

UNCONVENTIONAL AND WELL-KNOWN TRADE MARKS

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This paper considers two fields of trade mark law which have expanded in recent years. Unconventional trade marks involving sounds, smells and shapes have started appearing on trade mark registries in Europe and the United States. The owners of well-known marks like Coca-Cola, which has long been firmly protected against imitators and “free riders”, have also not been content with the protection they receive under national laws and have managed apparently to secure even more advantages from national legislatures and international fora. The *United States-Singapore Free Trade Agreement* of 2003 compelled Singapore to strengthen its trade mark laws to encompass these developments. This paper examines unconventional and well-known marks from a comparative, primarily European law, perspective. It argues that the expanded protection accorded to these marks is not self-evidently a good thing in public policy terms. It concludes that re-forming the law is not the same as reforming it.

I. INTRODUCTION

A discussion of the law relating to unconventional and well-known trade marks seems timely in the light of Singapore’s undertaking fresh trade mark obligations under the *U.S.-Singapore Free Trade Agreement* of 2003 (*FTA*).¹ This paper undertakes that discussion from a comparative, primarily European, perspective with specific reference to Singapore. No attempt is made to state Singapore law: that has been undertaken elsewhere.² I wish instead to highlight some themes and policy factors that inform the field.

The two topics—unconventional and well-known trade marks—are, at first sight, only loosely related. “Conventional” trade marks comprise words or designs such as Coca-Cola as a word or in its familiar cursive script—both legally well-established and regularly protected by the tort of passing-off or by registration in trade mark

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¹ Online: Office of the U.S. Trade Representative <http://www.ustr.gov/Trade_Agreements/Bilateral/Singapore_FTA/Final_Texts/Section_Index.html>

² See *e.g.* Susanna H.S. Leong, “Conditions for Registration and Scope of Protection of Non-Conventional Trade Marks in Singapore” (2004) 16 *Sing. Ac. L.J.* 423, and Ng-Loy Wee Loon, “The IP Chapter in the US-Singapore Free Trade Agreement” (2004) 16 *Sing. Ac. L.J.* 42.

offices. By contrast, “unconventional” marks are today’s more *outré* elements: smell, sound, colour, shape, even taste and gesture. Until recently, such things were thought to be unregistrable and largely unprotected at common law. This position is changing internationally. Smell, sound, colour and even shape marks now appear on many trade marks registries and in trade mark legislation and treaties. They are, even when unregistered, gaining protection in both common law and civilian legal systems.

This process is worth reflecting on before these unconventional trade marks of today become the conventional trade marks of tomorrow. I shall focus more on the conditions affecting registration of these trade marks than on the way the common law protects them. How such marks can be protected under other schemes—*e.g.*, copyright or design law, or as geographical indications of origin—is not considered.

The other section of the paper deals with well-known marks—which are far from unconventional. Celebrity status is what every mark and mark owner aspires to. The basic question I consider is not whether these trade marks should be protected but whether they deserve the special treatment that is fast becoming their international norm. Should Coca-Cola, whether registered or not, get better legal protection than does a lesser-known mark, even though the owner of the latter mark pays the same registration and renewal fees, and the same sort of legal fees when he comes to enforce them in court?

Before turn to examining these questions, I wish to make some preliminary remarks.

II. EXPANSIONISM

The long-run history of the law of trade marks—indeed, the history of all of intellectual property law—has been one of expanding subject-matter and scope of protection: what is protected, how deep protection should run, and where and against whom it should run.³

The typical trade marks that were traditionally protected were, as has already been mentioned, words and graphic designs. Even then, some indicators were *prima facie* excluded for policy reasons. For example, a seller might claim and use “Fiji” as his mark for ice but not for bananas: “Fiji” bananas would suggest the geographic source of the bananas, something which all traders in Fijian bananas should be entitled to use to the exclusion of none. By contrast, “Fiji” for ice could arbitrarily mark out to consumers the ice of a single trader and would not, except to the marginal (and legally irrelevant) consumer of extraordinary geographical illiteracy, suggest the place where the product came from. Unusual circumstances might occur where a single trader did use “Fiji” for bananas so intensively that consumers came to identify them with a single trading source, rather than their geographic origin; the use of that mark by importers of bananas even from the Fijian islands would then mislead some consumers into believing they were getting the first entrant’s bananas. But such situations were relatively rare, and their occurrence was generally discouraged by legislators, administrators and courts alike, whether the first trader sought to register the mark in an official registry or sought to enforce it through the courts.

³ For a discussion of this phenomenon in U.S. law, see Mark Lemley, “The Modern Lanham Act and the Death of Common Sense” (1999) 108 Yale L.J. 1687.

Over time there has been constant pressure from industry—note, not consumers—to widen the subject-matter of protection to include as a trade mark virtually any perceptible feature in the sensory world that can be used to attract custom. By protection here, I mean *ex ante* protection at the stage of market planning, rather than simply *ex post* protection that occurs after a feature—be it word, graphic, shape, colour, scent, taste, sound or gesture—is invested, usually after much advertising, selling and reinforcement, with a significance linking the product or service with a single trader.

I obviously do not mean that *ex post* protection is unimportant. It is both important and endemic. In principle, any feature of a product or service becomes protectable against imitation or even independent adoption by later entrants if consumers come to recognize the feature as denoting a particular product source. Most modern legal systems treat as wrongful any suggestion that misleads consumers into believing that an offered product or service originates from a particular producer or source, when it in fact does not, at least if the original source's economic interests are harmed. No source-denoting feature is *a priori* excluded; nor are the categories of possible false suggestion or misrepresentation closed. How the activity is labelled—passing-off; unfair trading or unfair competition; false, misleading, confusing or deceptive marketing—is interesting historically and culturally but less important than the fact that tribunals in most jurisdictions where such a complaint is made can and do order offenders to cease the activity and compensate the injured trader, sometimes even requiring him to publicize the reform of his ways in the media.

But the drawbacks of *ex post* protection are well-known. To prove a mark's reputation and to prove the defendant's misrepresentation is costly. Protection is *ad mercatorem*, not *in rem*: it runs against an individual wrongdoer rather than the world. Rights are co-ordinate with reputation and thus territorially confined. Extending or transferring them may prove difficult and risky.

Such drawbacks can be eliminated or reduced by an officially-assured grant of *ex ante* protection. That is what the establishment of official trade mark registries was mainly about. A trader wants advance official assurance that a marketing feature he plans to adopt will be recognized as his own. He wants other traders warned off that feature or similar features when they decide how to market competing or even non-competing products and services. Since potentially any feature may be protected *ex post*, the pressure is to gain official *ex ante* assurance of that protection in a globally portable form—a registered proprietary trade mark. When states become involved in granting that official assurance, they may legitimately ask whether the costs of administration and the social and economic costs of providing *ex ante* protection of particular features, instead of leaving them to be protected *ex post*, are justified on public grounds. What those justifications may be deserves thinking about.

