

LAW AND PRACTICE OF TRADE MARKS

EXAMINATION PAPER 2018

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) *Metro International SA v. Independent News & Media plc* [2005] IEHC 309 (High Court – Clarke J).
 - (b) *Bayerische Motoren Werke Aktiengesellschaft v Ronanyne* [2013] IEHC 612 & [2014] IEHC 210 (High Court – Ryan J).
 - (c) *Nutrimedical BV v. Nualtra Ltd* [2017] IEHC 253 (High Court – Twomey J).
 - (d) *Aldi Stores (Ireland) Ltd v. Dunnes Stores* [2017] IECA 116 (Court of Appeal).
 - (e) *McCambridge Ltd v. Joseph Brennan Bakeries* [2012] IEHC 368 (Supreme Court).

2. Baldricka Inc. is a United States corporation which manufactures designer clothing under the trade mark BALDRICKA. In 2005 it commenced discussions with Barney Burns, a Monaghan based businessman, about granting to him an exclusive distributorship for its clothing in Ireland. However, it was not possible to conclude an agreement and, following the economic crash in 2008, Baldricka Inc. decided not to launch its products in Ireland. In the last year Baldricka Inc. has revisited the possibility of launching its products in Ireland, but has discovered that Barney Burns registered BALDRICKA in Class 25 in 2007 while he was still in discussions with Baldricka Inc. When Baldricka Inc. wrote to Barney Burns three months ago to complain about this and demand that he assign the trade mark to it, he refused and responded that he was perfectly entitled to obtain the registration as he had intended to operate a business connected to that brand and furthermore that he was now about to launch his own range of clothing under the name BALDRICKA. Baldricka Inc. has since discovered that Barney Burns is offering cheap sports and leisure apparel bearing the name BALDRICKA (that does not emanate from Baldricka Inc.) for sale on the website www.americantrends.ie.

Baldricka Inc. has sought your advice as regards whether it can prevent Barney Burns from using the BALDRICKA name in Ireland and either invalidate or secure the revocation of the Irish registered trade mark BALDRICKA owned by him.

3. Outline and discuss by reference to relevant case law and statutory provisions the civil remedies available in the event of registered trade mark infringement being established.
4. Consider the circumstances in which colours may be registered as trade marks, any factors that might impede such registration and any means that might be employed to overcome such difficulties.

SECTION B

5. Your client Pam Street Trading Limited is a manufacturer of clothing and shoes under the brand GLAMWEAR and your client's range of goods are available in a number of boutiques and department stores throughout Ireland. Your client's GLAMWEAR range of clothing and shoes launched in Ireland in 2010 and has been continuously used since that date.

You have recently filed an Application for the GLAMWEAR Trade Mark in Class 25 on behalf of your client. The Application has now been examined by the Irish Patents Office and an examination report has issued.

An objection to registration has been raised under Section 8(1)(b), 8(1)(c) and Section 10 of the Trade Marks Act, 1996.

With respect to the objection raised under Section 10, the Irish Patents Office has cited the following Trade Marks:-

Irish Trade Mark Registration

Mark:	GLAM-R
Status:	Registered
Publication of Reg Date:	March 11, 2011
Class:	35
Services:	<i>Retail and wholesale services in relation to clothing, footwear and headgear</i>

EU Trade Mark Registration

Mark:	GLAMWARE
Status:	Registered
Registration Date:	May 6, 2016
Class:	25
Services:	socks; tights; hosiery

Draft a letter of advice to your client reporting the examination of their application, explaining the nature of the objections raised under Section 8(1)(b) and 8(1)(c) and also commenting on the cited Trade Marks raised under Section 10. All options in terms of overcoming the various objections should be outlined to the client and you

should also advise Pam Street Trading Limited on the likelihood of overcoming the objections raised.

6. On 24 November 2017, Kenanto Limited (hereinafter called 'the Applicant') of Ranelagh Avenue, Dublin 6, Ireland, made application under Section 37 of the Trade Marks Act, 1996 to register 'ONE PIZZA' as a Trade Mark in respect of '*pizza shops, pizzerias, pizza restaurants, pizza takeaways*' in Class 43.

Advertisement of the acceptance was published in Journal No. 2355 on Wednesday 21 March 2018.

Your Client, Number One Pizza Limited, is the proprietor of the Trade Mark NUMBER ONE PIZZA covering '*Pizzas, sandwiches, food preparations*' in Class 30 and was registered on December 31, 2000. Number One Pizza Limited has been selling its pizzas in Ireland under the Trade Mark NUMBER ONE PIZZA since 2001.

