Trade Marks and Language
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'... it is true that we live by symbols ...'1

Abstract
The traditional perception is that trade marks signal the origin of goods and services. The perception is challenged in this article. It is argued that trade marks are an important component of popular culture. Popular culture thrives in a fluid, unregulated environment. Yet the rhetoric of trade mark law is that the great open commons of the English language require the protective mantle of regulation: 'trade marks' should be narrowly defined and thresholds for registration set high in order that the language commons should remain in their pristine natural state; while at the other end infringement of a registered trade mark should be narrowly construed to avoid anything that would grant a full 'proprietary' right in a trade mark. The article explores the evolution of such ideas and their apparent hold still over the law. It is observed that there is a more sophisticated understanding now of the nature and function of language as a cultural device compared with that which existed at the time the British trade mark registration system was established. And it is suggested that trade marks that develop a cultural dimension should be granted rights accordingly. Regulation in the name of protecting the language commons should be kept to a minimum, targeting cases where trade mark owners seek to use their trade marks as instruments of censorship and control.

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1 Mishawaki Rubber & Woollen Manufacturing Co v SS Kreige Co 316 US 203, 205 (1941) (Frankfurter J).
1. Introduction

Language is a remarkable instrument of expressive activity. Its capability to reflect and influence human behaviour is still scarcely comprehended. But one thing is clear: words are not merely by-products of social interchange; they are an essential feature of the way in which we 'constitute and articulate our world'. And an ever-changing feature. In the last century alone the English language's corpus of words and meanings has increased by more than a quarter to accommodate the complexity of modern existence, spurred on by the energy of traders looking to capture the public imagination (and no doubt to make a living as well). Expressions like 'Roller Blades' and 'Barbie Doll' and 'Star Wars' never existed in the lexicon until coined by traders and 'Just Do It', 'Enjoy', 'The Real Thing' and 'You Know You Want It', to list but a few of the multitude of expressions chosen for their 'effervescent qualities' and 'injected into the stream of communication with the pressure of a firehose', had different more limited significations in the pre-advertising age.

The line between trade marks as, at their simplest, 'signs' used to distinguish goods or services in the market and trade mark language as a social-cultural phenomenon is a thin one. The imagery of those denoted 'traders', who employ meaning as a commercial signalling device and commonly register their trade marks, and those denoted 'authors', who create copyright works and rarely register trade marks (except sometimes for character merchandising purposes), can often be basically the same. The Coca-Cola Company may be a trader in soft drinks but 60 per cent of its company value lies in its brands. Why? Because its brands and...
the images they conjure are an important part of what it sells. Eminem may be a rap musician but he is also a trader selling his music, his messages, his personality and his brilliant use of language. His repeat phrase, ‘one shot — one opportunity’ used in the semi-biographical film 8 Mile have as good a claim to trade mark status as Coca-Cola’s ‘The Real Thing’. They mark him out, they distinguish his work in the market of music and entertainment: they are his signature piece. Mike Leigh’s use of ‘Secrets and Lies’ as the title (signature again), theme and key passage in the film Secrets and Lies has fixed those words with his brooding significance. The Star Wars films are as much identified with their ‘Empire Divided’ and ‘Dark Side’ and ‘Star Wars’ language as their plots and characterisations; Joanna Rowling’s ‘Hogwarts’ is fixed in the memories of a generation of 12 year olds; and Peter Jackson made ‘Middle Earth’ famous by his faithful depiction in films of Tolkien’s The Lord of the Rings. Artists build their reputation around minimalist use of powerful words — as with Colin McCahon’s ‘I Am’, Brett Whiteley’s ‘It’, and Sam Durant’s ‘Like Man, I’m Tired of Waiting’.

In a world where trade mark is replacing copyright as the favoured form for protecting cultural texts, it can no longer be said, if ever it could, that trade marks exist only in relation to goods or services and have no meanings in themselves. The 20th century has seen popular culture take art, music and poetry into the ‘street’ of film, radio, television, and now even more pervasively the internet. Ordinary people (including importantly children) have money and leisure and independence to devote to their entertainment and they are prepared to spend these on things that draw them together, creating

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10 8 Mile, Director Curtis Hanson, Starring Eminem, Universal Pictures, 2002.
12 See the official Star Wars website at <http://www.starwars.com/>.
13 The trade mark is registered by Time Warner for inter alia paper products and entertainment services: 806048.
15 As acknowledged by Tourism New Zealand which has since sold New Zealand as ‘Middle Earth’ <http://www.newzealand.com/homeofmiddleearth/).
17 Brett Whiteley, Alchemy, Sydney, 1972–1973
18 Sam Durant, Like Man, I’m Tired of Waiting, Lightbox, California, 2002.
20 As said in Exxon Corporation v Exxon Insurance Consultants International [1982] Ch 119 at 143 (Graham J) (‘Exxon’ not a copyright work), and on appeal Stephenson LJ at 130–1.
21 A trend observed by Jane Gaines, Contested Culture: The Image, The Voice and The Law (1991); see especially at 208 and passim.
22 A radical change from a century ago where 80 per cent of household income was used for basics of food, clothing and shelter: see Robert Fogel, The Fourth Great Awakening and the Future of Egalitarianism (1999).
their own virtual communities based around a network of shared experiences. Now trade marks do more than ‘sell’ goods and services, let alone distinguish their ‘origin’ — still the only true function of trade marks according to trade mark law.23 Like them or not, trade marks tell stories. Their expressiveness is the basis of commercial activity, the trader-author the conduit of meaning, and the market-audience the monitor and arbiter of taste. And the combination of a vivid visual characterisation and aural sound-bite effect makes them easy to remember (and difficult to forget) across the entire base of the population.24 The late Daniel Boorstin of the Smithsonian Institution observed that advertising now shows many of the familiar characteristics of folk culture: ‘... repetition, a basic style, hyperbole and talk talk, folk verse and folk music ... [and] a limbo between fact and fantasy’.25 Rosemary Coombe, The Cultural Life of Intellectual Properties author, adds: ‘... mass-media imagery and commodified cultural texts provide important cultural resources for the articulation of identity and community in Western societies ...’.26 Popular/folk culture also thrives in a fluid, unregulated environment.27 Yet our trade mark law traditionally operates under the umbrella that the great open commons of the English language require the protective mantle of regulation: ‘trade marks’ should be narrowly defined and thresholds for registration set high in order that the language commons should remain in their pristine natural state; while at the other end infringement of a registered trade mark should be narrowly construed to avoid anything that smacks of copyright style protection. My purpose in this article is to explore how such ideas came to evolve and why they continue to be the rhetorical foundation of the law in a world where so much has changed in the last broad century — especially when, with the opportunity for a fresh start presented by the internet, the opposite approach, one of low-regulation, was adopted with respect to domain names.

23 ‘Selling’ goods by signalling their quality was a ‘true’ trade mark function as remarked upon by Frank Schechter in 1927: ‘The Rational Basis of Trademark Protection’ (1927) 40 Harvard Law Review 813 — challenging the conventional idea that trade marks were simply and properly used to designate trade origin. The conventional idea, however, continues to persist see, for example, Shell Company of Australia Ltd v Esso Standard Oil Ltd (1963) 109 CLR 407 at 425 (Kino J); Johnson & Johnson Australia Ltd v Sterling Pharmaceuticals Pty Ltd (1991) 21 IPR 1 at 24—25 (Gummow J).

24 The combination of vivid visual imagery and repetitive sound-bite advertising in an entertaining format combines successful features of language teaching approaches, while the choice of simple word formats and transparent meaning for trade marks makes them ideal subjects for language acquisition: see generally Douglas Reutzel & Robert Cooter Jr, Teaching Children to Read (2000) at 262-3 especially (canvassing recent research on reading instruction approaches) and Eve Clark, The Lexicon in Acquisition (1993) at 109-125 (pointing to transparency and simplicity of language as keys to acquisition).

25 Daniel Boorstin, ‘Advertising and American Civilisation’ in Yale Brozen (ed), Advertising and Society (1974) 11 at 22 — pointing to the change since the 19th Century when the function of advertising was simply to inform. By the early 1920s, Boorstin notes, advertising in the US had taken on the function of persuading — and in a country where ‘a shared, a rising, and a democratised standard of living was the national pride and the national hallmark’ — ‘advertising had become the rhetoric of democracy’. Id at 14.

26 Coombe, above n19 at 57.

27 Boorstin, above n25 at 21, talking particularly of traditional folk culture.
The paper has three main parts. Next, I consider the very different treatment of language when it comes to the regulation of trade marks and domain names. Then, I review the historical context of our registered trade mark system, including the influence of 19th century linguistic theories which treated language as historically pure and fragile to disruptive influences. Finally, I suggest that with the experience of the last 100 and more years, and the benefit of sociolinguistic ideas about the robust flexible character of language development, some rethinking of the fundamentals of trade mark law is in order. In particular, those concerned with freeing the language commons might redirect their attention to the level of regulation in the system. Amid fears that trade mark owners given more rights will naturally seek to exploit expressive components of their trade marks to control and censor popular discourse, the possibility that guiding commercial norms may be a preferable alternative to restrictive regulation has apparently so far been overlooked.

2. Regulation of Trade Marks Versus Domain Names

The internet is a web of interconnected networks, or virtual superhighways, with millions of websites, or virtual shopfronts, which serve as vehicles for trading and dissemination of thoughts and ideas. To have a website locus on the internet a domain name must be registered — and the domain name once registered becomes the unique identifier, the signature, or trade mark, of its holder. Registering a domain name is simple. For the most popular domains — those ending in .com, .org and .net — registration is on a first to file basis with no substantive requirements. The most important constraint is the practical technical one that a domain name may not be identical to an already registered domain name. (More thresholds apply for registration in the Australian administered .au domains, but even these are not particularly stringent.) Also simple is the dispute resolution system if a registration is challenged. Only three grounds of objection may be raised under the uniform dispute resolution process which governs most domain name registrations (including in the .com, .org and .net domains). The grounds for objection are cumulative: first, that the domain name is identical or confusingly similar to a trade mark in which the complainant has rights; second, that the registrant has no rights or legitimate interest in the domain name; and third that the domain name was registered and is used in bad faith.

