

## LAW AND PRACTICE OF TRADE MARKS

### EXAMINATION PAPER 2024

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) *Allergan Inc. v. Ocean Healthcare Ltd* [2008] IEHC 189 (High Court – McGovern J).
  - (b) *Galway Free Range Eggs Ltd v. O'Brien* [2019] IECA 8 (Court of Appeal).
  - (c) *Sealed Air Corporation v. Controller of Patents, Designs and Trade Marks* (29 July 2003) (High Court – Smyth J).
  - (d) *Aviareto Ltd v. Global Closing Room Ltd* [2021] IEHC 377 (High Court – Butler J).
  - (e) *Tommy Hilfiger Europe Inc. v. McGarry* [2008] IESC 36 (Supreme Court).
  
2. Over the last 30 years Northern Brewers Limited has marketed and sold cider under the name “*Old Cavan Cider*” in a 500 ml can shaped and painted so as to look like a wooden cask. The cider is sold throughout the country and both retailers and consumers are familiar with its name and packaging. Recently Northern Brewers Limited has learned that a new company, called Cavan Drinks Limited, is planning to market cider in a barrel-shaped can with the slogan “*Cavan Drinks Cider!*” embossed across the front.

Northern Brewers Limited seeks your advice as to the availability of trade mark protection in respect of the name “*Old Cavan Cider*” and the can in which its product is marketed, as well as any other legal means of protecting its position.
  
3. Outline and discuss by reference to relevant case law and statutory provisions the civil remedies available in the event of registered trade mark infringement being established.

4. In the context of a claim of trade mark infringement, explain what is meant by “*added matter*” and how it is treated when assessing whether an infringement has occurred.

## SECTION B

### Question 5

Your client is a company based in the United States of America and, on 1 February 2024, filed US Trade Mark Application no. 90940591 COZY CLOUD SOCKS in Class 25 for “socks”. Your client is interested in applying to register the Trade Mark in Ireland, where it has not yet used the Mark. Your client has instructed you to conduct an availability search of the Irish and European Union Trade Mark Registers (and the WIPO Register designating each). The searches have revealed the following most pertinent Marks in the names of third parties:

1. Irish Trade Mark registration no. 018699263 CLOUD NINE in Class 25 for “*footwear; socks; socks for infants and toddlers*” filed on 6 May 2022 and its registration was published on 20 December 2022.
2. European Union Trade Mark application no. 2024/1030 COZY CLOUD SOCKS in Class 25 for “socks” filed on 1 April 2024.
3. European Union Trade Mark registration no. 2489064 in Class 25 COZY TOES SOCKS for “*footwear; socks*”, which proceeded to registration on 1 October 2018. Brief Internet research reveals that the Trade Mark has not been used anywhere within the European Union within the last five years.

With the above results in mind, prepare an opinion for your client advising on:

1. the inherent registrability of the COZY CLOUD SOCKS Trade Mark, the risk of receiving a provisional refusal based on absolute grounds, and any limitations you may need to enter upon examination;
2. each of the located Trade Marks and whether and to what extent they will impact your client's chances of successfully obtaining a Trade Mark registration in Ireland. Your advice should include any steps which your client could take to address any possible issues; and
3. the overall prospects of securing registration of the COZY CLOUD SOCKS Trade Mark in Ireland.

### Question 6

Your client, an Irish sports equipment manufacturer, writes to you as follows: “We developed last year a new and innovative mountain biking helmet (Helmet A), which is shown in Figs. 1-6. Helmet A was revealed to the public at the “Worldbike

Exhibition” held in New York on July 1-3, 2023, and subsequently went on sale in the EU across a range of retail stores and online. It has sold very well and featured very favourably in a number of leading cycling magazines.

“Our Helmet A has a distinctive set of ventilation holes which contribute significantly to the overall appearance of the helmet, as well as providing ventilation and cooling for the wearer. We sell Helmet A with a chin guard, but the user can detach this if they do not need full face protection. Figs. 5 and 6 show the helmet with the chin guard removed.



Fig. 1  
Helmet A



Fig. 2  
Helmet A



Fig. 3  
Helmet A



Fig. 4  
Helmet A



Fig. 5  
Helmet A



Fig. 6  
Helmet A

“We have discovered that on February 10, 2024, a German competitor, Schutz GmbH, disclosed on its website a similar bicycle helmet (Helmet B), shown in Figs. 7-10. We believe that they are about to start selling Helmet B throughout the EU.



Fig. 7  
Helmet B



Fig. 8  
Helmet B



Fig. 9  
Helmet B



Fig. 10  
Helmet B

“Admittedly, Helmet B looks quite different at first glance from our Helmet A because it has no chin guard and is in a very different colour scheme. However, it has an identical pattern of ventilation holes and the same shape as our helmet, and we are convinced we can show that they copied these aspects of our design.

