

## Oyster bay keeps out Oystercatcher

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World renowned New Zealand winemaker, Delegat's Wine Estate Limited, which owns "Oyster Bay" wine, has successfully prevented registration of an application for the trade mark "Oystercatcher" by Oystercatcher Wines Limited.

The Assistant Commissioner has found that the dominance of the element "Oyster" in the Delegat's trade mark, together with Delegat's' other "oyster" marks and the use which Delegat's has made over the years together combine to make registration of the "oystercatcher" mark likely to confuse and deceive consumers.

Delegat's has for many years used the OYSTER BAY device mark incorporating a scene of the bay, together with the word mark OYSTER BAY, and has also promoted the mark 'SOMETIMES THE WORLD REALLY IS YOUR OYSTER'. It also has registered the mark "OYSTER".

The Assistant Commissioner found that the OYSTER BAY mark is well known in New Zealand, and that the trade mark "SOMETIMES THE WORLD REALLY IS YOUR OYSTER" also had a sufficiently substantial reputation in the market. The acquisition of distinctiveness was central to the Assistant Commissioner's decision.

The Assistant Commissioner noted the extensive sales of OYSTER BAY wine in New Zealand and overseas since 1990, the large range of outlets, the extensive advertising and promotion,

that OYSTER BAY represented 12 percent of New Zealand's wine exports, and was sent to 30 countries, its international success in both sales and awards, the fact that there was only one OYSTER BAY wine in each category of wine, and its high ranking in the Wine Intelligence Survey of consumers.

When comparing the marks, the Assistant Commissioner primarily compared the word mark OYSTER BAY with the word mark OYSTERCATCHER, while noting the device mark and the SOMETIMES THE WORLD REALLY IS YOUR OYSTER mark.

She noted both that the opposed mark could be stylised in the same manner as Delegat's mark and also that she needed to consider the actual use of the mark by the opponent.

With respect to the idea of the mark, the Assistant Commissioner said that provided she left aside the actual use of the mark, the idea of the two marks was different – one being the name of a place and the other a wading shorebird.

However when she introduced the actual use of the mark into her analysis she found that the OYSTER element in the mark was the dominant essential feature of the mark and that the opposed mark was similar. OYSTER BAY wine was promoted by reference to the slogan and by particular reference to oysters. She noted that the market had been educated to recognise that the dominant element of the mark was "oyster".

The fact that there were a number of other "bay" marks relating to wine also meant that the "oyster" element assumed much greater significance, and the expert evidence that consumers would use that as a shortcut to identify it in the purchasing process.

She also considered that OYSTERCATCHER might be wrongly perceived as being part of the OYSTER BAY family of marks.

When considering the position under section 25(1)(b), (which required the Assistant Commissioner to compare the opposed mark with the opponent's trade mark registrations, as distinct from its actual use of the marks), the Assistant Commissioner found that the OYSTER registration was relevant, being the only element of the opponent's mark an essential element in the applicant's mark, together with the fact that the word "oyster" was at the fancy end of the continuum with respect to wine. She held that consumers would at least be caused to wonder that there was a connection in the course of trade between the applicant's goods and the opponent.

Under section 25(1)(c), relating to prejudice to a well-known mark, the Assistant Commissioner also upheld the opposition, citing the similarity between the marks, the fact that the applicant's mark was untested and the opponent which prized the quality of its wine would have no control over the quality, the exclusive association of "oyster" with the opponent's wine, the detrimental effect on the opponent's marketing strategy, blurring of the distinctiveness of the applicant's association with "oyster" and the potential for the OYSTERCATCHER mark to free-ride on the success of the Delegat's' wines.

*\*Baldwins represented the opponent, Delegat's Wine Estate Limited, in this opposition. The decision has not been appealed.*