

Trade marks exam 2006.

Brief examiner's comments.

Question 1

The searching part of this question was generally well done.

Candidates were expected to identify phonetic variation and similar goods/services issues.

For the label trade mark the focus should have been on the distinctive parts of the label.

The inherent registrability part of the question presented more difficulty for some candidates. The trade marks cannot be looked at in isolation from the goods or services. A practical approach based on likely consumer perception and competitors' needs was lacking in many answers.

Question 2

The comparison of the trade marks was well done. The general criteria for comparison of marks and goods were identified, together with relevant cases.

A number of candidates only considered if the mark could be registered and failed to comment on use.

The registration of the mark by the distributor was addressed well with options for dealing with the mark given, for example assignment, opposition based on bad faith, or agreement for the distributor to continue.

Question 3

This question was poorly answered for different reasons.

Candidates were expected to identify advantages of trade mark registration compared to the use that had been made of the mark. For example company name registration gives no proprietary right per se, passing off requires reputation to be proved and can be geographically limited.

The process for registration is straight forward.

The application of the process to this particular mark involved considering the potential offensiveness of the mark.

Question 4

This question required an understanding of renewal deadlines, the process and supporting evidence requirements for assignment, how to deal with ABC Ltd, a check of IPONZ records and possibly seeking further information. Should the XEEB mark be restored and assigned or a new application filed? Merger of XEEZ mark in classes 9 and 16.

Question 5

The comparison of the marks and goods/services was generally well done.

Many candidates did not consider the relevance of the Octagon Ltd's use, for honest concurrent use, a defence to a claim of infringement, a ground of invalidity. A number of candidates struggled with explaining non-use.

Question 6

This question was generally well done. Candidates could identify the differences and criteria for the different types of mark. The advantages and disadvantages such as control over use and cost were more of a problem.

Question 7

This question involved an understanding of

- when trade mark applications and registrations can and cannot be amended and what changes are possible
- deadlines for claiming convention priority in the New Zealand application (cf from first overseas application)
- opposition and non-use deadlines and limitations on the reg 32 discretion

Question 8

Candidates were expected to:

- show an understanding of the law surrounding trade mark registration infringement (including the defence of having a registered trade mark), passing off, breach of the Fair Trading Act, well known trade mark infringement
- Apply the law to facts of the question – what reputation? Well known? What is the misrepresentation?
- Explain interim injunction criteria on facts of this case
- Identify grounds for invalidity application. For example bad faith, confusion or deception based on family of TRACK marks, confusion or deception based on well known mark, confusion or deception based on existing registration
- Possible trade mark applications.