

2014

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

Briefly comment on the registrability under the Trade Marks Act 2002 of the following trade marks:

- (a) WILL AND KATE for baby clothes
- (b) MOORE for television broadcasting services
- (c) “Ni hao” (Chinese for “hello”) for restaurant services
- (d) A portrait of a Maori chief drawn in 1865 for cigarettes
- (e) XLR8R for animal growth hormone

(5 marks in total)

Question 2

Briefly answer all of the following questions:

- (a) How does IPONZ treat 2 trade mark applications that are filed on the same day, for the same mark, and the same products, but in different owner names?
- (b) What is the difference (if any) between the legal effect of a change of name, an assignment, and a merger?
- (c) Name a situation when a series trade mark application cannot be divided.
- (d) After how many years can a registration not be challenged based on Section 18 grounds, and from what date does that period begin?
- (e) How long can a potential opponent extend the period for filing a notice of opposition under the Trade Mark Regulations 2003?

(5 marks in total)

Question 3

Your clients, Marco and Sophia, are setting up a craft beer brewery in the Coromandel with an on-site restaurant/café and bar. Marco's speciality is in beers with fruity undertones and Sophia's is gourmet meat pies.

Customers will be able to tour the brewery, have beer tastings, purchase beer, as well as eat Sophia's food and drink Marco's beer at the restaurant/café. Eventually, Marco would like to sell his beer to specialty bars and liquor outlets around New Zealand.

Marco and Sophia have settled on MISTY MOUNTAIN as a trade mark they can use in relation to their business and all of their products. They have sought your advice as to whether or not they can use and register MISTY MOUNTAIN. Marco and Sophia do not own any trade mark registrations or domain names.

You conduct a search of the New Zealand Trade Mark Register and locate the following registrations, which with the exception of the registrations noted in (a) and (b), are all in the names of different owners:

- (a) MISTY's MOUNTAIN CAFE – "café services" in class 42, registered in 2005.
- (b) MISTY'S – "restaurant services; takeaway pizza services" in class 42, and "baked goods, including bread, pizza pies, fruit pies and desserts" in Class 30, registered in 2005.
- (c) MIST – "beer; non-alcoholic beverages" in class 32, registered in 2010.
- (d) DARK MIST – "alcoholic ginger beer; beer; ale; stout beer" in class 32, registered in 2000.
- (e) Sea Mist – "aerated beverages including fruit drinks and beer" in class 32, registered 1993.
- (f) NATURAL MIST – "fruit drinks and beverages; beer" in class 32, registered in 2009.
- (g) WILD MOUNTAIN – "fruit juices; syrups and other preparations for making beverages" in class 32, registered in 2006.
- (h) MARCO's - "craft beer" in class 32, registered in 2004.

You also conduct a marketplace search and locate the following additional references:

(i) A company named Misty's Mountain Tours Limited

The following domain names:

(j) www.mistysbrew.co.nz

(k) www.marcosbeer.co.nz

(l) www.mistymountaincafe.com.au

Advise Marco and Sophia.

(20 marks in total)

Question 4

Dolphin Studios Limited (“DSL”), has decided to diversify its computer animation business and has purchased the rights to four existing and very popular mobile phone game applications (“Apps”) from Muttonbird Apps Limited (MAL). The games in question are called SPIDERBACK, LIZZY LIZARD, FIREBIRD and WINKY and each of the games has a cool looking character associated with it. DSL intends to develop these games further and start selling them overseas.

In the sale and purchase agreement, DSL’s lawyer effected the assignment of MAL’s copyright in the software and the graphics (including the copyright in the popular characters) to DSL. However, the trade mark rights for each of the games were not covered by the sale and purchase agreement, and DSL is anxious to secure its ownership of these trade marks and any related rights.

You are advised by MAL that its ownership of the trade mark rights is based on the following:

LIZZY LIZARD is a currently registered trade mark covering all relevant products and services.

SPIDERBACK is not registered but it has been used in New Zealand since May 2012 as the trade mark for the mobile computer game.

FIREBIRD was registered but it has not been renewed. It was due for renewal on 20 September 2013.

WINKY was the subject of a trade mark application filed on 10 May 2013. Unfortunately, MAL filed the application itself and failed to respond to the first compliance report.

MAL acknowledges that it was intended the trade marks would be transferred to DSL along with all other IP rights as part of the agreement. MAL has offered to provide anything that will assist with the transfer of the trade marks to DSL.

Advise DSL on the following:

- (a) What steps should be taken to safeguard DSL’s ownership of all the trade marks that might be associated with the Apps. Your answer does not need to address any issues relating to the appropriate classes, or the product and service coverage for any trade mark applications or registrations.

