

## LAW AND PRACTICE OF TRADE MARKS

### EXAMINATION PAPER 2023

Time Allowed: 3 Hours and 20 minutes

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

Candidates MUST answer TWO questions from Section A, TWO questions from Section B and TWO questions 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) *Cofresco Frischalterprodukte GmbH & Co. KG v. Controller of Patents, Designs and Trade Marks* [2008] 1 IR 582 (High Court – Finlay Geoghegan J).
  - (b) *Guinness Ireland Group v. Kilkenny Brewing Co. Ltd* [1999] 1 ILRM 531 (High Court – Laffoy J)
  - (c) *Nutrimedical BV v. Nualtra Ltd* [2017] IEHC 253 (High Court – Twomey J).
  - (d) *Aviareto Ltd v. Global Closing Room Ltd* [2021] IEHC 377 (High Court – Butler J).
  - (e) *Compagnie Gervais Danone v. Glanbia Food Society Ltd* [2010] 3 IR 711 (Supreme Court).
  
2. For the last fourteen years Sandro has been carrying on a restaurant business in Donnybrook under the name “*The Palermo Pasta Palace*”. Throughout Dublin the restaurant is known for its excellent Italian cuisine. In December 2022 Nicola opened a take-away in O’Connell Street in Dublin called “*Palermo Pizzas*”. Over the last few months Sandro has been surprised to hear a number of his regular customers commenting that they frequently purchase pizzas from his “*O’Connell Street branch*”. On inspecting “*Palermo Pizzas*” Sandro discovered that it was decorated by means of the same colour scheme as his restaurant (red, white and green – the colours of the Italian flag) and the counter staff wore uniforms which were very similar to those worn by his waiters (a white shirt, a red waistcoat and black trousers). Although he had not suffered any discernible loss of custom, Sandro protested to Nicola but the latter retorted that most of her customers had never heard of his establishment and her trade was attributable to the take-away’s city centre location.

Advise Sandro as to:

- (a) Whether he has a viable cause of action for passing off against Nicola (a generic recitation of the law on this topic will not suffice); and
- (b) To what extent he could protect his business from future difficulties of this kind through trade mark registration(s).

3. While making detailed reference to relevant case law and statutory provisions, consider whether, and if so to what extent, ownership of an Irish registered trade mark provides a defence to:
  - (a) A claim for infringement of an earlier Irish registered trade mark;
  - (b) A claim for infringement of an earlier EU trade mark; and
  - (c) A claim for passing off.
4. While making detailed reference to relevant case law, outline and discuss what have been determined to be “*proper reasons for non-use*” for the purposes of section 51(1)(a) and (b) of the Trade Marks Act 1996.

## SECTION B

### Question 5

In 2013, on behalf of your Client Bon Bon Bakeries Limited, you secured Irish Trade Mark Registration No. 123456 for BON BON BAKERIES. This Trade Mark was registered for:-  
Class 30: “*Flour; bread; cakes and pastries*”.

You Client has, since that time, been operating a bakery and associated shop in Galway, selling its homemade cakes and breads, under the BON BON BAKERIES name.

Recently, you and your Client have become aware of Irish Trade Mark Application No. 678910 BON BAP-etit Bakeries, for goods in class 30, being “*flour; mixes for the preparation of bread and cakes*”. This Application was published for opposition purposes in the Official Journal of the IPOI, dated 27 February 2023.

Advise your client on:-

- The deadlines and procedures associated with filing an opposition against Irish Trade Mark Application No. No. 678910 BON BAP-etit Bakeries, (up to an initial decision issuing from IPOI);
- The basis for filing such an opposition;
- Any particular issues to be considered in connection with any such opposition, and the risk(s) to the Client – if any - associated with same; and
- Briefly comment on your Client’s chances of success.

### Question 6

Your client, an Irish company by the name of Extreme Thrills Limited is a manufacturer and seller of a range of “games, toy models, video games and related goods and is the owner of an Irish Trade Mark Registration for the Trade Mark EXTREME THRILLS registered on 14 June 2017 in respect of “*Games, toys and playthings; video game apparatus*” in Class 28.

