

Scholarly Commons @ UNLV Boyd Law

Scholarly Works

Faculty Scholarship

2008

Identical Cousins? On the Road with Dilution and the Right of Publicity

Mary LaFrance

University of Nevada, Las Vegas – William S. Boyd School of Law

Follow this and additional works at: <https://scholars.law.unlv.edu/facpub>



Part of the [Intellectual Property Law Commons](#), and the [International Law Commons](#)

Recommended Citation

LaFrance, Mary, "Identical Cousins? On the Road with Dilution and the Right of Publicity" (2008). *Scholarly Works*. 429.

<https://scholars.law.unlv.edu/facpub/429>

This Article is brought to you by the Scholarly Commons @ UNLV Boyd Law, an institutional repository administered by the Wiener-Rogers Law Library at the William S. Boyd School of Law. For more information, please contact youngwoo.ban@unlv.edu.

IDENTICAL COUSINS?: ON THE ROAD WITH DILUTION AND THE RIGHT OF PUBLICITY

Mary LaFrance[†] & Gail H. Cline^{††}

Abstract

The dilution doctrine and the right of publicity have a great deal in common, because both represent property-like rights that have evolved from legal doctrines largely unrelated to property concerns. Although both doctrines have engendered controversy in the United States, the dilution doctrine generally evokes greater skepticism and confusion. This Article evaluates how these concepts are viewed in a number of jurisdictions outside the United States. From this examination, two conclusions emerge. First, despite the similarities between the doctrines, countries do not tend to adopt or reject them in tandem. Second, the degree to which each doctrine achieves widespread and well-understood acceptance in a particular country depends on whether and to what extent that doctrine has evolved from the nation's own legal and cultural traditions. When a country adopts either of these doctrines largely as a result of international pressures or legislative mandates that have little foundation in domestic traditions, judicial confusion and/or resistance are common results.

[†] William S. Boyd Professor of Law, William S. Boyd School of Law, University of Nevada, Las Vegas. The authors would like to thank Professor Eric Goldman and the participants in the conference on *Trademark Dilution: Theoretical and Empirical Inquiries* at the Santa Clara University School of Law, where an earlier version of this paper was presented.

^{††} J.D. 2004, William S. Boyd School of Law, University of Nevada, Las Vegas; Office of the Senior Counsel, Sunbelt Communications. The views expressed in this article are solely those of the authors.

I. INTRODUCTION

In the United States, the dilution doctrine and the right of publicity have a great deal in common – not in their origins, but in their current application. Yet the dilution doctrine currently engenders more skepticism and confusion than publicity rights. This Article inquires how these parallel concepts are faring outside the United States. From examining the status of these doctrines in Japan, continental Europe, the United Kingdom, Canada, and Australia, two conclusions emerge. First, the similarities between the doctrines do not lead countries to adopt or reject them in tandem. Second, the stable and successful establishment of each doctrine in any given country depends on whether that doctrine has emerged as a natural evolution from the nation's legal and cultural traditions. Incoherent and inconsistent judicial interpretations tend to result when either doctrine is introduced by other mechanisms, such as global harmonization pressures or a legislative process that fails to include sufficient efforts to assess the benefits and burdens of the proposed legislation.

II. IDENTICAL COUSINS AT HOME

In the United States and a number of other countries, trademark dilution laws have evolved as a relatively recent departure from traditional unfair competition and trademark doctrines that are based on a likelihood of consumer deception or confusion.¹ Over a somewhat longer period of time, right of publicity laws have evolved from traditional privacy concepts.² Each doctrine has, to some extent, left its historical roots behind. The theory of dilution, where recognized, is now completely divorced from concerns about consumer confusion or deception (i.e., about the origin or endorsement of goods or services).³ The right of publicity is now, in an increasing number of countries, recognized as a property interest that is separate from the traditional concept of privacy as a right of personality designed to protect personal feelings and dignity.⁴

1. 3 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 24:67 (4th ed., 2007).

2. Stacey L. Dogan & Mark A. Lemley, *What the Right of Publicity Can Learn from Trademark Law*, 58 Stan. L. Rev. 1161, 1167-71 (2007); HUW BEVERLY-SMITH, ANSGAR OHLY & AGNES LUCAS-SCHLOETTER, *PRIVACY, PROPERTY AND PERSONALITY* 64-68 (2005).

3. MCCARTHY, *supra* note 1, at § 24:69.

4. As used in this article, "dilution" refers to protection of marks against unauthorized uses without regard to whether the unauthorized use is likely to cause consumers to be confused

In countries where these transitions have been most complete, this parallel evolution has led to the recognition of two new intangible property rights. Under dilution law, trademarks are treated as a form of property rather than simply as a signaling device that enables consumers to distinguish one vendor from another.⁵ Where the right of publicity is fully developed, the commercial use of a person's identity is now treated more as a conversion of property than as an injury to the person.⁶ Although their origins are quite different, the dilution and publicity doctrines have seemingly converged, leading some to suggest that dilution law is "a right of publicity for corporations."⁷

Thus, while dilution and the right of publicity have disparate origins, the rights have substantively converged. In either case, the infringer is accused of using the plaintiff's valuable property right to enhance the consumer appeal of the defendant's goods or services by capturing the emotional responses that are aroused by the plaintiff's intangible property, but without confusing the consumer about the origin or sponsorship of the defendant's goods or services. The claimant of the property right, on the other hand, asserts ownership of the favorable associations connected to the claimant's identity – whether that identity is brand identity or the identity of an individual person.

The parallels between dilution and the right of publicity are also seen in the criticisms to which they are subject. Most notably, both concepts are in tension with free expression.⁸ Both doctrines have also been criticized for placing excessive burdens on competition.⁹ In

with regard to either (1) the origin of the defendant's goods or services or (2) the relationship between those goods and services and the senior user. "Right of publicity" refers to the protection of a person's name or likeness against unauthorized commercial uses, regardless of whether that right is property-based or personality-based.

5. MCCARTHY, *supra* note 1, at § 24:70.

6. 1 J. THOMAS MCCARTHY, THE RIGHTS OF PUBLICITY AND PRIVACY § 1:7 (2d ed., 2007).

7. Clarisa Long, *Dilution*, 106 COLUM. L. REV. 1029, 1061 (2006). Alternatively, one could characterize the right of publicity as dilution law for people. *Cf.* Dogan & Lemley, *supra* note 2, at 1198-1200 (suggesting that the standards of dilution law could be applied to limit the scope the right of publicity).

8. *See, e.g.,* L.L. Bean, Inc. v. Drake Publishers, Inc., 811 F.2d 26 (1st Cir. 1987) (holding that applying Maine's dilution statute to parody of plaintiff's clothing catalog violated First Amendment); *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562 (1977) (holding that television news broadcast of plaintiff's "human cannonball" performance violated his right of publicity).

9. *See, e.g.,* *Carson v. Here's Johnny Portable Toilets, Inc.*, 698 F.2d 831, 841-45 (6th Cir. 1983) (Kennedy, J., dissenting) (arguing that too liberal an application of the right of

addition, courts and lawmakers continuously wrestle with defining the scope and nature of the rights encompassed by dilution and right of publicity claims. For example, in the case of dilution, there is continuing uncertainty as to: which marks should be protected,¹⁰ the degree of similarity necessary to support a dilution claim,¹¹ the nature of the injury arising from dilution,¹² and how that injury may be proved.¹³ With respect to the right of publicity, perennial issues include: which aspects of identity are protected,¹⁴ whether the right is transferable and/or descendible,¹⁵ and the degree of similarity necessary to establish that a specific person's identity has been evoked.¹⁶

While the right of publicity seems to be steadily expanding in most states, a recent article by Professor Clarisa Long documents a decline in the success of dilution claims brought in the United States under the Federal Trademark Dilution Act (FTDA) since 1998, and suggests that this trend may reflect a judicial resistance to the concept

publicity inhibits free enterprise); Robert N. Klieger, *Trademark Dilution: The Whittling Away of the Rational Basis for Trademark Protection*, 58 U. PITT. L. REV. 789, 795 (1997) (arguing that dilution laws "pose an anticompetitive threat to market efficiency and consumer welfare").

10. See, e.g., Robert G. Bone, *A Skeptical View of the Trademark Dilution Revision Act*, 11 INTEL. PROP. L. BULL. 187, 196-98 (2007) (criticizing the Trademark Dilution Revision Act of 2006 for extending federal dilution protection to descriptive marks and broadening its application to trade dress in contravention of case law taking a more restrictive approach); Caroline Chicoine & Jennifer Visintine, *The Role of State Trademark Dilution Statutes in Light of the Trademark Dilution Revision Act of 2006*, 96 TRADEMARK REP. 1155, 1166-71 (2006) (noting different standards for fame and distinctiveness under federal and state dilution laws).

11. See, e.g., Chicoine & Visintine, *supra* note 10, at 1172-73 (noting difficulty of articulating a uniform rule regarding degree of similarity required).

12. See, e.g., Rebecca Tushnet, *Gone in 60 Milliseconds: Trademark Law and Cognitive Science*, 86 TEX. L. REV. 507 (2008) (analyzing claims that dilution increases consumer search costs).

13. See, e.g., *Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC*, 464 F. Supp. 2d 495, 504-05 (E.D. Va. 2006), *aff'd on other grounds*, 507 F.3d 252 (4th Cir. 2007) (acknowledging that the case was governed by the 2006 TDRA, which suggests specific factors for assessing "likelihood of dilution," but instead applying case law addressing likelihood of dilution under the New York state statute).

14. See, e.g., *Tin Pan Apple, Inc. v. Miller Brewing Co.*, 737 F. Supp. 826 (S.D.N.Y. 1990) (declining to extend right of publicity to soundalikes, despite California case law to the contrary).

15. California has just retroactively extended its postmortem rights of publicity to celebrities who died before 1985, responding to pressure after courts in New York and California held that Marilyn Monroe's heirs had no enforceable right. CAL. CIV. CODE § 3344.1 (West Supp. 2008).

16. *White v. Samsung Elecs. Am., Inc.*, 989 F.2d 1512 (9th Cir. 1993) (Kozinski, J., dissenting from denial of rehearing en banc) (arguing that game show celebrity's right of publicity should not extend to a humorous ad depicting a robot wearing a similar wig and evening gown and appearing on a set resembling the game show set).

of dilution.¹⁷ In her view, possible causes for the courts' disquietude include the elusive nature of the harm, the possible social benefits of dilution, reluctance to apply dilution to nontraditional origin indicators such as product design, uncertainty as to which marks are famous and distinctive enough to warrant this extra degree of protection, and concern over a possible conflict between dilution law and exhaustion of rights.¹⁸ She describes this judicial attempt to limit the impact of dilution law as a "bottom-up phenomenon."¹⁹ Even before the FTDA, state dilution laws experienced a mixed reception from judges who were reluctant to abandon confusion-based infringement doctrine and uncertain how to limit the scope of trademark protection once the likelihood of confusion was no longer available as a limiting factor.²⁰ If the judiciary's uneven handling of state dilution laws and the FTDA was a "bottom-up" reaction, then the Trademark Dilution Revision Act of 2006 (TDRA) was a "top-down" response.²¹ It remains to be seen, however, whether the judiciary will display a greater comfort level with the TDRA than with its state and federal predecessors.

III. LESS-THAN-IDENTICAL ABROAD

In recent years, both the dilution and right of publicity doctrines have received increasing recognition outside the United States. However, no multinational agreements require countries to incorporate the dilution doctrine into their national trademark laws.²²

17. Long, *supra* note 7, at 1032.

18. *Id.* at 1062-75.

19. *Id.* at 1075.

20. See, e.g., *Mead Data Cent., Inc. v. Toyota Motor Sales, Inc.*, 875 F.2d 1026 (2d Cir. 1989) (rejecting a dilution claim using an analysis more suitable to determining a likelihood of confusion).

21. Among other changes, the TDRA made the federal dilution statute expressly applicable to both blurring and tarnishment claims, introduced a set of factors for courts to consider in assessing a likelihood of dilution by blurring, clarified that dilution protection is not limited to inherently distinctive marks, and overturned the Supreme Court's decision in *Moseley v. V Secret Catalogue, Inc.*, 537 U.S. 418 (2003), by specifying that a plaintiff is required to prove only a likelihood that the defendant's conduct will dilute its mark, not that dilution has already occurred. See 15 U.S.C.A. § 1125(c) (West Supp. 2007).

