

2017

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

Comment on the inherent registrability of the following trade marks.

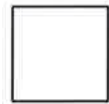
- (a) ULTRA FAST for broadband internet services. [1 mark]



- (b) (the colour purple) for household cleaners. [1 mark]

- (c) FUQ for wound dressings. [1 mark]

- (d) JAMES COOK for electrician services. [1 mark]



- (e) (an image of a square) for toys. [1 mark]

[5 marks in total]

Question 2

Comment on the registrability of the following marks under Section 25 of the Trade Marks Act 2002.

- (a) BRIGHTEN for “traffic lights” (Class 9)

There is a prior registration for BRIGHT IN THE NIGHT for “lights for vehicles” (Class 11). [3 marks]

- (b) CART for “trees” (Class 31)

There is a prior registration for ART for “flowers” (Class 31). [2 marks]

- (c) POLAR BEAR for “non-alcoholic drinks” (Class 32)



There is a prior registration for for “beer” (Class 32). [2 marks]

[7 marks in total]

Question 3

Discuss the border protection measures available under the Trade Marks Act 2002, including the procedures for establishing any border protection measures, and the procedures governing the seizure, detention, and release of imported goods under those provisions.

[5 marks in total]

Question 4

Bloggs Ltd owns a trade mark registration for BLOHARD covering “advertising services; retail services” in class 35.

Bloggs Ltd has been running an advertising agency under the trade mark BLOHARD for the last six years but has never used the trade mark in relation to “retail services” and has no intention of using BLOHARD on these services.

BigBlow LLC has used the brand BLOHARD in relation to its online retail site in the United States and would like to start online sales under the BLOHARD brand in New Zealand. BigBlow LLC asked Bloggs Ltd to consent to its use and registration of the trade mark BLOHARD. Bloggs Ltd is happy for BigBlow LLC to use the BLOHARD brand for “retail services” only, and this suits BigBlow LLC.

Advise BigBlow LLC on what steps it could take to secure the rights it needs in the BLOHARD trade mark. [4 marks]

[4 marks in total]

Question 5

Your client is considering taking a licence and a security interest over a registered trade mark in New Zealand in order to facilitate an amicable split with a business partner.

- (a)** How can your client best secure her interest in the trade mark against third parties? [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 trade mark under the Trade Marks Act? [3 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]

[9 marks in total]

Question 6

Prepare a full clearance search strategy for BLUE DOOR for medical apparatus.

Explain in detail what you would search (including Boolean operators), where you would search, and the criteria you would use.

[10 marks in total]

Question 7

Rave China International Automobiles Company (Rave China) is a car manufacturer based in China. It has made cars for decades and is relatively well-known in some parts of the world. It used to own 90% of a New Zealand company Rave New Zealand Limited (Rave NZ) that bought cars from Rave China and sold them in New Zealand. Unfortunately, the business in New Zealand did not go well and Rave NZ was put into liquidation 3 years ago.

Rave China owns two class 12 trade mark registrations in New Zealand for the RAVE (word) mark and for the Rave Logo, both of which simply list in their specifications of goods: "motor vehicles". Due to poor sales, Rave China decided not to renew the registrations when they fell due for renewal 8 months ago.

Cheeky Garage and Car Imports Limited (Cheeky Cars) is a New Zealand business that specialises in maintaining and repairing cars. Since Rave NZ went into liquidation, Cheeky Cars has been importing and selling genuine RAVE cars in New Zealand. Some of these cars are purchased from foreign distributors and others have been bought second hand at car auctions overseas.

Twelve months ago Cheeky Cars began buying unbranded tyres from China and then applying the trade mark RAVE to them to sell to its customers.

Rave China is not happy about the actions of Cheeky Cars and seeks your advice.

- (a)** Advise Rave China about any legal causes of action and remedies available to it. [12 marks]

Five additional issues (described below) are also causing Rave China concern. Advise Rave China about the legal actions open to it in respect of each (do not discuss remedies).