We cannot ignore international pressure in this respect. Left to itself, Singapore's trade mark law would look quite different from what it is today. Singapore's view of what its national interest dictates is not the same as that dictated by others, to some extent the world community through the World Trade Organisation ('WTO'), but especially through more free trade agreements with the European Union ('EU') and the United States.

III. BASIC LEGAL FRAMEWORK

According to the *Agreement on Trade-Related Aspects of Intellectual Property Rights* ('TRIPs') "any sign or combination of signs" may be registered as a trade mark, although a condition may be imposed that the mark be "visually perceptible".⁴ Singapore initially took advantage of this condition in its trade marks law but was required by the *FTA* to remove it; and so it has. What remains is the less stringent condition derived from EU law: to qualify for registration, a "sign" must be "capable of being represented graphically".⁵

A basic question is whether, and if so, how far, the additional requirements the European Court of Justice ('E.C.J.') has imposed on European trade marks will be transposed into Singapore trade mark law by Singapore's courts and Intellectual Property Office. The E.C.J.'s rulings apply to both the European Community trade mark (which, when registered with the European trade mark office in Alicante, applies throughout the EU) and national marks registered in any EU state (including the U.K.). So one would expect Singapore practice largely to reflect that of the EU, unless the Singapore authorities think a particular decision or approach is misguided or otherwise unsuitable to Singaporean circumstances.

The point is important because European courts have deduced other characteristics of EU trade marks that may not be immediately evident from the wording of the EU *Trade Mark Directive*⁶ of 1988 and its complementary *Trade Mark Regulation*⁷ of 1993. It may be relatively uncontroversial to accept the E.C.J.'s view that the essence of a trade mark is its distinctiveness, *i.e.*, it must guarantee to consumers the identity of one product source from all others.⁸ That is easily deduced from the definition of trade mark that the Singapore Act mirrors, *viz.*, that the trade mark must be "capable of distinguishing 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."⁹ But what of the following other two features imposed by the E.C.J., both said to flow from the interpretation of the *Trade Mark Directive* and *Trade Mark Regulation* as a whole, that a trade mark:

- (a) must be "clear, precise, self-contained, easily accessible, intelligible, durable and objective";¹⁰ and
- (b) must not deprive the trade or the public of signs that should be free to all?¹¹

Presumably, requirement (b) is uncontroversial: that policy has historically underlain U.K. law from early on, where courts took measures to discourage the trade mark predations of "[w]ealthy traders [who] are habitually eager to enclose parts of the

⁴ 15 April 1994, 33 I.L.M. 1197 [TRIPs] (Annex 1C to the *Agreement Establishing the World Trade Organization*, 15 April 1994, 33 I.L.M. 1144), art. 15.1.

⁵ *Trade Marks Act*, Cap. 332, 1999 Rev. Ed. Sing., s. 2, definition of "trade mark"; compare EC, *Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks*, [1989] O.J. L. 40/1, art. 2 [*Trade Mark Directive*]; EC, *Council Regulation No. 40/94 of 20 December 1993 on the Community Trade Mark*, [1994] O.J. L. 11/1, art. 4 [*Trade Mark Regulation*].

⁶ *Ibid.*

⁷ *Ibid.*

⁸ *Arsenal Football Club plc v. Reed* C-206/01, [2002] E.C.R. I-10273, [2003] Ch. 454 (E.C.J.).

⁹ *Trade Marks Act*, *supra* note 5, art. 2, definition of "trade mark".

¹⁰ *Shield Mark BV v. Kist* C-283/01, [2004] Ch. 97 (E.C.J.) at para. 55 [*Shield*].

¹¹ *Windsurfing Chiemsee v. Boots* [1999] E.T.M.R. 585 (E.C.J.).

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”.¹²

Requirement (a)—the seven steps up which a mark application must ascend before proceeding to registration heaven—seems, at first sight, more controversial but appear nevertheless appropriate to Singaporean conditions. The likelihood that Singapore courts would, if called on, accept this E.C.J. requirement must have been known to *FTA* negotiators when the agreement was signed in 2003; yet nothing, apart from a provision I shall shortly mention, was included in the *FTA* to change that position.

How then are scents, sounds, colours and shapes—features that many legal systems find problematic—treated in European trade mark law? Rulings on registrability are important because, once on the register, trade marks get broad protection against confusion and dilution—typically wider protection than is extended to unregistered marks at common law.¹³ In Europe, all marks—whether traditional word or design marks, or some other differently perceptible feature—are in theory examined for registrability according to the same criteria. Consumers may nevertheless view features such as scent, sound, colour and shape differently from standard marks, and this perception is key when the capacity of these features to act as a trade mark is assessed.¹⁴

A. Scent as Trade Mark

In 1990, plumeria scent added to sewing thread was registered as a U.S. trade mark.¹⁵ One assumes the panel members making this decision were keen gardeners and could, in a blindfold test, differentiate a plumeria from a petunia. Whether the general public was or is as discerning is more debatable. One also assumes that the registrability of a scent mark would be confirmed in the courts. The occasion for express judicial *imprimatur* has however not arisen so far. Practice within the U.S. Patent and Trademark Office and professional opinion is however favourable, and the U.S. Supreme Court, in adopting a broad view on the registrability of colour trade marks, supported its holding by referring with apparent approval to the practice of registering scents (as well as shapes and sounds).¹⁶

On top of eliminating the condition of visual perceptibility, the *FTA* added that each party “shall make best efforts to register scent marks”.¹⁷ The following points may be made about this provision:

- (a) Neither party is absolutely bound to register scent marks.¹⁸ Nor may it categorically exclude them.

¹² *Joseph Crosfield & Sons’ Appn.* (1909) 26 R.P.C. 837 (C.A.) at 854.

¹³ Compare William Cornish, *Intellectual Property: Omnipresent, Distracting, Irrelevant?* (Oxford: Oxford University Press, 2004) at 96: “caution before grant [of registration] is needed because of the wide consequences after grant”.

¹⁴ *Procter & Gamble v. Office for Harmonisation in the Internal Market (OHIM)* (29 April 2005), joined cases C-468/01 P to C-472/01 P (E.C.J.) at para. 36 [*Procter*].

¹⁵ *Re Clarke*, 17 U.S.P.Q. 2d 1238 (T.T.A.B. 1990).

¹⁶ *Qualitex Co. v. Jacobson Products Co.* 115 S. Ct. 1300 (1995) [*Qualitex*], referring to *Re Clarke*, *ibid.*

¹⁷ *FTA*, *supra* note 1, art. 16.2(1).

