

2016

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

Comment on the inherent registrability of the following trade marks.

- (a) AOTEAROA (the Maori name for New Zealand) for live lambs [1 mark]
- (b) RED SKINS for baseball caps [1 mark]
- (c) KLEAN for disinfectants [1 mark]
- (d) JUSTIN BEIBER (a well-known musician and singer) for clothing [1 mark]



- (e) (the shape of a bottle) for soda [1 mark]

[5 marks in total]

Question 2

Comment on whether the following marks are registrable having regard to Section 25 of the Trade Marks Act.

- (a) MIGHTY MIX for cat food and dog food (Class 31)

There is a prior registration for MIGHTY MAX for “stock food; feed supplements for livestock” (Class 31) [3 marks]

- (b) DARI-KOOL for “refrigerators” (Class 11)

There is a prior registration for VARICOOL for “refrigerators” (Class 11) [2 marks]



- (c) (label) for “talcum powder” (Class 3)

There is a prior registration for NEW BABY for “non-medicated toilet preparations in powder form for use in relation to babies” (Class 3) [3 marks]

[8 marks in total]

Question 3

Answer the following questions.

- (a) What provisions are there for recording licenses against registered trade marks under the Trade Marks Act? [1 mark]
- (b) During what period can a registered trade mark be renewed? [1 mark]
- (c) What are the purposes and benefits of the Nice classification system? [3 marks]
- (d) In what circumstances can a flag be registered as a trade mark? [2 marks]
- (e) What are the mandatory requirements to file a trade mark application? [2 marks]
- (f) What are the mandatory requirements to record a transfer in respect of a registered trade mark? [4 marks]
- (g) What is the function of the Advisory Committee? [1 mark]
- (h) What criminal offences are defined in the Trade Marks Act? [3 marks]

[17 marks in total]

Question 4

- (a) Discuss the border protection measures available under the Trade Marks Act, including the procedures governing the seizure, detention and release of imported goods under those provisions. [8 marks]
- (b) What factors should be taken into account by New Zealand Courts when deciding whether use of a New Zealand registered trade mark by a United Kingdom business on a .com website hosted in the United Kingdom is use in New Zealand for the purpose of infringement? [2 marks]

[10 marks in total]

Question 5

Purple Taxi Limited (PTL) is a taxi company that has been operating in Auckland since 1998. It is very successful and most people around Auckland recognise its distinctive purple coloured vehicles. PTL owns a trade mark registration for the colour purple in class 39 covering “transportation services”.

Violet Taxi Limited (VTL) which started in Wellington in 2010 has recently expanded its operations into Auckland. VTL’s taxis are coloured violet. To avoid small fares, VTL’s taxis have been turning away customers on the street who want to take short trips. On two occasions members of the public have called PTL to complain. PTL believes that is because of VTL’s predominant use of the word VIOLET and the colour violet on VTL’s taxi livery and website.

- (a) Advise PTL about the legal causes of action open to it and the legal remedies that might be available. [10 marks]

Four additional issues (described below) are also causing PTL concern. Advise PTL about the legal causes of action open to it in respect of each (do not discuss remedies).

- (b) An advertisement on Auckland billboards that states “Violet is the new purple”. [2 marks]
- (c) One of the drivers working for VTL has registered the domain names purpletaxi.nz and purpletaxis.nz in his personal name and those web addresses are redirecting web traffic to VTL’s website. [2 marks]
- (d) VTL is the applicant for an accepted trade mark application filed 1 month ago in respect of the colour violet for *‘providing temporary use of online non-downloadable software for providing transportation services, bookings for transportation services and for dispatching motorized vehicles to customers’*. [4 marks]
- (e) A postal mail out to businesses in the Auckland CBD stating that VTL is providing a fixed fee cash service to take customers from the CBD to the Airport. The mail out correctly notes that no other taxi business in Auckland offers a similar fixed fee service, and then has a picture of PTL’s logo with a red cross next to it. [2 marks]

[20 marks in total]

Question 6

Your client, Marty de Fly, is an inventive genius who recently developed a type of skate board that uses magnetic fields to travel centimetres above the ground. He began selling his toy under the name FLY BOARD in May 2015. Unfortunately, due to safety issues (his boards had a habit of nose diving) Marty was forced to stop selling his boards about 6 months ago. However, he has nearly sorted out the problem and he has started advertising his second generation FLY BOARD toy for pre-order.

