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EDITOR’S NOTE

On January 7, 2005, the International Trademark Association presented the first Learned Professors Trademark Symposium in San Francisco, CA, at the offices of Coblentz, Patch, Duffy & Bass LLP. This program was designed to provide an academic perspective on trademark issues for professors of trademark law, jurists hearing and deciding important cases dealing with trademark disputes and novel legal arguments, as well as legal practitioners specializing in trademark law who want to enhance their knowledge of international and comparative trademark law. Three of the world’s leading trademark professors—James Chao, J. Thomas McCarthy and David Vaver—presented comprehensive examinations of global and comparative leading-edge issues and concerns of trademark law and policy, from an Asian, North American and European perspective, respectively. The Trademark Reporter® is proud to publish two of these articles as presented at the Learned Professors Trademark Symposium.
I. INTRODUCTION

This paper is about shape, senses and sensation. I review recent European trends relating to trademarks featuring shape, smell, sound and colour—rights in shape and senses—and also attempts to introduce a right of publicity for celebrities—rights in sensation. The tendency in these cases is to expand protection, although in a less pronounced way than in the United States. A trend towards “the more trademark rights, the merrier” is nevertheless evident. I make some observations on the desirability of that tendency as the paper proceeds.

II. OVERVIEW

First, a few background comments about European trademark law to set the stage (by Europe is meant the countries that make up the European Union). Before 1989, the trademark law—the law of registered trademarks, unfair competition and misappropriation—of member states was national. Not only did different states have laws stated in different terms, but there were differences of ideology, purpose, legal culture and tradition. A principal object—traditionalists might say the only legitimate object—of the EU was to create a single commercial market. Goods should flow freely within the EU as if there were no national borders.

Intellectual property rights, including trademark rights, could impede that free flow. The same or a very similar trademark could be held by different owners in different states, so a product or service legitimately marked and marketed in one state could be blocked from entering another state where the trademark owner was nominally different. Trademark owners could thus create price discrimination territories by manipulating trademark law—an undesirable feature of a single market, at least according to competition authorities. Different national trademark standards might also impede the smooth functioning of a common market. So
an EU directive of 1989 required states to “approximate” their national trademark laws—essentially to standardize their laws on key features, with the occasional opt-out provision. In 1994 an EU regulation established an European registry to give trademark rights EU-wide effect. Both laws allowed parallel importing of trademarked goods within, but not into, the EU.

There are thus striking structural similarities between the EU and the American trademark system. The US federal registry and the state registries roughly mirror the European central trademark registry and the individual registries of the member states; US and state trademark law and practice roughly mirror European law and national trademark laws and practices. There are, however, important differences. One is that a single court, the European Court of Justice (“ECJ”), is the ultimate authority on the legal effect not only of the European Community trademark but also of the trademark laws of member states, and may require member states to conform with European trademark (and other) directives. The ECJ takes both ultimate appeals and references on points of European law from the national courts, and also ultimate appeals from the European trademarks office after these have passed through an intermediate court, the European Court of First Instance (“CFI”). Since European trademark law is relatively recent—the current UK Trade Marks Act replaced the pre-EU 1938 Act in 1994—the CFI and ECJ (quite apart from the internal decisions of the trademark offices and their appeal boards) have been busy producing rulings that affect both European and national trademarks laws.

Since the law on European Community trademarks is virtually the same as the trademark law that member states must individually implement, there is greater uniformity in principle among member states than may exist in US law. Differences in practice resulting from the varying national legal cultures and traditions of course continue but will decrease over time.1

III. EXPANSIONISM

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

1. Oddities remain. Thus, a trademark may without incongruity be registered nationally in one or more member states, but not in other states or not as a European Community trademark; it may be distinctive in one set of states but not another set or throughout Europe.
The typical trademarks that were traditionally protected were 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.

Over time there has been constant pressure from industry—note, not consumers—to widen the subject-matter of protection to include as a trademark 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, smell, 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 also 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 legal systems in which 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 reputation and misrepresentation is costly. Protection is *ad mercatorum*, not *in rem*: it runs against an individual wrongdoer rather than the world. Rights are co-ordinate with reputation and are thus territorially confined. Extending or transferring the rights 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 trademark registries was all 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 trademark.

When states become involved in granting that official assurance, they may legitimately ask whether the costs of administration and the costs on the economy 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.

