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Special Fashion Edition

Protecting Fashion and the Role of Intellectual Property

Jennifer Huby, Partner, and **Ben Cameron**, Senior Associate, at HWL Ebsworth, discuss the various ways intellectual property can protect fashion.

In Australia, authors, musicians, playwrights, painters, sculptors, and even software coders, all receive immediate and automatic protection the moment their literal (or metaphorical) pen lifts off the paper. Generally, this protection is for the rest of their life and then a further seventy years.¹

Fashion designers have a more difficult time for at least three reasons.

- First, copyright is most relevantly granted for artistic works (i.e. paintings, sculptures, drawings); and 'works of artistic craftsmanship' (which is dealt with in part 1.2 below). Fashion doesn't neatly fall into one of these categories, which can make it hard to show exactly what rights the designer holds, although generally the designer would own copyright in:
 - silhouette drawings of a garment that the designer makes (**Drawings**); and
 - artworks that the designer creates to be printed onto fabric (**Prints**).
- Second, fashion exists in a peculiar intersection of 'copyright' and 'designs' (not fashion designs but intellectual property 'designs') such that copyright in Drawings and Prints may be lost entirely.

- Third, the fashion industry has a long-standing and recognised practice of copying:

The evidence indicates that copying and adapting the designs of other designers is the accepted modus operandi of designers, including reputable designers, within the industry; and that it is through this process that fashion products are created.²

This means that copying is often rife, especially where the 'look and feel' of a garment is copied, which can make it very difficult to establish whether a designer's rights have been infringed.

It also gives rise to non-intuitive results. For instance, the Harlem designer Dapper Dan created the jacket on the left in the 1980s using fabric covered in the Gucci trade mark. This would almost certainly have infringed Gucci's (trade mark) rights. However, in 2017, the jacket on the right was 'designed' by Gucci.



1. Copyright Act 1968 (Cth) s 33.

2. Review 2 Pty Ltd v Redberry Enterprise Pty Ltd [2008] FCA 1588 [88] (Kenny J).

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Editors' Note

Our dear CLB readers,

Following our special bonus edition in June (who said 2020 wasn't a great year?), we are delighted to deliver to you our special fashion industry edition, focusing mostly on intellectual property in the fashion world. Now, let me assure you, in Eli's high-school yearbook, when his classmates were asked who among them was most likely to edit a fashion magazine, Eli received every vote available. Described as a pioneer of probably-doesn't-know-how-to-use-a-mirror chic, Eli was nominated by his peers as a likely fashion critic par excellence, in what can now be vindicated as a most prescient prediction. With fashion knowledge acquired from reading legal judgments, Eli has long been able to differentiate blue from such other colours as red, yellow and even orange.

But, fear not, dear CLB readers. You are in safe, begloved hands, with Eli's co-editor. As Karl Lagerfeld probably did not declare on his death bed: "You cannot spell 'Fashion' without Ash."

Eli: So Ash, who are you wearing?

Ashleigh: Eli. We spoke about this before the red carpet. It's not cool to ask that question anymore. (Zimmerman, though.)

Eli: Let us in on the thinking behind this special edition. Why fashion?

Ashleigh: Fashion trends invade all industries and professions in one way or another and law is no exception. Aside from the obvious wigs and gowns, well-tailored suits and the highest of heels, fashion law is fundamentally intellectual property law - it's designs, and trade marks, and copyright - and therefore something that is of central interest to our readers. The fashion industry has long driven innovation and technology. It's artwork, and drawings, and photography. It's marketing and advertisements and sponsorship. And so, some of the most interesting intellectual property decisions have been fashion industry decisions. It's an area that IP lawyers are regularly

dealing in. But also, it's October 2020, and we've been wearing the same trackies every day since March - and isn't the world just crying out for a CLB fashion industry special edition?

Eli: Completely. So what are we looking at in this edition?

Ashleigh: We have **Jennifer Hubby** and **Ben Cameron** from HWL Ebsworth discussing the various ways of protecting original fashion with intellectual property. **Rebecca Smith** from G+T discussing trade mark law in the context of online retail following the Pinnacle Runway v Triangl judgment. Two of our favourite Young Lawyers reflect on our favourite fashion judgments: **Amy Campbell** from HWL Ebsworth looks at the Seafolly judgment and **Joel Parsons** from Bird + Bird looks at Elwood v Cotton On. We also have reports on two recent and highly successful CAMLA Young Lawyers events, being the Virtual Speed Mentoring event, by **Jess Millner** (MinterEllison) and the Non-Publication & Suppression Orders 101 webinar, by **Ellen Anderson** (Addisons).

Eli: Wonderful. But what if I wanted more?

Ash: Well, you're in luck then, Eli. We also have interviews with three of our favourite fashion lawyers. **Philippa Bergin-Fisher**, the General Counsel of Zimmermann, chats with you Eli; **Marina Mitrevski**, the General Counsel of The Iconic chats with **Bella Street**; and **Justin Cudmore** of the Australian Fashion Chamber and Marque chats with Marque's **Emma Johnsen**. Emma also has a piece in this edition on fashion IP in China following the Michael Jordan decision, which you promised her you wouldn't title "EmJ on MJ". **Anita Cade** and **Lachlan Wright** from Ashurst have a piece on copyright and tattoos; and I've written a piece on infringement and knockoffs in the fashion industry.

Eli: I've got to say, Ash. We've really, ahem, fashioned an excellent edition in difficult circumstances.

Ash: Oh dear. Thanks to all the contributors. We hope you enjoy!

The Gucci jacket, which appears to be very similar, may have infringed Dapper Dan's copyright by reproducing a substantial part of Dapper Dan's jacket. However, if Dapper Dan had been based in Harlin, Queensland instead of Harlem, New York, it is entirely possible that Gucci would not have infringed Dapper Dan's rights. This is because if he had sold many of the jackets, copyright protection in the Drawings for the jacket may have been lost as further explored below. Even if he had registered the jacket as a 'design', due to the time that had passed, he would have been unable to enforce the design.

1. Copyright Can Be Lost

A painter can generally rely on copyright to stop a sculptor making a sculpture of one of the painter's paintings (and indeed vice versa).³ This is because copyright in a two-dimensional artwork (such as a Drawing on paper for the silhouette of a dress) includes the right to control any three-dimensional reproductions of it, say, as an actual dress.

However, copyright will be lost⁴ if a fashion designer's Drawing is mass produced⁵ in a garment which embodies the shape and configuration (what is referred to as the 'corresponding design') of the

Drawing. If so, third parties are free to copy the original Drawing from the date the product is first offered for sale or hire anywhere in the world.⁶ This is the 'copyright/design overlap'.

1.1 What is a corresponding design?

A corresponding design is the visual features of shape or configuration which, when embodied in a product, result in a reproduction of the original artistic work. This only applies to 'shape or configuration' and not 'pattern or ornamentation'. For instance, the '*repeating, parallel grooves in the seat of a plastic chair and on its back which produced a noticeable visual effect constituted*

3. Copyright Act 1968 (Cth) s 21(3).

4. Ibid s 77(2)(a).

5. The legal term is 'industrially applied', and, per Regulation 12(1)(a) of the Copyright Regulations 2017 (Cth), will generally be satisfied where 50 or more products have been produced.

6. Copyright Act 1968 (Cth) s 74(1).

features of shape or configuration not pattern or ornamentation.⁷

The intention of this was to ensure that artistic works exploited as two-dimensional works (and were therefore ‘patterns’ or ‘ornamentations’) still receive copyright protection.⁸ Therefore an artwork printed onto the surface of a fabric is not a ‘corresponding design’ and will not lose copyright as copyright can only be lost if there is a three-dimensional corresponding design.

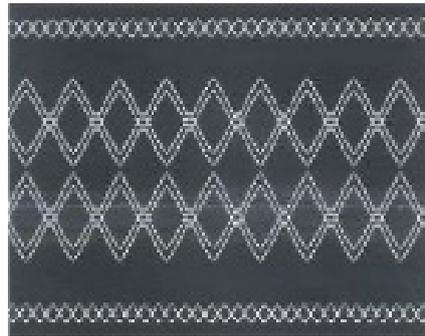
However, artwork on clothing can be both two-dimensional (as with printed designs) and three-dimensional, as with designs woven into items such as knits, weaves and tapestries. These three-dimensional reproductions could be a ‘corresponding design’.

It is not always clear as to when sufficient ‘three-dimensionality’ exists for embellishments to become a ‘corresponding design’. However, both the *Seafolly*⁹ and *Polo Lauren*¹⁰ cases suggested (without deciding the matter) that embroidery was not sufficiently three-dimensional.

It is also not clear as to what the precise distinction is between ‘shape and configuration’ (which would give rise to a ‘corresponding design’ such that copyright in the artwork would be lost) and ‘pattern and ornamentation’ (in respect of which copyright would continue).

In *obiter*, the Full Federal Court dealt with this issue in relation to Polo Lauren’s embroidered (and thus strictly three-dimensional) polo player logo on its shirts by finding that the logo was ‘conceptually distinct’¹¹ from the shirts. That is, the garment did not embody the original artistic work that is the logo and therefore copyright could not be lost in the logo.

It was also considered in *Seafolly*, where the following artwork was stitched onto Seafolly’s bikini tops:



City Beach also embroidered the same pattern on its bikini tops, and argued that copyright had been lost as a result of the copyright/design overlap. However, the stitched pattern was not a ‘corresponding design’ of the artwork because the bikini top itself was not made in the shape or configuration of that artwork. That is, the embroidered pattern only occupied ‘a part of the garment, which is not itself made in the shape or configuration of the artwork.’¹²

1.2 Works of artistic craftsmanship

To make the matter more complex, none of the copyright/design overlap issues arises if the original work is a ‘work of artistic craftsmanship’. That is, if the original work meets that definition, copyright will not be lost even if a corresponding design of the work is ‘industrially applied’.

The decision as to whether a product will be a ‘work of artistic craftsmanship’ has some interesting elements. For instance:

- the fact that it is made by machine does not prevent it being a work of artistic craftsmanship (although it might make it more difficult to establish). Where a ‘skilled person...uses those skills

to set up and operate a machine which produces an article... it is a manifestation of the creator’s skill with computer-controlled machinery;’¹³

- being aesthetically beautiful is not sufficient to make a product a ‘work of artistic craftsmanship’. The craftsman must demonstrate artistic expression. To do so, he or she has to be ‘unconstrained by functional considerations.’¹⁴ Thus, a hand-carved ‘plug’ for a boat was not a work of artistic craftsmanship because the designer’s primary aim in the design was functional: speed.

That said, a good takeaway message is that a mass-produced garment (especially one with a utilitarian purpose) is less likely to be considered a ‘work of artistic craftsmanship’. However, a wedding dress that has been designed as a ‘one-off’ and is hand-made, is more likely to be a ‘work of artistic craftsmanship’.

2. Protection Through Design Registrations

The designs registration process is intended to provide protection which would otherwise be lost due to the copyright/design overlap. However, as far as fashion designers are concerned, there are a number of significant deficiencies with the design registration process, including that:

- designs have to be registered before the design is first offered for sale anywhere in the world. This means that designs have to be registered before it is known whether they will be successful. Registering an entire season’s designs can be time consuming and costly and may not be needed for designs that are short-lived;

7. *Sommer Allibert (UK) Ltd v Flair Plastics Ltd* [1987] RPC 599 [613].

8. Revised Explanatory Memorandum, *Designs (Consequential Amendments) Bill 2003* (Cth) 4 [16].

9. *Seafolly Pty Limited v Fewstone Pty Ltd* [2014] FCA 321 [485-486].

10. *Polo/Lauren Co LP v Ziliani Holdings Pty Ltd* [2008] FCAFC 195.

11. *Ibid* [58].

12. *Seafolly Pty Limited v Fewstone Pty Ltd* [2014] FCA 321 [482].

13. *Coogi Australia Pty Ltd v Hysport International Pty Ltd* (1998) 86 FCR 154.

14. *Burge v Swarbrick* [2007] HCA 17 [83].

- design protection only lasts for five years (or a total of ten years if renewed) - compared with the *minimum* duration of copyright protection of 70 years; and
- once a design is registered, copyright is lost. This is particularly difficult given the copyright/design overlap uncertainties. Unnecessary design registration (for instance because the original work is a work of artistic craftsmanship or because the garment does not embody a corresponding design) will actually reduce the rights a designer has.

In May 2020, IP Australia stated that it will offer an automatic grace period of 12 months before the priority date. Designers could therefore release a design into the market and then decide within the next 12 months whether to register the design. However, any competitors that released a competing product during that time would have a defence of 'prior use'.¹⁵ Therefore, designers can only stop competitors from using their design after they register it. The Bill to do so has yet to be introduced though, and no time frame has been set.

