

2012

PATENT ATTORNEYS

EXAMINATION

PAPER B

The New Zealand Law and Practice
relating to Trade Marks

Regulation 158 (1) (b)

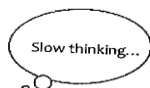
Duration: 3 hours (plus 10 minutes for reading)

When considering answers to the questions in this year's examinations, no account is to be taken of any Bill that may be before the New Zealand Parliament.

Question 1

You are asked to advise your client on the availability for use and registration of the following marks:

1. Nutrimax for a nutritional sports drink
2. T.L.C. for a massage oil
3. The word "Maroon" for kayaks.
- 4.



for an electric crock pot (slow cooker)

- a) Outline the search strategy, method and parameters for the searches you will undertake on the IPONZ database. (8 marks)
- b) Outline what further searches you would take to assist in determining whether each mark is available for use and registration in New Zealand. (4 marks)
- c) Advise on the registrability of each of the above marks. (4 marks)

(16 marks)

Question 2

A US associate has asked for your advice on the rights and obligations of trade mark licensees and of those having taken a security interest over registered trade marks in New Zealand. They ask:

- a) What are the obligations, options and implications relating to recording the following rights in New Zealand:
 - i) Having an exclusive licence to use a registered trade mark.
 - ii) Having a non-exclusive licence to use a registered trade mark.
 - iii) Obtaining a security interest over a registered trade mark.(4 marks)
- b) What are the requirements in New Zealand to ensure that use of a registered mark by a licensee (as opposed to the owner of the mark) is treated as use of a registered mark under the Trade Marks Act? (2 marks)
- c) What are the situations under which a licensee can issue proceedings for infringement of the registered trade mark they are licensed to use, and what is the procedure to be followed so they can do so? (2 marks)

(8 marks)

Question 3

- (a) Provide details of the procedure and obligations on the parties involved in applying to the Commissioner to revoke a registration for non-use. (4 marks)
- (b) Provide details of the provisions which prevent a mark from being revoked as having become generic under section 66(1)(c), even where the mark as registered has become a common name in general public use for a product or service in respect of which it is registered. (1 mark)

(5 marks)

Question 4

You act for an energy drink company called Unlimited Energy Ltd.

Unlimited Energy has developed a dual package containing an energy drink and a cereal bar that are to be sold together as a complete meal solution in dairies and supermarkets.

Your client wants to call this new product DualEnergy.

You have undertaken trade mark searches and advised your client that its trade mark is available for use and registration in class 32 for non-alcoholic beverages and class 30 for cereal based foods and bars. You have recommended filing applications for the DualEnergy mark to preserve your client's position pending launch of the product in 4 months.

Your client is concerned that many of its competitors track trade mark applications and would see the application. They are worried that because the application would be filed in class 30 (in which they do not usually file) and because of the reference to "Dual" in the mark itself, their competitors will know that Unlimited Energy is creating a new type of product – a combined food and drink energy product. They are worried that a competitor may quickly copy the idea and beat them to market.

Advise on the strategies available to Unlimited Energy seeking trade mark registration in New Zealand while minimising the risk of a competitor finding out about their creation of a new market segment, as well as the risks and benefits associated with each strategy.

(10 marks)


Question 5

You act for Black Pearl Clothing Limited (BPC), a Vanuatu company manufacturing women's casual clothing and men's beach shirts under the label BLACK PEARL. It also has a range of BLACK PEARL women's shoes. BPC uses a logo on all of its swing tags and labels, as follows:



Black Pearl clothing is widely available in boutiques in Vanuatu. Your client tells you that it is the most famous local clothing brand in Vanuatu. One shipment of 200 women's dresses was sent to New Zealand in 2010, which were sold through two boutiques in New Zealand, both in Auckland.

