

2003

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).

Answer all Questions

Question 1

Answer all questions. Refer to the relevant provisions in each of the Trade Marks Act 1953 as currently amended (the 1953 Act) and the Trade Marks Act 2002 (the 2002 Act).

- 1.1 Describe two significant differences between what must not be registered under section 17 of the 2002 Act and what it shall not be lawful to register under section 16 of the 1953 Act. Give two examples of each of these.
4 marks
- 1.2 How has the necessary character of distinctiveness for registrability been described in the 1953 Act and the 2002 Act respectively?
2 marks
- 1.3 Both the 1953 Act and the 2002 Act make reference to a degree of validity after registration for 7 years. Explain the differences between the provisions.
2 marks
- 1.4 Explain the differences between the infringement sections and the registrability sections of the 2002 Act as they affect the protection provided for what are referred to as well-known trade marks.
5 marks
- 1.5 In what circumstances does comparative advertising infringe a registered trade mark under the 2002 Act?
2 marks
- 1.6 Explain the grounds for revoking a registration under section 66 of the 2002 Act. **5 marks**
- 1.7 Explain the significant differences between the assignment provisions in the 2002 Act and the 1953 Act.
6 marks
- 1.8 In what circumstances may the trade mark be altered in a registration or application under the 2002 Act?
2 marks
- 1.9 What is the scope for rectification of the register in the 2002 Act?
2 marks

30 marks

Question 2

Your client company wants to use and register as a trade mark the name FLASHERS RETREAT for a licensed bar selling alcoholic beverages and snacks, initially in Auckland but hopefully elsewhere in New Zealand.

A preliminary search locates the following references:

New Zealand Part A registered trade marks (in the names of different proprietors):

- FRIARS RETREAT for restaurant and tavern services in class 42 registered since 1990
- FATHERS RETREAT for restaurant and accommodation services in class 42 registered since 1991
- FLASHING RESPONSE for spirits in class 33 registered since 1992
- JACK FLASH for liquor retailing in class 42 registered since 1993
- FLASH TREATS for snack foods in classes 29 and 30 registered since 1994
- FLASHERS for publications in class 16 registered since 1980 and since 1999 for toiletries in class 3, jewellery in class 14, leather goods in class 18, and clothing in class 25

References in telephone directories:

- FRIARS RETREAT restaurant, Napier
- FATHERS RETREAT hotel, Wellington
- JACK FLASH liquor retailers in several New Zealand cities
- RETREAT bar and grill, Dunedin

New Zealand incorporated company:

- FLASHERS RETREAT (NZ) LIMITED, owned by an Australian company

Domain name:

- flashersretreat.co.nz, owned by the same Australian owner of the above New Zealand company.

The proprietor of the FLASHERS registrations is an English company, which you recognise is the publisher of the well known FLASHER men's interest magazine which carries advertisements for its FLASHER range of men's toiletries, jewellery and clothing.

Consider each of the above references and advise whether and/or how they affect use and registration by your client of its proposed name in relation to its business. If necessary consider what further enquiries you would recommend be made.

In your advice, refer to the principles and legislation which govern your advice on the availability for use and registration of the proposed mark.

Then, assuming you are giving your opinion after the Trade Marks Act 2002 is fully in force, discuss the relevant sections of the Trade Marks Act 2002 which would govern your advice.

35 marks

Question 3

Your client is Intergalactica Productions Inc of USA, registered proprietor of the trade mark INTERGALACTICA registered since 1993 for films, audio and video apparatus, computers and software in class 9, entertainment services in class 41, and computer programming in class 42. Your client is the producer of the well known science fiction film INTERGALACTICA and a continuing range of computer games based on that film.

Your client has discovered appearing in flea markets around the country, apparently counterfeit DVD and CD copies of the film and of the computer games, toy space vehicles which are obvious copies of those depicted in the film and the games, comic books based on the film, and hats, which all use the INTERGALACTICA trade mark and the get up used by your client.

Your investigations show that a New Zealand company named Spacetime Limited is distributing and possibly importing the abovementioned counterfeits and toys, hats and comics.

You have discovered that Spacetime has filed applications to register the trade mark INTERGALACTICA for books in class 16, clothing in class 25 and toys in class 28. These applications were advertised in the New Zealand Patent Office Journal which issued on 28 April 2003.

a) Advise your client having regard to the Trade Marks Act 1953 and other relevant legislation and remedies. You do not need to advise on copyright issues.

When giving your advice, be sure to discuss the following matters -

- 1) What further information you would find useful for advising on how to stop the distribution and sale of the counterfeits and the toys, hats and comics;
- 2) Based on the available information, what action can be taken to stop the distribution and sale of the counterfeits and the toys, hats and comics;
- 3) What additional measures are available to protect your client's INTERGALACTICA trade mark. Outline procedural steps and time limits involved.

(b) Discuss any additional remedies introduced by the 2002 Act. Do not discuss the transitional provisions of the 2002 Act.

35 marks