**IV. BASIC LEGAL FRAMEWORK**

According to TRIPS, “any sign or combination of signs” may be registered as a trademark, although a condition may be imposed that the mark be “visually perceptible.”\(^2\) EU law imposes an apparently less stringent condition: to qualify for registration, a feature must be a “sign” that is “capable of being represented graphically.”\(^3\) In addition, it must:

(a) be “clear, precise, self-contained, easily accessible, intelligible, durable and objective”;\(^4\)

\(^2\) TRIPS, art. 15.1.


One assumes that this somewhat different condition is TRIPS-compliant on the principle that the greater encompasses the lesser: i.e., the condition that a mark be visually perceptible is met if all such marks are registrable, but some non-visually perceptible marks are also admitted on condition that they can be described in visually perceptible terms.

\(^4\) *Shield Mark BV v. Kist* [2004] Ch. 97 at § 55 (ECJ) (“Shield”).
(b) be distinctive, i.e., guarantee to consumers the identity of one product source from others;⁵
(c) not deprive the trade or the public of signs that the directive or regulation implies should be free to all.⁶

I now wish to examine how smells, sounds, colours and shapes—features that many legal systems find somewhat problematic—are treated in European trademark law.⁷ Rulings on registrability are of course important because, once on the register, trademarks get broad protection against confusion and dilution—often wider protection than is extended, for example, in the UK to unregistered marks at common law.⁸ In Europe all marks—whether traditional word or design marks, or some other differently perceptible feature—are examined for registrability according to the same criteria. Consumers may nevertheless view features such as smell, sound, colour and shape differently from standard marks, and this perception is key when their capacity to act as trademarks is assessed.⁹

V. SMELL AS TRADEMARK

In 1990, plumeria scent added to sewing thread was registered as a US trademark.¹⁰ 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 may be more debatable. The occasion for express judicial imprimatur has however not arisen so far. Practice within the USPTO and professional opinion is however favourable and the US Supreme Court, in adopting a broad view on the registrability of colour trademarks, supported its holding by referring with apparent approval to the practice of registering fragrances (as well as shapes and sounds).¹¹

Shortly afterwards, the smell of fresh cut grass for tennis balls was registered as a European trademark, and the odour of beer for

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⁵. Arsenal Football Club plc v. Reed, Case C-206/01 (ECJ, 12 November 2002).
⁷. See generally Stefano Sandri & Sergio Rizzo, Non-Conventional Trade Marks and Community Law (2003), which, while published before the appearance of a number of important ECJ cases on the subject, nonetheless remains a useful monograph.
⁹. Procter & Gamble v. OHIM, Joined Cases C-468/01 P to C-472/01 P (ECJ, 29 April, 2004), §36 (“Procter”).
dart flights and of roses for tyres was registered in the UK. Smell may attract or repel buyers, even of darts, tyres or tennis balls; one suspects that nobody has sought to register the smell of horse manure. The 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.

Trademark “progressives” may argue, with Cole Porter, that “In olden days a glimpse of stocking / was thought of as something shocking; / now, Heaven knows, / anything goes”—and should go. Trademark traditionalists—or “regressives” as “progressives” might call them—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 smell marks, European trademark registries eventually took the “regressive” line. The main legal sticking points were lack of distinctiveness and non-compliance with the requirement that any registrable sign had to be “capable of being represented graphically.” So making motor and heating fuel smell of raspberry did not create a trademark for the scent: consumers would just think the smell was added to mask the otherwise unappealing smell of the product.

On the issue of graphic representation, one may ask: how can the smell of “freshly cut grass” be represented accurately, let alone graphically? Does all grass smell the same? Is the smell 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”? Do we need a spectrogram produced by an electronic nose technologist to delineate it? Or a reference to the chemical compound that produces the smell? A deposit of the

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14. Trademark Directive, above, art. 2; Trademark Regulation, above, art. 4.


smelly item? More to the point, how will a rival trader who wants to apply a smell to his product know when he has produced something confusingly similar? Will the smell of “newly mown hay” or “freshly pruned trees” infringe? Will an initially neutrally smelling ball that, with use, acquires the smell 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—was sought to be registered in Germany for a wide range of services including even legal services. But the applicant also described his olfactory mark as being the smell of methyl cinnamate; he deposited a container that included the smell; and for good measure he also provided the chemical formula of the smell-producing compound.

