

2007

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: 12 marks

You are asked to conduct a search of the Trade Marks Register to advise on the availability for registration of the following trade marks

1. MX35 for automotive parts
2. THE NATIONAL SWIMMING FOUNDATION for sporting and education services
3. A plastic bottle/container in the shape of a lime, for lime juice
4. BEST BARGAIN for retail services

(a) Outline the search strategy, method or parameters for the searches you will undertake of the Trade Marks Register.

(8 marks)

(b) Comment on the inherent registrability of each of the above marks.

(4 marks)

Question 2: 8 marks

(a) An application was filed on 20 June 2007 in class 25 for "clothing and belts". The IPONZ Compliance Report which issued on 25 June 2007 states that "belts" are correctly classified in class 18. Comment on what should be done.

(1 mark)

(b) Explain whether the following applications for division are allowable and what should be done:

- (i) An application for the division of a trade mark application for a series of trade marks where one of the marks in the series is found to be too dissimilar to the other marks in the series.
- (ii) An application for division of a trade mark application during opposition
- (iii) An application for division into two separate registrations of a registered trade mark currently registered in both classes 18 and 25.

(3 marks)

(c) Application 760021 has been accepted and advertised. The application was filed with a specification of goods listing the class 9 class headings but inadvertently the application failed to include the goods "computer software". Comment on whether the error can be corrected and what should be done.

(2 marks)

(d) A trade mark application was inadvertently filed in the name of the secretary who filed the application rather than in the name of the company she worked for. Comment on whether the error can be corrected and what should be done.

(2 marks)

Question 3: 8 marks

Explain the difference between rectification under section 76 of the Trade Marks Act 2002 and corrections of error under section 37(2)(b) of the Trade Marks Act 2002. Outline the requirements for each.

Question 4: 32 marks

You act for EMO Fashions Limited ('EFL'), a New Zealand company which manufactures and markets a range of casual wear under its EMO label.

EFL is the registered proprietor of the trade mark EMO which was registered in 2003 in relation to "*Clothing, headgear and footwear*" in class 25.

The EMO range of garments is renowned for its dark moody colours which have great appeal to the youth market. Indeed, the EMO label has been New Zealand's top selling brand of clothing in the 16 – 24 year age group over the last 4 years.

EFL comes to you complaining that its label is being ripped off. Your investigations reveal –

- (i) Last week FTC Limited began selling dark coloured sweatshirts through its department stores under the brand **EMOtif**. Further investigations reveal that FTC Limited owns a registered trade mark for **EMOtif** which proceeded to registration in 2006 in relation to "casual wear" in class 25.
- (ii) Chinese-made EMO belts and bags are being sold on the TradeMe® website by Speedy Imports Limited, a company which it appears regularly imports product and sells it on the internet through TradeMe.

EFL requests your opinion as to what it can do to "clean up the market" and protect the distinctiveness of its EMO label, now and in the future.

Advise your client briefly discussing options, remedies and procedures (except those procedures relating to the filing of a trade mark application). Other than to identify a remedy, candidates should not repeat procedural information if set out previously in their answer.

Question 5: 26 marks

For the purposes of answering this question it is recommended that candidates first set out the relevant legal principles, and then apply these in turn to each of the references disclosed by the search.

Your Wellington client wishes to use the new trade mark CRACKERJACKS for a shop selling takeaway ready to eat meals and non-alcoholic beverages. Your client will also be providing a delivery service for internet and telephone orders.

The foods will be promoted as low-fat health foods which will be prepared (and pre-cooked if necessary) offsite and then frozen. The foods will be thawed and if necessary heated by microwave immediately before sale or delivery to consumers.

Your client will start its business in Wellington but proposes franchising the concept to allow expansion to other parts of New Zealand.

Your preliminary search locates the following:

Trade mark registration 111333 CRACKERJACK for "cocoa products" in class 30, registered 1975

Trade mark registration 612345 CRACKERJACK for "gin" in class 33, registered 2000

Trade Mark registration 643202 CRACKERJACK for "telecommunication services" in class 38, registered 2002

Trade mark registration 234567 JACKS CRACKERS for "cracker biscuits" in class 30, registered 1996

Trade mark registration 300222 CRACKERTIME for "snack foods and confectionery" in class 30, registered 1999

Trade mark registration 733447 CROOKED JACK for "fish" in class 29, registered March 2006

Trade mark registration 665544 CRACKERS for "restaurant services" in class 43, registered January 2004

The above registrations are all current and have different registered owners.

A common law search which included an internet search and a search of the Register of Companies disclosed the following information:

Auckland telephone directory entry CRACKERS RESTAURANT.

New Zealand company CRACKERJACKS RESTAURANT LIMITED of Wellington, but no reference to it could be located in any current New Zealand telephone directory

New Zealand company CRACKERJACK PRODUCTS LIMITED of Hamilton and associated telephone directory entry with Yellow Pages reference to "toys"

Domain name "crackerjack.com" pointing to a USA website promoting frozen foods. Further investigations reveal that the owner of the crackerjack.com website has an Australian trade mark registration which is based on an International (Madrid) registration dated 2006 for CRACKERJACK for "frozen meat; frozen fish; frozen fruit; frozen vegetables" in class 25. Its US owner has no trade mark registrations or applications in New Zealand.

Your client is not aware of the use of any of these trade marks, except the Auckland CRACKERS licensed restaurant which he acknowledges is known to some people in Wellington.

Advise your client whether it can use and register the trade mark CRACKERJACKS for its proposed business, and what further investigations or preliminary steps should be taken. Advise what action your client should take to protect the trade mark. Please refer to relevant statutory provisions and case law when providing your advice.

Question 6: 14 marks

You are approached by a group of artists and craft shop owners in the Coromandel who have an idea to promote and protect the name POHUTUKAWA PEOPLE COUNTRY CRAFTS. They wish to allow other artists, craftspeople and craft shop owners in the Coromandel to use this name to promote and sell art and craft goods which originate from the Coromandel.

They envisage permitting use of the name by others for a small administrative fee but want all users to comply with some minimum standards as to the origin and nature of the goods, quality of manufacture and quality of service. They propose forming an association but acknowledge that in the future they may form a company or an incorporated society to manage the project once they have a better idea as to how such a body might be constituted and controlled. Their plans have become public and they want to protect the name as soon as possible.

Advise this group what steps they should take to protect the name and logo and to be comfortable that no-one else's rights will be infringed. Consider the functions and the advantages and disadvantages of the various types of trade marks which might be applicable to your clients' situation.

Recommend the best registration strategy for your clients.

Nice Classification of Goods and Services – Ninth Edition

- 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.
- 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.