- (b)** Cheeky Cars has put up large prominent signs on its shop front saying "Authorised Rave dealership". [2 marks]
- (c)** Cheeky Cars has listed its imported cars on a popular online auction website using the word RAVE and also the Rave Logo. [2 marks]
- (d)** Cheeky Cars has filed an application to register the trade mark RAVE for tyres. This application was published as accepted 1 month ago. [3 marks]

- (e) Rave NZ had used the phone number 0800 728369 (RAVENZ) but soon after it went into liquidation this number was released due to unpaid bills. The number now goes through to Cheeky Cars who answers the phone "Hello Rave New Zealand". [2 marks]
- (f) Rave NZ had owned the domain name *www.rave.nz* but soon after it went into liquidation this domain expired. Cheeky Cars now owns the domain name and is redirecting visitors to a popular blog about large dance parties. [1 mark]

[22 marks in total]

Question 8

Crazy Games LLC is a United States based company that operates a popular online software platform for playing computer games. Users simply sign up and then use their usual internet browser to play the games online.

Crazy Games LLC has been operating the platform for seven years but has never advertised or promoted its services in New Zealand. In fact, its services are currently geo blocked for everywhere outside of the United States. This means that New Zealand gamers should not be able to access the service. However, technology savvy gamers in New Zealand have found ways around the geo blocking and for the last 12 months have been accessing Crazy Games LLC's software platform to play games.

Crazy Games LLC is negotiating to sponsor the New Zealand computer games championship. Currently the championship is sponsored by Top Tech Limited. As part of this deal the championship would change its name from Top Tech Championship to Crazy Games Championship. Top Tech Limited is annoyed about being dropped as sponsor.

The first event to be held under the new name will be in December 2017 with advertising beginning in about 3 months time. To coincide with this, Crazy Games LLC intends to unblock its services so that all New Zealand consumers will be able to access its services. Crazy Games LLC is also going to open a store in downtown Auckland called CRAZY GAMES that will sell CRAZY branded gaming merchandise such as clothing, mouse pads, keyboards, headphones and toys.

Crazy Games LLC seeks your advice as to whether it can use and register the trade mark CRAZY GAMES in New Zealand and so you conduct a trade mark search.

Your search of the New Zealand Trade Marks Register for CRAZY GAMES identifies the following trade mark registrations.

- Mark: CRAZY DEALS
TM Registration No. 789100
Services: "retail and wholesale services"
Class: 35
Status: Deemed date of registration - 1 July 2007.
Owner: Fish Supplies Limited

- TM Application No. 1061818
Mark: CRAZY GAMES
Filed on 1 April 2017
Status: Acceptance date: 25 May 2017; Publication date: 26 May 2017
Services - "financial sponsorship" Class 36
- "entertainment" Class 41
Owner: Top Tech Limited.

- TM Registration No. 825555
Mark: LAZY GAMES (registered) for
Goods: "board games and card games"
Class 28
Status: Deemed date of registration 10 June 2010
Owner: Games R Us Limited.

- TM Registration No.814444
Mark: KRAZY
Goods: "clothing"
Class 25
Status: Deemed date of registration 1 October 2009.
Owner: T-shirt Limited.

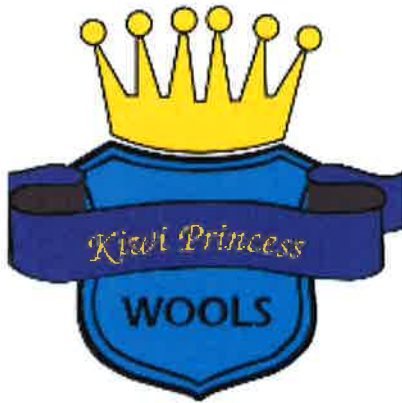
Advise Crazy Games LLC.

[18 marks in total]

Question 9

KPW Limited has filed an application to register a trade mark it proposes to use, details of which are as follows:

Application No.: 1234567



Mark:

Goods: Table covers, bed covers and other textile covers for the household including bed linen and table linen; bath towels, face cloths, beach towels; furnishing accessories for beds.

