

# The Trademark Reporter®

Official Journal of the International Trademark Association



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## OF TARTANS AND TRADEMARKS

*By Ross D. Petty\**

### I. INTRODUCTION

In the past two hundred years or so, tartan plaids have come to symbolize not only Scotland itself, but also the various Scottish clans and regiments, each of which has one or more uniquely identifying tartan plaids. Indeed, in the United States, and in parts of Canada and Australia, April 6<sup>1</sup> is recognized as National Tartan Day.<sup>2</sup> National Tartan Day is not a commemoration of the

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1. April 6 was selected because the Declaration of Arbroath was signed on this day in 1320. The Declaration was a plea to Pope John XXII to support the Scottish cause for independence from England. For a translation of the Declaration of Arbroath from the original Latin, see Paul H. Scott, *Scotland: An Unwon Cause* 4-7 (1997). Perhaps the most famous lines of the Declaration are as follows:

“[F]or, as long as but a hundred of us remain alive, never will we on any conditions be brought under English rule. It is in truth not for glory, nor riches, nor honours that we are fighting, but for freedom—for that alone, which no honest man gives up but with life itself.” *Id.*

2. April 6 was declared National Tartan Day in the United States by a Resolution of the United States Senate dated March 20, 1998. S. Res. 155, 105th Cong., 2d Sess. (1998). The Resolution reads as follows:

Whereas April 6 has a special significance for all Americans, and especially those Americans of Scottish descent, because the Declaration of Arbroath, the Scottish Declaration of Independence, was signed on April 6, 1320 and the American Declaration of Independence was modeled on that inspirational document;

Whereas this resolution honors the major role that Scottish Americans played in the founding of this Nation, such as the fact that almost half of the signers of the Declaration of Independence were of Scottish descent, the Governors in 9 of the original 13 States were of Scottish ancestry, Scottish Americans successfully helped shape this country in its formative years and guide this Nation through its most troubled times;

Whereas this resolution recognizes the monumental achievements and invaluable contributions made by Scottish Americans that have led to America's preeminence in the fields of science, technology, medicine, government, politics, economics, architecture, literature, media, and visual and performing arts;

Whereas this resolution commends the more than 200 organizations throughout the United States that honor Scottish heritage, tradition, and culture, representing the hundreds of thousands of Americans of Scottish descent, residing in every State, who already have made the observance of Tartan Day on April 6, a success; and

Whereas these numerous individuals, clans, societies, clubs, and fraternal organizations do not let the great contributions of the Scottish people go unnoticed:

tartan itself, but is rather a celebration of Scottish heritage, thus lending further support to the tartan as a symbol of Scotland and “Scottishness.”<sup>3</sup>

This article examines the relationship between tartan plaids and trademark law. It first examines the history of the Scottish tartan from its early development through its prohibition after the 1745 Jacobite uprising in support of Prince Charles Edward Stewart as the rightful heir to the British throne. The article discusses how the tartan and the kilt evolved into distinctive patterns for individual clans and became the national dress for all of Scotland. Today, tartan products are a \$100 million industry in Scotland, so the issue of trademark protection for tartan patterns naturally arises. The remainder of this article is devoted to whether modern clan associations could register their tartans as trademarks, thereby gaining both control over how they are used and gaining licensing revenue from their permitted uses.

## II. THE HISTORY OF HIGHLAND DRESS AND THE JACOBITE UPRISINGS

Earliest records and descriptions of the people of the Scotland Highlands describe them as wearing loose shirts or tunics rather than trousers as worn by non-Celtic Northern Europeans. These loose shirts were augmented by a “plaid” (meaning blanket) or mantle worn over the shirt.<sup>4</sup> Some argue that tartan plaids date back at least to 1440, but these plaids were very different from modern day tartans. Earliest surviving samples, written records, and pictures of these plaids suggest that they were what we today would call stripes, checks and even herringbone and twill patterns, rather than the modern tartan patterns. One expert has described the number of plain weaves that have survived as “remarkably small” compared with those containing patterns such as twills, diamonds, and herringbone.<sup>5</sup> Thus, it appears that from an early time, highlanders did enjoy colorful patterned garments, just not what we would presently consider to be clan tartans.

It is clear that by 1600, Scotland highlanders were wearing what is now known as the large belted plaid. This is essentially a large blanket that is gathered into pleats and worn around the waist, secured by a belt. It was quite versatile. It could be unbelted

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Now, therefore, be it Resolved, That the Senate designates April 6 of each year as “National Tartan Day.”

3. See generally [www.tartanday.com/about.htm](http://www.tartanday.com/about.htm) and Ross D. Petty, *Tartan Law: A Celebration of National Tartan Day*, 34 Bus. L. Rev. 97 (2002).

4. Hugh Cheape, *Tartan* 13 (1995).

5. John Telfer Dunbar, *History of Highland Dress* 48 (1962).

and used as a blanket for sleeping or pulled over the head for protection from the nasty Scotland Highlands weather.<sup>6</sup> However, the term “plaid” in this usage refers to the garment that was the forerunner of the modern kilt, rather than a particular pattern of weave. Yet, at this same time, the term “tartan” did commonly refer to woolen cloth woven in stripes of color.<sup>7</sup> From 1600 through 1746, the belted plaid continued to be popular in the Highlands, and was worn by rich and poor alike (although the quality varied), but the tartan patterns were not yet differentiated by clan.

In 1603, James VI, King of Scots, the son of Mary, Queen of Scots, was crowned James I of England upon the death of his aunt, Elizabeth I. This Union of the Crowns led to a religious struggle between Catholic monarchs and the Church of England, which was trying to supercede Scottish Presbyterianism. Charles I, son and successor of James I, was executed after a trial by Parliament, and his heirs, Charles II and James II, were exiled.<sup>8</sup> James II's daughter was invited to become Queen Anne upon the death of King William II, but only after the 1701 Act of Settlement specified that if she had no children to succeed her, the crown would fall to Sophia of Hanover, the nearest Protestant relative. During Queen Anne's rule, the Scottish Parliament agreed to the Act of Union in 1707, and dissolved itself in exchange for 45 seats in the new joint House of Commons (where England held 513 seats) and 16 peers in the House of Lords (compared to England's 190). When Queen Anne died in 1714, the House of Hanover assumed the monarchy. This rejection of the Scottish line of rulers, together with the Act of Union, which was unpopular in much of Scotland, set the stage for various Jacobite rebellions, beginning with James VIII (reverting back to Scottish numbering), the “Old Pretender,” and ending with the defeat of Charles Edward Stewart, “Bonnie Prince Charlie,” in 1746.<sup>9</sup> In 1745, Prince Charles Edward Stewart adopted Highland dress as a uniform for his army, and it became a symbol of Jacobitism as he conquered Scotland and marched toward London.<sup>10</sup> However, Bonnie Prince Charlie spread his forces too thin, and upon the return of most of the British forces from France, he was forced to retreat back to Scotland and was ultimately bitterly defeated at the Battle of Culloden. He was barely able to escape back to France.

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6. *Id.* at 22-66.

7. Cheape, *supra* note 4, at 13.

8. Peter and Fiona Somerset Fry, *The History of Scotland 162-81* (1995).

9. *Id.* at 182-98.

