

Fair trading in fashionable names: What to do if your name is famous but you are not (yet)

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IN PRACTICE

The brand is perhaps the most important asset in a fashion business, because the brand remains stable in an industry where products are constantly changing. It is common practice in fashion to brand the product with its designer's name. Designers who have been named after luxury brands or celebrities and who then want to trade mark their names should, in most cases, be able to do so — as long as there is no connotation that gives rise to deception or confusion. Using both their first and last names as their trade mark should ensure that there is not. If they encounter difficulty, they may still prevail if they can show they were trading in the name before their opponent became famous.

Does your fashion designer client have a “fashionable” name? Were they named after a luxury brand, or perhaps after an international celebrity? Do they trade under their own name? If so, you may find that if they decide they would like to trade mark their name rather than merely continue to trade under it (in order to better protect this important asset of their business), they are likely to feel the full force of their namesake's opposition.

Many women enjoy names such as Tiffany and Chanel, and there are probably plenty of other examples of similar names, such as Mercedes and Cartier, or Bentley for a boy. Some of these people are bound to end up with their own business selling fashion and other consumer goods. While some of these names (such as Tiffany) have medieval origins, their revival in popularity in recent times is due to the influence of brand power. Many babies born in the last 40 years were not named after their great aunt or uncle, but after an iconic luxury brand or an international celebrity with an unusual name.

Tiffany Koury is a New York based fashion designer who trades under her own name, a common practice in the fashion industry. In 2006 she lodged an international trade mark application, which included Australia, to trade mark TIFFANY KOURY. This triggered opposition proceedings brought by the multinational luxury jeweller Tiffany & Co, who argued her trade mark would mislead and confuse consumers.

Tiffany Koury was not represented, did not appear, and did not put on any written submissions or evidence in reply in the opposition proceedings. Tiffany & Co's

opposition to her trade mark nevertheless did not succeed. As they were selling different products, and “Tiffany” was followed by the word “Koury”, the hearing officer, in a decision dated 31 August 2009,¹ held that there was no connotation or secondary meaning in the trade mark TIFFANY KOURY that was likely to deceive or cause confusion.

Sometimes the similarity of the two “competing” names can be sheer coincidence. A case in point is that of Katie Perry (born Katie Jane Perry, but aka Katie Howell), the Sydney designer of luxury loungewear who applied in September last year to register her name in Australia² as a trade mark. It was challenged by representatives of the American pop singer Katy Perry (born Katheryn Elizabeth Hudson) who they said was preparing to apply to register KATY PERRY as a trade mark here. Katie Perry (Howell) was prepared for a fight when the other side suddenly withdrew their opposition.

Meanwhile, Katy Perry had lodged her trade mark application for KATY PERRY (which includes Class 25: apparel), on 26 June 2009 and at the time of writing it was the subject of one adverse examiner's report dated 10 September 2009, but is still under examination.³ Acceptance is due on 10 December 2010.

In a reversal of the Katie Perry case, it has recently been reported that a Queensland handbag manufacturer, Mischa Accessories, has filed opposition to the starlet Mischa Barton's application to trade mark her name, as Kylie Minogue, Tiger Woods and Andre Rieu have. These types of word marks typically cover multiple classes of goods and services — not just those associated with the celebrity's industry, but also with a plethora of other consumer goods such as cosmetics, clothing and accessories. It will be interesting to see which of the two Mischas prevails in this latest case.

Fashion has always been fertile ground for intellectual property disputes, although most commentators agree there is a deficit in intellectual property protection for fashion designs in Australia, largely due to the copyright/design overlap provisions in ss 74–77 of the Copyright Act 1968 (Cth).⁴

However, owing to the cyclical nature of fashion design and the need to constantly reinvent and to come up with something new, this is an industry that would find a lengthy monopoly on its designs irrelevant, if not anathema.

“Artistic talent is like a brilliant firework which streaks across a pitch-black night, inspiring awe among onlookers but extinguishing itself in seconds, leaving behind only darkness and longing.”⁵ Alain de Botton’s remark in reference to art and architecture might be a little excessive to apply to the art of fashion design, given the fashion world’s strong elements of reinvention and reinterpretation, but its imagery does capture the ephemeral quality of fashion design.

A fashion brand, on the other hand, is concrete. A brand can be built up over decades into an asset that supersedes all other intellectual property assets in the business in importance and therefore in value. This is true not just for fashion but also for luxury goods, something that luxury brand owners and celebrity managers know only too well. They will therefore spend a great deal of money and effort to trade mark and protect lucrative brands. It seems up and coming fashion designers who were named after brands and celebrities will have to be prepared to fight for the right to trade mark their names.

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Footnotes

1. www.ipaustralia.gov.au/pdfs/trademarks/hearings/1160185.pdf.
2. Trade mark registered number 1264761, which it is noted is in the name of Katie Howell.
3. Trade mark application number 1306481, which it is noted is in the name of Katheryn Hudson.
4. See Little A and Talbot E, “Sequined stitched, painted embossed or bedazzled: fashion, the Designs Act and the Copyright Act” (2007) 20 (9) *ILPB* 134; Ritson L and Ireland E “Fashion’s designs on greater IP protection in Australia” (2007) 20 (9) *ILPB* 138, and Hume A, “IP laws an awkward fit for fashion industry” (2004) 17 (3) *ILPB* 37.
5. De Botton, Alain, *The architecture of happiness*, Hamish Hamilton, 200, p 171.