22. Recently, the United States has included mandatory dilution protection in several of its bilateral Free Trade Agreements. See *infra* note 190 and accompanying text. In the European Union, Article 4(3) of the 1988 Trade Mark Harmonization Directive mandates dilution protection for Community Trademarks, but there is no comparable requirement for national trademarks. First Council Directive 89/104, 1989 O.J. (L 40) 1. See *infra* note 87 and accompanying text. While Article 16(3) of the WTO Agreement's TRIPS provisions applies to the use of a similar mark on dissimilar goods or services, members are required to prohibit such use only where the use "would indicate a connection between those goods or services and the

Likewise, the right of publicity is not addressed in any international agreements.²³ As a result, the lack of consensus in the United States with respect to these doctrines is not only mirrored, but surpassed, by the lack of uniformity abroad.

Due to the conceptual parallels between the two doctrines and their nearly parallel evolution in the United States, it seems appropriate to inquire whether a similar pattern of development is emerging overseas. One might expect that countries recognizing a strong right of publicity would be favorably inclined toward recognition of the dilution doctrine, and that, conversely, countries skeptical of one doctrine might view the other with similar caution.

As discussed in Part IV, however, preliminary research suggests that no such simple pattern can be detected, and that the two doctrines do not emerge in tandem. The reason appears to be that their legal and cultural foundations are too different. Traditional trademark and unfair competition laws that are based on preventing consumer deception are nearly universal, and are well understood at a visceral level without regard to cultural differences. Dispensing with the requirement of a likelihood of confusion in the case of famous marks – as the United States has done – is a significant departure from that tradition, and countries differ in their willingness to embrace this change and in their perception of the benefits of this policy weighed against the burdens on competition and free expression.

Although widely recognized, the right of privacy – the foundation of the right of publicity – is not universal. Countries with strong traditions of protecting privacy rights generally extend those rights to a person's name and likeness.²⁴ In many cases, these countries are gradually transitioning from a personality-based right to one that has aspects of a property right.²⁵ Countries which lack a strong tradition of general privacy rights have no basis for recognizing the right to a person's name and likeness either as a right of personality or as a property right. In these countries, unauthorized

owner of the registered trademark mark." Agreement on Trade-Related Aspects of Intellectual Property Rights, Annex 1C, art. 16(3), Apr. 15, 1994, Marrakesh Agreement Establishing the World Trade Organization, 1869 U.N.T.S. 299, 33 I.L.M. 1197 (1994) [hereinafter TRIPS Agreement].

23. The right of privacy, in general terms, is mandated for countries adhering to the European Convention for the Protection of Human Rights and Fundamental Freedoms. See European Convention for the Protection of Human Rights and Fundamental Freedoms, Apr. 11, 1950, art. 8(1), Council of Europe T.S. No. 5, available at <http://conventions.coe.int/Treaty/en/Treaties/html/005.htm>.

24. See notes 76-84, 100-108, 171-189, and accompanying text.

25. See notes 100-108 and accompanying text.

commercialization of a person's identity is actionable only where other legal doctrines can be invoked (such as passing off or defamation).²⁶

Another observation that emerges from this legal road-trip with dilution and the right of publicity is that their acceptance depends a great deal on the *process* by which those rights came to be established. Where the rights have emerged gradually and are based on domestic policies rooted in shared cultural understandings, the rights are strongly protected. Where the rights have been imposed suddenly and without significant domestic policy debate (for example, where the doctrines have been adopted in response to international pressures), the rights are viewed with skepticism and receive a less-than-coherent reception from the judiciary.

Globally, dilution protection is not mandated by any multinational agreements, except for Article 4(3) of the European Union's 1988 Trade Mark Harmonization Directive. Article 4(3) requires European Union members to provide dilution protection to registered Community Trademarks, although it does not require similar protection for national trademarks.²⁷ Prior to 1988, dilution laws were already well-established in the Benelux countries and in Germany, where they are said to have originated.²⁸ All of the pre-2004 members of the European Union have amended their trademark laws to incorporate dilution protection for their nationally registered trademarks pursuant to voluntary provisions contained in the Directive.²⁹

Although Article 16(3) of the Agreement on Trade Related Aspects of Intellectual Property Rights (TRIPS) of the World Trade Organization (WTO) Agreement requires members to protect "well-known" trademarks,³⁰ it does not mandate dilution protection. In 1999, the Assembly of the Paris Union for the Protection of Industrial Property and the General Assembly of the World Intellectual Property Organization (WIPO) recommended adoption of dilution laws to protect well-known marks in their Joint Recommendation Concerning Provisions on the Protection of Well-Known Marks.³¹ Unlike Article

26. See notes 135-156, 207-213 and accompanying text.

27. See *infra* notes 87-88 and accompanying text.

28. See *infra* notes 92-97 and accompanying text.

29. J. Thomas McCarthy, *Dilution of a Trademark: European and United States Law Compared*, 94 TRADEMARK REP. 1163, 1163 (2004).

30. TRIPS Agreement, *supra* note 22.

31. Article 4(1) of the Joint Recommendation recommend protecting well-known marks against the use of any similar mark that "is likely to impair or dilute in an unfair manner" or that

16(3) of TRIPS, this recommendation has no binding effect. Despite the absence of any international mandates, dilution laws have been adopted by a number of countries outside of the European Union, including Mexico,³² Peru,³³ South Africa,³⁴ Canada³⁵ and Japan.³⁶ Of these countries, only Canada had a dilution law on its books prior to 1993.³⁷ Several recent free trade agreements negotiated by the United States include mandatory dilution provisions.³⁸

Like dilution laws, protection for the right of publicity is not mandated by any multinational agreements. Unlike dilution, however, the right of publicity has not been addressed in any of the free trade agreements negotiated by the United States, most likely because the impact of such infringements on the United States economy has not been quantified. Even the broader concept of privacy protection is not addressed in international agreements, except for the European Convention for the Protection of Human Rights and Fundamental Freedoms (ECHR). The ECHR addresses privacy only in general terms which do not seem to mandate protection for a person's right to prevent the unauthorized use of his or her likeness.³⁹ Despite the absence of international mandates, however, many countries provide strong and well-established protection for names and likenesses, often without any explicit legislation on the subject.⁴⁰

"would take unfair advantage of the distinctive character of the well-known mark." WORLD INTELLECTUAL PROP. ORG., JOINT RECOMMENDATION CONCERNING PROVISIONS ON THE PROTECTION OF WELL-KNOWN MARKS art. 4(1)(b)(ii)-(iii) (1999), http://www.wipo.int/about-ip/en/development_iplaw/pdf/pub833.pdf.

32. Ley de la Propiedad Industrial, Art. 90 (XV) (2005). See John M. Murphy, *The Confusing Similarity Standard in Mexican Trademark Law*, 96 TRADEMARK REP. 1182, 1209 (2006).

33. Legislative Decree 823; Decision 486. See also INT'L TRADEMARK ASS'N, THE PROTECTION OF WELL-KNOWN MARKS IN ASIA-PACIFIC, LATIN AMERICA AND AFRICA 19-20 (Oct. 2004), available at <http://www.inta.org/membersonly/downloads/ref.Asian.pdf> [hereinafter PROTECTION OF WELL-KNOWN MARKS].

34. PROTECTION OF WELL-KNOWN MARKS, *supra* note 33, at 21-23; South Africa Trademarks Act, Arts. 10(17), 34(1)(c).

35. See *infra* notes 158-170 and accompanying text.

36. See *infra* notes 41-75 and accompanying text.

37. See *infra* note 158 and accompanying text.

38. See *infra* note 190 and accompanying text.

39. "Everyone has the right to respect for his private and family life, his home, and his correspondence." European Convention for the Protection of Human Rights and Fundamental Freedoms, *supra* note 23 at art. 8(1).

40. See *infra* notes 100-108 and accompanying text.

IV. COUSINS ON THE ROAD

International comparisons with respect to dilution and the right of publicity are difficult due to the wide range of interpretations and the absence, in many cases, of significant case law. Only a few countries have clearly established their positions with respect to both doctrines. Australia and the United States, for example, are at opposite positions on the spectrum with respect to both doctrines, with Australia resisting both. Canada, Japan, and the United Kingdom are struggling to understand their own dilution laws, while only one of the three – the United Kingdom – has yet to embrace publicity laws.

A. Japan

As discussed below, legislative adoption of dilution laws in Japan has led to confused and less-than-coherent responses from the judiciary. In contrast, protection for the right of publicity is well-established, having arisen not through top-down legislation but as an outgrowth of general tort law. Moreover, the right of publicity is recognized as both a moral right and an economic right.

1. Dilution

Unlike many other civil law countries (notably the EU countries), Japan has adopted dilution-type legislation that protects both registered and unregistered marks. Article 4-1(19) of the registration provisions in Japan's Trademark Act bars registration of a mark that is similar to another person's well-known mark if it is used for "the purpose of gaining unfair profits, the purpose of causing damage to the other person, or any other unfair purposes."⁴¹

This language was added to Article 4-1 in 1996⁴² in response to "the increased demand for clarification of the protection of well-known and famous trademarks,"⁴³ in an attempt to "prevent the use of trademarks that are widely known in Japan or other countries with unfair intent."⁴⁴ The statutory language implies that the prohibition applies only when the applicant has unfair *intent*. The intent

41. SHŌHYŌ-HŌ [TRADEMARK ACT], Law No. 127 of 1959, art. 4-1(xix) (amended 2005), *translation available at* <http://www.cas.go.jp/jp/seisaku/hourei/data/TA.pdf> (unofficial translation provided by Japan's Cabinet Secretariat).

42. JAPAN PATENT OFFICE, TRADEMARK EXAMINATION MANUAL § 42.25(1) (2001), *available at* http://www.jpo.go.jp/quick_e/index_sh.htm.

43. *Id.*

44. *Id.*

requirement is consistent with pre-1996 case law in which Japanese courts resorted to concepts such as plagiarism and trademark abuse to deny the benefits of registration to parties that deliberately imitated famous marks.⁴⁵

The Trademark Examination Manual of the Japan Patent Office (JPO) leaves little doubt that this bar to registration reflects dilution principles:

Well-known and famous trademarks, which have become widely known and have gained a high reputation, credit and popularity among consumers as a result of the company's long, hard efforts and a considerable amount of advertising costs, can be considered to possess sufficient capability to attract consumers and to have worthy property values themselves.

The use of such well-known and famous trademarks by a third party may not necessarily cause confusion over the source of goods etc., but it may weaken the source-indicating function or harm the reputation of these well-known and famous trademarks. Therefore, it is necessary to sufficiently protect these trademarks from illicit use, bearing in mind such purposes.⁴⁶

The Trademark Examination Manual thus interprets Article 4-1(19) as incorporating both blurring and tarnishment concepts. Article 4-1(19) is designed to preclude registration of a trademark identical or similar to one that is "famous nationwide" because, even though the second registration "may not necessarily cause confusion of the source of goods, etc.," it "may weaken the source-indicating function or harm the reputation of the said famous trademark."⁴⁷ The Manual also confirms that the bar to registration applies only where the applicant has "unfair intent," and not where the similarity of the marks arises "by chance."⁴⁸ However, where the marks are very similar and the well-known mark is unusual (e.g., a coined word) the JPO trademark examiner is permitted to presume the existence of unfair intent.⁴⁹

Similarly, the JPO's Trademark Examination Guidelines provide that Article 4-1(19) bar registration of:

45. See Masaya Suzuki, *The Trademark Registration System in Japan: A Firsthand Review and Exposition*, 5 MARQ. INTELL. PROP. L. REV. 133, 169-70 (2001).

46. JAPAN PATENT OFFICE, TRADEMARK EXAMINATION MANUAL, *supra* note 42.

47. *Id.*

48. *Id.* § 42.25(2).

49. JAPAN PATENT OFFICE, EXAMINATION GUIDELINES FOR TRADEMARKS ch. III, pt. 17, § 5 (2007), available at http://www.jpo.go.jp/quick_e/index_sh.htm.

A trademark identical with or similar to a trademark well known throughout Japan, for which an application has been filed with *an intention to dilute* the distinctiveness of the well-known trademark to indicate the source of goods or impair the reputation, etc. of the trademark owner, however the trademark of that application per se is not liable to cause confusion over the source of the goods.⁵⁰

Accordingly, registration of a trademark is barred only if the dilution or impairment of reputation is intentional.

