



phillips ormonde fitzpatrick
intellectual property

Australian Millinery Association– IP Law Seminar

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Who are we

- > Phillips Ormonde Fitzpatrick Group
- > Leading Australian IP firm
- > Patent and Trade Mark Attorneys
- > Affiliated Law Firm
- > Specialist IP Support Company

IP Checklist

- > Helps to understand overall IP position of your business
- > Starting point for an effective IP management strategy



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Intellectual Property (IP) Checklist

Management systems

- 1) Appoint an Intellectual Property Manager.
- 2) Budget for obtaining and defending your IP rights and avoiding infringement of third-party rights.
- 3) Establish an IP awareness program for your management and staff.
- 4) Conduct regular IP portfolio reviews, and assess business value of each IP asset in terms of:
 - > providing competitive business advantage
 - > generating revenue
 - > necessity to attracting investment.
- 5) Review all current projects for emerging innovations, brands and other intellectual property.
- 6) Establish and maintain an IP register.
- 7) Incorporate IP tollgates into your product development process.

Copyright

- 1) Retain records relating to creation of any work that may be entitled to copyright protection, such as:
 - ~ textual material
 - ~ published works



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Why bother with IP?

- > May be able to obtain a statutory proprietary right
 - ❖ e.g. a registered trade mark, a patent, a registered design
- > Exclusive right to use or exploit
 - ❖ Can prevent others from infringing your IP rights
 - ❖ A third party may have some exclusive rights that you are infringing!
- > Valuable rights that can be sold and licensed
- > Can help to attract and secure investors

Different IP protection systems

Trade mark

- > a sign used to indicate the trade origin of the goods/services
- > common law trade marks TM (unregistered)
- > registered trade marks ® (application process)

Patent

- > protects inventive products, methods, systems, apparatus
- > registration

Copyright ©

- > protects literary, artistic, dramatic and musical works
- > automatic protection, no registration necessary

Registered design

- > protects shape, pattern and ornamentation of a product
- > registration



Confidential Information

- > Not a form of property
- > Contractual or equitable right to restrain unauthorised use of confidential information
- > Not information in the public domain or too obvious or trivial



Confidential Information

Examples:

- > Trade secrets
- > Know how
- > Business plans
- > Customer lists
- > Drawings

Copyright

- > Right to control the reproduction or copying and the communication of works or other subject matter
- > Arises automatically
- > Must be original work of author/creator
- > In Australia, the term of copyright protection depends on the type of work or subject matter other than work

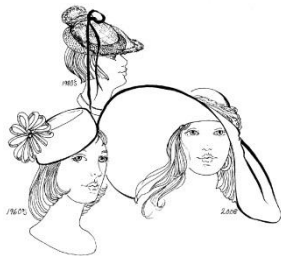
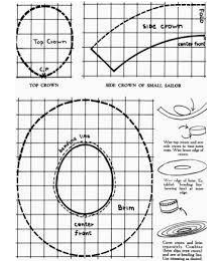
Works?

“Literary” works

- > Can be short and uncreative
- > Includes tables and computer programmes

“Artistic” works

- > Can be utilitarian
- > Includes photographs, patterns, drawings, engravings, textile prints and “works of artistic craftsmanship”



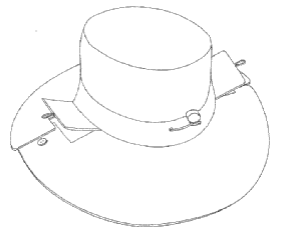
Works of Artistic Craftsmanship

- Must be a product of skill, training and/or specialist knowledge
- 3D hat, fascinator or headpiece may be work of artistic craftsmanship
- Sketches are artistic works not works of artistic craftsmanship



Designs

- > Protect the visual appearance of a product
- > A registered design can protect features of:
 - Shape and configuration (3D features)
 - Pattern and ornamentation (2D features)



Perspective View



FRONT VIEW (EXCLUDING INSIDE
BACK VIEW) - PHOTOGRAPHY



Designs

- > Designs must be new and distinctive
- > Should be filed before any public disclosure of the product
- > Term: 10 Years (renewable once at 5 year mark)
- > Visual appearance of a headpiece may be protected by a registered design

Copyright/design overlap

Dual protection may be available but in some cases you may lose ability to enforce copyright:

- > mass produce the chair i.e. industrially apply it and offer it for sale; or
- > register design that corresponds to the drawing of a chair.

