



## ***The Talking Law Podcast***

### Episode 111 - COVID and scandalous trade marks - a walk on the wild side

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## **Transcript**

**Joanna:** Hi, I'm Joanna Oakey here and welcome back to Talking Law, a podcast proudly brought to you by our commercial legal practice Aspect Legal. Now today we have something a little bit different and a little bit less serious than our usual Talking Law podcast we give you the latest tips and tricks in law. Today we are talking about COVID and scandalous trademarks and things that maybe you wouldn't have expected some things that have come to light that the fabulous Grace Yi who heads up our trademarks area at Aspect Legal has recently identified as something she thought was rather amusing and wanted to share with us. So grace, thank you for coming back on the show.

**Grace:** Thanks for having me, Jo.

**Joanna:** Brilliant. Okay. All right. Well, you and I just can't get enough of talking about trademarks of course. While we find this topic, very interesting, who knows about listeners will as well. Well, it could just be a little geeky thing that we geek out on trademark law. But I was fascinated by some

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of these things that you were telling me about marks that had been recently registered. And Gosh, I must say, I'm actually blown away by the creativity of some people, I must say, when this whole pandemic hit, getting a trademark related to COVID was not at all on my mind. So and we work in trademarks, well, and particularly you Grace day in day out, so some people out there are very creative, right?

**Grace:** Absolutely. Yeah. It's amazing.

**Joanna:** So give us a walk through some of the entertaining things you've seen recently with trademarks.

**Grace:** Yeah, so as you know, global pandemic hit around March in Australia. And interestingly, as soon as we hit mid March, we started getting trademarks being lodged on the trademark register in Australia for COVID related trademarks.

**Joanna:**  
So mid March? That's a little bit early isn't it?

**Grace:** Yeah, yeah. And it's and it's something that's not just happening in Australia. It's been happening internationally. So it's happening in China. It's happening in America. It's happening around the world. So here we go. I've got a trademark here for Corona clean.

**Joanna:** Corona clean? Haha Quite clever.

**Grace:** Haha

**Grace:** It is for detergents and disinfectants lodge on the third of March. How early is that? That's before lock down. Haha

**Joanna:** Actually, that's amazing. That's when we were still in denial.

**Joanna:** Whoever submitted that is a very creative person. Wow. Okay.

**Grace:** Yep. People have tried to lodge Corona Virus for an app.

**Joanna:** Really? Corona Virus? Oh for an app. Right. Okay. What kind of app was that? Do you know?

**Grace:** I don't know. They just launched it in class 9 for apps and software and class 41 for education and entertainment for the for the word Coronavirus.

**Joanna:** Oh! For education and entertainment?

**Grace:** Yeah,

**Joanna:**  
Gracious me, I just may wonder what they were up to. That's interesting

**Grace:** Yeah, who knows. There is Coronavirus resistant for cleaning products and household cleaning products. There's The Quarantine Concierge.

**Joanna:** Wow. And what's that? Is that cleaning again?

**Grace:** Class 39 for the delivery of goods.

**Joanna:** All right quarantine concierge. Okay, that's really clever.

**Grace:** Yeah.

**Joanna:** Tell us Grace, how did all of these marks fair? Did any of them get through?

**Grace:** Well, now that we're into end of May. All of these marks or most of these marks are under examination, which means that they've received some kind of adverse report from the trademarks office.

**Joanna:** Yes,

**Grace:** I can see one of these has been accepted. And it's probably because there's enough material in it to not be descriptive. So we'll talk about what these marks are probably facing without asking for access to the reports under OSI, we can't see them. But we can we can guess, based on, you know, other sorts of controversial marks that have been lodged in history.

**Joanna:** And let's, let's get through that in a moment, because I'm very interested in the controversial marks in history. But stepping back one, what are the reasons that you think there might be issues with some of these marks? They are all being held up here, the adverse report phase at the moment.

**Grace:** So there's two main issues one of them is that in the trademarks law, there's actually a provision that prevents trademarks from being accepted for registration if they contain or consist of scandalous matter or if its use would be contrary to law. So that's when we get a little bit technical and lay out what the provision actually says, but really, it's there to give the registrar the ability to say, No, we can't accept that trademark. It's just too scandalous.