¹⁸ Compare other obligations in the same art. 16.2(1) of the *FTA*: “Each Party shall provide that trademarks shall include service marks ... and may include geographical indications.”

- (b) Presumably “best efforts” includes providing procedures that would enable scent marks to be registered if they reasonably fulfil other conditions. This includes the condition of “graphic representation” which Singapore was allowed to, and did, retain.
- (c) Does merely following EU procedure and case law amount to making “best efforts to register”? Probably not, otherwise the provision is otiose: the parties would know that Singapore courts might well follow EU case law unless the *FTA* said something more.
- (d) Even if the Singapore legislature said nothing about scent marks, Singapore courts could rely on the *FTA* article to support more relaxed registration requirements than the E.C.J. has imposed under EU law.¹⁹
- (e) A U.S. court, directly faced with the question of registrability of a scent mark, may now be even less inclined to consider overturning current U.S. practice and professional opinion favouring registration.

With these points in mind, we may turn to EU law. Shortly after the U.S. plumeria case, the scent of fresh cut grass for tennis balls was registered as a European trade mark, and the odour of beer for dart flights and the scent of roses for tyres was registered in the U.K.²⁰ Scent may attract or repel buyers, even of darts, tyres or tennis balls; one suspects that nobody has sought to register the scent of horse manure for them. The broad policy question is whether the first trader who decides to make his product artificially smell better should be granted a state monopoly for that feature against other like-minded traders.

Trade mark “progressives” may argue, with Cole Porter, that “[i]n olden days a glimpse of stocking/was thought of as something shocking;/now, Heaven knows,/anything goes”—and should go. Trade mark traditionalists—“regressives”, as they may be labelled by “progressives”—may argue that the temptation should be resisted of granting exclusivities over selling features of a product that may make it more attractive to buyers, but which at best are merely secondary identifiers of origin. The consumer has already usually identified the product through the word, symbol or design mark that has been placed on it. To allow that secondary characteristic to operate as a mark is to prevent rival traders from making their product similarly attractive. It is to grant a limited, but nevertheless quite significant, form of monopoly over a selling feature.

After a brief flirtation with scent marks, European trade mark registries have decided to reject them.²¹ The main legal sticking points were the mark’s lack of distinctiveness and its non-compliance with the requirement that any registrable sign had to be “capable of being represented graphically”.²² So a raspberry scent applied

¹⁹ This is not as heterodox as it sounds. Lord Hoffmann recently relied on *TRIPs*, *supra* note 4, art. 9.2 to support the unprotectability of ideas under copyright law, despite the absence of a corresponding provision in the *Copyright Designs and Patents Act 1988* (U.K.) 1988, c. 48: *Designers Guild Ltd. v. Russell Williams (Textiles) Ltd.* [2000] 1 W.L.R. 2416 (H.L.).

²⁰ *Venootschap onder Firma Senta Aromatic Marketing’s Application* [1999] E.T.M.R. 429 (Eur. Comm. Trade Marks Office, Second Board of Appeal). See D. Lyons, “Sounds, Smells and Signs” [1994] Eur. I.P. Rev. 540.

²¹ *Sieckmann v. Deutsches Patent- und Markenamt C-273/00*, [2002] E.C.R. I-11737, aff’g the Advocate General’s Opinion (6 Nov 2001).

²² *Trade Mark Directive*, *supra* note 5, art. 2; *Trade Mark Regulation*, *supra* note 5, art. 4.

to motor fuel was found not to create a trade mark for the scent: consumers would just think the smell was added to mask the (for some) otherwise unappealing scent of the product.²³

On the issue of graphic representation, one may ask: how can the scent of “freshly cut grass” be represented accurately, let alone graphically? Does all grass smell the same? Is the scent admixed with the smell of fumes from the gas-driven mower? Does the grass smell the same from a distance as from close quarters? Does it help to know that the mark holder said it tested “14 grass fragrances—including clay court and hay—before opting for the freshly cut grass odour”?²⁴ Do we need a spectrogram produced by an electronic nose technologist to delineate it? Or a reference to the chemical compound that produces the scent? A deposit of the smelly item?²⁵ More to the point, how will a rival trader who wants to apply a scent to his product know when he has produced something confusingly similar? Will the scent of “newly mown hay” or “freshly pruned trees” infringe? Will an initially neutrally smelling ball that, with use, acquires the scent of grass become infringing?

Now one might read the requirement that a sign be “capable of being represented *graphically*” broadly to include any combination of descriptions and deposits that reasonably conveyed to an interested reader the metes and bounds of the exclusion claimed. So it was argued when an odour described as “balsamically fruity with a slight hint of cinnamon”—apparently a term recognizable in the perfume industry and possibly among pretentious wine critics—was sought to be registered in Germany for a wide range of services, including even legal services. But the applicant also described his “olfactory” mark²⁶ as being the scent of methyl cinnamate; he deposited a container that included the scent; and for good measure he also provided the chemical formula of the scent-producing compound.

The E.C.J. rejected all these methods, individually or in combination, as satisfying the requirement of graphic representation. The court was willing to accept the registration of non-visual marks if they could be represented graphically “particularly by means of images, lines or characters” in a way that was “clear, precise, self-contained, easily accessible, intelligible, durable and objective.” The application failed on all counts. Whether any form of description of a scent mark can satisfy these criteria in the EU is therefore doubtful. The more complex a description becomes, the more a trade mark registration starts to resemble a patent claim and the higher become the transaction costs in deciding the ambit of the registration and how to avoid infringement. Lawyers may not see this as a problem but businesses may. As—perhaps more—importantly, how or whether consumers may benefit from an environment further cluttered with competing scents is unclear.

How far these considerations can, in the light of the *FTA*, be taken into account in Singapore when a scent mark presents itself for registration remains to be seen.

²³ *Myles Ltd.’s Community Trade Mark Application* R 711/1999-3, [2003] E.T.M.R. 56 (OHIM Board of Appeal).

²⁴ Steve Bird, “Game, Scent and Match for Grassy Tennis Balls” *The Times* (25 May 2000).

²⁵ *John Lewis of Hungerford Ltd.’s Trade Mark Application* [2001] R.P.C. 575 (Trade Marks Registry Appeal).

²⁶ Calling a scent mark “olfactory” gives the feature quasi-scientific polysyllabic respectability but cannot advance its legal legitimacy.