10. Cheape, *supra* note 4, at 28.

***A. The Ban of Highland Dress—  
Not a Traditional Sumptuary Law***

Immediately after the defeat of Jacobite forces at Culloden in 1746, the English Parliament prohibited the wearing of Highland dress and the tartan in Scotland.<sup>11</sup> Dunbar reports that those suspected of violating the act were forced to take the following oath:

I, \_\_\_\_\_, do swear, and as I shall have to answer to God at the great Day of Judgment, I have not nor shall have in my possession, any gun, sword, pistol, or arm whatsoever; and never use any tartan, plaid, or any part of the Highland garb; and if I do so, may I be cursed in my undertakings, family, and property —may I never see my wife and children, father, mother, and relations —may I be killed in battle as a coward, and lie without Christian burial, in a strange land, far from the graves of my forefathers and kindred; —may all this come across me if I break my oath.<sup>12</sup>

While the ban on the possession of weapons by Highlanders makes sense after the rebellion, requiring the same oath and imposing a punishment of six months imprisonment for the first offense of wearing or possessing Highland clothes seems extreme. Supporters of Highland dress argued that the plaid was very inexpensive and well suited for the cold life in the Highlands. As already noted, it served as a blanket for sleeping and made crossing the numerous Highland streams and bogs easier since it could simply be raised so as not to get wet and then lowered again upon reaching dry land. On the other hand, supporters of the law argued that the plaid encouraged idleness, since it was suitable for lying around, its coloring provided camouflage for Highland robbers, and its use as a portable tent encouraged rebellion. Regardless of the merits of the ban, it is clear that it was enforced at least for the first five years or so after its enactment.<sup>13</sup>

This prohibition of the wearing of certain clothes by a specific category of people, while unusual by today's standards, was not unusual after war or rebellion in earlier times. Such prohibitions had been previously imposed against both the Irish and the Moors

11. Act of 1746, 19 Geo. 2, ch. 39 (Eng.): “[N]o Man or Boy, within that Part of Great Britain called Scotland, other than such as shall be employed as Officers and Soldiers in His Majesty’s Forces, shall, on any Pretence whatsoever, wear or put on the Clothes commonly called Highland Clothes (that is to say) the Plaid, Philebeg, or little Kilt, Trowse, Shoulder Belts, or any Part whatsoever of what peculiarly belongs to the Highland Garb; and that no Tartan, or party-coloured Plaid or Stuff shall be used for Great Coats, or for Upper Coats; . . .”

12. Dunbar, *supra* note 5, at 6.

13. *Id.* at 4-8.

in Spain.<sup>14</sup> Such clothing restrictions are similar to those imposed under an ancient legal tradition classified as sumptuary law.<sup>15</sup> The general purpose of sumptuary law was to prevent the poor from spending their money on clothes or other extravagances that they could not afford. Extravagance was widely believed to be wrong, if not a sin. It was feared that the poor would attempt to hide their poverty by conspicuous purchases of clothing that would make them appear to be above their class. If the tartan prohibition is deemed the last vestige of sumptuary law, then sumptuary law ended much as it began, as an attempt to break up the power of clans. The beginnings occurred in ancient Athens in the 6th Century B.C. as a regulation of funeral processions, which were a key ritual of the clans. The government sought to re-orient people toward the family and the state and away from the clan. Sumptuary law evolved to encompass all rites of passage, such as births and marriages, and in ancient Rome they sought to limit the extravagant servings of food at banquets. The Romans also introduced sumptuary restrictions on gold ornaments on clothing and other issues of fashion.<sup>16</sup>

In Europe, China and Japan, the advent of feudalism brought sumptuary clothing restrictions imposed on the emerging middle class to keep them from too closely emulating the upper class. Initially, clothing restrictions were simply limits on the price paid for outfits or materials. Later laws specifically reserved certain fineries for those of particular higher social classes. Lastly, with the advent of mercantilism, sumptuary law took on protectionist aspects. Limitations were placed upon the purchase of goods that had been imported, and as a country developed its own production capacity, these limits generally were lifted on domestic products, but not on imports.<sup>17</sup>

These general patterns were followed in Scotland, although at a somewhat later period than in England. The first known Scottish sumptuary statute of 1429 divided society into three broad classes: lords and knights with income over 200 merks; gentlemen and

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14. Dunbar, *supra* note 5, at 2.

15. See Alan Hunt, *Governance of the Consuming Passions: A History of Sumptuary Law* (1986). Actually business dress codes, Sunday "Blue Laws," anti-gambling and city ordinances against prostitution and adult nightclubs may be the last vestiges of these ancient laws. *Id.* at 364, 382-87. See also Malla Pollack, *Your Image Is My Image: When Advertising Dedicates Trademarks to the Public Domain—With an Example from the Trademark Counterfeiting Act of 1984*, 14 *Cardozo L. Rev.* 1391, 1422-27 (1993) (arguing that the prohibition on trademark counterfeiting may be an example of modern sumptuary law). See also Kozinski, *Trademarks Unplugged*, 68 *N.Y.U. L. Rev.* 960, 976 (1993).

16. Hunt, *supra* note 15, at 18-22.

17. *Id.* at 22-34.

burgesses; and commoners.<sup>18</sup> In 1672, these three classes were reduced to two.<sup>19</sup> Sumptuary law in Scotland was almost completely repealed in 1673 by the repeal of prohibitions against anyone but the rich wearing silk fabrics, beaver hats and lace.<sup>20</sup> The repeal was justified on the grounds that the poor actually worked to produce these items. The few remaining class restrictions were removed in 1681.<sup>21</sup> For the next decade, sumptuary restrictions applied to everyone as a trade protectionist measure.<sup>22</sup>

The later British ban on Highland tartan and apparel, although regulating dress, was not a sumptuary law in the classic sense. It was not intended to prevent extravagance based on trade protection or other social policy grounds, nor was it intended to prevent the poor from emulating the rich through conspicuous consumption, thereby spending their money foolishly and diluting the distinctiveness of the finery worn by the upper class. Indeed, in the Highlands, before the ban, everyone wore tartan whether rich or poor.<sup>23</sup> Rather, the ban was intended to prevent Highlanders from readily identifying each other, and from the tartan and Highland dress serving as a symbol for rebellion. Because Highland dress was less expensive than alternatives, the ban on Highland dress required the poor to spend more money to obtain less suitable clothing. Poor Highlanders also were required to wear clothing that would blend in better with richer classes of people. Thus, in many ways, the apparent sumptuary ban of the tartan was not sumptuary at all, but more akin to ethnic suppression.

The tartan proscription provides an interesting contrast with modern trademark law. In modern times, the increasing prominence of trademarks on items and their protection under law appears to encourage both conspicuous consumption of trademarked items and people with similar likes identifying one another. The wearing of an expensive trademarked item is precisely the type of conspicuous consumption that traditional sumptuary laws condemned if the wearer was poor. The wearing of a trademarked item of a sports team or bearing a collegiate logo is the sort of association/identification that the ban on Highland dress sought to restrict. Despite this restriction, as discussed below, the identification of “Highlandism” and eventually

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18. Acts of Parliament of Scotland [APS] II: 18:8-10 (Scot.). See generally, Francis Shaw, *Sumptuary Legislation in Scotland*, 24 *Juridical Rev.* 81 (1979).