The Guidelines also note that, in determining whether a mark is used for “unfair purposes,” the examiner should consider “[m]aterials showing that a trademark, if used by its applicant, is liable to impair credit, reputation, consumers-attractiveness built up in a well-known trademark.”⁵¹ This language suggests that the examiner should be concerned only with trademark uses that have a tarnishing effect, rather than uses which merely undermine the distinctiveness of the well-known mark or which “free-ride” on the notoriety and favorable associations of the mark. In contrast, the Manual suggests that both blurring and tarnishment are grounds for refusing registration.⁵² Despite their differences, both the Manual and the Guidelines clearly interpret Article 4-1(19) as precluding registration only where the applicant has some kind of predatory intent. Finally, while neither the Manual nor the Guidelines suggest that registration should be denied based on free riding alone without proof of a tarnishing or a blurring effect, the statutory reference to “gaining unfair profits”⁵³ appears to support this additional ground for denial.

Article 2-1 of Japan’s 1993 Unfair Competition Prevention Act provides a cause of action for the trademark owner against:

(1) acts of creating confusion with another person’s goods or business by using an indication of goods or business (which means a name, trade name, trademark, mark, or container or package of goods used in relation to a person’s business, or any other indication of a person’s goods or business; the same shall apply hereinafter) that is identical or similar to said person’s indication of

50. *Id.* § 1(b) (emphasis added). Although “well known” is not defined in this context, the section of the Guidelines that addresses defensive registrations indicates that “well known” means “famous.” *See id.* ch. XIII, § 1. With respect to Art. 4-1(19) of the registration statutes, the JPO’s Trademark Examination Manual equates “trademarks widely recognized by consumers” with “famous” trademarks. *See* TRADEMARK EXAMINATION MANUAL, *supra* note 42, § 42.14.

51. EXAMINATION GUIDELINES FOR TRADEMARKS, *supra* note 49, § 4(f).

52. *See supra* notes 46-47 and accompanying text.

53. *See supra* note 41 and accompanying text.

goods or business that is well known among consumers or other purchasers . . . ;

(2) acts of using as one's own an indication of goods or business that is identical or similar to another person's famous indication of goods or business. . . .⁵⁴

When these two subsections of Article 2-1 are compared, it seems clear that subsection (2) is the only one that could be characterized as a dilution provision, because it makes no reference to a likelihood of confusion. It also differs from subsection (1) in that it refers to "famous," as opposed to merely "well known" marks, although it is not altogether clear how Japanese courts are to distinguish between these categories.⁵⁵

In Professor Port's recent study of Japanese dilution law, he notes that the legislative history of the 1993 unfair competition amendments specifically indicates that they were intended to prevent "free riding."⁵⁶ This same passage in the legislative history however, goes on to suggest that, as a result of free riding, "consumers might become confused that this newcomer is the same as the company that endeavored to obtain high trust and repute."⁵⁷ It is not clear whether this means that consumers will believe that the goods or services are from the same company, or merely that they are the same in their characteristics and quality. Additionally, in spite of referencing confusion, the report elsewhere states that a dilution claim should not depend on consumer confusion.⁵⁸

The creation of a dilution cause of action in Japan was not a pure "top down" phenomenon. Prior the 1993 amendments, Japanese

54. FUSEI KYŌSŌ BŌSHI-HŌ [UNFAIR COMPETITION PREVENTION ACT], Law No. 47 of 1993, art. 2-1, *translation available at* <http://www.cas.go.jp/jp/seisaku/hourei/data/ucpa.pdf> (unofficial translation provided by Japan's Cabinet Secretariat). For an alternate translation, see Kenneth L. Port, *Trademark Dilution in Japan*, 4 NW. J. TECH. & INTELL. PROP. 228, 229 (2006).

55. As noted earlier, *supra* note 50, the Trademark Examination Guidelines appear to treat well-known marks as synonymous with famous marks, although this interpretation of the trademark registration statutes by the Japan Patent Office would not necessarily carry over to the Unfair Competition statutes, nor would it appear to be binding on Japanese courts. In *Advance Magazine Publishers, Inc. v. Puropasuto*, 1890 HANREI JIHO 127 (Tokyo D. Ct., July 2, 2004), a case discussed by Professor Port, the Tokyo District Court treated the name of a magazine as well known but not famous where it was well known to readers of fashion magazines but not to the general public. See Port, *supra* note 54, at 246.

56. Port, *supra* note 54, at 233 (citing SANGYO KOZO SHINGIKAI CHITEKI ZAISAN SEISAKU BUKAI HOKOKUSHO [REPORT OF THE INTELLECTUAL PROPERTY POLICY COMMITTEE OF THE INDUSTRIAL STRUCTURE COUNCIL] (1992)) [hereinafter IPPC REPORT].

57. *Id.*

58. See *id.*

courts often, in the case of identical marks, presumed confusion even where confusion was unlikely, in an effort to protect marks from free riding.⁵⁹ This practice suggests that, even before the dilution provisions were enacted, such free-riding was inconsistent with the Japanese judiciary's fundamental sense of commercial morality. Nonetheless, as discussed below, the judiciary's interpretation of the 1993 amendments suggests that the courts are confused about the difference between dilution and traditional confusion-based doctrines.

Despite the Japanese courts' past willingness to find confusion even where it is unlikely, Professor Port has noted that very few dilution-type claims have been brought under the unfair competition statute.⁶⁰ Of the cases he reports, one involving product design trade dress is analyzed under Article 2-1(1) – the confusion provision – rather than Article 2-1(2).⁶¹ The Tokyo High Court rejected the dilution claim, reasoning that if there had been dilution then the plaintiff's product design would have ceased to be famous and would have lost its ability to function as an origin indicator.⁶² By requiring proof of actual blurring, this reasoning overlooked the “free rider” aspect of dilution which, it appears, Article 2-1(2) was intended to encompass. This supports one of the hypotheses posed by Professor Long in her study of FTDA cases – that judges are reluctant to extend dilution protection to unconventional marks such as product design.⁶³

A second case under Japan's unfair competition statute involved an entertainer who adopted a stage name very similar to a company's well-known mark.⁶⁴ The Tokyo District Court analyzed the claim under Article 2-1(1), finding that the defendant's name caused confusion.⁶⁵ This time, Professor Port notes, the court condemned the defendant's action as free-riding, thus using a dilution concept to justify a finding of confusion.⁶⁶

Professor Port also reports a Tokyo District Court decision holding that the name VOGUE for a fashion magazine was well-known but not famous, and therefore was not eligible for dilution

59. *Id.*

60. Port, *supra* note 54, at 247.

61. Port, *supra* note 54, at 238-39 (citing *Negurosu Denko KK v. Matsushita Denko KK*, 1819 HANREI JIHŌ 121 (Tokyo Koto Saibansho, May 31, 2002)).

62. *Id.* at 239.

63. Long, *supra* note 7, at 1069-70.

64. Port, *supra* note 54, at 240-41 (citing *Tokyo Kyuko Dentetsu KK v. Takachi Noboru*, 1639 HANREI JIHŌ 115 (Toyo D. Ct., Mar. 13, 1998)).

65. *Id.* at 240.

66. *Id.*

protection under Article 2-1(2).⁶⁷ Nonetheless, with no explanation, the court held that the use of a similar name for a condominium was actionable under Article 2-1(1) on the grounds of confusion.⁶⁸ Yet confusion between the name of a magazine and the name of a condominium seems very unlikely.

In reflecting on these rulings, Professor Port suggests that “Japanese judges have an inherent distrust of the notion of dilution,” and that, despite or perhaps because of the apparently broad mandate of Article 2-1(2), “Japanese judges seem reluctant to apply the language as written and, instead, seek other options to attempt to confine the expansion of the trademark right.”⁶⁹ Professor Port concludes that “the confused status of Japanese trademark dilution law indicates a judiciary at odds with the legislature,” and that the courts are attempting “to rein in a right the judiciary sees as inconsistent with the purposes of trademark protection in Japan.”⁷⁰ If Professor Port is correct, then it appears that the Japanese judiciary is engaging in the same kind of bottom-up attempt to rein in dilution laws that Professor Long has observed in the United States courts.

The judiciary’s discomfort with Article 2-1(2) is somewhat surprising since, prior to 1993, the Japanese courts were willing to find confusion even where true confusion was unlikely.⁷¹ The courts protected trademarks from free riding by employing the concept of “confusion in the broad sense.”⁷² Apparently the Japanese courts were willing, on their own initiative, to extend their traditional legal and ethical concepts (confusion and fairness) to protect trademarks against uses which violated the courts’ innate sense of business morality. But the legislative importation of a foreign legal concept designed to remedy those same perceived abuses has been less successful. Ironically, the legislative history of Article 2-1(2) indicates that, as of 1992, the Japanese courts had begun to have second thoughts about their practice of presuming confusion in order to provide a remedy against free riding.⁷³ This may offer a partial explanation of the courts’ difficulty in enforcing the new regime. If judicial attitudes

67. Port, *supra* note 54, at 246 (citing *Advance Magazine Publishers, Inc. v. Puropasuto*, 1890 HANREI JIHŌ 127 (Tokyo D. Ct., July 2, 2004)).

68. *Id.*

69. Port, *supra* note 54, at 231.

70. *Id.* at 229.

71. See *supra* note 56-59 and accompanying text.

72. Port, *supra* note 54, at 252.

73. IPPC REPORT, *supra* note 56 (noting that courts “have come to question the notion of presuming confusion”).

toward free riding were already in a state of flux, the courts may be uncertain about whether, and to what extent, the new law was intended to alter their past practice.

The bumpy ride experienced by dilution law in the Japanese courts is ironic for another reason as well. Japan has expressed a desire to strengthen the dilution laws of other countries, particularly in Asia, in order to reduce “free riding on the house marks of Japan’s well known companies.”⁷⁴ Toward this end, Japan’s Industrial Property Council has supported global harmonization efforts, such as the WIPO Joint Recommendation and a revision of TRIPS which would require WTO countries to adopt dilution laws.⁷⁵

2. Right of Publicity

In contrast to dilution, the right of publicity is well-established in Japan, where the contours of the right are similar to those recognized in the United States. Celebrities such as actors, therefore, are entitled to protection against the unauthorized use of their names and likenesses in advertising.⁷⁶ Japan recognizes that a celebrity’s right of publicity arises out of an economic interest, and protects that right under tort law even without a showing of mental suffering.⁷⁷ Despite Japan’s civil law tradition, Japanese courts recognize privacy and publicity rights as constitutional moral rights even though they are explicitly mentioned neither in the constitution nor in specific legislation.⁷⁸ Liability has sometimes been found even where the unauthorized use of a person’s likeness occurs in a news reporting context.⁷⁹

Japan recognizes that celebrities have both a right of publicity – an economic right – and a right of privacy – a moral right.⁸⁰ It is unsettled whether the economic right is completely separate from the moral right, which creates uncertainty as to the scope, assignability,

74. INT’L AFFAIRS COMM., INDUS. PROP. COUNCIL, TOWARDS THE INTERNATIONAL HARMONIZATION OF INDUSTRIAL PROPERTY RIGHTS SYSTEMS IN THE 21ST CENTURY ch. 2, pt. II.3(2)(A) (1999), available at http://www.jpo.go.jp/shiryou_e/index.htm.

75. *Id.*

76. MCCARTHY, *supra* note 6, at § 6:159 (citing *Mark Lester v. Tokyo Daiichi Film*, 817 HANREI JIHŌ 23 (Tokyo D. Ct., June 29, 1976)).

77. *Id.*

78. INTERNATIONAL PRIVACY, PUBLICITY AND PERSONALITY LAWS 283 (Michael Henry ed., 2001).

79. *Id.* at 284.

80. *See id.* at 289 n.9.

and duration of the right of publicity.⁸¹ A celebrity's moral right is infringed if his or her name or likeness is used in a way that harms his or her fame or reputation.⁸² Absent such harm, only the economic right is infringed. No specific law addresses these rights; they are protected under general tort law.⁸³ Finally, the right of publicity is not limited to name or likeness. The Tokyo District Court has held that "the essence of the right to publicity is the power to attract public attention," and that the right extends to "any matter with economic value, arising out of that celebrities' [sic] fame or reputation due to the attraction of public attention."⁸⁴

B. Continental Europe

Both dilution and right of publicity laws have strong and long-standing foundations in continental Europe. Their concurrent development seems to reflect fundamental European concepts of morality – personal moral rights, in the case of the right to a person's name and likeness,⁸⁵ and business morality, in the case of dilution law.⁸⁶ The discussion below focuses on Germany, France, and the Benelux countries because these EU countries have especially well-established dilution and right of publicity protections. As discussed in Section IV(C), these countries provide a useful contrast to the United Kingdom.

