



IPSANZ

New Zealand Update

2012

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Law Reform

- Patents Bill – still on hold
- Madrid Protocol
- IPONZ discussion paper – April
- Review TM Reg 2003
- Implement – Oct

Patent Attorney Regulation

- Cabinet agreement (Nov 2011) - patent attorney regulation - single trans-Tasman registration regime
- Bilateral Instrument being developed
- Domestic legislation - NZ and AU
- 2/3 years

File Sharing Infringement

- Discussion paper - review \$25 fee IPAPs charge right holders
- 2,500 (approx.) notices
- No 3rd Strikes/tribunal decisions
- Avoidance Strategies

The 'Good Life'



Indictment/extradition

- Megaupload's direct delete feature - voluntary
- Warner Bros - maximum quota 100,000 deletes per day
- Removed 1,9 m links - largest deleter v RIAA 17,000 links
- DMCA - safe harbour protection - links or actual files?

Recent Decisions

- Patents:
 - *Interpharma*
 - *Stewart*
- Trade Marks:
 - *MV Sumatra*
 - *Coombe v Coca Cola*
 - *Sambbasivam*
- Copyright:
 - *Oraka Technologies*

Patents



Interpharma

Issues:

- ❖ Amendments enlarge scope of patent
- ❖ Is post amendment decision amenable to judicial review; and
- ❖ Did the Commissioner make an error of law - failing to adequately inform himself as to relevant considerations?

Amendment Proper?

- Skilled addressee (Professor Tucker) - interpreted original claim 1 as limited to stock solutions
- Not encompassing a perfusion
- Amendments enlarged scope of claim
- Commissioner lacked jurisdiction

Discretion

- COP had to be satisfied proposed amendments fell within s 40(1) - disclaimer, correction or explanation
- Must know prior art- determine true nature of proposed amendments
- Error of law in exercising discretion without necessary information

S40(2)

- Judicial review precluded?
- Where, after the date of the publication of a complete specification, any amendment of the specification is allowed or approved by the Commissioner or the Court, *the right of the patentee or applicant to make the amendment shall not be called in question except on the ground of fraud*; and the amendment shall in all Courts and for all purposes be deemed to form part of the specification

van Gelder 's Patent

- Lord Esher:
- “The *Attorney-General* cannot make a valid amendment if it is to substantially enlarge the invention, or make it a substantially different invention. He cannot do it effectively. That is by virtue of Subsection 8. Then, if that be so, Subsection 9 has not the effect of making that, which he has done invalidly, conclusive, and if what he has done is invalid by reason of Subsection 8.”

Bowen LJ

"....supposing the disclaimer is an improper one, having regard to subsection 8, then although he has got the leave, it does not end the matter, because in any future proceeding it may be said, "Yes, but the leave given to you was inconsistent with the act of Parliament and that point could be taken, it seems to me, in all subsequent proceedings."

Moser v Marsden doubted and distinguished

Discretionary factors

- Patent two years to run
- Patent attorneys not “unduly slack”
- Acted promptly when on notice

Champagne Xpress bottle opener



“Inventor wins \$1m in patent scrap over clever champagne opener”

- United States co Franmara offered US\$2500 for licence in 2003
- Copied design and sold online
- Toogood J US\$864,500 damages, interest and costs

Stewart v Franmara Inc

- Formal proof
- US Company - served but no defence
- Confidentiality agreement - 2003
- "All matters relating to" bottle opener
- Invention = initial invention and any other invented by Inventor and disclosed to Recipient from time to time

Toogood J

[38] “Online distribution occurs in nations which have access to the world-wide web, including New Zealand and the United States of America. The defendant’s actions amount, therefore, to a breach of the confidentiality agreement and an infringement of the New Zealand patent “ .

[45] “In examining this aspect of the plaintiff’s claim, I have considered whether a New Zealand Court has jurisdiction over the alleged infringement of a patent granted outside New Zealand. Where there is a question about the validity of the patent there may be some doubt as to whether this Court is entitled to adjudicate on the plaintiff’s claim.”

[52] "I am satisfied also that the defendant's conduct in marketing the product in New Zealand via the internet constitutes a use or imitation of the plaintiff's invention in New Zealand, amounting to an infringement of the plaintiff's New Zealand patent"

Trade Marks



N V Sumatra v NZ Milk Brands



Comparison of Marks

- Dobson J too absolute - ANGKOR conjures up Asian or foreign flavour
- ANGKOR and ANCHOR still similar
- Differences not picked up by consumers in normal shopping situation
- Device marks different

Relevant Comparison

- s 25(1)(b) – TM's compared - only to similar goods
- Overall assessment - look at common denominator of all Milk Brands' marks - word ANCHOR
- Similarities, not differences important
- HC's approach wrong - ANCHOR word marks v goods similar to Sumatra's

Correct Test

1. Does proposed mark cover same or similar products covered by **any of** opponent's TM registrations,
2. If yes, is proposed mark similar to any of opponent's TM's for same or similar goods; and
3. If yes, likely to deceive or confuse?

