

LAW AND PRACTICE OF TRADE MARKS

EXAMINATION PAPER 2003

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) Montex Holdings Limited v. The Controller of Patents, Designs and Trade Marks [2001] 3 IR 85.
 - (b) Symonds Cider & English Wine Co. Ltd v. Showerings (Ireland) Ltd [1997] 1 ILRM 481.
 - (c) Guinness Ireland Group v. Kilkenney Brewing Co. Limited [1999] 1 ILRM 531.
 - (d) LRS International Ltd v. The Controller of Patents, Designs and Trade Marks [1976-77] ILRM 164.
 - (e) Zino Davidoff SA v. A & G Imports Ltd [2002] 1 CMLR 1.

2. The TALK SHOP KIDS are the latest teen pop music sensation. The band have been at the top of the Irish charts for the last two years. In addition to enjoying impressive sales of tapes and CDs, the band have derived significant revenue from merchandising. Last year TALK SHOP KIDS Trading Limited (a company owned by the band members) registered 'TALK SHOP KIDS' as a trade mark in Class 25 for clothing, footwear and headgear. For the last two months the band and the management of TALK SHOP KIDS Trading Limited have become increasingly concerned by the activities of Rodney Murphy, a clothing manufacturer who has been selling T-shirts bearing the words 'TALK SHOP KIDS - TALK OF THE TOWN'. The T-shirts also bear a removable cardboard tag which states 'This is not official merchandise - but enjoy it anyway!' TALK SHOP KIDS Trading Limited retained the services of a market research company which carried out a poll among approximately 500 teenagers who were seen wearing the 'TALK SHOP KIDS - TALK OF THE TOWN' T-shirts around the cities of Dublin, Cork, Limerick and Galway. However, it was unable to find anyone

who was willing to say that he or she thought the 'TALK SHOP KIDS - TALK OF THE TOWN' T-shirts were official merchandise or licensed by the band. Nevertheless, the TALK SHOP KIDS and TALK SHOP KIDS Trading Limited have threatened Rodney Murphy with proceedings for trade mark infringement and passing off.

Advise the TALK SHOP KIDS and TALK SHOP KIDS Trading Limited.

3. 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.

SECTION B

4.
 - (a) Set out the procedural steps which must be followed in order to oppose the registration of a trade mark.
 - (b) Consider how and in what circumstances an appeal from a decision of the Controller in respect of an opposition can be made to the High Court and from there to the Supreme Court.
5. For ten years Safla Limited has manufactured washing powder which is sold in blue boxes. The company has a fleet of trucks by means of which it distributes its washing powder and these trucks are likewise painted blue. Safla Limited wants to register the colour blue 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. Identify and discuss the various matters regarding registered trade marks which are capable of being entered upon the Register of Trade Marks.

7. Set out the provisions which one would expect to find in a properly drafted:
 - (a) Trade mark assignment; and
 - (b) Trade mark licence.

SECTION C

8. Analyse in detail the decision of the European Court of Justice in Philips Electronics NV v. Remington Consumer Products Limited [2002] ECR I-5475 and discuss the implications of the decision as regards the concept of distinctiveness and the extent to which the shapes of goods can be registered as trade marks.
9. Outline the procedure to be followed in order to apply for a Community trade mark.
10. Write notes on EACH of the following in the context of the Community trade mark system:
 - (a) Identifying the courts in which one should sue for infringement of a Community trade mark;
 - (b) Acquiescence in the use of a later Community trade mark;
 - (c) Applications to the Office for Harmonisation in the Internal Market for revocation and for declarations of invalidity regarding Community trade marks; and
 - (d) Appeals from decisions of the Office for Harmonisation in the Internal Market.