If introduced, this grace period would alleviate the requirement that designs have to be registered before first offer for sale. Designers will have an opportunity to see how the market reacts to their garments before making the decision to register the underlying design.

3. Copyright Infringement

Assuming that a designer has copyright in respect of a garment and believes that someone else has copied it, there are two relevant questions in any copyright infringement case.

First, has some part of the designer's original work (probably a Drawing or Print) been copied?

Second, are those copied parts a 'substantial part' of the designer's original work?

3.1 Has some part of the original work been copied?

Copyright protects against the act of *reproduction* or *copying*.

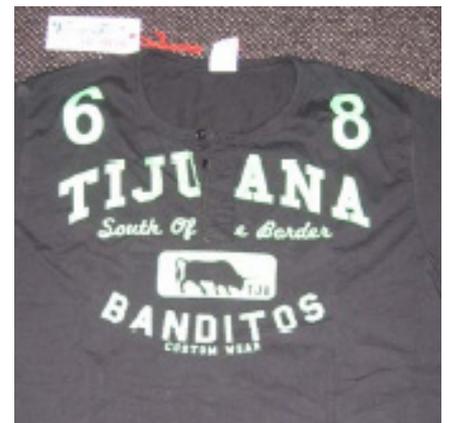
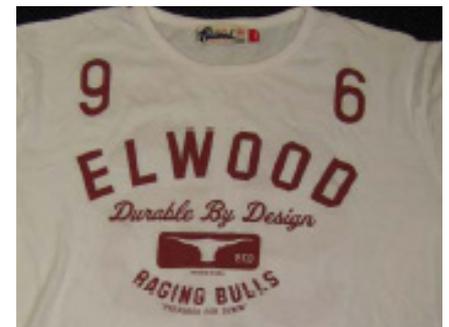
The first thing to consider is whether there has been an act of copying. Any similarities could be a mere coincidence. It is possible for a work to be created that is the same as, or similar to, another work by mere accident and without any copying of the other work. As long as each designer independently created their designs, even if they are identical, copyright will not have been infringed. On the other hand, subconsciously copying another design will still be 'copying' and infringe copyright.¹⁶

Where there is a 'smoking gun' (such as an email directing a designer to copy the original)¹⁷ it will be difficult to argue that no copying occurred. Similarly, it may be difficult when it can be shown that the alleged infringer had access to the original. Alternatively, the similarities between the two may be so significant that it gives rise to a presumption of copying. In *Eagle Homes Pty Ltd v Austec Homes Pty Ltd*,¹⁸ a residential architectural matter, the 'layout and traffic flows and the shapes, proportions and interrelationships of the rooms and other spaces' of the two designs were sufficiently similar to justify inferring that the latter copied the original.

The second thing to consider is what exactly has been copied.

It might be an exact pixel-for-pixel copy which would be an obvious copy. At the other end of the spectrum, the 'look and feel' may have been copied. This concept can

be most intuitively demonstrated by the example of using a thesaurus to replace every word in a paragraph or by translating it into another language. This would almost certainly amount to copyright infringement, notwithstanding that no two words were identical, because the structure, layout and/or meaning are replicated in the new paragraph. In the world of fashion, this might be the elements, colours, arrangement, layout, flow, brush strokes, and/or combinations of them.



For instance, in *Elwood Clothing Pty Ltd v Cotton On Clothing Pty Ltd*,¹⁹ the defendant (whose Print appears on the right) argued they only copied the idea instead of the expression of Elwood's Print on the left. Cotton On's Print copied the '*layout, the selection, arrangement, and style of the various elements*'²⁰ of Elwood's Print and was considered to be a copyright infringement.

15. IP Australia, *Response to public consultation: Implementing accepted recommendations from the Advisory Council on Intellectual Property Review of the Designs System* (2020) 6, 7.

16. *Francis Day & Hunter Ltd & Anor v Bron & Anor* (1963) Ch 587.

17. *Seafolly Pty Limited v Fewstone Pty Ltd* [2014] FCA 321.

18. *Eagle Homes Pty Ltd v Austec Homes Pty Ltd* [1999] FCA 138.

19. *Elwood Clothing Pty Ltd v Cotton On Clothing Pty Ltd* [2008] FCAFC 197.

20. *Ibid* [78].

The third thing to consider is who is responsible.

Ladakh Pty Ltd was upset when Quick Fashion Pty Ltd began selling a dress using a very similar butterfly Print to Ladakh's butterfly Print. Quick Fashion removed the offending dresses from sale, but the matter still ended up in court. Despite the fact that Quick Fashion *agreed* the Print on their dresses infringed Ladakh's Print, Quick Fashion argued that it had innocently purchased fabric with the infringing Print from its Chinese supplier. As there "was no 'smoking gun' with respect to the means by which [Quick Fashion] came into possession of [the infringing Print],"²¹ and Quick Fashion withdrew the dresses from sale once they knew of the infringement, it did not infringe Ladakh's copyright in its butterfly Print.

There may, of course, have been an infringement by the Chinese supplier of Ladakh's copyright but that is much harder to prosecute.

However there was a different outcome in the Spotlight case.²² As in *Ladakh*, Spotlight had received its fabric prints from its supplier and had no reason to doubt the supplier owned the copyright. However, Spotlight continued to offer the infringing products for sale after The Dempsey Group Pty Ltd notified it of its rights. In fact, more than 70% of Spotlight's sales occurred after they had been advised of Dempsey's rights. Ultimately, each sale by Spotlight after it was notified of Dempsey's rights was an infringement of Dempsey's copyright.

Some of Dempsey's and Spotlight's respective Prints and the copied elements are set out below, along with a summary of the findings in that case: (see below).

3.2 Do the copied parts amount to a substantial part of the original?

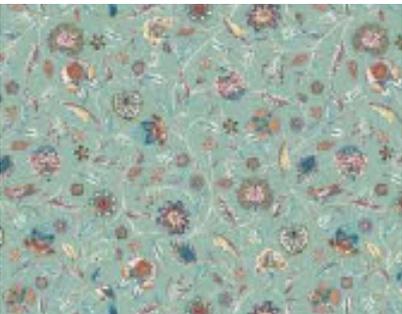
This step takes the elements that have been copied and asks whether

those elements are a 'substantial part' of the original. The question is:

*whether the features which the judge found to have been copied from Ixia formed a substantial part of Ixia as an artistic work ... why, in answering that question, should it be relevant to consider whether [the copy] did or did not look like [the original]?*²⁵

It is not necessary to look at the infringing copy, or even to compare the infringing copy with the original. Instead, *'it is important to consider whether the taken portion is an 'essential' or 'material' part of the [original] work... by considering the originality of the part allegedly taken.'*²⁶

In the *Elwood* case (referred to above), the original Print was almost entirely text based. However, the greatest amount of effort and skill went into the layout instead of the choice of words and numerals. Cotton On's version therefore 'reproduced... a substantial part of [the] design or layout' of the original.²⁷

Dempsey Print	Spotlight Print	Decision
		<p><i>The substance and essence of the [Dempsey] work lies in the combined effect of the artistic elements that comprise it... the combination of features in the design arrangement, background and overall colour scheme, taken as a whole, qualitatively reproduces a substantial part of the "look and feel" of the [Dempsey] artistic work and has sufficient objective similarity with the [Dempsey] artistic work.</i>²³</p>
		<p><i>The artistic quality of the [Dempsey] work consists of the colour, layout and shaping of the designs in the centre and the colour, layout, structure and integers of the border, the cumulative effect of which created the desired "look and feel"... the use of teal as the dominant colour in [Spotlight] product and the similarity of the shaping of the designs in the centre and border design, structure and integers have sufficient objective similarity and qualitatively reproduced, in a material form, the look and feel of the [Dempsey] product.</i>²⁴</p>

21. *Ladakh Pty Ltd v Quick Fashion Pty Ltd* [2012] FCA 389 [12] (Jessup J).
 22. *The Dempsey Group Pty Ltd v Spotlight Pty Ltd* [2018] FCA 2016.
 23. *Ibid* [122].
 24. *Ibid* [117].
 25. *Designers Guild Ltd v Russell Williams (Textiles) Ltd* [2000] UKHL 58 [2420-2421].
 26. *Elwood Clothing Pty Ltd v Cotton On Clothing Pty Ltd* [2008] FCAFC 197 [66].
 27. *Ibid* [74].



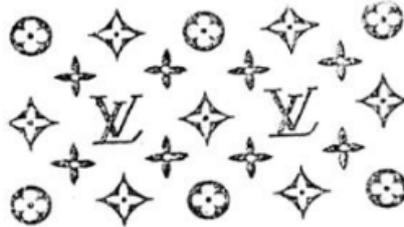
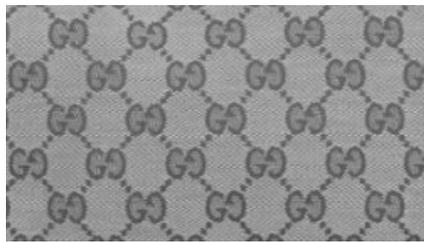
In *Seafolly Pty Limited v Fewstone Pty Ltd*, City Beach admitted copying Seafolly's original Print on the left with its Print on the right. With that question out of the way, the judge considered that the use of 'the same types of flowers... [in] different sizes... depicted in an impressionistic, nonphotographic style... [with] similar colour palettes... shown from a similar perspective' - combinations of which were not 'commonplace or demonstrably derived from other sources'²⁸ - was a reproduction of a substantial part of the Seafolly Print.

In each of these cases, a 'substantial part' was copied even though no single part had been copied 'exactly'.

4. Adding in trade marks

Given the inherent difficulties with relying on copyright and design protection in the fashion industry, designers often turn to trade mark protection, where possible, instead.

This may be achieved by registering the fabric print as a trade mark as Gucci, Louis Vuitton and even David Jones have done.

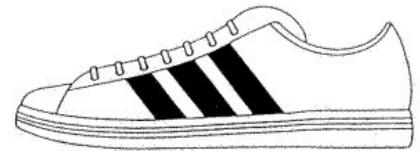


This is why Dapper Dan's garments (above) likely infringed Gucci's trade mark rights.

It might also be achieved by registering a colour, such as Louboutin's famous red sole.



In the case of Adidas, it may be achieved by registering a set of three stripes down the side of their shoe.



The potential overlap here between a 'trade mark' and a 'design' may be best demonstrated by Adidas' litigation for trade mark infringement against Pacific Brands Footwear Pty Ltd.²⁹ Pacific Brands had a series of shoes that incorporated various patterns of four angled stripes on the sides of their shoes. Some of those examples, and Robertson J's decision on infringement are set out on page 7.

There are two key takeaways for fashion designers:

- First, fashion designers should know how they intend to protect their Drawings and Prints before releasing them into the market. Getting this wrong or, worse, ignoring it could mean that they lose all rights in the Drawings or Prints. This can be a complex issue depending on the nature of the original work, the copyright/design overlap, trade marks and even consumer law (although this last aspect hasn't been addressed here).
- Second, fashion designers should keep records of their design process and iterations of their Drawings and Prints. If they ever find themselves the subject of a complaint that they have infringed someone else's rights, these records could be invaluable in demonstrating the independence of their creations.

28. *Seafolly Pty Limited v Fewstone Pty Ltd* [2014] FCA 321 [375].

29. *Adidas AG v Pacific Brands Footwear Pty Ltd* (No 3) [2013] FCA 905.

Adidas examples	Pacific Brands	Decision
		<p>The design of this shoe <i>infringed</i> Adidas' trade mark because of:</p> <p><i>the parallel equidistant stripes of equal width... in a different or contrasting colour to the footwear, running from the lacing area to the instep</i></p>
		<p>Pacific Brands (perhaps rightly) acknowledged that the design of this shoe <i>infringed</i> Adidas' trade mark.</p>
		<p>The design of this shoe <i>infringed</i> Adidas' trade mark because:</p> <p><i>the greater distance between the second and third stripes was very slight in this case and... was only noticeable upon a close inspection...[T]he background design does not remove any contrast between the stripes and the remainder of the shoe.</i></p>
		<p>The design of this shoe <i>did not infringe</i> Adidas' trade mark because there was:</p> <ul style="list-style-type: none"> <i>an obvious slightly wider gap between the second and third stripes</i> <i>the inclusion of panels in the shoe of a similar colour to the stripes (black or close to black), and the stitched-in element of contrasting colour (white) extending behind the stripes</i>
		<p>The design of this shoe <i>did not infringe</i> Adidas' trade mark because:</p> <p><i>first, there are four stripes, being four silver stripes... [and] there is a wider gap between the two central stripes... [T]he result is two groups of two parallel stripes. In any event, there are not three, or four, equidistant stripes</i></p>

CAMLA Young Lawyers Speed Mentoring Event

Reported by **Jess Millner**, Lawyer at MinterEllison



Over two nights in August, CAMLA brought back and moved online the much loved speed mentoring event. Hosted via Zoom by Sainty Law the event was organised by a team from the CAMLA Young Lawyers committee, who in the face of the COVID-19 restrictions wanted to offer young lawyers and law students a meaningful networking and mentoring opportunity.

