

A dairy brand by any other name

Many dairy brands in Australia incorporate people's names or place names – think Pauls and Peters, Bega and Bulla. But businessman Paul from Bega better be careful when choosing a name for his new company or product – if the name is trademarked, its registrant more often than not has exclusive rights to its use.

Say you are a dairy farmer named Peter, and you live in Bulla. Of course, your products are Peter's milk and Bulla cream, but calling them that would likely incur the wrath of the Société Des Produits Nestlé SA and Regal Cream Products, who own the Australian registered trademarks for the names. The best way to avoid legal trouble is to know the rules.

First name trademarks

The general rule of trademarks is that they must be distinctive as opposed to descriptive. That's because it would not be fair for any single trader to have a monopoly over the use of a descriptive word.

So, words 'pure milk' are unlikely to be registered as a trademark, because that would prevent other dairy manufacturers

from describing their milk as 'pure.' However, the addition of a logo or a distinctive word may make 'pure milk' unique enough to get it trademarked.

The situation is similar when it comes to common first names, such as 'John' or 'Mary.' On their own, they



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would likely be treated by the Trademark Office as not distinctive enough. Other dairy producers called John and Mary, the Trademark Office would argue, should be able to call their dairy products John's Milk or Mary's Ice-Cream.

There is a solution, however. If you use a first name for long enough and implement a sound marketing strategy that reinforces the association between the name and your product, your non-distinctive trademark could, over time, become distinctive enough to warrant registration.

Surname trademarks

When a trademark application is filed, the Trademark Office automatically considers the number of times the surname appears on the Australian electoral roll. If there are 750 or more people with the same last name, the Examiner would usually object to the application.

While not the case in Australia, in some countries you need to obtain the written

consent of the individual to register his or her real name as a trademark. This rule applies in the United States and New Zealand. Bear this in mind if you plan to export products overseas.

Geographical places

With place names, the rule of thumb is, if the product is physically produced in the geographical area after which it wants to be named, obtaining a trademark registration would be difficult. So, 'Queensland bananas' would not stand a chance of being registered as a trademark, but 'North Pole Bananas' could be registered easily because bananas don't grow in the North Pole.

But all is not lost. If you can present enough evidence of use, your trademark would likely be registered. Dairy examples include Yarra Valley Dairy, Bega and Red Hill Cheese. The brand owners most likely had to prove to the Trademark Office that they had developed a reputation in these trademarks, and that consumers have come to associate the name with their brand or product.



Disclaimer: This article provides a general overview of the law only and should not be relied on as legal advice.

If you are using a place name as a trademark, be sure to collect and keep extensive records of its use, from invoices to advertising materials. That way, if someone challenges the trademark, you would be able to show that you have used the brand name so extensively that consumers know it's yours.

Misleading and 'passing off'

Whether they are a name, a place or anything else, brand names cannot be misleading.

If your name is Jamie Oliver, and you want to use it to brand your new restaurant,

British chef and television personality **Jamie Oliver** could potentially take legal steps to prevent this. That's because you would arguably be trading



on and benefiting from his goodwill and reputation as an internationally renowned celebrity chef.

Because the famous Jamie Oliver sponsors and endorses products, he could also prevent you from using the name to brand your products.

Similarly, if a Ben Jones and a Jerry Smith created an ice-cream label and named it 'Ben & Jerry's Ice-Cream,' they could get in serious legal trouble with Unilever, the owner of the world-famous Ben & Jerry's brand, a registered trademark in Australia. Legal action would be warranted even if your ice-cream's packaging looks nothing like that of the famous Ben & Jerry's.

Country or origin labelling

One final point to be mindful of when using a geographical place names is to avoid misrepresenting the country or origin of the product.

For example, if you brand your cheese 'Tasmania's Favourite Cheese,' when in fact it's made in Victoria, you could be guilty of misrepresenting the origin of the product.

Check before you use

Brand names are an important marketing tool, so make sure you register yours as a trademark before you start using it. That's because trademarks are granted on a 'first come, first served' basis.

Trademarks are granted in categories of goods and services and can coexist. For example, 'Pink Lady' for apples and 'Pink Lady' for chocolates are both legitimately registered trademarks with different owners. The Greek goddess Nike has lent her name to sporting goods, but also to industrial jacks, and 'Dove' soap and 'Dove' chocolates happily co-exist as trademarks.

About the author

Sharon Givoni is an intellectual property lawyer and has advised many companies in the area of fresh produce, including in relation to trademarks, packaging and labelling. She has presented to industry groups and has been interviewed on TV on branding issues. Find out more on www.sharongivoni.com.au

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