

LAW AND PRACTICE OF TRADE MARKS

EXAMINATION PAPER 2005

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) Bayerische Motorenwerke AG v. Deenik [1999] 1 CMLR 1099.
 - (b) Masterfoods Limited v. Controller of Patents, Designs and Trade Marks, High Court, 30 April 2003 (Kelly J).
 - (c) Local Ireland Limited v. Local Ireland-Online Limited [2000] 4 IR 567.
 - (d) Sealed Air Corporation v. Controller of Patents, Designs and Trade Marks, High Court, 29 July 2003 (Smyth J).
 - (e) OHIM v. Wm. Wrigley Jr. Company [2004] RPC 18 (decision of the European Court of Justice delivered on 23 October 2003).

2. Dakroda Inc. is a corporation existing under the laws of the United States which has manufactured and sold cars in North America for the last seventy years. Its best known model is a sports car known as the “Comvar” which was first sold in 1968 and has been through a number of revisions since then. Dakroda Inc. has sold over 15 million Comvars and in 1975 registered “Comvar” as a trade mark in the United States and Canada. It is not registered as a trade mark anywhere else in the world. Dakroda Inc. has never sold the Comvar outside North America, but it believes that over the years individual car enthusiasts have occasionally imported this car into some European countries, including the United Kingdom and Ireland where it has also been featured in car magazines from time to time. Between 1987 and 1992 the Comvar achieved some notoriety as it was the car driven by the lead character in the hit American crime series “Nashville Narcotics” which was shown on Irish television and enjoyed large audiences.

Aldos Cars Limited, which manufactures cars in Ireland, has just launched a two-seater sports car which it has called the “Kamvar”. Television advertisements for the car show a left-hand drive version being driven through the streets of New York. However, as yet this car has not been marketed or sold outside Europe. Dakroda Inc. is greatly aggrieved by this choice of name and marketing strategy. It seeks your advice as to what possible causes of action it could assert against Aldos Cars Limited if it commenced proceedings before the Irish courts.

3. While making detailed reference to relevant decisions of OHIM, the courts of the United Kingdom and the European Court of Justice, consider the circumstances in which colours may be registered as trade marks.

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. 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. It has sold clothing under the LEGEND trade mark in Ireland for the last ten years. Four weeks ago it discovered that a company called Raider Brands Limited was manufacturing and selling jeans bearing the mark LEGENDS. Boffo Limited wants to obtain an interlocutory injunction to prevent Raider Brands Limited from engaging in what it regards as trade mark infringement and passing off.

Advise Boffo Limited as to the evidence which it will have to produce for the purpose of seeking an interlocutory injunction, the manner in which that evidence should be put before the High Court and the procedure that will have to be followed in order to bring the application for an interlocutory injunction before the High Court.

6. Set out the provisions which one would expect to find in a properly drafted:
 - (a) Trade mark assignment; and
 - (b) Trade mark licence.
7. Outline and discuss:
 - (a) The provisions of the Trade Marks Act 1996 that deal with removal of a trade mark from the register on the grounds of non-use.

AND

- (b) The use requirements necessary to avoid a trade mark being removed from the register on the grounds of non-use.

SECTION C

8. Discuss the exhaustion of rights doctrine developed by the European Court of Justice in so far as it applies to registered trade marks and in particular:
 - (a) The extent to which this principle has been enshrined in Directive 89/104 and Regulation 40/94;
 - (b) Its applicability in cases of repackaging; and
 - (c) The decision of the European Court of Justice in *Zino Davidoff SA v. A & G Imports Ltd* [2002] 1 CMLR 1.
9. Outline the procedure to be followed in order to apply for a Community trade mark.
10. Gulliva SpA is an Italian company which wishes to apply to register “Gulliva” as a Community trade mark in Class 38 for telecommunications. At present Gulliva SpA does not trade in Ireland, but it has a number of large multinational customers that have branches or subsidiaries in this country. Last month it discovered that an unconnected Irish company, Gulliver Limited, has been operating a shop in Dublin that sells and repairs mobile telephones and arranges for the installation of intercom systems in apartment and office blocks. Gulliver Limited has been trading in the Dublin area for three years and last year had an annual turnover of approximately €2,500,000.

Advise Gulliva SpA as to the relevance, if any, which Gulliver Limited's existence and activities will have in relation to its application for a Community trade mark and the respective rights which Gulliva SpA and Gulliver Limited would be able to assert if Gulliva SpA secured a Community trade mark for “Gulliva”.