28 Not that it was conceived for this purpose: for a discussion of its origins as a private communication network, see John Naughton, A Brief History of the Future: The Origins of the Internet (1999).
29 See, regarding the .com, .org and .net domains, under the Internet Corporation for Assigned Names and Services (ICANN) <http://www.icann.org>.
30 The Australian .com.au and .net.au domains are administered by the Australian Domain Name Registering Authority (auDA): <http://www.domainregistration.eom.au/domain­name­policies-main.php>. The latter requires an Australian connection as well as a prior business name or trade mark registration or an acronym, or an indication of a 'substantial connection to the registrant'.
31 For a similar dispute resolution system adopted for .au domains see the auDA site ibid.
32 For the full terms of the policy see <http://www.icann.org/udrp/udrp--policy-24oct99.htm>. 
somewhat.)\textsuperscript{33} Relatively few domain names have been challenged under the UDRP. Over 30 million have been registered since the internet began its commercial life the early 1990s.\textsuperscript{34} Of those, approximately 15,000 have been the subject to UDRP disputes since the system was established in 1999;\textsuperscript{35} less than 0.05 per cent. The remainder are free to be traded, otherwise used or simply held by the registrant. And since the direct costs of registering and disputing are low (registration in the .com, .org and .net domains set at around $70 (US) for the first two years; and a UDRP single arbitrator dispute costing around $1,500 (US) — and born by the disputant) the result has been an explosion of internet activity since the internet began its public life some 10 year ago.

The domain name system has its flaws.\textsuperscript{36} But criticism has tended towards the need for fine-tuning rather than rejection of the basic simple model. By and large, a primary internet policy of the last decade — promoting cheap expeditious trading options for those who wish to exploit the medium commercially — has been realised. And with no great impairment of public debate either.\textsuperscript{37} Debate flourishes on the internet and moderately free domain name registration and dispute resolution promotes it.\textsuperscript{38} ‘Gripe sites’ like NikeSucks.com, McSpotlight.org, SaveBarbie.com, and SaveHarry.com proliferate on the internet (notwithstanding efforts by some of those named as targets to control their spread) and their evocative names make their purpose immediately apparent to their audiences. In some cases ‘prescient companies’ have taken advantage of the consumer complaints lodged on these sites to change their own practices — enhancing their

\textsuperscript{33} See, for example, Telstra Corporation Limited \textit{v} Nuclear Marshmallows Case No D2000-0003 (the panel’s conclusion of bad faith rested on an inference from the defendant’s failure to give good cause for the adoption of the claimant’s trade mark ‘Telstra’ as a domain name, that ‘it is not possible to conceive of any plausible actual or contemplated active use of the domain name by the Respondent that would not be illegitimate … ’ (Associate Professor Christie at para 7.12): reported at <http://arbitration.wipo.int/domains/decisions/html/2000/d2000-0003.html>.

\textsuperscript{34} For Network Solutions reporting the 30 millionth registration worldwide (Muzi.com) on 5 October 2000, see Yahoo Finance at <http://uk.biz.yahoo.com/3b01004/0/ah4g.html> (10 March 2003), numbers in the top five open domains (including .com, .net and .org) totalled 37,383,532; see <http://www.whois.sc/internet-statistics/>.

\textsuperscript{35} See <http://www.icann.org/udrp/proceedings-stat.htm> as at 25 Feb 2004, 15,404 domain names challenged (13189 decided, 1349 disposed of without decision, 855 undisposed; 13 terminated for recommencement).


\textsuperscript{38} As Rosemary Coombe & Andrew Herman also point out with examples: see ‘Trademarks, Property and Property: The Moral Economy of Consumer Politics and Corporate Accountability on the World Wide Web’ (2000) 50 \textit{DePaul L Rev} at 609 (‘the Web is certainly used for corporate bashing’) and passim.
reputation for consumer sensitivity in the process. In other cases they have reacted by engaging in private and public debate. The sites thus serve an important dialogic purpose in more than one sense, leading potentially sceptical academic observers Rosemary Coombe and Andrew Herman to conclude that:

We are seeing a field of power shifting in digital terrain. As systems of univocal proprietary control give way to an interactive ethics that interrogates the claims of property with questions of propriety, we have a unique opportunity to challenge the impositions of privilege and insist upon new forms of responsibility and social accountability ...

Even the use of such common language terms and expressions as 'business', 'fun', 'free', 'tired' and 'tiredofwaiting' for domain names has not emerged as a serious problem on the internet. Contrary to what might have been expected at the beginning of the domain name registration system (based on assumptions carried over from trade mark law that common language must be in public hands if public access is to be maintained), a practice of private ownership and public use has developed. Generic sites are commonly exploited as portals for shared messaging by multiple subscribers. There are exceptions. For instance, the site tired.com, which carries the words, 'Are you tired? Tell us why' has no evident public benefit. However, rather than enclosing the language, tired.com has merely become the subject of public criticism labelled one of the most pointless websites on the internet today.

The simplicity of the domain name system is in contrast to registered trade mark systems. These nationally based systems are often complex and laborious, even in their most recent incarnations. In the 1990s with the World Trade Organisation's TRIPs Agreement linking intellectual property rights to international trade attention turned to harmonisation of national law standards. But barriers to establishment and enforcement of rights have not yet been fully

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39 Id at 610-611, giving the example of Dunkin Donuts introducing low-fat milk after complaints were lodged on a customer's <http://www.dunkindonuts.org> website. Another example is Apple's introduction of expanded warantee for iPod owners and reduction of its iPod battery replacement price after a wrathful 'gerilla film' about the company's practices was published by multimedia artists Van and Casey Neistat on <www.ipodsdirtyssecret.com>: 'The Sonic Bust' The Age (11 January 2004) Agenda at 12 (reprinted from the Washington Post).
40 See Michael Brush, 'Got a Gripe: There are Plenty of Places to Vent on the Net' for examples and advice at <http://www.mcspotlight.org/media/press/moneyonline_13jul96.html>.
41 above n38 at 626.
42 See, for example, <http://www.business.com/> (business search engine and directory); <http://www.free.com> (lists over 8000 internet sites offering free products and services); <http://www.fun.com> (a self-styled 'comprehensive guide to entertainment and the arts'); <http://www.tiredofwaiting.com> (an 'all in one web and domain resource').

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addressed. A particular regulatory target is the trade marking of language. Legislators and courts in the British mould have traditionally identified ‘inherent distinctiveness’, said to be found in the ‘nature’ of the trade mark irrespective of its use, as an important registration threshold. From a modern linguistic perspective, the notion that any meaning is ‘inherent’ in words is impossible: meaning is a product of social discourse. But in fact it is only use or prospective use ‘as a trade mark’ that may not be considered in assessing inherent distinctiveness, courts have sometimes added. Of course, linguists might also point out that ignoring or marginalising trade mark use leaves out a practical source of language development. And experienced lawyers may note that recognition of common law trade marks, protected from passing off on the basis of their reputation (and without a requirement that the origin of goods or services be indicated) is not so circumscribed. Lack of inherent distinctiveness has not been a bar to common law trade mark status since ‘Camel Hair Belting’ (used for belting made of camel hair) was acknowledged by the House of Lords as giving rise to an action for passing off in the 1896 case of Reddaway v Banham. But in the unreal world of trade mark law inherent distinctiveness is still the preferred standard held to by courts.

The preference is now subtler than before. When inherent distinctiveness decided a trade mark’s ability to be registered — as before the Australian Trade Marks Act 1995 (Cth) and the UK Act of 1994 — results were subjective, unpredictable and sometimes bizarre. For instance, ‘Solio’ was accepted by the House of Lords as inherently distinctive for photographic paper in 1898 (when the sun was employed in the process of developing photographs); as was ‘Tub

46 Although some potentially important changes were made, including a new definition of ‘trade mark’ as a sign used to distinguish goods or services in the market without specific reference made to ‘origin’, a broader set of criteria for assessing ‘distinctiveness’, and extension of infringement to cover identical or similar trade marks used for goods or services outside the original scope of registration (where such use would lead to likely confusion); see especially Articles 15 and 16.
47 Registrar of Trade Marks v W & G Du Cros Ltd [1913] AC 624 (hereinafter W & G Du Cros) at 634–S (Lord Parker); Burger King Corporation v Registrar of Trade Marks (1973) 128 CLR 417 (hereinafter Burger King) at 424 (Gibbs J) (‘“Inherent adaptability” depends on the nature of the trade mark’ and is ‘not something that can be acquired’). See also (no difference between common language and geographical terms), Clark Equipment v Registrar of Trade Marks (1964 111 CLR 511 (hereinafter Clark Equipment) at 512–4 (Kitto J).
48 As Kitto J makes clearer in Clark Equipment, id (the question is the ‘plaintiff’s chances of distinguishing his goods by means of the mark, apart from the effects of registration’). Compare W & G Du Cros ibid (Lord Parker).
49 For common law purposes reputation is a source of rights: see Reckitt & Colman Products Ltd v Borden Inc [1990] RPC 341 (hereinafter Reckitt & Colman) at 406 (Lord Oliver) (although referring to ‘identifying get-up’ rather than simply trade marks as importantly associated with reputation). Lord Oliver’s classical formulation of passing off’s elements of reputation, misrepresentation and damage has been approved many times, including in ConAgra Inc v McCain Foods (Australia) Pty Ltd (1992) 23 IPR 193, at 246–8 (Gummow J).
Happy' for cotton clothing (being presumably easy to wash in the tub) by the Australian High Court in 1956, notwithstanding a dissent by Kitto J who pointed out that coming happy expressions was a common form of slang at the time. However 'Perfection' and Orlwoola' were disallowed for soap and cloth respectively in 1909, as were 'Ribbon' for toothpaste in 1913, 'Charm' for hosiery in 1928, and (in Canada) 'Superweave' for textiles in 1949. And (Burger King's) 'Whopper' was deemed not inherently distinctive of hamburgers in Australia in the early 1970s—other traders might 'without improper motive' wish to use the term to describe their 'hamburger sandwiches', Gibbs J said, although there was no evidence they had or intended to do so.

Now, in the post-TRIPS era more jurisdictions follow the US in holding factual distinctiveness sufficient in principle. But with the threshold left to courts less has changed than might be supposed. It has been suggested 90 per cent recognition of the trade mark as a trade mark would be needed in order for the new threshold to be satisfied. The trade mark would have to be 'almost a household word'. And it would need to

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50 Reddaway v Banham [1896] AC 199 (the term accepted as a common law trade mark for industrial belting — setting aside the Court of Appeal's judgment reported at [1895] 1 QB 286 which in accordance with previous authority held that '[w]hatever is mere description is open to all the world': at 298 (Rigby LJ) quoting Cheavin v Walker (1876) 5 Ch D 850, at 863 (James LJ)). See also Erven Warnink BV v J Townsend [1979] AC 731 (public recognition of Advocaat as a 'descriptive' term distinguishing brandy-egg combination liqueur by its quality, without indicating origin or source, was sufficient basis for a common law reputation). As Lord Oliver said in Reckitt & Colman, above n49, 'even a purely descriptive term consisting of perfectly ordinary English words may, by a course of dealing over many years, become so associated with a particular trader that it acquires a secondary meaning such that it may properly be said to be descriptive of the trader's goods and of his goods alone' (at 412).


