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IP: *lock & key*

K&L Gates' Savannah Hardingham and Olivia Coburn report on a case over the ditch.

REGISTRATION OF A trade mark is the first step in protecting a brand. However, it is also important for brands to keep a watch on competitors and oppose applications to register marks which are similar to their brands. This was highlighted in a recent New Zealand case involving Australian handbag and accessories business Mimco.

Mimco successfully opposed a New Zealand trade mark application filed by Vestiditos for "Mimo & Co".

The goods and services claimed in the application for the Mimo mark included clothing, footwear, headgear, organising fashion shows and related services.

Mimco is the owner of various registered trade marks in New Zealand, including Mimco, Mimco Timepiece and Mimco Precious.

Grounds of opposition

Mimco relied on several grounds of opposition, including that:

- the Mimo mark is similar to Mimco's registered marks and claims the same or similar goods and services
- the use of the Mimo mark would likely deceive or confuse consumers, and
- the Mimo mark is identical or similar to Mimco's trade marks which are well known in New Zealand.

The Assistant Commissioner of Trade Marks (Commissioner) found that Mimco had proven the first two grounds of opposition. To be successful, Mimco only needed to establish one ground.

Decision

In respect of ground (1), the Commissioner focused only on Mimco's registrations for the Mimco mark as these marks were the closest to the Mimo mark. The Commissioner found that there was an obvious overlap between the goods and services claimed by the Mimo mark and the Mimco marks. The Commissioner accepted Mimco's argu-

ments that the Mimo mark is similar to the Mimco marks, namely that:

- the words Mimco and Mimo & Co are visually and phonetically similar;
- the elements Mim and Co are a visual focus for consumers when reading both marks, and are therefore a source of confusion between the marks; and
- the dog device in the Mimo mark does not render the mark different enough to co-exist with the Mimco mark without confusion.

For ground (2), the Commissioner found that there was an awareness of the Mimco mark in New Zealand. The onus then shifted to Vestiditos to demonstrate that its mark was not likely to deceive or cause confusion in the market. Vestiditos did not participate in the proceeding and the Commissioner found that Mimco established that the use of the Mimo mark would likely deceive or confuse consumers.

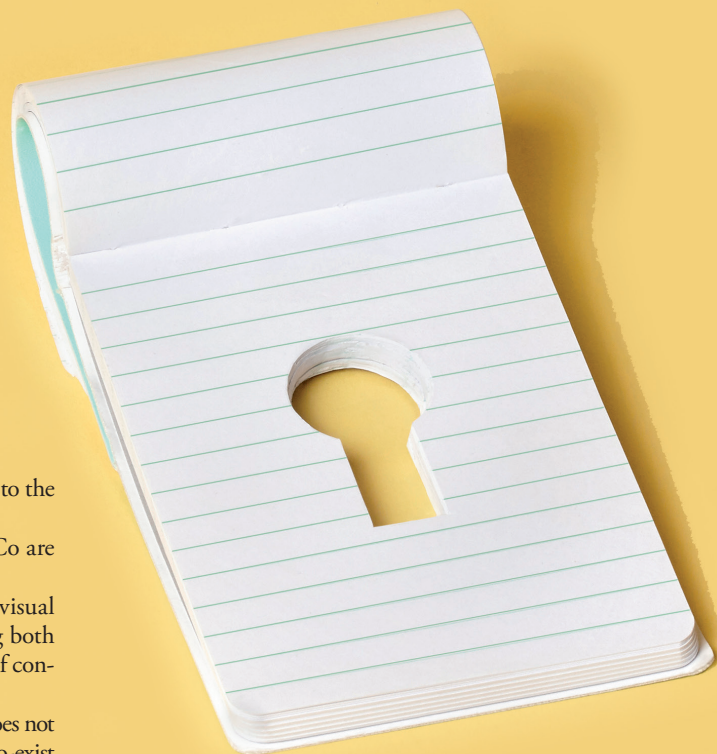
Regarding ground (3), the Commissioner found that whilst Mimco has a degree of reputation in New Zealand, it was not a "well known" mark.

Trade mark watching

This decision underscores the importance of trade mark owners keeping a keen eye on their competitors and their pending trade mark applications in key markets.

Once a trade mark is accepted for registration, the opposition period starts running. Trade mark oppositions must be filed within this period otherwise a trade mark will proceed to registration. While it may still be possible to attack a trade mark after registration, this process involves court action which can be expensive and time consuming.

In most countries, trade mark owners are not automatically notified when applications for similar marks are accepted for registration by the local trade marks office. In Australia, trade mark owners can monitor pending similar applications by reviewing the Australian Trade Marks Register online.



“ This can be an inexpensive and effective way to protect a brand. ”

However, the best way for trade mark owners to ensure they are aware of all relevant applications in time is by utilising a trade mark watching service. This can be an inexpensive and effective way to protect a brand. Typically this service involves periodic reviews of the relevant trade marks registers. Marks which are identified as being similar to the registered trade marks recorded with the watching service are then reported back to brand owners, in time for them to consider filing oppositions.

Brand owners should speak to their intellectual property lawyers regarding the benefits of trade mark watch services. These services can provide peace of mind and ensure that competitors' similar marks do not slip through the cracks and proceed to registration. ■

For more information about issues relating to trade marks and watching services please contact Savannah Hardingham Special Counsel at K&L Gates (savannah.hardingham@klgates.com). This article is for informational purposes and does not contain or convey legal advice. The information herein should not be used or relied upon in regard to any particular facts or circumstances without first consulting a lawyer.