

LAW AND PRACTICE OF TRADE MARKS

EXAMINATION PAPER 2006

Time Allowed: 3 Hours

Answer SIX questions only. Any additional answers will be disregarded and NOT marked.

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) Adidas-Salomon AG v. Fitnessworld Trading Limited [2004] 1 CMLR 14.
 - (b) Tommy Hilfiger Europe Inc. v. McGarry [2005] IEHC 66 (8th March 2005).
 - (c) Metro International SA v. Independent News & Media plc [2005] IEHC 309 (7th October 2005).
 - (d) LTJ Diffusion SA v. Sadas Vertbaudet SA [2003] ECR I-2799.
 - (e) OHIM v. Wm. Wrigley Jr. Company [2004] RPC 18.

2. Pong Pharmaceuticals Limited manufactures and markets a range of toiletries for men under the trade mark "BEAST" which is registered as a trade mark in Class 3. The fragrances have proved to be popular and competitors have attempted to achieve the same effect with their products. One such product is an aftershave which is made by Scents Limited and is sold under the name "ANIMAL MAGIC". As part of a marketing campaign, Scents Limited sent small sample bottles of "ANIMAL MAGIC" to department stores and chemist shops in the Dublin area. The bottles were accompanied by letters which invited the retailers to market "ANIMAL MAGIC" "as a less expensive alternative to BEAST aftershave."

Advise Pong Pharmaceuticals Limited as to any causes of action which it may have against Scents Limited.

3. While making detailed reference to relevant decisions, including decisions of the Controller and the courts of the United Kingdom, consider what must be established in order to demonstrate successfully that an application for a trade mark has been made in bad faith.

SECTION B

4. Consider the extent to which evidence as to the results of surveys can support a claim as to a 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.
5. Bokip Inc. is a company incorporated in the United States which has chains of fast-food restaurants in 32 countries that trade under the name "BEEPIES". It is now considering establishing such a chain in Ireland. However, in 1994 Osway Limited, an Irish registered company, registered "BEEPEYS" as a trade mark in Class 29 for "meat products". Osway Limited did not use the "BEEPEYS" mark, but in 2000 licensed it to Munchmaster Limited which operates an American themed burger restaurant in Temple Bar called "The Big Beepey".

Bokip Inc. has sought your advice as to its prospects of securing the revocation of Osway Limited's trade mark.

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

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. 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.

10. Teltzer Pharmaceuticals Limited markets a popular cold and flu remedy in Ireland and the United Kingdom under the Community 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 Community 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 Community 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.