1. Dilution

The 1988 Trade Mark Harmonization Directive requires EU members to bar registration of marks that dilute Community Trademarks,⁸⁷ but merely *permits* them to bar registration of marks that dilute marks registered in their national systems.⁸⁸ These similarly-worded provisions apply "where the use of the later trade mark without due cause would take unfair advantage of, or be

81. *Id.* at 289 n.10.

82. *Id.* at 289 n.9.

83. *Id.* at 289.

84. INTERNATIONAL PRIVACY, PUBLICITY AND PERSONALITY LAWS, *supra* note 78, at 290-91 n.14 (citing King Crimson case, 1644 HANREI JIHŌ 141 (Tokyo D. Court, January 21, 1998)) (holding that musicians' right of publicity could be infringed by reproduction of their record jacket, even if it did not contain their names or likenesses).

85. *See infra* notes 100-108 and accompanying text.

86. *See infra* notes 87-99 and accompanying text.

87. First Council Directive 89/104, art. 4(3), 1989 O.J. (L 40) 1.

88. *Id.* at art. 4(4).

detrimental to, the distinctive character or the repute of the earlier trade mark.”⁸⁹

The Directive also permits, but does not require, members to recognize a civil cause of action for dilution:

Any Member State may also provide that the proprietor shall be entitled to prevent all third parties not having his consent from using in the course of trade any sign which is identical with, or similar to, the trade mark in relation to goods or services which are not similar to those for which the trade mark is registered, where the latter has a reputation in the Member State and where use of that sign without due cause takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the trade mark.⁹⁰

The pre-2004 members of the European Union have all adopted dilution provisions that conform to the Directive,⁹¹ some with minor variations in wording. Little controversy or public debate seems to have accompanied their adoption, most likely because, as discussed below, dilution concepts were already established to varying degrees in the domestic laws of much of continental Europe.

Even before the Directive, dilution law was already established in Germany (where it is said to have originated in the 1925 Odol mouthwash case)⁹², the Benelux countries⁹³ (whose domestic law served as the model for the Harmonization Directive),⁹⁴ and, to a lesser degree, France.⁹⁵ The German courts recognized dilution-type claims under the general law of unfair competition.⁹⁶ In the Benelux

89. *Id.* at arts. 4(3), 4(4).

90. *Id.* at art. 5(2).

91. McCarthy, *supra* note 29, at 1163.

92. See Soyoung Yook, *Trademark Dilution in European Union*, 11 INT’L LEGAL PERSP. 223, 223 (2001).

93. See *id.* at 242-43; John A. Tessensohn, *May You Live in Interesting Times - European Trademark Law in the Wake of Sabel BV v. Puma AG*, 6 J. INTELL. PROP. L. 217, 231-32 (1999).

94. Yook, *supra* note 92, at 227.

95. See *infra* note 99 and accompanying text.

96. Yook, *supra* note 92, at 259-60; see also Mathias Strasser, *The Rational Basis of Trademark Protection Revisited: Putting the Dilution Doctrine into Context*, 10 FORDHAM INTELL. PROP. MEDIA & ENT. L. J. 375, 405-06 (2000). On this basis, German courts found that the fame of the Rolls Royce mark was unfairly exploited when a Rolls-Royce automobile was featured in a poster advertising Jim Beam Whiskey, Bundesgerichtshof [BGH] [1983] GRUR 247, 15 INT’L REV. INDUS. PROP. & COPYRIGHT. L. 240 (1984). In addition, they barred registration of the Dimple mark for cosmetics, because that mark was already well known for whiskey, Dimple [1985] GRUR 550, 1985 WRP 399 (BGH), 17 INT’L REV. INDUS. PROP. & COPYRIGHT. L. 271-75 (1986). See Elson Kaseke, *Trademark Dilution: A Comparative Analysis*

countries, dilution was addressed in Article 13A of the 1971 Benelux Trademark Act, which provided that:

Without prejudice to the possible application of ordinary civil law in matters of civil liability, the proprietor of a mark may, by virtue of his exclusive right, oppose: 1) any use made of the mark or of a similar sign for the goods or services in respect of which the mark is registered, or for similar goods or services; and 2) any other use, in economic intercourse, of the mark or of a similar sign made without a valid reason under circumstances *likely to be prejudicial to the proprietor of the mark.*⁹⁷

Although France amended its trademark laws in 1992 in response to the Directive,⁹⁸ even before then a remedy was often available for dilution-type claims if they constituted “parasitic behavior” giving rise to a “disloyal competition” claim under the liberally-construed tort provisions of the French Civil Code.⁹⁹

275-76 (March 2006) (unpublished Doctor of Laws dissertation, University of South Africa), available at

<http://etd.unisa.ac.za/ETD-db/theses/available/etd-10112006-121411/unrestricted/thesis.pdf>.

Germany amended its trademark statutes to conform to the EU Directive in the Trade Mark Reform Law of October 25, 1994, §§ 9(1)(3), 10(1) (refusal or cancellation of marks based on dilution), § 14(2)(3) (providing a cause of action for dilution, even for owners of unregistered marks). *Id.* at 299-300.

97. See Yook, *supra* note 92, at 227 (emphasis added).

98. Article L713-5, the wording of which is slightly different from the Directive, provides:

Any person who uses a mark enjoying repute for goods or services that are not similar to those designated in the registration shall be liable under civil law *if such use is likely to cause a prejudice to the owner of the mark or if such use constitutes unjustified exploitation of the mark.*

The foregoing paragraph shall apply to the use of a mark that is well known within the meaning of Article 6bis of the Paris Convention for the Protection of Industrial Property referred to above.

Law No. 92-597 of July 1, 1992, art. L713-5, Journal Officiel de la République Française [J.O.] [Official Gazette of France], July 3, 1992 (emphasis added). Article L713-5 has been held to protect against unauthorized use of a mark even in the absence of confusion, where the defendant was perceived as borrowing the prestige of the senior user's mark. See Yook, *supra* note 92, at 257-58 (citing Cour d'Appel [CA] [regional court of appeal] Paris, Dec. 15 1993, 1994 E.C.C. 385).

99. For example, in 1962 a French court held that the use of the PONTIAC trademark for refrigerators caused injury to the owner of the PONTIAC mark for automobiles by blurring the distinctive character and attractive power of the senior mark. Ruddy R.Y. Clauss, *The French Law of Disloyal Competition*, 17 EUR. INTELL. PROP. REV. 550, 553-54 (1995); Yook, *supra* note 92, at 258-59.

2. Right of Publicity

The right of publicity is strong and historically well-established in Germany, France, and the Benelux countries. Protection is particularly strong in the case of likenesses.

The right of publicity is especially well-developed in Germany, where it is recognized as both a personality right and a commercial right; the commercial aspect of the right is descendible.¹⁰⁰ The right is broadly defined,¹⁰¹ encompassing soundalikes¹⁰² and look-alikes.¹⁰³

France has long provided strong protection against unauthorized commercial use of a name¹⁰⁴ or likeness.¹⁰⁵ Although the right is

100. See Bundesgerichtshof [BGH] [Federal Court of Justice] Dec. 1, 1999, 143 Entscheidungen des Bundesgerichtshofes in Zivilsachen [BGHZ] 214, translation available at http://www.utexas.edu/law/academics/centers/transnational/work_new/german/case.php?id=726 See also INTERNATIONAL PRIVACY, PUBLICITY AND PERSONALITY LAWS, *supra* note 78, at 165; BEVERLY-SMITH, *supra* note 2, at 104-05.

101. The right to one's name is protected by Section 12 of Civil Code, and the right to one's image is protected by Section 22 of the Kunsturhebergesetz. See INTERNATIONAL PRIVACY, PUBLICITY AND PERSONALITY LAWS, *supra* note 78, at 165, 183; see generally Susanne Bergmann, *Publicity Rights in the United States and Germany: A Comparative Analysis*, 19 LOY. L.A. ENT. L.J. 479 (1999). Both rights are founded in Art. 2(1) of the German Constitution. See Personality Rights Database, Germany, <http://personalityrightsdatabase.com/index.php?title=Germany> (last visited Jan. 10, 2008). See also Bundesgerichtshof [BGH] [Federal Court of Justice] Feb. 14, 1958, 26 Entscheidungen des Bundesgerichtshofes in Zivilsachen [BGHZ] 349, translation available at http://www.utexas.edu/law/academics/centers/transnational/work_new/german/case.php?id=739 (use of plaintiff's image on advertising poster for aphrodisiac violated § 22 of the Act on Artistic Creations (1907) and Articles 1 and 2 of the German Constitution).

102. INTERNATIONAL PRIVACY, PUBLICITY AND PERSONALITY LAWS, *supra* note 78, at 171 (citing Oberlandesgericht [Regional Court of Appeal] Hamburg Neue Juristische Wochenschrift 1990, 1995).

103. *Id.* at 165 (citing Oberlandesgericht [Regional Court of Appeal] Karlsruhe Versicherungsrecht 1996, 600).

104. *E.g.*, INTERNATIONAL PRIVACY, PUBLICITY AND PERSONALITY LAWS, *supra* note 78, at 148-49 (citing Tribunal de grande instance [T.G.I.] [ordinary court of original jurisdiction] Chalon-sur-Saône, July 29, 1988, Bulletin Information Cour de Cassation 1989 ½, No. 135.).

105. INTERNATIONAL PRIVACY, PUBLICITY AND PERSONALITY LAWS, *supra* note 78, at 154-55. The right to one's image is protected by Arts. 9 and 1382 of the Civil Code. See Cass. 1e civ., July 5, 2005, Bull. civ. I, No. 295, 246 (unauthorized use of person's image was actionable where he incidentally appeared in same photo with two other persons who were the subject of a news story), translation available at http://www.utexas.edu/law/academics/centers/transnational/work_new/french/case.php?id=1235 See also Institute for Transnational Law, University of Texas School of Law, Marlene Dietrich v. Société France-Dimanche Translation, http://www.utexas.edu/law/academics/centers/transnational/work_new/french/case.php?id=1254#developments (subsequent commentary quoting a 1994 judgment of the Versailles Court of Appeal: "Any person, however famous, has an exclusive right to his picture and to the use which is made of it, by virtue of which he can oppose its reproduction and dissemination without his express and special authorisation, subject to the requirements of freedom of information.");

generally considered a personality right,¹⁰⁶ French courts and commentators are currently divided on the circumstances under which the right to one's image also has the characteristics of a property right, an issue which affects questions of damages, transferability, and descendibility.¹⁰⁷

The Benelux countries also provide strong protection against commercial use of names and likenesses. These rights are founded in their respective constitutions as well as the general privacy right in Article 8 of the ECHR.¹⁰⁸

C. United Kingdom

The United Kingdom differs from many other EU countries in that neither dilution nor the right of publicity is a part of its legal tradition. Dilution legislation was enacted only in response to the Harmonization Directive.¹⁰⁹ A right of publicity has yet to be recognized. Indeed, the courts have only recently begun to recognize a right of privacy, and only under compulsion from the ECHR.¹¹⁰

1. Dilution

The conventional wisdom is that dilution laws originated in the British and German courts.¹¹¹ Although Germany was indeed an early adopter of the dilution concept, a closer look at the 1898 British case that is often cited for the dilution concept suggests that Britain was not in fact an earlier adopter. The case held that the use of the

Personality Rights Database, Johnnie Halliday Case Summary, http://personalityrightsdatabase.com/index.php?title=Johnnie_Halliday_Soc_Hachette_Filipachi (last visited Feb. 22, 2008); Personality Rights Database, Michael Leeb Case Summary, http://personalityrightsdatabase.com/index.php?title=Michael_Leeb (last visited Feb. 22, 2008).

106. See Eric H. Reiter, *Personality and Patrimony: Comparative Perspectives on the Right to One's Image*, 76 TUL. L. REV. 673, 680-86 (2002).

107. *Id.* at 683-86; Elisabeth Logeais & Jean-Baptiste Schroeder, *The French Right of Image: An Ambiguous Concept Protecting the Human Persona*, 18 LOY. L.A. ENT. L.J. 511, 535-40 (1998); UCL Faculty of Laws, Institute of Global Law, French Legal News (May 2005), http://www.ucl.ac.uk/laws/global_law/legal-news/french/index.shtml; Alain J. Lapter, *How the Other Half Lives (Revisited): Twenty Years Since Midler v. Ford A Global Perspective on the Right of Publicity*, 15 TEX. INTELL.PROP. L.J. 239, 284-88 (2007).