Seised of the case, the ECJ rejected them all, individually and 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 these scores. Whether any form of description of a smell mark can satisfy these criteria is doubtful. The more complex a description becomes, the more a trademark 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 will not see this as a problem. Businesses may. How or whether consumers may benefit is unclear.

VI. SOUND AS TRADEMARK

Sound trademarks are now commonplace in the US, where MGM’s mark of “a lion roaring” has long been registered for movies. Their registrability has been judicially confirmed, although arguments may still arise over modalities of registration. Such marks are also judicially recognized in Europe, although under quite restrictive conditions. The seven-fold requirement of graphic representation as interpreted by the ECJ for smell


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 the ECJ decision in Shield Mark BV v. Kist in 2003.¹⁹ A Dutch firm held registered a set of 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 firm sued a communications consultant who used those marks to advertise seminars on intellectual property, including trademark law. The Dutch courts upheld an unfair competition complaint but dismissed the claims of trademark infringement on the basis that sound marks were not registrable.

The case was referred to the ECJ, which ruled that sound marks were registrable, but they had to conform 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 ECJ did not rule on two more obvious methods of representing a sound mark. But in respect of “Für Elise,” the court did say that sheet music in bar and stave notation with tempo, accidental, and rest marks satisfied the requirement of graphic representation. But 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” would not do either: 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 not a 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 cock crowing marks were found all to be unregistrable in the forms presented. Simply saying “cock crowing” will not do as a description because cocks 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 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

by lodging a sound recording or sonogram of a particular crowing, both apparently acceptable methods in the US. It so happens that MGM applied for a European trademark 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 ECJ Shield decision, a board of appeal ruled that sonograms were in principle acceptable but MGM’s did not fit the bill. Lions roar differently: loud or soft; long or short; high-pitched or low-pitched; and any permutation or gradation of those adjectives. 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 wonders, of course, 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 like the registered sonogram?

The ultimate question such cases pose is, of course, whether firms should be entitled to appropriate as their trademarks a sound in nature, and, equally, whether they should be entitled to reappropriate pieces of famous music when the music is out of copyright and beyond the reach of their composer’s moral rights. From the perspective of the music-loving public, to accept that a toilet manufacturer can use Mendelsohn’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 reappropriated for commercial ends. One wonders whether music will ever be or sound the same again?

VII. COLOUR AS TRADEMARK

Colour can be, or be part of, a protectable trademark: the blue, white, and gold oblong Visa trademark 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 trademark 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 trademark, 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 monopolize 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 ECJ 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.22

Of course, if a colour is trademark 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 identification code is required to notify the trade and the public of the claimed ambit of the monopoly.23

Combinations of colour usually work better as a mark than do single colours because buyers may more readily recognize combinations as trademarks and allow them to become distinctive. 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.24

This last point has not always been recognized. For example, pharmaceutical companies have sometimes persuaded courts that

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22. KWS Saat AG v. Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), Case C-447/02 P (ECJ, 21 October, 2004).
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. This reductionist view of patient psychology suggests that good health policy and intellectual property law do not necessarily coincide, especially since trademark 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. 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 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.

**VIII. SHAPE AS TRADEMARK**

Since trademarks are not substitutes for patents or industrial designs, the holder of a patent or a registered design—valid, invalid, or since expired—is not encouraged to bolster this monopoly through a trademark 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 trademarks.

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A large miscellany of products has sought to establish itself in Europe as a three-dimensional trademark: cakes, candy, watches, forklift trucks, flashlights, soap, detergent capsules, bottle shapes and other packaging.27 Again, although in theory such marks are not subjected to stricter criteria than traditional marks, in practice registration is tougher. The shoals on which they have typically foundered in Europe are a lack of distinctiveness and the presence of statutorily prohibited shape. 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.28 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 lacked distinctiveness as a trademark.29

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 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.”30 The leading case involved Remington’s imitation of the Philips trademark registration of the three-headed shape of its rotary electric shaver. The ECJ confirmed that product shapes, though not usually inherently distinctive, can become distinctive through use. In practice, however, proof that consumers recognize a shape as a trademark 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.31

A recent decision involved an unsuccessful attempt to register a three-dimensional flower shape for cheese in the UK.32 The British court rejected an argument that distinctiveness was established simply by showing that the shape was striking and unusual for cheese. For the shape to function as a trademark, the

28. Procter, above.
29. Mag Instrument v. OHIM, Case C-136/02 P (ECJ, 7 October 2004), §31.
30. Trademark Directive, above, art. 3.1(c) & (e).
average consumer had to be able to say: “By this shape I know I

Authorized persons only to use in the course of their professional duties. Not for distribution.

