

# LAW AND PRACTICE OF TRADE MARKS

## EXAMINATION PAPER 2002

Time Allowed: 3 Hours

Answer SIX questions only.

Candidates MUST answer at least ONE question from Section A, at least ONE question from Section B and at least ONE question 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) Sterling Winthrop Group Ltd v. Farbenfabriken Bayer AG [1976] RPC 469.
  - (b) La Chemise Lacoste SA v. Controller of Trade Marks [1978] ILRM 8.
  - (c) Local Ireland Limited v. Local Ireland-Online Limited [2000] 4 IR 567.
  - (d) Anheuser-Busch Incorporated v. The Controller of Patents, Designs and Trade Marks [1996] 2 IR 242.
  - (e) Bayerische Motorenwerke AG v. Deenik [1999] 1 CMLR 1099.
  
2. For the last thirty years Top Beverages Limited has manufactured and sold lemonade under the trade mark 'SPEF'. Due to intensive marketing campaigns, which have included television advertising, the sponsorship of sporting events and the distribution of merchandise including T-shirts and baseball caps, sales over the last five years have been considerable and last year's turnover in Ireland exceeded €25 million. Top Beverages Limited is the registered proprietor of the trade mark 'SPEF' which is registered in Class 32 (for mineral and aerated waters and other non-alcoholic drinks).

Top Beverages Limited has recently discovered that O'Donnell Drinks Limited, which manufactures cider, has retained the services of the well-known Irish darts champion, 'Bulls-Eye' Cassidy for an advertising campaign designed to promote its cider. Part of the campaign involves the placing of posters on billboards which contain a photograph of 'Bulls-Eye' Cassidy standing in front of a dartboard holding an empty

glass with the slogan 'Now that's what I call a real drink!' underneath. Above the photo is the caption: 'Get on target with O'Donnell Cider'. Top Beverages Limited is most concerned by the fact that in the photograph 'Bulls-Eye' Cassidy is wearing a 'SPEF' T-shirt on which the word 'SPEF' is clearly visible. Despite requests O'Donnell Drinks Limited has refused to withdraw the poster.

Advise Top Beverages Limited.

3. By virtue of section 6(1) of the Trade Marks Act 1996, in order to qualify as a trade mark a sign must be capable of distinguishing the goods or services of one undertaking from those of other undertakings. While making detailed reference to relevant decisions of the courts of the United Kingdom and the European Court of Justice, explain and differentiate between section 8's exclusion from registration of:
  - (a) signs which do not satisfy the requirements of section 6(1); and
  - (b) trade marks which are devoid of any distinctive character.

## **SECTION B**

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. (a) Outline the approach that you would adopt when deciding on the class or classes in respect of which a trade mark should be registered.  
(b) While setting out your reasons, indicate the class or classes in which you would apply to register trade marks for the following:
  - (i) Prepackaged sandwiches and rolls.
  - (ii) Computer games.
  - (iii) Hair mousse.
  - (iv) Sun glasses.
  - (v) Car alarms.
6. Baldricka Inc. is a United States corporation which manufactures designer clothing. Until recently it has been content to concentrate on

the North American market. Last year it registered 'BALDRICKA' as a trade mark in Ireland in Class 25. Recently it has been engaged in discussions with Hip Fashions Limited, an unrelated Irish company, with a view to exploiting the 'BALDRICKA' brand in Ireland. Hip Fashions Limited has suggested that it will establish a wholly-owned subsidiary to be called Baldricka (Ireland) Limited which will take an exclusive licence of the 'BALDRICKA' trade mark from Baldricka Inc. and then manufacture and sell clothing under the trade mark.

Baldricka Inc. has sought your advice as regards the proposal from Hip Fashions Limited.

7. Identify and discuss the various matters regarding registered trade marks which are capable of being entered upon the Register of Trade Marks.

### **SECTION C**

8. Outline the grounds upon which the registration of a Community trade mark may be opposed and the procedural steps to be followed when pursuing such an opposition.
9. For the last five years Shamrock Pharmaceuticals Limited has sold a wormer for cattle called 'BOVINO' in Ireland and the United Kingdom. Last week it received a letter from a firm of solicitors in England who stated that they act for a French company called Convar S.A. and that their client was the registered proprietor of 'BOVINIO' which has been registered since January 1999 as a Community trade mark in Class 5 for veterinary preparations. The letter went on to state that unless Shamrock Pharmaceuticals Limited ceased all use of 'BOVINO' within ten days Convar S.A. would commence proceedings against it seeking, inter alia, an injunction and damages.

Shamrock Pharmaceuticals Limited had been hoping to extend the market for 'BOVINO' into the rest of Europe and seeks your advice regarding the allegation of infringement which has been made, what it can do with a view to attacking the registration of 'BOVINIO' and the appropriate forum in which to do so.

10. Write notes on EACH of the following in the context of the Community trade mark system:
  - (a) Securing a filing date;
  - (b) Claiming and obtaining priority in respect of an earlier trade mark application;
  - (c) Claiming and obtaining seniority in respect of an earlier registered trade mark; and

- (d) Appeals from decisions of the Office for Harmonisation in the Internal Market.