For the last 30 years Air Technologies LLC has been improving hovercraft technology to develop its own hover board, which it is finally about to launch on the New Zealand market. Air Technologies LLC registered a trade mark in 1985 for FLYING BOARD covering 'transportation devices' in class 12.

Last week Air Technologies LLC noticed Marty's advertising and immediately contacted him threatening legal action if he didn't stop selling his device under the FLY BOARD name which Air Technologies LLC considers to be confusingly similar to its FLYING BOARD trade mark registration.

Marty thinks this is very unfair. He says there are plenty of other companies using the name FLYING BOARD to describe a range of skate board type products that use SEGWAY™ technology, fan technology or self-balancing/powered single wheel technology. He does not think Air Technologies LLC has done anything to stop these users of FLYING BOARD.

- (a) Marty wants to keep using his FLY BOARD brand and seeks your advice. Advise Marty on the legal causes of action available to Air Technologies LLC and the potential defences to such causes of action open to Marty. [8 marks]

It is one year later and due to financial problems Air Technologies LLC has given up its fight against Marty and gone into liquidation. Marty's board is now getting a lot of attention and he is about to spend a lot of money promoting his board and building up his business. He also believes there is a market for renting his boards at local tourist destinations.

- (b) Advise Marty what he should do to ensure he has strong defensible trade mark rights in the brand under which he markets his boards. [2 marks]

[10 marks in total]

Question 7

Prepare a full New Zealand clearance search strategy for BLACK EAGLE for clothing.

Explain in detail what you would search (including Boolean operators), where you would search and the criteria you would use.

[10 marks in total]

Question 8

Superb Lamb Limited (SLL) is about to start selling sheep meat in New Zealand using the trade mark BONNY MUTTON.

SLL has become aware of a New Zealand company called French Sheep Exports Limited (FSE) which has been exporting sheep meat for the last 30 years from New Zealand to France under the trade mark LE BON MOUTON (which is French for 'the good sheep'). FSE has sold virtually all of its sheep meat outside of New Zealand, although occasionally due to cancelled export orders, small quantities of its LE BON MOUTON branded mutton have appeared in PAK 'N' SAVE supermarkets in Christchurch. The last time this happened was in June 2013.

SLL seeks your advice as to whether it can use and register the trade mark BONNY MUTTON in New Zealand.

You therefore conduct a search of the New Zealand Trade Marks Register for BONNY MUTTON and locate the following trade mark registrations.

- BON MOUTON (registered) for "Meat products including frozen, chilled, preserved, dried and cooked meat" (Class 29) filed 1 May 1986. Owned by French Sheep Exports Limited.
- BONDI MUTTON (registered) for "Shepherd's pies; meat pies and Cornish pasties" (Class 30) filed 5 January 2014. Owned by Ewe Beauty Pies Limited.
- BONNY'S MUTTON MECCA (registered) for "Retail and wholesale services" (Class 35) filed 27 June 2013. Owned by Bonny Loves Meat Limited.

SLL wants to launch its new brand next month.

Advise SLL.

[20 marks in total]

Nice Classification (10th Edition)

List of Classes

Class 1

Chemicals used in industry, science and photography, as well as in agriculture, horticulture and forestry; unprocessed artificial resins, unprocessed plastics; manures; fire extinguishing compositions; tempering and soldering preparations; chemical substances for preserving foodstuffs; tanning substances; adhesives used in industry.

Class 2

Paints, varnishes, lacquers; preservatives against rust and against deterioration of wood; colorants; mordants; raw natural resins; metals in foil and powder form for use in painting, decorating, printing and art.

Class 3

Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices.

Class 4

Industrial oils and greases; lubricants; dust absorbing, wetting and binding compositions; fuels (including motor spirit) and illuminants; candles and wicks for lighting.

Class 5

Pharmaceuticals, medical and veterinary preparations; sanitary preparations for medical purposes; dietetic food and substances adapted for medical or veterinary use, food for babies; dietary supplements for humans and animals; plasters, materials for dressings; material for stopping teeth, dental wax; disinfectants; preparations for destroying vermin; fungicides, herbicides.

Class 6

Common metals and their alloys; metal building materials; transportable buildings of metal; materials of metal for railway tracks; non-electric cables and wires of common metal; ironmongery, small items of metal hardware; pipes and tubes of metal; safes; ores.