Your client is using the Trade Mark in respect of “*hand held video games, hand held electronic video games and accessories, electronic games, toy models*”

It has come to your client’s attention that an Irish Company by the name of Get Your Extreme Thrill Limited is using the Trade Mark GET YOUR EXTREME THRILL in respect of “*On-line gaming apps; gaming software; downloadable video games and downloadable computer games*”.

Based on information available to your client, it is believed that the goods of Get Your Extreme Thrill Limited are made available to consumers via the website [www.getyourextremethrill.ie](http://www.getyourextremethrill.ie).

Your client has expressed concern and has asked you to advise it about what they should do and provide advice as to what causes of action may be available to them, if any, and the basis of any such actions.

You should identify the possible causes of action available, if any, the basis of such actions and set out the reasons for your advice and also identify any additional information you may require.

**Question 7**

Your client Flora Limited has operated a restaurant in Galway under the brand The Marigold since 2016. Your client is expanding their business in Galway and will shortly open a boutique hotel and Spa under the brand Marigold Hotel.



You filed a new Trademark application for the client's logo on April 01, 2023 in classes 43 and 44 for the following:



Class 43: *Services for providing food and drink; temporary accommodation; hotel services café and restaurant services.*

Class 44: *Spa services; health and beauty spa services*

You have now received an examination report from the IPOI and an objection has been raised under Section 10 of the Trade Marks act 1996 based on the following marks


<p><b>EUTM Registration:</b></p> <p><b>Status:</b> Registered</p> <p><b>Registration date:</b> August 25, 2017</p> <p><b>Classes:</b> Class 43 : hotel services</p>
<p><b>Irish TM Application: Marigold Café</b></p> <p><b>Status:</b> Advertised</p> <p><b>Publication date:</b> April 15, 2023</p> <p><b>Classes:</b> Class 43: café services</p>

<p><b>EUTM Registration:</b></p> <p><b>Status:</b> Registered</p> <p><b>Registration date:</b> September 15, 2020</p>

**Classes:**

Class 3: facial preparations for use in spa treatments  
Class 44: Spa services

Draft a letter of advice to your client explaining the nature of the objections raised and advising on all options available to deal with the cited marks and your recommendations on a strategy for progressing the application through to registration.

**Question 8**

An industrial designer brings you a portfolio of designs, and is seeking advice on whether each of the following designs is protectable in Ireland. Ignoring other forms of IP such as copyright or patents, provide reasoned advice on whether each design below is protectable with registered and/or unregistered rights in Ireland. No design applications have been filed for any of these designs yet.

- a) Design 1 is a logo (Fig. 1A) that the designer created for a client, Abe's Locksmiths. The logo will be used on the company's website (Fig. 1B), as well as on branded padlocks they sell (Fig. 1C). The new logo, website and padlock design will be launched next week, and the logo itself has already been protected as a trade mark, with an EUTM registration having been filed for the device mark of Fig. 1A several months ago. The registration was published last week, and the designer asks if the trade mark registration will affect the availability of any design protection.
- b) Design 2 is for a wheelie bin lid (Fig. 2) with an original design combining an environmental message and a leaf graphic, printed on the inside surface only of the bin lid. The wheelie bin lid is entirely conventional on the outside, and the graphic and message are printed and not e.g. embossed, so they are invisible and undetectable when the lid is closed, but they are visible when the lid is raised as shown. Because wheelie bin lids are sometimes damaged or broken by the unloading mechanism of the bin lorry, such lids are designed to be replaceable components of the bin, and the first disclosure of your client's lid was in Belfast 18 months ago when a refuse company started using these lids to repair damaged bins.
- c) Design 3 is an ingenious roller coaster track design which, when viewed from the side, appears to spell the word "terror" in handwritten script. A major theme park in Japan announced in the Japanese trade press in January 2022 that they would be building this roller coaster, which would open in the summer of 2023. The article was accompanied by illustrations of the track's design. No disclosure has occurred since then or indeed outside Japan at all.
- d) Design 4 is of a metal washer (i.e. the flat circular metal object with a hole through the centre which is frequently used with a nut and bolt fixture). The washer is of conventional shape but is coloured a bright, fluorescent green. The client explains that such washers are often lost in a workshop, as their shape makes them liable to roll away when accidentally dropped. The client explains further that trials have shown that this particular fluorescent green colour makes them easier to find than any other colour scheme tested. Searches for known examples of washers with any fluorescent colouring have turned up blank, and the design has not yet been disclosed publicly.

