

# Critical analysis of trade marks



-----Critical Analysis of Jason Borland??™ s ???

The Culture of Trade Marks: An Alternative Cultural Theory Perspective???

-----Jason Borland has argued that ??? a form of trade dilution protection may be beneficial to ensuring that trade marks remain a valued form of public cultural expression??™. Critically evaluate his argument as developed in ??? The Culture of Trade Marks. An Alternative Cultural Theory Perspective??™, Intellectual Property Research Institute of Australia, Working Paper No. 13/05, June 2005. (Available on the IPRIA website: <http://www.ipria.org/publications/wp/2005/IPRIAWP13.2005.pdf>)

Under s17 of The Trades Mark Act 1995, a trade mark is a sign used, or intended to be used, to distinguish goods or services dealt with or provided in the course of trade by a person from goods or services so dealt with or provided by any other person.

When these signs assume the form of marks used in trade, these indicia of cultural difference may be legally recognized as the private properties of those who claim them as marks of their own commercial distinction???.

Bosland, in his article The Culture of Trade Marks: An Alternate Cultural Theory Perspective argues in favour of increased trade mark protection through an analysis of cultural theory. In particular he argues that, ??? a form of trade dilution protection may be beneficial to ensuring that trade marks remain a valued form of public cultural expression???. Whilst prevention of dilution of trade marks is indeed beneficial to company??™ s in commerce, it needs to be analyzed as to whether there are more negative or

positive outcomes of trade dilution protection on a trade marks ability to fuel cultural expression.

Trade marks are symbols designed to enable consumers to identify without confusion the source of goods or services. In our current world however, trade marks have become more than mere indicators to avoid confusing consumers. Trade marks have become culturally meaningful signifiers. ??? The visual cultures of national mass markets are, often saturated with signs of social difference???. Particular trade marks have become part of our every day culture, language and understanding. Louis Vuitton has come to signify wealth, luxury travel and European chic. Xerox is not just a brand that makes photocopiers, it has literally become a word to connote a photocopy, ??? can you Xerox this document???. However, brands like Xerox spend \$100, 000 a year explaining that you don't ??? Xerox??? a document, you photocopy it.

Disney is not just the trade mark for a company that makes cartoons, but holds the cultural meaning of youth, fairy tales, fun parks and romantic moments, ??? The family coming together was a Disney moment???. Famous trade marks have become entrenched with the ethics, morals, life choices, visions and ideas we believe in. So, just as Bosland suggests, trade marks have thus become a significant aspect of modern culture.

??? Trade marks may be logo??™s, brand names, characteristic advertising images, or other (usually visual) forms that condense and convey meaning in commerce???. ??? They are intangible property that denote a particular standard of quality, distinguish one party??™s goods or services from those

of another, symbolize the goodwill of the owner, and protect the public from confusion and deception???. An alternate view to that presented by Bosland, held by some scholars such as Coombe, and Assaf which emphasize ??? the importance of letting cultural signs subject to Intellectual Property be freely ??? recoded??? ??” that is, invested with new meanings.??? Under this notions as Bosland acknowledges ??? trade mark laws ??? stifle dialogic practice- preventing us from using the most powerful, prevalent , and accessible cultural forms to express identity, community and difference???. This argument is in favour of liberating cultural signs such as trade marks which are protected by intellectual property, to remove that protection and allow for alternative interpretations of culture to develop. ??? When the law allows owners of trade marks??; copyright and publicity rights to ??? freeze??? the meaning of the signs they own, it deprives other members of society the ability to take part in shaping their culture???.

This idea goes against Bosland??™s idea that trade marks deserve special protection. Assaf turns Bosland??™s idea on its head, by flipping the problem, he argues that cultural signs that are turned into trade marks loose there luster because there cultural meaning becomes restricted. Assaf promotes the idea of liberating intellectual property and ending the private protection of the cultural meaning of registered trade marks. Assaf sees Bosland??™s view of trade mark protection as meaning that it is only corporate ideology that ??? dominates our cultural discourse???. Boslands ideology looks to both the benefit of the company who owns the trade mark and to the benefit of the public arena, to preserve the cultural meaning of a sign without blurring its integrity. Bosland??™s ideology is much more

balanced than that of an extreme cultural studies perspective. This is because he holds the view that protection of the use of a trade mark should only extend to the use of a trade mark as a trade mark.