19. APS III:71-72: ch. 21 (Scot.).

20. APS III: 212, ch. 3 (Scot.).

21. APS VIII: 348-49, ch. 78 (Scot.).

22. Hunt, *supra* note 15, at 172.

23. Cheape, *supra* note 4, at 13.

“Scottishness” became a positive attribute, and a commercially profitable one as well. Thus, the trademark value of identifying goods overcame the political goal of ethnic repression.

### ***B. The Highland Revival and the Promotion of Clan Tartans***

By 1760, the ban on Highland tartan and Highland attire was no longer actively being enforced. In 1773, two British tourists in the Highlands failed to see a single person wearing tartan.<sup>24</sup> Even so, the seeds of a revival had been sown. Several portraits of clan chiefs painted during this period show them wearing both tartan and various forms of Highland clothing. Furthermore, the Highland Society was formed in 1778 in London, where its members legally could and did wear Highland dress. Lastly, the Act itself contained an exemption for Scotsmen serving in the British military. Field Marshall George Wade began recruiting Highlanders to serve in his Majesty’s forces in 1725. These Highland regiments were used initially to police the Highlands. Later, they were organized into the world famous Black Watch.<sup>25</sup> By the time the prohibition on Highland dress was repealed, Scottish soldiers had made that form of dress known worldwide. These regiments originally wore the large belted plaid, but quickly adopted the modern kilt after it was invented by Thomas Rawlinson, an English Quaker who designed it for his Scottish workers who needed a less cumbersome garment to fell trees and tend smelting furnaces.<sup>26</sup> As the number of regiments multiplied, the regiments became the first to adopt differentiating tartan patterns.<sup>27</sup>

The ban on Highland dress was officially repealed in 1782 by a bill introduced by the Marquis of Graham, later the Duke of Montrose, at the request of the Highland Society. The Marquis was hailed as a hero in Scotland because of this bill.<sup>28</sup> After repeal, interest in Highland dress continued to grow, stimulated by the works of Sir Walter Scott and the defeat of Napoleon in 1815 by British forces, including the Highland regiments, which quickly

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24. Hugh Trevor-Roper, *The Invention of Tradition: The Highland Tradition in Scotland*, in *The Invention of Tradition* 15, 24 (E.J. Hobsbawm & Terence Ranger, eds., 1983).

25. Cheape, *supra* note 4, at 37-38. The Black Watch may not be particularly famous in the United States. See *Scotch Whisky Ass’n v. Majestic Distilling Co.*, 958 F.2d 594 (4th Cir.), *cert. denied*, 506 U.S. 862 (1992) (The trade name BLACK WATCH held not likely to confuse consumers as indicating Scottish origin).

26. Trevor-Roper, *supra* note 24, at 21-22.

27. *Id.* at 25.

28. Cheape, *supra* note 4, at 41; Dunbar, *supra* note 5, at 8.

captured the imagination of the Continent. The year 1815 also saw the Highland Society of London begin its collection of “clan” tartans. By 1820, about 40 samples had been collected, many certified in writing as an “official clan tartan” by clan chiefs.<sup>29</sup> This interest culminated in 1822 with the publication of a book by Colonel David Stewart of Garth, entitled *Sketches of the Character, Manners and Present State of Highlanders in Scotland*, and King George IV’s visit to Edinburgh, the first visit to Scotland by a British monarch in two hundred years. William Wilson and Son of Bannockburn, Scotland, a tartan manufacturer for the military, having heard a suggestion that there would be a royal visit in 1819, prepared a “Key Pattern Book” that it sent with samples to the Highland Society of London, which duly certified the patterns as belonging to one clan or another.<sup>30</sup> As a result, when the Highland Chiefs were invited to meet their King during the Edinburgh visit, they could dress in their clan tartan as encouraged by Scott and Stewart and the tartan weaving industry. Indeed, even Lowlanders in Edinburgh, whose grandparents would not have been caught dead in a Highland tartan, wore tartan to greet the King. The King himself appeared in Highland dress in what is now known as the Royal Stewart tartan.<sup>31</sup>

After this period, the clan tartan became fashionable among the rich throughout Britain and much of the Continent.<sup>32</sup> Interest in Highland dress was further stimulated by the publication of James Logan’s *The Scottish Gael* in 1832, and the Sobieski Stuarts’ *Vestiarium Scoticum* in 1842, followed by their related volume *The Costume of the Clans* in 1845. Queen Victoria’s long interest in the Highlands started in 1842 with her first visit there. The Wilsons of Bannockburn continued to refine and update their pattern books, sometimes changing names of new patterns when adopted by a clan chief. They also regularized the exact pattern of clan tartans, making changes as needed to increase popularity.<sup>33</sup>

This enthusiasm for clan tartans continued into the twentieth century, with the founding in 1907 of the Kilt Society in Inverness, Scotland, and attempts by the Lord Lyon of Scotland, who exercises jurisdiction over Scottish Heraldry, to exert authority of clan chieftainships and tartans.<sup>34</sup> Today, an organization called the

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29. Cheape, *supra* note 4, at 48.

30. Trevor-Roper, *supra* note 24, at 30.

31. See generally Jan-Andrew Henderson, *The Emperor’s New Kilt: The Two Secret Histories of Scotland* 141-47 (2000).

32. Thus, restrictions on the wearing of the tartan by poor people at this time would have been a true sumptuary law, but no such law was enacted.

33. Cheape, *supra* note 4, at 55-62.

34. *Id.* at 69-70.

Scottish Tartans World Register is a non-authoritative body that maintains a single reference database of Scottish tartans.<sup>35</sup> Nearly six hundred tartan patterns are available today, including tartans for Lowland clans, military units, individual people, Canadian provinces and various cities and districts within Scotland. Many patterns come in several varieties, including standard, ancient, hunting and dress. Most recently, the Diana, Princess of Wales memorial tartan was introduced with “official approval” of the Diana, Princess of Wales Memorial Fund.<sup>36</sup> Ironically, the tartan, once condemned as the symbol of impoverished Highlanders and the Jacobite rebellion, not only has been embraced by Hanoverian monarchs, but also has become a commercial success for Scotland.

### III. COMMERCIAL USE OF TARTANS AND TRADEMARK LAW

With the commercialization of clan tartans, the question may be asked, why were these patterns not protected under trademark or copyright laws? The answer may be that, originally, the clan tartan patterns were purported to be of ancient origin. If a particular weaver copyrighted the pattern of an original tartan design, that would suggest modern artistic creation rather than ancient clan origin. Under modern copyright law, an original and distinctive tartan pattern would be eligible for copyright protection.<sup>37</sup>

Copyright protection for a new tartan design would apply despite the prohibition of copyrights on utilitarian articles.<sup>38</sup> Thus, while the garment design of a particular kilt would not be copyrightable as utilitarian, the tartan fabric from which it was made is separable from the utilitarian item and therefore would be copyrightable under U.S. Copyright law.<sup>39</sup> Fabric designs have been found to be copyrightable by U.S. courts.<sup>40</sup> The fact that a

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35. See [http://www.tartans.scotland.net/world\\_register.cfm](http://www.tartans.scotland.net/world_register.cfm).