... Trademarks are there to distinguish, not to eat.

IX. RIGHTS IN SENSATION

I wish to turn now from shape and senses to sensation, to a

right that overlaps with trademark rights and that may be

considered almost traditional in the United States but less so

elsewhere. A celebrity’s right of publicity—a property right to

control the commercial exploitation of the celebrity’s name and

image—has long been recognized in many, but by no means all,

states in the United States, although its precise contours,

including its intersection with free market and free speech rights,

continues to provoke controversy.33

Rights of publicity in Europe are similarly a mixed bag. Just

as the United States has no federal law on the subject and state

laws vary, so in Europe no EU directive or regulation deals with

publicity rights, and national laws vary. For example, French law

is, as one might expect, pretty protective; English law much less

so; Germany and the Netherlands are somewhere in between.

Theories for protection vary from those based on passing-off (least

protective) and personality rights (more so) to full-fledged property

rights (strongly protective but little recognized as yet).34

The contrast between American and UK law is worth

discussing. A convenient vehicle is the merchandising business

built on the fame of the (apparently) late Elvis Presley. Elvis of

course continues to be big business worldwide. At the end of 2004,
his daughter and sole beneficiary sold world rights to Elvis’s name

and likeness for $100 million and took a stake in a new company to

continue to exploit his posthumous fame.35 Since entrepreneurs do

not typically pay $100-plus million for nothing, one may expect (as

is the case) that the rights to Elvis’s name and image are

recognized in enough US states and in other countries to secure an

adequate revenue stream for some time to come.

The UK is not one of those other countries. The portion of the

$100m that would have been allocated to the acquisition of UK

33. E.g., David Lange, “Recognizing the Public Domain,” 44 Law & Contemp. Problems

137 (1981); Diane Zimmerman, “Who Put the Right in Right of Publicity in a Modern Age” 9


34. Julius Pinckaers, From Privacy Toward a New Intellectual Property Right in


celebrity “rights” was likely close to zero unless the buyer was betting on an imminent change in UK law. Such a change may come, as we shall see, but when is unclear. The current UK legal position is that the new company can certainly sell memorabilia bearing Elvis’s name and likeness, but it cannot exclude other traders from doing likewise and may indeed run into marketing complications unknown in its home market.

The travails of marketing Elvis’s image in the UK can be traced through litigation that occurred in both the US and UK involving a UK entrepreneur called Sid Shaw and Elvis Enterprises (“EE”). EE is the US corporation which held Elvis trademarks and publicity rights in the US under licence or assignment from the Elvis estate, and which sold or authorized (or tried to authorize) the sale of Elvis merchandise worldwide. Shaw had since the early 1980s developed a business in Elvis memorabilia in both the UK and the US under the name “Elvisly Yours.” His goods were even once sold at the Elvis shrine in Memphis, Graceland. But unhappy differences soon arose, culminating in prolonged litigation between EE and Shaw. The upshot was an injunction forbidding Shaw from marketing Elvis memorabilia in the United States.36

Meanwhile EE applied for UK trademarks for “Elvis,” “Elvis Presley” and Elvis’s signature, only to have Shaw oppose on the basis of an earlier UK “Elvisly Yours” registration over a wide range of products. EE’s applications eventually made their way into the English Court of Appeal, where they failed miserably. EE had sold little product in the UK, and what it had sold, the court decided, did not make the words “Elvis” or “Elvis Presley” distinguish EE products from Elvis memorabilia marketed by other traders in the UK market. UK consumers buying Elvis memorabilia bought them because the Elvis insignia reminded them of their hero. Nobody thought or cared whether any products sold by Shaw came from EE in the US. The court did decide that the Elvis signature mark that EE had applied to register, being in fancy script, was potentially distinctive of a particular trader. But, in a final twist, it found the mark to be too similar to Shaw’s “Elvisly Yours” registered mark, with the result that buyers would likely be confused into believing that Elvis Enterprises’s goods were associated with Shaw.37

The court was plainly unwilling to let trademark rights flow automatically from sensation or celebrity. It thought that anybody should be able to set up a business in mementos to a famous person, dead or alive, so long as they do not suggest that the goods

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originated with or were endorsed by the celebrity—something difficult to do when the celebrity is dead. The only way the celebrity can stop such an enterprise is to enter the market first himself and turn his name into a trademark for particular products or services—not just a decoration or a sign denoting himself, but a voucher of origin or control. And he should act quickly too. Just as the European patent system favours the first to file, so too does the trademarks system. The first filer is rejected only where registration would cause consumer confusion because of existing source reputation in a third party.