“Please advise on the questions below giving reasons for your advice, considering only Irish or EU design rights (registered or unregistered) and ignoring any potential copyright or patent issues.

- (a) Can we obtain any valid design registration in view of the prior disclosures, i.e. our launch of Helmet A in New York, subsequent sales and magazine publicity, and Schutz’s recent launch of Helmet B?
- (b) Assuming that valid design registration might be possible, what exactly should we register to improve our position against Schutz?
- (c) If we were able to successfully obtain design registrations following your advice on question (b), could we successfully enforce our rights against Helmet B?
- (d) Can we rely on unregistered design rights against Schutz?

### Question 7

You receive a letter from an Italian associate requesting advice on behalf of their client, Tiramisu S.r.L an Italian company owning the registered Trade Mark PECK (EUTM No. 24252627) registered on January 16, 2008 and covering “Pizzas, sandwiches, food preparations’ in Class 30. They have recently been alerted to an Irish Trade Mark Application PECKISH (No 678910) which was published on 15/3/2024 by Yummy Limited, an Irish company, for “Edible sandwiches, biscuits, bread, cakes, cookies, chocolate” in Class 30 and “Services for providing food and drink; cafe and coffee bar services” in Class 43.

Advise your client on what steps Tiramisu S.r.l can take to prevent the PECKISH Trade Mark application from progressing to registration (including the opposition procedures in this jurisdiction), any deadlines involved and their prospects of success.

### Question 8

Craic'N Tours Limited is an Irish company who self-filed an Irish Trade Mark Application on 05 January 2024 for the Mark as a series of two:

Mark One: CRAIC'N TOURS – EMBRACE THE CRAIC



Mark Two:

The company has spent a considerable amount of time and effort in devising the logo and as an Irish brand, there is an Irish flag included in their logo. Their specification covered the following:

*Class 39: Transport; packaging and storage of goods; travel arrangement; Organizing and arranging travel tours, excursions, and holidays; Travel agency services, namely, making reservations and bookings for transportation; Providing information regarding travel and transport via a website; Arranging of tours, sightseeing tours, and holiday tours; Transportation reservation services; Escorting of travelers; Rental of vehicles, bicycles, and motor vehicles for travel purposes; Arranging and providing travel information, advice, and planning*

*Class 41: Entertainment; sporting and cultural activities; Arranging and conducting guided tours, cultural events, and historical sightseeing tours; Providing information about entertainment and recreational activities via a website; Organization of cultural and educational events and activities*

*Class 43: Services for providing food and drink; temporary accommodation; Making reservations and bookings for temporary lodging, hotels, and motels*

Craic'N Tours have contacted you as they have received a letter from the IPOI advising that the following objections have been raised against the application:

- That the mark does not constitute a series:

- The second mark in the series contains an Irish flag which is excluded from registration: and
- Cited the below earlier marks:
  1. EUTM No. 018987898 EMBRACE THE CRAIC
 

Owner: Craic Dating Limited

Status: Registered. Registration date: July 16, 2017

Class 41: *Entertainment*

Class 45: *Dating services, including online dating services*
  2. Irish TM No. 345876 CRAIC TRAVEL
 

Owner: Craic Travel Limited

Status: Registered. Registration date: February 28, 2023

Class 39: *Transport; vehicle rental 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 objections raised and your recommendations on a strategy for progressing the application through to registration.

### **SECTION C**

9. Set out the various procedural avenues available to a party who wishes to invalidate a registered EU trade mark.
10. (a) Set out the procedural steps which must be followed in order to oppose the registration of an EU trade mark.

### **AND**

- (b) Set out the appellate structure and the possible bases for appeal in respect of such an opposition.
11. Outline and discuss by reference to relevant case law the criteria by reference to the issue as to whether a registered EU trade mark has a reputation in the European Union is to be assessed for the purposes of Articles 8(5) and 9(2)(c) of Regulation (EU) 2017/1001.
12. Tesser GmbH is the owner of a registered EU trade mark for the word mark FLYKEX which is registered in Class 25 for clothing. In December 2023 it commenced proceedings before the German courts against Barty Limited, an Irish company, for importing and selling trousers in Germany under the brand

FLYKECKS. Tesser GmbH's Irish subsidiary, Tesser Limited, owns an Irish registered trade mark for FLYKEX which is registered in Class 25 for clothing and footwear. Last month Tesser Limited commenced proceedings in Ireland for infringement of the Irish registered trade mark and passing off in respect of the sale by Barty Limited in Ireland of running shoes under the brand FLYKECKS. In circumstances where the proceedings in Germany are yet to be heard and determined, Barty Limited seeks your advice as to whether it would be possible to have the proceedings in Ireland stayed.