A fabulous line up of mentors from private practice, the bar and in-house took the time to jump on Zoom and offer invaluable advice and guidance to the mentees. It was speed dating for career tips. There were four rounds of timed two-on-one mentoring sessions held using the Zoom “breakout group” function. The event offered an opportunity for attendees to stay connected with the industry during COVID and it was fantastic to see that the online format meant that there were mentees that signed up from all over Australia.

A big thank you to Sainty Law and all the dedicated mentors who allowed the CAMLA Young Lawyers to pull together this successful online event.



Photos Above: the CAMLA Young Lawyers running the event at speed mentoring “HQ”

Interview: Philippa Bergin-Fisher

Eli Fisher, co-editor, sits down with **Philippa Bergin-Fisher** (of no relation, unless the COVID police are asking why we're chatting) to talk about all things fashion law. Philippa is the General Counsel of one of Australia's most loved fashion brands, Zimmermann. Zimmermann's story is one of legend. Nicky and Simone Zimmermann, two Sydney sisters, began designing garments in their parents' garage and selling them at Paddington markets. Today, Zimmermann is an international fashion powerhouse, and its clothing has been worn by celebrities and supermodels around the world. Zimmermann is truly one of Australia's most impressive global exports in the fashion industry. And yet, it still has the charm of a local family business. To my mind, in a world full of copycats, Zimmermann is a triumphant story of the power of creativity and originality - and a great lesson for CAMLA's IP lawyers.

Eli Fisher: Hi Philippa - on behalf of all of our readers, thank you so much for chatting fashion law with us.

Philippa Bergin-Fisher: You're welcome - thanks for inviting me.

EF: Where have you worked previously and what (apart from it being an obvious dream job) led you to your current role?

PBF: My primary background was in private practice, working in IP. It was varied and interesting, with a highlight being acting for Apple in its enforcement efforts against Samsung. However having spent some time in-house, I wanted a new challenge and to say goodbye to billable hours. I was very fortunate that Zimmermann was looking to create this role at this time, and that it enables me to use my IP enforcement skills within a more generalist role. On top of it being a great role, I can't lie - being surrounded by all these gorgeous clothes is very uplifting!

EF: Your IP background is obviously helpful to such a creative company as Zimmermann. But as General Counsel, I'm sure you get a mix of everything. What is a typical day at the office like for you?

PBF: I've been with Zimmermann for a year, and of course for most of that time we have been in this unusual COVID-19 period. So I'm not sure what typical means right now. Some days I am in the office, some days at home. There is usually a mix of contract work (such as leases, suppliers and contractors), IP enforcement work, liaising with foreign counsel and a wide variety of

other matters (which might be privacy, employment, working with production, retail, HR or design on various matters and initiatives).

EF: What do you consider to be some of the most interesting and challenging aspects of your role? As IP lawyers, do we overestimate the extent to which piracy is a business challenge for fashion designers?

PBF: I find it interesting to learn about the commercial side of the business: the design process, the supply chains, standards on sourcing and sustainability, new ideas being trialled and implemented.

The most challenging part is IP enforcement when it is difficult - when there is a recalcitrant copier, or a web host that does not understand copyright in fabric artwork. Stemming the flow of low-quality counterfeits is also an ongoing challenge.

The problem of piracy feels personal, since I can see the labour and dedication that goes into designing the original fabrics and garments. However for the fashion industry generally, the mass production of low quality counterfeits is a catastrophe from many directions - particularly environmental and human rights - and that is an equally strong reason to tackle piracy.

EF: I know that Zimmermann registers designs for its garments. Do you have thoughts about the design process, and the reforms currently underway?

PBF: Yes, many!



I think most of us agree there is room to improve the Australian design system. It is expensive to register, and the requirement to register prior to public disclosure means that businesses must try to predict which designs are most likely to be copied. This is not easy. To put it in context, Zimmermann has 5 collections a year, with a large number of original designs in each collection. Counterfeiters can start advertising copies for sale within days of a catwalk show, long before garments have even gone into production and months before they are available in stores.

It's great that IP Australia is looking at ways to improve the system. The current proposal of a 12 month grace period is wonderful in theory, as it would give designers a chance to see how a product is received in the market before registering. However the draft prior use defence really negates the benefit of that grace period for many including us, since

it would allow any individual who copies the product during the grace period to continue copying it (even after registration). Given the speed at which copiers move, Australian designers would still need to register prior to public disclosure if they wanted to protect their design. We would love to see the draft prior use defence exclude deliberate copiers.

Long term, we would like to see a way to protect unregistered designs, for example through an unregistered design right system like the United Kingdom.

EF: What do you wish you had known about the legal profession before becoming a lawyer? What are some tips for young lawyers looking to work in this area of law?

PBF: My first tip would be not to feel rushed and not to feel like you must only practise in the area in which you want to specialise. In the long run, I believe having a range of experiences makes us better lawyers even if we do ultimately end up with a deep speciality. Personally I have many examples of when I reluctantly worked on a matter in a different legal area, only for the knowledge I gained to be useful down the track. My other tip would be to try to work with good people who are nurturing and generous in their training of you.

EF: How has COVID-19 affected the industry and your role?

PBF: In both cases, there is much more going on than usual and we need to be flexible. Nobody has

been in this situation before and so there is a lot we're all doing for the first time. The industry was first impacted back in January, and since then we have seen store closures, reopenings and reclosures. Zimmermann has stores in Europe, the USA and of course Australia, and each country and state has its own evolving rules and laws to manage the pandemic. Amidst it all, two beautiful Zimmermann boutiques have opened in Milan Italy and Dallas Texas, such an achievement and show of resilience at this time. Here's to the day that we have the ability to travel again.

EF: Thank you so much for this. We're all very grateful for your insights!

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Catching Trade Mark Law up with the Reality of Online Retail: Pinnacle Runway Pty Limited v Triangl Limited

Rebecca Smith, Lawyer, Gilbert + Tobin, comments on the importance of the Pinnacle Runway v Triangl decision for brands and online retailers.

Described by Murphy J as “*ill advised proceedings...with no clear winner*”, the decision that iconic Australian swimwear brand Triangl did not infringe Pinnacle Runway Pty Ltd’s Australian registered trade mark DELPHINE when it used “Delphine” as a style name for a bikini is, nonetheless an important precedent for brands and online retailers.

There are few Australian trade mark decisions that focus on how established principles apply in the current and evolving retail environment. Rather than buying products predominantly in bricks and mortar stores, purchases are increasingly made online in the context of direct marketing emails and Instagram posts. The Court’s recognition of the reality of online fashion retail is an important development that may inform brand protection strategies in Australia. It makes the appeal filed by Pinnacle late last year one of the top cases to watch in 2020.

The style name was not used “as a trade mark”

As Triangl had used “Delphine”, a name substantially identical to Pinnacle’s registered trade mark DELPHINE, in connection with goods covered by the trade mark registration (swimwear), it was common ground that Triangl would have infringed Pinnacle’s DELPHINE trade mark unless Triangl could show that it had not used “Delphine” as a trade mark – i.e. to distinguish its products from those of other traders.

The Court’s acceptance that women’s names are commonly used as style names in the fashion industry to conveniently distinguish between different styles sold by the same brand – but not as trade marks –

was essential to its conclusion that there was no trade mark use and no infringement.

As well as being an important source of practical guidance in minimising the risks of trade mark infringement in fashion and other industries that use non-distinctive style names in this way, this is a good example of the Court recognising a specific industry practice with the benefit of the right evidence (with the opinion of Triangl’s fashion and cosmetics industry-focused expert being preferred).

The finding that evidence from the internet archive The Wayback Machine of third party websites was admissible for this purpose is a key authority for trade mark cases, given other recent adverse decisions in this area and the importance of The Wayback Machine evidence in many brand disputes.

Recognition of the online retail environment

Underlying the finding that there was no trade mark use, and no trade mark infringement, is recognition by the Court of how consumers actually understand and interact with e-commerce platforms. Part of the reasoning supporting the admissibility of The Wayback Machine evidence was the recognition that a product listing on an online store is much more than just an ad – it “*sets out the essential terms of the proposed transaction, which will be completed if the consumer clicks on another button on the website and provides his or her credit card details*”. For that reason, the Court found that the product listing page should be treated as a business record for the purposes of the business records exception to the hearsay rule in the *Evidence Act*.

Perhaps even more importantly, Murphy J’s reasoning on the trade mark infringement issue focused on how consumers would perceive the screenshots of the Triangl website where the “Delphine” bikinis were offered for sale by Triangl (which has primarily been an online retailer since around 2013). The features of the website – the dominant TRIANGL mark, a TRIANGL GIRLS button, and the domain name <australia.triangl.com> were noted, in contrast to the use of DELPHINE in the same font size and colour as the names given to the different colour and floral patterns available in the “Delphine” bikini style. Murphy J considered that this was “*not suggestive of a mark rising to the significance of distinguishing the commercial origin of the goods*”.

The Court also found that the overall “*context or setting in which Triangl used the name DELPHINE on its website is of critical importance*”, looking to the content of the home page featuring the TRIANGL mark, as well as the “View All” button and the “New Arrivals” button which would lead consumers to scroll through a range of bikini styles, each with a style name, making it unlikely that DELPHINE would be perceived as a badge of origin. In relation to the use of DELPHINE on direct email marketing, the fact it was sent only to subscribers to Triangl’s email list was considered by the judge to “*increase the improbability that they [consumers] would perceive that DELPHINE was being used as a trade mark or as indicating the trade source of the swimwear*”.

While these points may be obvious to e-commerce businesses and consumers, the subtlety of how consumers interact with and interpret the content of online retail

platforms has not yet been widely recognised by Australian Courts in the trade mark context. The potential application of this type of reasoning to all trade mark disputes involving the internet is significant and, subject to any different approach the Full Court may take, indicates an important evolution of Australian trade mark law.

Instagram and Facebook advertising

An interesting take away from the decision in light of the increasing importance of Instagram as a click-through sales platform is that Pinnacle may have had better prospects of establishing trade mark infringement

if it had directly relied on the 12 Instagram and 7 Facebook posts for the “Delphine” bikini, rather than relying on them simply as context for how consumers would perceive the use of DELPHINE on the Triangl website and direct marketing emails.

These posts described the bikini as “DELPHINE” and “The DELPHINE”, and referred to the model wearing “Fiore Nero” and “Fiore Gallo” (colours in which the “Delphine” style was available). While probably not enough to change the overall result of the case on their own, this comes much closer to advertising DELPHINE as a sub-brand of TRIANGL. It indicates an important

area to watch for fashion and other industries using style names when advertising products on social media, depending on whether they wish to establish reputation in a style name as a sub-brand, or avoid inadvertently infringing a third party trade mark with a style name that is intended to be merely descriptive.

Although the decision appears encouraging for businesses wishing to avoid trade mark infringement with style names, it is important to remember that Pinnacle did not have any significant reputation in the DELPHINE brand, and if it did, the outcome for Triangl may have been different.

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City Beach's Folly - Taking a Substantial Part of Seafolly's Artwork

Case note: *Seafolly Pty Limited v Fewstone Pty Ltd* [2014] FCA 321 (*Seafolly v City Beach*)

Amy Campbell, Senior Associate, HWL Ebsworth, revisits the *Seafolly* decision for our special fashion edition.

Introduction

Seafolly Pty Limited (**Seafolly**), a well-known Australian designer, manufacturer, wholesaler and retailer of swimwear and beachwear, instituted proceedings against Fewstone Pty Ltd trading as City Beach Australia (**City Beach**), also a designer, manufacturer and well-known retailer of swimwear and beachwear. Seafolly claimed that City Beach was for infringing Seafolly's copyright in three artistic works from its 2010 summer range.

Background

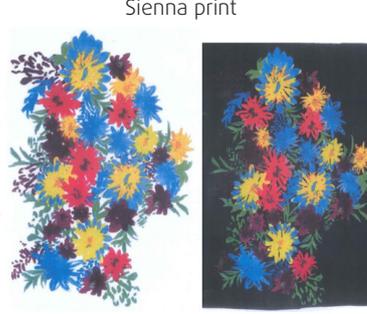
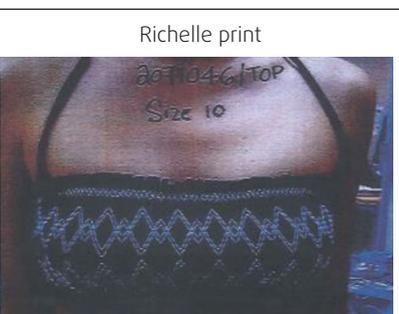
Seafolly engaged design company Longina Phillips Designs Pty Ltd (**Longina**) to create artwork for its 2010 summer range. Seafolly's instructions included photos of 1950s swimsuit designs for "inspiration and direction." Longina's designs used "creative skills to paint roses inspired by the photographs". Through a deed of assignment, Seafolly purchased from Longina the artwork set out in column 1 in the table below. Fabrics printed with the artwork were subsequently used to manufacture a number of different swimwear garments for the 2010 summer range.

