

LAW AND PRACTICE OF TRADE MARKS

EXAMINATION PAPER 2026

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. While referring to relevant case law, outline and discuss the manner in which section 24 of the Trade Marks Act 1996 provides redress in the case of groundless threats of proceedings for infringement of a registered trade mark.
2. Write notes on any **THREE** of the following cases:
 - (a) *Nutrimedical BV v. Nualtra Ltd* [2017] IEHC 253 (High Court – Twomey J).
 - (b) *Sealed Air Corporation v. Controller of Patents, Designs and Trade Marks* [2003] IEHC 642 (High Court – Smyth J).
 - (c) *Allergan Inc. v. Ocean Healthcare Ltd* [2008] IEHC 189 (High Court – McGovern J).
 - (d) *Compagnie Gervais Danone v. Glanbia Food Society Ltd* [2010] 3 IR 711 (Supreme Court).
 - (e) *Aviareto Ltd v. Global Closing Room Ltd* [2021] IEHC 377 (High Court – Butler J).
3. While referring to relevant case law, outline and discuss the extent to which regard may be had to survey evidence in trade mark infringement and passing off cases, together with the principles regarding how such surveys should and should not be conducted.

4. While referring to relevant case law, consider what must be established in order to demonstrate successfully that an application for a trade mark has been made in bad faith.

SECTION B

Question 5

You have received a notification from the IPOI, under Rule 18, enclosing a Notice of Opposition, advising that your client's Trade Mark Application CROPS, a word mark application filed on 1 November 2025, covering goods in Class 29 i.e. "crisps, potato chips", has been opposed by the owner of a EU registration for CROSS registered 1 March 2019, covering goods in Class 29 namely "snack foods; vegetable based crisps". Your client owns an earlier Irish Trade Mark registration for CROPS covering identical goods to the current application in Class 29 which is dated 1 December 2015.

- 1) Advise your client of the various stages of the Opposition, giving an outline of the opposition procedures, deadlines and any defence available.
- 2) Set out the nature of the materials and/or evidence which they would typically utilise in response to an opposition, and the options available to them for addressing any materials and/or evidence supplied by the opponents.
- 3) You should also briefly advise your clients on the prospects of their application being successful.

Question 6

You have been contacted by an individual, John Bird, who has been trading extensively throughout the Republic of Ireland since 2020 providing a range of pre-mixed cocktails, spirits and pre-mixed alcoholic beverages, under the mark **MAGPIE**. Given the success of this venture to date, he now wishes to protect his trade mark and has asked for your advice on the following:

He has asked you to undertake a trade mark clearance search for his mark and your research has disclosed the following four marks which may be pertinent:

Irish Trade Mark No. 113467

Mark: MAGPIE
Proprietor: Erin Distillers Limited
Date of Application: 12 February 2012
Date of Registration: 20 October 2014

Classes: 32, 33
Goods: Beer, non-alcoholic beverages, spirits.
The mark has not been used since 2019.

European Union Trade Mark No. 018123697



Mark:

[Description of Mark – Representation of a Magpie bird]

Proprietor: Xcelsior GmbH, Germany
Date of Application: 1 March 2022
Date of Registration: 23 November 2022
Classes: 35, 43
Services: Retail sale of beverages, alcohol and foodstuffs
Restaurant, bar and café services.

There is no indication of use of this mark at present.

Irish Trade Mark No. 234567

Mark: JIM'S MAGPIE DINNERS
Proprietor: XYC Limited
Date of Application: 1 March 2018
Date of Registration: 12 December 2018
Classes: 29, 30
Goods: Meat, fish, poultry, vegetables, desserts, chocolate.
The mark is used for the above goods since 2015.

International Trade Mark No. 1526987

Designated countries: Ireland, United Kingdom, Germany, Italy.

Base Application: French Trade Mark application

Mark: MAGGIE
Proprietor: Francoise S.A., France
Date of Application: 6 June 2025
Date of Registration: Not applicable
Classes: 33
Goods: Alcoholic beverages, spirits, cocktails.
Research has confirmed that the base French application on which this International Application has been filed has been cancelled.

Please review each of these prior marks and provide your opinion as to whether each could be an obstacle to filing an application for the client's mark and if so the reasons for same and also provide any suggestions for overcoming possible objections based on these individual prior marks.