Non-dairy Creamers

- HC correct - both goods for “whitening”
- Uses and users identical
- Same trade channels
- Sold close together
- Different physical nature not determinative
- Same applies to flavourings

- s 25(1)(b) - Cereal, biscuits and confectionery – not similar to ANCHOR in class 30
- Specification no longer covers cereal products, biscuits and confectionery
- 25(1)(c) - ANCHOR only well known for dairy products - no connection or prejudice

Coombe v Coca-Cola



Wikipedia

- "The phrase "World famous in New Zealand" is a commonly used phrase within New Zealand. It is used to describe items that though famous within New Zealand are unknown in the rest of the world..."
- Synonym - used by general public - describe all things "kiwiana" well-known only in NZ

Slogan

- Phrase - 1993 ('L&P') soft drink
- S18:
 - Consist only of signs or indications designating kind, quality, quantity, value or geographical origin of goods
 - Customary in current language or bona fide and established practices of trade
 - No distinctive character in relation to goods

- Not ordinary way to convey characteristic
- Invented and fanciful slogan
- Oxymoron quirky, original and distinctive
- Not merely descriptive or laudatory because well known
- Only Coca Cola used on soft drinks

[24] “Whether WFINZ is merely a descriptive or laudatory phrase is a question of fact.

In this case I agree with the position of the Commissioner that describing something as WFINZ is not merely the ordinary and usual way to convey that WFINZ is an invented and fanciful slogan.

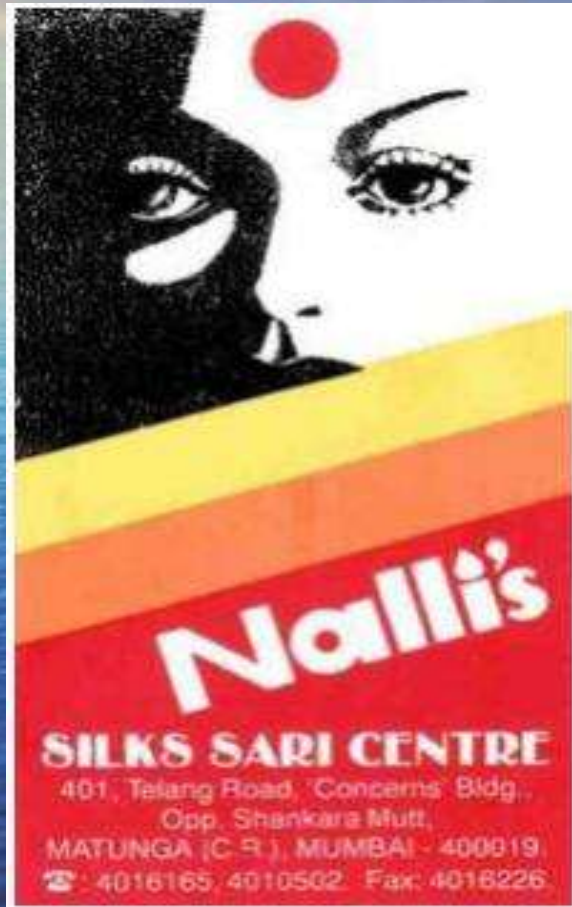
It is an oxymoron that produces a quirky, original, and distinctive incongruous and self-contradictory statement.”

[43] “Looking at the phrase in the abstract, while it is possible it could remain meaningful when applied to other types of goods, that alone does not mean that it is devoid of distinctive character.

Undoubtedly, when first coined the phrase was distinctive.

More importantly, when assessed in context, it is not a phrase that has been used by other manufacturers of soft drinks. Nor is it something that could be adopted in relation to soft drinks sold in New Zealand generally.”

Sambbasivam v Chetty



Nallis

Genuine Use?