52 Mark Fays Ltd v Davies Coop & Co Ltd (1956) 95 CLR 190, at 201 (Williams J) (the term conveys only a 'vague', 'covert and skilful' allusion to the clothing's washability), see also Dixon J at 193-95. (For a modern comparison see The Procter & Gamble Co v Office for the Harmonisation in the Internal Market (Trade Marks and Designs) (2002) Ch 82 (ECJ): 'Baby Dry' considered inherently distinctive for nappies.)

53 Joseph Crosfield and Sons' Application (1909) 26 RPC 837; In particular, Cozens-Hardy MR observed that, notwithstanding 30 years extensive use, 'Perfection' was used adjectively and was 'a mere laudatory epithet'—thus 'I think it would be wrong to allow a monopoly in the use of such a word' (at 855). Further, the judge added, as far as 'Orlwoola' is concerned the misspelling of 'all wool' (properly disclaimed) did not render it distinctive (at 856).

54 In Re Colgate & Co's Application (1913) 30 RPC 262.

55 In Re Keystone Knitting Mill's Ltd's Application (1928) 45 RPC 421.

56 Registrar of Trade Marks v GA Hardie & Co Ltd (1949) 4 DLR 582.

57 See Burger King, above n47.

58 And notwithstanding that by then the Trade Marks Act 1955 (Cth) allowed for registration on the basis of 'capability to distinguish', and identified inherent distinctiveness as only a factor to be considered along with secondary reputation (ss 25 and 26): in practice courts continued to use the same negative test (need for trader and public access to common language) to hold the threshold not satisfied as for cases where inherent distinctiveness was the only criterion.

59 For instance, Trade Marks Act 1995 (Cth) s41(6), Trade Marks Act (1994) UK s51(1). The UK Act also implements standards set down in the European Trade Marks Directive No 89/104/EEC.

60 British Sugar Plc v James Robertson & Sons Ltd (1996) RPC 281 at 305 (Jacob J). See also Ocean Spray Inc v Registrar of Trade Marks (2000) 47 IPR 579 (hereinafter Ocean Spray) at 587 (Wilcox J).
be recognised as a 'trade mark' denoting the origin of goods or services.\textsuperscript{61} Thus 'Whopper' with virtually 100 per cent public recognition as Burger King's 'trade mark' is now registered in Australia.\textsuperscript{62} But 'Have a Break' was found insufficiently distinctive of Nestlé's chocolate when the company recently sought registration in the UK, proffering evidence of common law trade mark recognition.\textsuperscript{63} (The question whether it should be registered is currently before the European Court of Justice).\textsuperscript{64} And Ocean Spray's inability to show it had used 'Cranberry Classic' as more than an identifying descriptor of its fruit drinks barred it from the Australian trade marks register in 2000.\textsuperscript{65} The possibility of secondary meaning establishing distinctiveness is now conceded in principle. But in practice it is inherent distinctiveness that is still a deciding consideration in almost all cases,\textsuperscript{66} albeit registrars and courts may now be more flexible than once they were in applying that standard.\textsuperscript{67} The premise is still that regulating entry into the system is preferable to simply determining whether common law trade mark status has been or will be achieved (or more simply, as with domain name registration, deciding conflicting claims).\textsuperscript{68}

What is the purpose of these limitations? Williams J said in the \textit{Tub Happy} case that protecting the English language commons is an essential attribute of our trade mark law, quoting Lord Herschell in the \textit{Sofia} case.\textsuperscript{69} The idea seems so at odds with current linguistic thinking that the history of its apparently inexorable hold on the law warrants closer examination.

\textsuperscript{61} See especially \textit{Ocean Spray}, id at 588-9 (Wilcox J).
\textsuperscript{62} Trade Mark: 751333.
\textsuperscript{63} \textit{Societe des Produits Nestlé SA v Mars UK Ltd} [2002] All ER (D) 05. There was survey evidence supporting public recognition but Rimmer J placed weight on Nestlé's past use of 'have a break' with 'have a Kit Kat' as supporting its merely descriptive use: at para 32.
\textsuperscript{64} The question whether, for registration under the UK \textit{Trade Marks Act} 1994, distinctiveness could be acquired 'following or in consequence of the use of that [ie the claimed] mark as part of or in combination with another mark?' was referred by the Court of Appeal to the European Court of Justice: \textit{Societe des Produits Nestlé SA v Mars UK Ltd} [2003] EWCA Civ 1072.
\textsuperscript{65} \textit{Ocean Spray}, above n60.
\textsuperscript{66} For registrations too - for example, a sample of 2,000 of 14,219 Australian registered trade marks sealed in the period 1 July 2003--31 December 2003 reveal two ('Commonwealth Games' and 'Rowing World Cup') endorsed as registered on the basis of factual distinctiveness (secondary reputation) alone.
\textsuperscript{67} For instance, it is unlikely expressions like 'Just Do It' and 'Do What You Want' referred to above at n5 would have been considered sufficiently inherently distinctive to warrant registration even 30 years ago when 'Whopper' was disallowed (above n47), yet they are registered in Australia. For a survey of 300 recently registered trade marks classified by the Australian Trade Marks Office as inherently distinctive finding up to one third drawing on common language, see Megan Richardson, 'Trade Marks and Language. Welfare Effects', WTO Conference, Adelaide, February 2004 (copy on file with author).
\textsuperscript{68} Trade mark law makes provision for conflicting claims as well: see for instance ss44 and 60 \textit{Trade Marks Act} 1995 (Cth) elaborating on provisions found in earlier Australian and UK statutes; and \textit{Southern Cross Refrigerating Co v Towoomba Foundry Pty Ltd} (1954) 91 CLR 592 ('Southern Cross' for refrigerators and well-drilling equipment) and \textit{Berlei Hestia Industries Ltd v The Bali Company Inc} (1973) 129 CLR 353 ('Berlei' and 'Bali' for bras).
\textsuperscript{69} \textit{Mark Foyes Ltd}, above n52 at 199. The reference is to \textit{Eastman Photographic}, above 51 at 580.
3. **Importance of History in the Trade Mark System**

Our trade mark system is a product of history.\(^{70}\) When the first comprehensive British trade marks registration system, the *Trade Marks Registration Act 1875*,\(^{71}\) was adopted there were designs and patent registration models in place which could easily be adapted to the purpose of determining the character of the system adopted.\(^{72}\) The fact that trade mark registration was available in some European countries,\(^{73}\) and it was hoped granting like rights in Britain would lead to reciprocal rights for British traders abroad, added the weight of public opinion --- at least of those traders consulted by the Select Committee on Trade Marks in the lead up to the 1875 Act.\(^{74}\) They submitted registration should involve a process of examination of the trade mark; and the registrar should have the authority to reject a claim on the ground of insufficient distinctness from any existing mark, as in Prussia.\(^{75}\) The Select Committee questioned whether such a bureaucratic system adopted for trade mark registration 'would suit the habits and feelings of people of this country'.\(^{76}\) But, ultimately (although it took some 13 years), the Bill was enacted along the general lines sought.\(^{77}\) The new Act also specified a registered trade mark as ‘belonging to particular goods, or classes of goods’.\(^{78}\) This was considered necessary to reflect the nature of a ‘trade mark’ as understood and employed at the time, viz to denote manufacturing origin.\(^{79}\) John Smith, Sheffield Chamber of Commerce President, told the Select Committee that:

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\(^{71}\) *Trade Marks Registration Act 1875* (UK) 38 & 39 Vict, c91.

\(^{72}\) See *Report of Select Committee on Trade Marks Bill* (London: Parliament House of Commons, 1862) at 26 (William Smith - Sheffield Chamber of Commerce Secretary and drafter of the 'Bill No 1', which subsequently became the 1875 Act).

\(^{73}\) The Superintendent of Patents (Woodcroft) testified to the Select Committee in 1862 that Patent Office registered patents, designs and trade marks in Austria, Bavaria, Belgium, France, Hanover, The Netherlands, Portugal, Prussia, Russia, Sardinia (Italy), Saxony, Spain, Sweden, Norway, Prussia, Wurttemberg (Germany) and America: id at 71.

\(^{74}\) For instance *Select Committee on Trade Marks* at 3 and 32–33 (Jackson); at 36 (Ryland), at 45 (Bartleet), at 53–54 (John Smith, Sheffield Chamber of Commerce President and chief promoter of the Bill that eventually became the 1875 Act). See also at 71 (Woodcroft, Superintendent of Specifications in the Patents Office) and at 121 and 128 ((Joseph) Smith and Hindmarsh, lawyers experienced in handling trade mark piracy cases on behalf of British manufacturers).

\(^{75}\) See especially id at 36 (Ryland). See also William Smith at 27 (suggesting an opposition procedure was also desirable to allow for full monitoring).

\(^{76}\) Id at 36.

\(^{77}\) *Trade Marks Registration Act 1875* 38 & 39 Vict, c91. The Bill took some 20 years to be enacted, possibly because its more radical aspects including provision for registration of trade marks, for assignment and for a single trade mark (registration) system applying to ‘all trade marks of all the various and very numerous manufactures of the United Kingdom’ troubled the Committee: see Id at 27–33 (interviewing William Smith, drafter of the Bill). In the meantime another Bill, which also was considered by the Select Committee (as ‘Bill No 2’) and provided more narrowly for criminal remedies against fraudulent applications of trade marks, was enacted as the *Merchandise Marks Act 1862*: see at 128–139 (Hindmarsh, drafter of Bill No 2, explaining its terms and comparing it with Bill No 1).

\(^{78}\) *Trade Marks Registration Act 1875* s2 (Characteristics of a registered trade mark).

\(^{79}\) In later Acts a definition of ‘trade mark’ was elaborated to mean ‘a mark used or proposed to be used upon or in relation to goods for the purpose of indicating that they are the goods of the proprietor of such trade mark’ (*Trade Marks Act 1905* (UK) s3). Compare *Trade Marks Act 1905* (Cth) s1 (as amended by the *Trade Marks Amendment Act 1912* (Cth)).
A man might put any label he pleases upon his goods ... descriptive of their quality, or recommending them in any way he pleases; but in addition to this description, I think there should be a trade mark that indicated the individual house from which the goods came.  