In fact, many athletes and other celebrities have obtained trademark registrations for their names, likenesses and signatures over a wide range of products and services. Similarly, sports teams have registered their names, colours and insignia and have been able to protect them against unauthorized sellers of sports memorabilia, even where the seller disclaims any connection with the official products.

None of the judges in the British Elvis case seemed to regret the result they reached one jot. One put it this way: no prior authority supports a broad “free standing general right to character exploitation enjoyable exclusively by the celebrity”; nor in “addressing the critical issue of distinctiveness [should there be any] a priori assumption that only a celebrity or his successors may ever market (or license the marketing of) his own character. Monopolies should not be so readily created.”

The moral is plain enough. Marketers cannot assume that the rights they have in one jurisdiction will automatically be recognized or translated into another jurisdiction unless they undertake some active marketing there too. “Use it or lose it” holds as true for law and business as it does for evolutionary biology.

English law has not moved much beyond the position taken in the “Kojakpops” litigation in 1975. This did not involve registered trademarks or oppositions to registration, but instead an attempt to establish common law rights to fame in a television character. Universal City Studios, which produced the “Kojak” television series, licensed a British company to make and sell “Kojak” lollipops on the UK market. The licensee was however stopped from doing so by another company that had earlier adopted and

38. I ignore non-trademark possibilities. For example, the celebrity may own copyright in a photograph or even (possibly) a signature. These may be turned to account during his life or after his death and their copying may equally be prohibited or regulated under copyright laws.


40. Elvis Presley case, above, at 597 by Simon Brown LJ. Both Brown LJ and a fellow judge in the Elvis case, Walker LJ, have since been promoted to the House of Lords.
used “Kojakpops,” with no authority from Universal, on the lollipops it had sold in the UK.

The court thought that Universal might have common law rights—and thus something to license—in the word “Kojak” in respect of television series and other things closely related to films. But Universal had no rights—and thus nothing to license—in respect of remote activities such as making and selling candy, even though the “trademark” eccentricity of the eponymous proponent of the television series was his habit of masticating lollipops. Universal could not have stopped the unlicensed seller under the English common law of passing-off unless it could have shown confusion resulting from that seller’s initial sale of Kojakpops; but there was no confusion or likelihood of confusion between the products associated with Universal Studios and those associated with the first marketer of “Kojak” lollipops in UK. On the contrary, it was the first marketer, which had established a trade under the Kojakpops mark, which could stop everyone else in the UK, including the “licensed” seller from Universal, from passing-off their products as being the first trader’s. “It may very well be,” said the judge, “that in the United States of America there are rights in invented names or invented fictional characters which are not recognised in this country because, so far as the law of England is concerned, we do not recognise any copyright or other species of property in any names or words, invented or not.”

Had Telly Savalas, the actor who played Kojak, himself sued the initial candy maker, he would have been no better off. Had the candy maker used “Savalas” for the lollipop and Telly had sued over that, he would probably also have lost—at least until quite recently.

Today he would do better on the same facts if his name were well enough known in the UK. In 2003 the well-known—in Britain—Formula 1 racing driver Eddy Irvine was awarded healthy damages against a radio station that ran a rebranding campaign featuring a brochure with Irvine’s photograph on the front, digitally remastered to show Irvine holding a radio with the station’s new mark “Talksport” on it. The courts did not say that Irvine had a right to control the commercial use of his name or image. Mere “misappropriation” remains not actionable in the UK. But the courts thought that Irvine’s case went beyond that. He had a substantial goodwill in his name and image that he could protect against a false innuendo of endorsement. The radio station’s promotion had falsely traded on his celebrity by suggesting he had endorsed their new product, and had to pay for that lie.

In the United States, it took half a century from when states started to recognize that a person could object to the commercial misappropriation of his image to when a property right in celebrity was judicially recognized. A similar trajectory may occur in reluctant European states, although progress may occur quickly than it did in the US. Privacy rights in a person’s likeness are gaining strength both nationally and at the European level. The legal impetus has been article 8(1) of the European Convention on Human Rights (“ECHR”), which provides a right to respect for a person’s private and family life. The UK courts, which have long denied any common law right to privacy, have come to rely on this provision to extend to celebrities the power to control when and how the media may publish their image and report on their private lives.