B. Sound as Trade Mark

Sound trade marks are now commonplace in the U.S., where Metro-Goldwyn-Mayer's mark of "a lion roaring" has long been registered for movies. Unlike scent marks, their validity has been expressly accepted in the federal courts,²⁷ although the precise form in which they may be registered has not been fought out. Unlike scent marks, no *FTA* provision—other than the removal of the visual perceptibility condition—pushes the case for more relaxed registration requirements for sound marks in either Singapore or the U.S.²⁸

Sound marks are registrable in the EU, but under quite restrictive conditions. The seven-fold requirement of graphic representation as interpreted by the E.C.J. for scent marks—a "clear, precise, self-contained, easily accessible, intelligible, durable and objective" representation—applies across the board to all marks. It therefore constrains both what sound marks may be registered and how, if registrable, they may be described.

The leading case is *Shield Mark BV v. Kist* ('Shield') in 2003.²⁹ A Dutch firm held a set of registered sound marks comprising the opening bars of Beethoven's "*Für Elise*" and another set of a cock crowing, all for a wide range of services, including (appropriately enough) providing education on intellectual property issues (including no doubt the registrability of sound marks). The registrant sued a communications consultant who used those marks to advertise seminars on intellectual property, including trade mark law. The Dutch courts upheld an unfair competition complaint but dismissed trade mark infringement claims on the basis that sound marks were not registrable.

The case was referred to the E.C.J. on the trade marks point. The court ruled that sound marks were registrable but must comply with the requirement of graphic representation already mentioned. The marks were registered in a variety of forms except, oddly enough, by reference to any sound recording or sonogram; so the E.C.J. did not rule on two of the more obvious methods of representing a sound mark. As regards "*Für Elise*", it ruled that representing the sound as notes in ordinary lettering—E, D#, E, D#, E, B, D, C, A—was inadequate: the lack of any indication of pitch and duration left the mark fatally undefined. Just saying "the first 9 notes of '*Für Elise*'" with or without the addition of the words "when played on a piano" also would not do: a reader would have to leave the register and go elsewhere to figure out what those notes were, what they sounded like, or even (if no fan of Beethoven or classical music) what "*Für Elise*" actually was. And then scores of "*Für Elise*" differ in pitch, and different pianists are known to render the notes using different tempi and dynamics. The court however accepted the validity of a description of the mark by means of sheet music in bar and stave notation with tempo, accidental, and rest marks: this form, it said, satisfied the requirement of graphic representation.

²⁷ *Oliveira v. Frito-Lay* 251 F.3d 56 (2d Cir. 2001), approving *Re General Electric Broadcasting Co.* 199 U.S.P.Q. 560 (T.T.A.B. 1978).

²⁸ Although the rather restrictive E.C.J. decision on sound marks (see next footnote) was issued in 2003 some months after the signing of the *FTA*, the negotiating parties would have known that sound mark registrations were problematic in the EU in light of the earlier decision by the Court's Advocate General. The lack of any "best efforts" obligation to provide for registration therefore leaves Singapore courts and authorities entirely free to follow E.C.J. precedents if they choose.

²⁹ *Supra* note 10.

Yet one wonders how stave notation does satisfy the seven-fold requirement of registrability the court claimed to apply, or even how it adequately describes the mark as it had been used. The melody line of “*Für Elise*” played one-handed on a piano sounds different from the piece played—as originally scored by Beethoven—for two hands; and either version sounds different from the piece scored for and played by a trumpet, a chamber quartet or a symphony orchestra. If the sound actually used for a mark was only of the melody line played by a piano, to protect automatically all forms of representing the sound is to grant the registrant more than he has used or, one may say, deserves: the well-known vice of the overbroad claim. The problem may be clearly exposed when infringement is eventually alleged, for then the argument may take on the complexion (and complexity) of a musical copyright infringement case. More basically, the E.C.J.’s assumption that stave notation is “easily accessible” and “intelligible” is unrealistic: it presupposes a standard of musical literacy in trade mark registry aficionados that many successful contemporary popular composers lack.

The other marks in issue in the case—the crow of a rooster—were all found to be unregistrable in the forms presented.³⁰ Simply saying “cock crowing” is no description because roosters crow differently. Describing the sound as “Kukelekuuuuu”—the Dutch onomatopoeia for the English “cock-a-doodle-doo”—is no better: the representation differs among languages and is not in fact the sound a rooster makes: no red-blooded hen (or other rooster) would be fooled.

The court left open the question of whether the sound of a cock crow is registrable in any form. The most obvious method would be the lodging of a sound recording or sonogram of a particular crowing, both accepted in U.S. practice. It so happened that Metro-Goldwyn-Mayer (‘MGM’) did apply for a European trade mark for its lion roar, as represented in an attached graphic pattern it called a sonogram. In a decision delivered a couple of months before the E.C.J. *Shield* decision, a trade marks appeal board ruled that sonograms were in principle acceptable but MGM’s did not fit the bill.³¹ There is no standard lion’s roar: it may be loud or soft, long or short, high-pitched or low-pitched, or in other permutations or gradations. MGM’s sonogram did not indicate time or frequency, so no-one could tell anything about the tone, volume or duration of the sound. One may also wonder, after a registration in due form, what would constitute substantial infringement of a sonogram representing a 5-second high-pitched lion roar: a 2-second low growl, or a sonogram representing such a growl that looked the registered sonogram?

Singapore could nevertheless resolve the procedural point by allowing some combination of sonogram, sound recording and writing to fulfil the graphic representation requirement. Providing a sound file accessible online for searchers is at least more feasible, in the current state of technology, than trying to providing a scent sample that is accessible on-line at a remote location.

³⁰ Compare *Ride the Ducks LLC v. Duck Boat Tours Inc.* (21 March 2005), No. 04-CV-5595 (U.S. Fed. District Ct., E.D.Pa.) where, in interlocutory proceedings, the registrability of a U.S. service mark comprising the sound “of a quacking noise made by tour guides and tour participants by the use of duck call devices throughout various portions of the tour” was apparently accepted, although the mark failed for lack of distinctiveness.

³¹ *Metro-Goldwyn-Mayer Lion Corp.’s Appeal relating to Community trade mark application No. 143 891*, Case R 781/1999-4, Decision of OHIM Fourth Board of Appeal of 25 August 2003, as corrected on 29 September 2003.

The substantive policy question still remains: should firms be entitled to appropriate as their trade mark a sound in nature, and, equally, should they be entitled to re-appropriate pieces of famous music when the music is out of copyright and beyond the reach of their composer's moral rights (in jurisdictions which recognize such rights)? From the perspective of the music-loving public, to accept that a toilet manufacturer can use Handel's "*Water Music*" to advertise his wares seems bad enough. He may then, through a passing-off action, flush out other traders from confusing the public by using the same or similar music to push their own wares. To go further and allow such indicia to be registered seems an unnecessary encouragement for the whole public domain music repertoire to be privately re-appropriated for commercial ends. One wonders whether music will ever be or sound the same again?³²

C. Colour as Trade Mark

Colour can be, or be part of, a protectable trade mark: the blue, white, and gold oblong Visa trade mark for credit cards is a well-known example. The difficulty of course is that colour is popularly thought of as an inherent property of matter (although technically, it is the brain's reaction to light reflecting off matter). Added colour is often used simply for functional purposes (a red traffic light) or to decorate products or make them more attractive. Colours are therefore not inherently trade mark material, but can become so by use.

