

Buchanan Law

Arts & Entertainment Update

MAY 2008

"They do not generate instant excitement, but trademarks are at the core of what makes or breaks a business"

(Source: The Australian Newspaper, 26 September 2006)



BUCHANAN LAW
Intellectual Property and Technology

www.buchananlaw.com.au

Isn't it ironic (in a strictly non Alanis Morissette sense) that arguably the most important asset of any artist, business or organisation in the entertainment industry is far too often the one that is afforded the least amount of protection? What is this elusive asset? It is the one thing that distinguishes you in the market place from your competitors. It is the front man of your business goodwill. Most importantly though it is what people **remember**. Give up?

We're talking about your name . after all, without it you're nothing (no offence).

Office Buchanan Law Pty Ltd
Level 3,
54 Marcus Clarke Street,
Canberra ACT 2601

Postal GPO Box 579,
Canberra ACT 2601

Tel 02 6221 9555

Fax 02 6162 3202

Email info@buchananlaw.com.au

ABN 55 121 082 388

"The best way to protect a name is to register it as a trade mark. If you can afford to do it then do it"

(Source: Arts Law Centre of Australia website)

The best way (in the whole wide world . no joke) for an artist, business or organisation to protect their branding (name or logo, etc.) is to register it as a trade mark. A registered trade mark is a legal proprietary right that gives you the exclusive use of your chosen name, logo or other branding in connection with specific goods and/or services you nominate . in other words, you own it!

Well, why isn't everyone doing it, then? It could be argued that everyone is starting to - the number of trademarks registered has jumped by around 10 per cent every year for the past decade. This rise in awareness of the importance of Intellectual Property within the Australian arts and entertainment sectors has also brought a rise in the number of new legal proceedings commenced for trade mark infringement. The best way to protect you or your business is to register sooner rather than later.

Registering a trade mark is a proactive step (*sigh*) in the protection of your intellectual property; the idea is to do it *before* something goes wrong so that if something actually does go wrong, you have a leg to stand on. That said, registration is certainly not without its benefits! Just a handful of the advantages it affords are:

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The Benefits

- Firstly, it is the easiest way to take legal action for infringement of your branding . you only need to show that you own the mark and, if challenged on the point, that you have been continuously using it in connection with your specified goods and/or services. There are other ways to protect an un-registered mark, such as the common law relating to passing off but these all place additional burdens on the injured party (e.g. in the case of passing off, to prove an established reputation in branding). As you might have guessed, this can be a much more complicated, time consuming and expensive process.
- Secondly, you get to use the ® on your branding! In all seriousness this really is important . only registered trade mark owners may use the ® on their branding, which effectively puts the world on notice of your Australian registration. Your mark is also listed on the public register of Australian trade marks to serve this same purpose.
- Finally, a trade mark registration is property and as such potentially a very valuable business asset. With the consent of the owner a registration is capable of being assigned or transferred at any time.

"The benefit of any trademark is that it gives you the ammunition to shoot the gun. Without it you don't have rights."

What's in a name?

Yep you guessed it: these are real band monikers:

- This Bike Is a Pimp Bomb
- Bullet For My Valentine
- Panic! At The Disco
- Test Icicles
- My Morning Jacket
- New Young Pony Club
- Mr. Mister
- Lost Underpants of Doom
- Baldilocks
- Boris The Sprinkler
- Coffin Break
- Diet Christ
- Arctic Monkeys

(Source: Martin Pollock, interview on Catapult/ABC website)

The Myths

Sadly, the registered trade mark is a horribly misunderstood creature. The following points serve to dispel the myths and set the record straight once and for all:

- *'We don't need a trade mark registration, we have our business name'.*
Sorry, but a trade mark registration **is different** to a registered business name, company name or domain name. None of these other registrations confer a *proprietary* right and as such they are not enforceable against infringers.
- *±We don't need a trade mark. Everyone knows who we are and nobody would dare try and rip off our name/brand.q*
Can you really be sure of this? And if somebody does ~~rip~~ you

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offq then what next? Without a trade mark registration youqre basically gambling that this situation is never going to arise. Is it really worth the risk? See the attached page of all time great IP blunders if you want to know what can go wrong.

➤ *#t's too expensive... lawyers – all they want is my money'.*

Wrong . we donq want your money, honey, we want your love! To prove it, wedq even be brave enough to tell you that there are DIY options for filing a trade mark application. Now, of course, we would rather you file through us (we are sure we still do qvalue addqin terms of assessing and positioning brands and applications) but we would prefer that you went ahead yourself rather than not do it at all. Although very affordable, we understand that not everyone is in the financial position to register their marks **BUT** if you can afford to do it, then we think you would have to be crazy not to.

The Proof is in the Pudding

Who else in your sector has taken the step to protect their branding? Below are just a handful of artists, businesses and organisations that have taken the registered trade mark initiative:

- Family Nightclub (Brisbane)
- Cargo Bar (Sydney)
- Sasha (International DJ/Producer)
- Carl Cox (International DJ/Producer)
- Hilltop Hoods (ARIA Award Winning Music Artist)
- Wolfmother (ARIA Award Winning Music Artist)
- Sydney Symphony Orchestra
- Melbourne Theatre Company

(Source: IP Australia Register of Trade Marks)

Going Forward...