108. See INTERNATIONAL PRIVACY, PUBLICITY AND PERSONALITY LAWS, *supra* note 78, at 60-63 (Belgium), 295-304 (Luxembourg), 318-26 (Netherlands).

109. See *infra* notes 115-119 and accompanying text.

110. See *infra* notes 134-156 and accompanying text.

111. See, e.g., Julie Arther Garcia, *Trademark Dilution: Eliminating Confusion*, 85 TRADEMARK REP. 489, 491 (1995); Walter J. Derenberg, *The Problem of Trademark Dilution and the Antidilution Statutes*, 44 CAL. L. REV. 439, 448 (1956); Frank I. Schechter, *The Rational Basis of Trademark Protection*, 40 HARV. L. REV. 813 (1927).

KODAK mark on bicycles was infringing and reveals that, while the goods in that case (bicycles and photographic supplies) were noncompeting, they were related.¹¹² Both were often sold in the same stores and Kodak marketed a camera specifically for use on bicycles.¹¹³ The court's holding was based on a liberal view of consumer confusion as to sponsorship or affiliation¹¹⁴ rather than on a novel theory of infringement. As discussed below, even after the United Kingdom formally adopted a dilution statute in 1994, many courts seemed reluctant to abandon the requirement of confusion.¹¹⁵

Like the other pre-2004 members of the European Union, the United Kingdom has adopted a dilution law that tracks the language recommended by the 1988 Trade Mark Harmonization Directive.¹¹⁶ Initially, some British courts refused to interpret these provisions in a way that dispensed with the traditional confusion requirement.¹¹⁷ Later decisions acknowledged that confusion was no longer required,¹¹⁸ but expressed varying degrees of uncertainty as to the other requirements of section 10(3).¹¹⁹

112. *Eastman Photographic Materials Co. v. John Griffith's Cycle Corp.*, (1898) 15 R.P.C. 105, 110.

113. *Id.*

114. *Id.*

115. See *infra* notes 116-119 and accompanying text.

116. Section 10(3) of the Trade Marks Act of 1994 provides:

(3) A person infringes a registered trade mark if he uses in the course of trade a sign which—

(a) is identical with or similar to the trade mark, and

(b) is used in relation to goods or services which are not similar to those for which the trade mark is registered,

where the trade mark has a reputation in the United Kingdom and the use of the sign, being without due cause, takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the trade mark.

Trade Marks Act, 1994, c. 26, § 10(3).

117. See *Baywatch Prod. Co. v. Home Video Channel*, [1997] F.S.R. 22, 30 (Ch.) (holding that § 10(3) requires a likelihood of confusion in cases involving similar marks on dissimilar goods, because it would be “illogical” to apply a more demanding standard to similar goods than to dissimilar goods); cf. *BT plc v. One in a Million* [1999] F.S.R. 1 (C.A.) (leaving the question open).

118. *Sihra's Trade Mark Application*, [2003] R.P.C. 44 (holding that confusion as to origin is not required to oppose registration under § 10(3)); cf. *Audi-Med Trade Mark*, [1998] R.P.C. 863, 871-72 (TMR) (holding that likelihood of confusion is not required under § 5(3) to reject application for registration); *Oasis Stores Ltd.'s Trade Mark Application*, [1998] R.P.C. 631 (TMR) (similar).

119. See *Mars UK Ltd. v. Burgess*, [2004] EWHC (Ch) 1912, 2004 WL 1476759 (noting that § 10(3) is “a powerful protection for the trademark owner since it allows an infringement claim without proof of confusion,” but rejecting plaintiff's § 10(3) claim because plaintiff failed to establish that its color mark, used in product packaging, had a reputation in the United

After a string of ECJ precedents that interpreted the corresponding provision of the Trade Mark Harmonization Directive,¹²⁰ British courts began to apply section 10(3) more liberally, but continued to express uncertainty as to its scope. In *Miss World Ltd. v. Channel 4 Television Corp.*,¹²¹ the High Court enjoined a television station from using the term “Mr. Miss World” in promoting the broadcast of a transsexual beauty pageant, even in the absence of a likelihood of confusion. The High Court held that the “Mr. Miss World” mark would violate section 10(3) by taking “unfair advantage” of the reputation of the “Miss World” mark.¹²² In *L’Oreal SA v. Bellure NV*,¹²³ the High Court went even further, finding infringement under section 10(3) where the maker of a series of “smell-alike” perfumes gave vendors comparison lists identifying the brand name fragrance that each of its products was imitating.¹²⁴ This usage was not confusing, and would have been considered truthful comparative advertising, and thus non-infringing, under United States trademark laws.¹²⁵ The Court of Appeal of England and Wales expressed concern about the ramifications of the High Court’s holding.¹²⁶ Agreeing that the defendant’s use was nonconfusing but was designed to capitalize on the repute of the brand name fragrances,

Kingdom); *Daimler Chrysler AG v. Alavi (t/a Merc)*, [2001] R.P.C. 42 (Ch) (rejecting claim under § 10(3) because plaintiff failed to show a “connection” between the two marks); *Premier Brands UK Ltd. v. Typhoon Europe Ltd.*, [2000] F.S.R. 767 (Ch) (stating that likelihood of confusion was not required under § 10(3), but denying relief because plaintiff failed to demonstrate any detriment); *Daimlerchrysler AG v. Alavi*, [2001] R.P.C. 42 (Ch.) (expressing uncertainty as to the concept of “detriment” under § 10(3)); *see also* Stephanie Chong, *Protection of Famous Trademarks Against Use for Unrelated Goods and Services: A Comparative Analysis of the Law in the United States, the United Kingdom and Canada and Recommendations for Canadian Law Reform*, 95 TRADEMARK REP. 642, 671-72 (2005); DAVID S. WELKOWITZ, TRADEMARK DILUTION: FEDERAL, STATE, AND INTERNATIONAL LAW 441-43 (2002 & Supp. 2006).

120. *E.g.*, Case R 308/2003-1, *Mango Sport Sys. S.R.L. Socio Unico Mangone Antonio Vincenzo v. Diknah S.L.*, [2005] E.T.M.R. 5; Case C-408/01, *Adidas-Salomon AG v. Fitnessworld Trading Ltd*, 2003 E.C.R. I-12537; Case C-251/95, *SABEL BV v. Puma AG*, 1997 E.C.R. I-6191.

121. *Miss World Ltd. v. Channel 4 Television Corp.*, [2007] EWHC (Pat) 982, [2007] F.S.R. 30.

122. The same outcome could have been reached based on likelihood of confusion, since both parties provided similar services – entertainment in the form of beauty pageants.

123. *L’Oreal SA v. Bellure NV*, [2006] EWHC (Ch) 2355, [2007] E.T.M.R. 1, [2007] R.P.C. 328.

124. *Id.*

125. *See, e.g.*, *R.G. Smith v. Chanel, Inc.*, 402 F.2d 562 (9th Cir. 1982) (holding that advertising for knock-off perfume may lawfully identify the brand name of the fragrance being imitated).

126. *L’Oreal SA v. Bellure NV*, [2007] EWCA (Civ) 968, 2007 WL 2817991.

Justice Jacob expressed difficulty “deciding where to draw the line between permissible and impermissible ‘free riding.’”¹²⁷ Justice Jacob noted that “you can only have effective comparative advertising where the advertiser is in some sense ‘free riding’ on the goodwill of the target mark.”¹²⁸ He was also uncertain as to the scope of “due cause” with respect to the comparison lists, because “realistically, you cannot sell a replica fragrance – a lawful product – without such a list.”¹²⁹ Finally, with regard to the term “unfair advantage” in section 10(3) of the Trademark Law, as well as Article 5(2) of the Harmonization Directive, he expressed concern that some courts in the European Union were treating as unfair every advantage gained through the use of another’s trademark, without allowing for the possibility that a particular use might in some cases confer a fair advantage.¹³⁰ To obtain clarification on the application of section 10(3) to truthful comparative advertising, the court referred all of its questions to the ECJ.¹³¹

127. *Id.* at ¶ 27.

128. *Id.* at ¶ 38.

129. *Id.* at ¶ 83.

130. *Id.* at ¶¶ 91-94. In particular, Justice Jacob expressed concern about the following statement in *Mango Sport Sys. S.R.L. Socio Unico Mangone Antonio Vincenzo v. Diknah S.L.*, which upheld the rejection of an application to register a Community Trademark:

As to unfair advantage, which is in issue here since that was the condition for the rejection of the mark applied for, that is taken when another undertaking exploits the distinctive character or repute of the earlier mark to the benefit of its own marketing efforts. In that situation that undertaking effectively uses the renowned mark as a vehicle for generating consumer interest in its own products. The advantage for the third party arises in the substantial saving on investment in promotion and publicity for its own goods, since it is able to “free ride” on that already undertaken by the earlier reputed mark. It is unfair since the reward for the costs of promoting, maintaining and enhancing a particular trade mark should belong to the owner of the earlier trade mark in question

Id. at ¶ 88 (citing Case R 308/2003-1, *Mango Sport Sys. S.R.L. Socio Unico Mangone Antonio Vincenzo v. Diknah S.L.*, [2005] E.T.M.R. 5, [19]).

131. The court referred the following five questions:

1. Where a trader, in an advertisement for his own goods or services uses a registered trade mark owned by a competitor for the purpose of comparing the characteristics (and in particular the smell) of goods marketed by him with the characteristics (and in particular the smell) of the goods marketed by the competitor under that mark in such a way that it does not cause confusion or otherwise jeopardise the essential function of the trade mark as an indication of origin, does his use fall within either (a) or (b) of Art. 5 of Directive 89/104 ?

2. Where a trader in the course of trade uses (particularly in a comparison list) a well-known registered trade mark for the purpose of indicating a characteristic (particularly a smell of a fragrance product) of his own product (particularly its smell) in such a way that:

The cautionary note sounded by Justice Jacob's opinion in *L'Oreal* could signal a desire to "put the brakes on" the trend toward

- a) it does not cause any likelihood of confusion of any sort; and
- b) it does not affect the sale of the products under the well-known registered mark; and
- c) it does not jeopardize the essential function of the registered trade mark as a guarantee of origin and does not harm the reputation of that mark whether by tarnishment of its image, or dilution or in any other way; and
- d) it plays a significant role in the promotion of the defendant's product does that use fall within Art. 5(1)(a) of Directive 89/104 ?

3. In the context of Art. 3a(g) of the Misleading Advertising Directive (84/240) as amended by the Comparative Advertising Directive (97/55), what is the meaning of "take unfair advantage of" and in particular where a trader in a comparison list compares his product with a product under a well-known trade mark, does he thereby take unfair advantage of the reputation of the well-known mark?

4. In the context of Art. 3a(h) of the said Directive what is the meaning of "presenting goods or services as imitations or replicas" and in particular does this expression cover the case where, without in any way causing confusion or deception, a party merely truthfully says that his product has a major characteristic (smell) like that of a well-known product which is protected by a trade mark?

5. Where a trader uses a sign which is similar to a registered trade mark which has a reputation, and that sign is not confusingly similar to the trade mark, in such a way that:

- (a) the essential function of the registered trade mark of providing a guarantee of origin is not impaired or put at risk;
- (b) there is no tarnishing or blurring of the registered trade mark or its reputation or any risk of either of these;
- (c) the trade mark owner's sales are not impaired; and
- (d) the trade mark owner is not deprived of any of the reward for promotion, maintenance or enhancement of his trade mark.
- (e) But the trader gets a commercial advantage from the use of his sign by reason of its similarity to the registered mark

does that use amount to the taking of "an unfair advantage" of the reputation of the registered mark within the meaning of Art. 5(2) of the Trade Mark Directive ?

L'Oreal SA v. Bellure NV, [2007] EWCA (Civ) 968, ¶ 164, 2007 WL 2817991.

expansive interpretations of section 10(3). Although not mentioned by Justice Jacob, another recent decision of the High Court may add fuel to such concerns. In *Julias Samann Ltd. v. Tetrosyl Ltd.*,¹³² the High Court used section 10(3) to effectively give one party a monopoly over the market for air fresheners shaped like Christmas trees:

There is a real probability that members of the public seeing the Christmas Tree product will think that it is another product in the Magic Tree range or a Christmas version of the Tree products. In my judgment the evidence and comparison of the marks and sign establish that the average consumer will make a link between the sign and the Tree marks and that this will inevitably damage the distinctiveness of the Tree marks. Their capacity to denote the products of the claimants exclusively will be diminished.¹³³

The pendulum which initially rejected the dilution concept in *Baywatch* may have swung too far in the opposite direction in *Julias Samann*. Judicial treatment of dilution claims in the United Kingdom has yet to settle into a consistent pattern.