**Joanna:** Yeah, yeah. And, you know, I guess a some of the potential issues with the registration of Corona, or marks including the word Corona. I mean, firstly, we have a really strong brand, or be it in beer for Corona, which I guess lets you know, potentially if you're anywhere near whatever the registrations are for Corona, the beer now you're likely to have that cited, but I guess in many senses, Corona is becoming quite descriptive. Now perhaps is that you know, is that something that you think might be an issue here as well Grace?

**Grace:** Absolutely. So yes, a lot of these marks the second issue that they're going to face is that Coronavirus, COVID-19, all of these sorts terms a very generic descriptive terms that everybody is using at the moment to describe a virus. So to say that someone can own it and monopolize it and have the right to exclude any other trader, from using it would be contrary to the spirit of the trademark law.

**Joanna:** Which was the one that got through Grace. You said one has just been accepted? Well, it looks like yeah, it's been accepted in the mark was E-healthy is interim covid behavioral vaccine.

**Grace:**

Right. So there's enough material in there as a whole. It's got enough.

**Joanna:** Yeah. I see, I'm really interested to see how the quarantine concierge. I'd love to know how that one goes. I'd be interested to see what happens with that. People can be very creative, can't they Grace?

**Grace:** Yeah, absolutely. The fact that there are people out there as soon as a pandemic hits, they put the entrepreneur hats on and think, how can I monopolize on this? That's just amazing, right?

**Joanna:** Yeah, yeah, yeah. And I guess one of the takeaways in this that, you know, we've been

discussing is that it's quite clever for a business to think when there is a lot of attention to a particular area to think, how is it that I can use brand and then through trademark registration, brand protection to have something that is really clever and will be picked up in the in the discourse that's just out there at the moment? Right. And I think that's, I think that's super clever. But the point is, if you want protection for these, then you need to do it in a way that complies with our trademark laws here in Australia.

**Grace:** Yeah, I don't know if we should talk like this, but if some of these marks wanted to get up these COVID Mark, it'd be about adding something to it that makes, as you say, is clever, using a turn of phrase or a pun or a play on words and adding something to it to make it really distinctive and stand out. That's what we're talking about to get it across the line,

**Joanna:** I think and actually how about a challenge to Grace is to keep your eye out and see. Maybe we'll have an eye out for the cleverest mark that is actually able to make it through the trademark registration process that has some reference to this some pandemic we are currently living in and fairly obsessed with. So we'll look out for that. How about we do that? And you our listener? Why don't you join me in this sounds like a fun game, well why don't we just throw it out there. If you send in, sent it to [info@aspectlegal.com.au](mailto:info@aspectlegal.com.au) any entries you have for this game we want to know the most creative, bizarre and I don't know the most amazing trademark registrations, I guess, that relate to COVID or quarantine or Coronavirus.

So throwing it out to you more report back. How about we report back maybe in a few months grace on what we've seen whether we've picked up and whether we've found a winner? Well, they won't be through the application process. I guess in that time for listeners who aren't aware the minimum period of time for the processing and trademark application from the date of application through the actual full registration is, is it still seven and a half months, Grace?

**Grace:** Yes.

**Joanna:** Seven and a half months. So anyway, we may need to give it a few more months. But anyway, we can just go on the basis of applications at the moment. I'm interested to hear in the creativity of trademark applications. So there you go. We've got a bit of a contest out there and look, the person who submits something that we end up deeming to be the most creative will win a bottle of champagne. Yes, a bottle of champagne. Let's we're throwing it out there. So go on, get us your applications and otherwise grace will be on there. She'll be looking as well. So...

**Grace:** Well, I'll put my hat in the ring.

**Joanna:** Oh, yeah. Have you got one. That you haven't told us?

**Grace:** There's one. There's one that was lodged on the second of may for Coronavirus sucks.

**Joanna:** Okay. Wow, you're really close to this bottle of champagne Grace.

**Grace:** It was lodge in 7 classes Jo. Okay.

**Joanna:** Well tell us what does Coronavirus sucks do? as the goods or services?

**Grace:** Well, this person wants to use this brand on phone covers, stickers, bags. cups, details, clothing.

**Joanna:** Wow.

**Grace:** Watches, badges. It's merchandise, it's Coronavirus sucks merchandise.

**Joanna:** Wow. Okay, interesting. Well, I don't know, let's wait and see if that one gets through. All right.

**Grace:** Yeah.

**Joanna:** So you've mentioned grace as we first started talking that there were also some other controversial marks through history. And that you've seen that gave us a little bit of an indication of how some of these Corona trademark applications might go. I want to hear about those what what have you found? What have you dug up in the trenches of our trademark journals?

