

2013

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

Briefly comment on the registrability under the Trade Marks Act 2002 of the following trade marks:

- a) MIRACLE MUD for skincare preparations
- b) PAPER PAL for stationery
- c) ORGANIC SELECTION for apples
- d) ANZAC for tennis balls
- e) TASMAN SEA for fishing equipment

5 marks

Question 2

Aotearoa Bioactives Limited (ABL) manufactures and sells the leading brand of infant formula in New Zealand under the ENZED trade mark.

Relevant product packaging features a distinctive graphic design of a smiling cow standing in a field

ABL has one trade mark registration in New Zealand for the ENZED word mark in class 5 covering "infant formula". The registration dates from 2000 and is in force until 2017.

An opportunity has arisen for your client to export its infant formula to Australia, the USA, Canada, the UK and India.

Write notes in preparation for a meeting with your client to discuss the following issues:

1. The options available to your client to protect its brands overseas, the advantages and disadvantages of each, including your advice on any considerations relating to each.
2. Your recommended strategy including any further steps you advise.

Australia, the USA and the UK are members of the Madrid Protocol while Canada and India are not.

15 marks

Question 3

Your client sells a range of scientific calculators under the following names:

ADTRONIC 1000

ADTRONIC 2000

ADTRONIC 3000

ADTRONIC 4000 NU-ERA

Your client wants to register all of these brands as economically as possible.

Advise your client on how it can achieve its objective including your recommended strategy.

5 marks

Question 4

You act for a Hamilton based company called Countryside Innovations Limited. Your client has developed a water treatment capsule for animal water troughs. When the capsule is added to the water, it maintains the water quality for three times as long as conventional water treatment solutions.

Your client has obtained patent protection in New Zealand for the formulation and now wants to start to commercialise the capsules under the AQUACLEAR brand.

You carry out a search for your client and find the following:

1. A current registration for BAQUACARE in class covering 1 “water treatment chemicals”. This trade mark was registered in 2005 and is due for renewal on 3 August 2017.
2. A current registration for AQUA-CLEAR in class 11 covering “pool pumps and water filters”. This trade mark was registered in 1999 and is due for renewal on 24 February 2015. AQUA-CLEAR filters are the dominant product in the New Zealand pool filter market.
3. A current registration for AKWA in class 1 for “aquarium chemicals”. This trade mark was registered in 2003 and is due for renewal on 12 November 2021.
4. A current registration for AQUACHLOR in class 1 for “water chlorination chemicals”. This trade mark was registered in 2012 and is due for renewal on 14 April 2022.
5. A current registration for AQUAKLAR in class 1 for “water treatment chemicals”. This trade mark was registered in 1996 and is due for renewal on 9 July 2013. You are aware that the word “KLAR” is German for “CLEAR”. The trade mark owner is Gesundheit Chemicals Limited.
6. An expired registration for AQUA-KLEAR in class 1 covering “water treatment chemicals including those for swimming pools and spa pools”. This trade mark is also owned by Gesundheit Chemicals Limited and dates from 1995. It was due for renewal on 23 August 2012.
7. A company registration for Aquaclear Limited which further internet-based investigations confirm is a mobile swimming and spa pool cleaning and maintenance business based in Wellington.
8. A domain name registration for aquaclear.co.nz. Further enquiries reveal there is an operational website attached to this domain name which relates to an online business selling domestic water filters.

Advise your client on whether the AQUACLEAR trade mark is available for use and/or is registerable for the goods of interest indicating any further information that you require and action that may be taken to overcome any potential difficulties.

20 marks

Question 5

(a) 8 Marks

Between 2000 and 2010, Cool Drinks Limited manufactured and marketed the very successful MARIELLA soft drink range. Then, in June 2010, it suffered a catastrophic fire which resulted in the destruction of its factory, stock and plant.

Cool Drinks' remaining assets included –

- New Zealand trade mark registration no. 678543 MARIELLA in class 32 covering “non-alcoholic beverages”. The registration dates from 13 September 2002 with a renewal date of 13 September 2012. The renewal fee has not been paid.
- A domain name registration for mariella.co.nz.

For two and a half years the owners of Cool Drinks Limited tried desperately to raise the funds necessary to rebuild the business.

Unfortunately, by 2013 and without another bottle of MARIELLA being sold, the company's owners threw in the towel and walked away from the business. Cool Drinks Limited was struck off the New Zealand Companies Register on 1 March 2013.

Your client wants to acquire the MARIELLA trade mark.

Advise your client what it needs to do.

(b) 17 Marks

Assume your client is successful in obtaining an assignment of both the trade mark registration and the domain name. The trade mark assignment, which did not specifically include the goodwill of the business, has not yet been recorded at the Intellectual Property Office of New Zealand.

Your client now intends to relaunch the soft-drink range with refreshed artwork and expand the business to cover a range of merchandise such as apparel, novelty drinking straws and glassware.

Your client has sent you details of New Zealand trade mark application no. 891018 MARY-ELLE filed by an Australian company Maryelle Drinks Pty Limited on 15 March 2013 and published for opposition on 30 May 2013 covering the following goods and services:

Class 21 – glassware

Class 25 – clothing and headgear

Class 32 – non-alcoholic beverages including sparkling mineral water

Your client has asked to meet with you urgently to discuss its position.

Write notes for your meeting with your client to discuss:

1. The potential grounds, merits and chances of success in a possible opposition. Do not detail the various steps after a Notice of Opposition is filed.
2. Problems you foresee and any steps your client can take to improve its position.

25 marks in total

Question 6

You act for Zealandia Toys Limited which manufactures and sells a range of toys. In 1998, your client invented a circular shaped flying disc that because of a series of unique vents and grooves across its surface, returns to the thrower once thrown.

Your client had a registered design for the shape of the toy but this has recently expired. Your client has a trade mark registration in New Zealand for DISKORANG which is registered in class 28 for “games, toys and playthings”. This trade mark dates from 1998.

At first, sales of the DISKORANG™ toy were slow with only a few dozen units sold each year. However, after a video of a group of DISKORANG enthusiasts performing all sorts of tricks with the toys went viral on YouTube™ in 2009, sales of DISKORANG units exploded with the toy topping the best seller lists since then. DISKORANG has now become a household name.

At the beginning of 2012, your client was approached by Brisbane based company Vortex Toys Pty Ltd to see if it could distribute your client’s range in Australia. After some “toing and froing” your client decided it would use its own contacts to sell into Australia.

Last week, your client rang you to say that it had discovered lookalike products being sold at two markets in Auckland under the Vortex DiscoRing brand. Further enquiries reveal these products are made in China on behalf of an Australian company called Vortex Imports Pty Ltd.

Your own enquiries reveal that Vortex Imports Pty Ltd applied to register the trade mark Vortex DiscoRing in New Zealand in January 2013 in class 28 covering “toys and playthings including diskorangs”. The application was advertised for opposition purposes at the end of March 2013 and is awaiting registration.

Your client is very upset by the activities of Vortex Imports Limited and wants to know if and how it can stop them.

Advise your client what options and remedies are available to it, the requirements for each, any obstacles you foresee and provide recommendations for how your client might proceed and improve its position.

30 marks