City Beach also engaged a design company, 2Chillies Pty Ltd (**2Chillies**), to assist in designing prints and shapes for garments to be sold by City Beach. Under its engagement with 2Chillies for its 2011 range, City Beach sent photographs of Seafolly prints as "references"¹, "inspiration"² and "direction"³. In City Beach's instructions to 2Chillies, it referred to one bikini design as a "Seafolly knock off"⁴ and rejected designs created

by 2Chillies intended to remedy the similarities between the Seafolly artwork and the designs for City Beach.⁵ One 2Chillies witness gave evidence that, "we did try to make it more different, but it did keep getting changed close back to the Seafolly one ... [we were trying to make it] more

original."⁶ City Beach also sent a one-piece Seafolly Seniorita swimsuit (see the third row in column 1 of the table below) to a manufacturer in China to be "as per the" original.⁷

The examples of the artwork at issue are set out in the table below:

"Seafolly Artwork"	"City Beach Prints"
<p>English Rose artwork</p> 	<p>Rosette print</p> 
<p>Covent Garden artwork</p> 	<p>Sienna print</p> 
<p>Seniorita artwork</p> 	<p>Richelle print</p> 

1 *Seafolly v City Beach* at [108], [110].
 2 *Seafolly v City Beach* at [97], [101], [117].
 3 *Seafolly v City Beach* at [115].
 4 *Seafolly v City Beach* at [154].
 5 *Seafolly v City Beach* at [170].
 6 *Seafolly v City Beach* at [139].
 7 *Seafolly v City Beach* at [206]-[207].

Seafolly sold:

- 63,267 units of the English Rose garments (comprising 48,750 units sold wholesale, 10,342 units sold wholesale overseas, 2,755 units sold retail from its concept stores and 1,420 units sold retail from its direct factory outlet).
- 30,059 units of the Covent Garden garments (comprising 21,123 units sold wholesale, 6,430 units sold wholesale overseas, 1,025 units sold retail from its concept stores and 1,481 units sold retail from its direct factory outlet).
- 3,916 units of the Senorita garments (comprising 3,123 units sold wholesale in Australia, 101 units sold wholesale overseas, 16 units sold retail from its concept stores and 676 units sold retail from its direct factory outlet stores).

City Beach sold:

- 8,155 units of the Rosette garments;
- 2,388 units of Sienna garments; and
- 749 units of the Richelle garments.

Key issues at trial

Seafolly made the following submissions:

- a substantial part of each of its copyright works was reproduced without its licence in a material form in the corresponding print or embroidery used to manufacture the City Beach garments, contrary to sections 14, 31(1)(b)(i) and 36 of the *Copyright Act 1968* (Cth) (**Copyright Act**);⁸

- City Beach’s reproduction of a substantial part of each of the Seafolly Artworks was not the result of independent creation but was due to copying of those works from Seafolly garments, which City Beach conceded it had purchased and used to instruct its designers;⁹ and
- City Beach infringed Seafolly’s copyright pursuant to ss 14, 37 and 38 of the Copyright Act by directing the manufacture in China of garments imprinted with or incorporating the Seafolly Artworks, which City Beach imported and sold in Australia with the actual or constructive knowledge that the making of the article would have constituted an infringement of Seafolly’s copyright had it been made in Australia by the importer.¹⁰

Seafolly outlined in its submissions that there were 12 features of the English Rose and Covent Garden artworks reproduced in the respective City Beach prints, including the use of different sized flowers and the use of impressionistic and non-pictorial flowers. The Senorita artwork comprised 5 features that were reproduced.¹¹ Seafolly submitted that these reproductions amounted to a substantial part of the original Seafolly Artworks.

City Beach did not deny that the Seafolly Artworks constituted an artistic work within the meaning of s 10(a) of the Copyright Act. It also did not deny the subsistence, or Seafolly’s ownership, of the copyright of the English Rose and Covent Garden artworks.¹² It did, however, contend that the Senorita artwork was not original

in that it did not originate with Seafolly’s employees or designers and was a common place design. If that submission failed and it was found that copyright subsisted in the Senorita artwork, City Beach conceded that Seafolly would also own the copyright in this work.¹³ City Beach also admitted that it manufactured, imported for sale, sold or, by way of trade, offered for sale or exhibited, the garments bearing the City Beach prints, and authorised that conduct.¹⁴

Nevertheless, City Beach denied that it had infringed Seafolly’s copyright and submitted that:

- there was not “sufficient objective similarity” between the Seafolly Artworks and the City Beach Prints;¹⁵
- any parts taken from the Seafolly Artworks were not original so were not substantial or protected. It submitted that Seafolly Artworks:

“were, in themselves, unoriginal, commonplace and derived from the “prior art” which Seafolly itself consulted and used for inspiration in accordance with the routine practice of the fashion industry”,¹⁶

In the alternative, City Beach submitted that it had, at most, taken the unprotected idea or underlying concept of the Seafolly Artworks but had not taken their form of expression, because:

- the exclusive rights of the owner of the copyright in an artistic work do not (in contrast to copyright in literary, dramatic and musical works) include the right of adaptation so an artistic work requires an exact

⁸ *Seafolly v City Beach* at [3].

⁹ *Seafolly v City Beach* at [4].

¹⁰ *Seafolly v City Beach* at [5].

¹¹ *Seafolly v City Beach* at [15].

¹² *Seafolly v City Beach* at [222].

¹³ *Seafolly v City Beach* at [18].

¹⁴ *Seafolly v City Beach* at [19].

¹⁵ *Seafolly v City Beach* at [20].

¹⁶ *Seafolly v City Beach* at [21].

or faithful reproduction of a substantial part of an original artistic work to infringe copyright (**Exact Reproduction argument**);¹⁷ and

- in respect of the *Senorita* artwork, the smocking embroidery used in the garment was a “corresponding design” within the meaning of s 74 of the Copyright Act.¹⁸

City Beach ultimately denied that it ought to have reasonably known that Seafolly was the owner of copyright in the *Seafolly Artworks* and that City Beach’s acts of commercial exploitation of its garments, if done in Australia, would have been an infringement of Seafolly’s copyright in the *Seafolly Artworks*.¹⁹

Decision at trial

Justice Dodds-Streeton considered the copyright protection for “adaptations” of artistic works, what constitutes a “substantial part” of an original work and the application of the “design defence” as it related to the *Senorita* artwork.

In making findings in respect of each of these points, Dodds-Streeton J concluded that:

- City Beach infringed Seafolly’s copyright in the *English Rose* artwork because the *Rosette* print reproduced in a material form a substantial part of the *English Rose* artwork and there was an objective similarity between the two works.
- City Beach infringed Seafolly’s copyright in the *Covent Garden* artwork because the *Sienna* print

reproduced in a material form a substantial part of the *Covent Garden* artwork and there was an objective similarity between the two works.

- Seafolly’s *Senorita* artwork constituted an original artistic work which was the product of labour, skill and effort, together with a process of trial and error, on the part of the Seafolly designers, which was reflected in the material expression of the work.²⁰
- City Beach infringed Seafolly’s copyright in the *Senorita* artwork because the *Richelle* print reproduced in a material form a substantial part of the *Senorita* artwork and the two works were “manifestly similar.”²¹

Her Honour was satisfied that on the evidence that City Beach had infringed Seafolly’s copyright directly pursuant to ss 31(1)(b)(i) and indirectly by importation and sale pursuant to ss 36, 37 and 38 of the Copyright Act.

Her Honour rejected City Beach’s arguments raised in the relation to the lack of originality - copyright does not require “originality” in the form of artistic merit, complexity, excellence, distinction,²² novelty or inventiveness²³ but “originality” instead forms ‘a pre-condition of its subsistence and is also relevant to infringement, as it informs the concept of a “substantial part”’²⁴.

Her Honour’s approach to reaching these conclusions was adopted from *Milpurrurru v Indofurn Pty Ltd* (1994) 54 FCR 240; 130 ALR 659

(*Milpurrurru*) - the first question is whether there has been copying, and then secondly whether the copying is substantial. Justice Dodds-Streeton’s answers to these questions are considered below.

Adaptations

Her Honour rejected the “exact reproduction” argument posited by City Beach, stating that it was contrary to well-established principles and was made without reference to specific authority.²⁵ She found that while “adaptation” bears very particularised meanings in the Copyright Act which are not applicable to artistic works, “*it does not follow that because the exclusive rights of the owner of copyright in an artistic work do not include the right to make an adaptation, variations or modifications falling short of an exact or very close copy cannot infringe.*”²⁶ Her Honour found that if copyright in artistic works was limited to exact or faithful reproduction the scope and value of the copyright in such works would be “unduly narrow.”²⁷

Her Honour undertook the “relevant inquiry” in respect of artistic works: “*not whether the disputed [alleged reproductions] are an adaptation but whether [they] reproduce a substantial part of one of the artworks.*”²⁸

Substantial part

Her Honour acknowledged that ‘while substantiality is qualitative rather than quantitative, the reproduction of a very large part of the copyright work might take on “qualitative mantle”. A quantitatively small part may

¹⁷ *Seafolly v City Beach* at [23], [224].

¹⁸ *Seafolly v City Beach* at [24].

¹⁹ *Seafolly v City Beach* at [25].

²⁰ *Seafolly v City Beach* at [415].

²¹ *Seafolly v City Beach* at [417].

²² *Seafolly v City Beach* at [237].

²³ *Seafolly v City Beach* at [238].

²⁴ *Seafolly v City Beach* at [238].

²⁵ *Seafolly v City Beach* at [225].

²⁶ *Seafolly v City Beach* at [228].

²⁷ *Seafolly v City Beach* at [229].

²⁸ *Seafolly v City Beach* at [229] citing *Milpurrurru* at [259].

amount to a substantial part of the copyright work if it constitutes a material or vital element, which is of value or importance to the copyright work as a whole.²⁹

The factors relevant to distinguishing a substantial part of copyright work from a merely insubstantial part or from an idea or concept shift according to the subject matter in question but, her Honour observed that originality is consistently recognised as important to substantiality. The High Court in *IceTV Pty Ltd v Nine Network Australia Pty Ltd* (2009) 239 CLR 458, [2009] HCA 14 emphasised that if the originality of what was taken did not manifest itself in a form of expression, it would not constitute a substantial part of the work.³⁰ By reference to Australian and international cases, her Honour also considered the dichotomy between idea and form of expression and repeated the established principle that it is not necessary for infringing work to look like the original copyright work but requires a consideration of that which is essential or material, identified by the elements that made the copyright work an original artistic work.³¹

Consistent with these principles, her Honour noted that Seafolly's allegations were that the City Beach Prints reproduced in a material form a substantial part of the corresponding Seafolly Artworks which, as discussed above, can be a feature or combination of features abstracted from the work.³² To determine whether this occurred, it was also necessary to determine whether the City Beach Prints were derived or copied from the corresponding Seafolly Artwork and whether there was objective similarity between the respective two works.

Experts provided evidence of the similarities – which included their background and motifs, the motif style, the scale of the motifs, the way in which the motifs were rendered and the balance between the motifs and base colour. For the Senorita artwork and Richelle print, regard was had to the diamond patterns and diagonal lines of the smocking embroidery. With consideration to the elements of the designs, her Honour found that elements and features and combination of each taken from the Seafolly Artwork cumulatively comprised a substantial part of each work in the relevant qualitative sense and they also comprised a quantitatively significant part of the work.

Based on City Beach's conduct of providing images and samples of garments with the Seafolly Artwork to 2Chillies and its various instructions to 2Chillies and a manufacturer in China, including City Beach's disregard of efforts made by 2Chillies to reduce similarities, her Honour found that the City Beach's use of the Seafolly work was deliberate and the City Beach Prints were clearly derived or copied from the corresponding Seafolly Artwork.

