



**2008**

**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 (Total 18 marks)

Biggs Limited wishes to use the trade mark BALDWIN STREET on wines in class 33. Biggs Limited has asked you to advise whether the mark is available for use and registration.

- (a) Outline a search strategy, method, or parameters for the searches you will undertake of the IPONZ website. (2 marks)
- (b) Your searches found the following:
- i) Registration for BALWYND for liqueurs in class 33 – registered on 25 March 2001 and does not appear to be in use
  - ii) Current accepted application for MICHAEL BALDWIN covering beers in class 32 – published on 30 April 2008 and further inquiries confirm the mark is in use
  - iii) Current application for BALE STREET covering wine in class 33 and further inquiries confirm the mark is in use
  - iv) Registration for BALDWYN for bar and restaurant services in class 42 – registered on 20 January 1999 and further inquiries confirm the mark is in use
  - v) Company registration for Karen Baldwin Limited – further inquiries confirm Karen Baldwin is a clothing designer
  - vi) domain name registration for [www.stbaldwin.co.nz](http://www.stbaldwin.co.nz) – further inquiries reveal the domain name is owned by Steve Baldwin who has a weekly column on wine in the Otago Daily Times.
  - vii) domain name registration for [www.baldwinst.co.nz](http://www.baldwinst.co.nz) owned by Dunedin City Council – BALDWIN STREET is the name of a Dunedin street, which is reputed to be the steepest street in the world
  - viii) BALDWYN is a town in Northern Canterbury where grapes are grown.

Advise Biggs Limited on whether the trade mark BALDWIN STREET is available for use and registration on wines. Discuss any possible obstacles found by the search, including any strategies for overcoming those obstacles, and identify any objections that may be raised by IPONZ if an application is filed for BALDWIN STREET. (16 marks)

Question 2 (Total 25 marks)

You receive a telephone call from Tom Jones. His company, UGL Limited ("UGL"), designs golf clubs and golf balls which are manufactured in China and then imported and marketed by UGL in New Zealand. UGL's products have only been on the market in New Zealand since August 2007, but have already become a huge success.

UGL sells its golf products under the trade mark ULTIMATE. A new label was developed by a design agency in January 2008 and is now being used. No trade mark application has been filed for the label.

UGL filed a trade mark application for the words ULTIMATE GOLF on 2 August 2007 covering "golf equipment, golf clubs, golf balls, golf tees, golf bags, golf accessories" in class 28 and "clothing" in class 25. A compliance report issued asking that "clothing" be amended to "golf clothing". No response has been filed at IPONZ.

Mr Jones has become aware of a website [www.ultimate.co.nz](http://www.ultimate.co.nz) selling counterfeit golf balls under the ULTIMATE brand and using UGL's newly developed ULTIMATE label. Mr Jones purchased some of the counterfeit golf balls and found they originate from China from a different manufacturer to the one used by UGL. The website is owned by Mr William Kearns whose website went on-line in December 2007. So far Mr Jones has been unable to contact Mr Kearns, but Mr Jones has learned that Mr Kearns is involved in some litigation concerning the importation of other counterfeit product into New Zealand.

Mr Jones has also found counterfeit ULTIMATE golf balls for sale on Trade Me [www.trademe.co.nz](http://www.trademe.co.nz) (a New Zealand online auction website).

UGL wants to stop the sale of the counterfeit product in New Zealand.

Discuss whether UGL can stop the sale of the golf balls through the websites [www.ultimate.co.nz](http://www.ultimate.co.nz) and [www.trademe.co.nz](http://www.trademe.co.nz) in New Zealand, discussing what actions could be taken, the requirements for each cause of action, focusing on any remedies available, and including recommendations on how UGL should proceed.

(25 marks)

Question 3 (Total 18 marks)

Answer the following questions citing any relevant legislation.