36. See, e.g., [www.scottishlion.com](http://www.scottishlion.com).

37. See, e.g., *Concord Fabrics, Inc. v. Generation Mills, Inc.*, 328 F. Supp. 1030 (S.D.N.Y. 1971) (preliminary injunction for copyright infringement of “Indian Madras Plaid” denied because defendant’s pattern significantly different from the plaintiff’s copyrighted pattern). The Scottish Tartans World Register site suggests copyright protection for new tartans is available. See *supra* note 35.

38. 17 U.S.C. § 101 (2002).

39. See, e.g., *Kieselstein-Cord v. Accessories by Pearl, Inc.*, 632 F.2d 989 (2d Cir. 1980) (decorative belt buckles may be copyrighted because the decorations are separable from the utilitarian belt buckle aspects of the items). See S. Perlmutter, *Conceptual Separability and Copyright in the Designs of Useful Articles*, J. Copyright Soc’y 339 (April 1990).

40. See, e.g., *Millworth Converting Corp. v. Slifka*, 276 F.2d 443 (2d Cir. 1960) and *Peter Pan Fabrics, Inc. v. Martin Weiner Corp.*, 274 F.2d 487 (2d Cir. 1960). See generally

particular tartan plaid may identify an association with a certain clan, region or city is apparently not considered utilitarian since copyright law protects artistic logos for sports teams<sup>41</sup> and commercial products.<sup>42</sup>

The historic identification of specific tartans with particular clans also prevented trademark protection. While English common law recognized an action for damages for copying a merchant's mark at least as early as 1584,<sup>43</sup> for a tartan to receive such protection, the pattern would have to have been recognized as the mark of a particular weaver, rather than an emblem of a particular clan. In those days, discreet small marks were customarily used as trademarks rather than the entire pattern, so obtaining protection from common law deceit as a result of a copying of the entire pattern rather than a discreet mark would have been unlikely.<sup>44</sup> Moreover, by bringing such a case, the weaver would be claiming that the pattern was original to the weaver, rather than being a pattern used by a particular clan from earlier times. Thus, the myth that clan tartans originated in ancient times has historically militated against the application of either copyright or trademark protection to clan tartans.

### *A. Could a Modern Clan Society Claim its Tartan(s) as a Trademark?*

Collective marks are trademarks or service marks used by members of a cooperative, an association, or other group or organization, and include marks indicating membership in a union, association, or other organization.<sup>45</sup> Registration of a clan tartan as a collective mark by a clan society would allow the tartan to signify membership in the clan and be used to sell official clan

Jennifer Mencken, *A Design for the Copyright of Fashion*, 1997 B.C. Intell. Prop. & Tech. F. 121201 (1997).

41. See, e.g., *Bouchat v. Baltimore Ravens, Inc.*, 241 F.2d 350 (4th Cir. 2000), cert. denied, 532 U.S. 1038 (2001).

42. See, e.g., *Olsen v. R.J. Reynolds, Tobacco Co.*, Copyright L. Rep. (CCH) P27,044 (9th Cir. 1992) (cigarette logo).

43. See Keith M. Stolte, *How Early Did Anglo-American Trademark Law Begin? An Answer to Schechter's Conundrum*, 88 TMR 564 (1998) (Sandforth's Case of 1584 involved a maker of "bad" cloth who used the same mark as a well-known maker of "good" cloth. The decision abstract appears to refer to Longe's Case, reportedly heard in the House of Commons in 1558, but no record of this earlier decision has been found).

44. But see *Vuitton et Fils S.A. v. J. Young Enterprises*, 644 F.2d 769, 772-74 (9th Cir. 1981) (luggage decorated with repeating pattern from manufacturer's logo is protected because pattern is not functional but based on the identity of the manufacturer).

45. 15 U.S.C. § 1127 (1988 & Supp. IV 1992). The European Community also recognizes collective trade marks. See Rule 43 of Commission Regulation (EC) No. 2868/95 Implementing Council Regulation (EC) No. 40/94 on the Community trade mark, 1995 OJ L 303.

products such as memorabilia that include the tartan.<sup>46</sup> This would appear preferable to registering a clan tartan as a certification mark under U.S. law because certification marks can not be used by their owners to sell goods or services, and may only be used by third parties who qualify under the certification standard.<sup>47</sup> For example, the clan society could certify that a particular weave was its genuine tartan and certify others (presumably for a licensing fee) to produce and sell products using the tartan, but the society could not sell those products directly, and the certification mark would not signify membership in the clan. However, in practical terms a collective mark is similar to a certification mark and could function as one.<sup>48</sup>

Unlike copyright law, there is no requirement that a trademark be original to its creator—the only requirement is that it be used to distinctively identify the source of goods or services or, in the case of a collective mark, membership in a particular organization. The clan society would have to publicize not only that a particular tartan is uniquely associated with it, but that the tartan is used to identify the source or sponsorship of particular products of, or membership within, the clan. Many clan tartans appear to have had over 75 years of promotion as being connected to a particular clan. This should be strong evidence of a secondary meaning in those clan tartans among potential customers/members. Unfortunately, there are several constraints on the ability of a clan society to enforce trademark rights over its various clan tartans (dress, hunting, ancient). It is worth emphasizing that to be distinctive, it is not necessary that consumers or members be able to accurately identify the particular clan that is the source of a particular tartan. Rather, they must identify tartan patterns as identifying products or members of a particular clan, even if they can not identify the clan, rather than viewing the tartans as being just generic patterns of cloth that are available for use by anyone, thus having no secondary meaning.

### ***B. Constraints on Trademark Registrations***

There are three principal reasons why clan tartan trademarks may be denied trademark protection or trademark registration: (1) they may be considered to be symbols or insignia of a nation, state

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46. *Id.* This is exactly opposite to the approach once proposed for Native American tribal insignia: to prohibit the use of such insignia as or within trademarks. See Alexis A. Lury, *Official Insignia, Culture, and Native Americans: An Analysis of Whether Current United States Trademark Law Should Be Changed to Prevent the Registration of Official Tribal Insignia*, 1 J. Intell. Prop. 137 (2000).

47. *Id.*

48. *Opticians Ass'n of Am. v. Independent Opticians of Am.*, 920 F.2d 187, 193 n.8 (3d Cir. 1990).

or municipality; (2) they may be treated as merely a surname; or (3) they may be considered to be primarily geographically descriptive. Marks in the first category may not be registered (at least not without a disclaimer).<sup>49</sup> Marks in the latter two categories may be registered in the United States only upon a showing of a secondary, source-identifying meaning.<sup>50</sup> Moreover, trademarks that are primarily geographically deceptively misdescriptive may not be registered under recent Lanham Act amendments.<sup>51</sup>

The first problem may be summarily addressed in two ways. First, as noted in the first part of this article, Scotland is no longer an independent nation.<sup>52</sup> It is not clear that it qualifies as a state under U.S. law. Second, Scotland does have the equivalent of national symbols, such as the flag of St. Andrews, but individual clan tartans have a long history of identifying particular clans rather than identifying the entire area of Scotland. However, tartan patterns have been established for Australian and Canadian provinces, as well as some cities. Registration of any such tartans as trademarks might be challenged, but those are not the clan-identifying tartans that are the subject of this article.

