

2006

PATENT ATTORNEYS

EXAMINATION

PAPER B

The New Zealand Law and Practice
relating to Trade Marks

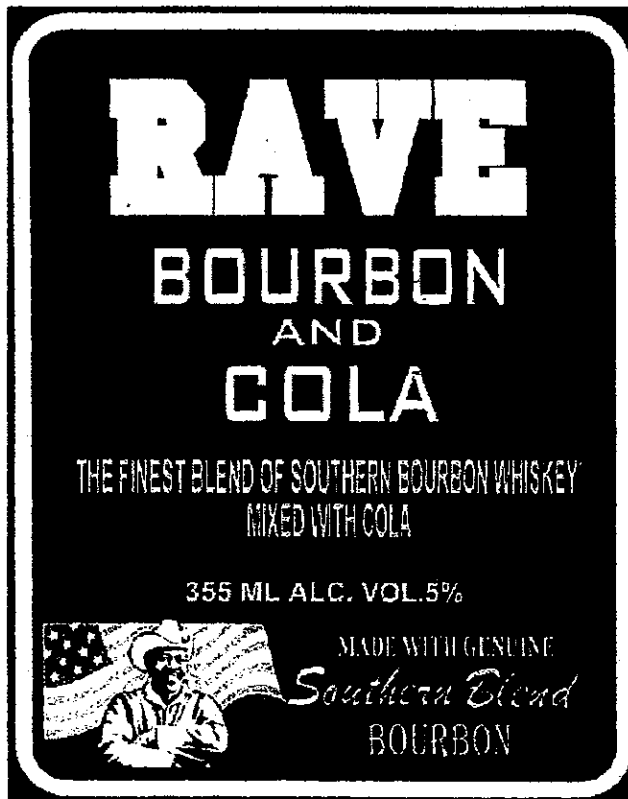
Regulation 158 (1) (b)

Duration: 3 hours (plus 10 minutes for reading)

Question 1

You are asked to conduct a search of the Trade Mark Register to advise on the availability for registration of the following trade marks:

- 1.1 DR KNOW for medical services
- 1.2 X.T.C. for nutritional supplements
- 1.3 RAVE label for alcoholic drinks



- 1.4 The colour red for cutlery
 - a) Outline the search strategy, method, or parameters for the searches you will undertake of the IPONZ records. **(8 marks)**
 - b) Comment on the inherent registrability of each trade mark. **(4 Marks)**

Question 2

Rapid Plc of the United Kingdom seeks your advice as to whether it can use and register its trade mark RAPID in New Zealand in relation to footwear. Rapid Plc has been using the RAPID brand on footwear in the United Kingdom since 1991 and in Australia since 2000; however Rapid Plc has never sold or marketed RAPID footwear in New Zealand.

Rapid Plc has recently appointed a New Zealand distributor, Stream Ltd. The first shipment of its RAPID shoes is ready to be sent to New Zealand from Rapid Plc's manufacturer in China.

A search of the Trade Marks Register, the Companies Register and domain names discloses the following:

- Registration no. 293847 RAPIDO – covering “swimwear” in class 25 – Rapido Swimwear Ltd
- Registration no. 296661 RAPIDE – covering “fire protective clothing and footwear” in class 9 – Safety Equipment, Inc
- Registration no. 348967 RAPIT – covering “clothing including casual wear” in class 25 – Rappers Inc.
- Registration no. 640646 RAPID – covering “hand bags, purses, wallets and belts” in class 18 – Racy Accessories Ltd
- Application no. 748619 RAPID – covering “shoes” in class 25 – filed by Stream Ltd on 1 June 2006

www.rapidz.co.nz is a website belonging to an outdoor equipment supplier
www.rapide.com is a website belonging to a company that sells safety equipment, including specialised clothing, footwear and headwear.

Rapid No. 1 Ltd
Rapid Tours Ltd

Advise Rapid Plc whether it can use and register RAPID in New Zealand. What steps should Rapid Plc take to ensure ownership of the mark? Outline any further information you require to advise Rapid Plc.

(15 marks)

Question 3

You receive an enquiry from Dennis Pere of Aroha Ltd. Dennis's company has been using the AROHA name since 2001 as the name of its restaurant in Dunedin.

Aroha Ltd intends to sell a range of 'heat and eat' frozen meals to a local supermarket under the trade mark AROHA TO GO.

Given that Dennis has already incorporated his company under the name Aroha Ltd, he asks whether he could and should register the AROHA trade mark and wants to know what the process is.

Answer Dennis's questions and provide any additional advice you consider relevant to Aroha Ltd on how to protect its name.

(10 Marks)

Question 4

You act for Spandin Ltd. Spandin informs you that it has just bought all the assets of Xeez Ltd, which is in receivership.

Until recently Xeez Ltd marketed a range of toys and playthings (class 28) and electronic games (class 9) under both the XEEZ and XEEB brands.

