

2010

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)

When considering answers to the questions in this year's examinations, no account is to be taken of any provisions of the Patents Bill, the Trade Marks (International Treaties and Enforcement) Amendment Bill, the Regulatory Improvement Bill (as it relates to amendment of the Designs Act 1953), or any other bill that may be before the New Zealand Parliament.

Question 1 (Total 29 marks)

New Zealand is hosting the International Taekwon-Do Federation's (ITF) World Championships in March 2011. The ITF Taekwon-Do World Championships is the most prestigious event on the Taekwon-Do calendar. The tournament attracts the best competitors from around the world, gathers together the national authorities, and celebrates this martial art technique. The tournament will combine the Under 21 and Open championships for men and women in one tournament over 5 days in Wellington. A website has been established to promote the tournament. Attached is a copy of the first page of the website (see website at <http://www.itfnewzealand2011.com/index.html>).

The last championship tournament was held in Argentina in 2009. The tournament was extremely successful, attracting international competitors, supporters, and officials to the host country, requiring significant sponsorship, and receiving international media coverage.

The ITF will license its trade marks for use by licensees on a range of bags, clothing, sports clothing, protective clothing, and sports equipment which will be sold during the tournament.

The success of the last tournament was plagued by the sale of counterfeit product outside the main competition venue, significantly reducing the sale of legitimate product, and impacting on the financial return to the hosts of the tournament and ITF's licensees.

The ITF needs to guarantee a certain level of sales to the host country and its sponsors, and seeks your advice in preparation for the tournament next year.

Advise ITF on an appropriate strategy for protecting the trade marks which will be associated with the event, and discuss the effects and merits of that strategy. Your advice should note all relevant legislation and laws for protecting ITF's trade marks and for preventing counterfeit product being sold leading up to and during the tournament in March 2011.

You may assume the ITF has not registered any of its trade marks in New Zealand.

A summary of the international classification of goods and services is attached to assist you.

Welcome to the Official Website of ITF Taekwon-Do World Championships 2011



Home About New Zealand Eng TournaEnt Travel Country Liaison Volunteers Sponsorship Contact Us

Federations

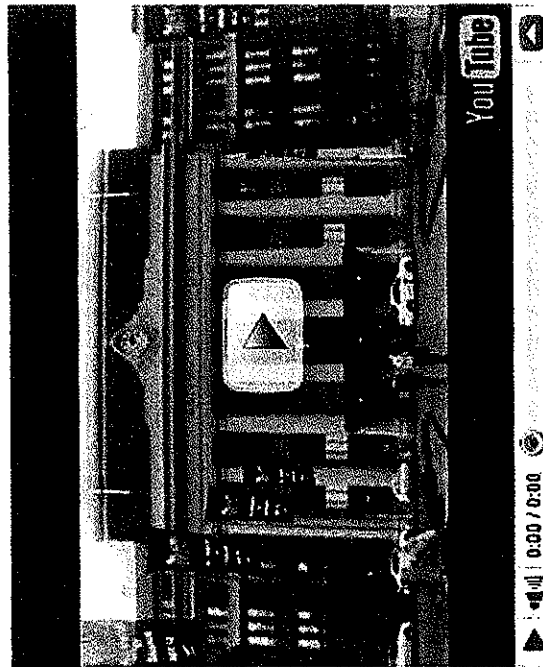


9 - 13 March 2011
ITF Taekwon-Do
World Championships
302
Days
To Go

Free

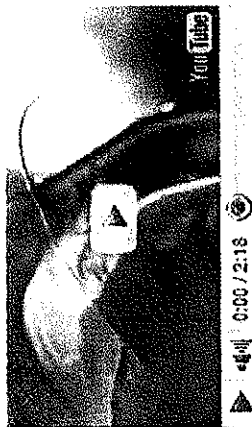
Invitation

To all ITF Taekwon-Do National Associations: The 2011 ITF Taekwon-Do World Championships are to be held in New Zealand. We are proud to have this opportunity, and invite you to join us whilst we showcase our nation and rich culture to the world.



Come to New Zealand

Known as Aotearoa (Land of the Long White Cloud) in Maori, New Zealand is a land of spectacular natural beauty, with a diverse range of must-see locations and activities to suit a wide range of interests. So come to New Zealand and take up the challenge.



ITF Taekwon-Do World
Championships 2011
Download File



Question 2 (12 marks)

Devise search strategies or the parameters for the searches you will undertake of the IPONZ records and comment on the registrability of the following trade marks:

- (a) KAHURANGI for clothing – “kahurangi” is the Maori word for blue (3 marks)
- (b) SAREMAC for cameras (3 marks)
- (c) JON MACENROW for tennis racquets (3 marks)
- (d) a bottle shape for shampoos and conditioners (3 marks).

Question 3 (26 marks)

Landau Supplements Inc. ("Landau") has manufactured and distributed health and vitamin supplements in the United States since 1983 under the brand MASTER CLEANSER.

A New Zealand company, Healthy Vitamins Limited ("HVL"), has been Landau's sole exclusive distributor of MASTER CLEANSER supplements in New Zealand since 1995. This arrangement terminated in November 2006 due to a disagreement between the parties. Landau's MASTER CLEANSER goods have not been sold in New Zealand since December 2006.

Landau recently appointed a new distributor, Muscles Limited, which intends to begin selling MASTER CLEANSER products in August 2010.

