<a> PART I – EXISTING CONCEPTIONS OF TRADE MARKS AND HUMAN RIGHTS AND A FRAMEWORK FOR CHANGE

<a> CHAPTER 1 – THE NEED FOR INCREASED AWARENESS OF HUMAN RIGHTS IMPLICATIONS FOR TRADE MARKS

<b> 1. Introduction

Human rights norms matter for trade mark law. As a form of commercial expression that communicates information about a product, granting trade mark protection can restrict freedom of expression to protect the rights of trade mark owners and consumers. Yet too often, trade mark law focuses on owner rights and fails to recognise the impact of trade mark protection on human rights. The three case studies in this book demonstrate the impact of trade marks on diverse human rights, expanding analysis beyond the usual focus on the relationship between trade marks and freedom of expression and providing guidance for states to realise human rights obligations. Trade mark laws that are consistent with human rights principles can function to protect human rights to health and life. Ignoring human rights norms in trade mark law can restrict freedom of expression, limit rights to cultural participation and facilitate hate speech. Recent interpretations of the *Agreement on Trade Related Aspects of Intellectual Property* ('*TRIPS*') by the World Trade Organization ('WTO') Dispute Settlement Bodies present promising opportunities for states to recognise societal interests that are consistent with human rights obligations when they implement multilateral intellectual property agreements into domestic law.[1] However, states are still not obliged by international intellectual property agreements to ensure that trade mark laws are consistent with human rights, despite independent legal and normative obligations to do so. Meanwhile, ensuring compliance is increasingly difficult. Trade marks benefit social welfare by functioning to identify goods and reduce consumer search costs. These benefits are less certain as illicit trade increases, sophisticated reproductions of counterfeit goods proliferate, and substandard goods bearing false trade marks pose threats to human rights to life and health.

Part One of this book explores the existing relationship between trade marks and human rights in international law and theoretical conceptualisations of this relationship. It proposes an analytical framework that will support a human rights culture for trade marks focused on comprehensive and integrated protection of all human rights using a rights-based approach. This introductory chapter identifies systemic fragmentation between the fields of intellectual property law and human rights law. It explores the doctrinal and normative reasons justifying increased consideration of the human rights implication of trade mark law. Enforcement mechanisms that support international agreements underpinning protection for intellectual property rights include provisions that are stronger than the consensus-based approach used by human rights institutions. A concern of this book is that the international legal order is moving towards an emphasis on order, associated with intellectual property agreements, and away from concerns of justice, associated with human rights protection.[2]

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[1] See Panel Report, Australia – Certain Measures Concerning Trademarks, Geographical Indications and Other Plain Packaging Requirements Applicable to Tobacco Products and Packaging, WTO Doc WT/DS435/R, WT/DS441/R, WT/DS458/R, WT/DS467/R (28 June 2018) [7.2406], [7.2588] ('Australia – Tobacco Plain Packaging'). See also Panel Report, Turkey – Certain Measures Concerning the Production, Importation and Marketing of Pharmaceutical Products, WT/DS583/12 (28 April 2022) (affirmed in Turkey – Pharmaceutical Products, WTO Doc WT/DS583/ARB25 (25 July 2022) (Award of the Arbitrators)) ('Turkey – Pharmaceutical Products').

[2] Samuel Murumba, 'Foxes and Hedgehogs at the Intersection of Human Rights and Intellectual Property' (2012) 38(1) *Monash University Law Review* 119, 134.

This encourages a trend towards primacy of intellectual property law over human rights law, which is not justified by normative considerations of justice. Consequently, a more positive culture to support and promote human rights in trade mark law is needed.