The playthings and games were sold by Xeez Ltd through its two XEEZ toy stores. Spandin wants to own all of Xeez Ltd's trade marks and instructs you to transfer them to Spandin Ltd.

The asset sale documents do not specifically mention the trade marks.

A search of the Register of Trade Marks reveals the following trade mark registrations:

Number	mark	class	date	renewal due
294625	XEEZ	28	3 July 1998	(expired) 3 July 2005
315947	XEEZ	16	3 July 1999	3 July 2016

(You discover that ABC Toys Ltd is currently recorded as a licensee of Registration no. 315947)

315948	XEEZ	9	3 July 1999	3 July 2016
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You also discover the following registration owned by Charles Farlie - the founding director of Xees Ltd :

315975	XEEB	9	3 July 1999	(expired) 3 July 2006
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Outline the best way for your client to achieve its objectives and organise the trade mark portfolio and what supporting documents or other information you require.

(13 marks)

Question 5

Octagon Ltd uses the trade mark OCTAGON in relation to house paints and house painting services, and has done so since 1998. Octagon Ltd recently filed an application to register the trade mark OCTAGON in relation to paint (class 2) and house painting services (class 37). The application is examined. The compliance report cites, as a bar to registration under section 25, the trade marks set out below. Octagon tells you the owner of Registration no. 238641 was struck off the Companies Register about 3 years ago.

Number	Mark	Date	Class	Goods/Services	Status
732981	OCTAGEN	5-7-04	2	paints, lacquers, varnishes	registered renewal due 5/7/2014
238641	OCTAGON	7-7-94	2	preservatives against rust and against deterioration of wood	registered renewal due 7/7/2015
244955	OCTAGO	6-10-98	37	water blasting services	expired renewal due 6/10/2005

Octagon Ltd seeks your help. Outline the issues and the options for addressing the issues.

(12 marks)

Question 6

Explain what collective trade marks and certification trade marks are. Contrast them with standard trade marks and identify any advantages or limitations collective trade mark registrations and certification trade mark registrations offer.

(6 marks)

Question 7

Comment on whether the following clerical errors can be corrected and what should be done.

- 7.1 Registration No 234176 has been registered as SEELY instead of SEALY.
- 7.2 An application for the mark PASTY should have been for the mark PASTE.
- 7.3 Application No 740012 has been accepted and advertised. The correct convention priority date is 12 June 2005 and not 21 June 2005 as claimed in the original trade mark application.
- 7.4 An application filed on 4 July 2006 should have claimed a convention priority date of 1 April 2006.
- 7.5 The goods 'computer mouses' should have been included in a registered trade mark covering 'computer hardware and software'.
- 7.6 The deadline for filing an opposition to a trade mark was incorrectly noted and passed six weeks ago.
- 7.7 The deadline for filing a counterstatement to an application for removal for non-use of a trade mark registration was incorrectly noted and passed two weeks ago.

(12 marks)

Question 8

Your client is Soft-Track Ltd (ST). ST is an Auckland based software developer that develops and sells a broad range of software products.

ST has a successful range of software products (first launched and advertised in early 2004), which can be used to track and analyse data from different sources and times. The data can be presented in a variety of formats, such as charts, tables and maps.

These products carry the following brands:

TRACK-GEO - geologists and engineers use this,
TRACK-TOPO - geographers use this,
TRACK-POP - actuaries and government statisticians use this,
TRACK-HOSP - hospitals and health boards use this.

ST has a single trade mark registration for TRACK-HOSP covering "computer software and hardware in the field of health care". The mark was registered in March 2004.

ST is the market leader in this field of software in New Zealand and claims to be the biggest software development company in New Zealand. ST has won export awards. There has been publicity in trade magazines for ST. In mid-2004 a television news item reported on sales of ST's TRACK-HOSP software to several Australian hospitals.

ST advises that it has discovered a software development firm called Klein, Samson and Taylor (KST) of Christchurch marketing a product called TRACK-FARM. TRACK-FARM is a software product that analyses and tracks pasture and soil data.

ST became aware of the TRACK-FARM product two weeks ago when one of the ST software developers saw a KST brochure at her brother's farm in the Waikato region. ST's investigations indicate that the TRACK-FARM product was launched in January 2006. ST has also discovered that KST applied to register the trade mark TRACK-FARM covering "data analysis computer software" in December 2005. The mark is now registered.

ST says that the Klein of KST is an ex-employee of ST who, prior to resigning at the end of 2005, was working on a software product for analysing and tracking pasture data code-named "TRACK-FARM".

ST is upset by the TRACK-FARM branding and wants to know if and how ST can stop KST's use of the TRACK-FARM trade mark, and what ST should do.

Outline the relevant law and comment on what action ST could take. Refer to the issues you see, relevant cases and procedures and any further information you would require. No comment is required on possible misuse of confidential information.

(20 marks)