- e) Design 5 is a chair which the designer claims to be a unique fusion of Victorian and modern styles. On detailed questioning it transpires that the upper half of the chair (the back and arms) is an exact replica of a classic Victorian design, while the lower half (the seat and legs) is an exact copy of a best-selling modern Swedish design, so that no part of the chair's design is original of itself, but the combination has not been seen before and the design has not yet been disclosed publicly.



Fig. 1A

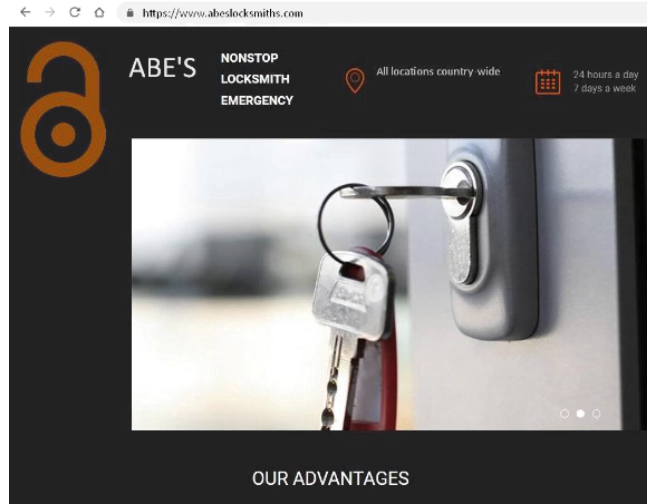


Fig. 1B



Fig. 1C

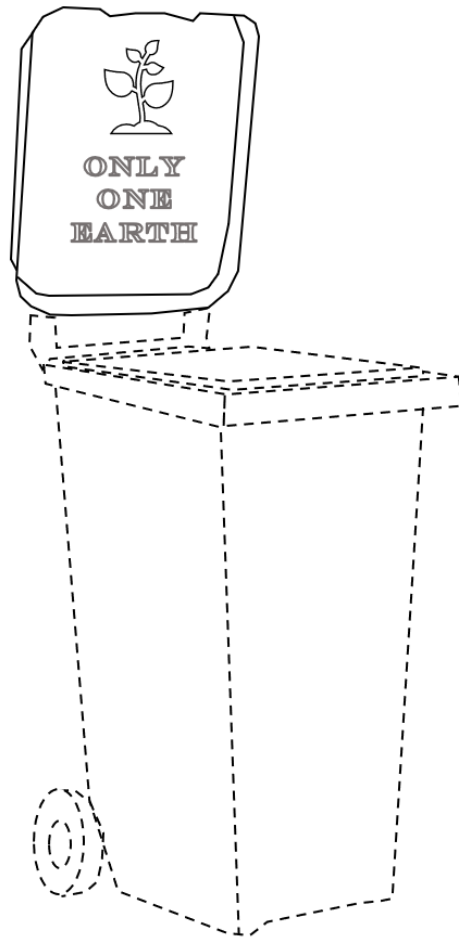


Fig. 2

### SECTION C

9. Outline and discuss the steps to be taken in order to adduce evidence in support of a claim that the subject matter of a EU Trade Mark has acquired a "*reputation in the Union*" for the purposes of Article 9(2)(c) of Council Regulation (EC) 207/2017 and indicate the type and breadth of evidence typically required.
10. Identify and describe the functions of the various sections within the European Union Intellectual Property Office which deal with EU trade marks.
11. Outline the time limits and procedures to be followed in order to oppose the grant of an EU trade mark.
12. Consider whether, and if so to what extent, words that are descriptive of goods or services in one or more European languages may nevertheless be registered as EU trade marks in respect of such goods or services.