

2004

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 has a possible 4 marks
Question 2 has a possible 10 marks
Question 3 has a possible 8 marks
Question 4 has a possible 7 marks
Question 5 has a possible 8 marks
Question 6 has a possible 10 marks
Question 7 has a possible 6 marks
Question 8 has a possible 10 marks
Question 9 has a possible 15 marks
Question 10 has a possible 10 marks
Question 11 has a possible 12 marks

Answer All Questions

Question 1

Your client instructs you to file an application to register the trade mark MOUNT. After filing the application, but before the application is accepted, you realise that you made a typographical error in the application form and you incorrectly applied to register the trade mark MONT.

How and under what circumstances could you correct such an error?

What would be the position if the trade mark was already registered by the time you noticed the mistake?

4 marks

Question 2

You are contacted on behalf of the Potato Growers Association who wish to register their trade mark FRITE for a new type of potato that its members will grow and sell.

Advise your client regarding its options as to the types of trade mark protection it could obtain, and what you recommend. In your advice to your client compare and contrast the types of trade mark registrations available.

10 marks

Question 3

Your client has filed a multi-class application to register its trade mark in Australia in respect of "perfumes, lotions" in class 3; "handbags, satchels, umbrellas" in class 18 and "clothing including shirts, t-shirts, dresses, pants, lingerie" in class 25 on 10 January 2004.

Your client now wishes to register its trade mark in New Zealand. As well as the above goods, your client wishes to seek registration in New Zealand for "powders, cosmetics and hair care preparations" in class 3 and "jewellery and watches" in class 14.

Advise your client as to the options available to it to protect its trade mark for all the goods listed above and of any special requirements and deadlines.

8 marks

Question 4

You are instructed to renew 4 trade marks registrations for which renewals are/were due on:

- (i) 8 June 2003;
- (ii) 8 September 2003;
- (iii) 8 January 2005; and
- (iv) 8 September 2005.

Can you renew these trade marks now?

If yes, are there any additional requirements for any of them? If not now, when can you renew the registrations?

7 marks

Question 5

Your client wishes to use a trade mark. In undertaking a search you become aware of two existing registrations owned by the same proprietor, (both registered under Trade Marks Act 1953), which relate to the identical trade mark and cover the same and similar goods. These two registrations have the following actual dates of registration:

- 15 January 1992; and
- 7 June 2001

Your further enquiries suggest that the trade mark which is the subject of these registrations, has never been used.

What steps can your client take to overcome the obstacles that these registrations will present to use and registration of the trade mark by your client?

8 marks

Question 6

Shock, Inc., is an American manufacturer of SHOCKVALUE gimbals. Shock, Inc., has registered its trade mark in the United States but has not yet registered its trade mark in New Zealand.

On filing an application to register its trade mark in New Zealand, a registration for the identical trade mark is raised as a citation under section 25. On discussing the situation with your client, it transpires that Startle Limited, the proprietor of the cited trade mark, is Shock Inc's, distributor for the SHOCKVALUE gimbals in New Zealand.

Advise your client what action it may take in order to overcome the citation and facilitate registration of its trade mark (including steps to take, official fees and applicable deadlines).

10 marks

Question 7

Your client is the registered proprietor of the trade mark SURVIVOR in class 34 which is registered for tobacco products such as "cigarettes, cigars, tobacco", and luxury goods such as "lighters, cigarette cases, cigar cutters". Your client decides to sell off its tobacco business and focus on luxury goods.

Discuss the steps your client has to take to be able to sell its tobacco business and trade mark.

6 marks

Question 8

Your client has become aware of a competitor planning to use a trade mark it considers to be very similar to a trade mark your client has used for several years but has never registered. It transpires that the competitor has filed two applications for the trade mark:

- (i) the first, for the mark in plain letters, filed on 15 January 2004 and advertised as accepted in the Patent Office Journal that issued on 26 March 2004, and
- (ii) the second application, for the same mark but incorporating a device component, filed on 29 January 2004 and advertised as accepted in the Patent Office Journal that issued on 30 April 2004.

