

2015

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 of the following trade marks under the Trade Marks Act 2002:

(a) MYSURE for "insurance services".

(1 mark)



(b) - This image of Krishna (an Indian religious figure) for "electronic cigarettes".

(1 mark)

(c) BEE KEEPER for "beer; mead" (mead being a type of beer made from honey).

(1 mark)

(d) St Bathans (a small town in Central Otago, famous for its apricots) for "dessert wine".

(1 Mark)

(e) SELFEE for camera equipment

(1 mark)

(5 marks in total)

Question 2

Answer all of the following:

- (a) Excluding non-use, what are the grounds for revoking a trade mark registration under s.66 of the Trade Marks Act 2002.

(3 marks)

- (b) Briefly explain the convention priority system.

(1 mark)

- (c) Your client wants to register the mark TANIWHA (a mythical water spirit from Maori legend) for music services. Which additional 3 of the following marks would be most likely to qualify as a valid series of trade marks along with TANIWHA, and why?

- (i) Tunny-far
- (ii) tane pha
- (iii) taniwha
- (iv) Ta-Ni-Wha
- (v) Tan iwha
- (vi) TAN-I-WHA
- (vii) TaNiWhA

(2 marks)

- (d) What is the difference between “continued processing” and “abeyance” within the context of the examination of trade mark applications?

(2 marks)

- (e) What are 4 advantages of owning a registered trade mark compared to simply using a mark in trade?

(2 marks)

(10 marks in total)

Question 3

Xavier Black is about to launch a new taxi business in Auckland which he plans to call "Firebird Taxis".

He recently visited Cuba, and became obsessed with the 1950s and 60s American cars being used as taxis. Since returning to New Zealand Xavier has converted four old American cars into novelty taxis. One of his taxis is an iconic Pontiac Firebird which still carries the manufacturer's graphics on its bonnet of a bird engulfed in flames -



Xavier has also developed merchandise for customers of his taxis which supports the theme of a 'Firebird' with T-shirts and caps featuring the following image -



Xavier plans to attract customers by offering the full 50's American experience. One of his promotional ideas is to advertise that passengers will receive free American style candies while being entertained with old-style American music on the taxis' sound system.

You conduct an availability search of the New Zealand Trade Mark Register for FIREBIRD and locate the following trade mark applications and registrations, all owned by different parties:

- (i) **Firebird Music** - in class 9 covering "*downloadable music; compact discs; digital video discs; electronic media devices; data carriers*" and
- class 41 covering "*musical entertainment services; radio entertainment services; music production services; games and quizzes; the provision of information relating to the aforesaid services*".

This registration is owned by Firebird Music Productions Limited (refer paragraph xi below). It has an application date of 23 October 2002 and a registration date of 20 January 2004.

- (ii) **FIREBIRD** - in class 12 covering "*Vehicles for locomotion by land, air or sea; parts, fittings and accessories for the aforesaid products*". This has an application date of 16 March 1965 and was registered on 19 July 1967. The owner is General Motors, Inc which manufactured Pontiac cars between 1926 and 2009.

- (iii) **BIRD** – in class 25 covering “*clothing footwear and headgear including T-shirts, hoodies, hats, jumpers, sweaters, gloves, jackets, coats, socks and scarves*”, applied for on 15 August 2010 and registered on 23 March 2012. The owner is an individual who trades as ‘Bird Clothing’ and who owns the website www.birdclothing.co.nz (refer paragraph xii below).
- (iv) **ANGRY BIRD** – in class 25 covering “*clothing, including hats, caps, shoes, scarves, socks*” with an application date of 10 May 1994 and a registration date of 18 December 1996.
- (v) **PHOENIX** – in class 25 covering “*clothing*”. This has an application date of 10 March 1985 and was registered on 26 July 1987.
- (vi) **FIREBIRD** – in class 30 covering “*coffee, tea, cocoa, sugar; confectionery; chocolate; chocolate containing chilli; chocolate containing alcohol; iced confections; cakes; sauces (condiments)*” with an application date of 18 November 1987 and was registered on 22 February 1988.
- (vii) **Bird** – in class 39 covering “*Transport services; taxi services; transportation of passengers by sea*”. This registration expired on 18 July 2014. The owner is Greg Bird and he owns the website www.birdtaxi.co.nz (refer paragraph xiv below).
- (viii) **FIREHAWK** – in class 39 covering “*transport services; vehicle rental services; helicopter rental services; tourism services; sightseeing services; travel arrangement services*”. This mark has an application date of 12 January 1990 and was registered on 10 December 1990. The owner is Firehawk Helicopters Limited (refer paragraph x below).
- (ix) **PHOENIX** – in class 39 covering “*transportation services; freight services; mail services; supply chain logistics services; wharf cartage services*” with an application date of 16 August 2014 and a publication date 28 April 2015.

