

Foster's Fails to Prevent Registration of FIJI BEER Trade Marks

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In 2007 Flour Mills of Fiji Limited filed two trade mark applications for logos containing the words FIJI BEER:



Foster's Group Pacific Limited ("Fosters") a well known Australian beer producer opposed on the basis of two trade mark registrations for logos containing the words FIJI BEER:



Fosters is the largest producer of beer in the South Pacific and the producer of the well known beer, sold under the trade mark FIJI BEER.

In addition to its registered trade marks, Fosters sought to show that its trade marks for beer were well known in New Zealand, despite its beer not being sold in New Zealand. Many New Zealanders travel to Fiji for holidays, where the opponent's beer is widely sold and advertised. The assistant commissioner accepted that the opponent's beer was known in New Zealand despite not being available for sale here. She also accepted that the goods are the same and the relevant markets and the trade channels were likely to be the same. The general idea of the marks was also said to be the same, namely beer from Fiji. However, the trade marks themselves were found to be visually, aurally and conceptually different, particularly the stylisation. The inclusion of the letters "fmf" in the applicant's logo marks were said to strongly suggest that the beer is produced by the applicant and make it "immediately clear" that the applicant's marks are not the opponent's.

The opponent requested a disclaimer over the word FIJI. Section 71 of the Trade Marks Act 2002 gives the Commissioner discretion to allow a disclaimer where there are public interest reasons for doing so.

The opponent requested a disclaimer of the word FIJI on the basis of its strong reputation in the word FIJI for beer. Despite the Court of Appeal recently ordering a disclaimer over the words FAMILY SEARCH as part of a device, which as a whole was found to be distinctive (*Intellectual Reserve Inc. v Robert Sintes* [2009] NZCA 305), the assistant commissioner declined to order one.

A disclaimer was said to create misapprehension within the market because the market might think that the applicant's monopoly in its marks does not include the word/device "FIJI", especially if that word/device has been singled out for a disclaimer and the word/device "BEER" has not. It was also thought that the market may consider that the word/device "FIJI" (if it is ever used by itself by the applicant) may never acquire a distinctive character if there were a disclaimer.

It is difficult to reconcile the findings of the Court of Appeal with the findings of the assistant commissioner. In *Intellectual Reserve Inc. v Robert Sintes* both the applicant's and the opponent's marks were stylised, both included the words FAMILY SEARCH and both were considered distinctive, despite the presence of descriptive words.

While there is provision for disclaimers in the Trade Marks Act 2002, the Intellectual Property Office of New Zealand dropped the practice of requiring disclaimers some years ago. It is possible that the assistant commissioner was reluctant to revive the practice of disclaimers, despite the Court of Appeal's recent decision in *Intellectual Reserve Inc. v Robert Sintes* allowing a disclaimer.

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