

Does “publicly available” mean available to the public generally?

Section 7(1) of the *Patents Act (1990)* requires that novelty of a patent must be assessed inter alia by reference to prior art information which is “made publicly available” in a single document whether in or out of the patent area.

In *Merck & Co Inc v Arrow Pharmaceuticals Limited* [2006] FCAFC 91 (15 June 2006), Merck appealed a decision of the Federal Court (single judge) that invalidated claims in Australian Patent No. 741818 (“Merck’s Patent”) which were directed to a new dosage regime on two grounds, one of those being that the claims lacked novelty in light of three issues of a publication called Lunar News.

The evidence showed that Lunar News was published three times a year and some 18,000 copies of relevant issues of Lunar News were sent to recipients around the world with about 150 select recipients in Australia and New Zealand. The publication was not available in libraries and nor could it be purchased by members of the public or even supplied on request to them.

On appeal, the Full Federal Court held that the Lunar News articles were “publicly available” as it was *“well established that a description in an obscure publication would suffice to destroy novelty, provided it was a publication, that is to say that the document, whether or not it was read generally by the public, had been available to the public (Sunbeam Corporation v Morphy-Richards (Aust) Pty Ltd (1961) 180 CLR 98). It was sufficient that the document or thing alleged to be the anticipation came into the hands of a person in circumstances which left him or her free at law and equity to do whatever they liked with it (Fomento Industrial SA & Biro Swan Ltd v Mentmore Manufacturing Co Ltd (1956) RPC 87).”*

In conclusion, the Full Court stated that an *“Australian Patent may now be defeated by reason of some publication which in reality nobody in Australia had the remotest possibility of being aware of before the priority date.”*

Merck have filed an application seeking special leave to the High Court.



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A Wacko Tale

Dogged Dispute over Pet Food Trade Marks

Australian pet owners will recall television advertisements about colourful plasticine dog characters lured into uncharacteristically good behaviour by pet food dangled in front of them by loving (or desperate) owners and accompanied by the catchy voice-over DOGS GO WACKO FOR SCHMACKOS.

Effem Foods Pty Ltd, the Australian manufacturer of the successful dog food, owns registered trade marks for both SCHMACKOS and DOGS GO WACKO FOR SCHMACKOS covering its pet food products.

As with many a situation involving a dog (some may say), a dispute has ensued between Effem Foods and Wandella Pet Foods Pty Ltd over Wandella Pet Foods’ attempt to register the trade mark WHACKOS for animal food stuffs.

Effem Foods objected to the WHACKOS mark but the Registrar of Trade Marks did not agree and ordered that the WHACKOS mark be registered. Effem Foods then appealed to the Federal Court where Justice Moore considered the dispute.

One of Effem Foods’ arguments was that it used the words GO WACKO as a trade mark in its advertisement. Moore J was disinclined to see trade mark use of GO WACKO in the voice balloon: he pointed out that the words could be “descriptive of the state the dog owner might attain in teaching the dog in accordance with the instructions”.

Effem Foods then tried to argue that the words GO WACKO were used as a trade mark on its packaging. Justice Moore was not able to discern any prominence (aurally or visually) in the words GO WACKO to suggest separate use of them as a trade mark.

Nor was Effem Foods able to identify any other relevant advertising which, in the view of the Court, showed use of GO WACKO as a trade mark.

Effem Foods next argued that WHACKOS was a trade mark deceptively similar to its SCHMACKOS trade mark. Moore J agreed that there were “broad similarities” and that both trade marks appeared to have been made up with “an air of frivolity” but these factors were not sufficient to make them deceptively similar.

The final argument raised by Effem Foods was that WHACKOS was deceptively similar to its registered trade mark DOGS GO WACKO FOR SCHMACKOS. Here Effem Foods succeeded. Moore J agreed that GO WACKO gave colour to the whole expression DOGS GO WACKO FOR SCHMACKOS and illuminated in “a light hearted and amusing way” the dog’s attitude



which would be recalled by consumers when they saw WHACKOS for dog food. He therefore refused registration of WHACKOS.

Having failed all fences except the last one, it might be considered somewhat surprising that Effem Foods succeeded in arguing that GO WACKO are words sufficiently prominent to enable the trade mark DOGS GO WACKO FOR SCHMACKOS to be regarded as deceptively similar to WHACKOS. Especially as the court had not been persuaded that the words GO WACKO were sufficiently prominent to distinguish Effem Foods’ pet food. Yet in determining whether DOGS GO WACKO FOR SCHMACKOS was deceptively similar to WHACKOS Moore J only had to consider whether an imperfect recollection of both trade marks would be likely to result in traders confusing the source of dog food.

The last word may not yet have been uttered in this war of dog foods. It appears that Wandella Pet Foods has sought leave to appeal Justice Moore’s decision.



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