2. Right of Publicity

The status of the right to protect one's name and likeness under United Kingdom law is strikingly different from that of most of continental Europe. As discussed earlier,¹³⁴ the right to privacy is well-established in Continental Europe, and the right of publicity is receiving increasing recognition as an outgrowth of that right. In the United Kingdom, a right to privacy is only just beginning to be recognized, and it has not yet led to protection for a person's name or likeness either as an aspect of privacy or as property.

Absent either a privacy-based or property-based right to prevent unauthorized commercial use of a person's name or image, such activities are actionable in the United Kingdom only where a plaintiff can establish passing off, false advertising, or libel.¹³⁵ For example, musical performers the Spice Girls and Abba both failed in their attempts to enjoin unauthorized merchandising activities, because they were unable to prove that consumers would believe that the performers had endorsed the merchandise.¹³⁶ In the courts' view, it

132. *Julias Samann, Ltd. v. Tetrosyl, Ltd.*, [2006] EWHC (Ch) 529, [2006] E.T.M.R. 75.

133. *Id.* at ¶ 83.

134. See *supra* notes 100-108 and accompanying text.

135. MCCARTHY, *supra* note 6, § 6:155.

136. *Lyngstad v. Anabas Prods., Ltd.*, [1977] F.S.R. 62 (Ch.); *Halliwell v. Panini*, LEXIS June 6, 1997 (Ch.) (unreported transcript available through LEXIS service—enter “NAME

was not sufficient that the defendant was exploiting the performers' appeal and reputation.

The sudden emergence of a right of privacy in the United Kingdom is the result of an unusual combination of top-down and bottom-up phenomena; the courts have been given a mandate to find and define a right of privacy with neither legislative guidance nor a common law tradition on which to base that right.¹³⁷ Until recently, the UK had long resisted any recognition of privacy rights, largely due to concerns that such rights would have a chilling effect on freedom of the press, and would be the subject of unpredictable judicial interpretation.¹³⁸ Although the UK ratified the European Convention for the Protection of Human Rights and Fundamental Freedoms (ECHR) in 1951, the nation's lack of enthusiasm for the concept of privacy protection delayed any implementation of the Convention until 1998, when the Human Rights Act was passed.¹³⁹ The privacy protections within the Human Rights Act were nonspecific, stating only that the courts and other public authorities must comply with the Convention as interpreted by decisions of the European Human Rights Commission and the Court of Human Rights.¹⁴⁰ The British government explicitly stated that it would not enact specific privacy legislation, and that it was up to the courts to develop a privacy doctrine in compliance with these authorities.¹⁴¹ As the Court of Appeal of England and Wales has observed, "[t]he courts have not accepted this role with whole-hearted enthusiasm."¹⁴²

When the European Court of Human Rights held in *Von Hannover v Germany*¹⁴³ that Article 8 of the ECHR requires members to affirmatively provide a privacy remedy against private actors,¹⁴⁴ English courts at last concluded that the United Kingdom was required to recognize a right of privacy.¹⁴⁵ However, because they lacked a common law concept of privacy, the courts attempted to

(halliwell) and NAME (panini)" in search of England and Wales Reported and Unreported Cases); see also Lapter, *supra* note 107, at 278-82.

137. See *infra* notes 139-154 and accompanying text.

138. MCCARTHY, *supra* note 6, at §§ 6:154-6:155.

139. INTERNATIONAL PRIVACY, PUBLICITY AND PERSONALITY LAWS, *supra* note 78, at 437.

140. Human Rights Act, 1998, c. 42, § 12; see INTERNATIONAL PRIVACY, PUBLICITY AND PERSONALITY LAWS, *supra* note 78, at 438.

141. Douglas v. Hello Ltd., [2005] EWCA (Civ) 595, ¶ 46, [2005] E.M.L.R. 28.

142. *Id.*

143. Von Hannover v. Germany, 40 E.H.R.R. 1 (2005), [2004] E.M.L.R. 21.

144. Douglas v. Hello Ltd., [2005] EWCA (Civ) 595, ¶¶ 46-49.

145. *Id.* at ¶ 46.

implement the right as an extension of existing doctrine. The 2003 decision in *Douglas v. Hello Ltd.* held a newspaper liable for publishing unauthorized photographs of the wedding of Michael Douglas and Catherine Zeta-Jones.¹⁴⁶ The court based its holding on the tort of breach of confidence.¹⁴⁷ Because no confidential relationship existed between the plaintiffs and the defendant newspaper, the court simply dispensed with the traditional requirement that the confidential information be “disclosed in circumstances importing an obligation of confidence,” stating that this condition would not be required in a situation “where a person can reasonably expect his privacy to be respected.”¹⁴⁸

Soon, however, the courts openly acknowledged that the breach of confidence tort was ill-suited for protecting a general right of privacy: “We cannot pretend that we find it satisfactory to be required to shoe-horn within the cause of action of breach of confidence claims for publication of unauthorized photographs of a private occasion.”¹⁴⁹ Although courts in a common law nation are certainly comfortable with the general concept of developing legal doctrines to fill legislative gaps, it is striking that the British courts so openly stated their discomfort with being compelled to stretch existing doctrine to cover a new right that was alien to their legal tradition.

This awkward formulation ended a year later, when the House of Lords held in *Campbell v. Mirror Group Newspapers Ltd.*¹⁵⁰ that Article 8 of the ECHR required them to recognize that a person’s right to privacy is violated when a disclosure concerns matters as to which a person has a reasonable expectation of privacy. Although the judges recognized that the privacy right must be weighed against the Convention’s Article 10 rights of free speech and press,¹⁵¹ the majority concluded that Campbell’s privacy right outweighed the public’s interest in seeing a photograph of her leaving a meeting of Narcotics Anonymous.¹⁵²

Although the House of Lords openly acknowledged a right of privacy in the *Campbell* case, it expressly declined to recognize a

146. *Douglas v. Hello Ltd.*, [2003] EWHC (Ch) 786, [2003] E.M.L.R. 31.

147. *Douglas v. Hello Ltd.*, [2005] EWCA (Civ) 595, ¶¶ 51-53.

148. *Id.* at ¶ 72.

149. *Id.* at ¶ 53.

150. *Campbell v. Mirror Group Newspapers, Ltd.*, [2004] UKHL 22, [2004] E.M.L.R. 15.

151. *See id.* at ¶ 86.

152. *See id.* at ¶ 125.

generalized right to protect one's likeness from unauthorized use.¹⁵³ Because this particular photograph pertained to an aspect of Naomi Campbell's private life, the court instead held that the newspaper had violated her right to prevent public disclosure of private information.¹⁵⁴

Despite the recent and rapid recognition of the right to privacy in the United Kingdom, the British courts still do not recognize a right to prevent unauthorized use of one's name or likeness, a well-established right elsewhere in Europe. While Michael Douglas, Catherine Zeta-Jones, and Naomi Campbell can prevent the noncommercial use of their photographs when those photographs involve disclosures of private information, they cannot prevent commercial uses of their names or likenesses unless those uses defame them or falsely imply their endorsement of goods or services.¹⁵⁵ In the limited context of commercial advertising, however, celebrities may ask the advertising standards authorities to seek injunctive relief on their behalf.¹⁵⁶

D. Canada

Canada's dilution statute has seen little use, and the few cases applying it have done little to clarify its scope. In contrast, a right of publicity has been recognized in at least six provinces,¹⁵⁷ by statute and by common law, even without a federal or constitutional mandate.

1. Dilution

In Canada, a dilution statute has been on the books since 1953,¹⁵⁸ but has seen little use. The statute, which is now section 22 of the 1985 Trade Marks Act, prohibits unauthorized uses of registered marks that are "likely to have the effect of depreciating the value of the goodwill attaching thereto." Although the history of section 22 suggests that it was intended to replicate the concept of dilution as it

153. "Unlike France and Quebec, in this country we do not recognise a right to one's own image." *Id.* at ¶ 154 (citing *Aubry v. Editions Vice-Versa Inc.*, [1998] 1 S.C.R. 591 (Can.)).

154. *Id.* at ¶ 125.

155. INTERNATIONAL PRIVACY, PUBLICITY AND PERSONALITY LAWS, *supra* note 78, at 447-48.

156. *Id.* at 448.

157. See *infra* notes 171-189 and accompanying text.

158. WELKOWITZ, *supra* note 119, at 444.

had evolved in the United States at that time,¹⁵⁹ 54 years after the enactment of this provision, courts still have not determined what it means to depreciate the value of goodwill. This is not surprising, because section 22 offers little guidance to assist the courts. That this omission was deliberate is evidenced by comments from the Chair of the Trade Mark Law Revision Committee that recommended the legislation:

The intention of the Act of 1953 is to accord to the court very broad powers of discretion in deciding questions of infringement. Any conduct likely to have the effect of depreciating the goodwill attaching to a trademark is a matter left entirely to the discretion of the court and the Act of 1953 quite properly prescribes no rules for the exercise of the discretion. The answer will depend upon the facts of each case and the breadth of view brought to bear on modern commercial questions by any judge called to interpret the section.¹⁶⁰

The Canadian courts thus found themselves invested with virtually unbounded authority to establish rules for a new cause of action that had no foundation in the common law. The result, not surprisingly, has been a curious mixture of confusion, literalism, and paralysis.

The first case applying section 22, the 1968 *Clairol* case,¹⁶¹ interpreted it as preventing truthful comparative advertising. The court strangely limited the statute's application by holding that it applied to comparative information on the product's packaging but not to comparative information in promotional brochures.¹⁶² A 1985 case applying *Clairol* held that section 22 was violated where a defendant referenced the plaintiff's product in a non-disparaging way simply by showing that the competing products were compatible and similar;¹⁶³ oddly, the defendants did not even contest this interpretation.¹⁶⁴

159. Mirko Bibic & Vicky Eatrides, *Would Victoria's Secret Be Protected North of the Border? A Revealing Look at Trade-Mark Infringement and Depreciation of Goodwill in Canada*, 93 TRADEMARK REP. 904, 904 (2003).

160. *Id.* at 912 (quoting H.G. FOX, *THE CANADIAN LAW OF TRADEMARKS AND UNFAIR COMPETITION* 340-42 (1972)).

161. *Clairol Int'l Corp. v. Thomas Supply & Equip. Co.*, [1968] 2 Ex. C.R. 552.

162. See the discussion in WELKOWITZ, *supra* note 119, at 444. See also David Welkowitz, *Protection Against Trademark Dilution in the U.K. and Canada: Inexorable Trend or Will Tradition Triumph?*, 24 HAST. INT'L & COMP. L. REV. 63, 100-02 (2000).

163. *Interlogo, AG v. Irwin Toy Ltd.*, [1985] 3 C.P.R.3d 476, para. 20 (Fed Ct.).

