

Office of Hon Simon Power

Minister of Justice
Minister for State Owned Enterprises
Minister of Commerce

Minister Responsible for the
Law Commission
Associate Minister of Finance
Deputy Leader of the House

CMSP08-09/207

Tony Culmer
tonyculmer@xtra.co.nz

27 APR 2009

Dear Tony Culmer

I refer to your e-mail to Hon Gerry Brownlee dated 30 March 2009 regarding your concerns about the terms "Saison" and "Radler" being registered as trade marks by the Intellectual Property Office of New Zealand (IPONZ). Your letter has been referred to me for a response as the matters raised in it fall within my portfolio responsibilities as Minister of Commerce.

I have asked officials at IPONZ to provide me with some background information in relation to the registration of these trade marks.

In relation to the Saison trade mark (registration no. 644965), I am advised that the trade mark was applied for by DB Breweries Limited on 24 April 2002 and an examination report issued requesting a translation of the word. The application was subsequently accepted on 13 June 2002, published for opposition purposes on 28 June 2002 and registered on 24 October 2002.

In relation to the Radler trade mark (registration no. 700726), I am advised that the trade mark was applied for by DB Breweries Limited on 2 September 2003. Upon receipt of the application, it was examined by IPONZ pursuant to the Trade Marks Act 2002 (the Act) and a compliance report was issued on 5 September 2003 raising a concern in relation to the possible descriptiveness and non-distinctiveness of the trade mark under section 18 of the Act. The Act provides that all applicants may respond to objections raised in relation to their application and a response was received from the applicant's agent disagreeing with the IPONZ position and providing reasons as to why the application was eligible for registration. That response satisfied IPONZ that its initial concerns in relation to the application should be withdrawn. The trade mark was subsequently accepted on 13 February 2004, published for opposition purposes on 27 February 2004, and registered on 8 June 2004.

I am advised that the Act requires IPONZ to consider the eligibility of a mark for registration at the date on which it was applied for. In the cases of the Saison and Radler trade marks, IPONZ assessed their eligibility as at 24 April 2002 and 2 September 2003 respectively. I am further advised that as part of

the examination process, research would have been conducted into the meaning of the terms Saison and Radler in New Zealand at the time of filing, including whether at that time New Zealand consumers would have understood the terms as describing a style of beer and whether other traders would have a legitimate need to use that term in connection with their own beer products.

The trade mark system established under the Act is designed to accommodate conflicting views and to provide workable processes for the resolution of the opposing interests and views of different parties. In this respect, the trade mark process generally has three stages in which a trade mark can be objected to: examination; opposition; and invalidity. The examination process in relation to the trade marks Saison and Radler has been outlined above.

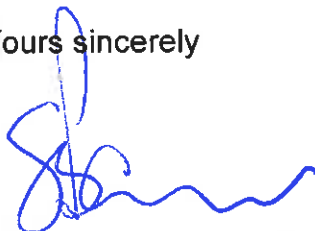
Opposition is a way of challenging a trade mark once it has passed through the examination stage and has been accepted for registration. When a trade mark is accepted for registration by IPONZ it is published for opposition purposes. This mechanism is to allow anyone who thought the trade mark should not be registered to lodge an objection opposing registration of the trade mark. No oppositions were lodged against the trade marks Saison or Radler and both proceeded to registration.

The invalidity process is a way of challenging a trade mark once it has been registered. It can be thought of as a "late opposition". The invalidity process is governed by sections 73 and 74 of the Act and regulations 106 to 112 of the Trade Marks Regulations 2003 (the Regulations). An invalidity proceeding has the extra hurdle of a party having to show why they are aggrieved by the registration. If an invalidity matter proceeds to a hearing, a decision will be issued by an Assistant Commissioner of Trade Marks. The Assistant Commissioner's decision may be appealed to the High Court.

It is not appropriate, nor possible under the provisions of the Act, for me to give directions to IPONZ officials on the validity of the registrations of the trade marks in question as the Act sets out the process under which such matters should be determined.

Whilst IPONZ is not able to provide you with legal advice, should you wish to discuss the trade mark process and the procedural options available to you, please contact Simon Gallagher, Manager Trade Marks and Hearings Office, IPONZ – phone: (04) 978 7594 or e-mail: simon.gallagher@iponz.govt.nz.

Yours sincerely



Hon Simon Power
Minister of Commerce