

LAW AND PRACTICE OF TRADE MARKS

EXAMINATION PAPER 2022

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. Discuss the decision of the Irish Supreme Court in *Merck Sharp and Dohme Corporation v. Clonmel Healthcare Ltd* [2020] 2 IR 1 and consider what implications, if any, this decision has for the availability of interlocutory injunctions in actions concerning the infringement of trade marks and passing off.
2. For over 80 years three separately owned creameries in the vicinity of the village of Ballyfengan in County Cork have produced a soft blue cheese. This cheese is known as "*Ballyfengan Blue*" and is made according to a traditional local recipe. The cheese has been sold throughout Ireland and generates total sales of more than €22 million each year. No registered rights exist in respect of the name "*Ballyfengan Blue*". The Tozos supermarket chain has started selling blue cheese, which is produced in Denmark, under the name "*Ballyfinan Blue*" in its stores in Cork, Dublin, Galway, Limerick and Sligo. An employee of Tozos invented the name "*Ballyfinan*" and there is no such place in Ireland or Denmark. Kilty Creamery Limited, which is one of the three creameries that produces "*Ballyfengan Blue*" and holds approximately 20% of the overall market in the State for that product, seeks your advice as to whether it can successfully bring passing off proceedings against Tozos.
3. Consider the extent to which evidence as to the results of surveys can support a claim as to a likelihood of confusion on the part of the public and indicate how you would go about adducing such evidence in the most effective manner possible.
4. While making detailed reference to relevant case law, outline and discuss the criteria for determining whether there is similarity of goods or services for the purposes of sections 10(2) and 14(2) of the Trade Marks Act 1996.

SECTION B

5. You have been contacted by a new client, The Dublin Whiskey Company Limited, based in Dublin, who self-filed an Irish Trade Mark Application for the Mark DUBLIN'S BEST, for the following goods and services:

Class 33: "whiskey and gin"

Class 35: "shops, off-licences, and retail services"

Your client has received a letter from IPOI, objecting to the Application on the grounds that the Mark is:-

- (a) Devoid of distinctive character, and consists exclusively of signs or indications that designate the quality, and/or geographic origin of the goods and services;
- (b) Confusingly similar with an earlier Irish Trade Mark Registration for DURNAN'S BEST, registered for "mineral waters, spring waters" in Class 32, which registered in 2002; and
- (c) An objection on the basis that the Class 35 services are insufficiently clear, or precise.

Advise your new client of the various options available to them for addressing the three objections arising. You should also briefly advise your clients on the prospects of their application being successful.

6. Your client, an Irish company by the name of Bish Bash Bosh Limited owns and runs a number of retail outlets in Ireland under the Trade Mark BISH BASH BOSH and sells a range of clothing. It is the owner of the following Trade Mark Registration:

EU Trade Mark Registration No. 001256789 BISH BASH BOSH registered on 22 April 2021 in respect of "Retail services connected with the sale of clothing, footwear and headgear" in Class 35.

The manner in which your client actually uses its Trade Mark in relation to the retail outlets is as follows:



Your client has received a letter from the representatives of an Irish company called Bish Bosh Limited who are the owners and Registered Proprietor of an Irish Registration for the Trade Mark BISH BOSH, details of which are as follows:

Irish Trade Mark Registration No. 345782 BISH BOSH registered on 14 June 2016 in respect of:

Protective clothing; protective footwear; in Class 9

Leather and imitations of leather; luggage and carrying bags; handbags, purses, umbrellas and parasols in Class 18

Articles of clothing, footwear and headgear in Class 25

They claim to use the Trade Mark in the following manner:



The letter requests that your client ceases use of the Trade Mark BISH BASH BOSH and the company name Bish Bash Bosh Limited.

Your client has asked you to advise them as to the causes of action available to the other party, if any, and what is the strength of its position, or otherwise and what can be done in relation to the letter it has received.

You should identify the possible causes of action available to the other party, if any, the basis of such actions, your client's position and set out the reasons for your advice. You should also identify any additional information you may require to provide fuller advice based on your initial assessment and advice.

7. Your client SuperBru Limited has been operating a brewery in Cork since 2010. Your client holds an existing Irish Trade Mark Registration for the word mark SUPERBRU in Class 32 covering "beer" and registered in 2012.

