

The Grinch Who Stole Swiftmas?

News comes this week that American entertainer, Taylor Swift, has applied to register a number of trade marks in the US, including the phrase 'Swiftmas' and the number '1989'.

These follow a busy year at the US Patents and Trade Marks Office for the singer, who has previously applied to register such phrases as 'Sick Beat', 'Blank Space' and 'I'll write your name...'

The obstacles to registration for these latest applications are relevant to all trade mark owners and are worth some serious consideration.

Why are her US applications of any relevance to Australia?

If these latest applications follow the same route as her previous registrations for 'Taylor Swift' for fragrances, clothing and music and entertainment services, the applications in America will soon be followed by applications in Australia, backdated to the date of the American applications under international trade mark treaties.

This is a route we recommend to our own clients here in Australia, looking to expand into overseas markets within the six month priority window. Backdating the application has the advantage of ensuring that your rights are not in danger from unscrupulous third parties, business partners or rivals who may apply for your trade marks in those overseas markets to disrupt your business or gain a commercial advantage.

As the music industry has long had to battle counterfeiters and rights' infringers, this would be high on Taylor Swift's list of commercial priorities. Let's look at each application on its own merits.

'Swiftmas'

Ms Swift's fans coined the phrase 'Swiftmas' in reference to the good deeds carried out by their favourite Pop elf at this time of year. Can you successfully register a phrase coined by someone else? And what if the goods and services applied for are not the same as those previously associated with the mark?

A trade mark operates as a badge or origin for goods and services and while 'Swiftmas' is associated with her charitable deeds and entertainment services, the US application has been made in respect of clothing alone.

There are a number of factors in Ms Swift's favour here:

1. 'Swiftmas' is a new 'made up' word, and is not already part of ordinary English language usage;
2. Is not likely to be needed by honest clothing manufacturers to describe their products in the ordinary course of trade;
3. It is now uniquely associated with Ms Swift alone and her actions, even though the phrase was initially devised by others; and
4. Is not likely to be the subject of identical or substantially similar prior registrations that may

block her own application.

Overall, these aspects mean that Ms Swift may very well successfully achieve registration and we'll all be wearing 'Swiftmas' pyjamas to open our presents next year.

'1989'

Although '1989' is now associated with Ms Swift's music, can you achieve trade mark registration for a date or a year? It is possible in some circumstances, but a trade mark is a monopoly granted by law, excluding other traders from the use of that phrase or image, and therefore there are substantial public policy reasons against registration of this mark in Australia.

What are the factors working against her?

1. This mark is already in extensive common English usage;
2. Is arguably not inherently adapted to distinguish one trader's goods from another's. This is despite the US application's presentation of '1989' in a stylised font, as this is unlikely to be enough to distance it from the every day use of the date. If the Australian application involved a logo incorporating pictorial elements, this would greatly increase its chances of success and there are a number of applications of this type already on the Australian register;
3. Is likely to be needed by others in the ordinary course of trade without meaning to trade off the goodwill established by Ms Swift in her music. While one cannot discount that she has established some goodwill and fame in '1989' through the successful album and tour of that name - proving that an ordinary word or number is now only understood to refer to your goods or services is a very difficult task; and
4. IP Australia has already rejected an unrelated 2008 application to register '1989' for music and entertainment services, despite the provision of evidence of use and considerable efforts by those applicants. Accordingly, we can expect any application filed by Ms Swift to have trouble.

'Sick Beat' 'Blank Space' 'And I'll write your name'?

As mentioned above, trying to register a common phrase or lyrics as a trade mark is very difficult and not something that Clifford Gouldson would recommend to a client as the preferred course.

Establishing ownership of these phrases, and proving a consumer would only connect that phrase with your music is quite a challenge in the US and would be even more difficult here in Australia. The key is persuading a trade mark examiner that the phrase is distinctive enough for your products - just ask the owners of the Australian registrations for 'Fat, Sick and Nearly Dead' or 'Fully Sic' for example.

In Ms Swift's case, her marks have been accepted for registration in the US and advertised for opposition. Given the amount of online comment by other musicians over her 'ownership' of this phrase, it will be interesting to see which, if any, industry figures oppose the applications. As this is likely to take some time and money, why would Ms Swift and her business connections bother?

One major advantage is the deterrent effect of these applications on counterfeiters who would usually seek to employ those phrases on merchandise meant to profit from the popularity of her music around her world tour.

What Should You Know and What Should You Do?

1. Unique words and phrases invented to describe a product or business will always have an easier path to trade mark registration;
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2. Detailed Logos are one way to achieve some protection on the register for businesses whose marks incorporate everyday phrases and words where a plain or stylised font would fail;
3. In the age of social media marketing, a phrase coined by your customers to describe your products can, in limited circumstances, become a trade mark of your business and therefore your asset. It is important to act quickly to ensure that you capitalise on that opportunity before it is adopted by others and the asset is lost;
4. Where a product or service is also set to be launched in overseas markets, take advantage of the international trade mark treaties to backdate your overseas applications and protect your intellectual property before you've made your first overseas sale.

Please contact us if you have any questions or IP concerns with your business and in the mean time Clifford Gouldson wishes you a 'Merry Swiftmas' - under licence of course!

For more information contact our Intellectual Property Team.

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