Further, it was specified that to qualify for registration, a trade mark must consist of certain 'essential particulars' (something not provided for in exactly those terms in the Bill as considered by the Select Committee). Initially this requirement meant that the name, word or device chosen should be represented in a special and particular way. But later, in the _Patents, Designs and Trade Marks Act of 1883_, the list was extended to include fancy or invented words and the like (including newly coined expressions of a non-descriptive character). Even with the distinctiveness threshold expressed in such embryonic form, comparison could be made with design law. In both cases more than simply copying of features previously adopted with respect to the articles in question was needed. As accepted for registration of designs, it would seem the 'more' required 'an exercise of intellectual activity so as to originate, that is to say, suggest for the first time, something that has not occurred to anyone before'. To give effect to such standards an examination and opposition procedure was adopted for registration of a trade mark, like the procedure adopted for registering a design or patent, and care and control of the trade marks register was given to the Commissioners of Patents.

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80 _Select Committee on Trade Marks_, above n74 at 57. Compare and contrast John Smith's later identification of a trade mark as effectively 'equivalent to a man's signature to a letter': id at 58.

81 _Trade Marks Registration Act 1875_ s10. The language of the provision is more restrictive than in the Bill, as drafted by William Smith, which provided that a 'trade mark' might 'include any name, word, letter, mark, device, figure, sign, seal, stamp, label or other thing duly registered as herein provided': see _Select Committee on Trademarks_, above n72 at 129 (Hindmarsh) and also at 28 (Smith) (the words 'trade mark' should include a trader's name — and the name and a symbol combined are 'the best form of trade mark').

82 See _Patents, Designs and Trade Marks Act 1883_ 46 and 47 Vict, c57 s64. In the _Trade Marks Act 1905_ (UK) the latter requirement was slightly modified to allow registration of words having no 'direct' reference to the character or quality of the goods: s9 and compare _Trade Marks Act 1905_ (Cth) s16(1)(d).

83 As observed by Sherman and Bentley, above n70 at 168-70, it was the design system that served as the particular model for the new trade mark registration system — and this (along with the patent system) provided an important point of analogy for the existence of rights, as an aid to interpreting trade mark doctrine, for the shape the system of registration should take, and the language and structure to be used in trade mark legislation'.

84 As with trade marks, originally only able to be registered with respect to goods (registration of service trade marks came later), designs were from the beginning registered with respect to 'articles' of manufacture; see _Designs Registration Act 1839_ 2 & 3 Vict, c17 s1.

85 _In Re Clarke's Design_ [1896] 2 Ch 38 at 30 (Lindley LJ).

86 The opposition procedure was formalised in _Patents, Designs and Trade Marks Act 1883_. Part IV. But in the case of trade marks under the _Trade Marks Registration Act 1875_ the practice was already adopted of advertising applications for registration in the Trade Marks Journal and of giving consideration to notices of objection before registration: see, for example, _In Re Worthington & Co's Trade-Mark_ (1880) 14 Ch D 8.

87 _Trade Marks Registration Act 1875_ s1.
There were other common points with the designs and patent systems. In particular, once registration was granted, the 1875 Act provided for a right of 'exclusive use of such trade-mark' — analogous to the rights granted in registered designs and patents and quite different from common law trade mark protection which was limited to conduct likely to deceive or confuse. Thus the emergent idea of an intellectual property right as entailing an exclusive right, not simply a more easily recognised and transmissible version of the common law right as previously thought by some during the Select Committee hearings, was given legal effect. Trade marks like patents and designs were classified as industrial property in the Paris Convention of 1883, an event which legal historians Brad Sherman and Lionel Bently observed marked the 'crystallisation' of the legal categories. Fifteen years later, the idea of an exclusive property right being obtained in a registered trade mark that was sufficiently innovative to qualify as distinctive for statutory purposes was seen as entirely logical by courts. As Lord Hershell posited in the Soolo case, if a trade mark is invented 'what harm is done, what wrong is inflicted, if others be prevented from employing it, and its use is limited in relation to any class or classes of goods to the inventor?' The question was rhetorical. By then it was simply accepted that the corollary of the innovation threshold adapted across from the designs/patent systems was the granting of an exclusive 'property' right in a registered trade mark.

Why was the design/patent model followed so slavishly in trade mark law? We can already posit that, from an administrative perspective, it must have seemed safer and simpler to take the model being evolved for designs and patents and adapt it for trade marks rather than try to come up with an entirely new model — that appears to be a conclusion of Sherman and Bently as well. Certainly, once

88 Id s3, although eschewing explicit use of the word ‘property’ for a trade mark.
89 See Leather Cloth Co Ltd v American Leather Cloth Co Ltd (1865) 11 HLC 523, 11 ER 1435 at 1442 (Lord Kingsdown) and generally Reddaway v Banham, above n50, concluding also the relevant ‘property’ was not in the common law trade mark but rather in the trading reputation (‘goodwill’) misappropriated through its deceptive use.
90 The latter certainly appeared to be the opinion of William Smith (drafter of Bill No 1), for instance: Select Committee on Trade Marks, above n72 at 28-29 (in answer to the question ‘by the 9th clause of your Bill, you say that when a trade mark is registered, the person in whose name it is registered shall hold it as his personal property, and that it shall be transmissible according to the ordinary rules of law affecting personal property’, Smith replied ‘yes’ — later observing that ‘[t]he expression that there is no property in a trade mark according to law is only partially true, for there is unquestionably a property in a trade mark, for example, I doubt whether Messrs Rodgers & Sons [a well known Sheffield cutlery firm] would take £200,000 for their trade mark tomorrow’. By contrast Hindmarsh (drafter of Bill No 2) argued against recognition of a property right in trade marks on the ground that this would create a monopoly in the trade mark totally and entirely unknown to law': id at 129.
91 Paris Convention for the Protection of Industrial Property (1883) Articles 6-10.
92 Sherman & Bently, above n70 at 61.
93 Eastman Photographic, above n51.
94 Id at 580 — although emphasizing that registration was permitted ‘not as a reward for merit’ (but query whether by the mid 19th century, reflecting the high-point of British utilitarianism, reward for merit rooted in older natural law philosophy was the particular policy driving the design and patent registration systems either: compare Sherman & Bently, above n70 ch 3 ‘Designing the law’).
95 See above n83.
the need for a registration system was accepted, there was no consideration of any alternative approach to that proposed in the Select Committee hearings or 13 years later when the Trade Marks Bill 1875 was enacted: it was introduced in June and passed by August with no further discussion.96 And among some of those responsible for the British legislation there did seem to be a rather simplistic view that trade marks, at least those worthy of registration, were rather like designs and inventions and to be protected for similar utilitarian reasons: stimulating innovative activity (seen as important in a country in the midst of the industrial revolution, and appreciative of its benefits). At the same time, conceiving of the ideal trade mark as a creative embodiment enabled the 19th century lawmakers to meet concerns about the costs of restricting competition in a strongly laissez-faire economy. The benefits of some restraints on untrammelled competition in order to reward and promote innovation had already been accepted for patents and designs;97 now the reasoning could be extended to trade marks as well — albeit without much thought being given to the social value of the ‘innovation’ concerned.

Finally, a particular benefit of a distinctiveness-cum-innovation threshold for trade marks was identified in a report issued on the workings of the Patents, Designs and Trade Marks Act 1883,98 where it was said that:

Words are, undoubtedly, a most popular form of trade-mark, but some limit must obviously be put upon the words which an individual may be permitted to register and claim the exclusive use of ... [N]o one ought to be granted the exclusive use of a word descriptive of the quality or character of any goods. Such words of description are the property of all mankind, and it would not be right to allow any individual to monopolise them and exclude others from their use.99

And similar sentiments were expressed in the Solio case, by Lord Herschell: ‘The vocabulary of the English language is common property: it belongs alike to all’.100

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96 As recorded in Hansard’s Parliamentary Debates (3rd Series, 39 Vic, 1875).
97 Including by leading utilitarians of the day including Jeremy Bentham and John Stuart Mill, as well as (some years earlier) Adam Smith. All favoured a limited term of monopoly in exchange for the ingenuity and effort expended in developing a profitable invention, seen as an engine of the British economy’s growth and development — primarily these writers were talking about patents here. For a careful survey of contemporary opinion, see Harold Dutton, The Patent System and Inventive Activity During the Industrial Revolution 1750–1852 (1984) at 17–29 (concluding ‘inventive activity was associated with progress as well as private profit, and this probably explains why the argument was so popular during the early nineteenth century’); and further M Richardson ‘Owning Secrets: Property in Confidential Information?’ in A Robertson (ed), The Law of Obligations: Principles and Boundaries (2004) at 145.
98 Report of a Commission Appointed by the Board of Trade to Inquire into the Duties, Organisation and Arrangements of the Patent Office under the Patents, Designs and Trade Marks Act 1883, so far as relates to Trade Marks and Designs (81 PP C 5350, 1888).
99 Id at 21. The statement is quoted (with approval) by Halsbury LC in Eastman Photographic, above n51 at 574.
100 Eastman Photographic, above n51 at 580. Compare id at 574 (Lord Halsbury LC) and 583 (Lord MacNaghten). See also Joseph Crosfield, above n53 at 854 (Cozens-Hardy MR), in a passage more openly cynical as to the motives of traders: ‘Wealthy traders are habitually eager to enclose parts of the great commons of the English language and to exclude the general public of the present day and of the future from access to the enclosure’.
The concern was not just that competition might be hindered if other traders would be denied the ability to employ common language terms to describe and extol their products. Maintaining a language commons that would be freely accessible to the community at large was seen as linguistically essential at the end of the 19th century. Linguistics — the systematic study of language development — had by then become more than a field of academic study: it had captured the public imagination in the same way as philosophy and economics had done so the century before (and continued to throughout the period). Various explanations have been offered of the rise, including the growth of universities and popular education, the establishment of learned societies, the establishment of periodicals, even the publication of the *Oxford English Dictionary* in 1860. Whatever the explanation, it is clear the study of language took a 'momentous turn' in the course of the century. And historical comparative linguistics, with its perception of language as a product of refinement taking place over centuries, dominated the discourse. Premising trade mark registration on a degree of real innovation was the way lawmakers had to alleviate fears about the effect of exclusive trade mark rights on the 'great open commons' of the English language; a language whose central significance for the process of intelligent thought, the articulation and communication of information and ideas, and the maintenance of a cultural tradition was the subject of serious study. Compare thus the words quoted earlier from the 1883 trade marks report and *Solio* case and those of influential German linguistic scholar Wilhelm Von Humboldt in *Über die Verschiedenheit des Menschlichen Sprachbaues* (1836): 'A people's speech is their spirit, and their spirit is their speech.' Compare also the words of the English language commentator, Archbishop Richard Trench, in his popular set of lectures *On the Study of Words* first published in 1851: '([Language] is the embodiment, the incarnation ... of the feelings and thoughts and experiences of a nation .... With such views commonly held to in the mid-19th century, and with a still limited understanding of the process of language development, it was