164. *Id.*

Canadian courts have been highly inconsistent in applying section 22 to parodies in advertising,¹⁶⁵ holding in 1983 that the PERRIER mark was depreciated by a “Pierre Eh!” label parodying Prime Minister Pierre Trudeau,¹⁶⁶ but rejecting a claim that SEXUAL PURSUIT depreciated TRIVIAL PURSUIT (despite finding a likelihood of confusion in the latter case).¹⁶⁷

Nor have the courts clarified whether section 22 applies to blurring or free-riding. The Canadian Supreme Court’s 2006 decision in the *Veuve Clicquot* case tells us only that “a mental association of the two marks does not, under section 22, necessarily give rise to a likelihood of depreciation.”¹⁶⁸

Viewed together, these cases suggest that Canadian courts interpret “depreciation” as an especially broad form of tarnishment, by applying section 22 to uses that may reflect negatively on the mark. For example, comparative advertising is truthful and beneficial to consumers, but can “depreciate” the mark by suggesting that another maker’s product may be equal or superior. The Canadian courts have not applied section 22 to uses which merely blur the distinctiveness of a mark or free-ride on its ability to attract consumers. Indeed, the correctness of this narrow view was asserted by Justice Thurlow in *Clairol*:

As I see it goodwill has value only to the extent of the advantage of the reputation and connection which its owner enjoys and whatever reduces that advantage reduces the value of it. Depreciation of that value in my opinion occurs whether it arises through reduction of the esteem in which the mark itself is held or through the direct persuasion and enticing of customers who could otherwise be expected to buy or continue to buy goods bearing the trade mark. It does not, however, as I see it, arise, as submitted by Mr. Henderson, from danger of loss of exclusive rights as a result of use by others as this in my view represents possible loss of exclusive rights in the trade mark itself rather than reduction of the goodwill attaching to it.¹⁶⁹

Given the paucity of case law applying section 22, its meaning is unlikely to be clarified in the near future. As Professor Welkowitz has noted, section 22 cases often fail to move forward, because the

165. See WELKOWITZ, *supra* note 119, at 444.

166. Source Perrier (Société Anonyme) v. Fira-Less Marketing Co., [1983] 2 F.C. 18, 70 C.P.R.2d 61.

167. Horn Abbott Ltd. v. Thurston Hayes Devs. Ltd., [1997] 77 C.P.R.3d 10, 22 (Fed. Ct.).

168. Veuve Clicquot Ponsardin v. Boutiques Cliquot Ltée, [2006] 1 S.C.R. 824, 850.

169. Clairol Int’l Corp. v. Thomas Supply & Equip. Co., [1968] 2 Ex. C.R. 552, 573.

plaintiffs frequently fail to meet the Canadian courts' demanding standard for preliminary injunctions.¹⁷⁰ This standard has the effect of weeding out many section 22 claims, thus enabling the Canadian courts to minimize the impact of section 22 without engaging in the type of substantive judicial activism that might otherwise be needed to restrict the scope of the statute.

2. Right of Publicity

Even though there is no federal or constitutional mandate to protect privacy in Canada,¹⁷¹ the right of publicity is protected in at least six of its provinces.¹⁷² The civil law province of Quebec adopts the French view that a person's name and likeness are protected as an inalienable personality right,¹⁷³ while the common law provinces treat name and likeness as property.¹⁷⁴ The general trend seems to be toward broader acceptance of a right of publicity similar to that recognized in the U.S.¹⁷⁵

Four of the common law provinces have privacy statutes that specifically prohibit the unauthorized use of a person's name or likeness in connection with promoting goods or services,¹⁷⁶ while a fifth, Ontario, protects the right at common law.¹⁷⁷ Quebec protects the right under several sections of its Civil Code.¹⁷⁸ The Supreme Court of Canada has been strongly protective of privacy rights, even where they conflict with freedom of expression, although the latter is expressly mentioned in the 1982 Canadian Charter of Rights and Freedoms, while the right of privacy is not.¹⁷⁹

In Ontario, the right of publicity has branched off from the doctrine of passing off, and is now protected under the common law

170. WELKOWITZ, *supra* note 119, at 445 n.69 (collecting cases).

171. INTERNATIONAL PRIVACY, PUBLICITY AND PERSONALITY LAWS, *supra* note 78, at 74.

172. *See infra* notes 173-189 and accompanying text.

173. *See* Les Éditions Vice-Versa v. Aubry, [1989] 1 S.C.R. 591, 592.

174. *See, e.g.,* Athans v. Canadian Adventures Camps, [1977] 17 O.R.2d 425, 1977 Ont. Rep. LEXIS 86 (Ont. High Ct.) (professional athlete's image was protected against unauthorized commercial use even absent passing off). *See also* MCCARTHY, *supra* note 6, § 6:157.

175. MCCARTHY, *supra* note 6, § 6:157.

176. Privacy Act, R.S.B.C., ch. 336 (1979); Privacy Act, R.S.M., ch.74, § 3(c) (1970); Privacy Act, Nfld. R.S., ch. 6, § 4(c) (1981); S.S., ch. P-24, § 3(c) (1978); *see* MCCARTHY, *supra* note 6, § 6:157.

177. *See infra* notes 180-182 and accompanying text.

178. Québec Civil Code, R.S.Q., ch. C-1991, tit. 2, ch. III, arts. 35, 36(5) (2006); *see* MCCARTHY, *supra* note 6, § 6:157.

179. INTERNATIONAL PRIVACY, PUBLICITY AND PERSONALITY LAWS, *supra* note 78, at 74-75.

tort of misappropriation.¹⁸⁰ The right is treated as a property right and is descendible.¹⁸¹ Although it has predominantly been applied to celebrities, it applies to noncelebrities as well.¹⁸²

In Quebec, as in France, there is strong protection for the unauthorized use of a person's photograph.¹⁸³ Unlike France, however, Quebec explicitly extends protection beyond photographs to include name, image, likeness, and voice.¹⁸⁴ As in France, the right is an inalienable right of personality.¹⁸⁵ However, enforcement of the right may be withheld in cases involving matters of legitimate public interest.¹⁸⁶ Although statutes explicitly recognizing the right were enacted in 1994,¹⁸⁷ Quebec courts had recognized the right as early as 1973.¹⁸⁸ The Quebec courts, as well as the Supreme Court of Canada, found that the right to prevent unauthorized use of a one's likeness was implicit in the general privacy provisions of the 1975 Quebec Charter of Human Rights and Freedoms.¹⁸⁹

E. Australia

Given their cultural, historical, and political similarities, it is remarkable that Australia and the United States occupy opposite ends of the legal spectrum with regard to the rights of privacy and publicity and the dilution doctrine. Unlike many of its trading partners,

180. See, e.g., *Athans v. Canadian Adventures Camps*, [1977] 17 O.R.2d 425, 1977 Ont. Rep. LEXIS 86 (Ont. High Ct.); *Krouse v. Chrysler Canada, Ltd.* [1973] 1 O.R.2d 225. See also INTERNATIONAL PRIVACY, PUBLICITY AND PERSONALITY LAWS, *supra* note 78, at 89 (collecting cases, and citing Howell, *The Common Law Appropriation of Personality Tort*, [Can.] INTEL. PROP. J. 149, 170-72 (1986)); MCCARTHY, *supra* note 6, § 6:157.

181. INTERNATIONAL PRIVACY, PUBLICITY AND PERSONALITY LAWS, *supra* note 78, at 89 (citing *Horton v. Tim Donut Ltd.*, [1997] 75 C.P.R.3d 451, 459-60; *Gould Estate v. Stoddard Pub'g. Co.*, [1996] 30 O.R.3d 520 (Gen. Div.)). In contrast, the right is not descendible under the British Columbia, Saskatchewan, and Newfoundland statutes, and the Manitoba statute is silent on descendability. INTERNATIONAL PRIVACY, PUBLICITY AND PERSONALITY LAWS, *supra* note 78, at 80; MCCARTHY, *supra* note 6, § 6:158.

182. INTERNATIONAL PRIVACY, PUBLICITY AND PERSONALITY LAWS, *supra* note 78, at 91.

183. *Id.* at 84.

184. Québec Civil Code, R.S.Q., ch. C-1991, tit. 2, ch. III, art. 36(5) (2006); INTERNATIONAL PRIVACY, PUBLICITY AND PERSONALITY LAWS, *supra* note 78, at 85.

185. INTERNATIONAL PRIVACY, PUBLICITY AND PERSONALITY LAWS, *supra* note 78, at 86.

186. See, e.g., *Field v. United Amusement Corp.*, [1971] C.S. 283 (involving a documentary film depicting participants in the Woodstock music festival).

187. INTERNATIONAL PRIVACY, PUBLICITY AND PERSONALITY LAWS, *supra* note 78, at 85.

188. See *Rebeiro v. Shawinigan Chemicals (1969) Ltd.*, [1973] C.S. 389.

189. *Aubry v. Les Editions Vice Versa Inc.*, [1998] 1 S.C.R. 591; *Belasky v. 3164055 Canada Inc.*, [1986] R.R.A. 851 (Super. Ct.); *Cohen v. Queenswear Int'l Ltd.*, [1989] R.R.A. 570 (Super. Ct.); *Bogajewicz v. Sony of Can. Ltd.*, [1995] 128 D.L.R.4th 530 (Que. Super.Ct.); see INTERNATIONAL PRIVACY, PUBLICITY AND PERSONALITY LAWS, *supra* note 78, at 84-87.

Australia recognizes neither a right of publicity (or privacy) nor a right to prevent trademark dilution; unauthorized use of a likeness or a trademark is actionable only if passing off is established. Yet Australian law makes perfect sense in light of its roots in English common law. Today, the United Kingdom is reluctantly embracing both privacy and dilution laws only because of pressures to conform to the policies and practices of continental Europe. However, because it is less influenced by Europe, Australia today is more English than the English. It remains to be seen whether the United Kingdom's reluctant embrace of dilution and privacy laws will eventually have an impact on Australia.

Australia is currently under no compulsion from international trade agreements to change its position on privacy, publicity, or dilution doctrine. Unless that situation changes, any move toward the adoption of dilution or privacy laws will be the result of self-determination. This would require, in the case of privacy and publicity rights, a change in social attitudes and, in the case of dilution laws, a convincing argument by trademark owners that the economic benefits of dilution protection outweigh the interference with free speech and competitive freedom. With respect to privacy, publicity and dilution laws, Australia is the laboratory of the future.

1. Dilution

Australian trademark law contains no explicit dilution provisions and Australia is not a party to any international agreement requiring dilution protection. Indeed, unlike many of the United States' other recent bilateral trade agreements,¹⁹⁰ the 2004 U.S.-Australia Free Trade Agreement contains no dilution provisions.¹⁹¹

Australia's close neighbor New Zealand enacted a dilution law for well-known marks in its Trademarks Act of 2002, closely tracking the language of the EU Trade Mark Harmonization Directive.¹⁹²

190. *E.g.*, U.S.-Chile Free Trade Agreement, U.S.-Chile, art. 17.2(7), (9), June, 6, 2003, 117 Stat. 909; U.S.-Jordan Free Trade Agreement, U.S.-Jordan, art. 4(1)(a), Oct. 24, 2000; U.S.-Republic of Korea Free Trade Agreement, U.S.-S. Korea, art. 18.2(8), June 30, 2007, 8 U.S.T. 2217; U.S.-Oman Free Trade Agreement, U.S.-Oman, art. 15.2(7), 11 U.S.T. 1835 (pending implementation). These agreements are available at the website of the United States Trade Representative, http://www.ustr.gov/Trade_Agreements/Bilateral/Section_Index.html.

191. The U.S.-Australia FTA is available at the website of the United States Trade Representative, *supra* note 190.

192. The Trade Marks Act, 2002, Act No. 49, § 89(1)(d), provides:

(1) A person infringes a registered trade mark if the person does not have the right to use the registered trade mark and uses in the course of trade a sign --

....

However, unlike the dilution statutes of New Zealand and the EU countries, Australia's trademark statute omits the crucial language referring to unfair advantage or detriment. Until 1995, Australia provided an infringement cause of action only where a mark was used on similar or related goods.¹⁹³ Section 120(3) of Australia's Trademarks Act of 1995 now satisfies Article 16(3) of TRIPS with respect to registered well-known marks, but it still requires the trademark owner to show that the defendant's use of the mark on unrelated goods suggests "a connection" between the defendant's goods and the owner of the registered mark:

A person infringes a registered trade mark if:

- (a) the trade mark is well known in Australia; and
- (b) the person uses as a trade mark a sign that is substantially identical with, or deceptively similar to, the trade mark in relation to:
 - (i) goods (*unrelated goods*) that are not of the same description as that of the goods in respect of which the trade mark is registered (*registered goods*) or are not closely related to services in respect of which the trade mark is registered (*registered services*); or
 - (ii) services (*unrelated services*) that are not of the same description as that of the registered services or are not closely related to registered goods; and
- (c) because the trade mark is well known, the sign would be likely to be taken as indicating a connection between the unrelated goods or services and the registered owner of the trade mark; and
- (d) for that reason, the interests of the registered owner are likely to be adversely affected.¹⁹⁴

(d) identical with or similar to the registered trade mark in relation to any goods or services that are not similar to the goods or services in respect of which the trade mark is registered where the trade mark is well known in New Zealand and the use of the sign takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the mark

193. See *Campomar Sociedad, Limitada v. Nike Int'l Ltd.*, (2000) 202 C.L.R. 45 ¶¶ 36-49 (discussing Trade Marks Act of 1955).