Design defence

City Beach alleged that the Senorita design applied to the fabric used to make the Senorita garments was a "corresponding design" for the purposes of s 74(1) of the Copyright Act and so reproduction of that work did not infringe Seafolly's copyright in it. City Beach further submitted that the design and the fabric never existed independently so was argued to be "embodied" in the product.³³

Seafolly rejected City Beach's defence and submitted that:

- (a) the Senorita artwork was two dimensional, showing the placement of embroidery and depicting features of pattern and ornamentation, rather than visual features of shape and configuration; and
- (b) the Senorita artwork was not "embodied" in the fabric used to manufacture the Senorita garments. Rather, the embroidery was applied to the garments.³⁴

Her Honour considered the complex legal and policy landscape that informed the design and copyright overlap with regard to previous legislation, legal scholarship and *Polo/Lauren Co LP v Ziliani Holdings Pty Ltd* [2008] FCAFC 195. She concluded that the relevant law indicates that:

...it is the features of shape or configuration of an artwork (not a label on which the artwork is reproduced) that must be relevantly embodied in a product, which will occur when the product (in the present case, a garment) is made in the shape or configuration of the artwork.

*Unless that requirement is satisfied, the defence based on a corresponding design will not be made out even if the design is placed on or in the article in a three dimensional way, as embodiment and three dimensionality are both necessary conditions.*³⁵

On this assessment, her Honour ultimately found that the Senorita garments were not made in the shape or configuration of the Senorita artwork so the Senorita diamond pattern embroidery design was not "embodied in" the garments. The Senorita artwork was instead

29 *Seafolly v City Beach* at [242].

30 *Seafolly v City Beach* at [249].

31 *Seafolly v City Beach* at [262], [262].

32 *Seafolly v City Beach* at [287].

33 *Seafolly v City Beach* at [430].

34 *Seafolly v City Beach* at [431].

35 *Seafolly v City Beach* at [470]-[471].

considered a constituent element, not a “corresponding design”. City Beach’s defence therefore failed.

Damages

Seafolly sought remedies including compensatory damages (\$240,999.18), damages for damage to its reputation (\$70,000), additional damages (\$300,000), conversion damages (\$211,753.34), declarations, injunctions and orders for delivery up all remaining stock of the respondent’s infringing garments.

The award of damages for infringement of intellectual property rights is intended “to compensate for loss or injury” suffered as a result of the respondent’s infringement, rather than to punish the defendant.³⁶ Nevertheless, the Full Federal Court has observed that such damages should be assessed liberally.³⁷

To determine the appropriate damages, her Honour applied the five steps established in *Norm Engineering v Digga* and endorsed in *Elwood v Cotton*, being to:

- (1) examine the number of sales made by the Respondent;
- (2) assume that the Respondent was trying to capture sales from the Applicant, the market leader;
- (3) assume that the number of sales made by the Respondent is equal to the number of sales lost by the Applicant;
- (4) discount the number in (3) to reflect the fact that not all sales made by the Respondent can be considered sales lost by the Applicant; and
- (5) apply any further discount necessary in the circumstances of the case

Based on this assessment and the evidence provided by each party in respect of sales and prices, and the

nature of the market, parties, supply chain and the goods sold, the court ordered that City Beach pay Seafolly damages in the sum of \$250,333.06, broken down as follows:

- \$80,333.06 in damages for lost profit, at a 75% discount due to the different target markets and price point of the garments;
- \$20,000 in reputational damage in consideration of a modest impact on Seafolly’s reputation;
- \$150,000 in additional damages due to City Beach’s continued sale of infringing garments after notice from Seafolly, the evasiveness of some of City Beach’s lay witnesses and the benefit derived by City Beach from the sales of the infringing garments; and
- nil for conversion damages, since the court considered that quantum of other damages would sufficiently compensate Seafolly.

Comment

Adaptation of artistic works – reproduction of a substantial part

Seafolly v City Beach clarified that the rights of owners of artistic works will be infringed when a substantial part of those works is reproduced – the reproduction does not need to be exact or faithful. The Federal Court looked beyond the “look and feel” and obvious visual similarities and differences of the relevant artworks to make a qualitative assessment about the value and extent of what had been taken from the original work. City Beach’s conduct provides a reminder that inspiration must not lead to imitation.

Originality

The case also serves to distinguish between originality in the context of authorship and originality in the context of the subsistence of copyright. Despite the relevance of Meryl Streep’s piercing and

iconic assessment in the *Devil Wear Prada* (“Florals? For spring? Ground-breaking”), Justice Dodds-Streton was satisfied that, based on the skills, labour and work in the creation of the Seafolly Artworks, these works were sufficiently original and not commonplace. Her Honour was also satisfied that City Beach had taken a substantial part of the features that made the Seafolly Artworks original.

Damages

This case also provides a useful example of how the Federal Court will approach the calculation of damages for copyright infringement under the various heads of damage for which a copyright infringer may be liable. The quantum of damages in this case might be expected also to act as a deterrent within the fashion industry in respect of similar infringing conduct.

³⁶ See authorities cited in *Seafolly v City Beach* at [506]

³⁷ *Seafolly v City Beach* at [506] citing *Bailey v Namol Pty Limited* (1994) 53 FCR 102 at [111].

Interview: Marina Mitrevski

Isabella Street, Legal and Business Affairs at Sony Music Entertainment, chats with **Marina Mitrevski**, Executive, General Counsel & Company Secretary at THE ICONIC.

Isabella Street: You've had such an interesting career both here and abroad with some fantastic experience particularly through Axiom, which led to your first role in the fashion industry at ASOS.com. How has your experience both here and overseas prepared you for your current role as Executive, General Counsel & Company Secretary of Australia's best online fashion store, THE ICONIC?

Marina Mitrevski: Thank you - I love being an in-house lawyer and have worked predominantly in-house my entire career in Australia, United Kingdom, United Arab Emirates and Sweden. Whilst there is no real single moment that stands out above others, I'd have to say that a pivotal moment in my career was when I joined Axiom in London who are the MEGA-disruptors and trailblazers of NewLaw turning the business of law on its head! As a 6 year ppe lawyer I decided to make "the move" to London and joined Axiom where over the course of the following 6 years, I was provided with unparalleled opportunities to work for some of the world's most incredible organisations and clients - such as the likes of ASOS.com through to a Middle East sovereign office too. I was fortunate to be placed on long-term secondments where I was fully integrated into client sites within the respective Legal teams and was responsible for leading and delivering the full suite of legal advisory services, and also a few legal transformation projects too. Throughout my time at Axiom, I was exposed to a new value proposition for both lawyers and clients alike which allowed me to think laterally, challenge the status quo, and explore all facets of delivering best-in-class in-house legal services. This experience cemented for me that lawyers are more than strategic legal and

business advisors, they are also business enablers, who can help guide and transform a business. I'm now in the unique and privileged position to have one of the best legal roles in Australia and New Zealand as General Counsel & Company Secretary at THE ICONIC - a dynamic intersection where my love for law, business, fashion and technology collide!

IS: What does an average day in the GC's shoes involve at THE ICONIC?

MM: At THE ICONIC, I am responsible for leading a team charged with advising on, and delivering, a range of Legal, Governance, Risk and Compliance initiatives across all areas of the organisation. Together with my team, we are committed to providing best-in-class legal services for all ICONITES by partnering and collaborating cross-functionally with all business units. Our Legal team has been on a journey to challenge and set the benchmark for in-house legal services aligned to THE ICONIC's vision of "LIBERATION". They embody core ICONIC values by delivering key value across all business areas including by demonstrating: "We Are True to Our Customers", "People Are Our Greatest Asset", "Stronger Together", "We Get Things Done", "We Dream Big", "Growth Is Our Mindset" and "We All Make A Difference".

In terms of what my day looks like - for me, literally no two days are ever the same! The only time I am ever a creature of habit is how I start my day! I often start each morning with a walk or else with a tea or mocha over what I call 'set-up' time. This non-negotiable "quiet" time is diarised each morning so I can set myself up for the day - I scroll through emails (check to see what's

come in overnight from brands abroad or our parent company Global Fashion Group in London) and I plan for the day ahead. Due to the fast paced nature of our business, this time allows me to prioritise and re-prioritise work for the remainder of the day, and also allow myself to check in with my team. After this I'm generally in a variety of Executive team meetings and Project meetings we have on-the-go across all areas of THE ICONIC spanning Category Management, Operations, Tech, Marketing, Finance, Growth & Development and People & Culture.

I'm also often working with my team on initiatives we can adopt to ensure that we are able to provide seamless and inspiring experiences, not only for our customers, but also for our colleagues. We are often exploring how technology can make the lives of our employees better, and we're constantly innovating and implementing new processes through the use of technology e.g. the set-up of online legal learning, drop-in clinics, electronic signatures, workflow management and contract management systems. By improving the productivity of our Legal team, we enable the business to continue to grow and move at pace, which is what THE ICONIC is all about #wegetthingsdone!

IS: What sort of legal issues do you deal with?

MM: As General Counsel & Company Secretary, I deal with a whole host of strategic contracts with a focus on commercial contracts negotiations on supplier trading agreements, as well as general advisory on a whole range of e-commerce, privacy, social media, consumer law, competition law, trade marks, litigation, property, risk management, compliance and governance matters. In addition, I

advise on go-to-market strategies for new business models, brand development for private labels we manufacture, marketing campaigns, customer competitions, collaborations and technology development. I am also responsible for leading the compliance, regulatory and secretariat activities of the business.

IS: What do you love most about working in the fashion industry and what do you find the most challenging?

MM: I love fashion and I love tech for so many reasons - although predominantly it is because both offer you the freedom of self-expression, the freedom of discovery and the freedom to choose. At THE ICONIC we are all about LIBERATION and quite honestly, no two days are ever the same which is LIBERATING in itself! Whether I'm negotiating an agreement with local or international supplier/brand/designer; manufacturing agreements for private labels; marketing initiatives for runways and campaigns; engineering agreements for the build or expansion of a site or an automation platform - the work that I do is always so diverse! In terms of what's most challenging? Well I'd have to say logging off at night. When you love what you do, and it starts to feel like a hobby as opposed to work, it's sometimes hard to call it a day!

IS: What recommendations do you have for young lawyers hoping to move into this space? What sort of legal background is useful for a role like yours?

MM: First and foremost, in order to be a successful in-house lawyer it is crucial to have a curious mind! Roll your sleeves up. Immerse yourself in the work and get ready to serve your colleagues and the company. Learn the business from the ground up. Say YES to every opportunity presented your way. Assume nothing! Expect



the unexpected! Constantly approach each matter with a willingness to learn - you might need to unlearn, re-learn but in most cases just learn! Don't be afraid to speak up, have an opinion and share your views. Ask for feedback. Listen to your team and colleagues. Get a coach or a mentor, and don't forget to give back in some way to the world, or else simply by mentoring others too! And most

importantly - choose an area of law, an industry or a business that you have a deep interest in so that your work does not feel like a chore! Have fun. And breathe!

IS: I imagine COVID-19 has upset your supply chains. Can you give us some insight into the types of problems the business has had to face during this difficult time?

MM: THE ICONIC is part of Global Fashion Group and one of our regional counterparts operates in South-East Asia, so we were in a fortunate position to understand the impact that COVID-19 could potentially bring globally and in Australia well ahead of time. As a result, we established our COVID-19 Task Force in February with this cross-functional team tasked with defining how we would approach and manage COVID-19 when it reached Australia. The most important thing for us was protecting the health, safety and wellbeing of our people. Although we're an online business and have been fortunate to continue operations during Australia's lockdown period at varying levels, we still had the complexities of managing both our people working from home, and those who continued to work on site. We immediately instilled the highest standards of health and safety for those on site including mandatory temperature checks for any employee and third party entering the site, health declaration forms, increased cleaning measures, protective face masks, hand sanitiser and of course, physical distancing. Additionally, where we work with models for production, our hair and makeup artists and stylists have helped direct our models to complete simple looks themselves at a safe distance ensuring a contactless environment. For our people working from home, we prioritised access to learning and wellbeing resources, increased communication from our Executive team and Leaders through additional Zoom Stand Up meetings, along with engaging our team through group activities such as cooking classes and workouts to name a few.

While we had to make some difficult decisions regarding our brand partners and supply chain in the short-term, we remained in close contact with our partners throughout COVID-19 to manage the impact. During this time, we accelerated a number of initiatives that will see us launch new business

models and new categories to help grow both our business, and our brand partner's business, as we head into the new decade.

IS: I have certainly been indulging in some online shopping since isolation with trackies, jumpers and exercise gear being my main purchases of late. Has the #StayHome selection of products been a success for the business?

MM: During this period where many of us have spent an increased amount of time at home, we have seen a pivot in the style choices of our customers. We've witnessed our ICONIC customers prioritise comfort, with key in-demand categories over past months including loungewear, sleepwear, sportswear, as well as items such as slippers, sweats, performance sneakers and at-home sport go-tos. To help make it easier for our customers to access a curated at-home assortment we introduced a dedicated #StayHome navigation bar on our homepage. Whether it's sleepwear, puzzles, or workout equipment, this navigation filter has proved incredibly popular with our customers, helping them easily uncover relevant at-home products with ease. Most recently, in line with the latest restriction measures across Victoria, and the wearing of non-medical masks encouraged in other states, we've witnessed booming demand across our assortment of face masks.

