

2005

PATENT ATTORNEYS

EXAMINATION

PAPER B

The New Zealand Law and Practice
Relating to Trade Marks

Regulation 158(1)(b)

Duration: 3 hours (plus 10 minutes for reading)

Candidates are not required to express answers in the form of a letter. The answer should outline the relevant issues, law, procedures and cases where appropriate.

1. Your client Fruitee Ltd makes and sells fruit juice and fruit concentrates. It has recently purchased the mineral water division of Aquaplus Ltd.

Aquaplus's mineral water division uses three trade marks – TruAQUA, AQUANAUT, and JINK. Fruitee Ltd wants to continue using all three marks for mineral water. In addition your client thinks JINK is such a good brand that it wants to use JINK on all its products.

Aquaplus's business records indicate that:

- TruAQUA is currently registered as a trade mark for "mineral water".
- AQUANAUT was registered as a trade mark for "mineral water", but the renewal appears to have been overlooked. It was due for renewal on 23 May 2003.
- JINK was registered as a trade mark for "mineral water". Again the renewal of the registration appears to have been overlooked. It was due for renewal on 25 January 2005.

The purchase agreement for the mineral water business makes no reference to trade marks. The CEO of Aquaplus acknowledges that it was intended the trade marks would be sold along with everything else which made up the business of Aquaplus's mineral water division. The CEO recalls that the above trade marks were filed in the name of Aquaplus Ltd and confirms that Aquaplus is happy to provide any assistance that may be required for transferring the trade marks to Fruitee Ltd.

Fruitee Ltd requests your advice as to its options, and what needs to be done to sort out its trade mark protection.

(10 marks)

2. You act for clothing designer Tweedie Sylvester. She wants to use the trade mark MONKEY for a range of t-shirts and casual wear. Tweedie is convinced it will be an important trade mark for her business. She filed a trade mark application last month covering “casual wear” in Class 25.

The compliance report from IPONZ cites a number of trade marks. They are all registered in the name of different owners :

MONKEE – “clothing and footwear” in Class 25, registered in 1998

MANKY – “clothing” in Class 25, registered in 1981

DONKEY – “clothing” in Class 25, registered in 2000

MONIKA E – “clothing and hats” in Class 25, registered in 1999

DR MUNKS – “footwear” in Class 25, registered in 2004

MONKEY – “bed linen” in Class 24, registered in 2002

MONKEY SUITS – “rental of formal and dinner suits” in Class 42, registered in 1990.

Tweedie now comes to you for assistance. She needs to be supplying product to retailers in about five weeks and wants to have her mark registered. You make some additional checks and note :

A company registration for “Monkey Wrench Limited”

A domain name www.monkeyware.co.nz.

Tweedie tells you that she knows her competitors. MANKY was a brand that failed in the 1980’s. DONKEY is a brand for jeans. MONIKA E is a label for upmarket designer dresses and accessories. Tweedie is unaware of any of the identified names, and she does not know of any of the other trade marks, and suspects they are not in use.

Advise Tweedie, and in your advice describe the enquiries and procedures you recommend.

(16 marks)

3. A US associate contacts you and advises it has a client company interested in filing a trade mark application in New Zealand.

The trade mark is ORGANIC SELECTION and it is used in relation to “frozen chickens”. The US company has used the ORGANIC SELECTION trade mark in the US for a number of years and it has become very well known in the US market.

It will be at least six months before the US company appoints an agent in New Zealand and gets ORGANIC SELECTION product on the New Zealand market.

A trade mark search does not identify any identical or similar trade marks for any relevant goods.

Your US associate wants to know whether a registration for ORGANIC SELECTION can be obtained and what difficulties might be encountered. Comment on the issues with reference to any relevant case law.

(6 marks)

4. You act for an established New Zealand winery. Since 1994 your client has been marketing a popular sauvignon blanc in a fish-shaped clear glass bottle which has an unusual scale-like pattern on it. Your client has decided that for the next vintage of this wine, it will use a deep blue coloured glass to make the bottle

The client’s research indicates no other company is using blue coloured wine bottles.

Your client asks you if it can obtain registered trade mark protection for its proposed new bottle in relation to wine in class 33.

Comment on the issues relating to registrability of the proposed new bottle.

(6 marks)

5. What is a divisional application and when may one be made ?

(4 marks)

6. Since 1990 Oz Co Pty Ltd has manufactured and marketed a range of hand tools in Australia under the ZONKA brand. Oz Co's product range includes OLD TIMER gardening tools which are based on designs that were popular back in the 1880s. There is no copyright in the design of the tools.