The more common the colour, the less likely it is that the consuming public will regard it as a trade mark, but this factual assumption can be overcome by evidence. The broader the range of goods or services applied for, the greater care is needed before deciding whether to register the mark, lest other traders be stopped from using colour simply as a selling feature of their goods. Traders could also monopolise the whole spectrum by registering large numbers of colours and shades.

This general stance is common to Europe and elsewhere. In one leading case, the colour orange was sought to be registered for a variety of products and services relating to seed preparation and marketing: seed preparation machinery, seed consultancy services and seeds themselves when sold to the public. The E.C.J. accepted that orange was in principle registrable, but only exceptionally in the absence of use. Registration was confirmed for consultancy services, but not for machinery and seeds: there the market did not treat colour as distinctive of particular producers, and orange was indeed used simply as a colour for other producers' products.³³

Of course, if a colour is trade mark material, it has to satisfy the graphic representation requirement. Just providing a sample of the mark and describing it as "orange" is not enough. A reference to a Pantone number or other internationally recognized

³² Compare Walter Benjamin, "The Work of Art in the Age of Mechanical Reproduction," (trans. by H. Zohn), in D.H. Richter, ed., *The Critical Tradition: Classic Trends and Contemporary Trends* (New York: St Martin's Press, 1989) at 571 and 574, arguing that art loses its aura as reproduction detaches it from its original tradition. Similarly, the commercialising of public domain music detaches it from the private relationship it shares with its listener and places it in the commercial sphere of pushing marketplace commodities.

³³ *KWS Saat AG v. (OHIM) (Trade Marks and Designs)*, Case C-447/02 P (E.C.J., 21 October, 2004).

identification code is required to notify the trade and the public of the claimed ambit of the monopoly.³⁴

Combinations of colour usually work better as a mark than do single colours because buyers may more readily recognize combinations as trade marks and allow them to become distinctive. But the description must be more precise than just “blue and yellow for adhesives” even if the shades of blue and yellow are specified and samples are attached: “Such representations would allow numerous different combinations, which would not permit the consumer to perceive and recall a particular combination, thereby enabling him to repeat with certainty the experience of a purchase, any more than they would allow the competent authorities and economic operators to know the scope of the protection afforded to the proprietor of the trade mark.”³⁵ Sometimes a particular colour or combination may be competitively necessary: outboard motors may have to be black or white to match the full range of colours that boats come in. In such cases, distinctiveness should be rarely found: to grant one trader a monopoly in the colour may put other honest traders at a significant competitive disadvantage.³⁶

This last point has not always been recognised. For example, pharmaceutical companies have sometimes persuaded courts that a patient who demands “the same again” means to receive not just a drug with the same active ingredients but the very same drug as before made by the same manufacturer.³⁷ This reductionist view of patient psychology suggests that good health policy and intellectual property law do not necessarily coincide, especially since trade mark law allows the first maker itself to change ingredients without telling the public.

The use of colours for pharmaceuticals has long been contentious. Proprietary drug companies fight among themselves to claim the colour they think best to market their particular product, and then fight generic drug producers who adopt the same colour for their copies when the product comes off-patent. Today so many different colours are used by each drug company for its range of products that claims that any one colour can be or has become distinctive of a single company are scrutinised, rightly, with scepticism. Prototypical colours for pills—white, yellow, green, pink—while technically registrable, may be just too common to distinguish one owner’s pills from another’s in fact.³⁸ Consumers might think these are the colour of the ingredients; they may think the colour is there to make the pill more attractive; they may think the colour distinguishes the product (one particular formulation from another) rather than the producer (Drug Co. X’s pill from Drug Co. Y’s pill); and doctors and pharmacists who wish to avoid charges of negligence or professional misconduct rely on indicators other than mere colour or shape when prescribing or dispensing.

To overcome such objections, assertions that a colour is in fact distinctive of a single producer must be supported by convincing evidence. Even if the assertion is

³⁴ *Libertel Groep BV v. Benelux-Merkenbureau* Case C-104/01, [2002] E.C.R. II-3843 E.C.J. (E.C.J.).

³⁵ *Re Heidelberger Bauchemie GmbH* (24 June 2005), Case C-49/02 (E.C.J.) at para. 35.

³⁶ *Viking-Umwelttechnik GmbH v. OHIM (Trade Marks and Designs)* Case T-316/00, [2002] E.C.R. II-3715 (C.F.I.), green and grey for mowers non-distinctive; compare *Qualitex*, *supra* note 16 at 1304.

³⁷ *F. Hoffman-La-Roche & Co. AG v. DDSA Pharmaceuticals Ltd.* [1972] R.P.C. 1 (C.A.) (green and black capsules for Librium tranquillizer).

³⁸ *Smith Kline & French Laboratories Ltd.’s Cimetidine Trade Mark* (1988), [1991] R.P.C. 17 (Ch.) (pale green for Tagamet held non-distinctive in U.K. in fact despite long use).

accepted, the mark may still be weak and entitled to only narrow protection. What is true for single colours is equally true for combinations of colour such as two-tone capsules.

D. Shape as Trade Mark

Since trade marks are not substitutes for patents or industrial designs, the holder of a patent or a design right—valid, invalid, or since expired—is not encouraged to bolster this monopoly through a trade mark on the same feature. So functional and ornamental features—elements that are integral to a product or that make it attractive—should not usually be accepted as trade marks.

