

LAW AND PRACTICE OF TRADE MARKS

EXAMINATION PAPER 2019

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) *Nutrimedical BV v. Nualtra Ltd* [2017] IEHC 253 (High Court – Twomey J).
 - (b) *McCambridge Limited v. Joseph Brennan Bakeries* [2014] 1 IR 172 (High Court – Charleton J – Account of Profits).
 - (c) *Allergan Inc. v. Ocean Healthcare Ltd* [2008] IEHC 189 (High Court – McGovern J).
 - (d) *Compagnie Gervais Danone v. Glanbia Food Society Ltd* [2010] 3 IR 711 (Supreme Court).
 - (e) *Glaxo Group Ltd v. Rowex Ltd* [2015] 1 IR 185 (High Court – Barrett J – Stay Issue).
2. 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.
3. Set out the time limit governing the making of an appeal to the High Court under section 79 of the Trade Marks Act 1996 (as amended), the procedure to be followed in order to make such an appeal and the basis upon which such an appeal is conducted.
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 acquired a new client Memco Ltd, manufacturers and sellers of a range of cosmetics in Ireland since 2010. Memco Ltd are the proprietors of an Irish trade mark registration for the mark COZMETICO in class 3, registered in July 2012. Memco Ltd have recently filed a new application for the device mark below:-



Mark:
Date of Application: 10 March 2019
Class: 3
Goods: skincare preparations; cosmetics and related accessories.

Memco Ltd have received an examination report from the Irish Patent Office. An objection has been raised under Section 10 of the Trade Marks Act 1996 based on the following mark:

European Union Trade Mark

Mark: COSMETTICO
Status: Advertised
Date of Application: 1 February 2019
Date of Publication: 2 April 2019
Class: 3
Goods: Skincare preparations; cosmetics; essential oils.

The Irish Patents Office have also stated that it will be necessary to formally agree to an entry in the Journal and Register of a disclaimer of the words "Make up made easy".

Finally the Irish Patents Office have raised an objection under Section 39(2) stating that the term "related accessories" is vague and imprecise and could be appropriate to more than one class. Memco Ltd have clarified that in terms of accessories, they manufacture and sell a range of make up applicators, sponges and brushes, eye lash curlers along with make up mirrors and make up bags.

Memco Ltd have requested that you assume responsibility for the application and provide a letter of advice explaining the reasons and nature of the objections raised. They have also requested advice on all of the options available to overcome the objections raised and progress the application through to registration.

6. Your client, an Irish company by the name of Valentos Limited is the owner of an EU Trade Mark Registration for the Trade Mark VALENTOS which was registered on 20 January 2019 in respect of “Leather and imitations of leather; luggage and carrying bags; handbags; purses” in Class 18. It is using the Trade Mark in respect of “handbags and purses” in Ireland in the following manner:



Your client has received a letter directly from an Irish company drawing their attention to an Irish Trade Mark Registration for the Trade Mark VALENTINOS which was registered on 14 February 2017 in respect of “articles of clothing; footwear and headgear” in Class 25. They also point out that they use the mark as follows:



The letter expresses concern and requests that your client ceases use of the Trade Mark in Ireland and requests an undertaking that they will not use the Trade Mark in Ireland.

You are asked to advise your client about what they should do and provide advice as to what causes of action may be taken against them, if any, and the basis of any such actions. Set out the reasons for your advice and also identify any additional information you may require.

7. You have received a notification from the Irish Patents Office, under Rule 18, enclosing a Notice of Opposition, advising that your client's Trade Mark Application BeeLite, a word mark application filed on 1 November 2018, covering goods in Classes 2 and 16, i.e., "paints, varnishes and colourants" in Class 2, and "paintbrushes" in Class 16, has been opposed by the owner of a EU registration for Belight registered 1 March 2014, covering overlapping goods in Class 2, "paints, varnishes, lacquers; colourants; coatings; wood stains."

Advise your client of the various stages of the Opposition, giving an outline of the opposition procedures and deadlines. Set out the nature of the materials and/or evidence which they would typically utilise in response to an opposition, and the options available to them for addressing any materials and/or evidence supplied by the opponents. You should also briefly advise your clients on the prospects of their application being successful.

8. Your client, Kidzap plc, develops apps and games for children. Eight months ago it released a game called Flutter, whose main character (Flutterface) is a stylised head in the shape of a butterfly. The image is used within the main icon for the app (Fig. 1), and appears on the various app stores where the game is distributed as well as on Kidzap's own site, flutter-game.eu. Your client assures you that the employee who designed this stylised head image is unaware of having been inspired by or having seen any similar image before creating the design.

Noting that the game had become very successful, and to capitalise on the success, four months ago Kidzap started selling on its website ornamental novelty badges (Fig. 2) and t-shirts (Fig. 3) bearing the Flutterface image (shown below). Sales of these products have grown virally with demand coming from across the EU.

Your client has become aware in recent weeks of two unauthorised uses of the Flutterface image: (a) a Danish dairy company called Mooberry has started selling in Denmark a strawberry milk drink branded with the same image (Fig. 4); and (b) an Italian clothing website (www.copy.it) is selling ties bearing your client's image (Fig. 5). Both products were launched after the app became a top ten download in the main app stores. Neither the Danish nor Italian companies are making any use of the word Flutter (or any similar name).

Your client has not yet taken any steps to register any form of IP right. With reference only to EU trade mark and EU design rights (ignoring in particular copyright, and passing-off or similar causes of action), advise your client how it might maximise its IP position and, having done so, which trade mark and design rights it might be able to assert against Mooberry and www.copy.it.



Fig. 1: Client's app & web icon



Fig. 2: Client's badge



Fig. 3: Client's T-shirt



Fig. 4: Strawberry milk sold by Mooberry

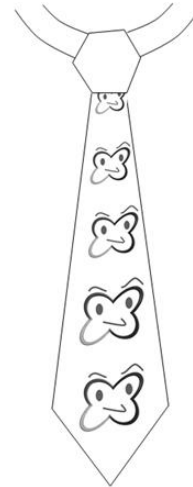


Fig. 5: Tie sold on www.copy.it

SECTION C

9. Set out the various procedural avenues available to a party who wishes to invalidate an EU trade mark.
10. Outline the steps to be taken in order to adduce evidence in support of a claim that the subject matter of an application for an EU trade mark has acquired distinctiveness through use and indicate the type and breadth of evidence typically required.
11. Explain the rules for determining which court(s) have jurisdiction in respect of the infringement of an EU trade mark.
12. Discuss, with reference to decided case law and relevant statutory provisions, the exhaustion of rights doctrine insofar as it applies to registered trade marks.