

LAW AND PRACTICE OF TRADE MARKS

EXAMINATION PAPER 2021

Time Allowed: 3 Hours and 20 minutes

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. 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.
(20 marks)
2. For the last fifty years Top Beverages Limited has manufactured and sold lemonade under the trade mark SPEF, which is registered in Class 32 for soft drinks. The lemonade is sold in blue cans and in clear plastic bottles with a blue label, and in both regular and sugar-free versions. Last month Healthy Vibe Limited launched a range of high energy drinks aimed at athletes under the brand name SPEV-E. These drinks are sold in bio-degradable cartons which are green in colour. Top Beverages Limited wrote to Healthy Vibe Limited complaining of what it regarded as a clear infringement of its registered trade mark and passing off. However, Healthy Vibe Limited's response rejecting these complaints contended that the respective products did not taste the same, their packaging was visually dissimilar and they were aimed at different markets. Top Beverages Limited has sought your advice as regards the strength of its claims for trade mark infringement and passing off and how it should respond to the contentions raised by Healthy Vibe Limited.
(20 marks)
3. Examine the most prudent way(s) of communicating in writing on behalf of a trade mark owner who wishes to assert its rights without triggering potential liability for groundless threats under section 24 of the Trade Marks Act 1996.
(20 marks)
4. While making detailed reference to relevant case law, outline and discuss:
 - (a) The provisions of the Trade Marks Act 1996 that deal with removal of a trade mark from the register on the grounds of non-use.

AND

- (b) The use requirements necessary to avoid a trade mark being removed from the register on the grounds of non-use.

(20 marks)

SECTION B

5. You have recently filed an Irish Trade Mark Application for your client Deltoid Limited a firm of Irish Architects and Interior Designers operating in Dublin, Cork and Galway since 2014. You have filed the application in relation to the logo set out below and the examination report has now issued from the Irish Patents Office.



Mark:

Date of Application: August 10, 2020

Class: 42

Goods: *Architecture; Interior design services*

An objection has been raised under Section 10 of the Trade Marks Act 1996 based on the following:

European Union Trade Mark:



Mark:

Proprietor: Perfect House GmbH
Status: Registered
Date of registration: January 10, 2015
Class 20: 20: “Furniture; beds, bedding, blinds”
Class 42: 42: “Furniture design services”

Irish Trade Mark:

Mark: howse
Proprietor: Paul Byrne
Status: Advertised
Date of publication: August 20, 2020
Class 42: 42: “Architectural services; interior design services”

A brief internet search highlights that Paul Byrne is a former distributor of your client Deltoid Limited.

Draft a letter of advice to your client explaining the nature of the objection raised, outlining all the options available to the client and suggest a course of action for dealing with the cited trade marks and mention any other potential action which the client could consider taking at this stage.
(20 marks)

6. A Client has asked you to carry out a full availability Trade Mark clearance search in Ireland for the Trade Mark BINBOMB for a ‘*liquid cleaning capsule for bins*’. Firstly, what Nice classes would you include in your search and what trade mark databases would you search?

The results of the searches revealed the following Trade Marks:

- BINKLEAN covering the goods ‘*bin deodorant pellets*’ registered on 16 February 2007. A brief Internet search shows no current use of the Trade Mark.
- BINBAGG logo covering the goods ‘*bags of plastics for lining refuse bins*’ registered on 6 October 2016. A brief Internet search shows that the mark is currently in use.

- BIMBO covering the goods '*hand cleaning preparations*' registered on 16 December 2016. A brief Internet search shows the trade mark is being used.
- BINBLAST covering '*cleaning services*' registered on 20 January 2015. A brief Internet search shows that the mark is currently in use and the owner has been using the mark since January 2018.

Please let the Client know if the Trade Mark BINBOMB is free for use and registration in Ireland in relation to the goods '*liquid cleaning capsules for bins*' and explain why.

(20 marks)

7. Your client, an Irish company by the name of Freshen and Go Limited is the manufacturer and seller of a range of cosmetics, toiletry preparations, perfumes, deodorants, essential oils and soaps "and is the owner of the following Trade Mark Registrations, both for the Trade Mark FRESHGO.

Irish Trade Mark Registration No. 345620 registered on 22 April 2010 in respect of "Non-medicated cosmetics and toiletry preparations; perfume; deodorants; essential oils; soaps" in Class 3, and

EU Trade Mark Registration No. 0003567280 registered on 14 June 2016 in respect of "Non-medicated cosmetics and toiletry preparations; perfume; deodorants; essential oils; soaps" in Class 3.

Your client is using the Trade Mark in respect of "perfumes, deodorants, body sprays and soaps".

It has come to your client's attention that an Irish Company by the name of Fresh and Go Ready Limited is using the Trade Mark FRESH AND GO READY in respect of "pharmaceutical preparations and sanitary preparations".

Based on information available to your client, it is believed that the products are manufactured in Ireland and exported to Italy.