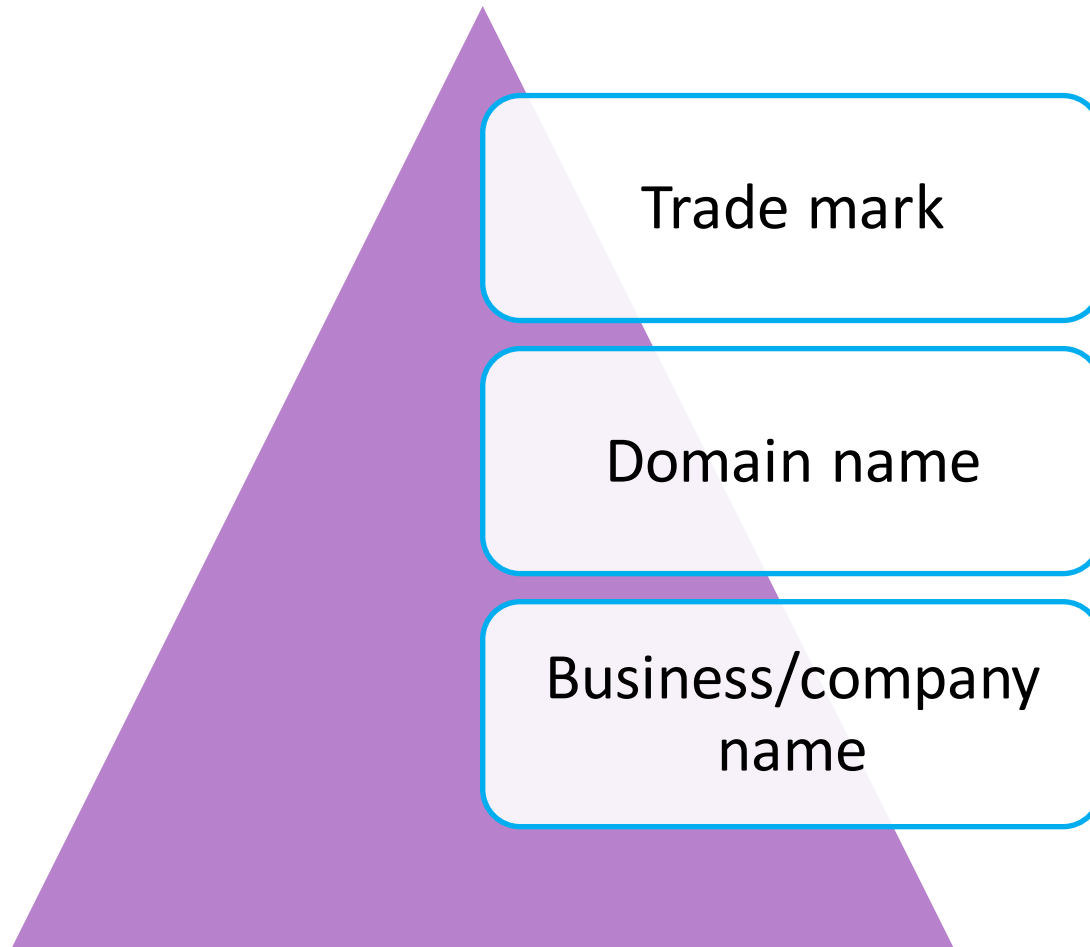
BUT copyright is retained:

- > in works of artistic craftsmanship even if mass produced (but not if there is a design registration); and
- > if the design is registered that corresponds to the relevant artistic work where the design relates to the two-dimensional pattern on a product (e.g. wallpaper design)

Some useful tips

- > Copyright notice -© 2017 Laura Cathcart
- > Document development of work – keep all sketches and designs
- > May need to prove you are the owner of the work and that it is your original work
- > Consider contractual arrangements around ownership

What's in a name?