IS: I was very pleased to hear THE ICONIC is transitioning its delivery satchels to 100% recycled materials. You started working at THE ICONIC in 2018, the same time THE ICONIC became a signatory to the Australian Packaging Convention. Was this a coincidence or were you a driver behind the company making this decision?

MM: Continued progress towards reducing the environmental impacts of both our internal and external business operations has

always been a key priority value for THE ICONIC. As part of our wider sustainability journey and commitment to more sustainable packaging solutions across the thousands of orders we deliver each year, we're incredibly proud to be the first major ANZ retailer to introduce delivery satchels made from 100% post-consumer recycled content. This means that the plastic for each satchel is sourced mostly from reused LDPE from household collections. We're also proud to have our satchels accredited under the Good Environmental Choice Australia's (GECA) Recycled Products Standard, which means each satchel has been independently assessed to verify its recycled content and ensures that the production process meets strict environmental, human health and ethical impact criteria. We also encourage all customers to recycle their ICONIC satchel (and all other soft plastics from home) by dropping it off to a REDcycle bin, which can be found at major supermarkets.

IS: What impact has this decision had on stakeholders and the internal policies, operations, and marketing of the company?

MM: Introducing our new satchels has had an incredible impact on our people and stakeholders. While the project itself was intensive to ensure we chose the most effective packaging solution, implementing this change is an inherent part of who we are as a business with sustainability key to our inherent values and what we know is the right thing to do. We believe in progress over perfection at THE ICONIC, and although we appreciate that we still have a long way to go on our sustainability journey, this milestone is another important step in making positive progress across our long-term environmental responsibility.

IS: Are there any other self-regulatory standards or commitments, which you deal with on a regular basis?

MM: In terms of self-regulatory standards or commitments, we work incredibly hard to keep up with the targets outlined in our inaugural Annual Progress Report, which we released in November 2019. You can find this on our website.

IS: The fashion industry has received much criticism not only for its detrimental impact on the environment and animal welfare, but also due to the lack of transparency around working conditions and wages. THE ICONIC recently registered 'THE ICONIC Considered' as a trade mark for its self-rated selection of fashion products that meet certain sustainable and ethical credentials. How important is this new initiative for the business and the future of the industry as a whole?

MM: We created THE ICONIC Considered in April 2019 as a way to help customers shop by the values that mean the most to them personally. Sustainability is a personal choice and means different things to different people – our Considered edit highlights products with at least one of 30 defined sustainability credentials, in five categories, allowing you to shop by what's important to you. Concerned about climate change? Shop Eco-Production. Do you prioritise animal welfare? Shop Animal Friendly. Want to have a positive impact on society when you shop? Shop Community Engagement. We have a responsibility as a retailer for better managing our own impact, while helping enable customers to make choices based on their values through accessibility and a wide assortment.

THE ICONIC Considered and our Sustainability and Ethical Sourcing strategy at its core is driven by a recognition of the moral imperative that our industry must urgently take significant action to better manage its social and environmental impacts. This is why in November 2019, we released our inaugural Annual Progress Report, which

details our progress (and our shortfalls), outlining our 2022 targets across Ethical Sourcing, Environment, Community and Diversity, Inclusion and Body-Positivity. We know these topics matter to our customers and it matters to us as humans who work for THE ICONIC. For us we want to drive progress in our own operations and at the same time, encourage our wider industry to reflect and be inspired to make changes in theirs too. You can read more about these targets and our sustainability journey, here.

IS: The fashion industry has also been scrutinised for its lack of diversity, in particular the size, physical ability, gender and race of models used in photo shoots. Have you noticed a shift in representation generally within the industry?

MM: There's a lot that the fashion industry could be doing to make progress across many areas, which is why we at THE ICONIC are so committed to making progress ourselves in order to inspire change. In our business, we are 'all about the people', so diversity, inclusion and celebrating body-positivity is an innate part of our DNA, and core to our purpose of 'Liberation'. For the past three years this has manifested most prominently at our annual Summer Show, where we celebrate the first day of summer with an incredibly uplifting show featuring a diverse representation of models across shapes, sizes, backgrounds, ages and orientations. We're so proud of this production each year, which has been dubbed by key media outlets as 'the world's most body-positive runway'. This representation is further reflected across the models that appear day-to-day in our ecommerce catalogue, to our diverse and inclusive internal team, made up of almost 1,000 people from 43 nationalities. We know there's still a huge amount of work we can do in this space and we're excited for a number of initiatives we have in the pipeline to continue building on this progress to date.

IS: As a GC, you are seen as a strategic advisor who has to balance business, legal and ethical considerations. I imagine this is a difficult juggling act! How do you manage this role and what tips would you give other GCs or aspiring GCs?

MM: It certainly is a juggling act, however, having a strong ethical and moral compass is integral to wading through various scenarios that lawyers from all industries across the world often encounter on a daily basis. Ask yourself the simple questions: Will this decision headline the news tomorrow? Is there a universal rule that applies here, or another way to approach this? Will the proposed course of action yield a good result? What would happen if everybody did this? How will this affect the reputation of my organisation, and my character as a lawyer?

In terms of tips for aspiring GCs, I'd encourage you to go back to basics and revisit the foundations of your team and organisation. Do you have adequate and appropriate policies, procedures, processes and protocols in place? Are they up to date? Do you set specific timelines for reporting of various matters? Do you have mechanisms in place to allow reporting to occur across all levels of employees?

Perhaps the most important tool of all is building good relationships, being approachable, continuously training and educating your colleagues, getting support from other Executives and also as a team role-modelling and displaying ethics and integrity every single day.

Counterfeits Brought to Heel -

Manolo Blahnik Worldwide Limited v Estro Concept Pty Limited

Ashleigh Fehrenbach, Senior Associate, MinterEllison

One of the world's most famous high-end shoe brands, made famous by *Sex in the City* character Carrie Bradshaw, may showcase the bounds of the somewhat newly introduced *Intellectual Property Laws Amendment (Productivity Commission Response Part 1 and Other Measures) Act 2018 (Cth) (Act)*.

On 29 May 2020, Manolo Blahnik Worldwide Limited (**Manolo**) launched preliminary proceedings in the Federal Court against an operator of designer fashion outlets, Estro Concept Pty Limited (**Estro**)¹. Manolo sought to have Estro hand over company records and documents to ascertain whether Estro has engaged in trade mark infringement, misleading or deceptive conduct and passing off.

The Act was brought in response to a 2016 Productivity Commission Report relating to Australia's intellectual property system, to (among other things) better facilitate parallel importation into Australia.² In particular, the Act seeks to expand the scope of the defence against trade mark infringement in the context of parallel importing. Introduced in September 2018, it amends the *Trade Marks Act 1995 (Cth) (Trade Marks Act)*, alongside other legislation including the *Copyright Act 1968 (Cth)*. For the purpose of the Trade Marks Act, the Act seeks to clarify the circumstances in which the parallel importation of trade mark goods will not infringe a registered trade mark.

Parallel Importing in Australia

Prior to the introduction of the Act, there had been uncertainty for parallel importers importing genuine

goods into Australia. If importers did not know if there were specific contractual arrangements in place between the owner of the trade mark and its distributors, this may result in the importer falling foul of the limited defence found in s 123(1) of the Trade Marks Act.

This defence previously provided that where it could be shown that a trade mark had been applied to goods by, or with the consent of, the registered owner of the trade mark, this would not constitute an infringement. The courts have interpreted "consent" quite narrowly, demonstrated in *Lonsdale Australia Limited v Paul's Retail Pty Ltd & Anor [2012] FCA 584*. As a result, importers had to very carefully review any contractual or corporate arrangements under which the trade mark had been applied.

The insertion of s122A into the Trade Marks Act (repealing s 123(1)) has introduced a new set of criteria that must be met for an importer's activities to be taken as not infringing a registered trade mark. A parallel importer will now not infringe the trade mark rights of the registered owner of the trade mark, if the following elements are successfully met:

1. the goods being imported are similar to the goods covered by the Australia trade mark;
2. the importer has made inquiries relating to the trade mark before using it; and
3. after such inquiries, a reasonable person would conclude that the trade mark had been applied with the consent of a relevant person.

What's the story with Estro?

The issue of questionable counterfeit products sold by Estro was first brought to light when a customer complained to Manolo about a product purchased from Estro in July 2019. The purchased pumps (in a style known as "Hangisi"), branded with Manolo's trade mark, were different when compared to the genuine product.

As part of its preliminary application earlier this year, Manolo tendered photographs comparing the allegedly counterfeit shoes with the genuine product. At present, Australian customers can only purchase Manolos online or at authorised retailer, Harrods. Counsel for Manolo submitted that it was possible that genuine shoes could have been acquired, including through parallel importing, and the documents sought from the company would help it ascertain whether or not to bring a claim.

Satisfying the 122A Criteria – a three-part test

Satisfying element 1 (*establishing similar goods*) is generally a straightforward process, as "similar goods" are defined in s 14 of the Trade Marks Act. Goods will be similar to other goods where they are the same or of the same description as other goods.

To satisfy element 2 (*making inquiries before use*), the Explanatory Memorandum to the Act³ provides that reasonable inquiries will be based on subjective circumstances of each import and good. More substantive inquiries may be required where a supplier is known or suspected to supply counterfeit goods. For example,

¹ *Manolo Blahnik Worldwide Limited v Estro Concept Pty Limited*

² Recommendation 12.1 of the Report: "parallel imports of [trade] marked goods [should] not infringe an Australian registered trade mark where the marked good has been brought to market elsewhere by the owner of the mark or its licensee".

³ https://parlinfo.aph.gov.au/parlInfo/search/display/display.w3p;query=ld%3A%22legislation%2Fems%2Fr608o_ems_74977042-bfb1-4233-be9c-b93118431f48%22

where the prices offered by a supplier are eyebrow raisingly lower compared to other similar goods, the reasonable parallel importer may need to make further inquiries and perhaps even contact the trade mark owner. A certificate of authenticity from the supplier should be sufficient to demonstrate that reasonable inquiries have been made. Less extensive inquiries may be anticipated when purchasing from a known licensed distributor of the relevant goods.

In relation to element 3 (*the trade mark applied with consent of relevant person*), the relevant person can be a registered owner or authorised user of the trade mark, a person who is permitted to use (or has significant influence over the use of) the trade mark by the registered owner or authorised user. It can also be an associated entity (within the meaning of the *Corporations Act 2001* (Cth)) of any of these people. The reference to associated entities is intended to capture the situation where the trade

mark was applied to the goods in a foreign country by one member of a corporate group structure and the owner of the trade mark in Australia is a different member of the same corporate group. The amendments contained in the Act do not affect counterfeit goods being imported into Australia in that kind of scenario.

Interestingly, by requiring the consent of a relevant person at the time of the *application*, the Act provides some protection for parallel importers. This is a solution against the previous practice of trade mark owners later assigning their Australian trade marks to an Australian distributor to put the brakes on parallel importing of products.

Impact of the Act

The changes provide more clarity for parallel importers, provided they have carried out the necessary checks and balances. Parallel importers should sufficiently document their

inquiries in respect of element two (and any responses to such inquiries) regarding the trade marked goods. If an importer's actions are later called into question, they should hopefully be able to sufficiently demonstrate compliance with s 122A.

That being said, trade mark owners still need to ensure that distributors comply with the contractual arrangements that have been put in place. As an example, if a distributor permitted to sell trade mark goods in Germany only, is knowingly selling to unrelated third parties for export to Australia, the trade mark owner can still rely on its contractual rights to take action against the distributor.

So where does all this leave Manolo and Estro? Justice Brigitte Markovic's decision on the case is due to be delivered and it will be interesting to see whether Estro engages in the protections afforded by the Act to parallel importers. For Estro's sake, let's hope the shoe fits.

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Michael Jordan and New Balance Lead the Charge in Bringing Chinese Trade Mark Laws Into the Global Fold

Nathan Mattock, Emma Johnsen and Laksha Prasad, Marque Lawyers

In the wake of recent changes to China's trade mark laws, global brands now have new avenues for recourse against bad faith filings and infringement in the traditionally protectionist economy.

Speaking of trends, the Supreme People's Court of China (SPC) made yet another finding to protect the rights of non-native brand owners, by ruling in favour of celebrated shooting guard Michael Jordan in his battle against Qiaodan Sports Co. Ltd China (Qiaodan).

Jordan had initially commenced proceedings against Qiaodan almost ten years ago, over their registration of the word 'Qiaodan' – a phrase that has been commonly received as a phonetic transliteration of the name 'Jordan' – as well as a logo depicting a basketballer attempting a mid-air layup.

Despite having held the registration of these marks since 2007, the comparable similarity of Qiaodan's marks to Jordan's name and the prominent Jumpman logo, was enough for the basketballer to seek damages in an effort to protect his rights in his name and portrait.

