

# Fashionable

## Myths “busted”

Some people mistakenly believe that if they have a business name (or company or domain name) that this in some way gives some protection.

This is wrong.

Registering a business name is purely an administrative requirement so that the details of a business can be easily found. Similarly, registering a company name does not give any ownership rights. With domain names, you never really own those - you just get a licence to use that name for a certain time period.

The upshot is that really the best, and only real, way to really protect your brands is through trade mark registration.

## Registration - What are the benefits?

A registered trade mark is an asset which can be renewed every ten years. It can be assigned or licensed to others in return for payment to the owner of the registration

Further:

- it allows the owner of the registration to prevent unauthorised use of the trade mark in relation to the same, or similar or closely related, goods or services
- it places the public on notice of the owner's rights and also provides a relatively quick and cheap method of enforcing those rights
- it is Australia-wide (unlike business name registration);
- the application or registration of a trade mark may deter other people from obtaining registration for a subsequently filed trade mark which is identical or similar; and
- Registration entitles you to use the “®” symbol to put the public on notice of your trade mark rights.

## What trade marks are easiest to register?

Given that registration gives you a monopoly in the brand, certain requirements need to be met, perhaps most importantly, that the trade mark is distinctive and that no one else already has applied for or registered (or is using) a confusingly similar mark.

Examples of distinctive names include: Mambo, Billabong, Prada, Razza Matazz and Voodoo. They do not describe clothing as such. You can compare these to the names white leather, discount dresses and slinky swimsuits which are highly descriptive.

The rule is, you should not be able to stop other traders from using words that they have a genuine need to use to describe their own goods and services.

Some examples of descriptive marks include:

- Common surnames i.e. Smith's Clothing
- Geographical terms i.e. Tassie Jeans;
- Generic names i.e. Sports Kids;
- Words that directly describe the quality of the clothes i.e. Cashmere Apparel; and
- Words that are laudatory (expressing praise) which can be harder, i.e. “beautiful garments”.

*The old saying “imitation is a form of flattery” is well understood in the fashion industry, especially in the current competitive environment. While different styles may give a hint of the source of a garment, their brand label is the ultimate differentiator. Fashion and branding lawyer, **Sharon Givoni**, sets out some tips and traps of branding laws.*

## Searches

When you have a new trade mark it is important to have searches conducted before using it. If someone else has been using it in connection with similar goods or services (i.e. retailing of clothing), they have prior rights at law to you and may be able to prevent you from using the name. These are best done by a lawyer, as searching properly requires special skills, but a good starting point is a Google search.

For example, if you wanted to use the name “LillyPilli” for dresses and someone else has the mark “Lilli P” for clothing, this could be problematic, even if your real name was “Lilly”.

## Case Studies

### *What if you want to go international?*

If you are thinking of exporting check that the name is available to use overseas. A few years ago, fashion jeans label, Tsubi, found itself in a dispute with the US shoe manufacturer Tsubo when they expanded their Tsubi brand into the US. While the name Tsubi can still be lawfully used in Australia, the name is now recognised and used internationally as Ksubi.

According to media reports the brand changeover was a costly exercise and this demonstrates the importance of checking first.

### *Lost in translation*

It is also worth checking upfront that a trade mark in English does not mean something obscene or offensive in another language

An embarrassing scenario came about when British car company Vauxhall released a car called “Nova” in Spain, which, when translated to Spanish means “does not work”.

Microsoft's VISTA-branded operating system apparently translates to “frumpy old women” in Latvian

The lesson?

Businesses should always engage local translators, before they decide to distribute overseas.

### *Non-traditional trade marks*

Many people may not be aware that today you can register shapes, sounds, and colours as a trade marks. So, if you have a unique shape of packaging that no one else uses for t-shirts, for example, you might wish to consider registering it as a trade mark.

The theory is, is that when people see that shape they will associate it with your particular clothing label.

# trade mark tips.

## **Care for a chocolate?**

An iconic example is the prism-shaped packaging of “Toblerone” chocolate, which is registered as a shape mark

The triangle shape of their chocolate (reminiscent of the Swiss Alps) is also registered and is instantly recognisable. (see picture below).



*\*Photography and image supplied care of Simon Watts*

## **Sound**

McCain Foods (Aust) Pty Ltd has a registered trade mark for the sound of “Ah McCain (Ping) You've done it Again”.

## **Colour**

Shiny, red-lacquered shoe soles are the signature style of French shoe designer, Christian Louboutin's shoes, especially on the bottom of stilettos and he has been quoted as saying that his aim is to break the rules and make women feel empowered.

While the red sole is meant to distinguish shoes as being his designs, and he has applied for a trade mark for the red shoe sole in the US, Australia and other countries (see picture below), issues have recently arisen as to whether other shoe labels (such as Yves Saint Laurent) should be refrained from using the colour red on their shoes' soles.



*Image of the trade mark application as filed by Christian Louboutin in Australia.*

## **Lessons to be learnt**

Valuable lessons come out of this article:

·First, always check whether someone is not already using a brand name before you begin using and investing in it, especially in the fashion industry! Professional trade mark searches and even Google searches should form part of this check

·Second, remember that business names, company names and domain names do not give you any ownership rights in the name.

·Third, if you have a distinctive name, for your fashion label or store, you should strongly consider registering it as a trade mark.

This is a complex area of the law and it is recommended that you seek the advice of a lawyer or trade mark attorney

**Disclaimer** - This article is of a general nature only and does not constitute legal advice.



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