

LAW AND PRACTICE OF TRADE MARKS

EXAMINATION PAPER 2009

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) *Tommy Hilfiger Europe Inc. v. McGarry* [2008] IESC 36 (29th May 2008).
 - (b) *Jacob Fruitfield Food Group Ltd v. United Biscuits (U.K.) Ltd* [2007] IEHC 368 (12th October 2007).
 - (c) *Arsenal Football Club plc v. Reed* [2003] All ER (EC) 1 (decision of the European Court of Justice).
 - (d) *Allergan Inc. v. Ocean Healthcare Ltd* [2008] IEHC 189 (24th June 2008).
 - (e) *Irish Distillers Ltd v. Cooley Distillery plc* [2008] IEHC 236 (4th July 2008).

2. Shamrock Pharmaceuticals Limited is the registered proprietor of 'VITOVEC' which has been registered since January 1999 as an Irish registered trade mark in Class 5 for veterinary preparations. It did not use the mark until January 2006 when it launched a wormer for cattle which has been advertised under the name 'BOVINO'. The packaging for this product refers, on its front, to "BOVINO' with added 'VITOVEC'" and goes on to explain on the back of the box that 'VITOVEC' is a new specially formulated vitamin supplement for cows that has been incorporated into 'BOVINO' to ensure optimum health and vitality for cattle. To date sales of 'BOVINO' have totalled €5.3 million.

Advise Shamrock Pharmaceuticals Limited as to whether 'VITOVEC' is vulnerable to revocation for non-use.

3. Explain the distinction between an action for infringement of a registered trade mark and an action for passing off, and in doing so identify the matters in respect of which evidence would have to be adduced in order to succeed in each.
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. Baldricka Inc. is a United States corporation which manufactures designer clothing. Until recently it has been content to concentrate on the North American market. Last year it registered 'BALDRICKA' as a trade mark in Ireland in Class 25. Recently it has been engaged in discussions with Hip Fashions Limited, an unrelated Irish company, with a view to exploiting the 'BALDRICKA' brand in Ireland. Hip Fashions Limited has suggested that it will establish a wholly-owned subsidiary to be called Baldricka (Ireland) Limited which will take an exclusive licence of the 'BALDRICKA' trade mark from Baldricka Inc. and then manufacture and sell clothing under the trade mark.

Baldricka Inc. has sought your advice as regards the proposal from Hip Fashions Limited. Advise Baldricka Inc. as to the steps which you believe it should take in order to protect its interests in Ireland, including such contractual provisions or other documentation as might be put in place.

6. (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) Satellite navigation systems for motor vehicles.
 - (iii) Nappies for babies.
 - (iv) Drain cleaner.
 - (v) Drain cleaning services.

7. 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.

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 trade marks legislation;
 - (b) Its applicability in cases of repackaging; and
 - (c) The decision of the European Court of Justice in *Parfums Christian Dior SA v. Evora* [1997] ECR I - 6013.
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".