

Trade marks – a call for interdisciplinary work

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Trade marks constitute one aspect of branding. They are ubiquitous. The challenge of searching for a pair of trainers without a trade mark on the exterior is illustrative. Interaction with brands appears integral to daily living.

Interdisciplinary work is needed because trade marks are used by traders, consumers and the law for different purposes, yet traders, consumers and the law interact through trade marks. Traders use trade marks to create a desire for their goods/services in absolute terms and in terms relative to the goods/services of other traders. EasyJet as a trade mark ideally conveys to the relevant public the spirit of fun and simplicity in the services offered. Nu-Salt identifies both its competing goods – salt – and its differentiation from those goods. This differentiation may be achieved in the minds of the prospective consumers through branding represented in trade mark form. Through branding, consumers are familiarised with Apple and IBM computers, and the differentiation between them, despite the non-descriptive nature of the marks.

Consumers, on the other hand, use trade marks to identify the goods/services for the fulfilment of tangible and intangible needs. Nu-Salt suggests fulfilment of a tangible need for those on a low-sodium diet. Beyond tangible needs, using an Apple computer allows the consumer to express a taste in computers, and allows others who share similar taste to identify with the consumer, and vice versa. The consumer's emotional needs may thereby be fulfilled socially. Those needs may be further fulfilled by the feeling of self-affirmation in engaging with a brand reflective of the consumer's self-image. When one trusted consumer recommends the use of Apple computers to another, that other's search cost for a desired computer and his/her risk of using a brand censured by the relevant social group are lowered. More worryingly, social acceptance

can also be achieved by the use of counterfeit goods or goods bearing a mark identical or similar to a well-known mark. Illicit vendors of counterfeit goods thrive on this consumer desire.

The law, however, views trade marks differently. The common law of passing-off provides trade mark protection such that 'no man may pass off his goods as those of another.'¹ The Trade Marks Act 1994 defines a trade mark as 'any sign capable of being represented graphically which is capable of distinguishing goods or services of one undertaking from those of other undertakings' (s.1) A trade mark right is infringed where a mark is used in trade for goods or services identical to those registered for an identical mark (s.10(1)). It is also infringed where a mark is used in trade for goods or services identical or similar to those registered for an identical or similar mark, and consumer confusion is likely to be caused thereby (s.10(2)). In short, the law protects the ability of a plaintiff's mark to perform its legally defined function of distinguishing the goods and services of the plaintiff's undertaking from those of other undertakings. In doing so, the law claims to protect consumers from confusion, to protect traders from unfair competition and to promote economic efficiency. Consumers may cast their economic votes by selecting goods and services which suit their needs and desires based on the trade marks borne on these goods and services and, by purchasing on this basis, distribute economic resources to the favoured traders so these traders may further satisfy consumer needs and desires.

An interdisciplinary view of trade marks is needed to appreciate that the law, although it purports to govern trade mark use, does not fully recognise the traders' designs and the consumers' desires behind their trade mark use. For example, the trader's use of EasyJet to

connote the spirit of fun and simplicity in the services offered, and consumers' desire for counterfeit goods or goods bearing a mark identical or similar to but not confusing with a well-known mark, are not traditionally considered in trade mark law.

Interdisciplinary work is also urgently needed because of the international impetus to further regulate trade mark use. Thus, the current Act includes as a trade mark infringement the use of a mark in trade which 'without due cause, takes unfair advantage of, or is detrimental to, the distinctive character or the repute of' an identical or similar registered mark with a reputation in the United Kingdom (s.10(3)). The meaning of this relatively recent inclusion continues to attract controversy.

The author is the first winner of the British Brands Group Prize in Trade Mark Law at the University of Oxford.

¹ *Reckitt & Colman Products Ltd v Borden Inc* [1990] 1 WLR 491 (HL(E)) 499

First IP prize awarded

The first British Brands Group Prize in Trade Mark Law has been awarded to Dr Catherine Ng for her dissertation under the supervision of Professor David Vaver on 'Dilution of the Law of Passing-off'. The prize, awarded in conjunction with the University of Oxford, is for the best dissertation or thesis submitted as part of a postgraduate degree in Law on a subject connected with the law or practice of trade marks, unfair competition, or branding. The judging panel comprises one member of the Faculty of Law and one intellectual property lawyer, in this case Dr Justine Pila, university lecturer in IP law, and Mr Henry Carr QC of 11 South Square, Gray's Inn.