



The case of the branded banana – A red hot tip for marketing your product

By Sharon Givoni

Frank Sciacca had a puzzle to solve.

The ecologically-grown bananas he and his wife, Dianne, had grown on their farm had a great deal going for them. They had been farmed under an eco-protocol, in chemical-free soil, with minimum use of fertilizer (to allow a more natural-growing cycle) the result being an eco-friendly banana that generally has more flavour than traditionally grown bananas.

Frank and Dianne knew of all this. The challenge they faced was how to get the message across to consumers, particularly, as grocery shoppers often tend to shop in a hurry, without giving too much consideration to the tiny labels on fruit. What could they do to show consumers, at a glance, that these bananas are different?

In what may have been one of his more creative moments, Frank dipped some bananas in green or blue paint so that it just covered their tips, placed them in a bowl and stood back to appraise his work. Not bad. But it needed something more....

A few days later, Frank was drinking a beer with a friend who, building on the idea of red paint, suggested he try and dip his bananas in coloured food grade wax of the type traditionally used for cheeses.

An idea was born.

The red wax tip was a success. So much so that people who do their own grocery shopping are likely to be familiar with the wax-tipped bananas that, literally, scream for attention on grocery shelves.

But Frank and Dianne didn't stop there. The red wax tip is a great idea and great ideas need to be protected. Recognising this, they sought advice from a trade mark attorney, who suggested that they register the red wax tip as a trade mark. This may come as a surprise to some people as trade marks are traditionally associated with brand names and logos, something two-dimensional that can be reduced to paper. While once this may have been the case, the changes to Australia's trade mark laws that took effect in 1996 allow companies to



protect shapes, sounds, colours, scents and aspects of packaging as trade marks. In reality, anything distinctive was always capable of being registered as a trade mark, but the Trade Marks Office was very reluctant to let anything other than words or logos, pictures and drawings become registered. So the law was updated to clarify the situation.

Back to the story. On 12th April 2000, Frank and Dianne applied, in the name of their company, Fada Pty Ltd, to register the red wax tip as a trade mark for bananas.

As trade mark registration gives the owner the exclusive right to use the mark for the goods or services for which it is registered, the Trade Marks Office has a policy of examining all trade mark applications carefully to avoid giving monopoly rights over trade marks that other

people might have a legitimate need to use for their own goods or services.

So Frank and Dianne had to prove that their trade mark, the red wax tip applied to a banana, in itself, at the time of their application, distinguished their bananas from those of other farmers. This they did by submitting substantial evidence of use – for example, sales figures, proof of marketing and promotional activities, statutory declarations from government departments as well as people in the fruit and vegetable industry who could verify that, to them, the red wax tip identified Fada Pty Ltd's eco-bananas. The fact that they had, for some time, been educating consumers to "Look for the distinctive red tip" to identify their bananas, being the statement they had been using on the website further boosted their case (see <http://www.eco-banana.com>). They have also



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applied to register green and blue wax tips for bananas as well.

However, not everyone has been so lucky. For example, a company by the name of Flower Carpet Pty Ltd could not convince the Trade Marks Office to register the colour pink applied to pots containing rose plants, despite six years of quite extensive use and having promoted its plants as "The rose in the pink pot".

The Trade Mark Examiner refused to register the mark and Flower Carpet requested a Trade Marks Office Hearing. Flower Carpet provided evidence that pots in which roses are presented for sale are mostly coloured black, green or terracotta. Black and green, they argued, are chosen for their functionality, being the colours most resistant to UV rays, and therefore play a role in prolonging the life of the pot itself. As for terracotta, they argued that this colour is

generally reminiscent of traditional terracotta flower pots. Their own colour, pink, had been deliberately chosen to match the colour of the blooms of the original Flower Carpet roses and enhance the attractiveness of the plants themselves.

The Hearing Officer took all this on board, but ultimately, refused the registration. This decision was based on a few reasons, including:

- ◆ The fact that plants are not infrequently sold in brightly coloured, decorative pots, including pink (for example, for "pink cone" flowers);
- ◆ The colours enhance the appeal of the product and are sometimes designed to match the plants they contain;

In light of the above, other traders have a competitive need to present their plants,

including roses, in coloured pots and therefore the pink plant pot was not inherently adapted to distinguish Flower Carpet's plants.

The evidence also showed that the applicant heavily promoted its plants under the brand FLOWER CARPET, which was stamped onto the pink pots, and therefore she was unable to determine the extent to which consumers would identify its plants by the colour pink alone, without anything else.

The message

The above case studies demonstrate that your marketing strategies for your product can influence brand protection.

Trade mark protection is not just for big companies. If you have a good idea for a brand, whether it's a name, image, shape, colour or aspect of packaging, it is important to explore the best method by which you can protect it at an early stage. Leaving it too long can lead to copycat brands on the market, which can be harder to stop if all you have is an unregistered trade mark.

About the Author



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