- Appeal - AC
- Revoke 2 TMs - saris, headgear and footwear
- 3 years – no genuine use
- S's – agent/studying in NZ
- Delivery from family shop in India - 2 items - packaging included TM
- Distributed 75 business cards

IPONZ

- New evidence excluded – strategic holding back – not exceptional circumstances
- Insufficient evidence to attribute use of mark to goods delivered
- Deliveries from shop in India not trade in NZ
- Student visa prevented genuine trade

HC

- Attempt to game timetabling - antithesis of genuine reason
- Sales isolated, but genuine use of mark 'for purposes of trade'
- Student visa irrelevant to "trade"
- Sales could be foothold in NZ - adequately proven

[46] “I consider that the activity qualifies as genuine when such a small number of dealings might in other contexts not qualify as such, because of the nature of the goods in respect of which the mark is used. Two transactions in the space of the relevant three-year period in other contexts such as, say, a high volume manufacturing business, might be so insignificant as to not justify a finding that the use is genuine. However, business on a very modest scale as an adjunct to a principal businessmay qualify as genuine without the same minimum level of activity that would be required in other contexts to establish its **genuine character.**”

Zone

- IP ZONE/ZONE
- On-line and off line TM business
- ZONE IP
- American Express
- Trading in IP assets

“My” Marks

- AMI
- MY INSURANCE/MY CAR INSURANCE/MY HOUSE INSURANCE
- “MY” adds distinctive element to generic phrases
- use unusual and awkward
- “MyDoctor” – not actually a doctor

Optimize

- **Optimum**
- Optimise your pet's health ...

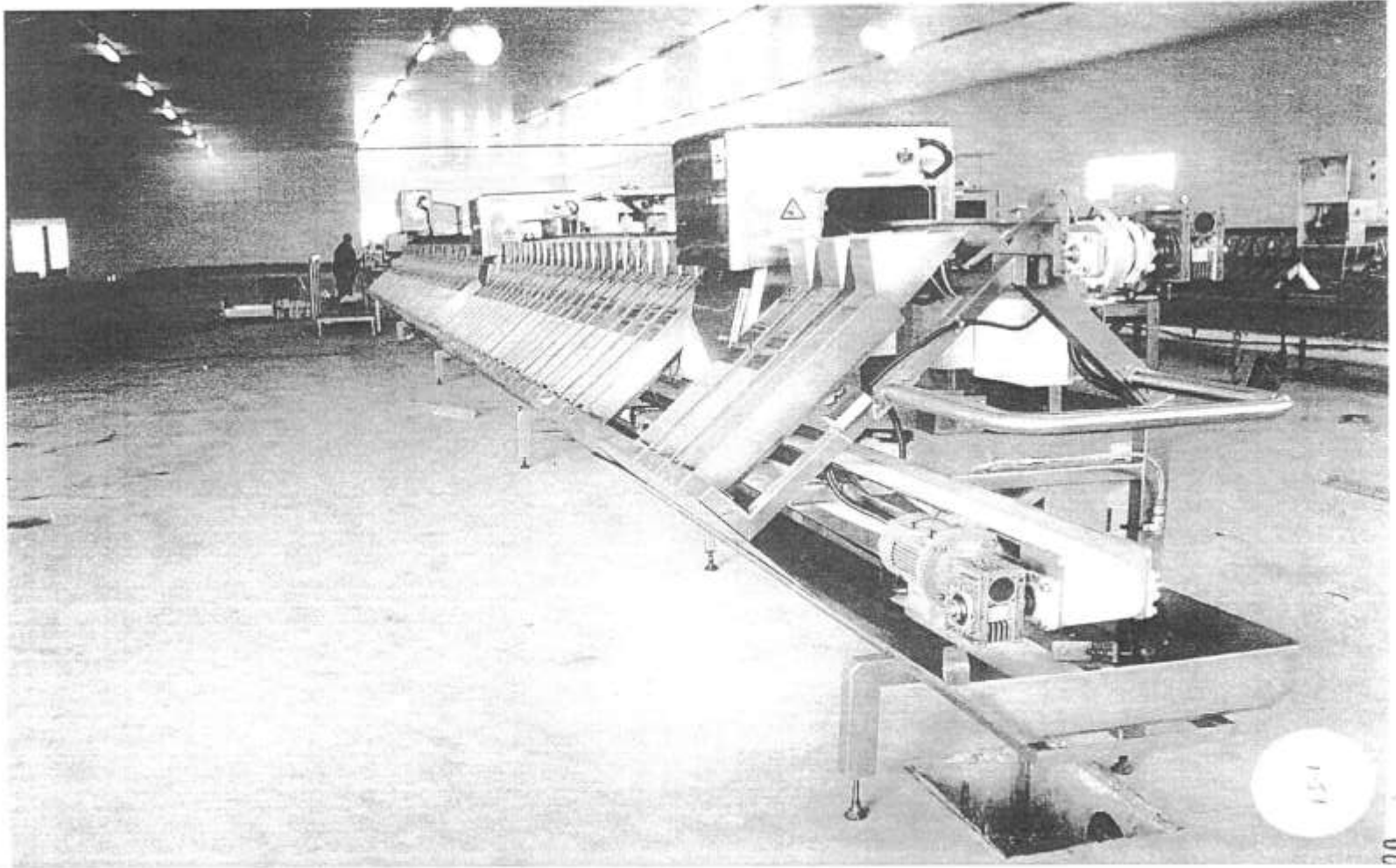


OPTIMIZE PRO
LEAD THE PACK

Copyright



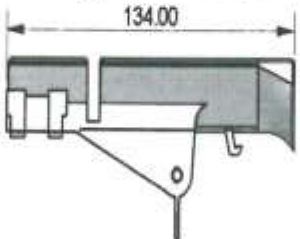
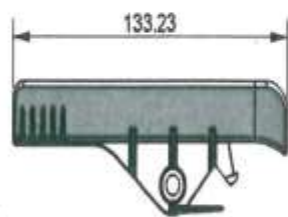