101 Albeit this was a primary concern of some judges: see, for example, above n58 and n100.
103 See generally Robert Evans, *The Language of History and the History of Language* (1998) at 21–29. Harris, above n2 at 8 also points to the 'quasi-mystical' (religious) approach to language, which had developed by the mid-19th Century.
104 Evans, above n103.
106 This is Robbins' translation: see Robbins, above n102 at 165. (Von Humboldt's words '[i]hre Sprache ist ihre Geist und ihre Geist ihre Sprache' (Humboldt, above n105 at 7) are more literally 'your speech is your spirit, and your spirit your speech'.)
107 Richard C Trench, *On the Study of Words* (1851), began as a series of lectures at the Diocesan Training School, Winchester. It was republished in many editions including the one from which the following quotation is taken (1890 ed).
impossible to imagine common language expressions being registered let alone used as a trader's exclusive proprietary mark. Indeed, even for common law trade marks it took some 50 years more before secondary reputation established in otherwise common terms could be recognised as sufficient to mount a passing off action against deceptive or confusing use — a change which was evidently more difficult still to effect in the case of the more elaborately articulated and conceptually entrenched registration system.

In summary, it would seem that for a multitude of reasons the British registration system was not adopted and was certainly not applied to offer protection to what later were accepted as common law trade marks — those which had become associated with trading goodwill/reputation (which, after some initial uncertainty, were able to be protected under the common law passing off doctrine). Nor was its purpose to protect marks that predictability would emerge as common law trade marks in the future. Rather, as Lord Parker noted in W & G Du Cros Ltd in 1913, registration was permitted for 'certain kinds of mark (somewhat limited in number) which the Legislature considered appropriate for use as trade marks'. The aim was to foster the generation of ideal trade marks, words or phrases whose creativity was sufficient to take them out of the common pool and avoid any risk of destruction of the natural language. Correlatively, any trade mark that was able to meet trade mark law's inherent distinctiveness standard was assumed to be safe for and indeed entitled to have full and exclusive 'proprietary' rights. It was only later that infringement came to be treated by courts as essentially a hypothetical version of the common law passing off action. And since the right to claim infringement was for a long time restricted to goods, and later services, covered by the trade mark registration (a restriction only abolished in part when required by TRIPs), this led to the illogical position of a trade mark system harder to access yet scarcely broader in protection than its common law counterpart.

108 Id at 29, adding, more floridly, that 'language is the amber in which a thousand precious and subtle thoughts have been safely embedded and preserved. It has arrested ten thousand lightning flashes of genius, which, unless thus fixed and arrested, might have been as bright, but would have also been as quickly passing and perishing, as the lightning'.

109 After some initial hesitation (the Trade Marks Registration Act 1875 was unclear, stating simply that an infringement action could not be brought without registration of the trade mark: s1; and deemed registration to be equivalent to public use: s2). But see, for example, Great Tower Street Tea Co v Langford (1888) 5 RPC 66; Faulder v Rushton (1903) 20 RPC 477, and Reddaway v Banham, above n50; and generally William R Comish, Intellectual Property (2nd ed, 1989) at 395.

110 W & G Du Cros, above n47.

111 Id at 636.

112 Id at 636.

113 Infringement terms were not spelt out in the early British Acts, but were left to courts, only codified in the Trade Marks Act (1938) UK to require the use of a trade mark identical with the registered mark or one so nearly resembling it as to be likely to deceive or cause confusion (s4). In the case of the Australian legislation statutory codification occurred earlier and 'substantially identical' was used in place of 'identical': Trade Marks Act 1905 (Cth) s53.
The above position has largely been maintained across the British Commonwealth common law world. Only the United States went a different way in earlier recognising simple status as a common law trade mark as the basis of a trade mark's entitlement, an approach later codified in the Lanham Act 1946. At the same time the Lanham Act for a long time granted little different protection to registered trade marks than was available at common law. But in 1996 the US legislature endorsed trade mark 'dilution' as a basis of a separate claim under an amended Lanham Act (again, without restriction to registered trade marks although protection is limited in another way: viz to trade marks deemed 'famous') and before that many US states had their own anti-dilution laws.

114 By about the middle of the 20th century courts had generally come to assume that the identical or substantially identical basis for claiming infringement was there for a narrow class of cases where likely confusion could be presumed without the need for this to be proved: see, for example, Shell v Esso, above n23 at 414-5 (Windeyer J): in assessing substantial identity, a close side by side comparison of similarities and differences should be undertaken—a trade mark had to be virtually literally identical to satisfy the standard. Conversely, the deceptively similar/likely confusion basis for claiming infringement emerged as a flexible impressionistic standard, and a hypothetical one at that: see ibid and further Southern Cross Refrigerating Co v Toowoomba Foundry Pty Ltd (1954) 91 CLR 592 at 595 (Kitto J) (the question is what can the registrant do with the trade mark once registered).

115 See above n46.

116 Including in Australia which, even before enactment of the first Commonwealth legislation in 1905, modelled on the UK Act of 1905, found state law counterparts to the UK Acts of 1862 and 1875—see, for example, Trade Marks Act 1865 (NSW) and Trade Marks Act 1876 (Vic).

117 In part the reasons were constitutional. The US Constitution 1788 did not specify trade marks as 'intellectual property'; and when the need for federal legislation became apparent the Supreme Court refused to consider trade marks to be analogous to copyrights or patents in the early Trade-Marks Cases 100 US 82 (1879) (concluding 'the ordinary trade mark has no necessary relation to invention and discovery'), leaving their treatment under the Constitution's commerce clause open. The Australian Constitution 1901 included trade marks within its intellectual property head of power: s51(xviii). The High Court has noted 'the efforts in coining a new trade mark' were sufficient to warrant the general epithet 'intellectual effort': Grain Pool of Western Australia v Commonwealth (2000) 46 IPR 515 at 527 (Gleeson CJ, Gaudron, McHugh, Gummow, Hayne & Callinan JJ).

118 Lanham Act § 2, 15 USC § 1052.

119 Thus use is a requirement for trade mark protection: see Lanham Act § 1, 15 USC § 1051 (and although actual use may be delayed for up to 36 months, any delay past 12 months requires 'good cause'). Also, infringement has the same focus on likely confusion in the case of registered and unregistered trade marks Lanham Act § 32 and 43(a), 15 USC § 1114 and 1125(a) and see Polaroid Corp v Polarad Electric: Corp 287 F 2d 492 (1961) at 495 (factors relevant to assessing likelihood of confusion). See generally J Thomas McCarthy, McCarthy on Trademarks and Unfair Competition (4th ed, 2003).

120 Lanham Act § 43-45, 15 USC §§1125–1127: 'dilution' defined as 'lessening of the capacity of a famous mark to identify and distinguish goods or services, regardless of the presence or absence of ... likelihood of confusion, mistake or deception'. See J Thomas McCarthy, 'The 1996 United States Federal Anti-Dilution Statute' (1998) 9 AIPJ 38. See also (for the domain name field) Anticybersquatting Consumer Protection Act (1999) § 3002, 15 USC § 1125(d)(IA).

Continental European countries have also traditionally recognised a wide range of harms as covered by their trade mark and unfair competition laws, not only those that depend on likelihood of confusion, but their choices could more easily be dismissed as antithetical to the concerns of pragmatic common law jurisdictions (especially outside the UK whose European Community membership imposes obligations to harmonise trade mark law to meet European standards). The latest development put new pressure on British Commonwealth countries to reassess the fundamentals of trade mark law, with courts invited to construe existing trade mark infringement provisions to extend to dilution and the question of legislative law reform openly raised on more than one occasion.

4. Mapping the Future: Towards a Market in Language

In the context of today's modern world should our trade mark system continue along historical lines? There are several reasons to think it should not.

First, modern sociolinguistic studies of language development have now established language as a far more resilient, adaptable and interesting creature than the historical linguistic scholars imagined. From the early 20th century on, writers such as Franz Boas at Columbia, Edward Sapir at Yale and anthropologist Benjamin Whorf began to observe the dynamic relationship between language and

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122 In the French case, for example, the broad provisions of Art 1382 Code Civil inter alia encompass protection against disloyal competition, parasitic trading and other kinds of unfair competition, the German UWG specifically prohibits unfair trading practices. The Uniform Benelux Law on trade marks deals with cases of trade mark uses that 'may cause damage to the owner'. The last was the model for Trade Marks Directive 1988 Art 5(2), which allows EC Member States the option to include trade mark anti-dilution protection under their national law. This has been implemented in most member States: see Adidas-Salomon AG v Fitnessworld Trading Ltd Case C-408/01 (ECJ, October 2003). See generally Anselm Sanders, Unfair Competition Law (1997) and Richardson, above n8.

123 Query whether the UK has fully implemented Trade Marks Directive 1988 Art 5(2) but the commitment to harmonisation of laws that went with EC membership inevitably has had some influence: see Arsenal Football Club plc v Reed [2003] RPC 144 (ECJ) and Arsenal v Reed [2003] 3 All ER 865 (CA) (literal anti-dilution right against unauthorised use of 'Arsenal' for character merchandising unavoidable under the UK Act of 1994).

124 See, for example, the Australian Council on Intellectual Property (ACIP), Review of Enforcement of Trade Marks: Issues Paper (2002) <http://www.acip.gov.au> at 4.8.3 – inquiring whether anti-dilution rights should be available for well-known or famous trade marks. The World Intellectual Property Organisation has also established a panel to consider harmonisation of laws on trade marks, geographical indications and designs – trade mark dilution may well be considered there. And the Assemblies of WIPO and the Paris Union have adopted a 'soft treaty' on the protection of well-known marks (see 34th Series of Meetings of the Assemblies of Member States of WIPO, September 20 to 29, available at <www.wipo.int/about-ip/en/development_iplaw/doc/pub833.doc> As yet, however, the issue is not on the TRIPs agenda and nor was protection against dilution specified in the Australia-United States Free Trade Agreement (March 2, 2004).