**Grace:** Yeah, There are so we can we can kind of guess what's going to happen with these Corona related trademark applications because we've seen it happen before. So if you recall back in 2014, when that Malaysian Airlines Flight, MH370 went missing.

**Joanna:** Yeah,

**Grace:** Amazingly, 2 trademark applications got lodge, very soon after the flight went missing, actually, for that flight number,

**Joanna:** Holy cow.

**Grace:** Yeah, for MH370, in class what he won for various entertainment and education type services. And that application actually went all the way to a hearing.

**Joanna:** Wow.

**Grace:** Yeah. And so I guess one of the reasons why the examiner would have initially locked it backwards because of it being scandalous. But after hearing it was rejected on the basis that it was descriptive. So this is how we know that these two issues are in play. It was the airline itself that lodged the application.

**Joanna:** All right. Hmm. The art so Malaysia Airlines lodged the trademark application here in Australia.

**Grace:** MH370 was launched by a company called AEON International propriety limited. And then in July MH370 was lodged again by Malaysian Airlines system,

**Joanna:** Right? Okay,

**Grace:**

A Malaysian company, and they lodged it in class 9 for all different types of scientific products class 16 for books and paper products in class 41 for education and their reasoning for lodging it was that they were going to use the brand educate the community about the flight that went missing.

**Joanna:** Wow. It's interesting. I think organizations sometimes take the approach of trademark registration in a defensive way in that they want to try and ensure that no other organizations will end up with a mark even if their future usage is limited. And of course, it's really important not to register a mark that you intend never to use. And you do have a grace period. Between registration and between having to have used a mark.

But if you haven't used it within the first three to five years, is that right? Grace? Yeah. Then you are exposed to another company making or another organization making an application or someone making an application for removal of the mark on the basis that you haven't used it. So it's important if you register a trademark, and you intend to keep the protection and you use it in some way, but certainly it's a valid reason for trademark registrations that we've seen organizations take

that they might take out a registration in order to ensure that other organizations don't end up with that monopoly right rather than them.

**Grace:** And in the whole time that we've been working on trademarks, I can only recall one instance where it was really clearly that there was no intention of using it. And I don't think we went ahead with lodging that because you've got to have that intention to use.

**Joanna:** Yeah, yeah. Which is important important for people to be aware of if they're thinking about trademarks from these more defensive mode, but I guess you can meet the tests of use, sometimes quite easily. So anyway, if that's something that you're thinking about, you should certainly take legal advice. Go to someone that they know talking about so they could talk you through how it is that you can ensure that once you have a trademark registration, you don't lose it on the basis that you failed to use it in the proper way. So okay, so did any of these inmates 370 marks get through Grace?

**Grace:** No,

**Joanna:** None at all. Okay, even the Malaysian airline ones didn't get through. Okay. Interesting. It is interesting because obviously that was a flight code of Malaysian Airlines. So it does bring in interesting discussions and certainly is an excellent reminder. I think for organizations, when they're choosing brands to think very critically about whether or not those brands can indeed be protected by way of trademark registration, before they throw a whole lot of money into it, if they might want to have that protection, you know, because we have seen time and time and time again, organizations go through the creative process of coming up with a brand, only later to find that they're completely surprised that they're not going to be able to get protection for it because they've put the cart before the horse because they've done the creative process. And committed to all of that without having the legal step also taken which is the assessment of whether or not it's a registerable mark. That's an interesting one, and but not nothing. saralee onpoint for our discussion controversial marks, I want to hear more of the fun stuff Grace. What else have you dug out there? I want to hear at all.

**Grace:** You want to hear some really unusual marks? Gosh, in the time that we've done trademark work we've never had clients come up with how shall we say colorful marks?

**Joanna:** Well, we've had colorful marks but maybe just nowhere near as colorful as you're about to talk about here. I think that's the...