Since tartan patterns are associated with a clan of a particular family name, trademark authorities may choose to treat tartans in a fashion similar to a family name. Since marks that are primarily family names may be registered only if they are proven to have a secondary meaning as a source identifier in the minds of consumers, it makes sense to require that proof of such secondary meaning be required for tartan clan trademarks as well.<sup>53</sup> This approach was followed by the Canadian Trade Marks Opposition Board in an actual tartan trademark case. In *Charles Ogilvy v. Jas. A. Ogilvy Ltd.*, both companies had long used the Ogilvy clan hunting tartan in association with their offerings. The Board treated the tartan just like the surname Ogilvy and denied registration because of the lack of distinctiveness.<sup>54</sup> This is

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49. 15 U.S.C. § 1052(b). Note heraldic arms also have been used in or as trademarks. See, e.g., Stephen J.M. Kinsey, "Trademarks in the Court of Chivalry," 43 *Trademark World* 25 (Dec. 1991/Jan 1992).

50. 15 U.S.C. §§ 1052(e)(2), 1052(e)(4) and 1052(f).

51. 15 U.S.C. § 1052(f). Registration for geographically descriptively misdescriptive marks is only available if they established a secondary source identifying meaning before December 8, 1993, the enactment date of the North American Free Trade Agreement Implementation Act (NAFTA).

52. See *supra* notes 8-9, and related text.

53. A search of the U.S. Patent and Trademark Office database revealed only two registered marks that included the word "tartan" in the goods description field (Drambuie had the only active Registration, Reg. No. 0624687) and only 47 registered marks that included the word "plaid" in the goods description field, including several owned by 3M.

54. 49 C.P.R. (2d) 276 (Trade Marks Opposition Board 1978) (Can.).

consistent with the traditional U.S. legal maxim that a business person cannot appropriate the person's surname as a proprietary trademark against others who share the same surname.<sup>55</sup> However, more recent cases have protected distinctive surname trademarks, particularly when they are used by junior users in a competing or related business. Protection has been justified if the junior user is trying to mislead consumers or if consumers are likely to be confused because of the similarity of the marks.<sup>56</sup> Occasionally, courts allow somewhat similar surname marks to be used, even if in the same business, but require a clear disclaimer of affiliation by the junior user.<sup>57</sup>

Another way to circumvent the problem of using a common surname or clan tartan in a trademark would be to add other features to the trademark. In an English case, similar to the Canadian Ogilvy case, the authority denied registration of the surname MacKenzie, alone, as a trademark for whisky, noting that Scottish surnames were commonly used for whisky names. It also noted that the use of a tartan pattern in a trademark was commonplace and thus non-distinctive for Scotch whisky. However, the entire proposed trademark was eligible for registration because it consisted of a combination of the surname, the tartan and a seal with two deer upon it. The entire combination was held to be distinctive.<sup>58</sup>

The use of a tartan pattern may distinguish two otherwise similar marks. In an opposition to the registration for the word TECH in white script letters across a tartan background by the owner of another TECH trademark, the Court of Appeals of the District of Columbia found that the fact that the marks would be used for different types of products, cigars versus ice cream and soft drinks, would avoid consumer confusion. The court further noted that the tartan background added to the distinctiveness of the mark being registered.<sup>59</sup> A similar result was reached in

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55. *Howe Scale Co. v. Wyckoff, Seamans & Benedict*, 198 U.S. 118 (1905); *Goidel v. Advance Neckwear Co.*, 132 Tex. 308 (1939). See also 15 U.S.C. § 1052(e)(3).

56. See, e.g., Quentin R. Wittrock, *Use of Personal Names in Noncompeting Businesses—Doctrines of Unfair Competition, Trademark Infringement, and Dilution*, 70 Iowa L. Rev. 995 (1985); *Alexis Lichine & CIE v. Sacha A. Lichine Estate Selections*, 45 F.3d 582 (1st Cir. 1995) (court refused to modify voluntary injunction to allow son to use his full name to sell alcoholic beverages after father had sold rights to a third party to use his similar name in same business); *E & J Gallo Winery v. Gallo Cattle Co.*, 12 U.S.P.Q.2d 1657 (E.D. Cal. 1989), *aff'd*, 966 F.2d 1327 (1992) (one of the three sons of the founder of Gallo Winery enjoined from using family name "Gallo" to sell cheese); and *Gucci v. Gucci Shops Inc.*, 688 F. Supp 916 (S.D.N.Y. 1988) (Paolo Gucci enjoined from using the name Gucci to sell leather products even though he used his full name and disclaimed association with the famous Gucci line of leather products).

57. *L.E. Waterman & Co. v. Modern Pen Co.*, 235 U.S. 88 (1914).

58. *MacKenzie Trade Mark*, 1967 R.P.C. 628 (Trade Mark Registry, Dec. 14, 1966).

59. *Pittsburgh Brewing Co. v. Ruben*, 3 F.2d 342 (D.C. Cir. 1925).

Canada when Uncle Ben's Inc., a well-known maker of rice products but with a common name, challenged the registration of UNCLE BEN'S TARTAN BEER with a tartan and waterfall in the background.<sup>60</sup> In both cases the fact that TECH and UNCLE BEN are weak marks also probably assisted in allowing the registration of similar marks used to identify dissimilar goods. Thus, if a clan were denied trademark status for its tartan, alone, it could combine the clan name, clan crest and the tartan to create a distinctive trademark.

Commercial users of clan trademarks also may select a different variation of a tartan to avoid confusion. Most traditional clan tartans are available in three distinctive variations: regular, dress and hunting. Some may also be sold in ancient forms of these patterns. The regular pattern typically emphasizes white and red colors, while the hunting pattern typically emphasizes green. Thus, in cases where a senior user has adopted one particular form of a clan trademark, the junior user could adopt one of the other variations to avoid confusion, and use a disclaimer or add additional features to the tartan. However, if all tartan forms became collective trademarks of the clan, then commercial users would have to be licensed by the clan to use the tartan as a trademark or as part of a trademark in any of its variations.<sup>61</sup>

There is a limit to the distinctiveness that a tartan background can provide. In Scotland, the Court of Session denied registration of the word GALLOWAY on a tartan background for use in identifying a type of cheese because of the pre-existing GALLOWAY mark for cheese (without the tartan background).<sup>62</sup> Since Galloway is a town in Scotland, the name already suggested Scottish origin. Adding a tartan background did not alleviate the likelihood of consumer confusion in this case.

In holding that the use of a tartan plaid in a trademark suggests Scottish origins, the Galloway cheese case suggests the third issue in seeking trademark registration for a clan tartan: geographic origin. As with family surnames, primarily geographically descriptive marks may not be registered unless they acquire a secondary meaning, and they must not be geographically deceptively misdescriptive.