This view is supported by the US decision of *Mattel*, whereby use of the trade mark Barbie in a song was seen as not use as a trade mark. The question of *Bosland*'s ideology however, remains as to what extent this protection of trade marks should be afforded to achieve a balance. *Bosland* suggests that protecting trade mark rights, might not be as harmful to culture and cultural expression as perhaps first thought. This raises the issue of how trade mark rights should be recognized by the law, in order to protect both the company and the public interest in building culture. Indeed, trade marks have become such significant role players in the signs of modern culture that questions of trade mark rights at law have become an increasingly more salient issue. Trade mark protection of brand elements such as brand names, logos, and symbols has become a huge aspect of brand management because, the selection, use, registration, maintenance and protection of a company's trade marks can be critical to the fiscal health and overall value of the business.

In a world where trade mark is replacing copyright as the favoured form for protecting cultural texts, *Exxon* espouses that no longer do trade marks exist only in relation to goods or services and have no meanings in themselves. Trade marks are now part of the very fabric of society and have, just as *Bosland* asserts, actually become apart of popular culture.

Therefore, *Bosland* raises the issue of whether the need to protect the existing culturally expressive aspects of a trade mark outweigh the private

interest of a company or owner in protecting a commercial trade mark.

Under the common law a ??? technical trademark is defined as any fanciful arbitrary, distinctive, and nondescriptive mark, word, letter, number, design, or picture that denominates and is affixed to goods: it is an inherently distinctive trade symbol that identified a product???. Legally a brand name is a ??? conditional property???, protected only after it has been used in commerce to identify products (goods or services) and only in relation to those products or to closely related offerings.

To preserve a brand name??'s role in identifying products, federal law protects brands from actions of others that may tend to cause confusion concerning proper source identification. How are trade marks protected Trade mark appropriation is an issue which requires protection. Trade mark appropriation is a developing area of NSW state law that can severely curtail even those brand strategies that do not ??? confuse??? consumers.

Appropriation is defined in terms of enhancing the image of a new offering via the use of some property aspect of an existing brand. That is, appropriation resembles theft of an intangible property right. The argument can be raised that to prevent imitations is that even in the absence of confusion, a weaker brand will tend to benefit by imitating an existing brand name.

??? The owner of a strong, unique brand should thus be entitled, incipiently, to prevent impairment of the brand??'s communicative clarity by its substantial association with another brand, particularly where this is an element of misappropriation???.??? Counterfeiting alone costs US companies \$200 billion a year, and an estimated 5 percent of products sold worldwide

are phony. Many national brand manufacturers are responding through legal action, as protecting trade marks is becoming essential to the ability to maintain an effective brand. For national brands, the key is proving that brand clones are misleading consumers, who may think they are buying national brands. The burden of proof in the US is to establish that an appreciable number of reasonably acting consumers are confused and mistaken in their purchases.

Currently, in Australia, rights are given by registration of the trade mark under s20. Which gives the registered owner the exclusive rights, to (a) to use the trade mark; and (b) to authorise other persons to use the trade mark. This gives the owner rights under Part 12 of the Act if there is an infringement on the trade mark. An infringement for a 'copy'™ or 'fake'™ infringing a trade marks rights of registration can be brought under the test for substantial identity and deceptive similarity as causing deception and confusion. The role of the court in a case of infringement proceedings as with Southern Cross, is to support the monopoly granted by the act. Factors that are consider in US courts that might offer further protection to trade marks if considered by courts in Australia in determining likelihood of confusion, could include 'the strength of the national brand'™s mark, the relatedness of the national brand and the brand clone products, the similarity of the marks, evidence of actual confusion, the similarity of marketing channels used, the likely degree of buyer care, the brand clone'™s intent in selecting the mark, and the likelihood of expansion of the of the product lines???. This is essentially protection from trade mark dilution. Trade mark protection from dilution is to be protected from 'a weakening

or reduction of the ability of a mark to clearly and unmistakably distinguish the source.

??? Dilution can occur in 3 ways: blurring, tarnishment, and cybersquatting. Blurring happens when the use of an existing mark by a different company in a different category alters the ??? unique and distinctive significance??? of that mark. Tarnishment is when a different company employs the mark in order to degrade its quality, such as in the context of a parody or satire. Cybersquatting occurs when an unaffiliated party purchases an Internet ??? domain name consisting of the mark or name of the company for the purpose of relinquishing the right to that domain name to the legitimate owner for a price???. Boslands suggestion that appropriately tailored trade mark dilution protection may even preserve the expressive capacity of trade marks and protect their status as effective instruments for cultural dialogue, is certainly arguable. This is because without adequate trade mark protection against dilution, brand names can become legally declared generic. This is the case for products such as Vaseline, cellophane, escalator and thermos.