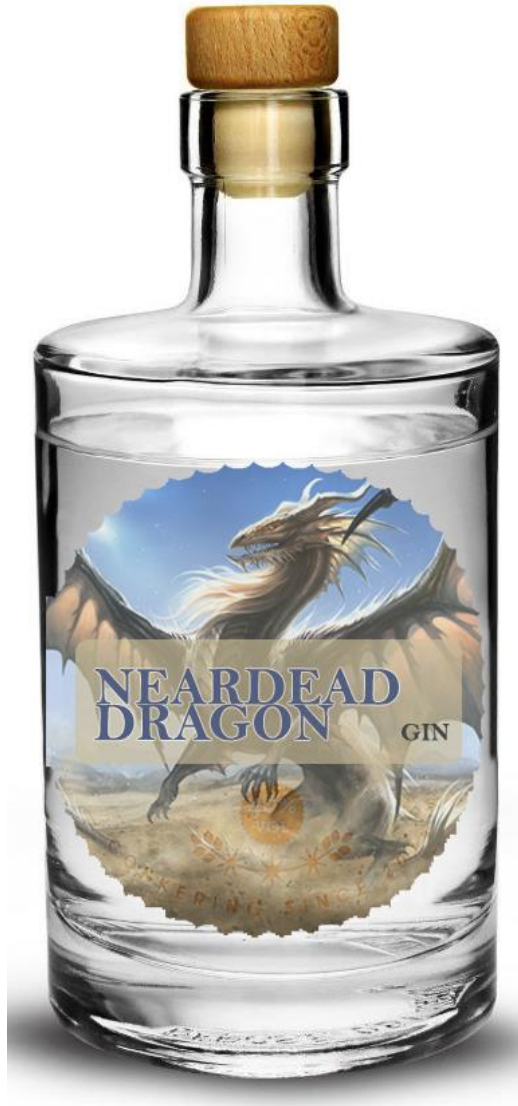
Number One Pizza Limited has sought your advice as to what it can do to prevent the application for the Trade Mark 'ONE PIZZA' from proceeding to registration. Advise Number One Pizza Limited as to what steps it can take, the deadline for doing so and the prospects of an opposition being successful. Furthermore, set out the Statement of Grounds your client can rely on.

7. Your client is a designer who brings you a portfolio of designs. Advise the client, in respect of each design, whether it can be protected by registered or unregistered design rights in Ireland. Ignore any other forms of IP such as patents or copyright.
 - a) A watering can having a novel shape based on a stylized raindrop. The shape makes a different visual impression from other products known to the client. The client advises you that he sold a limited number of samples at a gardening trade show in Frankfurt 14 months ago.
 - b) A logo for a software program called ZenDraw, which will also be used as an on-screen desktop icon. The logo is an original design of an intertwined "Z" and "D" superimposed on a chequered background. It has not yet been disclosed.
 - c) A thermostat housing which has been designed for the interior of an oven. It will be hidden inside the oven when the oven is in normal use.
 - d) A mug with an unusually shaped swan-neck handle and an unusually shaped octagonal, tapering body. The client advises that the handle makes the same overall impression on the informed user as a handle of a known teacup (whose body is quite different) while the mug's body shape makes the same overall impression as another known mug (whose handle is conventional). The client has searched extensively but has not found any mug with a similar combination of handle and body.
 - e) A decorative swirl pattern for a javelin. The client admits that it is an almost identical revival of a javelin design which was used in the 2008 Beijing Olympics but which was not subsequently commercialised. No such javelins have ever been made, used or sold in the EU or EEA.

8. Dragon Brewery Limited is the registered proprietor of the trade mark BEARDED DRAGON which is registered in Ireland in Class 32 for “beers, craft beers”. The Trade Mark was registered on 20 April 2015. The company sells its products in the manner shown below:



It has recently discovered that a competitor, Dragon Spirits Limited, who has only recently been incorporated, has started selling “gin” in Ireland under the Trade Mark NEARDEAD DRAGON. It sells its products in the manner shown below:



Advise Dragon Brewery what action can be taken against Dragon Spirits, if any, setting out the reasons for your advice, the information you may require and the basis upon which any action may be taken.

SECTION C

9. Outline the circumstances in which an EU trade mark court should stay infringement proceedings.
10. (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.

11. Explain how the Madrid Protocol interacts with the EU trade mark system.
12. Consider whether, and if so to what extent, words that are descriptive of goods or services in one or more European languages may nevertheless be registered as EU trade marks in respect of such goods or services.