125 Sociolinguists are 'centrally concerned with living language in society, with speech as the most fundamental element of human community': Evans, above n103 at 11. See Suzanne Romaine, Language in Society: An Introduction to Sociolinguistics (2nd ed, 2000) and Richard Hudson Sociolinguistics (2nd ed, 1996); and for a particularly lucid account John Carroll, Language and Thought (1964).
There are 'important interconnections ... between language, culture and psychology', Whorf observed in 1941, referring to his mentor and teacher Sapir.127 (Whorf himself went even further than Sapir in arguing not just the surface elements of a language, its vocabulary, but its structure, or grammar, are an important shaper of ideas.)128 In 1929 Sapir had already noted that 'language is becoming increasingly valuable as a guide to the scientific study of a given culture'.129 Four years later he added:

Changes in vocabulary are due to a great variety of causes, most of which are cultural rather than of a strictly linguistic nature. The too frequent use of a word, for instance, may reduce it to a commonplace term so that it needs to be replaced by a new word. On the other hand, changes of attitude may make certain words with their traditional overtones of meaning unacceptable to the younger generation, so that they tend to become obsolete. Probably the most important sources of changes in vocabulary is the creation of new words on analogies which have spread from a few specific words ... [as well as] borrowings of words across linguistic frontiers. This borrowing naturally goes hand in hand with cultural diffusion.130

Such observations identify important features of language not previously well understood: its adaptability in the face of cultural change, its inclination to borrow from myriad sources as well as its influence as a cultural device. They challenge the negative premise of the inherent distinctiveness construct, viz protection of the language commons, pointing to positive as well as negative influences of social discourse and context for language development. And they suggest the need to map not assume in advance. Thus they reinforce the conclusion that, at best, inherent distinctiveness should be a measure of inchoate common law trade mark status, its conclusions easily able to be displaced by showing secondary reputation.131 Further, more unexpectedly, they raise the prospect of trade marks emerging as a kind of language of their own. At their highest trade marks 'carry a lot of symbolic freight. They do more than identify ... things. They reveal social

126 Although sociolinguistics emerged as a formal discipline only in the 1960s, its roots lie further back. In the US they can be traced to the pioneering work of inter alia Franz Boas, his pupil Edward Sapir and Sapir’s pupil Benjamin Lee Whorf who premised their radical insights about the intersection of language and culture on their anthropological studies of American Indian tribes. See generally Hudson, above n125 at 1, 95ff. These scholars were working in the US. For early influences across the Atlantic of Swiss linguistic scholar Ferdinand Saussure and Cambridge philosopher Ludwig Wittgenstein, see Harris, above n2.


128 See, in particular, Whorf’s most well-known article ‘Science and Linguistics’ (1940) 42 Technological Rev 229, reprinted Carroll, above n127 at 227.


hierarchies ... [and] acts of identity — in short, they satisfy the sociolinguistic idea of what language is and should be. Current trade marks theories identify the value of trade marks as lying in their ability to identify 'things'. These theories might explain the law’s focus on avoiding likely confusion as the most obvious threat to the identification function. But at best they offer only a plausible reason for anti-dilution rights in asserting a trade mark may over time be harmed in its trade mark capacity — leaving them open to the critique of pandering to owner interests without clear social benefit. Sociolinguistics reveals trade marks that cross the threshold from commercial indicators to expressive devices to be not only more language-like, but more truly intellectual property-like, than before supposed (and not simply in the impoverished sense of the intellectual effort expended in achieving inherent distinctiveness, which ultimately became insufficient to sustain any broad notion of a registered trade mark as an exclusive

131 This need not be seen as violating the bare notion of ‘intellectual effort’ which is referred to in Grain Pool, above n 117 as the guiding principle of the intellectual property head of power in s51(xviii) the Australian Constitution. As the High Court noted in Grain Pool, that standard does not set a particularly high threshold for intellectual property protection, and in the case of trade marks the historical understanding of the concept ‘trade mark’ which may have prevailed when the Constitution was enacted should not be seen as giving ‘the circumstance’ of the power: id at 520–1 (Gleeson CJ, Gaudron, McHugh, Gummow, Hayne & Callinan J), citing Higgins J (dissenting) in Attorney-General (NSW) v Brewery Employees Union of New South Wales (1908) 6 CLR 469 at 610 (and revealing a rather sociolinguistic perception of the Constitution’s language as something whose meaning may change over time). Rather, intellectual effort for Constitutional purposes can now be understood as accommodating even the development of secondary reputation as a kind of ‘borrowings of words across linguistic frontiers’, to use Sapir’s words.

132 Suzanne Romaine said this of language generally: see Romaine, above n 125 at 244–5.


134 See, for example, Landes & Posner, above n 133 at 307 – the first (and main) economic ground for ‘the extension of the property right in a trademark beyond its use to identify a brand ... is that there is a potential for confusion because ... the connotations of the name will blur’. See, however, Posner, ‘Misappropriation: A Dirge’ (2003) 40 Houston L Rev 621 at 624–5 (expressing concern that anti-dilution rights may be construed to grant too much to a trade mark owner, without necessarily significant benefits). In sum, Posner now appears rather ambivalent about dilution. For a more sophisticated defence of a trade mark anti-dilution right (still resting on the damage that may be done to the trade mark function but adopting a broader notion of what that function is) see Schechter, above n 23. But the same criticism may be made (suggesting at least the need for proof of actual or likely damage in actual cases). Interestingly, Schechter also appears attracted to the notion that ‘coined, arbitrary or fanciful words or phrases’ — ie, inherently distinctive trade marks — are particularly deserving of protection, because they have ‘added to ... the human vocabulary’: see id at 829.
The utilitarian justification for copyright protection, lying in providing incentives for artistic and cultural development for the broader social benefit, can be extended to these new cultural items. For these trade marks, at least, infringement can be rationally extended to encompass uses that will likely blur or tarnish their expressive associations, reducing them to 'the commonplace' or rendering them socially 'unacceptable'.

Sometimes it is suggested trade mark owners do not require or warrant the mantle of anti-dilution protection, evidenced by the fact that there are expressive trade mark uses even without it. But the question is whether there would be greater efforts by traders generally to develop the expressive dimensions of their trade marks in the knowledge they can retain their benefits for longer than the uncertain leadtime until the first copier comes along. If the evidence from copyright is a guide, the answer should be yes. Rational traders who anticipate rewards flowing from taking on the role of cultural ambassador will do so more readily. The role will not be left, as now, to traders whose resources and standing give control of the public consciousness without great need for legal protection against dilution — those able to select trade marks for their 'effervescent qualities' then inject them into the stream of communication 'with the pressure of a firehose'. In this regard, US anti-dilution law is not necessarily helpful in pointing to the full extent of benefits that could be reaped through a well-tailored law. For instance, the US federal Act's requirement for a trade mark to be 'famous' to have the benefit of protection seems designed to ensure only those

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136 See especially Rochelle Dreyfuss, 'Expressive Genericity: Trademarks as Language in the Pepsi Generation' (1990) 65 Notre Dame Rev 397 at 408-9. (Dreyfuss goes further in arguing the audience is as much responsible to expressive trade mark meaning as those who claim ownership, and they should share the benefits — and compare Coombe, above n9). See also Landes & Posner above n133 at 293 ('[o]ur society seems not to suffer from such lexical poverty that a more extensive system of property rights in words is needed to alleviate it').

137 Although reliance on potentially self-interested testimony is risky, Eldred v Ashcroft 537 US 186 (2003) on the Constitutionality of the Copyright Term Extension Act (1998) US reveals many of those generating copyright works do so in hope of 'fair' financial rewards: see Ginsburg J at f15 (testimony of Quincy Jones, Bob Dylan, Carlos Santana and others in Senate Hearings on the Act). See also Robert Fry, 20th Century English art historian, quoted Megan Richardson, Joshua Gans, Frances Hanks and Philip Williams, The Benefits and Costs of Copyright: An Economic Perspective (Copyright Studies Centre, 2000) at 7 ('almost all artists who have done anything approaching first-rate work have been thoroughly bourgeois people').

138 Dreyfuss interestingly acknowledges this: Dreyfuss, above n136 at 424 ("[i]t would be interesting to know whether expressive use of trademarks is expanding", and suspecting it is "true").

139 See Kozinski, above n6.
traders who already dominate the public consciousness gain legal protection.\footnote{410} Further, as the Supreme Court noted in *Moseley v Victoria’s Secret Catalogue*\footnote{411} actual dilution must be proved under the Act\footnote{412} and it is questionable whether tarnishment is even covered in statutory language focused on ‘lesssening’ of the trade mark function.\footnote{413} State laws may be different, however.\footnote{414} And with European trade mark and unfair competition laws protecting against dilution in more flexible terms, European-origin labels as diverse as ‘Champagne’ (the prestigious and ‘joyful’ name for wine made by the Champagne method in the Champagne region of France),\footnote{415} ‘Clareyn’ (literally ‘clear water’, also a Dutch genever label connoting clarity and purity),\footnote{416} ‘and ‘Arthur’ (a name chosen and promoted as ‘*drôle et poétique*’ for clothing in France)\footnote{417} have within Europe developed and maintained a unique expressive *cachet*. Australia has few Australian-origin expressive trade marks of great note. Instead we have a history of attempts to appropriate national icons with their own cultural messages intact for registration as trade marks.\footnote{418} Our quintessentially Australian trade marks — including ‘Vegemite’, ‘Freddo’, ‘Qantas’ and perhaps ‘Tim-Tam’\footnote{419} — are

\footnotetext[410]{410} ‘Fame’ is not defined but factors which a court may consider are given (including duration and extent of use and of advertising and publicity of the market, geographical extent of the mark’s trading area, and degree of recognition of the mark): see *Lanham Act* § 43(c)(1), 15 USC § 1125(c)(1). It has been suggested only ‘household words’, the ‘best known marks in commerce’, could satisfy the standard (*TCIP Holding Co Inc v Haar Communications Inc* 244 F 3d 88 (2001), 99).

\footnotetext[411]{411} *Moseley v Victoria’s Secret Catalogue Inc* 537 US 418 (2003). The facts are noteworthy: the defendants adopted ‘Victor’s Secret’ as the name of their lingerie store, subsequently changing this to ‘Victor’s Little Secret’ after complaints from the Victoria’s Secret owner. Dilution was claimed, but without evidence (circumstantial or otherwise) of blurring or tarnishment.

\footnotetext[412]{412} Id at 433-4 (Stevens J) (for the Court) — adding scientific proof is ideal, except where dilution can ‘reliably be proven through circumstantial evidence’. In a concurring opinion, Kennedy J said it should be enough to show ‘diminishment of the mark’s capacity to serve its purpose’ will be the ‘probable consequence’ of the defendant’s actions rather than forcing the plaintiff to wait ‘until the damage is done’: id at 435-6.