Creating a positive human rights culture requires appropriate analytical tools for identifying existing and potential conflicts between intellectual property obligations and human rights. Such analysis forms part of a more comprehensive road map for promoting and fostering human rights culture in trade mark law. Chapter Two of this book explores how existing scholarship on the relationship between human rights and intellectual property recognises that trade mark laws engage human rights, and it develops a Human Rights Assessment for Trade Marks ('HRATM') framework, drawing on the development of human rights frameworks for public health. Existing conceptual models of intellectual property and human rights stop short of holistic and effective protection. Laurence Helfer and Graeme Austin's proposed model recognises the ultimate importance of human rights protection in intellectual property regulation but only recommends minimal protection for economic, social and cultural rights.[3] Christophe Geiger recommends broader protection for some economic, social and cultural rights but does not address limitations in protection for other rights, such as the right to health in the European fundamental rights system.[4] Peter Yu acknowledges the importance of economic, social and cultural rights and progressive realisation but does not apply this approach to concrete examples of domestic intellectual property law.[5] Nonetheless, analytical approaches from existing scholarship can be a valuable part of a human rights culture for trade marks, assisting states to assess the human rights compatibility of trade mark laws, depending on the local conditions in that state.

Applying the HRATM framework to three case studies in Part Two of the book improves our understanding of the relationship between trade marks and human rights and the way local conditions in different jurisdictions can influence this relationship. The framework guides comprehensive analysis of the relationship between trade marks and the full breadth of internationally recognised human rights – civil, political, economic, social and cultural rights. Existing literature often focuses on the right to freedom of expression.[6] Even in this area of scholarship, the appropriate relationship between trade marks and freedom of expression remains contested. Comparing recent American and European decisions reveals significant differences in the protection of freedom of expression in relation to registration of contrary trade marks that have implications for prohibitions on hate speech and the human right to participate in culture. However, there is little consideration of the way that internationally significant trade mark issues – including tobacco plain packaging, contrary marks and anti-counterfeiting – engage complex human rights considerations, including rights to health, a fair trial, cultural participation, and moral and material interests for authors. A human rights analysis of these issues demonstrates that it is critically important to found a human rights culture for trade marks and advocate for greater awareness of those issues amongst policymakers so that they can comply with their human rights obligations.

The plain packaging case study analyses the human rights implications of restrictions on the exercise of trade mark rights on tobacco packaging in Australia. Although the human rights impact of restricting the use of trade marks on packaging is beneficial, the disputes surrounding Australian plain packaging legislation and comparator legislation in Uruguay show that important human rights implications of

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[3] Laurence R Helfer and Graeme Austin (eds), *Human Rights and Intellectual Property: Mapping the Global Interface* (Cambridge University Press, 2011) 517.

[4] Christophe Geiger, 'Implementing Intellectual Property Provisions in Human Rights Instruments: Towards a New Social Contract for the Protection of Intangibles' in Christophe Geiger (ed), *Research Handbook on Human Rights and Intellectual Property* (Edward Elgar, 2015) 661.

[5] Peter K Yu, 'Reconceptualizing Intellectual Property Interests in a Human Rights Framework' (2006) 40(3) *University of California Davis Law Review* 1039. See also Peter K Yu, 'The Anatomy of the Human Rights Framework for Intellectual Property' (2016) 69(1) *SMU Law Review* 37.

[6] See, for example, Helfer and Austin (n 3).

plain packaging remain underexplored. This is particularly significant because these disputes chilled introduction of plain packaging legislation in other countries, delaying the human rights benefits of restricting the advertising function of tobacco trade marks. However, the disputes also suggest promising opportunities for greater systemic integration between intellectual property and human rights, which will be aided by the use of the HRATM framework.

The contrary marks case study identifies human rights concerns following two United States Supreme Court decisions that suspended the power of the United States Patent and Trademark Office to refuse registration of disparaging, scandalous and offensive marks.[7] Although these decisions were justified by reference to the applicants' free speech rights, the cultural significance of these marks means that their registration can unnecessarily impair freedom of expression rights of third parties who may wish to use them, restricting their right to participate in culture. Perceptions that trade mark registration suggests government endorsement of the use of these marks can also impact human rights to effective protection from discrimination and hate speech. The comparator European legislation regarding contrary marks recognises human rights differently, consistent with international intellectual property standards.[8] This indicates that, although it reflects the local approach to human rights implementation, the United States approach is problematic for a human rights culture, and attempts to use bilateral and plurilateral mechanisms to require other states to implement it need to be discouraged.