Class: 24

Filing Date: 7 July 2016

Your client has received a compliance report from IPONZ dated 29 July 2016 with a 7 July 2017 deadline for responding.

The examiner has raised the following objections:

1. Goods and/or services unduly broad

Your class 24 specification includes the wording:

"Furnishing accessories for beds"

This wording is unduly broad. Please specify the exact nature of these goods.

[KPW tells you it wanted to cover valances (i.e. a decorative cover for a bed base) and quilts, as well as padded storage boxes for bed linen designed to go at the foot of a bed. Note: furniture falls in Class 20]

2. Section 25(1) – Similar trade mark

Our search of the trade marks register has revealed at least one trade mark that is similar to yours, and covers the same or similar goods or services. This mark has priority over yours.

Registration No.: 1010101
Mark: PRINCESS WOOLS
Goods: Bed linen; bed blankets; underblankets; duvets; textile covers
for duvets; quilts.
Class: 24
Filing Date: 24 June 2015
Owner: Pea Productions Limited

The objection relates to the following goods/services:

“Table covers, bed covers and other textile covers for the household including bed linen and table linen; bath towels, face cloths, beach towels; furnishing accessories for beds.”

KPW has contacted Pea Productions to seek consent to KPW’s registration of its trade mark. Pea Productions advised it has a policy of not consenting to such things and has declined consent.

KPW now asks you to respond to the examiner’s objections and file submissions in support of registration of the trade mark.

- (a) In relation to the specification objection, briefly advise your client of the issues and propose solutions. [4 marks]
- (b) Assuming Registration No. 1010101 is valid, briefly advise your client of the arguments you would make to IPONZ in an effort to overcome the Section 25 objection. [6 marks]

[10 marks in total]

Question 10

Your client, Jon Dearie ('JD'), is a backyard inventor who has recently developed a new type of chemical coating to protect wooden fence posts from rotting. Farmers can easily spray the coating onto existing wooden fence posts. JD recently launched the product at a large national field day on 14 June 2017 using the brand JON'S NO MORE ROT. It was a huge success and he has started receiving a lot of orders.

JD was about to send out the first shipment of his product when he received a very stern letter from lawyers acting for a New Zealand company called No Rot Posts Limited ('NRPL'). The letter alleges that JD's use of JON'S NO MORE ROT is infringing the legal rights of NRPL and demands that he cease using JON'S NO MORE ROT immediately. The letter also demands that JD pays damages and all the legal costs that NRPL has incurred.

You conduct a brief search of the Register of Trade Marks and find the following two trade marks owned by NRPL.

- TM Appln No. 1071406
Mark: NO MORE ROT
Goods - "chemicals used in agriculture" in Class 1
- "preservatives against deterioration of wood" in Class 2
Status: Under examination
Filed 14 June 2017.
- TM Registration No. 750917
Mark: NO ROT POSTS
Goods: metal fence posts
Class: 6
Deemed date of registration: 10 July 2006
Status: expired but restorable

A bit of investigating shows NRPL has been selling steel fence posts to farmers under the trade mark NO ROT POSTS for over ten years. However, due to the rising price of steel, its fence posts are becoming uneconomical. Farmers have started looking to wooden fence posts as a cheaper alternative. In fact, NRPL has not promoted its products at all for the last 12 months. JD tells you he's heard they are in financial trouble and are having trouble paying their bills.

