

# TRADE MARKS PAPER 2007

## MARKERS COMMENTARY

### Question 1

This question required candidates to demonstrate their knowledge of strategies for searching trade marks and commenting on the registrability of trade marks.

#### 1(a) – Search Strategy

Most candidates received pass marks for this question. The most common errors involved not searching phonetic equivalents of letters, not targeting the distinctive part of the trade mark as opposed to non-distinctive words, and not having an understanding of the Vienna Classification and descriptor searches.

#### 1(b) – Inherent Registrability

The commentary on inherent registrability of the trade marks was generally well done. However many students struggled with the question relating to the shape of a container, being unaware of the descriptive significance of the shape.

### Question 2

2(a) required consideration of the issues involved in adding an extra class.

2(b) required knowledge of divisional trade mark applications, and sufficient knowledge to outline the procedure.

2(c) required knowledge of correction of an error under section 37(2)(b), the decision in *Re: Application by NEC Corporation*, and the relevant IPONZ Guidelines.

2(d) required knowledge of section 37(2)(a).

In general, Question 2 was handled poorly by candidates many of whom failed to demonstrate knowledge of, or sufficient familiarity with, section 37 and the procedures for filing an application for recordal of an assignment.

### Question 3

Question 3 required that candidates demonstrate their knowledge of the difference between section 76, which relates to the correction of errors in a trade mark registration (post-registration), and section 37(2)(b), which concerns correction of errors in trade mark applications (pre-registration).

Most candidates displayed a lack of knowledge of the sections, with few candidates achieving more than half marks.

#### **Question 4**

This question was one of the main questions of the paper (worth 32 marks) and deserved appropriate attention. Most candidates achieved more than half marks, although only a few got it more than 75% correct.

The best way of approaching this question was to deal with the two potential infringers in turn.

First as regards FTC Limited, candidates were required to assess whether there was trade mark infringement under section 89, whether there was a breach of the Fair Trading Act and/or passing off, and then discuss the procedures and remedies for dealing with an infringement. The discussion of remedies required practical knowledge such as sending a cease and desist letter, basic knowledge of legal remedies and the relevant sections of the Trade Marks Act and Fair Trading Act.

Candidates were also required to identify the potential for filing an Application for Declaration of Invalidity, the grounds for filing such an Application and the procedure for same.

As regards Speedy Imports Limited, candidates were required to again consider the issues of trade mark infringement (as above), with particular regard to a comparison of the goods (did they overlap?). In addition, practical advice to the client was required, such as recommending writing to TradeMe, filing a trade mark application for EMO and identifying and outlining the procedure for a Customs Notice.

#### **Question 5**

This question involved a typical fact situation of a client requiring advice as to the availability for use and registration of a trade mark.

In this question, candidates were required to advise the client whether use of its CRACKERJACK trade mark was likely to infringe any of the trade mark registrations disclosed by the search or whether there were any issues arising under the Fair Trading Act or the tort of passing off. Many candidates achieved around half marks and very few really excelled.

Most candidates could have picked up more marks by more carefully considering whether there was an overlap between the goods and services of the client and the goods and services of the cited registrations. In addition, candidates needed to assess the risks posed by the companies with relevant names and the domain name crackerjack.com. This could have been handled better by many candidates. With regards to the domain name, candidates were required to mention the possibility of spill over reputation from overseas, the risk to an application/registration filed by the client if crackerjack.com tried to prevent registration, and the kinds of investigations required to assess the risk posed by crackerjack.com.

Many candidates also failed to provide the client with advice as to the registrability of the client's trade mark, the goods/classes to be covered, and generally advise the client with regard to protection strategies.

### **Question 6**

This was another practical question requiring the candidates to advise a client as to the registrability of a trade mark and demonstrate knowledge about certification trade marks and collective trade marks.

To have achieved full marks, candidates needed to:

- Provide the client with trade mark searching advice.
- Discuss the best strategy for registering the trade mark - whether as a standard trade mark, a collective trade mark or a certification mark.
- Consider the function, advantages and limitations of the certification mark, and the same as regards a collective trade mark, and make a recommendation to the client as to the best option.

Generally the question was handled badly by candidates and obviously many had failed to cover certification marks and collective marks in their study.