The anti-counterfeiting case study also identifies serious human rights concerns posed by counterfeit medical products in Kenya and Sub-Saharan Africa during the Covid-19 pandemic. Although Kenyan legislation largely reflects *TRIPS* minimum standards for enforcement and enshrines further *TRIPS*-plus standards,[9] the case study suggests that widespread distribution of counterfeit goods in Kenya poses serious concerns for protection of the right to health and life as these goods are more likely to be of substandard quality. The resource intensive nature of effective cross-border trade mark enforcement, as well as the increasing sophistication of product imitations, seriously impair detection and deterrence of counterfeit goods. The Australian comparator suggests that this problem is not limited to less economically developed countries. Moreover, economically developed countries have specific human rights obligations to address problems through international assistance and cooperation.

This book uses the case studies of tobacco plain packaging, contrary marks and anti-counterfeiting measures to explore the human rights implications of the exercise, registration and enforcement of trade mark rights. Each primary case study is accompanied by a comparison of regulation of the subject matter in another jurisdiction. Comparison highlights the impact of differences in local conditions, such as mechanisms for domestic recognition of human rights and economic conditions, on the protection of human rights. Specific local conditions influence the application of models designed to harmonise the relationship between human rights and intellectual property protection. Together, the case studies establish that diverse human rights concerns can be engaged by the exercise, registration and enforcement of trade marks, often influenced by the scope of protection available to trade mark owners. The case studies also provide insight into ways to monitor and address fundamental human rights obligations in international law. The resulting lessons are often relevant across diverse jurisdictions, indicating that multilateral reform is needed. For example, Chapter Six of the book argues that the threats to the right to health identified in the anti-counterfeiting case study necessitate changes to the entire multilateral system.

The HRATM framework also supports rights-based reform to address the serious threats to human rights protection that currently exist due to the gap between human rights and intellectual property

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[7] *Matal v Tam*, 137 S Ct 1744, 1747 (2017); *Iancu v Brunetti,* 139 S Ct 2294, 2297 (2019).

[8] Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015 to Approximate the Laws of the Member States relating to Trade Marks [2015] OJ L 336/1.

[9] *Anti-Counterfeit Act* No 13 of 2008 (Kenya).

obligations in trade mark enforcement worldwide. Part Three of the book uses the findings from the case studies to propose an alternative approach to trade mark enforcement that harnesses the value of technology and rights-based principles, including international cooperation, through a Framework Convention for Goods Provenance ('FCGP'). It identifies a series of approaches that are useful for understanding the relationship between trade marks and human rights and can guide the establishment of a human rights culture for trade marks. Methods proposed for ensuring that the operation of trade mark law is consistent with human rights recognise as fully as possible the functions of intellectual property that are consistent with human rights. This recognition permits intellectual property to contribute to broader social welfare objectives that are consistent with the realisation of economic, social and cultural rights.

A human rights culture for trade marks enables states to ensure that trade mark protection regimes function consistently with international obligations to respect, protect and fulfil human rights. A human rights culture for trade marks supports the protection of trade mark rights in a manner that is consistent with human rights obligations. Human rights culture can surround, underpin or influence the development of trade marks protection. Resulting changes may not be appealing for all stakeholders: in many states, reform to existing institutions is required to ensure that trade marks are consistent with human rights.[10] There are complex human rights issues engaged by trade marks, but systematic analysis permits these issues to be understood and balanced against each other so that states can comply with their human rights obligations while implementing multilateral intellectual property standards.

The next section of this chapter introduces important features of the fragmented fields of human rights law and international intellectual property law. The third section explains the normative significance of ensuring that primacy is not given to trade mark obligations over human rights obligations.

<b> 2. Fragmentation Between Intellectual Property and Human Rights

Differences between the fields of intellectual property and human rights strongly influence the legal relationship between human rights and intellectual property. Separation between different fields of international law has resulted in fragmentation: an international legal system that is not cohesive.[11] A lack of cohesion is apparent in the failure to address and recognise relevant human rights in international intellectual property agreements. This can make it difficult for states to balance different obligations in international law.