Your client has expressed concern and has asked you to advise your client about what they should do and provide advice as to what causes of action may be available to them, if any, and the basis of any such actions.

You should identify the possible causes of action available, if any, the basis of such actions and set out the reasons for your advice and also identify any additional information you may require.

(20 marks)

8. Your client has designed a new chess set, shown in Fig. 1. The pieces are designed to fit together within a box with all of the pieces of one colour (white or black) interlocking to fill a layer with no gaps (Fig. 2). The pieces are shown individually in Figs. 3-8.

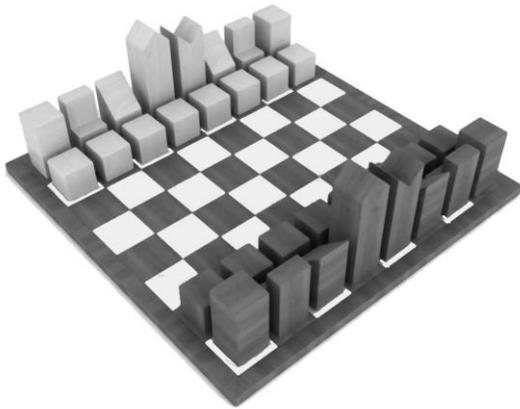


Fig. 1

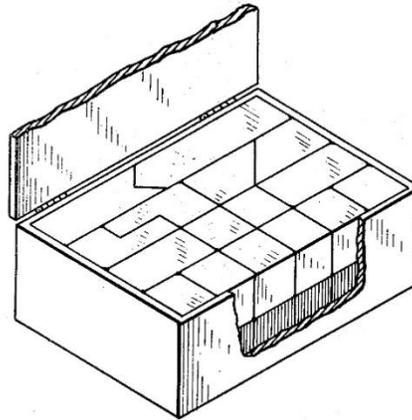


Fig. 2

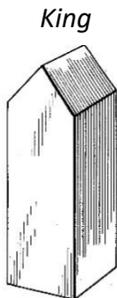


Fig. 3

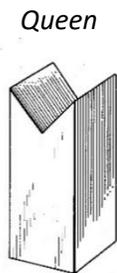


Fig. 4

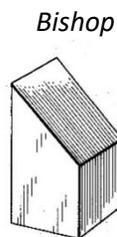


Fig. 5

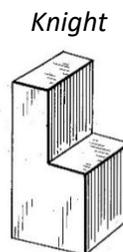


Fig. 6

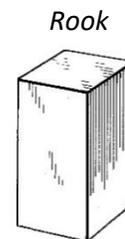


Fig. 7

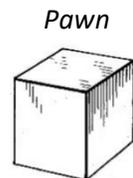


Fig. 8

On investigation, for each individual block shape you are able to find examples of known blocks with the same shape, whether as wooden or plastic building blocks, plastic building blocks, masonry blocks used in construction, etc. However, despite extensive searching you do not find any examples of chess pieces with any of these shapes.

The client informs you that their main market will be the continental EU countries (France, Germany, Netherlands, Poland). They expect to build a smaller market in the UK and Ireland. They have not yet launched their product. They plan to reveal the chess set for the first time at a trade show running alongside one of the major chess tournaments over coming months. They are considering events in Chicago, London and Stockholm for the launch.

The client asks for advice on the following questions:

1. Can they validly register the design of the chess set as a whole, as shown in Fig. 1 or 2?
2. Can they validly register the designs of the individual pieces shown in Figs. 3-8?
3. Can they validly register the 3D shapes of the pieces as trade marks?

4. On what basis would they be entitled to unregistered Community design rights, and how long would such rights last?
(20 marks)

SECTION C

9. In the light of the decision of the CJEU in Case C-482/09 *Budejovicky Budvar NP v. Anheuser-Busch Inc* (22 September 2011) and any other case law that you regard as relevant, consider the extent to which EU trade mark law recognises concurrent use as a factor relevant to the registrability of a trade mark.
(20 marks)
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.
(20 marks)
11. Fashtrend Limited is an Irish registered company and owns an EU Trade Mark for BYBELOT which is registered in Class 25 for clothing. The brand is highly successful and is used by Fashtrend Limited in respect of a range of expensive clothes aimed at teens and young adults. Fashtrend Limited has recently learned that the websites www.bybelotselect.ie and www.bybelotselect.com are offering counterfeit BOBELOT clothing. Investigations have revealed that both websites are owned by Almet Bazwal, a German citizen with an address in Turkey. Test purchases on both websites have been conducted by Fashtrend Limited, with goods that were ordered being sent by post to the home address of one of its employees in Dublin. On delivery it was found that these goods had been sent from Morocco. Fashtrend Limited wishes to sue Almet Bazwal for trade mark infringement before the Irish courts and seeks your advice as to whether it can establish a jurisdictional basis for doing so.
(20 marks)
12. Outline the circumstances in which an EU Trade Mark court should stay infringement proceedings.
(20 marks)