Scottish whisky producers have been quite active globally policing whisky trademarks to insure that third party marks do

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60. *Uncle Ben's Inc. v. Uncle Ben's Tartan Breweries Ltd.*, 25 C.P.R. (2d) 102 (Registrar of Trade Marks 1975) (Can.).

61. In cases where a clan tartan is used as background for a trade name and perhaps other pictorial items in a trademark, the clan might still argue that consumers would be confused over whether the clan sponsored that particular commercial use.

62. *A. McLelland & Son Ltd v. Scottish Pride Foods Ltd.*, 1995 Sess. Cas. (Outer House Cases, May 16) (Scot.).

not falsely suggest Scottish origin.<sup>63</sup> Obviously, use of a tartan is one possible means of implying, without explicitly claiming, Scottish origin. Such situations have been challenged as acts of passing off in English courts when the exporter knew the whisky would be blended with non-Scottish whisky and improperly labeled in the importing country.<sup>64</sup> Similarly, another English court allowed challengers the chance to prove consumer confusion concerning geographic origin where genuine Scotch whisky was blended with English ginger wine, but then sold under the grand name of WEE MCGLEN with a tartan background label. The product was described as “A Whisky Mac,” a product of “Ginger Wine blended with Scottish whisky.” The court could not decide the issue on summary judgment.<sup>65</sup> In cases lacking any product from the United Kingdom, the Scotch Whisky Association actively pursues false designation of Scottish origin in courts throughout the world by the use of Scottish tartan patterns usually combined with other suggestive features.<sup>66</sup>

The issue of false geographic description is not a problem for Scottish clan societies based in Scotland, since the geographic description would be accurate. However, it does raise a question whether a clan society in the United States, or another country, could register the trademark in those countries. Such regional societies are typically affiliated with the mother clan society in Scotland. The affiliation and the regional society’s genuine interest in its Scottish clan origins may be sufficient to allow registration of the tartan trademark in its home country.

A similar issue arises when the Scottish clan tartan mark is used on goods. If the goods are manufactured in Scotland, as many tartan cloth products are, there is no geographic misrepresentation. However, if a tartan mark is used on a coffee mug or writing pen manufactured outside of Scotland, might

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63. *Compare Scotch Whisky Ass’n v. Consolidated Distilled Products, Inc.*, 210 U.S.P.Q. 639 (N.D. Ill. 1981) (Loch-A-Moor held not to be geographically descriptive of product origin given a clear indication of U.S. origin, but still found to be unfair to Scottish products) *with Scotch Whisky Ass’n v. Majestic Distilling Co.*, 958 F.2d 594 (4th Cir.), *cert. denied*, 506 U.S. 862 (1992) (Black Watch held not likely to confuse consumers concerning Scottish origin).

64. *See, e.g., White Horse Distillers Ltd. v. Gregson Associates Ltd.*, 1984 R.P.C. 61 (High Court of Justice—Chancery Div., July 29, 1983) (U.K.) (Scotch whisky exported to Uruguay); and *John Walker & Sons Ltd. v. Henry Ost & Co. Ltd.*, 1970 2 All E.R. 106 (Chancery Div., March 25, 1970) (Scotch whisky exported to Ecuador).

65. *Lang Brothers Ltd. v. Goldwell Ltd.*, 1980 S.C. 237 (Inner House, Second Division) (U.K.).

66. *See, e.g., The Scotch Whisky Association v. Heublein do Brasil Comercial e Industrial Ltda.*, Civil Appeal No. 72088, Official Gazette 406 (Feb. 11, 1999) (Brazil), reported in the International Annual Review, 90 TMR 213 (2000); and *The Scotch Whisky Association v. Nevo Agencies et al.*, Tel Aviv District Court (unpublished 1996) (Israel), reported in the International Annual Review, 86 TMR 931 (1996) and the International Annual Review, 85 TMR 890 (1995).

consumers be misled concerning its geographic origin? Certainly the whisky cases and other cases suggest this result. However, if the tartan is a collective mark indicating membership or sponsorship by the clan society owner, then arguably it is not geographically misleading since an actual Scottish clan is licensing the product. Disclosure of manufacturing origin, *e.g.*, “Made in China,” would appear sufficient to dispel any consumer confusion concerning geographic origin.

### *C. Trademark Use*

If kilts, shawls, neckties and even some hard goods such as coffee mugs, pens, and jigsaw puzzles are constructed with material bearing a particular clan tartan pattern, the question arises whether that use of the tartan is use as a trademark, identifying source, or some form of non-trademark use. Consumers probably do not expect that a clan society itself produces such goods, but they may believe that the collective mark is licensed to various producers. Alternatively, consumers might not think of the clan tartan pattern as identifying the clan society source or sponsorship at all, but rather as merely an attractive pattern. Indeed, some consumers probably purchase tartan products that they find attractive regardless of any clan affiliation of either the pattern or of the consumer. A broad-based survey of consumers who might purchase tartan goods might reveal whether consumers recognize the clan affiliation aspect of the various tartan patterns. Tartan goods sold in “tartan shops” typically identify the products by clan affiliation. Such shops, catalogs and websites typically offer a wide variety of clan tartans. In contrast, general clothing stores may offer a few products such as flannel shirts or scarves, in a few genuine clan tartan plaids, which may be identified by clan name or simply a general color description, *e.g.*, green plaid. General clothing stores also may offer tartan plaid products using tartan patterns that are not claimed by any clan.

Historically, trademarks were initials or small marks that identified a particular manufacturer as the source of the item. In the modern world of consumer product branding, trademarks often are featured more prominently on packages or on the product itself, and many marketers offer brand-logo merchandise, such as T-shirts, that feature the trademark even if unrelated to the merchandise, *e.g.*, a Ford automobile logo on a T-shirt. While the tartan plaid is related to uniquely Scottish clothing such as the kilt and some forms of sashes or shawls, it is not related uniquely to coffee mugs or pens. The latter would be the equivalent of logo merchandise. Two questions arise. First, in the case of Scottish clothing, is the use of a tartan plaid aesthetically functional? This question is addressed in Section D. The second question, is the use

of a tartan pattern on other types of merchandise a use of the tartan as a trademark at all, is the subject of this section.

The sale of logo merchandise by sports teams, both professional and collegiate, as well as others, presents an interesting analogy to the sale of tartan merchandise that is not traditionally considered Scottish, such as T-shirts, coffee mugs, etc. Whether such ornamental use of trade symbols should be regulated as trademarks has been debated by scholars at least since 1948.<sup>67</sup> In 1975, in *Boston Professional Hockey Association v. Dallas Cap & Emblem Manufacturing, Inc.*, the Fifth Circuit Court of Appeals enjoined an emblem manufacturer from reproducing and selling National Hockey League team insignias, even when sold with a disclaimer of official sponsorship by the NHL. The Court found trademark infringement as well as false designation of origin and unfair competition.<sup>68</sup> Yet years later, the Fifth Circuit in *Supreme Assembly, Order of Rainbow for Girls v. J.H. Ray Jewelry Co.*<sup>69</sup> refused to follow *Boston Hockey*. The Fifth Circuit accepted the trial court's distinction that consumers were not likely to be confused about sponsorship or origin because, contrary to professional sports teams, most fraternal orders exercise little control over the use of their insignia in jewelry. The Fifth Circuit followed the reasoning of an earlier case in the Ninth Circuit.<sup>70</sup> Nonetheless, the *Boston Hockey* result seems to be the general rule in the United States for sport team logos.<sup>71</sup>

The controversy has continued in a recent set of cases in Europe. The European Court of Justice appears to favor the U.S. position of prohibiting unauthorized copying of sports team logos, but the English High Court of Chancery disagreed, finding that the use of trademarked logos on sports merchandise was not trademark use and was not likely to confuse consumers as to the origins of the merchandise. Ultimately, the English Court of

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67. Robert C. Denicola, *Freedom to Copy*, 108 Yale L. J. 1661, 1667-68 (1999) (citing, Ralph S. Brown, *Advertising and the Public Interest: Legal Protection of Trade Symbols*, 57 Yale L. J. 1165 (1948)).