Trade Marks

- > Badge of origin
- > A “sign” registrable under the *Trade Mark Act 1995* (Cth)



- > Protected by:
 - > Trade mark registration
 - > If not a registered trade mark might rely on reputation in the mark to establish other causes of action such as, misleading and deceptive conduct under the *Australian Consumer Law* or passing off.

Why register your trade mark?

- > Confidence that your use of the mark does not infringe any other trade mark registration
- > Puts others on notice of ownership of the mark
- > Easier to enforce than an unregistered trade mark
- > Indefinite term, renewable every 10 years

Requirements for registration

- > Must be 'capable of distinguishing' the goods/services from those of another trader
- > Not capable of distinguishing
 - > Descriptive words e.g. FRILLY for a dress
 - > Laudatory words e.g. BEAUTIFUL
 - > Place names e.g. Byron Bay
 - > Common surnames e.g. Smith
- > Must not be 'substantially identical with or deceptively similar to' an earlier filed trade mark e.g. **REVISE versus LEVIS, POSH PUPPY versus HUSH PUPPIES**

Trade marks

- > Searches
- > Who is the trade mark owner
- > Form of the mark
- > Classes of goods/services
- > Use TM and [®] as appropriate
- > Overseas

FREDERICK FOX

A handwritten signature in black ink that reads "John A. Boyd". The signature is written in a cursive style with a large, stylized 'J' and 'B'.

Trade mark conflicts... A few examples

“Substantially identical or deceptively similar” test

AKUBRA

AKURA

KANGOL

PANGOL

Tsubo v Tsubi (Now Ksubi)

TSUBI

KSUBI

Trade mark conflicts... A few examples

“Substantially identical or deceptively similar” test



Louis Vuitton v Sonya Valentine PL [2013] FCA 933



Adidas AG v Pacific Brands Footwear [2013] FCA 905



Trade mark conflicts... A few examples

Use of personal names

Partnership between Alannah Hill and Factory X ceased after 17 years.

ALANNAH HILL trade marks owned by Factory X.

Allannah Hill not allowed to use her name

Use of first names

accessories designer Colette Hayman /
fashion designer Collette Dinnigan –
Dispute over the use of the mark COLETTE
/ COLLETTE



Design conflicts

Registered design protecting the visual appearance giving unique appearance

Must be New and Distinctive to be registered

‘substantially similar in overall impression’ test



Review Australia Pty Ltd v Innovative Lifestyle Investments Pty Ltd [2008] FCA 74

Copyright conflict

Infringement if a substantial part of the original work is used without permission

