vehicles and parts and fittings therefor*”. The company has discovered Hot Wheels Accessories Limited is offering for sale wide six-spoked wheels that are advertised as being “*the perfect enhancement for Aldos models*”. When a representative of Aldos Motor Company visited one of the shops operated by Hot Wheels Accessories Limited, he found on display a sample of a wheel in a matt-black finish (the wheels on Aldos models are not coloured in this way as the chairman views this new phenomenon as “*tacky*”, “*vulgar*” and “*the badge of a boy racer*”) and at the centre of the sample wheel there was a red letter A.

Advise Aldos Motor Company whether either or both of its registered trade marks have been infringed and the reasons for this advice.

3. While making detailed reference to relevant case law, consider the extent to which colours may be registered as trade marks.

4. While making detailed reference to relevant case law and statutory provisions, consider whether, and if so to what extent, ownership of an Irish registered trade mark provides a defence to:
 - (a) A claim for infringement of an earlier Irish registered trade;
 - (b) A claim for infringement of an earlier EU trade mark; and
 - (c) A claim for passing off.

SECTION B

5. You have a Client that is interested in filing an Irish Trade Mark Application for its new brand name EARTH which it intends to use in relation to its healthy food range.

Your Client asks you to undertake a quick search of the Irish and CTM (now called EUTM) Registers including the international register for marks designating Ireland or the CTM / EUTM. These initial searches reveal a number of marks, the most pertinent of which are as follows:

- A) Irish Trade Mark Registration No. 123456 SOIL covering various food products in Classes 29, 30 and 31 which proceeded through to registration in June 2015;
- B) Community / EU Trade Mark Registration number 7891234 EARTHEN covering retail services in respect of food and related goods in Class 35 which proceeded through to registration in January 2014; and
- C) Community / EU Trade Mark Registration No. 4563256 EARTHLY covering various food products in Classes 29 and 30 which proceeded through to Registration back in 2007. Brief Internet searches do not highlight any obvious use of the mark by the Proprietor.

You are asked to prepare a note to your Client discussing the results and whether the marks will impact on your Client obtaining a trade mark registration in Ireland. Where applicable, this note should mention any steps which could be taken to minimise/overcome any problems that may arise on the basis of these Registrations.

6. You are contacted by a new local Client who states that they would like a "world-wide" trade mark. You briefly explain that there is no such thing and the Client asks for you to prepare a note on the various filing options that are available and what might be an appropriate strategy for them. When preparing this note, bear in mind that the Client currently trades in Ireland and the UK but plans to expand its business to other European countries and further afield such as the United States, Australia and China.
7. You have a Client who is a clothing designer who wishes to urgently file an Irish Trade Mark Application to protect a new brand. Write a note detailing the

information you will need from him before an Application can be filed. This note should also include a brief outline for the Client of the various stages in the application process from filing to registration if everything proceeds smoothly.

8. You have received a notification from the OHIM / EUIPO advising that your Client's Community / EU Trade Mark Application BOREO, covering goods in Class 9, has been opposed by the owner of a French, German and Italian Registration for BOROH all covering overlapping goods in Class 9. You then receive the news that the Opposition has been deemed to be admissible.

You undertake some investigations into the Opponent and determine that they operate in the same industry as the Client but only operate in France, Germany and Italy. Your Client is only interested in the Irish, UK and Spanish markets.

Advise the Client of the various stages of the Opposition and the options available for addressing same, given that you believe that it is likely that the Opposition will be upheld.

SECTION C

9. Identify, analyse and discuss what you regard as the five most important changes introduced by Regulation (EU) No. 2424/2015.
10. While making detailed reference to the decision of Barrett J in *Glaxo Group Ltd v. Rowex Ltd* [2015] IEHC 368, analyse the circumstances in which an EU trade mark court ought to stay proceedings pursuant to Article 104 of Regulation (EC) No. 207/2009.
11. Scontow Inc. is a United States corporation that operates over 8,000 low-cost super markets throughout North America. It is considering an expansion into Europe and seeks your advice as to its trade mark strategy and in particular whether it could register SCONTOW as an EU trade mark in circumstances where it has been advised that "sconto" means "discount" in Italian. Advise Scontow Inc. on whether you see any potential difficulties and, if so, how they might be overcome.
12. Outline the time limits and procedures to be followed in order to oppose the grant of an EU trade mark.