A large miscellany of product shapes and features has sought to establish itself in Europe as a three-dimensional trade mark: cakes, candy, watches, forklift trucks, flashlights, soap, detergent capsules, bottle shapes and other packaging.³⁹ Again, although in theory such features are not subjected to stricter criteria for registration than traditional marks are, in practice registration is tougher. The shoals on which shapes and designs have typically foundered in Europe are a lack of distinctiveness and a statutory prohibition on the registration of certain shapes. A squarish smooth-edged detergent tablet with a few coloured speckles or layers came unstuck on the first ground: consumers would take this shape, with or without the colour or layer features, as an inherent part of the product, not as indicating a particular detergent producer.⁴⁰ Similarly, “Mag-Lite” flashlights may look pretty and may warrant design protection; but their shape does not depart “significantly from the norm or customs of the sector and thereby fulfil its essential function of indicating origin.” So the shape was found to lack distinctiveness as a trade mark.⁴¹

Even if a shape is found distinctive, it must pass two further thresholds: it must not designate the kind, quality or intended purpose of the product or service, and it cannot consist exclusively of “the shape which results from the nature of the goods themselves, or the shape of goods which is necessary to obtain a technical result, or the shape which gives substantial value to the goods.”⁴² The leading case involved Remington’s imitation of the three-headed rotary design of the Philips electric shaver, an expired design registration that had since been re-registered this time as a trade mark. The E.C.J. confirmed that product shapes, though not usually inherently distinctive, can become distinctive through use. In practice, however, proof that consumers recognise a shape as a trade mark signifying a single source is difficult to achieve. But if the feature is designed to achieve a technical result, it is unregistrable even if other shapes could also achieve the same result.⁴³

The *Remington* case has not stemmed the flow of (mostly unsuccessful) attempts at trade mark registration of design features both in the European trade mark office and national registries. A recent decision involved the unsuccessful attempt to register a

³⁹ See generally Jeremy Phillips, *Trade Mark Law: A Practical Anatomy* (Oxford: Oxford University Press, 2003) at 142-155.

⁴⁰ *Procter*, *supra* note 14.

⁴¹ *Mag Instrument v. OHIM* Case C-136/02 P [2005] E.T.M.R. 46 (E.C.J.) at para. 31.

⁴² *Trade Mark Directive*, *supra* note 5, art. 3.1(c) & (e).

⁴³ *Koninklijke Philips Electronics NV v. Remington Consumer Products Ltd.* [2003] Ch. 159 (E.C.J.), *aff’d* [1999] EWCA Civ 1340 (C.A.).

three-dimensional flower shape for cheese in the U.K.⁴⁴ The English Court of Appeal rejected an argument that distinctiveness was established simply by showing that the shape was striking and unusual for cheese. For shape to function as a trade mark, the average consumer had to be able to say: “By this shape I know I can rely upon getting goods from the same maker as before.” The court, apparently drawing on its own knowledge, went on to say that consumers were not accustomed to recognising cheese shapes as trade marks. Trade marks are for distinguishing, not for eating; for consumers, not (cultural critics notwithstanding) for consumption.

IV. WELL-KNOWN TRADE MARKS

In 1999 the general assemblies of the World Intellectual Property Organization (‘WIPO’) and the *Paris Convention for the Protection of Industrial Property*⁴⁵ (‘*Paris Convention*’) jointly recommended better protection for well-known trade marks (‘*Joint Recommendation*’).⁴⁶ The *Paris Convention* (in article 6bis) had since 1925 forbidden the registration of copies or imitations of well-known marks where confusion was liable to result. The main target was the local trader who took and registered a foreign well-known mark in a country where registration meant everything and the unregistered mark was a legal non-entity. After 1925 the foreign mark owner could oppose or invalidate the registration of the same or a similar mark for the same or similar goods.

From that modest beginning came an international campaign by major brand holders to gain complete control over how their brands were perceived on the market. The better consumers think of a brand, the more they are attracted to it, the more they are willing to pay for it, the higher the price the brand owner can charge, and the greater his profit. Anything that interferes with the brand perception that the owner seeks to create breaks this chain and must be stamped out. The benefit to the brand owner’s stockholder value is obvious; less so is the benefit to consumers, other traders and the general public, especially when they are located in a developing country.

The story of how brand owners came to wrap their power grab in a mantle of respectability is well-known.⁴⁷ These were, after all, brand owners; they and their agents well knew how to package and sell the product to courts and legislatures in pleasingly evocative and even intellectually attractive labels. They knew how to divert thought away from the murkier aspects of marketing practice. They equally knew how to tarnish and dilute the opposition with suitably repellent labels. They managed gradually to install much of their programme in law in the industrialised world; but the process is incomplete.

TRIPs and the *Joint Recommendation* are among the latest international steps in the process. Singapore has implemented both by amendments to its *Trade Marks Act* 1998. It did so in respect of the *Joint Recommendation* because of an *FTA* obligation.

⁴⁴ *Re Bongrain SA Trade Mark Application* [2004] EWCA Civ 1690 (C.A.).

⁴⁵ 20 March 1883, last revised at Stockholm, 14 July 1967, 828 U.N.T.S. 305 [*Paris Convention*].

⁴⁶ *Joint Recommendation Concerning provisions On The Protection Of Well-Known Marks* adopted by the Assembly of the Paris Union for the Protection of Industrial Property and the General Assembly of the WIPO (September 20 to 29, 1999) WIPO Doc. No. A/34/13, online: WIPO <http://www.wipo.int/documents/en/document/govbody/wo_gb_ab/doc/a34_13.doc> [*Joint Recommendation*].

⁴⁷ See e.g. Lemley, *supra* note 3.

TRIPs pushed protection of well-known marks closer to U.S. law, which itself goes well beyond the requirements of the *Paris Convention*. Well-known marks for services, not just goods, must now be protected. A mark's notoriety is to be judged by reference to "the relevant sector of the public" (not necessarily everyone), and notoriety may come from advertising the mark, not just using it. More importantly, *TRIPs* extended the reach of well-known registered brands to catch use on dissimilar goods or services if the use would indicate a connection between the mark and the registered owner, and the owner's "interests" were "likely to be damaged".⁴⁸

It is unclear whether the connection mentioned need cause likely confusion. The better view probably is that confusion is not required,⁴⁹ but some (including Singapore in its *TRIPs* amendments⁵⁰) thought the opposite. The more probable view is that the provision was designed to protect against trade mark dilution, an idea brand owners had been pushing since the early 20th century.

Let us take a simple example of how the provision might work: Consumers who see the well-known mark "Lexus" on a can of dog food⁵¹ would, obviously, not think the can is a car which they could buy and drive: a person who thinks otherwise is the classic "moron in a hurry" who needs help elsewhere than from trade marks law. Nor would consumers think the car maker has entered the dog food business. The use of the mark would therefore likely not confuse them. Yet consumers might still connect the mark loosely with the Lexus brand they know for cars, and might subconsciously be drawn to buy a can because of the car mark's favourable aura. Is this reaction likely to damage Toyota's interests? What interests are these? *TRIPs* mentions none.

One possibility is that Toyota might have secretly been thinking of diversifying into dog food, even though the line is far removed from its usual basket of products. So one interest might be the mark owner's intention to move into a market that its consumers had no idea it was interested in. The dog food maker's use of Lexus then hampers the car maker's proposed brand extension and so damages that interest.

