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Double *trouble*

K&L Gates' Savannah Hardingham and Olivia Coburn speak with the founder of Prene Bags about brand protection.

WHEN STARTING A new brand, funds are often limited. Spending money on intellectual property (IP) protection can be low on the list for new businesses. However, getting IP protections in place quickly is a key step in building an exclusive and valuable brand that can stay the distance.

The founder of Australian brand Prene Bags, Tammy Green, started designing handbags in 2013 as a first-year business student. Not long after, she started Prene Bags and her first run of 600 units sold out before the bags hit Australian shores. What started out in the family garage quickly grew into an instantly recognisable brand with dedicated fans. With success comes imitators, and Green learned early on that she needed to devise a holistic strategy to protect her brand through both design and trade mark protection.

In Australia, designers can protect the overall appearance of original designs (including for garments, bags and accessories) by registering these pursuant to the Designs Act. The key is to file design applications at the right time – before the designs are released to the public, including on social media or online. Otherwise, design rights can be lost and there may be little that can be done to stop copyists.

“We learned from when we started the brand that not registering designs creates problems down the track, as there’s not much you can do about copying if the design isn’t registered. We have been able to protect our designs through registered designs, even if someone has been unaware of the registration and attempted to copy it,” Green says.

Once a design is registered it provides a strong registered right that adds value to any design-led business. A registered design is infringed if a third party, without permission, makes or deals in a product which is identical or substantially similar in overall impression to the design. In contrast to copyright infringement claims, it isn’t necessary to show the infringer was aware of the design registration or actually copied the design in order to establish design infringement.

“As the brand grows and you get more brand recognition, you also get more copycats, which causes problems with customers and retailers. There’s a flow-on effect where

online customers will complain, and retailers will complain if they’re aware of a knock-off on the market. When you have protection, you can assure retailers and customers that your designs are original and protected and that you can take action. It provides longevity for the products,” Green says.

The design registration process can be cost effective, particularly when considering the value that arises from registrations. Brands can promote the fact that they register their designs, which adds to the exclusivity of products and can also be an effective deterrent to would-be copyists. “Investing in registering key designs has been an important upfront investment for Prene,” Green says. “For what is basically a one off cost, we get to publish the design registration details on our swing tags – which we hope has a deterrent effect – and take action when we see copies in the marketplace. We’ve had some success in getting copy product out of the market quickly, on the basis of our registered design rights.”

Owners of registered designs are granted a monopoly to exploit their design for an initial period of five years, which can be renewed for a maximum period of 10 years. There is also the opportunity to file “multiple applications” for whole ranges at once, which can result in big savings for fashion brands and make the process more manageable. It is also possible to extend design rights internationally.

In addition to registering designs, fashion businesses should also secure registered trade mark rights in key brands early on, a step that Green took with the “PRENE” trade mark. “We’re investing in protecting the brand’s intellectual property as a whole. With the trade mark registration, we’ve been able to stop other people using our name”, she says.

By investing early in IP protection, fashion businesses set themselves up to reap the rewards that come from driving a strong brand. ■

For more information about design and trade mark registration and enforcement, please contact Savannah Hardingham at K&L Gates (savannah.hardingham@klgates.com). This article is for informational purposes and does not contain or convey legal advice. The information herein should not be used or relied upon in regard to any particular facts or circumstances without first consulting a lawyer.

