

First in, best dressed

Creating and protecting your own fashion brand

By Wayne Covell and Robin Covell

It's no secret that fashion and brand labels go hand-in-hand. The leading fashion brands are all registered trade marks. But what can up-and-coming designers do to protect their label in their early years?

A classic principle in trade mark law is *first in, best dressed*. And it means just that. The first person to use or apply for a trade mark means that person has the best rights to that name or mark. With that principle in mind, fashion designers should first and foremost move to secure intellectual property rights in their own brand label as early as possible.

One of the best rights that a fashion designer can have, is to own the trade mark rights in their label. Trade marks are personal property that can be licensed, mortgaged and sold and controlling those rights is king. The relative cost of international trade mark protection in the early years, however, is expensive. But formative steps should be taken as this is when many mistakes are made. Simply securing a business name or a company name or a domain name is not enough.

The first step is to clear your brand or trade mark for use in Australia. This is also a good time to check its availability in key fashion markets such as the USA and Europe.

Creating a great label for Australia is all very well, but why hem yourself in? Some preliminary work here can really pay off in the long run. It's a good idea to search for your fashion label to check if it's clear or available.

If it is, then a trade mark application should be promptly filed in Australia and all relevant domain names should be secured. The Paris Convention can really help here. This

means that you can file a foreign trade mark application and claim the same filing date as your Australian application *provided* it is filed within 6 months of the Australian application. This six month window is very helpful in terms of budget. Hopefully, you will know in 6 months time where your next bold step on the world stage will be.

So if you're thinking of registering your fashion brand as a trade mark what should you apply for? Many fashion designers choose to register their own name such as **Collette Dinnigan**, **Leona Edmiston** and **Carla Zampatti**. If the fashion designer's full name, first name or surname is available, then that's an excellent way to get started. But if it isn't then a distinctive, chosen or invented name is also a popular choice and is often easier to register. **Sass & Bide** is an excellent example. Sarah-Jane Clarke's and Heidi Middleton's friendship and creation of the successful **Sass & Bide** fashion brand was the subject of an episode on [Australian Story](#). Heidi Middleton explained that "Sass & Bide came from our nicknames. I branded Sarah-Jane with the nickname of 'Sass' when we first met. She was sassy. The name Bide was a family nickname, it really came from 'Heidi Bidey', 'Bidey Bow' to 'Bide'."

The other critical issue is what goods and services should be applied for? Invariably all clothing fashion designers should apply in international class 25 which covers most forms of clothing, headwear and footwear. But relying on class 25 alone for protection is risky. Fashion designers should also consider class 42 which covers clothing design and class 35 extends to fashion industry retailing including online retailing.

Of course the up-and-coming fashion designer will dream – or should dream – of brand extensions such as fashion accessories including sunglasses and spectacles in class 9, perfumes, fragrances and hair care products in class 3, handbags in class 18 as well as textiles in class 24 and yarns and threads in class 23.

In summary the following nine goods and service classes should be considered and searched for when considering the registrability of a fashion trade mark and how best to protect it:

- **class 3** – cosmetics, hair care preparations, perfumes and fragrances
- **class 9** – sunglasses and spectacles
- **class 18** – handbags, leather goods, umbrellas
- **class 23** – yarns and threads for textile use
- **class 24** – textiles and textile goods
- **class 25** – clothing, headgear and footwear
- **class 35** – retailing of clothing and fashion accessories, advertising
- **class 41** – entertainment and events
- **class 42** – design of clothing, footwear and headwear

Applying for a trade mark in these nine classes, however, will be expensive. IP Australia's filing fees are a minimum of \$120 per international class and the registration fees are \$250 per class. But, at the very least classes 25, 35 and 42 should be applied for as a 'toe in the water' approach. As the brand grows other classes can be applied for.

There are many other intellectual property issues to consider. In 2007 IP Australia, The Department of Innovation, Science and Research and the Australian Fashion Council launched *Fashion Rules: A Guide to Intellectual Property for Australia's Clothing and Fashion Design Industry* (see www.ipfashionrules.gov.au/UserFiles/File/handbook.pdf). Importantly, this Guide looks at designs, copyright, patents as well as trade marks. So far as trade marks are concerned the Guide encourages registration while noting the limitations of other forms of registration particularly business, company and domain names.

So, if you are seeking to protect your fashion brand, the foremost thing you need to do is obtain both a trade mark registration and the associated domain name. If you're launching a new fashion brand then it's best to obtain an availability search in the relevant markets or countries prior to using it.

Good luck! And remember, first in, best dressed.

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