The more obvious interests, however, are the avoidance of blurring or tarnishing of the mark's image. Blurring occurs if the buyer starts thinking dog food when he next sees a Lexus car.⁵² Tarnishing occurs when he starts thinking worse of the Lexus brand because of its association with dog food. If his dog turns its nose up or gets sick from eating the food, then its owner may be (irrationally or subconsciously) turned off Lexus cars and everything associated with them. And his dog may start

⁴⁸ *TRIPs*, *supra* note 4, arts. 16.2 and 16.3.

⁴⁹ *TRIPs*, *supra* note 4, art. 16.1 explicitly requires likelihood of confusion for trade mark infringement. If the same standard was meant for art. 16.3, why was the different phrase "indicate a connection" used? A comparable distinction has been made in EU trade mark law on similar drafting: *Sabel BV v. Puma AG* [1998] R.P.C. 199 (E.C.J.).

⁵⁰ *Trade Marks Act*, *supra* note 5, s. 27(3)(b).

⁵¹ The example is based on the Canadian case of *Lexus Foods Inc. v. Toyota Jidosha Kabushiki Kaisha* (2000), [2001] 2 F.C. 15 (Fed. C.A.), leave to appeal to S.C.C. refused, [2001] S.C.C.A. No 32 (Lexus canned foods allowed to register over opposition by Lexus car maker). Compare *Mead Data Cent., Inc. v. Toyota Motor Sales, Inc.*, 875 F.2d 1026 (2d Cir. 1989), where Toyota's arguments for letting its U.S. mark co-exist with LEXIS for a legal database seem incompatible with those later made in Canada to purge LEXUS from canned goods.

⁵² Thus, the registrant of the "marksandspencer.com" domain name was said to commit the tort of passing-off by "erosion of the exclusive goodwill in the name which damages or is likely to damage Marks & Spencer Plc": *British Telecommunications Plc v. One In A Million Ltd.* [1998] EWCA Civ 1272.

chasing them. If that scenario is thought unlikely, suppose the dog food maker then chose Lexus as the mark for a line of condoms he planned to launch.

The *Joint Recommendation* extended and elaborated the dilution concept. Among other things, it removed the distinction between registered and unregistered well-known marks. Secondly, it extended the reach of well-known marks against business and domain names. Thirdly, it provided a set of guidelines on when a mark could be considered well-known: perhaps appropriately, given the subject-matter, the guidelines themselves are likely to confuse the reasonable, even expert, reader.⁵³ Fourthly, the Recommendation conceded that the *TRIPS* article 16.3 might be read restrictively to cover only cases of likely confusion—where the brand owner was thought to have diversified into or licensed the remote use.⁵⁴ So it added two provisions, drawn from an amalgam of U.S. and EU law, that explicitly protected well-known marks from dilution. The mark owner could take action where:

- (ii) the use of that mark is likely to impair or dilute in an unfair manner the distinctive character of the well-known mark;
- (iii) the use of that mark would take unfair advantage of the distinctive character of the well-known mark.⁵⁵

Toyota might have a clearer claim against the dog food maker, certainly if he diversifies into Lexus condoms. On the other hand, Toyota's case might collapse: the language of all these provisions is so malleable that a national court, looking at these provisions into its legislation, might tell Toyota to quit whining and go sell some cars. Any formula that requires a tribunal to decide whether an activity has affected something “in an unfair manner” or has taken “unfair advantage” of an attribute gives decision-makers broad leeway.⁵⁶

Singapore has fleshed out these provisions in sections 55, 55A and 8(3)(A) and (B) of the *Trade Marks Act*. In section 2(1), it has defined dilution as “the lessening of the capacity of the trade mark to identify and distinguish goods” even if the parties are not competitors and no public confusion is likely. In section 2(7) it has also defined “well known” in the same question-begging way the *Joint Recommendation* has proposed. What is to be made of a provision that says, circularly, it is “relevant” to take into

⁵³ After art. 2(1)(a) says unexceptionably that any circumstance may be taken into account, art. 2(1)(b) provides a list of relevant factors, and then provides in art. 2(1)(c) this astonishing outpouring of verbiage:

The above factors, which are guidelines to assist the competent authority to determine whether the mark is a well-known mark, are not pre-conditions for reaching that determination. Rather, the determination in each case will depend upon the particular circumstances of that case. In some cases all of the factors may be relevant. In other cases some of the factors may be relevant. In still other cases none of the factors may be relevant, and the decision may be based on additional factors that are not listed in subparagraph (b), above. Such additional factors may be relevant, alone, or in combination with one or more of the factors listed in subparagraph (b), above.

⁵⁴ See *Joint Recommendation*, *supra* note 46, Explanatory Notes for art. 4(1)(b)(i).

⁵⁵ *Joint Recommendation*, *supra* note 46, art. 4(1)(b).

⁵⁶ Thus, *Joint Recommendation*, *supra* note 46, Explanatory Notes on art. 4(1)(b)(iii) include the following:

The reference to “unfair advantage” in this item is intended to give Member States flexibility in the application of this criterion. For example, reference to a well-known mark for commercially justifiable reasons, such as the sale of spare parts, is not unfair and should, thus, be allowed.

account anything “from which it may be inferred that the trade mark is well known, including such of the following matters as may be relevant” including recognition by any “relevant” sector of the public in Singapore, which is then itself defined in an inclusory way?⁵⁷ “Well-knownness” has caused difficulties everywhere it has come up, and listing a set of non-exhaustive factors which may all be irrelevant to determine it is very close to talking nonsense. For a geographically small state such as Singapore, this approach is particularly inapt: in practical terms, a continuing set of eye-catching advertisements in one of the republic’s high-circulation newspapers may make the mark well enough known for the provisions to bite.

It is hard to take these provisions seriously, and Singapore could not be blamed if its courts took a restrictive view of them.⁵⁸ On the one hand, well-known mark owners say that people should not reap where they have not sown, that bad faith should be punished, that people who sidle up to their well-known marks are guilty of dishonest commercial practice. These vituperations lead nowhere. One might as well say that the well-known mark owner is reaping where it has not sown when it stops a trader in a geographic or market field remote from the owner’s fields from using the same or a similar mark uncompetitively. Is the balance of interests between the well-known mark owner and the later user so unevenly balanced that we can confidently say it is the latter rather than the former who is acting in bad faith or contrary to honest commercial usage?