Advise your client whether it can oppose these trade mark applications, and if so explain how, and explain the opposition procedures, official fees and deadlines.

10 marks

Question 9

Your client wishes to use the trade mark **MANA** for clothing in class 25 and wants to know if it is available for use and registration.

You undertake searches and note the following:

- Current trade mark registration for the trade mark **MANNA 2** for “shoes and boots” – trade mark was registered on 23 July 2001 – trade mark appears to be in use;
- Pending trade mark application for trade mark **MARNA** in class 25 for “scarves, ties, cravats, ponchos and capes”;
- Current trade mark registration for **MONA** for “clothing” – trade mark was registered on 3 August 1993 – your further enquiries suggest that the trade mark is not in use;
- Lapsed trade mark registration for **MANU** for “clothing and headgear” – trade mark was registered on 16 November 1999 – renewal was due 8 December 2003 – further enquiries suggest trade mark was being used one year ago;
- Current trade mark registration for **MANUKA** for “sports uniforms and clothing” – trade mark was registered on 30 January 1975 – further enquiries suggest that trade mark is in use;
- Company name registration – **Mana Limited** – further enquiries reveal that this company provides management services;
- Domain name registration – www.mana.org.nz registered in the name of Manawatu Aged Nurses Association;
- Domain name registration – www.mana.com.au registered in the name of Melbourne Clothiers Pty Ltd

Identify:

- (i) possible obstacles to use of **MANA**;
- (ii) any options for overcoming such obstacles; and
- (iii) if the client decides to file an application for registration of its mark, identify any objections which might be raised by IPONZ.

15 marks

Question 10

You have filed, on behalf of a client, an application for registration of the trade mark **OUTRAGEOUS** in classes 20, 21, 24, and 25 for the following goods:

- Furniture including sofas and settees; screens; mirrors, picture frames; baskets; bead curtains; bottle racks; curtain hooks, rails, rings, rods and tie-backs; cushions.
- Household or kitchen utensils and containers; glassware, porcelain and earthenware not included in other classes; candlesticks; candelabra; crockery; crystal glassware; decanters; glassware; ice buckets; lazy susans; teapots and coffee pots.
- Textiles and textile goods, table covers, place mats, serviettes.
- Clothing, retail of clothing.

A Compliance Report has issued in which the following objections have been made:

- Section 18 – non-distinctiveness;
- Regulation 43 – “retail of clothing” does not fall in classes 20, 21, 24 or 25;
- Section 25 – confusing similarity to **OUTRAGE**, registered 2 years ago for “swimwear and board shorts” in class 25.

Advise your client of your proposed strategies for overcoming the objections and any relevant deadlines.

10 marks

Question 11

You act for Hot Products Limited (“HPL”). HPL has used its trade mark **RIP ‘N’ TIP** in relation to snack foods (as listed in its trade mark registration) since August 2000. HPL is the proprietor of the following trade mark registration:

Mark: RIP ‘N’ TIP
Number: 641005
Filed: 1 July 2001
Registered: 5 January 2002
Basis: Being Used
Goods: Snack foods, including corn chips, potato chips, pita crisps, pretzels and crackers.
Class: 30

HPL has since August 2003 marketed a chilli salsa under its **RIP ‘N’ TIP** brand.

HPL has just become aware of **Rip ‘N’ Pour Limited** (“RNPL”) and its marketing of a single serve size range of tomato sauces and chutneys under the brand **RIP ‘N’ POUR**.

HPL’s investigations show that RNPL’s first use of **RIP ‘N’ POUR** on its products occurred in September 2003.

HPL considers that RNPL’s use of **RIP ‘N’ POUR** on sauces is likely to be confused with its **RIP ‘N’ TIP** mark, though as yet it is unaware of any actual instances of confusion.

Advise your client of the strategies and legal options open to it, to prevent RNPL from using the **RIP ‘N’ POUR** trade mark on RNPL’s products, and describe any remedies which might be available to HPL.

12 marks