(15 marks)

- (b) Describe the general nature of the Madrid Protocol system and how it might assist DSL with obtaining rights overseas to the trade marks. Without referring to individual countries, what are the downsides to using the Madrid Protocol?

(5 marks)

(20 marks in total)

Question 5

Bright Meadows is a large health food and health supplements company based in the United States. One of its products is a blue corn based health supplement called BLUE WONDER which has particularly high antioxidant levels.

The BLUE WONDER product was sold in many different countries including New Zealand from 2006. Exports to New Zealand ceased in May 2011 due to a new law prohibiting the sale of genetically modified products.

Bright Meadows has received a letter from a New Zealand company named Wild Blue Yonder Limited (“WBY”) which says that:

- (a) WBY owns a trade mark registration in New Zealand for WILD BLUE YONDER covering “antioxidants; fish oil” which was registered in 2013, and
- (b) WBY has recently applied to register the word mark BLUE YONDER for “fish oil”, but an adverse compliance report has issued which cites the following registration under Section 25(1)(b):

Mark: BLUE WONDER

Owner: Bright Meadows Limited

Products: “Health supplements; dietary supplements; vitamin supplements; mineral supplements; antioxidants”

Application date: 5 March 2005

Actual registration date: 18 April 2006

- (c) WBY believes that the respective products should be able to co-exist in the New Zealand marketplace because the marks are different and the respective products are made from different constituents. Based on this, WBY requests that Bright Meadows provide a letter of consent within 2 weeks for the use and registration of BLUE YONDER in New Zealand in respect of “fish oil”.

Bright Meadows advises you that:

- (a) it wants to sell the BLUE WONDER product in New Zealand in the future;
- (b) it considers that the BLUE WONDER and BLUE YONDER products are too similar because, while fish oil has many therapeutic properties, it is also a powerful antioxidant; and
- (c) Bright Meadows does not want its product associated with anything “fishy”.

Advise Bright Meadows on each of the following:

(a) the nature and effect of a letter of consent;

(5 marks)

(b) what action WBY could take to improve its position and achieve its goals;

(5 marks)

(c) what action Bright Meadows could take to improve its position and achieve its goals; and

(5 marks)

(d) the likely outcome of any proceedings.

(5 marks).

(20 marks in total)

Question 6

Phoenix Transport Limited (“PTL”) is a freight business based in Auckland. PTL has used the name “Phoenix” since 1989 when the company was set up and incorporated by its CEO (Shawn Hawkins) after he returned from a 3 year stint working in Europe.

PTL transports freight around New Zealand mainly by truck, van and train, but also sometimes by sea and air. PTL has just received shipping documents which relate to freight travelling from Amsterdam to a consignee in Hamilton. The letterhead on the shipping documents identifies Phoenix International (“PI”) as its source and gives an address in Auckland for Phoenix International.

Shawn knows of Phoenix International as it is a very large multinational company based in The Netherlands with offices all over the world. Shawn knew that Phoenix International sent freight to New Zealand, but as far as he was aware it had always used local New Zealand agents to deliver that freight to consignees within New Zealand.

Shawn was not previously aware that Phoenix International had a branch office in New Zealand, but his investigations indicate that Phoenix International recently opened an office in Auckland. He is naturally concerned that Phoenix International’s entry into the market will lead to confusion or deception amongst his customer base.

Shawn’s investigations indicate that Phoenix International

- (a) first used the PHOENIX brand on shipping documents in New Zealand in 1976, and use continued through the 1980s;
- (b) did virtually no business in New Zealand during the 1990s and 2000s;
- (c) started using a Wellington based company to move its freight around in 2009;
- (d) started moving significant quantities of freight around NZ from late 2012 using 2 or 3 local transport companies, which led to it opening an office in May 2014 in Auckland;
- (e) has relatively low reputation amongst freight transport companies in NZ because it has only used a few of them to deliver freight to New Zealand consignees; and
- (f) is now marketing freight services to New Zealanders.

Shawn then tells you that he conducted a quick trade mark search on the New Zealand Trade Mark Register and located a trade mark registered in 2009 by Phoenix International - No.802200 PHOENIX in class 39 covering “transport services; freight and mail services; storage services”.

Shawn is now very worried and says he wants to take immediate legal action to shut down Phoenix International’s business in New Zealand.

Advise Shawn on the issues and what actions his company should take, the chances of success and the likely outcome including possible consequences. Ensure that you explain any legal procedures and remedies that are relevant.

(30 marks in total)