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

- (x) A company named Firehawk Helicopters Limited listed as “struck off”.
 - (xi) A company named Firebird Music Productions Limited
 - (xii) A domain name www.birdclothing.co.nz
 - (xiii) A domain name www.firebirdcars.com.au
 - (xiv) A domain name www.birdtaxi.co.nz
- (a) Advise Xavier whether his proposed trade mark is available for use and registration in New Zealand for his products and services.

- (b) Identify any risks in Xavier's proposed branding, and advise what can be done to mitigate those risks.

Please ignore any issues relating to copyright in the music.

(28 marks)

Question 4

Max Wildling owns a successful vineyard in the Marlborough region and sells fine wines across New Zealand. In 2001 he decided to diversify by producing a high quality "grape brandy" similar to Cognac. The 2002 vintage is finally ready for bottling after having spent 13 years maturing.

Max plans to base the branding for his brandy around the New Zealand hawk which is a bird often seen flying around his vineyard. He wants to call his brandy "Hawkeye" and he will also use a Maori translation of this name which he tells you is "KahuKaru". Both the English and Maori wording will be written in a stylised script on the product packaging.

Max's brandy will be sold in a distinctive old-style glass bottle. The body of the bottle balloons out from the bottom of a bulbous neck and then tapers slowly down to its base where the glass is roughly 30mm thick to give the bottle a heavy old fashioned feel.

The bottle also features the embossed wings of a hawk, with one wing on each side of the bottle. Around the neck of the bottle is a dark maroon ribbon held in place with a red wax seal that features a depiction of a hawk in flight. The website advertising for the product will also feature a moving image of a hawk in flight and the sound of a hawk's distinctive call.

- (a) Advise Max on a trade mark search strategy to determine the availability for use and registration of his potential trade marks. You should specify the marks that should be searched, where they should be searched and how they should be searched.

(5 marks)

- (b) Assuming the marks are available for use and registration, advise Max on the following:
- (i) Any special requirements for filing each mark.
 - (ii) Any registrability issues that are likely to arise and whether these can be overcome, and how.
 - (iii) Which marks to file in order to achieve a minimum level of protection at a minimum cost, and which marks (in order of importance) to achieve a maximum level of protection.

(10 marks)

(15 marks in total)

Question 5

Since 2000, Miraka Systems Limited (MSL) has been running educational programs for children with special needs based around interactive drawing. MSL's business is well-known within special education circles in Wellington.

In 2012 MSL began receiving phone calls and letters from people around New Zealand requesting after-sales services relating to MARIEKA brand robots. The MARIEKA robot was developed in Luxembourg by Marieka BV in around 2004 and has become very popular in many countries including New Zealand. It is very human-looking and is capable of advanced interaction with people. It functions much like a home computer connected to the internet, and is able to control home appliances, entertainment systems, security systems, lighting and air conditioning systems etc.

Computer applications, such as educational games and programs produced by Marieka BV, can also be downloaded to the robot. These are not sold in New Zealand, but they can be ordered online from Marieka BV's Dutch website.

There are currently over 1500 MARIEKA robots in New Zealand and, to MSL's annoyance, this popularity is currently resulting in around 20 calls a week to MSL's business, mainly enquiring about the availability of new computer applications. The situation has been made worse by the fact Marieka BV is not readily contactable within New Zealand.

Of particular concern to MSL is that it has developed an educational computer application that it wants to sell to extend its unique educational system across New Zealand; MSL is worried that if it markets this product under its MIRAKA name, confusion with Marieka BV may result.

MSL was using its trade mark in New Zealand first and wants Marieka BV to change its name.

MSL is the owner of trade mark registration 735800 for MIRAKA covering:

Class 16 - "*Printed matter; paper and paper products; artist materials; writing and drawing implements*"; and

Class 41 - "*Educational services relating to interactive drawing therapy; entertainment services relating to drawing therapy (excluding musical entertainment services); drawing training services; the provision of information relating to the aforesaid services*" (class 41).

Trade mark No.735800 was filed on 19 April 2003 and registered on 2 December 2003.

Marieka BV is the owner of Trade Mark Registration No. 811222 for MARIEKA covering:

Class 7 - "*Robotic apparatus and instruments; household maintenance robots; robots capable of performing human tasks; robots connected to and capable of interacting with the world wide web; parts, fittings and accessories for the aforesaid products*"; and

Class 9 - "*computer software, hardware and firmware; computer software applications for controlling household environments and appliances; computer software applications for controlling interactions between humans and robots; computer software applications for providing information and interactive experiences to human beings; computer gaming software; the provision of information relating to the aforesaid services*".

Trade mark No. 811222 was filed on 4 January 2006 and registered on 5 March 2007.

- (a) What legal options does MSL have to protect its position in New Zealand? What are its chances of success? Your answer must describe appropriate legal options for MSL and describe relevant legal tests and possible remedies.

(16 marks)

- (b) MSL has asked you to identify and discuss any practical solutions to the issues it faces.