BPC tells you that it is the registered proprietor in New Zealand of the following trade mark registrations:

Number	Mark	CI	Goods/Services	Application Date	Registration Date	Renewal Date
395644	BLACK PEARL	25	Clothing; women's shoes	17 October 1998	2 June 2001	17 October 2015
395645	BLACK PEARL	42	Retail and wholesale of clothing, footwear and headgear	17 October 1998	2 June 2001	17 October 2015
644604		25	Clothing, footwear and headgear	21 December 2003	3 December 2004	21 December 2013

Your client tells you that the logo in registration number 644604 was used to cash in on the Pirates of the Caribbean film, because the story centred around a ship called the "Black Pearl", but that when BPC changed to its current logo in 2008 it forgot to register it in New Zealand. BPC confirmed that while some products in Vanuatu bearing the old ship logo are still available, all of the dresses sent to the Auckland boutiques in 2010 included only the new Pearl logo on labels and swing tags.

Your client has come to you to complain that it is being ripped off. On a visit to New Zealand last week, your client was told of a men's clothing and shoe store in Wellington operating using the following name and logo:



Your client says that they are using exactly the same font as BPC uses, a rarely used but generally available font called Belgian Bold. Your client also believes that instead of using a picture of a real black pearl in their logo, they have used an ordinary pearl.

Your client's visit to the store revealed that they were selling a wide range of men's clothing from a number of different labels but no clothing branded with the Black Pearl mark. Your client also noticed that the store was selling many styles of men's shoes that bore the same Black Pearl name and logo as appeared on the storefront.

Your own investigations reveal:

- The domain name “blackpearlclothing.co.nz” has been registered by a company called BP Clothing Ltd, having the same address as the Wellington store.
- The website www.blackpearlclothing.co.nz is operating and open to customers throughout New Zealand. The site is only selling men’s shoes bearing the Black Pearl label.
- BP Clothing Limited filed a trade mark application two weeks ago for  in classes 25 and 35 covering “footwear” and “retail and wholesale of clothing, footwear and headgear”

BPC requests your opinion on what it can do to deal with this rip-off and to ensure it can go ahead with a planned national expansion into New Zealand for all of its products.

Advise your client, briefly discussing the risks arising from this situation for your client, and the options, remedies and procedures available to them. If your advice includes filing of further trade mark applications, do not include the procedure relating to this.

Other than to identify a remedy, candidates should not repeat procedural information if it has been set out previously in their answer.

(40 marks total)

Question 6

Your client wishes to register its trade mark, which will be used by members of its association whose products meet certain quality requirements.

Explain what collective trade marks and certification trade marks are. Contrast them with standard trade marks and identify any advantages and limitations that collective trade mark registrations and certification trade mark registrations offer.

(5 marks)

Question 7

Raparound Games Ltd ('RGL') is a company that sells board games. RGL is trying to diversify its business and has now devised a board game it wants to call JUMBLE. While it will start out as a board game, RGL thinks it could easily be turned into a game that can be downloaded onto mobile phones and tablet computers.

RGL has asked you to advise whether JUMBLE is available for use and registration in New Zealand in relation to board games and downloadable computer games.

Your search discloses the following:

- i. Registration 214955 JUMPBLE covering "sporting and gymnastic equipment" in class 28 – application filed 1 May 1991, registered 18 December 1995; current status "expired but restorable"; mark in use for rhythmic gymnastics hoops and balls. (3 marks)
- ii. Registration 238545 BUMBLE covering "games, toys and playthings" in class 28 – application filed 28 July 1999, registered 15 March 2003; current status registered; mark in use for jigsaw puzzles. (2 marks)
- iii. Application 754544 JUNGLE covering "playing cards" in class 16 – application filed 10 July 2009, registered 5 February 2011; current status registered and in use for playing cards. (2 marks)
- iv. Application 797490 GUMBALL RALLY covering "board games" in class 28 – application filed 5 February 2010; registered 20 March 2012; enquiries indicate that the mark is not yet in use in New Zealand, but is in use in Australia. (2 marks)
- v. Application 865342 GUMBLE SALE covering "retail and wholesale of computer games and video games" in class 35 – application filed 1 April 2012, current status accepted and published 25 June 2012; mark not yet in use. (3 marks)
- vi. Company registration for Jumble Jim's Ltd – enquiries indicate that the company operates a video game arcade under the name Jumble Jim's. (2 marks)

Advise RGL on whether the JUMBLE trade mark is available for use and for registration in New Zealand, in light of the search results. Discuss any obstacles that you consider to be problematic, including any strategies for overcoming those problems.

(2 marks)

(16 marks)