68. *Boston Professional Hockey Association v. Dallas Cap & Emblem Manufacturing, Inc.*, 510 F.2d 1004, 1013 (5th Cir.), cert. denied, 423 U.S. 868 (1975).

69. 676 F.2d 1079, 1081-85 (5th Cir. 1982). Thus clan crests, commonly available in jewelry, may not be protectable as trademarks although the clan tartans may be protectable. Some items include both logos.

70. *International Order of Job's Daughters v. Lindeburg*, 633 F.2d 912, 918-20 (9th Cir. 1980), cert. denied, 452 U.S. 941 (1981).

71. *Boston Hockey* has been followed in appellate decisions involving use of the University of Georgia's "Bulldog" logo on beer and the Boston Marathon logo on T-shirts. See *University of Georgia Athletic Ass'n v. Laite*, 756 F.2d 1535, 1547 (11th Cir. 1985); and *Boston Athletic Ass'n v. Sullivan*, 867 F.2d 22, 25 (1st Cir. 1989).

Appeal did follow the European Court of Justice and enjoined the unauthorized merchandise seller.<sup>72</sup>

The question remains whether the use of a clan tartan on merchandise is trademark use or not. Does the clan tartan indicate source or sponsorship to consumers? Professor Denicola notes that U.S. professional sports teams often present consumer survey evidence that most consumers believe sports logo merchandise is sponsored by the professional league or its teams.<sup>73</sup> Thus, because consumers believe that sports logo merchandise is licensed, it is protected by trademark law; in contrast, because consumers do not believe that fraternal insignia are licensed, they are not protected. The circularity of this reasoning and the inconsistent results suggest that the real question is not whether consumers believe a particular logo is licensed, but rather whether a particular use of the logo is a trademark use. Clearly, the wearing of sport team uniforms by team members indicates source or sponsorship, but it is far from clear whether the use of the team logo on T-shirts worn by fans is a trademark use indicating source or sponsorship. This might rather be called associational use of the logo by the purchaser to show support for the team. Because the clan tartan could be a collective mark showing clan membership, the case for tartan merchandise being trademark use is stronger than that of sport team logos.

For some products, such as clothes, tartan trademarks also have to overcome the presumption that they are merely an ornamental pattern rather than a symbol identifying the origin of the goods. The U.S. Trademark Trial and Appeal Board overturned a Trademark Examining Attorney's ruling that denied trademark registration for a Scottish tartan border design for sportswear. The Examining Attorney felt that the tartan border was "mere label ornamentation" whereas the Board felt the border also served as an identifying symbol of origin. The Board noted that approximately \$450 million of this design of sportswear had been sold, promoted by about \$9 million in advertising that always featured the primary trademark MCGREGOR in letters of red and green Scottish tartan.<sup>74</sup>

Burberry Department Store has long claimed international trademark rights in its distinctive plaid that it uses in the lining of raincoats. Its position was upheld by a Brussels court of appeals

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72. For a discussion of the various court opinions in this matter, see Anthony Arnall, *Arsenal Football Club plc v. Matthew Reed*, 40 Common Market L. Rev. 753 (2003).

73. Denicola, *supra* note 67, at n.37 (citing *National Football League Properties, Inc. v. Wichita Falls Sportswear*, 532 F. Supp. 651 (W.D. Wash. 1982); and *National Football League Properties, Inc. v. Dallas Cap & Emblem Mfg., Inc.*, 327 N.E.2d 247, 250 (Ill. App. 1975)).

74. *In re McGregor-Doniger Inc.*, 123 U.S.P.Q. 49 (T.T.A.B. 1959).

that held that the plaid was distinctive because of years of use, despite the use of other distinctive plaids by numerous other raincoat manufacturers.<sup>75</sup> Thus, the key is showing secondary meaning in the minds of consumers that particular tartans are associated with particular sources, such as a particular clan. Nearly 200 years of such tartan and clan associations supports the distinctiveness of clan tartans. Anyone can use a plaid pattern as the lining of a raincoat, but the Burberry plaid has developed a secondary source-identifying meaning in the minds of consumers of raincoats so it is protected as a trademark. The 75-plus years of promoting particular tartan patterns with particular clans should also establish secondary meaning for clan tartans.

#### *D. Aesthetic Functionality*

The Italian Supreme Court recently disagreed with the earlier Belgium decision supporting trademark registration for the Burberry pattern, instead holding that the tartan raincoat lining was aesthetically functional (perhaps indicating British origin) and, therefore, could not be registered under Italian law. However, the Court then also affirmed the lower courts' decisions that copying the particular Burberry tartan lining still amounted to unfair competition because of the risk of consumer confusion.<sup>76</sup> The concept of aesthetic functionality raised by the Italian Supreme Court as a bar to trademark protection in the *Burberry* decision merits some additional discussion in the context of tartan plaids.<sup>77</sup> The concept arose from the long held maxim that trademark laws must not protect the functional aspects of products.<sup>78</sup> For example, the flap or shingle over the back of a rain jacket may serve the function of repelling rain while at the same time providing some ventilation. If this is correct, the mere use of a shingle may not be protected as a trademark, although a distinctive, but non-functional, shaped shingle could be so protected.<sup>79</sup>

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75. *Sarma Penney Ltd. v. Burberry Ltd.*, decision of the Brussels Court of Appeals (3e ch bis), Feb. 19, 1985 (Belg.), reported in 5-6 *Revue de Droit Intellectuel* 158 (May-June 1985). See Stephen Bigger & Barbara L. Kagedan, *Notes From Other Nations: Benelux*, 76 TMR 80 (1986). Burberry's tartan plaid has been used since the early 1920s on clothes, according to its U.S. Trademark Registration No. 2022789, issued in 1996.

76. *Geoconf 2000 S.p.A. v. Burberry Ltd.*, Supreme Court, Decision of May 29, (1999) (unpublished, Italy). See *International Annual Review*, 90 TMR 213 (2000).

77. See generally, Mitchell M. Wong, Note, *The Aesthetic Functionality Doctrine and the Law of Trade-Dress Protection*, 83 Cornell L. Rev. 1116 (1998). See also Kozinski, *supra* note 15, at 962-63. In *Supreme Assembly*, the trial court found the fraternal insignia to be an aesthetically functional feature of the jewelry. 676 F.2d at 1083.

