

Typosquatting, country kitchens & smell marks

Cybersquatting - Typosquatting

Air France was recently a victim of typosquatting, which is a cross between cybersquatting and trade mark infringement.

Typosquatters generally divert consumers to Internet addresses with deliberate misspellings of popular domain names. In this case, Alvaro Collazo registered <www.arifrance.com> and used this domain name to divert traffic to other websites, including travel service websites.

Air France, whose domain name is <www.airfrance.com>, argued that by rearranging the second and third letters of its domain name, Collazo was intentionally diverting internet traffic away from <www.airfrance.com>. Air France also argued that as its trade mark had such a strong reputation, this created a presumption that Collazo had registered the domain name in bad faith and for commercial benefit.

The World Intellectual Property Organization dispute resolution panel agreed. The registration of a domain name that only differs from the well known mark by a typographical misspelling in itself strongly indicates that the domain name was registered in bad faith. Furthermore, Collazo is unknown at, and has no links to, Air France. The domain name was ordered to be transferred to Air France.

Typosquatting can be regarded as the next generation of cybersquatting, and is already posing economic threats to many big businesses. Trade mark owners should run regular audits on their marks and their domain names by searching the Internet for misspelt variants of their marks or domain names.

'Waltzing Matilda' and Country Kitchen - who used it first?

An Australian decision has held that it is important for a trade mark applicant to show a settled intention to offer the goods or services under the trade mark at any claimed priority date. Whether there is consistent use of the trade mark will go towards establishing that intent.

In *Lomas v Winton Shire Council* [2002] FCAFC 413, Brenda Lomas applied for the trade mark WALTZING MATILDA for various foodstuffs and restaurant services. The Winton Shire Council (WSC) and the Waltzing Matilda Centre

Limited (WMC) opposed registration of this mark. WSC argued that it had prior use of the trade mark in an advertisement for the Waltzing Matilda Centre in a Queensland accommodation and touring guidebook 19 days before Lomas.

WSC argued that by this prior use it was therefore the rightful owner of the trade mark. Use can be established where the mark has been used in an advertisement and there is an existing intention to offer or supply goods bearing the mark in trade.

The case went to the Full Court of the Federal Court who found that WSC did not have a settled intention to offer the relevant services using the WALTZING MATILDA trade mark. This was because WSC was not consistent in its use of "Waltzing Matilda Country Kitchen" in its advertising. WSC had used 'Waltzing Matilda Country Kitchen' in its entirety only once. On other occasions 'Country Kitchen' was used by itself or with the word 'Coolibah'. This inferred that WSC took some time in forming a settled intention as to the name of its proposed country kitchen facility.

The Full Court therefore found WSC did not have an intention existing before Lomas' priority date to offer or supply country kitchen services using the WALTZING MATILDA trade mark. WSC's opposition to Lomas' trade mark application was dismissed.

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To tell us what you think of this newsletter, or to have colleagues added or yourself deleted from the mailing list, contact moreinfo@minterellison.co.nz

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*This newsletter has been prepared by
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particular circumstances.*

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Trade marks that smell

Under the New Zealand Trade Marks Act 2002, smells may be registered as trade marks. Perhaps the most famous of smell marks is the smell of “freshly cut grass” registered for tennis balls. However, a recent European judgement has put the possibility of registering smells as trade marks in doubt, and its ramifications may be felt in New Zealand.

In *Dr. Ralf Sieckmann (C-273/00)* / 12 December 2002, the European Court of Justice (ECJ) held that because smell marks cannot be represented visually or graphically, they cannot be registered as trade marks. The ECJ held that graphic representation must enable the sign to be represented visually particularly by means of images, lines or characters, so that it can be precisely identified.

A sample of the smell was filed together with a written description and its chemical formula. The ECJ rejected these on the grounds that they were not “graphic representations” or durable and stable. The chemical description was also not acceptable as it was not recognisable to the average person and was only a description of the substance, not the smell itself. Graphical representations must be complete, clear and precise so that the object of the right of exclusivity is immediately clear. Secondly, they must be intelligible to interested persons inspecting the register.

The Advocate General concluded that as smells could not be represented graphically in a way that would be precise and clear for everyone, they could not be trade marks:

“Can an odour be ‘drawn’? Can an olfactory sign be graphically represented in a way which is precise and clear for everyone? In my view, the answer is no.”

While the ECJ did not rule out smell trade marks entirely, it did not state what would be acceptable as a graphical representation of a smell. However, as samples, written descriptions and chemical formulae of smells are not acceptable, the chances of succeeding in a smell application seem slim, even though the Trade Marks Act 2002 provides for the registration of such marks.