The Return of Duff Beer – Only This Time it’s ‘Legendary’

By Amanda Scardamaglia

Fifteen years after South Australian Brewing and Lion Nathan Australia had their plans to sell Duff beer thwarted by the Federal Court, German brewer Eschweger Klosterbrauerei is selling its ‘Legendary Duff Beer’ in Australia.

Available at a most independent bottle shops and online, the German Pilsner, was first launched in Europe, where it has been sold for a number of years. The brewer’s website boasts its Duff Beer was awarded the DLG Medal in 2011 (an award given by Germany’s independent drinks and food testing society). It was also recognised as a bestseller in 2010 and one of Germany’s most successful new products.

Although the German brewer has registered its red label bearing the word ‘Duff’ as a trade mark in the EU, the application has been opposed, presumably by Twentieth Century Fox, Matt Groening and his production company, as the product is not licensed or authorised by the producers of The Simpsons television series, in which the beer featured. A search of ATMOSS indicates that the company has not sought to register the trade mark in Australia.

So how, if at all, is this Duff beer different from the product marketed by South Australian Brewing and Lion Nathan Australia in the 1990s? And more importantly, will the Legendary Duff Beer suffer the same fate as its predecessor, at least in Australia?

The Nature of the Potential Claim

Trade mark lawyers and students will recall the proceedings brought by Twentieth Century Fox and Matt Groening Productions against two local Australian brewers who had marketed its own brand of ‘Duff’ beer. In a claim for passing off and a breach of section 52 and 53 of the Trade Practices Act 1974 (Cth) (now section 18 and section 29 of Schedule 2 of the Competition and Consumer Act 2010 (Cth), the producers of The Simpsons sought to prevent the breweries from promoting or dealing with any product using the same or similar get-up and incorporating the name Duff Beer, as depicted in the television series. The producers also asked that the breweries be restrained from using the name Duff or any deceptively similar name in relation to beverages, and from representing that their Duff beer was the product of the producers, or that it had the sponsorship or approval of the producers.

The producers succeeded on all grounds of their claim, with the Court granting an injunction preventing the breweries from continuing to sell their Duff branded products, while all existing stock was pulled from store shelves and destroyed. The rest is part of The Simpsons’ folklore, with the already sold Duff beer becoming prized collector items. Indeed since the product was pulled from sale, some cases of the beer have fetched thousands of dollars in online auctions.
It is likely the producers would have the same claim against the German brewer Eschweger Klosterbrauerei and/or its local distributor/s. That is, a claim in passing off in the nature of character merchandising and also for a breach of section 18 (and section 29) of Schedule 2 of the *Competition and Consumer Act 2010* (Cth).

Drawing on the Court’s interpretation and application of the law with respect to character merchandising in the 1996 proceeding, it is hard to see how a court, if faced with making a determination with respect to Legendary Duff Beer, could come to a different result.

**(a) Reputation and Secondary Meaning**

The word ‘Duff’ was conceived by Matt Groening in 1989 for use as the name of a fictionalised beer to feature in The Simpsons. As Homer’s drink of choice, Duff Beer is commonly depicted and referenced in the television series. Indeed, one whole episode of The Simpsons was devoted to the theme of Duff Beer, which was titled ‘Duffless’.

While Duff Beer is occasionally depicted as bottled beer in the television series, it is most prominently depicted as canned beer. The basic colours used are red, black, white and yellow, with the name Duff featured on the front of the can, in haphazard cartoon font.

In Groening’s affidavit evidence in the 1996 proceeding, he said that Duff Beer was intended to be one of several secondary characters and products that would play a continuing and essential part of the program. Interestingly, Groening said that he came up with the name Duff as a parody of the other one syllable American beers, like ‘Budd’ and Blitz.’

In light of this evidence, the Court in the South Australian Brewing case determined that the word ‘Duff’ had acquired a powerful secondary meaning, which the tort of passing off would protect. The fact that the case did not concern a fictional character but a make believe product was irrelevant. So in finding that Duff Beer had derived a distinctive character, the Court famously extended the principles which apply to character images or titles to the name of a fictional product. Clearly, the producers can rely on this finding as the basis upon which to make a claim against the use of the word Duff by the German brewer.