Qualitative test - not quantitative

Seafolly's English Rose artwork



City Beach's Rosette print



Copyright conflict

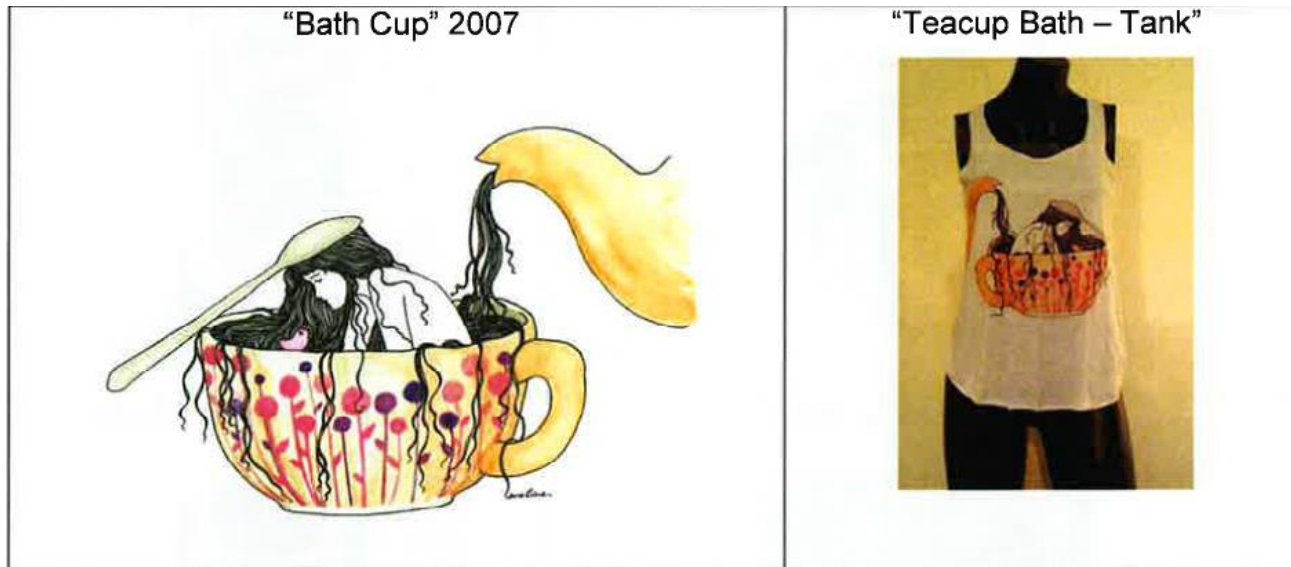


Maintain records of creation of Design to show it was created independently



Figure Eight Holdings, LLC v. New Era Cap Co., Inc., et al.,

Copyright conflicts– dangers of outsourcing



Source: Eveline Taranadjaja



- Due diligence on manufacturer
- Use manufacturing agreement including warranty that works are created independently and do not infringe other people's IP

IP Theft – Identify the issue and secure evidence

- > Keep a watch on markets, stores, trade fairs and on the internet:

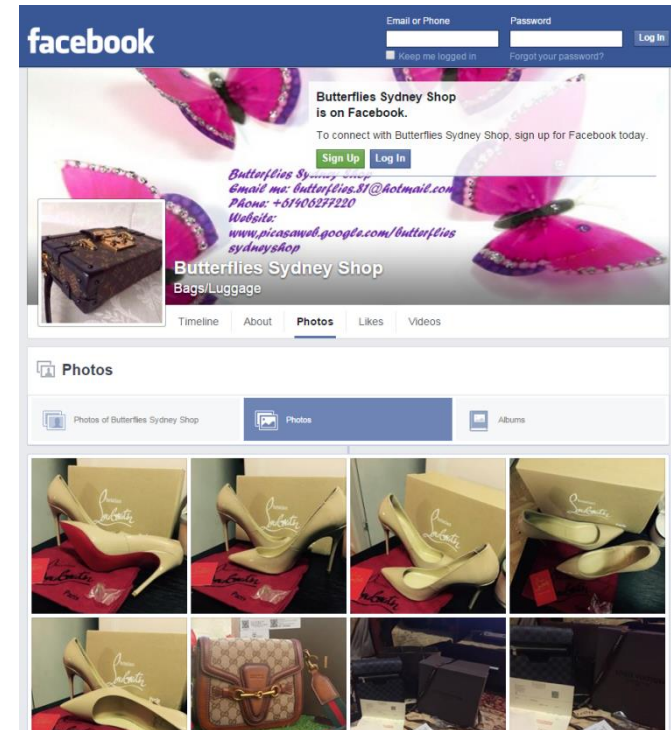
Auction sites: eBay; taobao.com; eachnet.com

BB platforms: alibaba.com; ec21.com ; madeinchina.com;

Search engines: baidu.com; sohu.com

Social Media

- > Take photograph or website printout
- > Obtain a test purchase with invoices/receipts (ABN...)
- > Photograph, label and sign item purchased
- > Possible use a registered investigation agency



IP Theft – Think before acting!

- > Assess whether IP rights infringed: Trade mark / copyright / Design
- > Assess possible legal risks before posting controversial content



Consider groundless threats (threats which cannot be substantiated) and misleading and deceptive conduct before sending letter of demand (Relief includes injunction and damages)

IP Theft – Letter of demand

Letter of demand seeking Undertakings:

- > to cease and desist sales/ distribution/ promotion and other infringing use
- > Delivery up of all infringing goods
- > Information about suppliers (in a Statutory declaration)
- > Compensation – (Statutory declaration setting out details of volume sold, income received and attaching financial records)