Here are some reasons why the well-known mark owner’s sense of grievance seems unjustified:

1. Once trade mark law moves away from the object of protecting consumers from confusion, it starts looking distinctly dodgy. Trade marks with some design elements—“Coca-Cola” written in fancy script—already have copy-right in that presentation as an “original artistic work”, beyond their rights as registered trade marks. Copyrights are not granted for even invented word trade marks like “Exxon,” let alone the more typical uninventive mark that comes out of a company’s marketing department. A right in an uninventive word—say “Sunlight” for soap—that runs against both competitors and non-competitors, whether or not public confusion occurs or is likely, starts looking like a worldwide perpetual copyright for a word that has not satisfied the ordinary, quite easy, conditions for copyright.
2. Well-known marks already receive considerable added protection. For example, likelihood of confusion is more easily found for such marks than for it is for their lesser-known sisters; they can get protected in remote countries where they have not even been used; cybersquatters are sent packing more easily.⁵⁹ And now the marks get protection against dilution. The message is that all marks may be born equal but some become more equal than others. One may perhaps not begrudge the added value that a well-known mark acquires on the market simply because of its notoriety: that is the standard

⁵⁷ *Trade Marks Act*, *supra* note 5, s. 2(9).

⁵⁸ The legislature has somewhat palliated their effect by introducing the same defences to an action under s. 55 as apply to all registered trade mark infringement cases, including: fair use in comparative advertising, non-commercial use, and news reporting and commentary: *Trade Marks Act*, *ibid.*, s. 55A; s. 28.

⁵⁹ See *e.g. British Telecommunications Plc v. One In A Million Ltd.*, *supra* note 52.

reward for success. But the rule in other fields of intellectual property is not that the more valuable one's asset becomes, the more additional rights we then proceed to award it. Just because a "Harry Potter" book becomes well known and its copyright becomes valuable since the books sell so well, their copyright owner is not also be awarded another set of exclusive rights: *e.g.*, that anyone who writes a book using the words "Harry Potter" anywhere in it now infringes the copyright, although the use of those two words would not have infringed the copyright when the books were selling slowly. Why then is trade mark law unique in this respect?

3. The principle of equal treatment among marks is violated in another respect. We treat firms with well-known marks better than we treat individuals with well-known names. During his lifetime, Elvis Presley could not stop anyone in the U.K. from applying his face and image to merchandise such as soaps or plates and marketing it openly, so long as fans were not misled into believing that he was endorsing those products.⁶⁰ Even in the U.S., his right to clamp down on such merchandising varied from state to state. After Elvis's alleged death, a U.K. trader in Elvis paraphernalia was held able to register trade marks bearing Elvis's name, and successfully to oppose the attempt by the Elvis estate to register its Elvis marks in the U.K.⁶¹ Why are states so reluctant to grant individuals the basic right to prevent the commercial use of their famous names and images, while simultaneously granting corporations not only that basic right plus more? Why have the rights of corporations somehow become more important than the rights of individuals? Is it simply because corporations have deeper purses and more effective political clout?
4. Granting any, let alone added, protection for a mark that its owner has not registered in a country within the well-known mark's catchment area is to reward insouciance and lack of due diligence at best, or incompetence at worst. Perhaps unsophisticated mark owners in the early 20th century may have deserved the protection that article 6*bis* of the *Paris Convention* gave them. They can hardly claim ignorance now in our globalised economy about how to protect what they claim to be their valuable asset in a remote jurisdiction: all they need to do is register it there. Regional registries (*e.g.*, for the European Community trade mark) and the *Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks*⁶² now make it relatively quick, easy and cheap to gain international protection for a global brand. Why should society protect those who fail to protect themselves?

Recall the post-War U.S. case where the owner of the well-known "V8" trade mark for vegetable juice chose to market its vitamin tablets under a completely different name. It managed to stop another trader from using "V8" for its competing vitamin pills—but not before a barely concurring

⁶⁰ *Irvine v. Talksport Ltd.* [2003] EWCA Civ 423 (C.A.), aff'd [2002] EWHC 367 (Ch.) on liability and increasing damages; *Re Linkin Park LLC's Appn.* [2005] E.T.M.R. 17, holding the name of a band unregistrable for posters under current EC and U.K. law.

⁶¹ *Elvis Presley Trade Marks* [1999] R.P.C. 567 (C.A.).

⁶² 27 June 1989, U.K.T.S. 1997 No. 3 [*Madrid Protocol*].

judge labelled the plaintiff's action that of a "dog in the manger".⁶³ Why is a trader who has not registered a mark in a jurisdiction but who wants to stop a local trader from adopting a similar mark there, even though there is no public confusion or competition with the first trader, any less a "dog in a manger"? Why should he be allowed both not to use the mark in remote fields and yet to stop others from doing so?

5. Granting rights as indeterminate as dilution rights to the owners of well-known marks places another weapon of harassment in the hands of the powerful against the weak. Professor Cornish instances the case where the movie studio which owns the "rights" in *The Simpsons* cartoon series sent a letter to the New Zealand owners of Duff's Brewery in Dunedin, Bev and Gavin Duff, telling them they would do well to change their company name because of the studio's "rights" over "Duff" beer, the fictional brand drunk by the character Homer Simpson. The studio's legal case may have been shadowy, but Bev and Gavin nevertheless changed the company name to "McDuff's Brewery".⁶⁴ They otherwise faced the prospect of crippling legal costs in taking on a movie studio giant. Who else in a similar position would have done differently? Care must be taken when rights are created and designed not to place clubs in the hands of those who need only a fly swat to defend themselves. And even flies sometimes deserve to be left alone.

V. CONCLUSION

Some years ago I suggested that:

"[T]he recent expansion of intellectual property has come to be more an end in itself than a means to the end of stimulating desirable innovation. The question whether existing protections should be scaled back or recontoured, because the activities that they supposedly foster would occur anyway and would be more widely distributed throughout society, is hardly asked any more."⁶⁵

The goal of trademark law may be more to help consumers choose between competing products than to stimulate desirable innovation. Yet the point remains: does granting greater trade mark rights do anything worthwhile other than reward efforts that would have occurred anyway?

I think not. Traders will always seek to make their products look, feel or smell better to attract or retain customers. They have plenty of ways to distinguish their products or services through conventional marketing practices. The truly inventive idea or design may deserve a patent or design right if it meets patent or design protection criteria. To allow trade mark protection in addition for the "unconventional mark" is to suggest the irrelevance of other protective regimes that were supposedly designed to encourage particular forms of innovation and to let other practices remain free for imitation. Deliberately chosen patent and design policies should not be swept aside by the sidewind of trade mark law.

⁶³ *Standard Brands v. Smidler* 151 F.2d 34 (2d Cir. 1945).

⁶⁴ *Supra* note 13 at 103-104.

⁶⁵ David Vaver, "Intellectual Property: The State of the Art" (2000) 116 Law Q. Rev. 621 at 636.

As for well-known trade marks, traders have ordinary commercial motivation enough to build strong brands and get consumers to prefer their products by reflex rather than by reflection. To provide new weapons beyond those currently available to stamp out market confusion is to fix what is not broken. It is to give the strong another legal way to harass the weak. That may be law re-form. It is not law reform.