**(b) Misrepresentation or Association**

In the 1996 decision, the Court held that the use of the word Duff by the Australian brewers would induce customers into believing that the product had a connection or association with The Simpsons program. The Court came to this conclusion having regard to the fact that the respondents’ ‘… intention was to “sail as close as possible to the wind” in order to “cash in” on the reputation of “The Simpsons” without stepping over the line of passing off or deceit.’ So, rather than require evidence of consumer confusion, Tamberlin J found that mere association, which would arouse and recall connotations of fun, irreverence and parody which surrounded The Simpsons, was enough to satisfy the cause of action. In particular he stated:

‘The name “Duff” will induce customers into believing that the product has a connection or association with “The Simpsons” program, when in fact it has no connection whatsoever. The fact is there is not and never has been any association between the applicants and the respondents. The implicit representation, in my view, is that the name “Duff Beer” produced by the breweries, is an embodiment of the fictional beer which features in the series. In reality, the product is a beer, which is manufactured in Australia by companies without any commercial or other association with the producers of the series.'
...the deliberate creation by the breweries of an association by use of the name “Duff” between the breweries’ beer can with “The Simpsons” program, in circumstances where there is no association and indeed, where such an association is contrary to the express policy of the producers, amounts to misleading and deceptive conduct. There is no necessity to demonstrate that the viewer or consumer must think in specific terms of permission or allowance in order to constitute deceptive conduct. The intentional use of the name “Duff Beer” which produces the false association is sufficient …’

Whether a court would find the same in a claim involving the Legendary Duff Beer is slightly more contentious, given there are a number of differences between the Legendary Duff Beer and the beer produced by the local Australian breweries, and in turn, the Duff Beer featured in The Simpsons.

Firstly and most obviously, the Legendary Duff Beer is sold in bottles and not cans, whereas previously noted, Duff Beer is normally depicted as canned beer in the television program. Whether this detracts from the possibility that consumers would think there is some association is questionable – the word Duff remains the most prominent aspect of the packaging on the German beer.

The prominent use of red, black and white on the Legendary Duff Beer is somewhat different to the get-up of the can featured in the television series, as it does not feature the colour yellow. Even so, the German brewer has used a similar haphazard cartoon font for the words ‘Duff Beer’.

The other significant difference here is the German Brewer’s use of the word ‘Legendary’. Does this sufficiently distinguish the German beer from any association with The Simpsons or does the term further embolden the association with the television program?

It is more probably the latter case. This is because it seems unlikely that the addition of the word ‘Legendary’ would sufficiently distinguish the goods from The Simpsons or that it would operate as a disclaimer so as to dispel any perceived association with The Simpsons and the German brewer. Consider here what the Court had to say about whether the use of a disclaimer bearing the words ‘unauthorised’ would be sufficient in the later proceeding, when Tamberlin J was considering the scope of relief:

‘It is too simplistic an approach to suggest that the word “unauthorised”, coupled with the other forms of proposed disclaimer, must dispel any association with “The Simpsons”. … Moreover, given the evidence that “The Simpsons” program makes a point of “sending up” in a comic manner, other advertisers and advertisements, and given the irreverent nature of the content of the series, it is by no means beyond reasonable argument that the disclaimers would reinforce, rather than negate or diminish, any association with the series.’

Another important factor relates to the question of merchandising. The Simpson’s television series is highly merchandised. Much of this licensed merchandise relates specifically to Duff Beer, with the range including t-shirts and caps depicting the fictional beer. Tamberlin J took this into account in ultimately holding that the extent of existing merchandising would make it more likely that the public would think that The Simpsons had sanctioned the beer produced by the Australian breweries. The consequence of this was significant from the producers’ perspective in terms of the potential damage to The Simpsons brand – particularly as the producers had consistently refused to licence merchandise with respect to alcohol and tobacco products because of the series’ popularity with children. This is a policy the producers have maintained to this day. Thus, one would expect that, for this reason, the Legendary Duff Beer is of particular concern to Twentieth Century Fox and Matt Groening Productions.
Conclusion

It seems remarkable that, notwithstanding Australia’s recent history with Duff beer and the well publicised Federal Court decision, another company would enter the Australian market with an unauthorised Duff labelled beer. Expect to see more on this in the near future, particularly once the EU trade mark opposition claim is resolved. In the meantime, it might be worth grabbing a case of the Legendary Duff Beer and secure your potential collector’s item now.

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