IP Theft Overseas – At the Source and in other countries

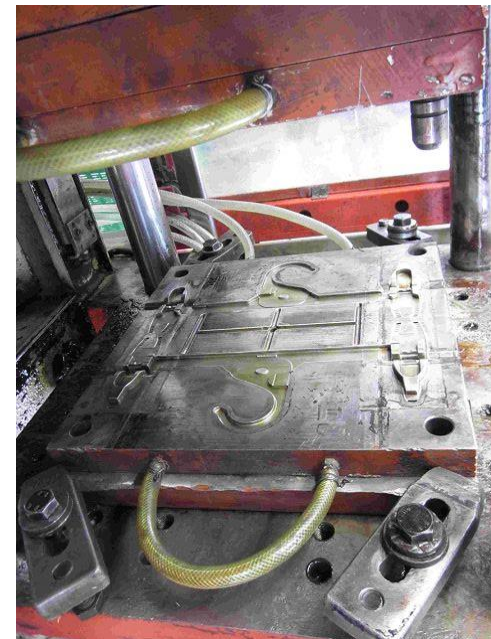
At the source

Conduct investigations, organise raid
with administrative authorities (China);
issue civil proceedings

In other countries

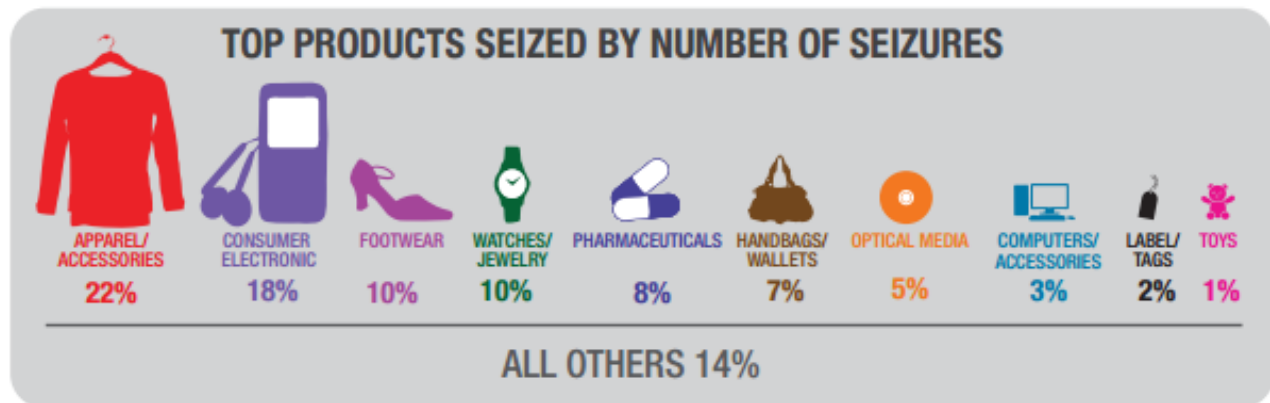
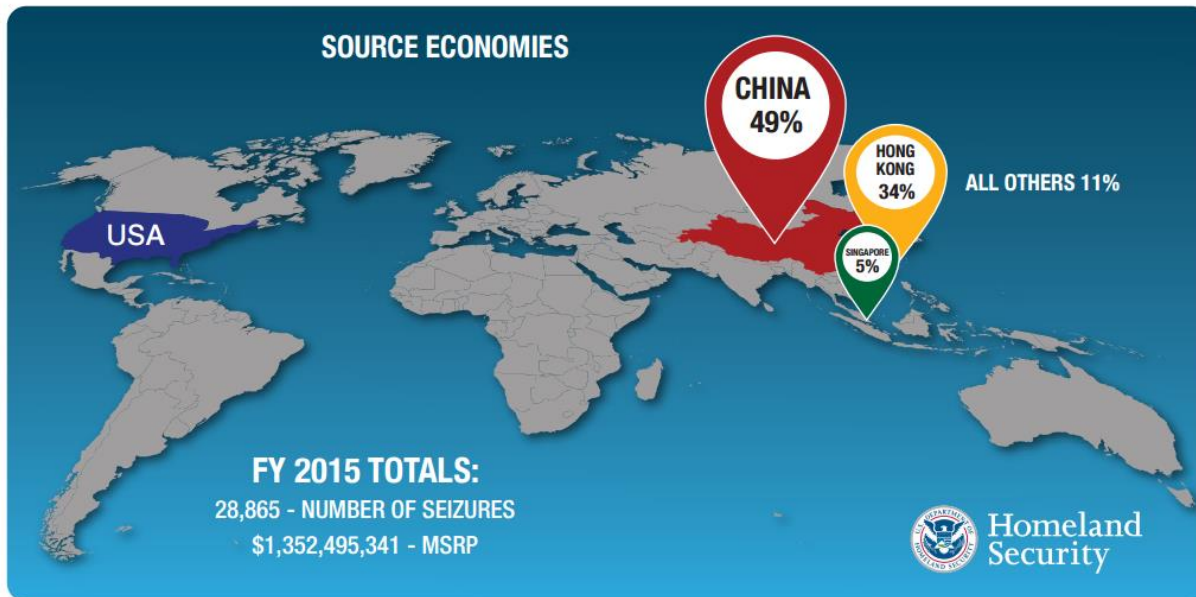
Lodge Customs Notice (Chinese Customs
check exports)

