

2018

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) METARAHI (means “great” in Te Reo) for wine [2 marks]

(b)  (the colour green) for household cleaners [1 mark]

(c) KAT TUKKA for pet food [2 marks]

(d) P1425 for electronic goods and components [1 mark]

(e) ALL THE FUN YOU’LL EVER NEED for toys [1 mark]

[7 marks in total]

Question 2

Comment on the registrability of the following marks having regard to Section 25 of the Trade Marks Act 2002.

(a) BEACH BALL for “sunscreen” (Class 3)

There is a prior registration for BALL’N’ BEACH for “sunglasses” (Class 9)
[2 marks]

(b) OMO for “fruit” (Class 31)

There is a prior registration for OH NO for “frozen fruit” (Class 29)
[2 marks]

(c) KOKS (meaning “tree” in Latvian) for “pharmaceutical preparations” (Class 5)

There is a prior registration for TREES for “medication for treating skin irritation”
(Class 5) [3 marks]

[7 marks in total]

Question 3

Answer the following questions.

- (a) Describe all the information that may be required to file a divisional trade mark application? [4 marks]
- (b) When can an owner of an International Registration designating New Zealand file a request to transform the New Zealand designation into a national application or registration?

What is the procedure for doing so?

What information is required to do so?

[4 marks]

- (c) What is a “collective association”? [3 marks]
- (d) How is a “series of trade marks” defined in section 5 of the Trade Marks Act? [3 marks]
- (e) What is the “presumption of validity” under section 75 of the Trade Marks Act? [3 marks]

[17 marks in total]

Question 4

Prepare a full clearance search strategy for EZ BOOK for educational services.

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 5

Safe Garden Products Limited (SGP) owns the following trade mark registrations:

Mark: GroSafe
Registration No.: 1030000
Submission Date: 20 October 2015
Renewal due: 20 October 2025
Goods: Fertilisers; manures; mulches
Class: 1

Mark: FORCE
Registration No.: 1030001
Submission Date: 20 October 2015
Renewal due: 20 October 2025
Goods: Fertilisers; manures; mulches
Class: 1

SGP sells **GroSafe** brand fertilisers for vegetable gardens which are sold in bulk to commercial vegetable growers and in small take home packs in supermarkets for home use.

SGP sells a bulk fertiliser for farmland under the **FORCE** brand which appears on its packaging as follows -

GroSafe

FORCE

fertiliser

SGP has recently discovered that Rapid Fertilisers Limited (RFL) started using the trade mark **GrowForce** about one year ago in relation to garden fertilisers sold in 2kg and 5kg bags at Bunnings retail stores.

SGP is unhappy about RFL's use of **GrowForce**. Analyse the issues, advise SGP on its options for preventing RFL's use of **GrowForce** and provide an assessment of the likelihood of success of any options you propose.

[15 marks in total]

Question 6

Tell Devices Inc (TDI) is a United States company that assembles and sells high quality desktop computers under the trade marks BLACK BOX and a Black Box Cube logo. It owns a New Zealand trade mark registration for BLACK BOX covering “computers” in Class 9. The status of the registration is “Lapsed, but restorable”, being due for renewal on 1 February 2018.

Black Box Distributors Limited (BBD) is a distributor and wholesaler of computers in New Zealand. TDI owned 25% of the shares in BBD. For many years, BBD was TDI’s distributor in New Zealand for all TDI’s computers. TDI would sell its computers to BBD who would then sell them at wholesale prices to large businesses and retail stores in New Zealand.

During and since the Global Financial Crisis sales of BLACK BOX computers in New Zealand were low and inconsequential to TDI and so in May 2015, in an effort to reduce its debt, TDI sold all its shares in BBD.

Immediately following the sale of TDI’s shares in BBD, BBD stopped buying computers from TDI. Instead, BBD bought computers from a cheaper manufacturer in China which, since May 2015, BBD has marketed and sold under the trade mark BLACK BOX.

For the last three years, TDI has not sold any computers in New Zealand, but it now wants to recommence selling computers in New Zealand through its Australian distributor. TDI contacts a nationwide retailer in New Zealand to see if it would be interested in stocking BLACK BOX computers again. The retailer responded by saying it already stocked BLACK BOX computers and had done so for at least 10 years.

- (a) Advise TDI about the legal causes of action open to it, the legal remedies that might be available, the risks it might face, TDI’s prospects of success, and steps TDI could take to improve its position. [15 marks]

Four additional issues (described below) are also causing TDI concern. Advise TDI about its legal options for resolving each issue (without discussing remedies) and provide analysis of the likelihood of success of any action you consider has merit.

- (b) BBD has filed an application to register the trade mark BLACK BOX for “retail of computers” in Class 35 and “financing services” in Class 36. The application was published as accepted 1 month ago. [5 marks]
- (c) TDI owned the domain blackbox.co.nz and redirected traffic to its main website blackbox.com. TDI let this domain lapse two years ago. BBD immediately registered the blackbox.co.nz domain and started using it to promote its business. [3 marks]

- (d) TDI is receiving complaints via its phone number about faulty BLACK BOX computers bought by New Zealand customers from BBD. It turns out that BBD's website says complaints and faults with BLACK BOX computers should be directed to TDI. [2 marks]

- (e) BBD's computers look exactly like the computers sold by TDI. BBD even uses the same Black Cube logo. [3 marks]

[28 marks in total]

Question 7

- (a) What are the minimum requirements a document purporting to transfer ownership of a trade mark registration must have in order to record an assignment on the Register of Trade Marks. [4 marks]

- (b) Review the attached document and advise No Hat Cat Limited ("NHC") about any issues it may need to consider, what changes should be made to the document and why, and what other steps it should take to improve its position having regard to best practice for assigning trade marks. [9 marks]

- (c) You discover that Too Many Hats Limited ("TMH"), at the time it filed its applications, never intended to use the trade marks. Advise NHC about this and what steps it should take to improve its position. [3 marks]

[16 marks in total]

Attachment to Question 6

DEED OF ASSIGNMENT

PARTIES

Too Many Hats Limited, a New Zealand company, of 1 Park Road, Wellington, New Zealand (**Assignor**)

No Hat Cat Limited, a New Zealand company, of 2 Cattery Road, Auckland, New Zealand (**Assignee**)

INTRODUCTION

The Assignor is the owner of the Trade Marks.

The Assignor has agreed to assign to the Assignee, and the Assignee has agreed to accept, the Trade Mark Rights on the terms and conditions of this deed.

COVENANTS

Effective Date means the date on which this deed has been signed by both parties;

Trade Mark Rights means the Trade Marks; and

Trade Marks means the registrations or applications for the trade marks set out in the Schedule.

Assignment: The Assignor transfers to the Assignee from the Effective Date the Trade Mark Rights

Governing law: The formation, validity, construction and performance of this deed will be governed by and construed in accordance with the laws of New Zealand. The parties irrevocably agree that the courts of New Zealand will have non-exclusive jurisdiction to hear and determine all disputes under or in connection with this deed

SIGNED AS A DEED

SIGNED on behalf of **Too Many Hats Limited**
by:

Signature of Director

Name of Director

Date

SIGNED on behalf of **Cat With No Hat Limited**

by:

Signature

Name

Date

Title

WITNESS


Signature: _____

Name: _____

Address: _____

Occupation: _____

SCHEDULE

Country	Number	Trade Mark	Classes	Status
New Zealand	1949030	CAT	25	Expired
New Zealand	1949031		25	Registered