- a. What is a disclaimer? Discuss in what circumstances a disclaimer may be entered against a trade mark application/registration. (2 marks)
- b. Describe the circumstances in which a trade mark owner can merge two trade mark applications or registrations? (2 marks)
- c. Discuss the differences between the rights that attach to trade mark applications and the rights that attach to registered trade marks under the Trade Marks Act 2002. (2 marks)
- d. What is a certification trade mark? Identify and describe the documents and conditions that apply to certification trade mark applications. (4 marks)
- e.
  - (i) What are the deadlines which pertain to an opposition proceeding and a revocation proceeding? In your answer, advise if any extensions of time are available for these deadlines and what conditions might apply to such extensions. (4 marks)
  - (ii) How does the extension of time of a deadline compare with a halt in proceedings? (3 marks)
  - (iii) What are the normal deadlines applying to responses to Compliance Reports, and what extensions of time are available? (1 mark)

Question 4 (Total 17 marks)

Firefly Limited has been marketing and distributing camping lamps for over 20 years in New Zealand. Firefly Limited's new managing director, Karen Stiles, has discovered the company has no trade mark protection for its house mark FIREFLY. Ms Stiles is aware of the importance of protecting trade marks, and seeks your advice on a trade mark protection strategy.

You conduct an identical trade mark search which finds a registration for the mark FIREFLY covering "lighting apparatus and equipment" in class 11. The trade mark is owned by Firefly Limited's former managing director, Joseph Hill, who applied to register the mark on 20 June 2005. The mark was registered on 21 January 2006. Marketplace inquiries disclose that Mr Hill has already begun marketing a range of "torches" under the trade mark FIREFLY.

Ms Stiles informs you that Mr Hill has been uncooperative since leaving Firefly Limited. Mr Hill now refuses to engage in any communication with Ms Stiles.

- a) Outline the options available to Firefly Limited to challenge Mr Hill's use and registration of the FIREFLY trade mark, noting any procedures and deadlines that may be involved. Advise Firefly on a protection strategy. (14 marks)
- b) Assume Firefly Limited's actions against Mr Hill are successful. The decision requires Mr Hill to transfer the registration to Firefly Limited. But Mr Hill passes away suddenly before completing the documentation necessary to give effect to the decision. What steps can Firefly Limited take to transfer the trade mark registration? What documents and additional information are needed to complete the transfer? (3 marks)

Question 5 (Total 15 marks)

Philip Devine owns a plant and garden store called BLOOMING DEVINE. His store sells a wide range of plants and shrubs, garden equipment, and garden accessories. He informs you that his store caters to all your gardening needs.

Mr Devine filed a trade mark application for BLOOMING DEVINE in his own name covering “garden retail services” in class 35 on 6 July 2007. A Compliance Report issued on this application raising the following objections.

Section 17 – the mark is considered to be offensive to a significant section of the community

Section 18 – the mark is non-distinctive and should be available for other traders to use

Section 25 - Registration for BLOOMIN covering “chemicals for use in agriculture” in class 1 and “preparations for killing weeds” in class 5 – registered 1 May 2000 – investigations find the mark is not in use.

Section 25 - Application for BLOOMING covering “living animals” in class 31 filed 4 July 2007 – investigations find the mark is in use.

Section 25 – Registration for DEFINE covering “garden hand tools” in class 8 – registered 2 November 2004 – investigations find the mark is in use.

Section 25 – Registration for DEVINE CATALOGUES covering “mail order catalogue services” in class 35 – registered 7 November 2007 – investigations find the mark is in use.

Section 25 – Lapsed registration for DE-VINE covering “plants” in class 31 – registered 2 May 2002 – last renewal fee due 28 October 2007 – investigations find the mark is not in use.

Advise your client in relation to the strengths and weaknesses of all the objections and the strategies you might adopt to overcome the objections. In your advice, refer to relevant case law, any deadlines, and documents that may be required, and advise what steps your client should take to strengthen his protection.

(15 marks)

Question 6 (Total 7 marks)

Rapid Pavilion PLC (a United Kingdom company) manufactures and distributes remote control trucks under the trade mark CRAYON, around the world and in New Zealand. Rapid Pavilion PLC licenses the use of its trade mark CRAYON in New Zealand to Tomohawk Limited (a New Zealand company). The licence agreement includes quality control provisions covering manufacturing techniques and guidelines for use of the CRAYON trade mark.

- a) Advise Rapid Pavilion PLC whether Tomohawk Limited should be entered as a licensee against its New Zealand trade mark registration for CRAYON. Outline the advantages and disadvantages of recording licensees in New Zealand. (3 marks)
- b) Would your advice change if the licence agreement did not include quality control provisions? Why? (2 marks)
- c) Would your advice in b) change if Tomohawk Limited is a subsidiary of Rapid Pavilion PLC? Why? (2 marks)