

LAW AND PRACTICE OF TRADE MARKS

EXAMINATION PAPER 2025

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. Discuss the decision of the Irish Supreme Court in *Merck Sharp and Dohme Corporation v. Clonmel Healthcare Ltd* [2020] 2 IR 1 and consider what implications, if any, this decision has for the availability of interlocutory injunctions in actions concerning the infringement of trade marks and passing off.
2. Camoks Limited has been selling designer clothing in Ireland under its CAMOKS brand for 25 years. Ten years ago it registered CAMOKS as a trade mark in Class 25 for clothing and footwear. In the last year it has discovered that an Italian company, Boppi SpA, has been marketing a range of shorts and trousers under the brand KAMOX, which are sold in stores in Italy, Spain, and Portugal. These garments are not available in stores in Ireland, but Camoks Limited has learned that as a result of online promotion by a number of Irish influencers, young people in Ireland have started purchasing KAMOX garments via the website www.kamox.it, which is accessible in the English language, with those garments being delivered to purchasers' addresses in Ireland via an independent courier service.

Camoks Limited seeks your advice as to its prospects of success if it brought proceedings for infringement of its registered trade mark or passing off against Boppi SpA.

3. Consider the extent to which evidence as to the results of surveys can support a claim that a mark has acquired distinctiveness through use and indicate how you would go about adducing such evidence in the most effective manner possible.

4. 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.

SECTION B

Question 5

You have received a notification from the EUIPO advising that your Client's EU Trade Mark Application WATERFALL, covering goods in Class 3, has been opposed by the owner of an Irish, UK and German Registration for WATERWORKS all covering overlapping goods in Class 3. You then receive further communication that the Opposition has been deemed to be admissible. Your investigations into the Opponent determine that they operate in the same industry as the Client but only have operations in Ireland, France and Germany. Your Client's markets of interest are Ireland, the UK and France. Advise the Client of the various stages of the Opposition, including any deadlines involved, and the options available for addressing same as well as their prospects of success.

Question 6

Your client is an Irish company, Emerald Ember Limited, that was incorporated in Ireland in 2007. Your client is the registered proprietor of the Trade Mark EMERALD EMBER registered in Ireland on 18 March 2008 in Class 33 for "*Alcoholic beverages, except beers; whiskey*". Additionally, your client is the registered proprietor of the Trade Mark EMERALD EMBER registered in the European Union on 12 September 2014 for "*Alcoholic beverages, except beers; spirits; distilled spirits; whiskey complying with the specifications of the protected geographical indication Irish Whiskey / Uisce Beatha Eireannach / Irish Whisky*". Your client has used the Trade Mark EMERALD EMBER continuously, only in Ireland, since 2007 in the manner depicted below. Your client's EMERALD EMBER Trade Mark has acquired a reputation in Ireland.



It has come to your client's attention that a recently incorporated Irish company, Celtic Ember Limited, has opened a bar and restaurant in Dublin named "The Celtic Ember". The company sources gins distilled by prominent Irish distilleries which it sells in its restaurant and bar in the manner depicted below. Your client has determined that these goods are also being exported to Spain, Italy, and France for sale in bars and restaurants.



Your client has expressed concern and has asked you to provide an opinion as to the causes of action available, the basis of such actions, any potential pitfalls your client

should be aware of, and your client's prospects of success. Include the reasons for your advice supported by relevant case law and identify any additional information you may require.

Question 7

Provide reasoned advice on the protectability of each of the following designs in answer to the questions raised. Ignore other forms of IP such as copyright or patents.

- a) Design 1 is an electrical connector with a novel and attractive appearance, used in the control electronics of a lift (elevator). The client advises that these connectors have a working lifespan of about 18 months, before they need to be replaced. Normally this connector is hidden behind a removable metal service panel that is screwed to the wall of the lift, but if the panel is removed, e.g. when an engineer is servicing or repairing the lift, the connector is immediately visible to allow easy replacement. Can this be protected by (i) a registered Irish design? (ii) an unregistered EU design right?
- b) Design 2 is an octagonal nut shown in Figs. 1 and 2. The client advises that while square nuts and hexagonal nuts are of course very well known, surprisingly a comprehensive search could not uncover any octagonal nuts, therefore please assume this is a novel design, and the client has not yet disclosed it. The client states that the reason for creating an octagonal nut is that it allows the nut to be used in tighter spaces, since the spanner has more positions where it can engage with the nut.

The client asks if this design is protectable by a registered Irish design.

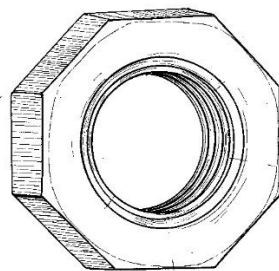


Fig. 1

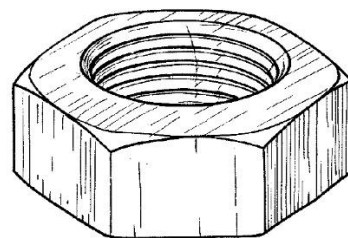


Fig. 2

- c) Design 3 is an animated screen that is displayed during a mobile phone start-up. When the phone is powered on, the screen changes smoothly through the sequence shown in the snapshots of Figs. 3A to 3E:

3A: The phone maker's name (ZENITH) appears on the screen.
3B: A logo depicting a stylised family group in grey fades in.
3C: The family group logo develops its colours.
3D: The family group logo increases in size while ZENITH shrinks.
3E: Final state of the transformation, a large family group logo with a small ZENITH.

The client asks you:

- (i) Is this kind of design registrable in the EU?
- (ii) If so, how you would suggest the design be shown in a design application to provide the best scope of protection?
- (iii) Are there any strategies to strengthen protection for the design (ignoring trademark protection)?
- (iv) Is unregistered design protection available for such a design?



Fig. 3A



Fig. 3B



Fig. 3C



Fig. 3D



Fig. 3E

Question 8

You have just received an email from a new client who is interested in obtaining a 'worldwide' trade mark and they are seeking initial trade mark advice. The company, Soapy Shannon Limited, is a small but ambitious start up based in Galway. The client has had a passion for making natural soaps and has been producing these products and selling them to local shops in Galway and throughout Ireland since late 2024. The best-selling product is SHAMROCK SOAP which is made with extracts of Irish Shamrock but the client also sells cleansers and cleansing cloths. The client has designed the logo depicted below.



Based on initial customer feedback especially from tourists, the client is considering selling the SHAMROCK SOAP products in Northern Ireland, the United States, Canada and China.

Draft an initial advice note to the new client advising on the next steps including the registrability of the trade mark, what Class or Classes they should consider and possible filing strategies.

SECTION C

9. Identify and describe the functions of the various sections within the European Union Intellectual Property Office which deal with EU trade marks.
10. Set out the rules for determining which court(s) have jurisdiction in respect of the infringement of an EU trade mark.
11. Discuss by reference to relevant case law:
 - (a) The exhaustion of rights doctrine as reflected in Article 15(1) of Regulation (EU) 2017/1001;

AND

- (b) The extent to which the affixing of an EU trade mark by a third party to goods that have been relabelled or repackaged is permissible having regard to Article 15(2) of Regulation (EU) 2017/1001.
12. Explain the circumstances in which acquiescence on the part of a proprietor of an EU trade mark may inhibit the ability of that proprietor to seek the invalidation of a later EU trade mark.