POF is the exclusive partner of the
leading anti-counterfeiting organisation
REACT - Network of offices and partners
in 80 countries



Working with Customs – Recent trends on counterfeit goods

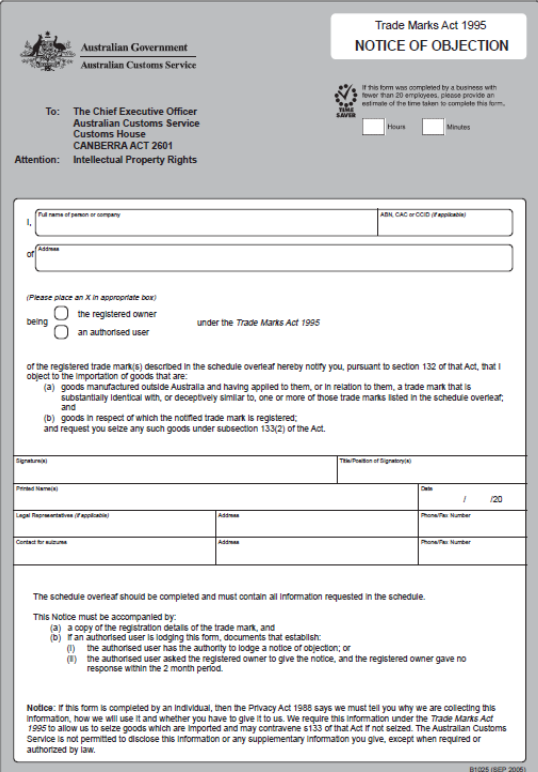
FISCAL YEAR 2015 IPR SEIZURE STATISTICS



Working with Australian Border Force

Notice of objection:

- > ABF will only seize counterfeit goods if a notice is lodged
- > Trade marks or copyright (not designs)
- > Valid for 4 years
- > Storage and destructions costs rarely sought after by ABF (unless big quantities seized or specific storage capacity issue)
- > Photographs of the items intercepted are usually sent by Customs
- > Importer and exporter details are included in seizure notice
- > Possible to obtain sample



The form is titled "Trade Marks Act 1995 NOTICE OF OBJECTION" and is issued by the Australian Government, Australian Customs Service. It is addressed to the Chief Executive Officer, Australian Customs Service, Customs House, CANBERRA ACT 2601, with attention to Intellectual Property Rights. The form includes a section for the filer's details (name, address, ABN, CAC or CCID), a section for the filer's role (registered owner or authorised user), and a section for the registered trade mark(s) described in the schedule. It also includes a section for the filer's signature and date, and a section for the filer's contact details (legal representative, address, phone/fax number). The form contains instructions on how to complete it, including a note that it should be accompanied by a copy of the registration details of the trade mark and a copy of the goods to be seized. It also includes a notice about the Privacy Act 1988 and the Australian Customs Service's policy on the use of personal information.

Thank you

Questions?