The breakthrough came in 2001 in a case where Michael Douglas and Catherine Zeta-Jones had sold advance exclusive rights to photographs of their wedding ceremony, held at the Plaza Hotel in New York, to a British magazine for £1 million. This “private” affair was attended by 350 family and friends under tight security and a ban on unauthorized cameras. A paparazzo nevertheless gained entry and took some surreptitious shots. When a rival British magazine published the photographs in competition with the authorized photos, the Douglases sued, claiming their privacy had been invaded. The British courts agreed, although they shied away from creating a separate right of privacy. Instead they extended the action that protects confidential information from being used or disclosed without authority to include cases where a person—here the rival magazine—is a knowing party to a breach of confidence. The Douglases’ wedding was treated as a saleable commodity akin to a trade secret. (Some secret!) Both the paparazzo who took the shots and also the magazine which bought and exploited them, knowing the Douglases had done all they could to control the occasion’s privacy, had to pay damages for their misbehaviour. More recently, the House of Lords confirmed that a well-known model could get damages against the newspaper which published photographs of her leaving a drug rehabilitation centre.

These developments parallel those at the European level, where the European Court of Human Rights in 2004 found that


Germany had failed to vindicate the privacy rights of Princess Caroline of Monaco against newspapers that had printed paparazzi shots of her enjoying quiet moments with friends and going about her daily business in public by herself or with her children. This material did not contribute to public debate on any matter of public interest and so was not justified under the media’s right to freedom of expression.\(^\text{46}\)

These decisions do not suggest that the ECHR requires publicity rights to be recognized in member states. The ECHR has however been potent in expanding the notion of privacy for both ordinary folk and also celebrities in a way that may go beyond US notions of privacy. It now provides a context and atmosphere in which courts may think there is nothing amiss in extending standard principles of civil liability to encompass publicity rights. When we find that in most jurisdictions those whose business involves using personalities in media advertising typically obtain consent from the people or estates involved, whether the person is famous or not, we may wonder how long it will take for law and practice to coalesce.

**X. CONCLUSION**

I conclude by returning to the issue of treating shapes, smells, sounds and colours as trademarks in Europe. The European obstacles to registration can of course be overcome by amending the trademark directive and regulation. Just as patent laws allow the deposit of samples to round out the disclosure of a patent specification, so trademark laws could be amended to relax the requirement for drawings and visual depictions of the mark. Samples of smells or colours could be deposited (and perhaps periodically refreshed as they degraded), and might suffice as a substitute for or complement to the writing requirements.

The question is whether the social gains from relaxing registration requirements are offset by the losses in leaving such features for regulation merely by default bodies of law such as passing-off and unfair competition. Put another way: is there a dearth or shortage of shape and sensation trademarks that needs encouragement to be overcome?

An emphasis on visually perceptible trademarks can of course unfairly discriminate among classes of consumer. A visual mark does not work for the blind or visually impaired. So we may wish to encourage registration of some aural, tactile or olfactory indicia that specifically target people with sensory impairments, to help

ensure equal treatment of potential consumers. That goal would not require registration of all sound and smell marks. It is noteworthy that none of the European cases involving unconventional marks targeted the sensorily impaired. Any benefit to them from registration would have been merely serendipitous. Beyond that, what benefit may accrue to ordinary consumers of an expansion in the universe of registrable trademarks seems elusive.

One might say the same of the expansion in rights in sensation. Yet here a different dynamic may operate. We may ask why the advertising industry should be free to use a person’s attributes as it wishes, without consent. Whether the right should extend beyond death is another matter. The death of Diana, Princess of Wales, gave rise to an unseemly tug of war between her estate, which wishes to control her image in perpetuity and to derive revenue to further her causes, and other marketers who simply wish to sell Diana memorabilia. The issue may simply boil down to one of labelling. “Officially sanctioned” Diana memorabilia could be so labelled, and the public which wishes to support the estate’s causes can do so. The estate could obtain a trademark indicating official sanction. Those who care simply for any product bearing her image can choose to buy untrademarked unofficial memorabilia. That solution is not the one that prevails in many states of the United States, but may work an acceptable compromise for other states, including those of Europe.
