

New Zealand - "MY" trademark applications allowed in surprising decision

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The assistant commissioner has allowed the registration of several trademarks including the words 'my' and 'insurance' by an insurance firm despite oppositions from competitors (T21/2010, November 8 2010).

AMI Insurance Limited applied to register a range of 'MY' marks, including MY INSURANCE, MY CAR INSURANCE and MY HOUSE INSURANCE. The applications were opposed by four insurance providers: AA Insurance Limited, IAG New Zealand Limited, Tower Insurance Limited and Vero Insurance New Zealand Limited. Two further applications, MY FARM INSURANCE and MY LIFESTYLE INSURANCE, were opposed by AA Insurance, IAG New Zealand and Vero Insurance. Tower Insurance also sought a declaration of invalidity in relation to the registered series marks MY MULTI QUOTE, MY MULTI-QUOTE and MY MULTIQUEOTE.

The parties opposing claimed, among other things, that the applications were not capable of distinguishing AMI's services, had no distinctive character, were descriptive and were customary in trade.

AMI sought to argue that the onus was on the opponents to prove that the applications should not be registered because the Trademarks Act 2002 has a presumption of registrability, unlike its predecessor, the Trademarks Act 1953. The assistant commissioner rejected this submission, noting that Section 13 of the Trademarks Act 2002 provides that the commissioner must be satisfied that there are no absolute or relative grounds preventing registration. This does not amount to a presumption of registrability.

The assistant commissioner further found that:

- the trademarks were capable of distinguishing because the word 'my' (in combination with the descriptive words) was not a generic description for the types of services, namely insurance services; and
- other traders were not likely to wish to use the words in the course of trade to describe their own services.

Her reasoning centred on the finding that consumers would refer to their insurance policies as 'my insurance', but insurance providers would not refer to their own services in such a way. In particular, she found that the trademarks were not descriptive because they would be taken by the average consumer to mean, for example, in the case of MY INSURANCE, "insurance that belongs to me", and that is a reference to something that belongs to the consumer, and is

not descriptive of AMI's services.

None of the evidence was said to reveal use by a trader of the words in question.

Some of the evidence pointed to insurance companies using the words 'my insurance' as part of their frequently asked questions, for example, "what do I do if I think my insurance policy has expired?". The assistant commissioner found that this was not an example of other traders wanting to use the trademark, because the trader is pretending to be in the shoes of the customer and is not making the statement as a trader of the services concerned.

In a rather surprising statement, the assistant commissioner found that an average consumer would not "immediately perceive this meaning in 'MY', plus whatever the type of insurance it is". It is hard to believe that a consumer would not understand the meaning of the words 'my insurance'.

None of the oppositions, nor the invalidity actions were successful on any of the grounds.

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