The ruling by the SPC, which was handed down in March of this year, overturned the lower courts' initial decision against Jordan, which held that 'Qiaodan' was a common surname in China and had no absolute correlation with Michael Jordan or his brand – a stance that was highly indicative of the Chinese courts' traditionally nationalist approach to such disputes.

However, Jordan's legal team was able to compile substantive evidence by way of two investigative consumer studies, which highlighted that 85% of a sample population in some of China's most populous provinces considered that 'Qiaodan' was

effectively synonymous with Michael Jordan and on that basis, 90% of interviewees considered Jordan's brand and Qiaodan to be affiliated with one another.

These reports were further supported by over 200 newspaper articles and over 1,000 other sports and educational texts, which all used the transliteration of Jordan's name to refer to the basketball player.

The overwhelming evidence presented by Jordan's legal team played a significant role in the SPC's adoption of a more relaxed benchmark in respect of Jordan's onus to prove prior use of the name. By requiring only a 'stable' correlation between Jordan's name and Qiaodan's mark to be proved (in contrast to an 'absolute' correlation), the SPC exhibited its nascent willingness to accept the results of the articles and consumer studies to allow large, non-Chinese celebrities and brands to rely on prior name rights to defend against infringement in China.

The resulting order by the SPC for the re-examination of the invalidation proceedings, is symptomatic of the Chinese courts' burgeoning use of discretion to award damages beyond statutory limits in favour of non-native brand owners – a trend that began in 2015, when the Beijing Intellectual Property Court first awarded a maximum statutory damage amount for a trade mark matter, in favour of French luxury clothing brand Moncler.

Since then, Chinese courts have exhibited more and more leniency towards arguments that challenge their traditionally first-to-file trade mark system.

In particular, the Standing Committee of the National People's Congress announced in April 2019, that they were implementing amendments to China's trade mark law to provide for

new sanctions against, and grounds to challenge bad faith filings.

Accordingly, trade mark applications filed in bad faith without intent to use, can be rejected outright during examination by the National Intellectual Property Administration of the People's Republic of China (CNIPA). This new scope for rejection was accompanied by increased statutory damages, from USD \$425,000 to USD \$708,500, and punitive damages to five times of the actual damages based on the rights holder's losses or a reasonable multiple of the trade mark licence fees.

In another recent case, the Shanghai Pudong People's Court ruled in favour of American-based sportswear company New Balance, in their unfair competition case against New Barlun Co Ltd for their unauthorised use of the stylised letter 'N' – which is otherwise recognised globally as the logo that is synonymous with New Balance. The Court accordingly ordered New Barlun to pay damages of RMB 10.8 million on the basis of years of losses for New Balance.

Despite the fact that New Barlun had successfully obtained trade mark registration for the lookalike mark in 2004, New Balance was able to use the revised laws for challenging bad faith applications to commence invalidation and opposition proceedings against New Barlun's mark, as well as obtain damages for trade dress infringement and unfair competition.

Ultimately, these new grounds for challenging bad faith filings coupled with the SPC's growing willingness to accept evidence of prior use by non-native brand owners, has provided new scope for global brand owners to assert their rights and revise their filing strategies in one of the most lucrative consumer markets in the world.

Skin in the Game - Copyright Law and the Depiction of Tattoos in Popular Media

Anita Cade, Partner, and Lachlan Wright, Lawyer, discuss copyright protection and commercialisation of tattoos under the US and Australian copyright laws.

What you need to know

- In 2016, Solid Oak Sketches sued 2K Games, Inc. and its parent company Take-Two Interactive Software, Inc. (**Take-Two**) for copyright infringement in the United States, for publicly displaying five tattoos on NBA players whose likenesses were accurately depicted in the popular basketball videogames NBA 2K14, 2K15 and 2K16.
- On 26 March 2020, the United States District Court for the Southern District of New York handed down its decision (the **Take-Two Decision**). The Court assessed the defendant's depiction of the tattoos within the game, and the defendants' intent in including the tattoos and found that the defences of de minimis and fair use were established.
- The Take-Two Decision is the first US decision to deal with the issues raised by publicly displaying copyright protected tattoos in popular media, such as a video game.
- The Take-Two Decision highlights that in the US, a court's determination on whether depicting a tattoo in popular media will constitute infringement will depend heavily upon the circumstances in which the tattoo was created and the medium and purpose for which it has been reproduced.
- Australia is yet to see any similar decisions regarding copyright infringement in relation to in-game use of tattoos or other copyright materials. While the underlying copyright principles are different, the considerations taken into account in the US are nonetheless likely to be relevant to the question of whether such use is truly an incidental use of an

artistic work in a cinematograph film and permitted under section 67 of the *Copyright Act (Cth)* 1968.

Who was suing and why?

The defendant, Take-Two, is a video game developer that releases titles through its subsidiary 2K Games. Since 1999, 2K Games has released an annual basketball video game, NBA 2K. The game is one of the most successful video game franchises ever, with a lifetime sales record of roughly \$90 million. The game itself is designed to accurately simulate the look and feel of an actual NBA game. Amongst other things, to achieve this Take-Two has "inked" its virtual basketball players with images of their tattoos to "depict the physical likeness of the real-world basketball players as realistically as possible."

The plaintiff, Solid Oak Sketches (**Solid Oak**), acquired exclusive copyright licences to five tattoos. Those tattoos appear on three players whose likenesses are depicted in the game, including LeBron James, Eric Bledsoe and Kenyon Martin. Solid Oak alleged that Take-Two had infringed its copyright by publicly displaying the tattoos on the depictions of those players in the 2013, 2014 and 2015 versions of the 2K game (see table below).

De Minimis Use, Fair Use and an Implied License

In response to the proceedings, Take-Two filed counterclaims submitting that the depiction of the tattoos

satisfied the US copyright defence of de minimis use and qualified as fair-use. Take-Two also claimed that the use of the images was pursuant to an implied authorisation granted by the players to use their likeness in the creation of the game, prior to Solid Oaks' acquisition of any rights in the tattoos.

In the US, the defence of de minimis use requires the alleged infringer to establish that the copying of the material is so trivial as to fall below the quantitative threshold of substantial similarity, which is a key element required to establish infringement in the US. Australia does not recognise a broad de minimis use defence, but does recognise an exception under section 67 of the *Copyright Act* in relation to "artistic works" only (which would include tattoos) that shares some similarities to the US de minimis use defence. Specifically, section 67 of the *Copyright Act* provides that copyright in an artistic work is not infringed by the inclusion of the work in a cinematograph film or in a television broadcast if its inclusion is only incidental to the principal matters represented in the film or broadcast.

In finding that the depiction of the tattoos in the game qualified as de minimis use, the Court stated:

The Tattoos only appear on the players upon whom they are inked, which is just three out of over 400

Tattoos in Issue	
Player	Tattoo Description
Lebron James	330 (Akron area code) surrounded by flames
	Script with Clouds and Doves
	Portrait of Lebron's child
Kenyon Martin	Grim Reaper holding a basketball
Eric Bledsloe	Basketball with Stars and Stripes

available players. The undisputed factual record shows that average game play is unlikely to include the players with the Tattoos and that, even when such players are included, the display of the Tattoos is small and indistinct, appearing as rapidly moving visual features of rapidly moving figures in groups of player figures. Furthermore, the Tattoos are not featured on any of the game's marketing materials.

The video clips proffered by Defendants show that the Tattoos "are not displayed [in NBA 2K] with sufficient detail for the average lay observer to identify even the subject matter of the [Tattoos], much less the style used in creating them." The videos demonstrate that the Tattoos appear out of focus and are observable only as undefined dark shading on the Players' arms. Further, the Players' quick and erratic movements up and down the basketball court make it difficult to discern even the undefined dark shading.

Take-Two was also successful in obtaining a declaration that their use of the tattoos qualified as fair-use under the Copyright Act, 17 USC (1976), on the basis that Take-Two's purpose in displaying the tattoos was to accurately depict the players in the games, and was entirely different from the purpose for which the tattoos were created, as a means "for the Players to express themselves through body art". The fact that the tattoos were incidental to the commercial value of the game, barely visible whilst playing the game, and comprised a minute percentage of the total game data, were additional factors that weighed in favour of a declaration that Take-Two's use of the tattoos was fair use. The US defence of fair use is significantly broader than Australia's much narrower fair dealing exceptions under the *Copyright Act* because it is not limited to a prescribed purpose and requires consideration of a number of broad factors such as the purpose and character of the use, the nature of the copyrighted work, the amount of the copyrighted work used and the use's effect on the value of the copyrighted work.

By way of contrast, in Australia, conduct must not only be fair in all the circumstances, but also be for one of the prescribed purposes under the *Copyright Act*, such as for parody or satire, criticism or review or reporting the news. There is no prescribed purpose under the *Copyright Act* that would have assisted Take-Two in establishing a defence under the fair dealing exceptions if this conduct was the subject of a challenge in Australia.

Take-Two also succeeded in establishing that it had an implied, non-exclusive licence to use the tattoos as part of its right to use the players' likeness when creating the game, and that such a licence was granted prior to Solid Oak obtaining the rights to the tattoos. This finding was made after evidence was given by the artists of the various tattoos showing that they intended the players to copy and distribute the tattoos as elements of their likeness, knowing that the players were likely to appear "in public, on television, in commercials, or in other forms of media". A similar result would have been achieved under Australian copyright law if Take-Two could establish that it had the benefit of an earlier non-exclusive licence to use the tattoos in the manner used.

What if the Tattoo was used for an overtly commercial purpose?

The success of Take-Two in establishing three different copyright defences in response to Solid Oak's infringement claims bodes well to deter future claims being brought for incidental or unavoidable depictions of tattoos in the media and public sphere in the US. However, the facts of this case are unique in that the depiction of the tattoos were an incidental part of the game, and did not feature in any marketing material or stray outside of the purpose of accurately representing the players likeness.

It seems likely that US courts would take a distinctly different approach if a tattoo was being used for an overtly commercial purpose without the permission of the copyright holder.

In 2011, the artist of Mike Tyson's distinctive face tattoo, Victor

Whitmill, filed a lawsuit against Warner Bros. Entertainment Inc (**Warner Bros**), in relation to the use of the tattoo in the film *The Hangover Part II*, in which the tattoo was depicted on the face of the character "Stu Price" played by actor Ed Helms. The tattoo also featured in the movie plot and was reproduced heavily in the promotion of the film by reason of its inclusion on the face of Mr Helms' character.

In 2003, Whitmill created the design for the tattoo that was inked on Tyson's face. At that time, Whitmill also obtained a release from Tyson explicitly giving Whitmill the rights to "all artwork, sketches and drawings" of the tattoo. Shortly after becoming aware of the new *Hangover* film, Whitmill successfully registered the tattoo with the US Copyright Office prior to filing a lawsuit seeking damages for copyright infringement and a preliminary injunction to halt the release of the film.

On 24 May 2011, the preliminary injunction application was denied by the US District Court on the basis that damages were an appropriate remedy to compensate Whitmill, and that such damages did not outweigh the harm that would be suffered by Warner Bros if the release of the film was delayed. Justice Perry did however acknowledge that Whitmill's infringement claim had "a strong likelihood of success" and that the design of the tattoo was an artistic work that was copyrightable regardless of the medium in which it was reproduced. Such comments underscore that the facts of the Take-Two decision are unique and that a similar result is unlikely to be reached in situations where tattoos are reproduced for a clearly commercial purpose. Unfortunately a decision in respect of the alleged infringement of Tyson's tattoo was never delivered as the matter was settled on a confidential basis shortly after the release of the film.

Tattoo Protection in Australia

Whilst there have been no Australian decisions which have needed to expressly consider the subsistence of copyright in tattoos, it is clear

that tattoos could be protected as “artistic works” under the *Copyright Act* because they are reduced to a material form (whether on the skin, on paper or by way of computer generated graphic), and subject of course to meeting the usual threshold requirements for copyright protection.

No really, your tattoo is not original

In Australia, whether a tattoo will be considered “original” for the purpose of attracting copyright protection, will depend upon the level of skill and effort expended in creating it. This is not a black and white test, rather it is a matter of degree as to whether a tattoo will satisfy the threshold.

By way of example, it is likely that simple, generic tattoos such as a

basic love heart, southern cross or anchor are insufficiently original to attract copyright protection. On the other hand, a more complex design of an anchor tattoo in which the artist had expended skill and effort may well be sufficiently original to attract copyright protection.

Similarly, if a tattoo is merely copied from another source, such as a photograph, film or drawing, not only will it not be considered original, but it may itself amount to copyright infringement if done without the consent of the copyright holder.

Where to from here?

It is clear that copyright can subsist in a tattoo and accordingly, its reproduction, publication or communication to the public can amount to copyright infringement

if done without the consent of the copyright owner, and without the benefit of any copyright exception.