Question 7

You represent Menlo Castle & Gardens, the world-renowned tourist attraction situated in the picturesque village of Menlo, Galway. In 2019, your clients planned to create a "Menlo Castle" premium whiskey for sale in the Menlo Castle gift shop but their plans were derailed by the Covid-19 Pandemic (March 2020 to May 2023) and associated lockdowns. Your clients' plans are currently back on track and they are setting up Menlo Castle Whiskey Distillery in association with a renowned Master Distiller to make their premium "Menlo Castle" whiskey.

It has come to your clients' attention that a local entrepreneur incorporated a company called Menlo Brewing Company Limited on March 1, 2026 which has posted plans online to launch a "Menlo Heritage" range of bottled lagers on July 1, 2026. The posts contains clear images of Menlo Castle and its surrounding gardens with patrons drinking out of bottles of Menlo Heritage lager. Drinking alcohol on the premises of Menlo Castle is not permitted except in the onsite restaurant. Visitors to the castle would never be drinking lager on the lawns.

Your client is the registered proprietor of the Trade Mark MENLO CASTLE registered in the European Union on April 23, 2018 for "bottled water" in class 32, and "alcoholic beverages, except beers" in class 33. Although your clients have never sold whiskey by reference to their "Menlo Castle" registered trade mark, your client has produced and sold apple cider and bottled water under the trade mark "Menlo Castle & Gardens Made" from their gift shop for a number of years.

Your client has expressed serious concern regarding the imminent launch of the "Menlo Heritage" lager product as they feel that there will be an unfavourable association with Menlo Castle and likely confusion, detracting from their planned launch of an exclusive whiskey. They have asked you to advise what they can do to prevent the launch, what courses of action may be available to them and the possible defences available to Menlo Brewing Company Limited.

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

Question 8

Answer both parts (a) and (b)

- (a) In May 2025, your client, Shannon Seating Ltd, obtained an Irish design registration for an office chair with a distinctively curved frame. A competitor, Apex Office Supplies, seeks to invalidate this, providing a scanned page from the official directory of the Hong Kong International Furniture Fair, dated October 2024. The page includes a photograph of an exhibition booth belonging to an unrelated Chinese company, clearly showing a chair with the same design on public display at the Fair. Your client has established that the Chinese design was never sold or advertised in the EU.

Advise Shannon Seating Ltd on whether the Hong Kong exhibition constitutes a valid disclosure, and if any exceptions to the disclosure rules apply based on these facts. (8 marks)

- (b) Your client, Modern Infrastructure Ltd, makes and sells on-street telecommunications cabinets—the large green metal boxes that form part of the streetscape and which house telecom switchgear. They first sold their “Sentinel” model in France in December 2024 but never registered the design, which features a distinctive embossed texture on the side panels. A competitor, Bulwark Power Systems, has launched a cabinet with a near-identical design, including the same textured side panels.

Your client wrote to Bulwark alleging infringement of unregistered design rights. Bulwark argued in return that the design is effectively the same as a plain cabinet to pedestrians walking past, and provides a survey of 200 pedestrians, 90% of whom could not distinguish the “Sentinel” cabinets from conventional cabinets when shown photos.

Advise Modern Infrastructure Ltd on (i) the validity of their unregistered design rights, including consideration of the relevance of the survey evidence, and (ii) whether they will be able to enforce design rights against Bulwark. (12 marks)

SECTION C

9. Set out the circumstances in which decisions of EUIPO in respect of EU trade marks can be appealed against and identify the tribunals to which such appeals lie and the procedures to be followed.
10. Explain **EACH** of the following in the context of the EU trade mark system:
- (a) The preparation and submission of an application for an EU trade mark;

- (b) Securing a filing date;
 - (c) Claiming and obtaining priority in respect of an earlier trade mark application; and
 - (d) Claiming and obtaining seniority in respect of an earlier registered trade mark.
11. Outline and discuss the circumstances in which an EU trade mark court should stay infringement proceedings. In so doing, particular reference should be made to the decision of Barrett J in *Glaxo Group Ltd v. Rowex Ltd* [2015] 1 IR 185.
12. While referring to relevant case law, outline and discuss the steps to be taken in order to adduce evidence in support of a claim that the subject matter of an EU trade mark has acquired a “*reputation in the Union*” for the purposes of Article 9(1)(c) of Council Regulation (EU) 2017/1001 and indicate the type and breadth of evidence typically required.