Register, register and register. Is that the only message? No, thatq far from it. One of the things you will have to think very carefully about is how the mark is going to be owned. Now, if there is only one of you, fine: but suppose you are part of a band or similar? In March 2008, the surviving members of the Beach Boys finally settled an eight year dispute over ownership and infringement of the BEACH BOYS registered trade mark. To avoid all of this, always make sure that you establish how the mark is going to be owned well ahead of time: will it be jointly owned between you as individuals? as a partnership asset? as a corporate asset? If you are not sure, then get some advice (this applies to other IP as well where more than one person is involved e.g. copyright in songs and lyrics) from arts and entertainment lawyers.

Who Are You?

Can you guess which of these Australian acts have NOT registered their name as a trade mark? (Answer on page 5)

- The Living End
- Powderfinger
- Midnight Oil
- Kylie Minogue
- Rogue Traders
- Cold Chisel
- The Screaming Jets
- Grinspoon
- Silverchair
- Eskimo Joe

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Arts & Entertainment: Blunder Corner

Saboteurs of the Raconteurs

Jack White of The White Stripes fame has a new band . everywhere else in the world they're known as The Raconteurs, but in Australia they're known as The Saboteurs. Why so, you ask? Well, unbeknown to Mr. White, a small-time Queensland jazz outfit had been using the Raconteurs name for some time in Australia with a sufficient level of notoriety (Triple J Unearthed) to develop a reputation in it. However when White's band made the Brisbane outfit an anonymous offer to release their rights in the name, the Aussies countered asking for more cash. In true rock n'roll style, White's lawyers supposedly told the Aussies to f*ck it and they commenced the arduous task of rebranding *everything* to The Saboteurs for the Australian audience.

Now this is all well and good if you have a bank balance somewhere in the vicinity of Mr. White's . however for any other common old artist rebranding from scratch is going to most likely break the bank.

ARTS & ENTERTAINMENT NEWSFLASH ...

ARIA DJ Licensing

DJs now have no excuse for using illegal music at their gigs according to a recent release issued by the Music Industry Piracy Investigators MIPI. A new DJ license available from the Australian Recording Industry Association (ARIA) has been marketed as a one-stop shop for DJs to allow format shifting of their music for use in their performances. Corresponding licenses for use of the published musical works themselves are available through AMCOS/APRA (though this is usually the venue's rather than the DJ's responsibility).

In the release, MIPI first appeals to the morals of would be and existing pirate DJs, if the people who rely on music to make a living are ripping it off, then what chance does the industry have to properly remunerate artists and songwriters? However, they also didn't forget to include a friendly reminder of the applicable criminal penalties for music piracy under Copyright legislation . up to \$60,500 and 5 years imprisonment per offence. This is not an issue to be taken lightly, especially as MIPI also noted that this is not just an issue for DJs . nightclubs and bar owners may potentially also be held liable for authorising copyright infringement at their premises by allowing a DJ to use pirate discs or illegal mp3 files.

Is this all just bluff? Some may say that format shifting by DJs is so prevalent that it has got to the point where it is beyond control. By way of comparison, a number of Australian DJs have been hauled before

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the courts in the last 5 years for producing mix-tapes without the permission of the copyright owners. Most recently, in 2005, high-profile DJs Chris Kross and Pee Wee Ferris were ordered to pay more than \$800,000 in damages and costs after the Federal Court found they had together illegally used unlicensed tracks on CDs sold in Sydney stores (Source: SMH, 13 March 2005).

True format shifting may be prevalent, but it will not stop copyright owners from enforcing their rights. The choice is yours . do the right thing or risk the sting.

Buchanan Law – who we are

Buchanan Law is a legal practice with a difference. We are leaders in our chosen practice areas, providing specialist and commercially oriented legal advice and creative solutions. We are young (some of us), enthusiastic (all of us) and share a passion for Intellectual Property and the law in the arts and entertainment sectors. We love what we do and we believe that there is no substitute for exceptional personal service. Please contact any of the team directly, or hit our website, to find out more about how we can help and the range of other services we provide.

You can find our website at <http://www.buchananlaw.com.au>, you can call us on 02 6221 9555 and the BL Team email contacts are as follows:

Name	Does	Contact
Scott Buchanan	Director, Principal Lawyer & Principal Trade Mark Attorney	scott@buchananlaw.com.au
Shaun Creighton	Senior Lawyer & Senior Trade Mark Attorney	shaun@buchananlaw.com.au
Monica Dawes	Lawyer	monica@buchananlaw.com.au
Gary Lea	Associate & Senior Trade Mark Assistant	gary@buchananlaw.com.au
James O'Connell	Paralegal & Trade Mark Assistant	james@buchananlaw.com.au

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Have you heard of them?
Heard of who?
!!!

That's right, !!! is a band name. They're a dance funk group from California who allow their fans to choose how to pronounce their name, so long as it consists of any monosyllabic sound repeated three times.

Some popular pronunciations include %hk chk chk+, bam bam bam+%h uh uh+- you get the idea.

Clever, yes, but have you tried to enter this one into a search engine...