\footnotetext[413]{413} Id at 432 (Stephens J) (though noting the intention was to include tarnishment).

\footnotetext[414]{414} See generally Klieger, above n121 at 812-3 (the laws discussed omit requirement of fame, specifically allow for likelihood of dilution harm, and clearly encompass tarnishment).


\footnotetext[416]{416} And the subject of one of the most famous European dilution cases decided under the *Benelux Act* when a sound-alike ‘Klarein’ was adopted for a cleaning product, *Colgate Palmolive BV v NV Koninklijke Distilleerderijen Erven Lucas Bols* [1979] EEC 419 — see Charles Gielen, ‘Harmonisation of Trade Mark Law in Europe’ The First Trade Mark Harmonisation Directive of the European Council” [1992] 8 *EIPR* 262.

\footnotetext[417]{417} See generally <http://www.arthur.tm.fr/> (L’histoire d’Arthur). On reference from a Paris court the ECI recently held the issue whether “Arthur et Félicie” (the name adopted for a children’s clothing label) involved use of an ‘identical’ trade mark for purposes of the Trade Marks Directive, entailed an impressionistic test (albeit not a flexible one): *LTJ Diffusion SA v Sédat Verthauder SA* C-291/00 (ECJ – 20 March 2003).}
primarily employed as identifiers rather than cultural artefacts. Not surprising when those whose efforts are more ambitious receive, at best, patchy legal support from the law.\textsuperscript{130} Most of our popular culture comes from elsewhere. For champions of a locally grown Australian popular culture, more incentives might thus seem better than less.

More incentives, thus broader rights against dilution, need not come at the cost to public access. It is now clearer than perhaps in the 19\textsuperscript{th} century that property rights, especially intellectual property rights, need not be absolute and there are good reasons sometimes for curtailing them.\textsuperscript{131} One useful insight from historical linguistics is that ownership of trade mark language may lead to private control over social meaning.\textsuperscript{132} If so, this is something that needs to be addressed. Noam Chomsky\textsuperscript{133} identifies the issue succinctly:

The principles of people like Von Humboldt ...were that people should be free. They shouldn't be under the control of authoritarian institutions ... [T]he idea of developing ... popular control over all institutions, economic, political and so on ... is the right direction to move. This is not a new idea; in fact, its roots are as old as classical liberalism.\textsuperscript{134}

\textsuperscript{148} For an interesting review, see Owen Morgan, 'National Icons and the Trade Marks Act 1995' forthcoming \textit{AIPJ} (2004) citing Brenda Lomas's recent attempt to register 'Waltzing Matilda' as a trade mark for a vast range of goods and services. In the Lomas case registration was objected to inter alia on the ground of prior ownership by the Winton Shire Council (home of the Waltzing Matilda Centre), without success. \textit{Winton Shire Council v Lomas} [2002] FCAFC 413. The court did not consider whether a common expression such as 'Waltzing Matilda' could be distinctive in the absence of secondary reputation. In the UK attempts to register common cultural symbols as trade marks have been rejected as lacking distinctiveness: see, for instance \textit{Re Elvis Presley Trade Marks} [1997] RPC 543.

\textsuperscript{149} As well as being established common law trade marks, these are all long registered (in the case of Vegemite for more than 70 years: see trade mark 37184; registered in 1928).

\textsuperscript{150} As, for example, in \textit{C4 Homershe & Co v Rosemount Estates Pty Ltd} (2000) 52 IPR 42 (evocative 'Hill of Grace' wine label not infringed by adoption of 'Hill of Gold' for a cheaper wine and nor was there passing off -- in part because the connotations of Hill of Gold (more mercenary) were different from those of Hill of Grace (more spiritual). That the use appeared tarnishing counted against likelihood of confusion.) Fictional and human characters have sometimes been more generously treated in their claims of confusing misuse of their trade marks and images, especially in Australia, leading some to suggest a \textit{de facto} anti-dilution standard may be employed for them (see for instance S Ricketson, 'Character Merchandising in Australia: Its Benefits and Burdens' (1990) 1 AIPJ 191).

\textsuperscript{151} A point I have laboured in Richardson, above n97. The insights, such as they are, owe much to Kevin Gray, 'Property In Thin Air' (1991) 50 Camb L J 252. In fact, trade marks are identified as 'property' in the \textit{Trade Marks Act} 1995 (Cth) but with no clear significance, apart from assignability etc, attributed.

\textsuperscript{152} A term coined by Lawrence Lessig (and although not talking specifically about control over trade marked language): 'The Regulation of Social Meaning' (1995) 62 U Ch L Rev 943.

\textsuperscript{153} Chomsky saw his roots lying in historical linguistics. However, his primary interest was with the 'deep structure' of the language. He did not go as far as Von Humboldt and others in identifying the vocabulary of language as the proper subject of scientific study, commenting that 'the concept of language is very obscure, and it is not clear that there is any intelligible or significant notion'. Noam Chomsky, \textit{The Generative Enterprise: A Discussion with Romy Huybregts and Henk van Rees} (1982) at 108. As such, the following statement is interesting in suggesting the language institution, as other institutions, may be worthy of analysis.
Put simply, if the risk is that trade mark owners allowed unlimited control over the use of their language will seek to exploit this as means of restriction and censorship inhibiting possibilities for valuable expression by others, then control should be separated from ownership. As linguistic expert Roger Shuy observes, in trade mark disputes it often emerges that more important than the question 'who can own language' is the question 'who ... [can] determine what can be said or written'.

There are cases already that show trade mark owners unready to allow uses of their trade marks that they believe could reflect badly on them, or are controversial, or lie too far outside the scope of their activities, no matter their overall social value (and including in cases where those who wish to use will pay). Will efforts at restraint simply increase with an expansion of rights against dilution? Does the proliferation of internet gripe sites show the benefit of rights not being expansive? Is it enough perhaps that courts already have the power to tailor remedies to facilitate use on payment terms (as a kind of compulsory license)?

The prospect that trade mark owners, given full anti-dilution rights, might seek to prevent the use of 'The Pink Panther Patrol' for a public safety campaign mounted by the gay community, or 'Pee Wee Scouts' as the title of a series of children's book, or 'Barbie Girl' as the name of a pop song mildly lampooning the Barbie image, or 'Star Wars' to critique a government's defence policies, to name but four US cases where dilution has been rather bizarrely claimed, raises the spectra of unfree speech in a society that generally values free speech and may

156 As in Campomar v Nike International Ltd (2000) 202 CLR 45 – when Campomar in 1985 sought permission for Nike to use its trade marked word for sports perfume, the response was "we do not believe perfume and cosmetic products are part of this company’s image": id at 62. When Campomar commenced using the ‘Nike’ label for its own sports perfume without licence, Nike claimed inter alia passing off. (That Campomar adopted a block-printing style assisted the finding of passing off: see Sheppard J at first instance: Nike v United Pharmaceutical (1996) 35 IPR 385 at 408.)

157 In the intellectual property context, a monetary award granted in lieu of an injunction can be viewed as a kind of compulsory licence; sometimes this may be an efficient response to market failure: see Dennis Karjala, ‘Misappropriation as a Third Intellectual Property Paradigm’ (1994) 94 Colum L Rev 2594 at 2608 and generally Guido Calabresi & A Douglas Melamed, ‘Property Rules, Liability Rules and Inalienability: One View of the Cathedral’ (1972) 85 Harvard Law Review 1089.

158 See MGM–Pathé Communications Co v The Pink Panther Patrol 774 F Supp 869 (1991) – the slogan ‘The Pink Panther Patrol’ used for a gay community based safety patrol held to likely confuse the public about possible sponsorship (which the First Amendment would not exempt) irrespective of the defendant’s political motives and the absence of evidence of actual confusion. The dilution claim under New York law was not considered.

159 See Girl Scouts of United States v Bantam Doubleday Dell Publishing Group Inc 808 F Supp 1112 (1992) – the use of the title considered not to disturb the ‘fame, reputation and selling power’ of the scout movement’s trademark expression ‘Scouts’ for the purposes of New York anti-dilution law. Thus First Amendment objectives could be served.

160 See Mattel Inc v MCA Records 296 F 3d 894 (2002). The use was held non-commercial by the US Court of Appeals (9th Cir), and exempted under the Federal Dilution Act: see n178 ff.

161 See Lucasfilm, Ltd v High Frontier 622 F Supp 931 (1985) – claims of ‘trademark infringement, unfair competition, misappropriation, disparagement’ etc dismissed on the basis that the defendants made no commercial use of ‘Star Wars’ (and in particular, the educational services they provided did not amount to the ‘selling of ideas’).
even provide for it in its Constitution. Even if plaintiffs generally fail in legal terms, the worry is their ability to threaten will be enough to stop the practice. In part, though, this depends on the perceived public reaction — since one thing experience of the internet has taught (if not already known) is that traders in the public eye are sensitive to their audience. Laws can help shape attitudes.

"[S]ocial norms and laws are often mutually supporting", as political scientist Robert Axelrod has observed, giving free speech as a particular example. Ideally, a well framed anti-dilution law would tailor its defences to not only sanction but *publicly* sanction traders who fail to respond positively to genuine efforts to facilitate public discourse (in the same way as fair dealing/use defences to copyright infringement may be openly used for free speech ends). An exception for 'good faith' use of the expressive component of a trade mark could encompass uses that valuably promote public debate on matters of political or social concern — including about the image projected by the trade mark itself. And a factor in determining 'good faith' might be whether genuine effort has been made to obtain agreement, or at least make some reasonable accommodation of an

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162 As the US does in the Constitution's First Amendment. As to Australia and the UK, see below n166.

163 The ability of law to change social norms (as opposed to simply regulate) for utilitarian ends has become a fruitful subject for new law and economics. For pioneering writings, see especially Lessig, above n152; Cass Sunstein, 'Social Norms and Social Roles' (1996) 96 Colum L Rev 903; Richard McAdams, 'The Origin, Development, and Regulation of Norms' (1997) 96 Mich L Rev 338; and Robert Cooter, 'Expressive Law and Economics' (1998) 27 J Legal Stud 585.

164 Robert Axelrod, *The Complexity of Cooperation: Agent-based Models of Competition and Collaboration* (1997) at 61 — adding that the law is particularly likely to be an effective instrument of socialisation where it serves to reinforce values that 'have already attained strength as a social and political norm'.