**Grace:** I'm blushing even thinking of saying this.

**Joanna:** Grace Tell us.

**Grace:** Here we go..we are adults. This podcast is M rated. Haha

**Grace:** There is a mark on the register for Knockin Fux.

**Joanna:** Oh my goodness. Well, What's that for?

**Grace:** It's for nuts and snacks?

**Joanna:** Nuts and snacks, okay. I mean, that's certainly creative, isn't it? and did you say to mark that's on the register? oh so it got through. It

**Grace:** Yeah it got through. It's registered. It's been registered since 2011. But the interesting one about this one is it's got an endorsement. And an endorsement is something that goes on the register. It's, you know, quite often we'll see endorsements like the trademark owner does not claim

exclusive use, and then it'll have some very descriptive element of the mark. Or what other endorsements have we seen, oh, this, the trademark owner will never use the cross symbol in a red on a white background, because that's owned by the Red Cross.

**Joanna:** Yes, we've seen that. We have seen that

**Grace:** But this trademarks got an endorsement on it that it's a condition of registration that this trademark will not be marketed to children.

**Joanna:** So it's interesting. I've never seen that sort of endorsement before. But there you go. The trademarks office has been very creative here about how they work through an application to apply. But they feel that they can actually register it. What else have you got?

**Grace:**  
There's a trademark on the register for Pommiebasher

**Joanna:** Goodness gracious. And that got through that got through

**Grace:** for clothing and drinks.

**Joanna:** Wow. Okay. And did this one go to hearing or did it get through without a hearing?

**Grace:** It actually did. And it was accepted because the decision maker decided that this is a word that's just colorful and colloquial and acceptable.

**Joanna:** Right. Okay. Well, there you go. And we have had some discussions about some more colorful language is been discussing before. One of the marks we're going to talk about, I don't think we can even say but perhaps we can spell it out. Great. spell it out. It's

**Grace:** Probably the most offensive word in the English language. And it's..this person has decided to learn trademark for a misspelling of it. So they have spelt it. K U N T.

**Joanna:** Right.

**Grace:** The one that's currently on the register is for a, what we would call a composite mark. It's got some elements of words as well as images.

**Joanna:** I'm not sure I want to know what the images are. What are the images Grace? I guess now I am interested. Haha

**Grace:** So the image is of actually I would say it's a skull. Oh, I'm wearing a top hat and smoking a cigarette.

**Joanna:** Okay, that's unusual. Yeah. And what are the goods or services protected by business?

**Grace:**  
It's for clothing. For it says in the claim, apart from just general clothing, motorcyclists clothing,

**Joanna:** I see, okay.

**Grace:** And the word elements out WOT spelled W O T and then K U N T question mark clothing. And it's currently under examination. So we don't know yet if it's going to get through. It received an adverse report.

**Joanna:** Yes, unsurprisingly. And of course, we've got a lot of F related marks. I gotta say the

funniest one in this list that you've got there. Grace is FUCKERWARE.

**Grace:** Hahaha

**Joanna:** Is'nt that funny.

**Joanna:** Is that for? I'm presuming it's not in a class that Tupperware is in? What's that one for?

**Grace:** It's in class 35 and I'll just read out the verbatim what they've claimed they claimed, direct marketing and selling of adult products and sex toys via parties.

**Joanna:** Oh, that's.. hahaha

**Grace:** Haha. I'm gonna cry now. Hahaha

**Joanna:** Too funny, wow, some people are very creative. Okay. Haha

**Grace:** Haha, I'm sorry. Haha

**Joanna:** Haha, I know and did that one get through? I'm interested?

**Grace:** Yes. It has been around since 2002.

**Joanna:** And can you tell if Tupperware opposed it?

**Grace:** Oh, no, no one opposed it.

**Joanna:** Yeah, right. Okay, I guess. I mean it's quite possible that their trademark search didn't contain some of the elements that were in this mark. I mean, obviously some sort of phonetic similarity. Well, okay, well look grace, I tell you what you've given us the goods today. This is a joy and I enjoyed having a bit more of a lighthearted discussion about trademarks. But there's some serious points in here. I guess the first serious point is that be aware, if you're quite colorful with your language or your marks, you might very well face issues with trademark registration on the basis that they too scandalous.

