

LAW AND PRACTICE OF TRADE MARKS

EXAMINATION PAPER 2013

Time Allowed: 3 Hours

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.

Any additional answers will be disregarded and **NOT** marked.

Candidates **MUST** obtain a pass mark in respect of **EACH** of the three Sections in order to gain an overall pass in respect of this examination.

SECTION A

1. Write notes on any **THREE** of the following cases:
 - (a) *Guinness Ireland Group v. Kilkenny Brewing Co. Ltd* [1999] 1 ILRM 531.
 - (b) *McCambridge Ltd v. Joseph Brennan Bakeries* [2012] IESC 46 (Supreme Court, 31st July 2012).
 - (c) *Tommy Hilfiger Europe Inc. v. McGarry* [2008] IESC 36 (Supreme Court, 29th May 2008).
 - (d) *Irish Distillers Ltd v. Cooley Distillery plc* [2008] IEHC 236 (High Court, 4th July 2008).
 - (e) *Falcon Travel Ltd v. Owners Abroad Group plc* [1991] 1 IR 175.

2. Aldos Motor Company Limited manufactures luxury cars. It has registered the mark “ALDOS” in the Register of Trade Marks in respect of Class 12 for vehicles. Harry Perry was trained as a mechanic by Aldos Motor Company Limited and worked for five years in a garage which was an authorised Aldos dealership. Last year he set up his own garage which services Aldos cars and also sells secondhand Aldos cars along with other makes of vehicle. Harry has advertised his garage in newspapers and car magazines as “*Harry Perry for Aldos Sales and Servicing*”. There is also a large sign above Harry's garage which bears this message. Almost invariably cars sold by Harry have a sticker placed in the back window which reads “*Harry Perry No. 1 Dealer for Aldos*”. This is regardless of whether the particular car happens to have been manufactured by Aldos Motor Company Limited.

Advise Aldos Motor Company Limited.

3. 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.
4. 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.

SECTION B

5. For ten years Safla Limited has manufactured “ZAP” washing powder which is sold in resealable plastic tubs from which the powder is measured and removed by means of a scoop. The tubs contain 1 kg of powder and are predominantly silver save for the presence of the word “ZAP” on the lid and sides in black print, a section of text dealing with how to measure and use the powder, and three parallel lightning-bolt shapes on the lid which are yellow in colour. Over 15 million such tubs have been sold in the State during the last ten years and Safla Limited wishes to obtain a trade mark registration in respect of the tub (it has already registered “ZAP” as a trade mark).

Explain how you would go about preparing the application for registration, the precise subject matter which you would advise Safla Limited to register and the classes in respect of which registration should be sought.

6. Set out the requirements governing the form, content and execution of statutory declarations for use in trade mark proceedings before the Patents Office.
7. Speeveck Inc. manufactures and sells the “CHOPFAST” brand of lawnmowers and garden tools in the United States and Canada. Recently it has been engaged in discussions with an Irish company, Cavan Cutters Limited, regarding an agreement whereby the latter would become the sole distributor of the aforementioned products in Ireland. It is intended that petrol powered lawnmowers bearing the “CHOPFAST” brand would be imported into the State from Speeveck Inc.’s factory in Idaho, while electric lawnmowers, hedge trimmers and other garden tools would be manufactured by Cavan Cutters Limited in the State and marketed under the “CHOPFAST” brand. Both parties agree that it is imperative that “CHOPFAST” be registered as a trade mark in the State, but they have yet to work

out who should hold the mark and the appropriate contractual structure that should be put in place. You have been asked to advise Speeveck Inc. in respect of these issues.

8. Explain the distinction between an action for infringement of a registered trade mark and an action for passing off, and in doing so identify with precision the matters in respect of which evidence would have to be adduced in order to succeed in each.

SECTION C

9. (a) Set out the procedural steps which must be followed in order to oppose the registration of a Community 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 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.
11. Outline and discuss the steps to be taken in order to adduce evidence in support of a claim that the subject matter of an application for a Community Trade Mark has acquired distinctiveness through use and indicate the type and breadth of evidence typically required.
12. Gulliva S.p.A. is an Italian mobile phone service provider. It is the registered owner of the Community trade mark “*GULLIVA*” in Class 38 for telecommunications which was registered with effect from 1st March 2003. At present Gulliva S.p.A. does not trade in Ireland. Last month it discovered that an unconnected Irish company, Gulliver Limited, has been operating a shop in Dublin that sells and repairs mobile telephones and arranges for the installation of intercom systems in apartment and office blocks. Gulliver Limited has been trading in the Dublin area for 15 years and in 2000 it registered “*GULLIVER*” as an Irish registered trade mark in Classes 9 (for telephone apparatus and portable telephones) and 38 (for telecommunications).

Advise Gulliva S.p.A. as to whether Gulliver Limited’s Irish registered trade mark is a threat to the continued registration of the “*GULLIVA*” Community trade mark and to the carrying on by Gulliva S.p.A. of business in Ireland under that mark.