

**EXAMINATION FOR REGISTRATION AS A PATENT AND/OR
TRADE MARKS ATTORNEY**

OCTOBER 2000

SUBJECT C: TRADE MARK LAW

Time Allowed: 3 ½ hours

Instructions to Candidates

1. Standard required to pass: 50%
2. Reading time: 10 minutes
3. Candidates should attempt ALL FIVE questions
4. The maximum marks for each question are indicated beside the question number
5. Candidates should, where relevant, support their answers by reference to decided cases, and provisions of the Trade Marks Act 1995

QUESTION ONE (Total – 20 marks)

- (a) Discuss the doctrine of imperfect recollection in determining whether trade marks are deceptively similar.
- 8 marks**
- (b) State briefly the facts findings and principles of law in the following cases:
- (i) Parkdale Custom Built Furniture Pty Ltd v Puxu Pty Ltd (1982) 149 C.L.R. 191
 - (ii) Koninklijke Philips Electronics NV v Remington Products Australia Pty Ltd 2000 AIPC 91-573
 - (iii) Top Heavy Pty Ltd v Killin (1996 34 IPR 282)

Total 12 marks

QUESTION TWO (Total – 20 marks)

Agia SpA, an Italian pharmaceutical manufacturer, has developed a drug which has proved successful in the treatment of depression. Having obtained government approval in Italy, Agia launched the product in that country in October 1998 under the trade mark IMPREVIUM.

In January 1999, Agia was visited in Rome by officers of an Australian pharmaceutical company, Alpha Pty Ltd, who expressed interest in distributing IMPREVIUM in Australia. Agia gave consideration to this suggestion, but finally appointed another company, Maxia Pty Ltd, as its distributor in Australia. Following correspondence and discussion, Agia concluded a distribution agreement with Maxia in June 1999. Maxia commenced clinical trials of IMPREVIUM in Australia in August 1999 and in September 1999 applied to the Department of Health for permission to sell IMPREVIUM in Australia.

Maxia has now noticed an announcement by Alpha that it plans to sell an analgesic under the trade mark IMPREVIA. Maxia has also learned that Alpha applied for registration of both IMPREVIUM and IMPREVIA in October 1999, and that these applications have been advertised as accepted in the Official Journal of 6 March 2000 for statements of goods reading: ‘Medicinal and pharmaceutical preparations including analgesics’.

Agia and Maxia inform you that no sales of IMPREVIUM had occurred in Australia prior to June 1999, but that a packet of IMPREVIUM pills together with brochures concerning the product (all, however, in the Italian language) had been sent by Agia to Maxia for consideration in May 1999. Furthermore, articles concerning IMPREVIUM appeared in the October 1998 issue of ‘The Psychiatrist’, and the July 1999 issue of the ‘Australian Journal of Medicine’. ‘The Psychiatrist’ is read by most Australian psychiatrists, while the ‘Australian Journal of Medicine’ has a very wide circulation among Australian medical practitioners generally. Your clients further assert that any confusion between their product and an analgesic could have dire consequences for the health of the patient.

Advise Agia and Maxia.

QUESTION THREE (Total – 20 marks)

Would there be infringement under the Trade Marks Act 1995 in the following circumstances?

- (a) A owns a registration of AIR HORSE for ‘vehicles and apparatus for locomotion by land air or water and parts thereof’. B uses FLYING HORSE for jet engines. **4 marks**
- (b) A owns a registration of METACILLIN for veterinary preparations. B uses BETACILLIN for an antibiotic. **4 marks**
- (c) A’s registration of STREETMASTER covers tyres. B repairs and retreads second hand tyres (including but not limited to STREETMASTER tyres) and sells them as ‘genuine STREETMASTER retreads’. **4 marks**
- (d) A owns separate registrations of TREASURE SEARCH, SPY SEARCH and PIRATE SEARCH which cover ‘computer hardware and software’. B sells an electronic game called FAMILY SEARCH. **4 marks**
- (e) SCHOOLIES is registered for travel services. A cruise ship company uses the word SCHOOLIES in advertising for cruises for school leavers. **4 marks**

QUESTION FOUR (Total – 20 marks)

Mary Jones is a manufacturer of handbags. At first, Mary made and distributed these bags herself. She called them FUNNY BAGS, and sold them with a small label attached reading “A FUNNY BAGS Product”.

Later Mary was approached by Fred Smith, who suggested that he should take over the distribution of the bags, leaving Mary to concentrate on production. Mary agreed, and under these arrangements, the product achieved great commercial success. Mary took on a number of assistants, and Fred now distributes the bags throughout Australia.

However, relations have soured between Mary and Fred, and Fred has informed Mary that he will be seeking alternative sources of supply. Fred has also warned Mary that he has applied to register FUNNY BAGS as a trade mark in his own name and that Mary must desist from further use of FUNNY BAGS. Fred has also written to retailers stating that FUNNY BAGS products are available exclusively from him, and that, if it became necessary, legal proceedings would be taken to protect his trade mark.

Mary has learned that before selling the FUNNY BAGS products, Fred has always added a label stating “Made exclusively for Fred Smith” and “FUNNY BAGS is a trade mark of Fred Smith”.

Mary believes that FUNNY BAGS is her trade mark, and seeks your advice as to what actions are available to her under the common and/or relevant statutes.

QUESTION FIVE (Total – 20 marks)

(a) Discuss the registrability of the following marks:

- (i) NO SMOKING for restaurant services
- (ii) KALGOORLIE for airconditioners
- (iii) The colour aquamarine for telecommunications

12 marks

AND

(b) What protection, statutory and otherwise, is provided to:

- (i) Olympic insignia?

AND

- (ii) Geographical indications?

8 marks

END OF PAPER