Whether the use in a cinematograph film or television broadcast is merely incidental, such that it is permitted under section 67 of the *Copyright Act* will be a question of fact, to be determined in the context of all the circumstances. Certainly, if the use is akin to the use by Take-Two in this matter, where the tattoos appear on only a few players out of many players and even then, are barely visible at all, let alone properly discernible and are not used in any promotional material, an Australian court may be willing to find that the inclusion is truly incidental to the principal matters represented in the film or broadcast.

2020 CAMLA Young Lawyers Non-publication & Suppression Orders 101 event

By CAMLA Young Lawyer Committee representative **Ellen Anderson (Solicitor, Addisons)**

On 17 September 2020, the CAMLA Young Lawyers hosted another successful webinar, with the support of Ashurst and hosted by Level 22 Chambers. The event was a 101 seminar on non-publication and suppression orders and was very well attended. Excitingly, the shift to virtual events has allowed attendees from States and Territories other than NSW to attend CAMLA Young Lawyer events this year.

The panellists were the deeply knowledgeable and highly entertaining Gina McWilliams (Senior Legal Counsel, News Corp Australia) and Daid Sibtain (Level 22 Chambers), and was moderated by CAMLA Young Lawyers Chair, Calli Tsipidis (Legal Counsel, FOX SPORTS Australia – Foxtel Group).

The discussion was a combination of real-life experiences and the underlying legal principles

relating to non-publication and suppression orders. With Gina’s first-hand experience regularly working with journalists at News Corp and Daid having appeared in courts on various occasions to object to the necessity of such orders, the pair were able to offer extremely valuable insight into why these types of orders are made and how they may be objected to.

Some other key topics discussed were:

- How the media become aware that an order has been made.
- Who has a right to be heard.
- The difference between a non-publication order and a suppression order.
- The challenges that the media (and its representatives) face when attempting to understand why an order

has been made, and deciding whether to contest it.

- Examples of where an order might be made but a statutory restraint already exists.

The Young Lawyers Committee is very grateful to Gina and Daid for giving up their time and sharing their insight. Also, to Calli for moderating the event, and the staff at Level 22 Chambers for hosting the event and ensuring it ran smoothly. Finally, to our Young Lawyer Committee members, Nick Perkins (Senior Associate, Ashurst) and Claire Roberts (Eleven Wentworth), for the significant time and effort they put into organising the event.

A recording of the Non-publication & Suppression orders 101 event can be accessed by CAMLA members at the CAMLA website.

Interview: Justin Cudmore

Emma Johnsen, Senior Associate at Marque and CAMLA Board member, sits down with **Justin Cudmore**, Partner at Marque, to discuss fashion law, the Australian Fashion Council and current changes to the industry.

Emma Johnsen: Could you provide us with an introduction into the AFC, and also yourself?

Justin Cudmore: The Australian Fashion Council is the industry body which aims to promote the growth of the textile and fashion industry in Australia.

I have been a director of the AFC for around 6 years, and last year was appointed Co-Chair. My day job is as a partner at Marque Lawyers – I’m a commercial lawyer with a specialisation in the fashion industry.

EJ: Could you give us a bit of detail into who and what the AFC is? Who are the AFC’s members?

JC: Anyone involved in the value chain of the fashion and apparel industries. Therefore not just designers, but also apparel businesses, retailers, manufacturers, fibre growers, tech companies and education providers.

EJ: What does the AFC do specifically for members?

JC: The AFC’s aims fall into five broad categories – strengthening supply chains; growing Australian exports; nurturing business; developing industry practices in ethical and sustainable product; and fostering design and innovation. Our activities are therefore focused on achieving those, and include programs to give emerging brands retail experience through pop-up stores (with an associated mentorship program); showrooms and events at overseas fashion weeks and trade events including Paris, New York, London and Hong Kong; lobbying on behalf of the industry with state and federal government, educating members on sustainable practices; and hosting industry round tables to discuss issues such as diversity and Indigenous representation, rethinking the fashion timetable and the industry’s response to COVID.

EJ: What are some recent items you’ve been lobbying for?

JC: We have been working with IP Australia for a number of years on reforms to IP laws, particularly the Designs Act. Many Australian fashion designers are not aware of the requirement to register a garment design if they want to have rights to prevent knock-offs. There are also financial and administrative hurdles to registering designs. As a result, very few designs are registered in Australia, and therefore copying is rife and generally occurs without consequence. The AFC lobbied for unregistered design rights. Recently IP Australia has released its recommendations for change, which include a grace period of 6 months which would at least allow designers to register designs for styles they believe will be particularly successful. The consultation on this issue continues.

I believe it is time that the intellectual property rights of fashion designers (and designers generally) are more robustly protected. The original idea for the loss of copyright in industrially produced designs was that usable things (a teapot, a dress) should be democratised and open to all. This simply doesn’t matter anymore – the array of choice for most goods is almost infinite. A particular design is all that a designer has to sell, and the fruits of their creativity should be properly (and automatically) protected.

Particularly as a consequence of COVID and the interruption to overseas based supply chains, there is a strong move towards bringing manufacturing back to Australia. Over the last few decades we have lost a great amount of expertise and capacity in this area as the cost of manufacturing in the developing world lowered. The AFC is working with the federal government on how that trend can be reversed.

Another strong focus of the AFC is promoting exports. While in the past a large amount of this work has involved being on the ground at fashion weeks and trade shows, in COVID times fashion weeks have been cancelled or gone virtual. In response to this, we partnered with Ordre, an online showrooming platform via which international buyers can view and order collections.

EJ: What is the current state of the fashion industry, namely during COVID. Can you speak to the “re-wiring” of the fashion industry?

JC: Many fashion businesses operate on a financial knife’s edge even in normal times, so unfortunately the industry has been hit very hard by COVID. Sales have dropped significantly, discounting is savage and out of ‘normal’ timing, and there have been issues with supply and orders being cancelled by major retailers.

However, with the supply chain effectively broken comes an opportunity to re-think how the industry operates. Recently, an initiative called #rewiringfashion has emerged (instigated by several significant designers, CEOs, retailers and the Business of Fashion publication). It focuses on two aims – to reduce the fashion calendar to two collections a year (many designers are currently releasing up to 6 collections a year); and reimagine fashion shows as consumer-focused events which promote clothing in-season (rather than a preview of what will be in stores in 6 months’ time). The industry (even at the high end, let alone fast fashion) was in a race to release more styles as often as possible – this was resulting in significant discounting to allow for new stock, and more wasted dead stock ultimately being destroyed. Hopefully this initiative will disrupt that cycle, and encourage customers to buy better quality, less product (at full price).

EJ: At Marque, what issues do you help clients with?

JC: We assist fashion clients with all of the issues any other business might face. This includes contract negotiation (particularly regarding supply chain and distribution channels, agreements with manufacturers, retailers and selling agents), disputes, regulatory, privacy, competition, etc.

However, there is definitely an IP focus for them. That is both at the front and back end. We provide strategic IP advice about what trade marks and designs to register and in which countries, and then assist with or manage enforcement by deciding which IP breaches are worth challenging and the ways in which that is done. We have provided a lot of assistance to clients regarding the registration of trade marks in China particularly. It is renowned for trade mark squatting, but fortunately with recent changes to their laws, we've had some success in having trade marks which were registered in bad faith deregistered.



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Elwood Clothing Pty Ltd v Cotton On Clothing Pty Ltd [2008] FCAFC 197

Joel Parsons, Senior Associate, Bird & Bird, revisits the Elwood v Cotton On decision for our special fashion edition.

The decision in *Elwood* provides guidance as to the preferable approach when ascertaining the scope of a protected work, and the applicable test for determining infringement, in the context of visual designs on clothing. The decision confirms an artistic work in such circumstances includes various visual aspects such as the layout, selection, arrangement, of the visual elements in the design.

Elwood, a designer and manufacturer of clothing and accessories, produced a t-shirt called the “NewDeal” t-shirt, as well as the “Vintage Sport Swing Tag”, a design applied to swing tags or labels used by Elwood in respect of its garments.

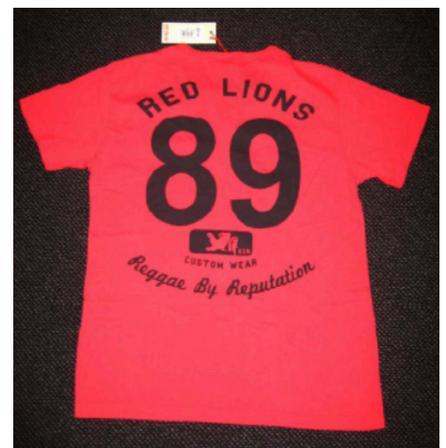


Elwood NewDeal T-Shirt



Elwood alleged that Cotton On had infringed copyright in the NewDeal t-shirt and the Vintage Sport Swing Tag. The designs of both the original

work, and allegedly infringing items, comprised of various graphical elements including short phrases and numbers.

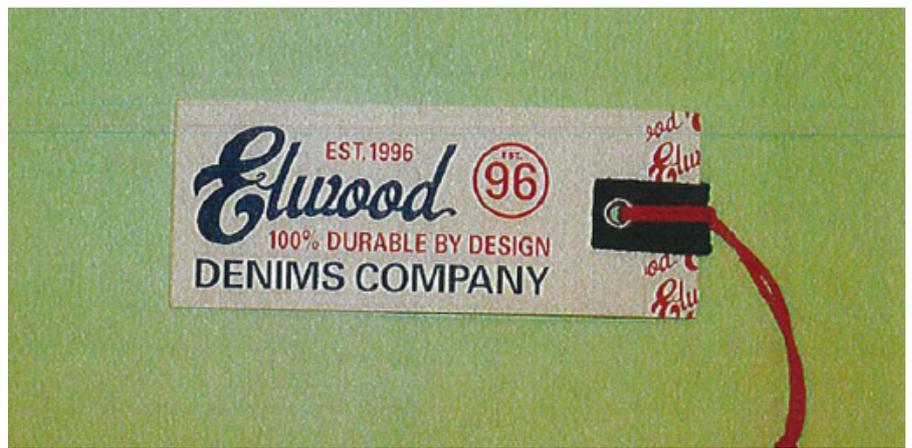


Cotton On Tijuana, Moscow and Kingston T-Shirts

Cotton On employees who designed the allegedly infringing items conceded they had been directed to use the Elwood products as a reference for new products. Cotton On also conceded that Elwood's designs were "original", however, whether or not Cotton On had taken a substantial part of Elwood's work, remained in issue. Cotton On also argued that Elwood's designs were literary, rather than artistic works.

At first instance the Court ruled against Elwood. The Court found that Elwood's designs were artistic works, but the "V-shaped" pattern of text and the layout of the NewDeal design, comprised part of the work's underlying idea, rather than the expression of the idea, and so to the extent Cotton On copied these aspects of the design, there was no infringement of the copyright in Elwood's works. On appeal, the Full Court agreed that Elwood's works were artistic works because they were of an artistic quality, consisting of layout, form, positioning and shaping and the interrelationship of the various visual elements. Any meaning that could arguably be conveyed by reading the text or numerals in those designs was so obscure and subservient to the artistic aspect, that they did not amount to a literary work.

However, the Full Court held that the relevant "works" in the circumstances, comprised the whole of each design "...enclosed by a notional circumferential boundary which encloses all of the various elements, and...the vacant space between them". Accordingly, the layout of the NewDeal design and other stylistic elements giving rise to the "look and feel", were matters of expression rather than the idea or concept. Even though the words and numbers in Cotton On's designs were different, by taking the layout and other relevant visual elements of Elwood's designs, Cotton On took a substantial part of the copyright work. Cotton On's design was found to have infringed the Vintage Sport Swing Tag on the same basis.



Elwood Vintage Sport Swing Tag



Cotton On Swing Tag

About CAMLA

The Communications and Media Law Association Incorporated (CAMLA) brings together a wide range of people interested in law and policy relating to communications and the media. CAMLA includes lawyers, journalists, broadcasters, members of the telecommunications industry, politicians, publishers, academics and public servants. Issues of interest to CAMLA members include:

- defamation
- broadcasting
- copyright
- advertising
- information technology
- freedom of information
- contempt
- privacy
- censorship
- film law
- telecommunications
- the Internet & online services

In order to debate and discuss these issues CAMLA organises a range of seminars featuring speakers prominent in communications and media law policy.

Speakers have included Ministers, Attorneys-General, members and staff of communications regulatory authorities, senior public servants, executives in the communications industry, lawyers specialising in media and communications law, and overseas experts.

CAMLA provides a useful way to establish informal contacts with other people working in the business of communications and media. It is strongly independent, and includes people with diverse political and professional connections. To join CAMLA, or to subscribe to the Communications Law Bulletin, complete the form below and forward it to CAMLA.

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