194. Trade Marks Act, 1995, Act No. 119, § 120(3) (emphasis in original).

There is little case law applying section 120(3).¹⁹⁵ This has not stopped some commentators from suggesting that the provision is already broad enough to protect well-known marks against dilution.¹⁹⁶ Although a 2000 decision by the Australian High Court suggested, obliquely and in dictum, that section 120(3) might protect a mark from “‘dilution’ of its distinctive qualities or of its value to the owner,”¹⁹⁷ no case has interpreted section 120(3) so broadly.¹⁹⁸ The adoption of the statutory phrase “indicating a connection,” in contrast to taking “unfair advantage of” or causing “detriment to” the value of mark, suggests that, at least for now, a plaintiff seeking relief under section 120(3) must show a likelihood of confusion or deception as to origin, endorsement, or association.

Like many other countries, Australia defines infringement of a registered mark to include the use of that mark on goods or services which are the same as, similar to, or closely related to, the goods or services for which the mark is registered.¹⁹⁹ In the case of identical goods or services, a likelihood of confusion is presumed.²⁰⁰ Where the goods or services are merely similar or closely related, however, there

195. A Westlaw search indicates that only nine cases have been reported.

196. Frederick Mostert & Trevor Stevens, *The Protection of Well-Known Trade Marks on Non-Competing Goods*, 7 AUSTL. INTELL. PROP. J. 76, 84 (1996); INTELL. PROP. RESEARCH INST. OF AUSTL., UNIVERSITY OF MELBOURNE, REVIEW OF ENFORCEMENT OF TRADEMARKS: SUBMISSION TO THE ADVISORY COUNCIL ON INTELLECTUAL PROPERTY IN RESPONSE TO ITS ISSUES PAPER ON REVIEW OF ENFORCEMENT OF TRADE MARKS 28-29 (2002) [hereinafter IPRIA].

197. *Campomar Sociedad, Limitada v. Nike Int'l Ltd.* (2000) 202 C.L.R. 45, ¶42. In discussing the importance of confusion or deception under other provisions of Australian trademark law, the Court observed in passing that:

In this decade, legislation in the United States, the United Kingdom, and now in Australia to varying degrees has extended the infringement action to restrain activities which are likely adversely to affect the interests of the owner of a “famous” or “well-known” trade mark by the “dilution” of its distinctive qualities or of its value to the owner.

Id. A footnote indicates that the Australian provision referenced here is § 120(3). The IPRIA’s subsequent claim, in its 2002 submission to the ACIP, that “the High Court must have intended in *Campomar v. Nike* that sub-section 120(3) does not require likely confusion,” was based entirely on this excerpt. IPRIA, *supra* note 196, at 29.

198. In applying § 120(3) to a defendant’s unauthorized use on coffee products of a well-known mark which the plaintiff had registered for pasta products, the Federal Court of Australia tacitly assumed that confusion as to association was required, pointing out that “it is well-known that food and beverage manufacturers make a variety of different products and that brands are extended over different products.” *San Remo Macaroni Co. v. San Remo Gourmet Coffee Pty Ltd.* (2001) 50 I.P.R. 321, 331.

199. Trade Marks Act, 1995, Act No. 119, §§ 120(1), (2).

200. *Id.* § 120(1).

must be a likelihood of deception or confusion.²⁰¹ Moreover, trademark infringement under several other provisions of Australian law requires that the marks be “substantially identical” or “deceptively similar,” the same terms that are used in section 120(3). Case law interpreting this language in the other provisions of Australia’s trademark law has construed these terms narrowly;²⁰² interpretations under section 120(3) are likely to conform to this practice. Thus, even if the phrase “indicating a connection” in section 120(3) is construed broadly enough to apply to blurring, tarnishment, or free riding, this application might in practice be limited to marks that are virtually identical, which would limit the potential reach of any dilution protection arising under the current statute.

Will the forays of New Zealand and the United Kingdom into dilution law persuade Australia to follow suit? Despite Australia’s close connections with these countries and with the United States, there seems little likelihood that Australia will amend its trademark laws to add a dilution provision in the near future. Although Australia’s Advisory Council on Intellectual Property (ACIP) has recommended further study of the issue,²⁰³ it reports receiving widely varying submissions on the need for such legislation,²⁰⁴ and the International Trademark Association (INTA) reports that there has been little advocacy for dilution laws within Australia.²⁰⁵ The dearth of cases litigated thus far under section 120(3) suggests that it would be premature at present for Australia to consider any further expansion of the protection for well-known marks.

201. *Id.* § 120(2). Australia’s common law also employs a liberal concept of passing off, applicable to false suggestions not only as to origin but as to “association, quality, or endorsement.” *Campomar Sociedad, Limitada v. Nike Int’l Ltd.* (2000) 202 C.L.R. 45, 88-89.

202. *See, e.g.,* *Polaroid Corp. v. Sole N Pty Ltd.* (1981) 1 N.S.W.L.R. 491, 495 (SOLAROID not substantially identical to POLAROID); *SAP Austl. Pty Ltd. v. Sapient Austl. Pty Ltd.* (1999) 48 I.P.R. 593, 604 (SAPIENT not substantially identical to SAPIENT COLLEGE); *Coca-Cola v. All-Fect Distribs. Ltd.* (1999) 96 F.C.R. 107, 121 (candy in shape of Coca-Cola bottle was not substantially identical).

203. The ACIP submitted a series of recommendations in its *Review of Trade Mark Enforcement* in April, 2004. Recommendation 7 advises:

- (a) The Government should support research into the economic and legal benefits of, and costs associated with, extended protection of well-known marks.
- (b) Australia should continue to actively participate in international discussions regarding well-known marks.

ADVISORY COUNCIL ON INTELL. PROP., *REVIEW OF TRADEMARK ENFORCEMENT* 5 (2004), available at <http://www.acip.gov.au/library/reviewtmenforce.pdf>.

204. *Id.* at 21.

205. PROTECTION OF WELL-KNOWN MARKS, *supra* note 33, at 6.

In its 2002 submission to the ACIP, the Intellectual Property Research Institute of Australia (IPRIA) cautioned against adoption of dilution provisions without conducting a broad review of:

- (a) "Whether the theory that protection against dilution leads to benefits for consumers and innovation is borne out in practice," and
- (b) "Whether the costs of protection against dilution are worth the benefits."²⁰⁶

Such searching reviews have been noticeably absent in most of the countries that have adopted dilution laws. This failure to legitimize almost certainly contributes to the confusion experienced by their judiciaries in attempting to interpret and apply those laws. If Australia adopts a dilution law, as a result of international pressures rather than domestic policy analysis, the absence of a legitimizing domestic foundation may lead Australia's courts to experience the same dissonance they have observed in their foreign counterparts.

2. Publicity

Like the United Kingdom prior to the 1998 Human Rights Act, Australia does not recognize a right of privacy or publicity in a person's name or likeness.²⁰⁷ Celebrities whose identities are used for commercial purposes generally have no remedy unless they can establish passing off or defamation.²⁰⁸

If a right of publicity does emerge in Australia, it is likely to result from increasingly broad interpretations of passing off, because there is no privacy doctrine to serve as a foundation. Courts have already held that passing off may arise where the use of a celebrity's likeness falsely suggests an endorsement of the defendant's product or service.²⁰⁹ In dictum, one court has suggested that an unauthorized

206. IPRIA, *supra* note 196, at 33; see also J. Thomas McCarthy, *Proving a Trademark Has Been Diluted: Theories or Facts?*, 41 HOUS. L. REV. 713, 717-18 n.15 (2004) (discussing Australian law).

207. INTERNATIONAL PRIVACY, PUBLICITY AND PERSONALITY LAWS, *supra* note 78, at 34-35.

208. Rosina Zapparoni, *Propertising Identity: Understanding the United States Right of Publicity and its Implications – Some Lessons for Australia*, 28 MELB. U. L. REV. 690, 693-94 (2004); see also MCCARTHY, *supra* note 6, § 6.156; INTERNATIONAL PRIVACY, PUBLICITY AND PERSONALITY LAWS, *supra* note 78, at 35, 37.

209. See, e.g., *Henderson v. Radio Corp. Pty*, 60 N.S.W.St. R. 576, 603-04 (1960) (finding false endorsement where dancers' images were used on a dance record); INTERNATIONAL PRIVACY, PUBLICITY AND PERSONALITY LAWS, *supra* note 78, at 35 (collecting cases); Daniel

use of a celebrity's likeness should be actionable regardless of whether consumers are actually misled into believing that the celebrity endorses the goods;²¹⁰ however, no court has squarely adopted this approach.²¹¹ In 1979, the Australian Law Reform Commission proposed creating a new cause of action for the unauthorized use of a person's name or likeness in advertising,²¹² but this proposal has not been adopted.²¹³

V. CONCLUSION

Although both dilution and the right of publicity are part of a strong tradition in parts of continental Europe, in most other parts of the world at least one of these concepts is relatively novel and, when introduced, has presented difficulties for the judiciary. Because publicity laws are usually based on the widely recognized concept of privacy, they are generally more widespread than dilution laws. Nonetheless, even this underlying right of privacy is not universally recognized. In countries like the United Kingdom and Australia, which do not have a tradition of privacy law, the introduction of a right of publicity is likely to engender confusion similar to that which has engulfed dilution laws.

Thus, while in the United States dilution and the right of publicity have come to strongly resemble one another as two types of protection for intangible property, because they are rooted in two very different traditions these doctrines bear little resemblance to one another overseas. The right of publicity flows almost inexorably from the right of privacy; where publicity rights are not yet established, this is typically because privacy laws are either nonexistent (as in Australia) or not well-developed (as in the United Kingdom). However, in trademark law the leap from protecting consumers

R. Shanahan, *"Image-Filching" in Australia: The Legal Provenance and Aftermath of the "Crocodile Dundee" Decisions*, 81 TRADEMARK REP. 351 (1991).

210. See *Hogan v. Koala Dundee Pty* (1988) 20 F.C.R. 314, 322.

211. INTERNATIONAL PRIVACY, PUBLICITY AND PERSONALITY LAWS, *supra* note 78, at 36.

212. Under the proposal, a defendant would be liable:

If he, with intent to exploit for his own benefit, the name, identity, reputation or likeness of that other person and without the consent of that other person, publishes matter containing the name, identity or likeness of that other person –
(a) in advertising or promoting the sale, leasing or use of property or the supply of services; or (b) for the purpose of supporting candidature for office.

AUSTL. LAW REFORM COMM'N, REP. NO. 11, UNFAIR PUBLICATION: DEFAMATION AND PRIVACY ¶ 250 (1979) (as reported by Hong Kong Law Reform Commission, December 2004, at http://www.hklii.org/hk/other/hklrc/reports/2004/12_1/11.html).

213. MCCARTHY, *supra* note 6 § 6:156.

against deception to protecting trademark owners against diminution of their assets seems to require a greater degree of legitimization in order to succeed. Confusion-based trademark doctrine is deeply rooted in tort law's visceral concept of deceit, but dilution's roots are in more abstract notions of business morality as to which there is less universal agreement.

Accordingly, the success of transplanting these two doctrines from one culture to another seems to depend in large part on whether the host culture accepts the underlying premises – that human dignity requires respect for name and likeness, and that commercial fairness precludes disparagement, “whittling away,” or free-riding on the hard-earned prestige of another's brand. In countries where these premises have not taken root – such as the United Kingdom and Australia – both doctrines face a hard trek to acceptance. When the rights are mandated by some extraterritorial source²¹⁴ or even when these doctrines are voluntarily imposed by domestic law but without thorough consideration and debate (as in Canada's dilution statute), they lack the legitimizing foundation which would help the judiciary to understand the laws and apply them consistently.²¹⁵

Australia, which currently is unburdened by obligations to adopt either dilution or right of publicity laws, and which lacks a cultural foundation for either, presents us with a tabula rasa. If Australia adopts these laws as the result of international harmonization pressures, one may expect to see the judiciary react with skepticism and inconsistency. In contrast, if Australia engages in a searching review of the costs and benefits of these laws, and concludes from this study that adopting a dilution law or recognizing a right of publicity will serve the public interest, this may provide the legitimizing foundation necessary to ensure clarity in the drafting of the laws and consistency in their judicial interpretation.

214. For example, the United States has used bilateral trade agreements to mandate dilution laws for Chile, Jordan, South Korea, and Oman, see *supra* note 190, and multinational agreements have introduced dilution and privacy laws into the United Kingdom. See *supra* notes 109-156 and accompanying text.

215. Not to be overlooked is the question whether the advocates themselves—those who frame the issues for the courts—have an adequate understanding of the meaning and purpose of the laws so that their advocacy can stimulate more rigorous analysis by the judiciary. Advocates, too, need a legitimizing foundation to give credibility to their arguments.

* * *