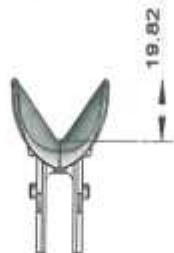
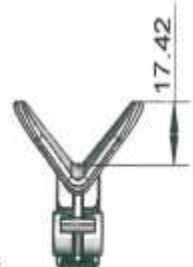
Oraka Technologies



- Electronic grading equipment - sorting fresh asparagus spears
- Copyright - cup assembly & collection chute
- Concept design - three parts of system - cup, chassis and trigger

Expression of principles in Oraka, Strauss and Geostel Chassis, Trigger and Cup

Areas of interest highlighted in red.

CUP	Oraka	Geostel	Strauss
Principle 1 - Elongated cup identified 168/15, 170/3 and 174/16			
Expressions of principle 1: Trio 1	Actual length 134 mm 168/30 	Actual length 133.23 - 174/16  2007	Actual length 2-3mm longer 170/38
Principle 2 - V shape identified 168/16 and 170/5			
Expressions of principle 2: Trio 1	Angle of V 90° - 168/33 	Angle 95°  2007	Very wide, rounded V 170/5-7
Trio 2	Depth of cup - 168/34 	 2007	Depth, width, radius of cup 171/4

Ownership

- Did Holdings take over Technologies' business and assets?
- Inference - mere speculation
- Not good at legal & admin aspects
- No assignment in writing

Idea / Expression

[62] idea of tipping cup attaches to conveyor belt v original expression of idea

Causal Connection

- Designers' meeting notes – reference to “existing” system
- Def's - cup assembly to compete
- On-going reference as development work proceeded

Speed

- [86] plaintiffs - speed inconsistent with independent design trail - powerful indicator of copying
- Defs – designers were skilled and expert and Mr Schwarz less organised and initially lacked experience
- Allan J – can't speculate

Infringement

- [106] Substantial part - qualitative, visual impression rather than quantitative analysis
- Pls' product - both quality & quantity
- Each component inter-dependent with others

Starting Point

- [110] PI's system - starting point
- Relied upon by designers
- No evidence of copying from plans and designs
- But reference back for solutions
- Q – incorporation of ideas or expression only?
- Solve problems in original way?

Template?

- [114] PI - copying inevitable
- Design must be very close - fit same machine & perform same function
- Differences aesthetic & not substantive
- Outcome virtually pre-ordained - no spare-parts exception

Functional Constraints

- [122] Dimensions & parameters = functional constraints
- Third party technology - software, magnetic actuation, Flextrak slat & collection chutes
- Placement & juxtaposition of items - same constraints on both the Pls and Defs
- Cf - side loaders *Steelbro* - shipping containers and truck trailers

- [124] “Given the **functional constraints** which dictated the design of both cup assemblies, it might be thought that the scope for variation between the products was limited. Similarities will be inevitable and might, at least in part, be explicable by reference to those constraints....

- “But **care is needed** over the making of assumptions where, as here, there has been access to the plaintiffs’ works throughout, and where indeed the copyright works (or a three-dimensional reproduction of those works) was the **initial starting point**. On the other hand, I bear in mind also the principle that where there are functional manufacturing constraints, competing products might necessarily be similar, and **small differences will then be of particular significance.**”

Adequate Explanation?

- [173] Degree of resemblance expected
- Points of resemblance satisfactorily explained - functional or market considerations
- Similarities no greater than expected even if completely independently designed
- Similarities in principles - not expression

Interdependence – Cup Assemblies

- [175] Interdependence of 3 key dimensions = objective similarity
- Not establish “**sufficient** similarity”
- Common principles - expressed differently

A wide-angle photograph of a sunset over a vast, calm ocean. The sky is a deep, vibrant blue, with wispy white clouds scattered across it. The sun is positioned on the left side of the frame, just above the horizon, creating a bright, glowing effect that transitions from yellow to orange and then to a soft purple. The ocean's surface is dark blue with gentle ripples, reflecting the light from the sky. The overall mood is serene and peaceful.

And that's it, thanks.