Oz Co registered the ZONKA trade mark in Australia in 1999 and filed a trade mark application for OLD TIMER in Australia on 12 February 2005 covering gardening tools in Class 7.

In late April, at a trade show in Australia, a Mr Black approached Oz Co asking whether he could be the New Zealand agent for the OLD TIMER range of tools. There were discussions and Mr Black asked for details of the product, including the construction methods, material costs and the foreign manufacturer. Mr Black said everything was fine and it was agreed Mr Black would be the New Zealand agent. There is an exchange of letters confirming this.

However, since early May 2005 Mr Black has not returned Oz Co's telephone calls or responded to e-mails and letters. Oz Co has also heard that its manufacturer has been contacted directly by Mr Black with a view to manufacturing some garden tools directly for Mr Black.

Oz Co has now discovered that Mr Black filed trade mark applications for ZONKA and OLD TIMER on 25 February 2005, covering hand tools and gardening tools in class 7. Acceptance of both applications was advertised on 25 April 2005. Oz Co has no trade mark registrations or applications of its own in New Zealand. It has not sold or marketed any of its tools in New Zealand, although Australian magazines and newspapers which occasionally have contained advertising for Oz Co's products will have circulated in New Zealand.

Oz Co seeks your advice as to what action it can take in relation to Mr Black's trade mark applications. Comment on what can be done, on what grounds, any deadlines, outline the relevant procedures, and identify any supporting material that may be required.

(14 marks)

7. The trade mark STORMERS was registered in New Zealand in 2002, in Class 28 for “card games and playthings”. The owner is Amazing Games Ltd (“AGL”) of the United Kingdom. 18 months ago AGL appointed an exclusive New Zealand distributor, NZ Distributors Ltd, to market and distribute AGL’s STORMERS card game.

NZ Distributors has been successfully selling the STORMERS card game to toy stores throughout New Zealand for the past 18 months. The game is extremely popular with children and teenagers. As well as forming part of the game, the cards can be traded. STORMERS card game tournaments are regularly held in many parts of New Zealand. There have been a number of magazine and newspaper articles on the STORMERS card game craze.

Ten months ago, one of the directors of NZ Distributors noticed a game branded STORMA when buying a set of golf clubs from Jack Co Ltd. NZ Distributors complained immediately to AGL, but the matter was not pursued.

NZ Distributors has now discovered that two local companies (Howard Toys Ltd and Bucko Games Ltd) have started selling the STORMERS card game. NZ Distributors does not supply those companies.

NZ Distributors wants something done about this situation – it conducts some investigations, and discovers the following information about each company. NZ Distributors sends the information to AGL demanding immediate action.

Jack Co. Ltd

Jack Co Ltd operates a chain of retail outlets selling sporting goods, sports shoes and sports clothing. It has been selling the STORMA game since September 2004. The STORMA product consists of instructions, a soft ball and four rackets. It is promoted as being “a great outdoor game – keeps the kids active and improves co-ordination”. NZ Distributors do not supply Jack Co Ltd with the card games.

Howard Toys Ltd

Howard Toys Ltd has been selling the STORMERS card game for one month. A sales assistant in the Howard Toys shop says that the card games are from the USA. Serial numbers show that the Howard Toys Ltd card games were part of a large purchase of STORMERS card games that Bulk Mart Inc of the USA made from AGL six months ago.

Bucko Games Ltd

Bucko Games Ltd has been selling STORMERS card games for two weeks. A shop assistant says, “They come from somewhere in Asia, so are the same price as at the stalls in the weekend market”. There is also a sign up in the store “our new website www.stormers.co.nz will be active soon – visit and keep up to date with the latest in STORMERS card packs”.

The games appear the same as the AGL product. However, on closer inspection it is noted there are a number of typographical errors in the instructions and the finish on the cards is not of the same standard as the AGL product. AGL manufactures all its card games in the UK.

AGL’s UK lawyer advises you that AGL wants to “clean things up in New Zealand.” Specifically, AGL wants to -

- stop the sale of counterfeit STORMERS games in New Zealand,
- stop the STORMA trade mark being used by Jack Co. Ltd, and
- stop sales of STORMERS games by Howards Toys Ltd and Bucko Games Ltd.

The UK lawyer asks you to identify the legal remedies AGL may have, the relevant requirements for establishing each cause of action, and recommendations as to how AGL should proceed.

No advice on contractual issues or what steps AGL may take outside of New Zealand is required.

(44 marks)