

LAW AND PRACTICE OF TRADE MARKS

EXAMINATION PAPER 2017

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) *The Irish Times Ltd v. Times Newspapers Ltd* [2015] IEHC 490 (High Court – Hedigan J).
 - (b) *Glaxo Group Ltd v. Rowex Ltd* [2015] 1 IR 185 (High Court – Barrett J (First Judgment)).
 - (c) *Diesel SpA v. Controller of Patents, Designs and Trade Marks* [2016] IEHC 415 (High Court – Binchy J).
 - (d) *Allergan Inc. v. Ocean Healthcare Ltd* [2008] IEHC 189 (High Court – McGovern J).
 - (e) *Cofresco Frischalterprodukte GmbH & Co. KG v. Controller of Patents, Designs and Trade Marks* [2008] 1 IR 582; [2007] 2 ILRM 430 (High Court – Finlay Geoghegan J)
2. Whacky Bakeries is the registered proprietor of the trade mark ENERPANNE which is registered in Class 30 for bread. It sells sliced bread under this mark in red wrappers. Last month it discovered that a competitor, Ballygrove Granary Limited, has started selling a loaf of sliced bread in a light blue wrapper, bearing drawings of a hurler, a runner and a tennis player, with the following script:

Ballygrove Granary

- ENERGY PAN -

Advise Whacky Bakeries its registered trade mark has been infringed and any potential grounds of defence that might be deployed by Ballygrove Granary Limited. (NOTE: Advice on the issue of passing off is not required).

3. Outline and discuss the extent to which designations of origin or geographical indications may provide a basis for opposing the registration of a trade mark.

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. Your client is Romano S.R.L. ("Romano"), an Italian clothing manufacturer. Romano is the proprietor of Irish Trade Mark Registration No. 513734 BRADA.

The details of the Irish Trade Mark Registration are:

Mark: BRADA

Status: Registered

Publication of Registration Date: 03 February 2006

Proprietor: Romano S.R.L

Class 25: Clothing; footwear; headgear.

Romano has been selling a wide range of clothing and related accessories such as T-shirts, trousers, jeans, scarves, hats and shoes in Ireland since 2006. All of the goods sold feature the BRADA mark prominently.

You have been informed that Romano has become aware of an Irish company named Braada Ltd. The company was incorporated in 2010. Prior to 2017, the company only sold household goods such as beds and sofas; however in the past two months it has expanded its range of products to include clothing.

Romano has noticed that two weeks ago Braada Ltd. filed an Irish trade mark application for the mark BRAADA. The application covers "Shirts, T-Shirts, ties, dresses, skirts, socks, headbands and caps" in Class 25.

Romano has sought your advice as to what it can do to prevent Braada Ltd's application proceeding to registration.

Advise Romano as to when it can file opposition against the pending application and give an outline of the opposition procedure. You should also advise Romano on the prospects of the opposition being successful.

6. Your client is Plato Limited, an Irish company. Your client owns an Irish Trade Mark Registration for the mark ATLANTIS. The mark is registered in respect of "Jewellery, precious stones and semi-precious stones" in Class 14 and the publication of the registration date is 10 February 2015.

For the past couple of years, your client has been focusing its efforts on developing its jewellery business in Ireland. However, it now wants to expand its

business overseas. Your client is keen to open retail outlets in the United Kingdom, Spain, Portugal, Italy, Germany, Denmark, France, Poland, Russian Federation, Switzerland and Norway.

Advise your client on the different options available to it to protect its mark in the above territories. You should explain all of the available registration options but keep in mind that your client is very cost conscious and would like to proceed in the most cost effective way possible.

7. Your client, Superowls Limited, a UK company, is the proprietor of an International registration in respect of the Trade Mark SUPEROWLS which covers towels and is based on a corresponding European Union registration. Your client's International registration has an effective date of 14 January 2014, and designates the United States. The SUPEROWLS trade mark has not as yet been used in the United States but there are plans to commence use of the trade mark there by the end of 2017. On 16 April 2016, Supatowels GmbH., a German Company, filed an application to invalidate your client's European Union registration based on Supatowel's prior German, Italian, Romanian and Austrian registrations of the Trade Mark SUPATOWELS covering the identical goods. The invalidity action was successful and your client's European Union registration was invalidated on 28 February 2017. Your client is not going to appeal against the outcome of the invalidity action. Supatowels GmbH filed an application to register the Trade Mark SUPATOWELS in the USA on 3 March 2017.

With specific reference only to your client's International registration, what are the issues involved for your client in the United States and what action would you recommend that your client takes in the light of the invalidation of your client's European Union registration, referring to any relevant deadlines.

8. Your client, Brightwhite Ltd., has designed a range of children's toothbrushes with handles shaped like various animals. The handles look very different from anything else currently available on the market. They have been selling the toothbrushes in Ireland, the UK and Germany for 4 months and the designs have generated a significant amount of interest in dental hygiene product circles across Europe. They come to you for advice as to how they may best protect their designs. They tell you that while their toothbrushes have conventional rectangular head ends (the part with the bristles) there are several other options (rounded end, oval shaped, angled head, etc.) and they are particularly concerned that competitors may produce toothbrushes which copy the Brightwhite handle designs but have differently shaped heads.
 - a. Advise Brightwhite Ltd. as to what protection they may already have for their designs. Outline any limitations of that protection. Advise whether such protection would cover a toothbrush which copies the design of Brightwhite's handle but which has a very different head end.
 - b. Advise Brightwhite Ltd. as to what action they could take to improve their position in terms of protection for (i) the overall designs of the toothbrushes and (ii) the designs of the handles specifically. Outline the advantages of taking any such action.

SECTION C

9. Identify, analyse and discuss what you regard as the five most important changes introduced by Regulation (EU) No. 2424/2015.
10. Outline the circumstances in which decisions of EUIPO in respect of EU Trade Marks can be appealed against and identify the tribunals to which such appeals lie and the procedures to be followed.
11. For the last 10 years Gripper Limited has sold motorcycle tyres in the United Kingdom, Ireland, Belgium, Germany and Austria under the name GRIPPER. It wishes to register GRIPPER as an EU trade mark in Class 12 for tyres for vehicles and seeks your advice as to whether it needs to demonstrate that GRIPPER has acquired distinctiveness through use and, if so, the information that it would need to produce in order to do so.
12. Outline and discuss the criteria by reference to which a non-registered trade mark or sign used in the course of trade will be adjudged to be "*of more than mere local significance*" for the purpose of Article 8(4) of Council Regulation (EC) No. 207/2009.