

LAW AND PRACTICE OF TRADE MARKS

EXAMINATION PAPER 2015

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) *McCambridge Limited v. Joseph Brennan Bakeries* [2014] IEHC 269 (High Court – Charleton J).
 - (c) *Tommy Hilfiger Europe Inc. v. McGarry* [2008] IESC 36 (Supreme Court).
 - (d) *Allergan Inc. v. Ocean Healthcare Ltd* [2008] IEHC 189 (High Court – McGovern J).
 - (e) *Compagnie Gervais Danone v. Glanbia Food Society Ltd* [2010] 3 IR 711 (Supreme Court).

2. For the last 11 years Cosy Cabs Limited has been operating a fleet of taxis in the greater Dublin area. The taxis consist of different makes and models of motor cars, but all are painted so that the roof, bonnet and boot lid are a particular shade of red and the rest of the car is white. Cosy Cabs Limited maintains that this colour scheme ensures that its taxis are easily recognisable and that this has assisted in the growth of its business. It has sought your advice as to whether it could obtain registered trade mark protection in respect of the colouring of its taxis. Explain how you would go about preparing any application(s) for registration, the precise subject matter that you would advise Cosy Cabs Limited to register, the classes in respect of which registration should be sought, any difficulties that you anticipate and how they might be overcome.

3. 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.
4. Explain the distinction between an action for infringement of a registered trade mark and an action for passing off, and in doing so identify the matters in respect of which evidence would have to be adduced in order to succeed in each.

SECTION B

5. Explain the operation of the Madrid Protocol.
6. You are contacted by your client Mr. Black who has been selling a range of craft beers under the mark TOPBREW in Ireland for the past 7 years. Mr. Black now wishes to extend use of his mark to the rest of the European Union and wishes to apply for a Community Trade Mark to protect TOPBREW before proceeding in this regard. You organise a meeting with the client to discuss this matter. Before the meeting, you undertake some initial checks of the Irish and Community Trade Marks Registers and of the Internet which reveal the following trade marks and earlier rights:

- Community Trade Mark Registration No. 9685788 TOPLAGER covering “beer” in class 32 filed in February 2007 and proceeded through to registration in January 2008
- Use of the name, SUPERBREW as the name of an Irish chain of pubs.

You have been asked by the client to prepare a report for them to be discussed at the meeting which addresses the following questions sent to you by the client:

- What objections, if any, may be raised by the Community Trade Marks Office (OHIM) and briefly mention steps which can be taken to overcome any such objections
- What proceedings can be initiated against the Community Trade Mark Application by each of the owners of the earlier trade mark and/or earlier right mentioned above and provide a brief opinion on what you would advise we do if such proceedings are filed by each of these owners

Please note that you are not expected to address any issues relating to the use of the client’s trade mark (e.g. infringement actions which might be taken against your client) in your answer.

7. Outline the procedure for opposing the registration of a trade mark before the Patents Office and set out the nature of the materials and/or evidence which one would typically utilise in the context of such an application.

8. 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 that one would expect to see in a properly drafted co-existence agreement.

SECTION C

9. Explain the procedure to be followed in order to convert a Community Trade Mark application into an application for an Irish registered trade mark and outline the circumstances in which this is and is not possible.
10. Outline and discuss the steps to be taken in order to adduce evidence in support of a claim that the subject matter of a Community Trade Mark has acquired a “reputation in the Community” for the purposes of Article 9(1)(c) of Council Regulation (EC) 207/2009 and indicate the type and breadth of evidence typically required.
11. Baldricka Inc. is a United States corporation that is the owner of the Community Trade Mark “BALDRICKA” which is registered in Class 25 for “clothing, footwear and headgear”. It wishes to commence proceedings for infringement of its CTM against Pepys Limited, a United Kingdom registered company (with a head office in Birmingham) that has been selling fur hats bearing the brand name “BALD RICK” in its chain of shops in Ireland, the United Kingdom and the Netherlands. It also wishes to commence proceedings against Benny Haltock, a Danish national living in Tunisia, who arranged for the importation of the fur hats bearing the brand name “BALD RICK” into Germany and their onward supply to Pepys Limited.

Baldricka Inc. seeks your advice on its options as regards where it should commence CTM infringement proceedings against:

- (a) Pepys Limited; and
 - (b) Benny Haltock.
12. Outline the circumstances in which decisions of OHIM in respect of Community Trade Marks can be appealed against and identify the tribunals to which such appeals lie.