



Would the

REAL ZARA

PLEASE STAND UP

Many textile and fashion designers use, or incorporate their own name into their brands. More often than not, the more unique the name is, the safer you are from “copy cats”. However, legal battles can arise if two designers use similar names. Intellectual property lawyer, Sharon Givoni delves deeper.

Clients are often surprised to find out that they can be stopped from using their own name for a fashion or textile label if someone else has registered it as a trade mark or has built up a strong reputation in it.

In fact, this issue recently came about when I was interviewed on the current affairs program Today Tonight about two mothers, Samantha Haydon and Shelley Tilbrooke, who created a Melbourne-based online shopping business called Zara+Lily. Zara Tilbrooke is Shelley's four year old daughter and Lily is Samantha's daughter, hence their choice of name.

When they received a letter of demand from global fashion Goliath, Zara, asking

them to stop using the name Zara in their brand name they were quite shocked.

According to media reports, Zara demanded that they stop using the words “Zara+Lily” “or other mark which is substantially identical with or deceptively similar to” the word Zara.

The international clothing giant also asked the mums to “immediately cancel” their business name registration and “adopt a different trading name not incorporating the word Zara” claiming trade mark infringement.

The ‘mumtrepreneurs’ decided to rebrand to avoid the stress of fighting a battle.

Their new business name is “Peach+Pear Kids” which operates through the website www.peachpearkids.com.au.

The rebrand has been an expensive process.

You might be thinking, can the owners of the Zara trade mark really stop these women from using one of their own children's name as part of their brand? The issue would not have arisen had they registered their trade mark Zara+Lily as trade mark registration gives you exclusive rights to use a name.

USING YOUR OWN NAME AS YOUR BRAND – WHAT ARE THE RULES?

Generally speaking, it is possible for someone to stop you from using your own name if they have developed a reputation in that name or if they have registered it as a trade mark.

In other words, you cannot start using a similar name in the clothing and textile business if to someone who has already worked hard to establish a reputation in the name.



USING CELEBRITIES' NAMES

The selling power of a celebrity's name is indisputable. Many celebrities have their names already registered as trade marks in various categories (Kylie Minogue, Ian Thorpe, Lleyton Hewitt, Andre Rieu and Tiger Woods to name a few) but even if a celebrity has not registered their name as a trade mark, you may still be stopped from using it as a brand in the area of fashion.

HOW FAMOUS DO YOU NEED TO BE?

Australian law provides "additional protection for celebrities as it is recognised that they should be able to utilise their reputation to endorse and sponsor other products in return for a payment of a licence fee. To deprive them of this would not be fair. After all, they earn their living partly through licensing.

Furthermore, the law does not allow you to pass off else's reputation as your own.

For example, if you were to call a fashion label "K. Minogue" people could well think that Kylie had endorsed or sponsored the label. If not the case, this would be misleading.

In fact, on the topic of Kylie, Kylie's lawyers have reportedly brought a High Court action in the UK against the makers of The Hotpants Workout video which using her trade mark gold hotpants on the sleeve and boasted that that the moves in the video had helped Kylie get toned. The tip is – if you are going to use the name of a celebrity or part of what they are famous for, always seek permission first.

Even with dead celebrities, caution is advisable. Their estates often have residual rights to their name, image and likeness, and could take legal action.



CATEGORIES OF GOODS AND SERVICES

The "exclusive rights" attached to a registered trade mark are only "exclusive" with respect to the specific "class" (or category) of goods and services. So, you may be able to use the brand name "Davenport" for a cooking course for example even if the surname is registered for clothing.

This issue arose in the US Tiffany & Co and Tiffany Koury case.

JEWELLERY GIANTS TAKES ON TIFFANY KOURY

In 2009, the luxury jewellery chain Tiffany & Co was unsuccessful when trying to prevent New York based fashion designer, Tiffany Koury, from registering her own name as a trade mark in Australia for clothing.

This was because jewellery and clothing were considered in that case to be different enough to avoid confusion. The two trade marks create different impressions as Tiffany & Co arguably creates the impression of a company or commercial entity, whereas Tiffany Koury is clearly a female name.

In the same year, in what could be described as a reversal of the usual David-and-Goliath style clash, Gold Coast hand-bag company, Mischa Accessories, challenged the US actress, Mischa Barton, from registering her own name for clothing label in Australia.

CASE STUDY DAVENPORT UNDERWEAR

Take the surname Davenport. You would not be able to use the name "Davenport" for a new underwear brand (even if it is your own surname) because Bendon Limited has registered the word "Davenport" as a trade mark in Australia for underwear and sleepwear. By doing so, Bendon Limited have secured the right to use this surname as a trade mark. Davenport is part of the Bendon Group's portfolio of brands and represents the idea of stylish and sporty underwear for people with bright personalities. Of this is subject to someone else having what's known as "honest / concurrent" use, such as TJPD Nominees Pty Limited which managed to register a logo incorporating the words "Liz Davenport" named after Australian fashion designer for women's clothing (lizdavenport.com.au).

CASE STUDY
MARLON BRANDO
PROVES POPULAR

Back in February 2012, American actor Marlon Brando's estate successfully recovered over \$350 thousand dollars from a company called Ashley Furniture Industries Inc. for using the names "Brando-Cocoa" and "Brando-Café" in relation to their furniture collection. According to reports, Brando Enterprises' legal team also challenged Madonna's desire to use images of the actor in her live shows. Speaking of Madonna, late last year, the singer herself made an unsuccessful legal claim in the US to try and stop someone from using the brand name Material Girl against clothing company LA Triumph, which sold a Material Girl fashion line for a number of years.

Such is the power of branding and character merchandising.

If you wish to use the name of a well known person, it is best to get their written consent (or that of their estate) before you use it.

WHAT DOES THIS MEAN FOR YOU?

When choosing a brand for your business which is also a person's name, it is critical to check that no one else has prior rights or a pending or registered trade mark to that brand name, even if that brand name is your own name, in the country (or countries) that you are using it in.

If you are using your own name or part of it for your own brand, think of registering it as a trade mark.

Simply registering it as a business name or domain name won't be enough to protect you legally. Do not fall into the common trap of thinking that it will.

Names - even your own name - can become your most valuable asset. Don't take it for granted that it will always be yours and take steps to protect it.

This is particularly important in the fashion and textile industry where designers' names are often inextricably linked with a brand and guarantee a certain level of style and quality.



“ Sharon Givoni is an intellectual property lawyer who has been running her own legal practice for over 12 years with many clients in the textile and fashion industry. www.sharongivoni.com.au. ”

TAKE AWAY TIPS

- Before you use a brand name (even if it is your own name) check to see that no one else has registered it as a trade mark in Australia in respect of the same types of goods or services;
- If you want to use a celebrity's name or image, always ask for their permission before you use it;
- The more common your name, the more important it is that you seek to register it - however it can be harder to get registration for;
- If you have a common surname, you might need to collect evidence of use to convince the Trade Marks Office that people associate it with you;

- Try and display the symbol ™ if the trade mark is not registered;
- In contrast, it is advisable to use the symbol ® if your name is registered;
- If you shorten your name over time e.g. "Elle" (as opposed to "Elle MacPherson") remember to protect that as a trade mark as well;
- Use it or lose it - if you register your name as a trade mark but you don't use it, someone else can apply to remove it on the basis of "non-use";



- Don't forget logos and initials, if you are using these as a brand name in their own right, they are important too; and
- Finally, if you are thinking of expanding overseas explore trade mark registration in those countries - trade mark registration is granted on a country-by-country basis.