JD wants to keep using the JON'S NO MORE ROT brand and seeks your advice. Advise JD on each of the following:

- (a) The legal causes of action available to NRPL and any potential defences to such causes of action open to JD. [8 marks]
- (b) The steps you recommend JD take to preserve or improve his legal position and to ensure he has strong defensible trade mark rights in the brand under which he markets his product. [2 marks]

[10 marks in total]

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 use in painting, decorating, printing and art.
- Class 3: Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; non-medicated soaps; perfumery, essential oils, non-medicated cosmetics, non-medicated hair lotions; non-medicated 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: Pharmaceuticals, medical and veterinary preparations; sanitary preparations for medical purposes; dietetic food and substances adapted for medical or veterinary use, food for babies; dietary supplements for humans and animals; plasters, materials for dressings; material for stopping teeth, dental wax; disinfectants; preparations for destroying vermin; fungicides, herbicides.
- Class 6: Common metals and their alloys, ores; metal materials for building and construction; transportable buildings of metal; non-electric cables and wires of common metal; small items of metal hardware; metal containers for storage or transport; safes.
- 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; automatic vending machines.
- 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; compact discs, DVDs and other digital recording media; mechanisms for coin-operated apparatus; cash registers, calculating machines, data processing equipment, computers; computer software; fire-extinguishing apparatus.
- Class 10: Surgical, medical, dental and veterinary apparatus and instruments; artificial limbs, eyes and teeth; orthopaedic articles; suture materials; therapeutic and assistive devices adapted for the disabled; massage apparatus; apparatus, devices and articles for nursing infants; sexual activity apparatus, devices and articles.
- 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.
- Class 14: Precious metals and their alloys; jewellery, precious and semi-precious stones; horological and chronometric instruments.
- Class 15: Musical instruments.
- Class 16: Paper and cardboard; printed matter; bookbinding material; photographs; stationery and office requisites, except furniture; adhesives for stationery or household purposes; artists' and drawing materials; paintbrushes; instructional and teaching materials; plastic sheets, films and bags for wrapping and packaging; printers' type, printing blocks.
- Class 17: Unprocessed and semi-processed rubber, gutta-percha, gum, asbestos, mica and substitutes for all these materials; plastics and resins in extruded form for use in manufacture; packing, stopping and insulating materials; flexible pipes, tubes and hoses, not of metal.
- Class 18: Leather and imitations of leather; animal skins and hides; luggage and carrying bags; umbrellas and parasols; walking sticks; whips, harness and saddlery; collars, leashes and clothing for animals.
- 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; containers, not of metal, for storage or transport; unworked or semi-worked bone, horn, whalebone or mother-of-pearl; shells; meerschaum; yellow amber.
- Class 21: Household or kitchen utensils and containers; combs and sponges; brushes, except paintbrushes; brush-making materials; articles for cleaning purposes; unworked or semi-worked glass, except building glass; glassware, porcelain and earthenware.
- Class 22: Ropes and string; nets; tents and tarpaulins; awnings of textile or synthetic materials; sails; sacks for the transport and storage of materials in bulk; padding, cushioning and stuffing materials, except of paper, cardboard, rubber or plastics; raw fibrous textile materials and substitutes therefor.
- Class 23: Yarns and threads, for textile use.
- Class 24: Textiles and substitutes for textiles; household linen; curtains of textile or plastic.
- Class 25: Clothing, footwear, headgear.
- Class 26: Lace and embroidery, ribbons and braid; buttons, hooks and eyes, pins and needles; artificial flowers; hair decorations; false hair.
- Class 27: Carpets, rugs, mats and matting, linoleum and other materials for covering existing floors; wall hangings (non-textile).
- Class 28: Games, toys and playthings; video game apparatus; gymnastic and sporting articles; decorations for Christmas trees.
- 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 and artificial coffee; rice; tapioca and sago; flour and preparations made from cereals; bread, pastries and confectionery; edible ices; sugar, honey, treacle; yeast, baking-powder; salt; mustard; vinegar, sauces (condiments); spices; ice.

- Class 31: Raw and unprocessed agricultural, aquacultural, horticultural and forestry products; raw and unprocessed grains and seeds; fresh fruits and vegetables, fresh herbs; natural plants and flowers; bulbs, seedlings and seeds for planting; live animals; foodstuffs and beverages for animals; malt.
- Class 32: Beers; mineral and aerated waters and other non-alcoholic beverages; fruit beverages 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 physical protection of tangible property and individuals; personal and social services rendered by others to meet the needs of individuals.