So I guess that's just 1 possible learning out of all of this, but I guess the other you know, the thing that really has struck me from this conversation other than trademarks can be quite amusing, a lot of trademarks, is the creativity of some people, you know, and really, I just think it's very clever to adopt the idea of when the mind of society has turned to a particular subject, finding a way to incorporate part of that subject creatively into a mark that you then take brand ownership of.

And then are able to get protection for is very clever, I think. And you know, and maybe there's a note in there in terms of how in business, we can think more creatively about brands that we were using for products or services, to not just, number one, take advantage of where the discourses and whatever I'm thinking about at the moment, but also how to do it in a way that is actually predictable so that we're able to build up monopoly rights for ourselves.

**Grace:** Yeah. And I think that's really important because, I mean, we spend so much time with our clients and I just see it in their eyes, when when they finally cottoned on to how important having their brand is protected. And I think that when the penny drops, is when they're at that risk of infringement, they feel exposed because there's a competitor in the market who's come up with a name. That's just to close for comfort, and they come to us and they realize really, if you're going to go into that battle with somebody else, and you need to shut them down, or you need to get that name off them. If you don't have it protected, it's literally like going to battle with no armor.

**Joanna:** Absolutely, yeah. And, you know, time and time again, we'll have these discussions with clients and we will say, you need to hold fire, we need to get our protections in line quickly first, because timing is everything in trademarks, you know, when it's particularly difficult when a competitor has gotten in first and blocked your path. You know, we've seen some really sad stories relating to this Grace and over our many, many, many years working in this area, so it's not hard, but you've got to be quick, I guess is the point and tackle early and right back at that creative phase.

**Grace:** Yeah, so we've talked about something a little bit funny today, but I wanted to use something like humor to get the issue back in front of mind. Because I think once I mean these people are funny but you know, we're having a laugh, but they get it. They understand what the trademark registration system is about. Yeah. And I feel like if we can use this funny story to bring the issue back to front of mind for our clients and our listeners, then I feel like we've achieved something today.

**Joanna:** Yeah, absolutely. As well as having fun. I've had fun Yeah. Have you had fun Grace?

**Grace:** We always have fun Jo.

**Joanna:** Well, look, I hope you, our listener had fun as well seeing the lighter side of trademarks, but also perhaps having a bit of a dawning of some how some of the things we're talking about today might actually be really relevant to your own businesses in terms of not just your own current protection but also how you approach branding into the future and the integration of considering the legal elements as well as the creative elements all together.

**Grace:** Yeah.

**Joanna:** Brilliant. Love that Grace. Thank you so much for coming on board with your fascinating information.

**Grace:** And you know what I really feel like we've done our job when when we get to a stage with our clients when they are at that brand development stage. And we've talked about this so much that they just know, I just got to run this past Grace and Jo and see what they think. And quite often we can just help them tweak it just a little bit and then we can get it protected straightaway.

**Joanna:** Yeah.

**Grace:** It's that insurance for their marketing.

**Joanna:** Yeah. And, you know, that can also make the difference between number one something that they can protect, so the marketing spend is protected, but also, that we're helping them to make sure they're not exposed to future infringement. Because it really is that those two elements here is that it's that ongoing risk that organizations don't understand they're running and the failure to protect those key assets that they're just really not clued into. So, there is a serious side of a more funny story.

**Joanna:** Thank you so much Grace. Loved to have had you on board.

**Grace:** Thanks Jo.

**Joanna:** Well that's it for our episode with Grace Yi from Aspect Legal, all about COVID and scandalous trademarks and other creative ideas of how to use trademarks and brand protection in creative ways. If you would like more information about this topic for example, if you were so interested and you want to download a transcript of the podcast episode to read it in more detail, then just head over to our website at [talkinglaw.com.au](http://talkinglaw.com.au) there you will also be able to find out how

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to contact Grace and our other fabulous legal Eagles at Aspect Legal. If you or your clients would like help with any trademarks that you're looking at protecting or indeed any brand during the creation phase that you'd like some legal input into in order to ensure that you end up with a trademark at the end of the day or a brand at the end of the day that is protected and protectable Well, thanks again for listening in. You've been listening to Joanna Oakey and Talking Law, a podcast proudly brought to you by a commercial legal practice Aspect Legal. See you next time.

