

LAW AND PRACTICE OF TRADE MARKS

EXAMINATION PAPER 2004

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) Masterfoods Limited v. Controller of Patents, Designs and Trade Marks, High Court, 30 April 2003 (Kelly J).
 - (c) Muckcross Park Hotel Limited v. Randles [1995] 1 IR 130.
 - (d) Sealed Air Corporation v. Controller of Patents, Designs and Trade Marks, High Court, 29 July 2003 (Smyth J).
 - (e) Case C-291/00 LTJ Diffusion SA v. Sadas Vertbaudet SA, European Court of Justice, 20 March 2003.

2. Boffo Limited manufactures clothing (including jeans and t-shirts) and is the registered proprietor of the trade mark LEGEND which is registered in Class 25. Recently it has discovered what it believes are infringements of its trade mark and/or passing off. First, Wham Jeans Limited has launched a television and poster campaign which carries the slogan: "Wham Jeans – A Leggy Legend." Secondly, a chain of retail outlets has begun to stock t-shirts which carry the word "Legend" on the front and a photograph of the Irish rock band of the same name on the back.

Advise Boffo 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.

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. Tysal Limited is an Irish registered company which is in the process of negotiating with a Padal SA, a French company, for sole distribution rights in Ireland of the latter's famous "Besqualle" cheese (which is named after the village in France where the founder of Padal SA was born and first manufactured cheese). Besqualle cheese is now manufactured in a factory in Lyon. While it has used the name "Besqualle" for twenty-five years, Padal SA never registered it as a trade mark. Tysal Limited is keen to ensure that if it obtains the distributorship which it seeks its position in the Irish market is protected by means of a registered trade mark.

Advise Tysal Limited and Padal SA as to the most effective means of securing registered trade mark protection for "Besqualle" in Ireland and what agreements should be put in place between them in relation to any such registered trade mark.

6. Consider the extent to which evidence as to the results of surveys can support a claim as to the likelihood of confusion on the part of the public and indicate how you would go about adducing such evidence in the most effective manner possible for the purpose of an opposition hearing.

7. (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) Wine decanters and glasses.
- (ii) Floppy disks for computers.
- (iii) Nappies for babies.

- (iv) Drain cleaner.
- (v) Drain cleaning services.

SECTION C

8. Analyse in detail the decision of the European Court of Justice in Arsenal Football Club plc v. Reed [2003] All ER (EC) 1 and discuss the implications of the decision in relation to the extent of the protection conferred by a registered trade mark.
9. 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.
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.