Class 7

Machines and machine tools; motors and engines (except for land vehicles); machine coupling and transmission components (except for land vehicles); agricultural implements other than hand-operated; incubators for eggs; automatic vending machines.

Class 8

Hand tools and implements (hand-operated); cutlery; side arms; razors.

Class 9

Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; compact discs, DVDs and other digital recording media; mechanisms for coin-operated apparatus; cash registers, calculating machines, data processing equipment, computers; computer software; fire-extinguishing apparatus.

Class 10

Surgical, medical, dental and veterinary apparatus and instruments; artificial limbs, eyes and teeth; orthopedic articles; suture materials.

Class 11

Apparatus for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating, water supply and sanitary purposes.

Class 12

Vehicles; apparatus for locomotion by land, air or water.

Class 13

Firearms; ammunition and projectiles; explosives; fireworks.

Class 14

Precious metals and their alloys; jewellery, precious stones; horological and chronometric instruments.

Class 15

Musical instruments.

Class 16

Paper and cardboard; printed matter; bookbinding material; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paintbrushes; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus); plastic materials for packaging; printers' type; printing blocks.

Class 17

Unprocessed and semi-processed rubber, gutta-percha, gum, asbestos, mica and substitutes for all these materials; plastics in extruded form for use in manufacture; packing, stopping and insulating materials; flexible pipes, not of metal.

Class 18

Leather and imitations of leather; animal skins, hides; trunks and travelling bags; umbrellas and parasols; walking sticks; whips, harness and saddlery.

Class 19

Building materials (non-metallic); non-metallic rigid pipes for building; asphalt, pitch and bitumen; non-metallic transportable buildings; monuments, not of metal.

Class 20

Furniture, mirrors, picture frames; unworked or semi-worked bone, horn, ivory, whalebone or mother-of-pearl; shells; meerschaum; yellow amber.

Class 21

Household or kitchen utensils and containers; combs and sponges; brushes (except paintbrushes); brush-making materials; articles for cleaning purposes; steelwool; unworked or semi-worked glass (except glass used in building); glassware, porcelain and earthenware.

Class 22

Ropes and string; nets; tents, awnings and tarpaulins; sails; sacks; padding and stuffing materials (except of paper, cardboard, rubber or plastics); raw fibrous textile materials.

Class 23

Yarns and threads, for textile use.

Class 24

Textiles and substitutes for textiles; bed covers; table covers.

Class 25

Clothing, footwear, headgear.

Class 26

Lace and embroidery, ribbons and braid; buttons, hooks and eyes, pins and needles; artificial flowers.

Class 28

Games and playthings; gymnastic and sporting articles; decorations for Christmas trees.

Class 29

Meat, fish, poultry and game; meat extracts; preserved, frozen, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs; milk and milk products; edible oils and fats.

Class 30

Coffee, tea, cocoa and artificial coffee; rice; tapioca and sago; flour and preparations made from cereals; bread, pastries and confectionery; edible ices; sugar, honey, treacle; yeast, baking-powder; salt; mustard; vinegar, sauces (condiments); spices; ice.

Class 31

Agricultural, horticultural and forestry products; raw and unprocessed grains and seeds; fresh fruits and vegetables; natural plants and flowers; live animals; foodstuffs for animals; malt.

Class 32

Beers; mineral and aerated waters and other non-alcoholic beverages; fruit beverages and fruit juices; syrups and other preparations for making beverages.

Class 33

Alcoholic beverages (except beers).

Class 34

Tobacco; smokers' articles; matches.

Class 35

Advertising; business management; business administration; office functions.

Class 36

Insurance; financial affairs; monetary affairs; real estate affairs.

Class 37

Building construction; repair; installation services.

Class 38

Telecommunications.

Class 39

Transport; packaging and storage of goods; travel arrangement.

Class 40

Treatment of materials.

Class 41

Education; providing of training; entertainment; sporting and cultural activities.

Class 42

Scientific and technological services and research and design relating thereto; industrial analysis and research services; design and development of computer hardware and software.

Class 43

Services for providing food and drink; temporary accommodation.

Class 44

Medical services; veterinary services; hygienic and beauty care for human beings or animals; agriculture, horticulture and forestry services.

Class 45

Legal services; security services for the protection of property and individuals; personal and social services rendered by others to meet the needs of individuals.