

LAW AND PRACTICE OF TRADE MARKS

EXAMINATION PAPER 2000

Time Allowed: 3 Hours

Answer SIX questions only.

Candidates MUST answer Question Number 1 and Question Number 2.

In the event of a Candidate failing to answer Question Number 1 and Question Number 2 the examination paper of that Candidate will NOT be considered valid.

1. Write notes on any THREE of the following cases:
 - (a) La Chemise Lacoste SA v. Controller of Trade Marks [1978] ILRM 8.
 - (b) Anheuser-Busch Incorporated v. The Controller of Patents, Designs and Trade Marks [1996] 2 IR 242.
 - (c) Guinness Ireland Group v. Kilkenny Brewing Co. [1999] 1 ILRM 531 130.
 - (d) Smithkline Beecham plc v. Antigen Pharmaceuticals Ltd [1999] 2 ILRM 190.
 - (e) Waterford Glass Ltd v. The Controller of Patents, Designs and Trade Marks [1984] ILRM 565.

2. Teltzer Pharmaceuticals Limited markets a popular cold and flu remedy in Ireland and the United Kingdom under the registered trade mark DELGAN. In both countries the product is sold without prescription in small bottles containing 30 tablets. In all remaining European Union member states the product is sold under the registered trade mark DALGOT in boxes of 20 tablets that contain four blister strips holding five tablets each. Bonty Chemists Limited have discovered that it is possible to purchase quantities of the tablets from wholesalers in France at prices that work out at less than half the price being charged by the suppliers acting for Teltzer Pharmaceuticals Limited in Ireland. Bonty Chemists Limited intends to import tablets bearing the registered trade mark DALGOT into Ireland, remove the tablets from the boxes and the blister strips and place them in bottles containing 30 tablets each. Because Irish consumers would not recognise the product if it was sold under the name DALGOT, Bonty Chemists Limited intends placing labels bearing the word DELGAN on the bottles. Those labels will be similar in size and colouring to those used by Teltzer Pharmaceuticals Limited, but will state 'Packaged in Ireland by Bonty Chemists Limited.'

Advise Bonty Chemists Limited.

3. Outline and discuss the manner in which section 24 of the Trade Marks Act 1996 provides redress in the case of groundless threats of proceedings for infringement of a registered trade mark. Reference should be made to relevant decisions of the courts in Ireland, the United Kingdom and such other jurisdictions as are appropriate.

4. (a) Identify the functions of the Controller on an application to register a trade mark and in a subsequent appeal to the High Court:
 - (i) Where the application is not opposed; and
 - (ii) Where there is an opposition.(b) Set out the procedural steps which must be followed in order to oppose the registration of a trade mark.
5. Explain the distinction between an action for infringement of a registered trade mark and an action for passing off.
6. Write notes on EACH of the following insofar as they are relevant to actions for trade mark infringement and passing off:
 - (a) A quia timet injunction.
 - (b) An interim injunction.
 - (c) An interlocutory injunction.
 - (d) An Anton Piller injunction.
 - (e) A permanent injunction.

Refer to relevant case law to illustrate how Irish courts have laid down and applied the principles applicable to each of these types of injunction.

7. Last year Gillos Film Productions Limited launched a children's cartoon series featuring six dogs with magical powers called 'The Magic Mongrels.' The dogs are called 'Spit', 'Spot', 'Scally', 'Tomser', 'Tigsy' and 'Bone'. The series was broadcast on national television and proved to be a huge success with young children. Gillos Film Productions Limited wishes to embark on the exploitation of merchandising associated with the series and envisages considerable potential in relation to items such as videos, games, toys, tee-shirts, lunch boxes and flasks.

Advise Gillos Film Productions Limited as to what strategy it should adopt in relation to the registration of trade marks to protect its rights and the rights of any licensees with whom it might enter agreements.

8. While making detailed reference to relevant decisions of the courts of the United Kingdom and the European Court of Justice, consider how an Irish court might interpret the phrase 'likelihood of association' in sections 10(2) and 14(2) of the Trade Marks Act 1996.
9. Indicate whether and to what extent:
 - (a) Smells;
 - (b) Shapes;
 - (c) Sounds;
 - (d) Slogans; and
 - (e) The names of geographical locations

can be registered as trade marks.

10. Write notes on EACH of the following:
- (a) The protection of well known trade marks under section 61 of the Trade Marks Act 1996;
 - (b) Certification trademarks;
 - (c) Collective trade marks; and
 - (d) The licensing of trade marks.