However, it has just come to Landau's attention that HVL -

- (a) registered the trade mark MASTER CLEANSER for "vitamin, mineral and health supplements" in class 5 - the application was filed on 10 December 2006 and registration was granted on 10 June 2007; and
- (b) registered the trade mark MISTER CLEANER for "carbohydrate based dietary supplements, other than for medical use" in class 30 - the application was filed on 10 December 2009 and registration was granted on 30 June 2010.

Investigations reveal that HVL has never used the MASTER CLEANSER trade mark in New Zealand after November 2006, but began using the MISTER CLEANER trade mark in January 2010 in relation to a carbohydrate based supplement which HVL claims will improve digestion and bowel health.

Landau seeks your advice on the risks to Muscles Limited if Muscles Limited sells MASTER CLEANSER products, and what can be done to minimise those risks and strengthen Landau's position.

Landau does not want you to detail procedural steps or deadlines

Question 4 (Total 18 marks)

Te Runanga o Ngati Tawhiri is the representative body for the people from the Ngati Tawhiri tribe, based in Hawera, Taranaki. Ngati Tawhiri has developed a new process for producing threads and cottons from locally grown flax plants. Te Runanga o Ngati Tawhiri has patented this process, and has begun marketing its threads and cottons under the trade mark INAHA PULSE.

Te Runanga o Ngati Tawhiri filed a trade mark application for its INAHA PULSE trade mark for "yarns and threads, cottons" in class 23 on 15 July 2009. Compliance Reports have issued and the following objections were raised.

- (1) Registration for PULSE covering "textiles" in class 24 and "retail of textiles" in class 35 – registered 4 July 2007.
 - (2) Registration for PULSAR covering "sewing machines" in class 7, registered in 2003.
 - (3) Registration for PULS@TE; PULSATE covering "clothing" in class 25, registered 17 April 2001 – next renewal fee due 27 September 2010.
 - (4) Lapsed registration for ENAHA covering "lace and embroidery, ribbons and braid; buttons, hooks and eyes, pins and needles; artificial flowers" in class 26 – registered 19 May 2001 – last renewal fee due on 5 March 2010.
 - (5) Registration for IMPULSE covering "retail of clothing" in class 35 – registered 4 July 2006.
 - (6) Registration for MARKET PULSE covering "bags made from textiles" in class 18 – registered 6 October 2008.
 - (7) Section 17 – Inaha is the name of a stream in Hawera, Taranaki and the registration would be considered offensive to Maori from that region.
 - (8) Section 18 – Inaha is the name of a stream in Hawera, Taranaki, and the mark is descriptive of goods that come from that area.
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- a) Te Runanga o Ngati Tawhiri has asked for your help to overcome the objections. Noting any deadlines, draft a response to the examination report on behalf of Te Runanga o Ngati Tawhiri.
 - b) Assume the citation for PULSE is maintained. Advise Te Runanga O Ngati Tawhiri on alternative strategies to overcome the citation.

Question 5 (Total 5 marks)

Tomuya KK owns a registration for CISTALK covering "beers; non-alcoholic beverages" in class 32.

Tomuya KK has been selling a range of beers under the trade mark CISTALK. Tomuya KK has never used the trade mark CISTALK on "non-alcoholic beverages" and has no intention to use the trade mark on these goods.

Chipmunk Beverages LLC has used the brand CYSTALK on its range of "mineral waters" in the United States and would like to sell this product range in New Zealand. Chipmunk Beverages LLC asked Tomuya KK to consent to its use and registration of the trade mark CYSTALK. Tomuya KK has offered to assign its registration for CISTALK to Chipmunk Beverages LLC for "non-alcoholic beverages" only.

- 1) Outline the process and documents needed to transfer the registration for CISTALK from Tomuya KK to Chipmunk Beverages LLC for "non-alcoholic beverages" only. (3 marks)
- 2) When checking the official records, you find that Tomuya New Zealand Ltd is entered as a licensee against the CISTALK registration. Advise Chipmunk Beverages LLC of any additional steps needed to record the assignment of the registration. (1 mark)
- 3) Advise Chipmunk Beverages LLC on how they could strengthen their trade mark protection in New Zealand. (1 mark)

Question 6 (Total 10 marks)

Thomson LLP owns a franchise of gyms in Europe, the United Kingdom, and Australia. Thomson LLP's most popular exercise program is its CARDIO ROCK program that mixes a cardio workout with rock and roll dance moves. The CARDIO ROCK trade mark has been used and registered by Thomson LLP for exercise programs throughout Europe, the United Kingdom, and Australia. This program is also licensed to other gym franchises, and can be found in almost every gym throughout Europe, the United Kingdom, and Australia.

The CARDIO ROCK programs are not offered in New Zealand, but New Zealand Fitness Limited, a consortium of New Zealand gyms, has received many requests to run this exercise program in New Zealand. New Zealand Fitness Limited approached Thomson LLP for a licence to offer the CARDIO ROCK program in its New Zealand gyms. Thomson LLP is keen to expand into the New Zealand market.

As part of its due diligence checks, Thomson LLP made some inquiries in New Zealand and found that a gym in Thames uses the domain name cardiorock.co.nz, which directs internet traffic to its website. The website itself does not make any other reference to the CARDIO ROCK trade mark and no trade mark registrations exist for the trade mark CARDIO ROCK.

1. Advise Thomson LLP whether they can use and license its CARDIO ROCK trade mark in New Zealand to New Zealand Fitness Limited? (4 marks)
2. Advise Thomson LLP whether they can take any action against the gym in Thames and stop their use of the CARDIO ROCK in its domain name. (6 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

Nice Classification (9th Edition)

- 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

Nice Classification (9th Edition)

- 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 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