

LAW AND PRACTICE OF TRADE MARKS

EXAMINATION PAPER 2014

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 (HIGH COURT)
 - (b) *McCambridge Ltd v. Joseph Brennan Bakeries* [2013] 1 ILRM 369 (SUPREME COURT)
 - (c) *Allergan Inc. v. Ocean Healthcare Ltd* [2008] IEHC 189 (HIGH COURT)
 - (d) *Cofresco Frischalterprodukte GmbH & Co. KG v. Controller of Patents, Designs and Trade Marks* [2008] 1 IR 582; [2007] 2 ILRM 430 (HIGH COURT)
 - (e) *Compagnie Gervais Danone v. Glanbia Food Society Ltd* [2010] 3 IR 711 (SUPREME COURT)
2. Borro Limited is the proprietor of the trade mark “TEN0” which is registered in Ireland for footwear in Class 25. It has discovered that a legal entity incorporated in Turkey is selling sports shoes bearing the brand “TEN0” over the Internet via a website that is hosted in Morocco. The shoes are priced in various currencies including euro and sterling. Advise Borro Limited as to whether there has been any infringement of its trade mark and any further steps which you recommend that it should take in defence of its rights.
3. Outline and discuss the various remedies that may be awarded by a court in the event of trade mark infringement being established.

4. Analyse the various potential defences to a claim for trade mark infringement contained in section 15 of the Trade Marks Act 1996.

SECTION B

5. Over the last 8 years Northern Brewers Limited have marketed cider under the name "*Old Cavan Cider*" in a 500 ml can shaped and painted so as to look like a wooden barrel. The name "*Old Cavan Cider*" is presented in orange lettering running diagonally across the front of the can. Northern Brewers Limited has sought your assistance in securing registered trade mark protection in respect of the name "*Old Cavan Cider*" and the can in which its product is marketed. Set out how you would prepare applications for registration and what you would do in order to ensure optimum protection.
6. Explain the purpose of a co-existence agreement, the circumstances in which one might find recourse being had to such an agreement and the provisions which one would expect to see in a properly drafted co-existence agreement.
7. Examine the most prudent way(s) of communicating in writing on behalf of a trade mark owner without triggering potential liability for groundless threats under section 24 of the Trade Marks Act 1996.
8. Outline the procedure for seeking the revocation of a trade mark before the Patents Office and consider the nature of the materials and/or evidence which one would typically utilise in the context of such an application.

SECTION C

9. Identify and describe the functions of the various sections within the Office for Harmonisation of the Internal Market which deal with Community trade marks.
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 the rules for determining which court(s) have jurisdiction in respect of the infringement of a Community trade mark.
12. For the last 15 years Whelan Marine Limited, which is based in County Cork, has manufactured and sold a range of outboard motors under the mark "*BATTO*". During this time it has developed a small but growing export market and it now wishes to register "*BATTO*" as a Community trade mark. However, the company is

concerned that “*BATTO*” has the same pronunciation as “*bateau*”, which is the French word for boat, and seeks your advice regarding whether this would affect the prospects of successfully securing a CTM registration.