

8 November 2010

Commercial Law Update

This article was first published in the October 2010 edition of the Lexis Nexis Australian Intellectual Property Law Bulletin.

Branding bands: why trade marking is crucial to commercial success in the music and entertainment industry

The original Material Girl has a big problem: when her daughter Lourdes decided that her future lay in fashion, not entertainment, and just two weeks after Madonna launched a global fashion label using her old nickname, she found herself on the wrong end of a lawsuit.

A Californian clothing company, LA Triumph, that had registered the trade mark "Material Girl" in the US and had been using it for several years, has filed in the California Central District Court claiming that it has been using the name since 1997.¹

Madonna has been known as the Material Girl for 25 years – who could forget her father marching her offstage as she threw money to the audience during her 1985 Virgin Tour?

She is sufficiently famous that she would be able to trade mark her own name in relation to a wide variety of goods and services worldwide.² Tiger Woods, Andre Rieu and Kylie Minogue are some celebrities that have done just that.³

Why wouldn't Madonna's people have registered her nickname as well? The same goes for any well known catch-phrases and song titles of her songs that may have commercial value as brand names.

File sharing is proving to be the Waterloo of the entertainment industry. A form of piracy, it has decimated the earnings of artists and record companies, and threatens to do the same for providers of video content like movie studios.

In the new environment other revenue streams need to be considered and exploited. The cult of celebrity provides a ready made business opportunity. At the John Butler Trio concert at the Hordern Pavilion in Sydney on 3 September, staff were doing a roaring trade in branded t-shirts. Tickets to this sell out concert were good value, but people will pay a lot more for good tickets to good shows.

The name of a band or a stage name is no doubt a trading name and a potential registered trade mark. They may also need to be registered as business names depending on the business names registration requirements in the relevant jurisdictions.

Mr Butler has for the past several years had the words "John Butler Trio" registered⁴ for entertainment, recorded music, paper goods, clothing, footwear and headgear. He should be advising his wife, who plays under the name "Mama Kin".

"Mama Kin" is the name of an Aerosmith song and a music club in Boston in which the band has a stake. There is no current trade mark registration for this name in Australia and Mrs Butler would be well advised to move quickly to apply for it as it may be that Aerosmith take a dim view of her "trading" name if she ever becomes well known enough to come to their attention.

The excellent Melbourne urban roots band Blue King Brown that opened for John Butler Trio have been around since at least 2005, but neither do they appear to have applied to register their name as a trade mark in Australia. It's something their management should be on to.

In the same way, names of songs can become valuable as trade marks – "Material Girl" being one of the most prominent examples.

The Red Hot Chilli Peppers took exception to Showtime calling their new drama "Californication" a few years ago, but Showtime had applied for the trade mark – the creators unfortunately had not. Consequently the TV show Californication is still with us, with Series 4 currently in production.

Some old dogs have learnt these new tricks – David Bowie trade marked his stage name and album name "Ziggy Stardust" back in 1998.⁵

Song titles will not be protected by copyright,⁶ so again trade mark registration would seem to be the answer.

While we are at it, what about the sting of a song riff as a “sound” mark? Harley Davidson were unsuccessful in trade marking the sound of their Hog’s engines, but the MGM Lion’s roar is trade marked, as is the Intel Pentium processor’s inane “ding dong” sting – surely not a work of great musical genius, but of undoubted commercial value.

My all time favourite sound mark is the quacking sound made by the patrons of amphibious vehicle city tours with plastic quackers handed out to them as they get on the bus. If this awful noise can be trade marked, what opportunities must lie in the truly creative compositions of our great musicians?

Now that the days of selling records appear to be over, bands and other entertainers need to think more creatively in a business sense as to how to turn their craft into a buck. They and their managers cannot afford to ignore the valuable commercial property that is their band or stage name, song titles and famous lyrics and riffs.

1 The filing of this suit was reported on 20 August 2010 by Reuters at http://legalonline.thomson.com.au/a24/print.jsp;jsessionid=ADB2EBAA5CE9E015F3A64543CD994D9C?id=173091&hitlist=%2Fa24%2FresultDetailed.jsp%3Ftopic%3D1903%26sortBy%3Drelease_sort%26reverse%3Dtrue%26start%3D0%26id%3D173091.

2 See Logan C, “*What’s in a name: Branding using given names and surnames*” (2008) 20(8) ILPB 118.

3 See Logan C, “*Fair trading in fashionable names: What to do if your name is famous but you are not (yet)*” (2009) 22(6) ILPB 114.

4 Trade mark registered numbers 913898 and 1089588.

5 Trade mark registered number 777238.

6 See Janus E, “*Entitled to protection? Names of creative works as trade marks in Australia*” (2009) 22(5) ILPB 74.