

LAW AND PRACTICE OF TRADE MARKS

EXAMINATION PAPER 2007

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) Symonds Cider & English Wine Co. Ltd v. Showerings (Ireland) Ltd [1997] 1 ILRM 481.
 - (b) Jaguar Cars Ltd v. Controller of Patents, Designs and Trade Marks [2006] 1 IR 607
 - (c) Bayerische Motorenwerke AG v. Deenik [1999] 1 CMLR 1099.
 - (d) The Zockoll Group Limited v. Controller of Patents, Designs and Trade Marks, High Court, 17 October 2006 (O'Sullivan J).
 - (e) Sealed Air Corporation v. Controller of Patents, Designs and Trade Marks, High Court, 29 July 2003 (Smyth J).

2. Aldos Motor Company Inc. manufactures luxury cars in the United States. In 1999, in the expectation that it would start to sell its cars in Ireland, it registered the mark "Aldos" in the Register of Trade Marks in respect of Class 12 for vehicles. However, for financial reasons it never began the manufacture of right-hand drive vehicles and to date only four Aldos vehicles have been registered in the State and all of these were pre-owned U.S. models imported into Ireland by private individuals. However, in the last three years Gillos Toys Limited has, under licence from Aldos Motor Company Inc., sold in the State over 5,000 toy cars which are replicas of Aldos models and on which the name Aldos is displayed. Aldos Motor Company Inc. entered into this licence agreement because it believed that it would be a useful means of commencing the promotion of its brand in Ireland. Last month a third party lodged with the Patents Office an application for revocation of the Aldos trade mark on the ground of non-use.

Aldos Motor Company Inc. wishes to oppose the application for revocation and you have been asked to advise it as to its prospects of success.

3. While making detailed reference to relevant decisions of the courts of the United Kingdom and the European Court of Justice, discuss the nature and scope of the protection conferred by section 14(3) of the Trade Marks Act 1996 and what must be established in order to invoke this provision successfully.
4. While making detailed reference to relevant decisions of the courts of the United Kingdom and the European Court of Justice, consider the extent to which the shapes of goods may be registered as trade marks.

SECTION B

5. Set out:
 - (a) The procedural steps which have to be taken in order to secure the registration of a trade mark;

AND

- (b) The procedural steps to be followed in order to oppose the registration of a trade mark.
6. Funkmeyer Stinkleheim & Gassman (“FSG”) are a long-established and successful New York law firm who have built up connections with firms of lawyers throughout the world. They wish to licence their name and the “FSG” logo to a newly-formed firm of Irish solicitors who have suggested registration of the name and logo as trade marks in Ireland.

Advise FSG as to the steps which you believe they should take in order to protect their interests in Ireland, including such contractual provisions or other documentation as might be put in place.

7. Outline and discuss the operation of the Madrid Protocol.

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. Critically evaluate, with reference to decided case law and relevant statutory provisions, the exhaustion of rights doctrine insofar as it applies to registered trade marks.
10. 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 2003 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 “BOVINIO” 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 “BOVINIO” 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.