78. See, e.g., *TrafFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23 (2001).

79. *Stormey Clime Ltd. v. Progroup, Inc.*, 809 F.2d 971 (2d Cir. 1987).

Aesthetic functionality occurs when a particular product feature is only functional in the sense that it is attractive to product buyers. The question arises whether that product feature may be protected as a trademark. U.S. legal commentators suggest that sports team logo clothing is aesthetically functional and, therefore, should not receive trademark protection.<sup>80</sup> The Italian interpretation appears too broad and would deny trademark protection to any product aspect that is in some way aesthetically pleasing. A more limited interpretation could allow aesthetic functionality to bar trademark protection when products cannot be designed in an alternative fashion and still be sold.<sup>81</sup> The question for sports team logo clothing is whether a T-shirt that says "I Love the New York Mets" is a viable alternative design to one that simply carries the Mets team logo.

Because of the cultural context of tartan plaids dating back to antiquity (or, in fact, almost 75 years), clothing containing the name of a particular clan would probably not be a viable substitute for clothing made of the clan tartan fabric. This would appear particularly true for traditional Scottish clothing items, such as the kilt. Indeed, kilts and other accessories such as neckties, shawls, etc., are often purchased to show membership or pride in a particular clan. The clan tartan would appear to be aesthetically functional when used on a kilt or other forms of traditional Scottish clothing.

An important question arises on the issue of the burden of proving functionality. The key question is how specific must the proof on non-functionality be? If consumers and potential consumers of Scottish tartan clothing are surveyed to ask the importance of purchasing the "right" tartan, many might rate that factor as being very important. However, if asked to actually identify the clan tartan they were seeking from a selection of similar tartans, few may actually be able to do so. If few consumers of clan tartan clothing can actually recognize the clan tartan pattern they are seeking, does that mean the tartan does not serve the function of identifying the clan in the minds of the consumers?

Not only does it appear ironic to have a clan disprove the functionality of its clan tartan in order to enforce trademark rights to the tartan, but such proof also would appear to disprove that the

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80. *E.g.*, Kozinski, *supra* note 15, at 962.

81. Tariff law in the United States does not recognize aesthetic functionality for purposes of determining whether apparel is classified as ornamental. *See Ferriswheel v. U.S.*, 644 F.2d 865 (C.C.P.A. 1981) (ornamentation that is necessary to make garments authentic still requires the garments be classified as ornamented clothing; the small fringe at the bottom of a kilt and epaulets of a Scottish jacket were found to be functional, but the braid on the jacket was ornamental requiring it to be classified as such for tariff purposes).

alleged trademark itself has a secondary meaning in the minds of consumers. This defeats trademark rights entirely. This leads to the dilemma identified by Malla Pollack. She argues essentially that while trademark law should prevent others from selling clothing containing an unlicensed logo of a sports team, the law should allow consumers to purchase a replica team jersey as long as consumers understand it is not a genuine team jersey that presumably would command a higher price.<sup>82</sup> Her argument should also allow consumers to purchase replica kilts if it is clear they are not licensed by the clan.<sup>83</sup>

A more simple approach to the issue of aesthetic functionality is warranted by a clan tartan's potential status as a collective mark. Obviously, such marks are in one sense functional in that they function to indicate an association with membership in the trademark owner's organization. If this associative function is deemed to be functional, then all collective marks would be void on the grounds of functionality.<sup>84</sup>

For other forms of clothing, such as sport shirts and raincoats, whose sale is not based on "Scottishness," it seems more reasonable for Scottish clans to be able to exercise trademark rights if they can prove their tartans have a secondary source-identifying meaning in the minds of consumers.<sup>85</sup> For these products, the tartan pattern is not aesthetically functional. There are many options for aesthetically pleasing designs beside a tartan pattern, and over 600 tartan patterns are currently available, with more created each day. Plaids that are somewhat similar to clan tartans easily could be designed.

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82. See Pollack, *supra* note 15, at 1491-94.

83. Although clans lose potential trademark revenue, the weavers, who initially originated the myth of Scottish clan tartans for their own commercial benefit, appear to be protected from low price replicas by the "Made in Scotland" designation. Consumers interested in authenticity appear to have little interest in tartan clothing made in countries other than Scotland.

84. In *Porsche A.G. v. Universal Brass, Inc.*, 34 U.S.P.Q.2d 1593 (W.D. Wash. 1995), the court came to the opposite conclusion in a case involving a key chain maker that used automotive trademarks on its key chains without license to do so. It argued that *Job's Daughters* involved a collective mark to designate membership in a fraternal organization that did not produce goods rather than a source mark to identify the producer of goods and any arguably aesthetically functional use of a source mark must avoid source or sponsorship confusion.

85. In *Wal-Mart Stores, Inc. v. Samara Brothers, Inc.*, 529 U.S. 205 (2000), the Supreme Court held that product configuration trade dress, as opposed to product packaging trade dress, could never be inherently distinctive, so that secondary meaning must always be proven before non-functional design attributes would be protected by trademark law. While the question of whether Scottish clan tartans should be an exception to this general rule and considered inherently distinctive is worth debating, this decision is consistent with the analysis presented here that anyone asserting trademark rights in clan tartans should be required to prove secondary meaning.

#### IV. CONCLUSION

The Scottish clan tartan and trademark law both have evolved over time. The Highland tartan was banned in 1746 after the Jacobite rebellion, except for military use by Highland regiments in the British army. With the defeat of Napoleon, the tartan kilt was swept up in a revival of romantic interest in Highland culture, encouraged by the very monarchy that had previously suppressed the tartan. At this time, clans became associated with particular tartan patterns. Tartan patterns, instead of being worn by impoverished Highlanders, were being flouted by well-to-do Lowland Scots and Europeans generally. Today, the clan tartans are well recognized by people of Scottish heritage and others throughout the world as symbolizing particular clans.

Trademarks started out as small inconspicuous marks that identified a particular source or producer of a product. Trademark law evolved from common law deceit when others would copy well-established marks and pass off their goods as being from the well-reputed source. Today, trademarks are flouted on clothing and other goods in ways that might have been condemned by sumptuary law of an earlier age. Sports teams demand exclusive rights to their logos, while some Native American groups seek to prevent the use of their cultural symbols and icons in trademarks altogether.<sup>86</sup>

Since clan tartans were developed as a commercial device over 75 years ago to sell more tartan cloth, it would seem there is little objection to the commercialization of these symbols of Scottish culture. Indeed, this article suggests that modern Scottish clan societies should be able to register their tartans as collective trademarks and gain revenue from authorizing both clan members and manufacturers to use the tartan. Such trademark use appears consistent with the trend of case law in the treatment of sports team logo clothing. The long period of identifying particular tartan patterns with particular clans is evidence of source-identifying secondary meaning and at least for products actually made in Scotland, the tartan trademark would not be primarily geographically descriptively misdescriptive. While use of a clan tartan would appear to be aesthetically functional for traditional Scottish clothing such as kilts, the concept of aesthetically functionality is not well accepted, and this article suggests that it is inconsistent with the concept of a collective mark and should, therefore, not be applied to such marks.

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86. For a discussion of Native American symbols and trademarks, see Lury, *supra* note 46.

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