Your client has recently expanded their operations to include a distillery for a range of spirits and is opening new premises in Cork. The new premises will operate as both brewery and distillery and there will also be a shop on site and regular whiskey and spirit tasting events. The launch of the new premises will coincide with a rebranding



of the SUPERBRU Trade Mark with the logo although the logo will also appear in the colour green from time to time.

You have been asked to carry out searches in order to check the availability for use and registration of the SUPERBRU Trade Mark in Ireland for the expanded range of goods and services. The searches have identified the following Trade Marks:

➤ **EUTM Application**

Trade Mark:	SUPPERBREW
Classes:	32 "Beer" 35 " <i>Retail services in respect of alcoholic beverage, beers</i> "
Status:	Advertised
Publication Date:	March 25, 2022

➤ **EUTM Registration**

Trade Mark:	STUPERBREW
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Classes: 32 "*Beer*"
33 "*Alcoholic beverages*"
Status: Registered
Registration Date: April 9, 2015

➤ **Irish Trade Mark Registration**

Trade Mark: SuperBrutal
Classes: 33 "*Wine; Spirits*"
43 "*Restaurant services*"
Status: Registered
Registration Date: September 22, 2008

Draft a report of the search results to the client assessing the risk if any, posed by each of the Trade Marks listed above. The report should address any problems that may arise based on the existence of these earlier trade marks and any steps which could be taken to overcome any such problems. Please include proposed filing particulars on the basis of the information provided and your assessment of the search results.

8. In parts (a) and (b) below, you should confine your advice to protection via unregistered and registered design rights, and in part (c) you are additionally asked to consider the potential co-existence of design rights with trade mark rights. No marks are awarded for discussing potential patent or copyright protection.
- a) Company A makes cardboard boxes. In order to strengthen their boxes, they have designed a box with walls made from a double thickness layer of corrugated cardboard. All other features of the box are entirely conventional. The only purpose of using double-thickness walls is the increased strength, and the feature was not added for any visual or aesthetic reasons. Nevertheless, the double-thickness walls are readily visible to a user of the box, and they make a different overall impression on the user compared to conventional boxes. Can this new box design (which has not yet been disclosed) be validly protected by Irish or Community design rights?
 - b) Ms. B is a fashion designer who launched her summer collection in a local boutique in Limerick four weeks ago week. The highlight was a summer dress made from a distinctive striped fabric, and having visually distinctive styling details on the pockets and along the hem. Ms. B advises that while the individual elements of her design (striped fabric, pocket details, hem details) can be found in different known dresses, she is certain that there is no existing dress with these elements combined in this way. Assuming she is correct, can she protect the design of her dress and what protection is available to her in this regard?
 - c) Mr. C owns a chain of pubs. He has designed a logo for his businesses which is distinctive in the hospitality field, and appears to be quite different from any other logo he could find in extensive searching. Having been advised that registered trade mark protection is available, he now wonders if he could secure design rights for something as abstract as a logo used in the service industry (he will not be selling any products bearing this logo). Advise him, giving reasons, whether such protection can be obtained, and if so whether such rights could be obtained in addition to a trade mark registration.

SECTION C

9. (a) Set out the procedural steps which must be followed in order to oppose the registration of an EU trade mark.

AND

- (b) Set out the appellate structure and the possible bases for appeal in respect of such an opposition.
10. Outline and discuss the steps to be taken in order to adduce evidence in support of a claim that the subject matter of an EU trade mark has acquired a reputation in the European Union for the purposes of Article 9(2)(c) Regulation (EU) 2017/1001 and indicate the type and breadth of evidence typically required.
11. Fashtrend Limited is an Irish registered company that manufactures and sells running shoes under the brand name SCARPER. It has successfully sold such shoes under that brand in Ireland and the United Kingdom for the last 12 years. It is keen to expand its market into mainland Europe and, with this in mind, wishes to apply to register SCARPER as an EU trade mark in Class 25 for clothing and footwear. The Italian word for shoes is "*scarpe*" (pronounced "*scar-pay*"). You have been asked to advise as to whether this might constitute an impediment to registration and, if so, how this could be overcome.
12. Outline the rules for determining which court(s) have jurisdiction in respect of the infringement of an EU trade mark.