

Examiner's Comments on Trade Mark Exam 2005

The technical parts of the paper were well done. The practical parts of the paper were poorly done.

Generally candidates were able to identify and recite the relevant law and the requirements of the trade marks Act 2002. However, the application of the law or rules of comparison to factual situations caused problems for many candidates.

Case law to support propositions or approaches came from many different sources. An awareness of recent, and not so recent, New Zealand cases from the High Court and Court of Appeal was lacking in many instances.

A number of candidates let themselves down by not reading the questions properly. A number of candidates also let themselves down by not allocating time appropriately.

Question 1

The renewal deadlines were generally well identified.

A few candidates thought that the marks could not be used until an assignment was recorded.

Only a few candidates thought checking the status of the register was worthwhile -licensees or the owner's name could be an issue.

Marks were missed by not commenting on the scope of the specification of goods for new applications, the supporting documentation for the recording of an assignment with IPONZ, the possibility of third party applications (AQUANAUT and JINK), as well as identifying the option, risks, or any benefit of relying on a new application for JINK rather than restoring the mark.

Question 2

The comparison of the trade marks and compliance report issues were generally well done.

A number of candidates confused what are the relevant goods to be taken into account when comparing the marks, either for the compliance report or possible infringement. For example the relevant goods for the MONIKA E mark were those set out in the registration not the goods the mark was actually used on.

The most common problem with answers was that they did not address the fact that Tweedie wanted to use the mark "in about five weeks". Only a few candidates noted that Tweedie would not be able to get a registration within that time frame, and that Tweedie's main concern should be whether she will infringe any of the identified trade mark registrations, in particular the MONKEE registration.

Question 3

The analysis of the descriptive nature of the trade mark and possible deceptiveness issues was well done.

The court of appeal considered similar issues in the HEAL THY CHOICE case (in relation to the Trade marks Act 1953) -overseas reputation, relevant date.

The possibility of an application once the mark had been used was not identified by many candidates.

Question 4

Identifying the limitations and requirements for shape marks was generally well done.

Many candidates made no reference to the High Court decision relating to kiwi fruit vine ties (FredcoTrading) - a New Zealand decision on shapes under the 2002 Act.

Candidates should have considered options relating to the shape and the colour, for example separate applications, series applications, the effect of a colour limitation.

Question 5

Regulations 49-53 set out relevant matters. Candidates either knew these or they did not.

Question 6

Easy marks were available for setting out the opposition procedure and commenting on deadlines.

A number of candidates did not identify the possibility of a convention application from Australia for OLD TIMER. This provided a basis for IPONZ to withdraw the acceptance or provided a ground of opposition.

Bad faith was identified by most candidates. Some explanation of bad faith was expected.

The possibility of spill over reputation supporting another ground of opposition s17(1)(a) should have been commented on.

Question 7

Candidates approached the multiple issues in a number of ways, for example cause of action by cause of action, or party by party.

A number of candidates limited passing off to get-up in the packaging, usually by reference to the JIF Lemon case.

The Fair Trading Act grounds were better understood, although some candidates referred to confusion rather than the section 9 requirement of being misled or deceived. The possibility of a s 13 ground of objection was only mentioned by the minority of candidates.

The tests for infringement of a registration were generally identified. Application of the tests caused problems for some, for example a number of candidates said the Bucko Games goods were only similar to the goods of AGL because the Bucko Games Ltd goods had typographical errors.

A number of candidates did not identify the Howard Toys games as being parallel imports, or were confused over what might constitute a parallel import. Only a few candidates considered whether passing off and the Fair trading Act might also be relevant in some circumstances. Most candidates identified the possibility of customs notices. A number of candidates were not clear on the procedure and deadlines. Several appear to have assumed customs seize the goods rather than AGL being required to issue proceedings to prevent the detained goods being released.

The considerations for an interim injunction were well identified.

The possibility of a Metallica or roving Anton pillar type of order for the weekend market traders was identified by most candidates. The explanation of this type of order and when it may be appropriate was good.

The issues relating to a domain name and what grounds it might be attacked on were not well addressed.

The contents and purpose of a cease and desist letter were generally well done.