

2019

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)

Attached: Class Headings (Nice Classification)

Question 1

Comment on the inherent registrability of the following trade marks.

- (a) **FOVEAUX STRAIT** (a strait in New Zealand) for fishing equipment [1]



- (b) for cricket bats [1]

- (c) **ONLY WATER** for flavoured water [1]

- (d) **Julius Caesar** for bath robes [1] (Julius Caesar was the name of a Roman politician born in 100 BC)

- (e) **SWEETEST THING** for chocolate [1]

[5 marks in total]

Question 2

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

- (a) **SWIMMING SUIT** for “cafe services” (Class 43)

There is a prior registration for **SUITS** for “coffee” (Class 30)
[3]

- (b) **FIRST CHOICE** for “apple trees” (Class 31)

There is a prior registration for **FROZEN CHOICE** for “frozen apples” (Class 29) [2]

- (c) **TUDO NEGRO** (meaning “all black” in Spanish) for “body deodorant for men” (Class 3)

There is a prior registration for **ALL BLACKS** for “perfume” (Class 3) [3]

[8 marks in total]

Question 3

Answer all of the following questions.

- (a) In Regulation 51 of the Trade Mark Regulations, what does “Division of trade mark application” mean and what can the division apply to? **[4]**
- (b) What is the effect of a trade mark limited in whole or in part to one or more specified colours? **[2]**
- (c) When may two persons make a valid joint trade mark application? **[2]**
- (d) What is the presumption of validity under Section 75 of the Trade Marks Act? **[4]**
- (e) According to the Trade Marks Act and IPONZ practice guidelines, what are the requirements of a letter of consent? **[5]**

[17 marks in total]

Question 4

Prepare a full clearance search strategy for QWIK FUN for entertainment 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

You meet with Ricky Joy who says he has a great idea for a new business. He says there is a heap of money to be made selling marijuana, and he wants to get everything ready so he's good to go as soon as marijuana is legal in New Zealand.

Ricky wants some help protecting the names he's come up with. The two options are **TOA** (Maori word meaning “shop” or “store”) and **KINGI** (Maori word meaning “king”). His friend has also generously designed him a sweet logo to use, for free!

He plans to sell online and maybe to have an App to assist buyers to place orders. He is also thinking of selling a range of merchandise.

Ricky has set up an unincorporated trust called Ricky's Trust to own the name. He wants you to file a trade mark application using the following list of goods and services he has prepared:

- *Online retail services featuring cannabis; marijuana; cigarettes; tobacco products; vaping equipment; accessories; t-shirts.*
- *Software.*
- *Providing a website with information about cannabis; marijuana; cigarettes; tobacco products; vaping equipment; accessories; t-shirts.*
- *Promoting cannabis; marijuana; cigarettes; tobacco products; vaping equipment; accessories; t-shirts.*

Ricky wants you to register his trade marks and advise him. He thinks this could be a global business.

Pulling out a bundle of cash from his back pocket, he says he prefers to pay in cash and all upfront if possible.

Advise Ricky.

[24 marks in total]

Question 6

Comfy Clothing Limited ('CCL') manufactures a large range of menswear. Around 6 years ago CCL began selling a low turnover range of tailor-made business shirts under the trade mark **HAPPY SHIRTS**.

CCL has recently filed a trade mark application for **HAPPY SHIRTS** covering "clothing" in class 25 and "clothing retail services" in class 35. IPONZ has issued an adverse compliance report which rejected the application under s. 25 of the Trade Marks Act, citing the following prior registration:

Mark: HAPEE SHIRTS

Number: 794444

Goods: "T-shirts"

Class: 25

Filed: 15 June 2009

Renewal Due: 15 June 2019 (expired but restorable)

Owner: Hapee Hippee Limited.

CCL's investigations indicate that Hapee Hippee Limited ('HHL') was quite well known for its t-shirts which it sold under the **HAPEE SHIRTS** brand, because the t-shirts carried humorous images promoting the use of marijuana. However, due to a fire at HHL's premises, HHL ceased trading in November 2016. HHL was struck off the Register of Companies on 1 May 2019 through failure to file an annual return.

Advise CCL of possible strategies for overcoming the citation of Registration No.794444.

[14 marks in total]

Question 7

You act for Endura Chemicals (“Endura”) which owns the following trade marks:

- Trade Mark No. 216075 **DURAGESIC**, registered since 7 February 1992 covering “analgesics and other pain relief preparations” in class 5.
- Trade Mark No. 216076 **DURATAC**, registered since 7 February 1992 covering “analgesics and other pain relief preparations” in class 5.

Endura has used these trade marks for almost 20 years in relation to transdermal patches containing pain relief medication which are sold by prescription only.

Alpha Pharmaceuticals (“Alpha”) has filed Trade Mark Application No. 842865 **DURAact** in relation to transdermal patches containing pain relief medication in class 5. The current status of the application is “under examination”. Alpha intends to launch its **DURAact** brand of non-prescription (over the counter) transdermal patches tomorrow.

Alpha also owns the following trade mark registrations:

- Trade Mark No. 69024 **DURAMINE** registered since 3 July 1961 in relation to “pharmaceutical preparations and substances for use in the treatment of obesity” in class 5.
- Trade Mark No. 100524 **DURATUSS** registered since 15 May 1972 in relation to “pharmaceutical products for the treatment of pain, fever and colds” in class 5.
- Trade Mark No. 206548 **DURAMAX** registered since 11 August 1990 in respect of “pharmaceutical preparations and products” in class 5.
- Trade Mark No. 794166 **DURATRAM** registered since 11 August 2008 in respect of “pharmaceutical preparations and products” in class 5.

Endura is concerned about Alpha’s proposed use of **DURAact** and wants to stop it using and registering **DURAact**.

Advise Endura:

- (a) Whether and how, and on what grounds, it could prevent registration of **DURAact**.
- (b) Whether and on what grounds it could prevent Alpha’s proposed use of **DURAact**, and what (if any) remedies might be available.

[22 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.