165 As, for example, in the recent case of *Suntrust Bank v Houghton Mifflin Co* 268 FJd 1257 (2001) (*Wind Done Gone* parody of *Gone With the Wind* held a fair use under US copyright law). In 'Fair Use as Market Failure: A Structural and Economic Analysis of the Betamax Case and its Predecessors' (1982) 82 Colum L Rev 1600, Wendy Gordon classically points to market failure as an explanation for at least part of the operation of the US fair use doctrine. Later Gordon adds that not all uses — especially those impacting free speech — need to be analysed in market failure terms, unless 'market failure' is taken also to accommodate cases where economic norms are inappropriate to govern: Wendy Gordon, 'Excuse and Justification in the Law of Fair Use' in Niva Elkin-Koren & Neil Wenstock Netanel, *The Commodification of Information* (2002) at 149. In my view the broader understanding of 'market failure' should prevail.

166 Uses that target the original material are particularly appropriate for such a defence (see also Michael Spence, "Intellectual Property and the Problem of Parody." (1998) 114 LQR 594 making the point generally that target parodies are worthy of particular protection). But other expressive uses may have social value as well, as for instance 'Star Wars' used for political purposes: above n161. This suggests benefits should be weighed against costs to determine overall benefit. Indeed, political expression should be constitutionally protected under the implied freedom of political discussion found by the High Court in the Australian Constitution: for this implicating private rights see *ABC v Lenah Game Meats Pty Ltd* (2000) 208 CLR 199 at 224 (Gleeson CJ). In the UK, given implementation of the European Human Rights Convention 1950 in the *Human Rights Act* 1998, free speech is provided for in even broader terms (Art 10 of the Convention).
owner's concerns, before proceeding to use, bearing in mind that accommodation may not always be feasible or appropriate.\footnote{167}

In the Australian case of the \textit{Campomar Sociedad Ltd v Nike International Ltd},\footnote{168} where the issue of dilution under the \textit{Trade Marks Act 1995} (Cth) was touched on, it was suggested the infringement action might extend to this on present legislative terms — or at least "to some extent".\footnote{169} The court at the same time noted countervailing interests in free competition, honest concurrent trade mark use, and "free and open communication".\footnote{170} The court also noted that dilution implicates trade marks functions going "beyond the traditional role as an identifier of origin".\footnote{171} It will be interesting to see the court developing these ideas further in an actual case. On its face they offer a second best solution. While it is possible that, on a rather extended reading, the existing provisions of the \textit{Trade Marks Act 1995} (Cth) could be stretched further to trade mark dilution a court seeking to do so would face several problems in dealing in a new way with standards previously assumed to be focused on likely confusion.\footnote{172} And more difficult to overcome is the absence of any defence tailored specifically to fostering public debate. There are partial defences; for instance, the Act allows for comparative advertising, good faith descriptive use, even honest concurrent use covering cases where traders have independently developed similar trade marks.\footnote{173} The flexibility courts have to limit a remedy for infringement should not be underestimated as a device for de facto compulsory licensing. And infringement

\footnote{167} As, for example, where a parody is meant to forcefully critique and/or lampoon the original (something Gordon was also concerned with, identifying parody as a fair use for which permission should not be required: Gordon, 'Excuse and Justification' above n65 at 159). In other cases, however, such as a use for broader social comment purposes query whether an attempt to gain permission and address concerns might be considered relevant to the 'good faith' of any subsequent unauthorised use. And sometimes even mildly critical or lampooning uses may be the subject of good faith efforts at accommodation of interests — as for instance (on the Moseleys' part) in \textit{Victoria's Secret}, above n141.

\footnote{168} \textit{Campomar}, above n156.

\footnote{169} \textit{Ibid}, Gleeson CJ et al at 53--4.

\footnote{170} \textit{Ibid} at 53--4, in respect of the last quoting Kozinski, above n6.

\footnote{171} \textit{Ibid} at 53.

\footnote{172} For a fuller discussion see Richardson, above n8, in particular noting that full anti-dilution protection would require a broader reading of the ‘substantially identical’ bass for claiming infringement on the part of Australian courts (although this is something for which there is now a European precedent: see above n147). And there are other limitations in the language of \textit{Trade Marks Act 1995} (Cth) s120(3), the so-called anti-dilution provision in the Australian Act, as well. For instance, the provision only covers cases where the use is for goods or services unrelated to those for which the trade mark is registered. The US Act is not so restricted, and neither the ECJ has held, should anti-dilution rights under the European Directive: see \textit{Adidas-Salomon}, above n122. In fact it is only a use for goods or services that are not directly within the scope of registration but may be considered ‘related’ to registered goods or services that presents a problem under the Australian Act — if dilution could be found with respect to uses for unrelated goods or services under s120(3) it should equally be available with respect to uses for registered goods or services under the terms of the core infringement provision, s120(1) — the difficulty is s120(2) (extending infringement to related goods or services, but with a statutory defence covering cases of no likely confusion).

\footnote{173} See \textit{Trade Marks Act 1995} (Cth) s122 "When is a trade mark not infringed?".
itself requires that a trade mark must be used ‘as a trade mark’, meaning entirely expressive uses are public domain. There is considerable scope in the last requirement especially for freedom of speech to be preserved. But there is no provision in the Australian Act that specifically covers the case where a trade mark is used as a trade mark and expressively at the same time. On its face the result is users would be forced to either avoid anything that may appear to be ‘trade mark use’ (a term capable of multiple applications) or else avoid expressive use.

Leaving courts to read in an exemption to unclear statutory language is not ideal either. In the recent Barbie Girl case Kozinski J in the US Court of Appeals, relied on a non-commercial use exemption, bolstered by the Constitution’s First Amendment’s free speech mandate, to hold the pop group Aqua free to use ‘Barbie Girl’ as the name of its song. The use being expressive could not be ‘commercial’, was the conclusion. Thus a free speech exemption was engrafted onto the non-commercial use exemption specified in the federal anti-dilution Act. Such an approach, if taken literally, would leave little scope for a trade mark dilution claim (certainly one premised on adoption of the expressive elements of the trade mark, as proposed in this article). And the results are perverse if all expressive uses no matter how meagre their contribution to social discourse, how destructive they may be to a trade mark’s integrity or imagery, and how commercial their flavour now find exemption. In the Barbie Girl case financial rewards were reaped from the choice of ‘Barbie Girl’ as a feature of the song’s name and theme. The outcome in the particular case may still be approved: children could benefit from questioning Barbie’s imagery, promoted by Mattel, of a ‘plastic’ teenage girl-cum-commodity and the extent of real damage done to the Barbie image is debatable. (Query whether a more prescient Mattel might have taken some advantage even of

174 The requirement for use ‘as a trade mark’ is expressed in Trade Marks Act 1995 (Cth) s120 – unlike s10 of the UK 1994 Act: the omission there has led to debate as to whether use as a trade mark is required under UK law. Contrast Arsenal cases, above n123 (the proper question is the effect of the use on the registered owner’s trade mark) and R v Johnstone [2003] 3 ALL ER 884 (trade mark use required). In the US trade mark use is not specified in the Federal Dilution Act, but some think it is inherent in the nature of a diluting (or at least blurring) use that this be as a trade mark: see McCarthy, above n19 at Vol 4, Part II § 24.103.

175 As, for example, in Top Heavy Pty Ltd v Killin (1996) 34 IPR 282 (‘Chill out’ used expressively did not infringe the plaintiff’s registered trade mark).

176 The point is well made by Patricia Loughlan, ‘Protecting Culturally Significant Uses of Trade Marks (Without a First Amendment)’ (2000) EIPR 328.

177 Loughlan, for example, argues that an Australian court would likely not find Aqua’s use of ‘Barbie Girl’ in its song to be a trade mark use: see id at 331. Some judges might: see, for example, Coca-Cola Co v All-Fect Distributors Ltd (1999) 47 IPR 481 (prominent use of Coca-Cola bottle-like shape for sweets held a trade mark use, notwithstanding defendant’s attempt to portray itself as merely acting ‘in fun’).

178 Mattel, above n160 (Kozinski J) ‘[w]ere we to ignore the expressive value that some marks assume, trademark rights would grow to encroach upon the zone protected by the First Amendment ... [T]he trademark owner does not have the right to control public discourse’. The Court concluded that Aqua’s song ‘merely lampoons the Barbie image’; therefore was not ‘commercial’; cert denied Mattel Inc v MCA Records, Inc 123 S Ct 993 (2003).

Aqua’s critique.) But a ‘Barbie Enjoys Cocaine’ logo on mass-produced T-shirts, or a ‘Barbiesplaypen.com’ website employed for adult entertainment trading purposes might be less appealing for public discourse and more damaging to Barbie’s image as a charmingly innocent child-friendly icon. A legislative solution fine-tuned to the private/public language divide, a tailored free speech defence to infringement that allows for consideration of social benefits and costs of an expressive use as well as the good faith (or not) of the parties concerned, is in my view preferable to simply relying on the blunt instrument of ‘commercial’ or even ‘trade mark’ use.

5. Concluding Comments

There is a tendency in modern academic scholarship to argue for even closer regulation of the nexus between trade mark rights and language, extending the high regulation approach for registration to infringement.

I argue that drawing on the expressive power of the law, its capacity as a kind of prestige dialect to foster desirable social attitudes and behaviour, could work better in promoting a healthy relationship between trade marks and language. Traders who seek to negotiate the line between expressive meaning and trade mark use should not be penalised for their contribution to popular culture. Their trade marks should be recognised for registration if they function as common law trade marks or are likely to in the future. Further, protection against dilution by blurring or tarnishing the associations of a registered trade mark should ideally be provided for by legislation, or as a second best solution read into the provisions of the Trade Marks Act 1995 (Cth). Those recognised as owners should have at least some control over how the expressive components of their trade marks will be used. However, the risk that ownership of language may yet be used as a tool of censorship means a well-tailored free speech infringement exception is fundamental to the modern registered trade mark system.

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180 In fact, it might be argued, a ‘prescient’ Mattel might benefit from considering the message of ‘Barbie Girl’ that Barbie needs to be liberated from her pre-feminist roots as a mere commodity, a plaything for others (including her so-called ‘playmate’ Ken), without a personality of her own. Compare above n39ff (influence of gripe sites on the internet).


182 See Mattel Inc v Internet Dimensions, Inc 55 USPQ 2d (BNA) 1620 (2000) (defendant’s adoption of ‘Barbiesplaypen.com’ as its domain name found to tarnish and dilute Barbie trade marks and ‘wholesome’ image, in violation of the Anticybersquatting Consumer Protection Act 1999).

183 See, in particular, Brown, above n135 and other references passim.
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