Schechter provides an analysis of trade mark function which argues, ??? quite apart from the destruction of the uniqueness of a mark by its use on other goods???, once a mark has come to indicate to the public a constant and uniform source of satisfaction, its owner should be allowed the broadest scope possible for the ??? natural expansion of his trade??<sup>TM</sup> to other lines or fields of enterprise.??? Therefore, use of a well know mark on other products, by the owner of the trade mark does not reduce a marks ability to mean something to a consumer. Bosland suggests that ??? a carefully adapted



trade mark dilution right might satisfy a cultural public interest in facilitating speech by preventing the dilution of a trade mark's expressive function. Therefore, the use of a trade mark by those who are not owners, and who may not offer what the trade mark has come to mean in terms of quality, satisfaction or reliability to a consumer, as well as the cultural meaning, is dilution of a trade mark. This as Bosland argues, takes away from the meaning of a trade mark. If a trade mark has become a culturally expressive mark, then would it not be in the best interests of the public to protect that cultural meaning by stopping dilution.

Trade marks are those words, symbols or other indicia that serve to identify a business as the source of goods or services. Ultimately, Bosland argues in favour of an increased trademark protection because in his view increased trademark protection will actually benefit public good by allowing the language of trademarks to remain clear and distinctive. On one hand, trade marking is essential, giving legal title to the brand owner. To the company, these intellectual property rights ensure that the firm can safely invest in the brand and reap the benefits of a valuable asset. To consumers, trade marking is important because to consumers, the special meaning that brands take on can change their perceptions and experiences with the product or service. Brands take on a unique, personal meanings to consumers that facilitate their day-to-day activities and enrich their lives.

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 value of a good or service only lies in part in what the actual good or service is, the rest of the

value lies in intangible brand value which needs protecting. The ubiquity of trade marks in national social areas and their currency both as cultural and as private property create conditions for struggles over significance. Therefore, it is also possible to challenge Bosland's assertion that protecting a trade mark from dilution is actually beneficial to culture and cultural expression. Trade marks are arguably an important aspect of everyday popular culture. In the cases of *Eastman Photographic*, *Proctor and Mark Foy* the protection of the English language has been at the forefront of trade mark law.

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 of 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. Authors such as Richardson argue that 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. Bosland examined cases where successful trademark dilution was upheld, such as *Henderson v Radio Corporation* and *Hogan v Koala Dundee* where situations of satire, parody or criticism were used. However, equally, in cases such as *Pacific Dunlop v Hogan* where the court found passing off even where the defendant's advertisement employed extreme parody.

This demonstrates that indeed, as Bosland suggests, effective dilution protection of trade marks can be made without sacrificing the importance of allowing culture to grow unhindered by the law. Bosland argument raises the issue of whether by allowing trade mark dilution, is the focus too much on commercial value of trade marks at the expense of the cultural and public interest in freedom of speech. Certainly, Bosland's argument focuses more on the dilution of trademarks than on the dilution of culture. Bosland does not focus on the perhaps loss of cultural meaning a trade mark may cause if it uses a current cultural sign and then the law protects that cultural sign's meaning so that it should remain stagnant to meaning the product, good, service or even the intangible brand value. Bosland however does highlight that trade marks are a rich form of cultural expression as mass media imagery and commodified cultural texts provide important cultural resources for the articulation of identity and community in Western societies. It can then be asserted that trade marks in fact facilitate language, the language of trade marks. Without ownership of trademarks, they would hold less value and in turn, this would mean that less thought would be put into new ideas and new cultural constructions. Therefore, examining Bosland's argument reveals that in fact whilst indeed trade mark dilution is essentially to protect the commercial value of a trade mark, carefully adapted trade mark dilution means that new cultural meanings are able to develop because intellectual property law can provide a direct role in shaping contemporary culture.

This adds meaning to cultural discourse instead of taking away from it. In conclusion, Bosland's use of cultural theory in a fresh and unique way lends a

focus on trade marks and trade mark protection previously unseen. Trade marks can be viewed as part of the process contributing to the creation of popular culture. Trade mark dilution is supported by Bosland, but only to a regulated extent that would see trade mark protection only extended to trade marks for their use as trade marks. His ideology would see greater use of cultural expression in trade marks to facilitate new and dynamic culture in society. Bosland's arguments are rationally argued, well balanced between extreme cultural theory and extreme trade mark protection. Bosland warns of the detriment of not protecting trade marks as it would lessen the stability of a stable cultural language that is used in society. Thorough investigation of Bosland's *The Culture of Trade Marks: An Alternative Cultural Theory Perspective*, it ultimately reveals that if trade mark dilution could be managed effectively then popular culture would not be inhibited, but instead flourish.

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