(i) One option is a mutual coexistence agreement. Without writing a full agreement, outline the main features of a possible coexistence agreement between the parties.

(ii) Are there any other practical solutions?

(8 marks)

(24 marks in total)

Question 6

“Little Green Elves Limited” specialises in garden design, landscaping and maintenance services. The business has operated very successfully in New Zealand since 1986 and now operates from 7 locations across New Zealand working for local councils as well as private residents and businesses. The CEO, Wing Chun, calls you about another business called “Green Man” which is owned by Trevor Green and has also been operating for many years, mainly in the South Island, but more recently in Auckland too.

Wing tells you that, while she is not afraid of a little competition, Trevor Green has started unfairly targeting Wing’s business.

Wing hands you a copy of her trade mark registration for LITTLE GREEN ELVES covering services in classes 37 and 42, including *“building services, landscaping services, gardening services, landscape and garden design services, maintenance services, composting services, mulching services, lawn mowing services, and weeding services”*.

Wing points to the following activities of Green Man which she has only recently found out about and which are really annoying her and causing issues for her business:

- (i) The use of the word “Green” together with the word “Man” is too similar to Wing’s brand which combines the word “Green” with the word “Elves”. She explains that while elves aren’t supposed to be human, they nevertheless have physical features consistent with a miniature human.
- (ii) The predominant use of the word and colour “green” on Trevor Green’s website, vehicle livery and uniforms.
- (iii) An advertisement on an Auckland radio station which states that “Green Man” provides better quality gardening services and products at a price guaranteed to be “at least 20% less than any price offered by any evil little green elves.”
- (iv) Trevor Green has purchased the Google Adwords™ “Little Green Elves” to promote his business. Adwords™ are a pay-per-click advertisement that will direct anyone conducting a search on GOOGLE for “little green elves” to the GREEN MAN website www.greenman.co.nz via a separate box above the main GOOGLE search results where Wing’s website appears.

- (v) Green Man Limited is listed as the applicant for trade mark application 956356 ELVEN MAGIC in class 5 covering "compost and fertilizer products." This application was filed on 12 September 2014 and advertised on 28 April 2015.

- (vi) Green Man Limited also owns trade mark application 956359 LITTLE GREEN MAN in class 1 covering: "*crystal granules for soil care; water retention agents for gardens and lawns, water saving crystals*". The application was filed on 12 June 2014 and its status is recorded on the Register as "Under examination". Further investigation reveals that Green Man Limited has missed the acceptance deadline of 12 June 2015.

Advise Wing on her legal options for challenging each of the above activities/matters, the grounds for any challenge and state the chances of success giving reasons for your opinion. Be sure to set out all relevant legal tests and possible remedies.

(18 marks)

CLASS HEADINGS

GOODS

- 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 painters, decorators, printers and artists
- 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* Pharmaceutical and veterinary preparations; sanitary preparations for medical purposes; dietetic substances adapted for medical use, food for babies; 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; goods of common metal not included in other classes; 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
- 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; automatic vending machines and mechanisms for coin-operated apparatus; cash registers, calculating machines, data processing equipment and computers; 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 and goods in precious metals or coated therewith, not included in other classes; jewellery, precious stones; horological and chronometric instruments
- Class 15* Musical instruments
- Class 16* Paper, cardboard and goods made from these materials, not included in other classes; printed matter; bookbinding material; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paint brushes; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus); plastic materials for packaging (not included in other classes); printers' type; printing blocks
- Class 17* Rubber, gutta-percha, gum, asbestos, mica and goods made from these materials and not included in other classes; 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, and goods made of these materials and not included in other classes; animal skins, hides; trunks and travelling bags; umbrellas, parasols and 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; goods (not included in other classes) of wood, cork, reed, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother-of-pearl, meerschaum and substitutes for all these materials, or of plastics
- Class 21* Household or kitchen utensils and containers; combs and sponges; brushes (except paint brushes); brush-making materials; articles for cleaning purposes; steelwool; unworked or semi-worked glass (except glass used in building); glassware, porcelain and earthenware not included in other classes
- Class 22* Ropes, string, nets, tents, awnings, tarpaulins, sails, sacks and bags (not included in other classes); padding and stuffing materials (except of rubber or plastics); raw fibrous textile materials
- Class 23* Yarns and threads, for textile use
- Class 24* Textiles and textile goods, not included in other classes; bed and 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 27* Carpets, rugs, mats and matting, linoleum and other materials for covering existing floors; wall hangings (non-textile)
- Class 28* Games and playthings; gymnastic and sporting articles not included in other classes; 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, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery, ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice
- Class 31* Agricultural, horticultural and forestry products and grains not included in other classes; live animals; fresh fruits and vegetables; seeds, natural plants and flowers; foodstuffs for animals; malt
- Class 32* Beers; mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages
- Class 33* Alcoholic beverages (except beers)
- Class 34* Tobacco; smokers' articles; matches

SERVICES

- 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 accomodation
- 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