The broader international context cannot be ignored in attempting to develop a human rights culture for trade marks. Increasingly, the world is recognising the critical impact that intellectual property can play in human rights protection, particularly the right to health. Adjustments to the *TRIPS* agreement following the *Doha Declaration on Public Health*,[12] which responded to the impact of intellectual property on access to medicines in the HIV/AIDS pandemic, have not created a system that can respond quickly to urgent health crises, where intellectual property-protected pharmaceuticals and

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[10] Zehra F Kabasakal Arat, 'Forging A Global Culture of Human Rights: Origins and Prospects of the International Bill of Rights' (2006) 28(2) *Human Rights Quarterly* 416, 424.

[11] See International Law Commission, Fragmentation of International Law: Difficulties Arising from the Diversification and Expansion of International Law. Report of the Study Group of the International Law Commission, Finalized by the Chairman, Martti Koskenniemi, UN GAOR, 58th sess, UN Doc A/CN.4/L.682, A/CN.4/L.682/Add.1, A/CN.4/L.682/Corr.1 (13 April 2006) ('ILC Study Group Report').

[12] *Doha Declaration on the TRIPS Agreement and Public Health*, WTO Doc WT/MIN(01)/DEC/2 (20 November 2001, adopted 14 November 2001) (Ministerial Declaration).

diagnostic tools are necessary for effective responses.[13] The limited waiver for patent protection for Covid-19 vaccines in 2022 only came after lengthy negotiations, deferring a further decision on protection for diagnostics and therapeutics.[14] The narrow waiver fails to recognise the integrated nature of intellectual property. Even where the information needed to work an invention is contained in a patent, new technology can require know-how that is protected separately as a trade secret.[15] Critical technology transfer that could lessen the impact of this has not occurred.[16] Trade marks are also relevant: access to medicine is negatively impacted if trade marks do not function effectively to prevent dissemination of substandard counterfeit goods.[17]

This book explores cases where fragmentation impacts the development and operation of domestic trade mark legislation. The recent WTO decision in *Australia – Tobacco Plain Packaging*, analysed in the plain packaging case study in Chapter Three, suggests that international intellectual property agreements could be interpreted so that intellectual property and human rights coexist in domestic law.[18] However, there is still no clear roadmap for reconciling competing interests between the two bodies of law and their governing institutions. The institutions that drive the development and enforcement of the two fields are distinct and the approach that they take differs considerably.

<c> 2.1 Intellectual property institutions and enforcement

TRIPS entrenched intellectual property into the international trade regime overseen by the WTO.[19] *TRIPS* has subsequently become the focus of international intellectual property law standard setting and enforcement.[20] The WTO dispute settlement mechanism is structured so that parties in breach may be subject to economic sanction and these have been applied in some disputes.[21] The multilateral trade mark standards agreed by parties to the *Paris Convention for the Protection of Industrial Property* ('*Paris Convention*')[22] have been incorporated into *TRIPS* and the agreement has expanded certain rights for trade mark owners, including rights for owners of well-known marks.[23] It has also created a system of cross-border enforcement, which requires states to provide mechanisms for detection and enforcement of trade mark owner rights in relation to imported goods bearing counterfeit trade marks.[24]

The WTO is the most important multilateral institution driving the development of international intellectual property norms. Within the WTO, the TRIPS Council oversees *TRIPS* and is composed of

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[13] See Siva Thambisetti et al, 'Addressing Vaccine Inequity During the Covid-19 Pandemic: The TRIPS Intellectual Property Waiver Proposal and Beyond' (2022) 81(2) *Cambridge Law Journal* 384.

[14] *TRIPS Non-Violation And Situation Complaints*, WTO Docs WT/MIN(22)/26 and WT/L/1137 (22 June 2022, adopted on 17 June 2022) (Ministerial Decision).

[15] Thambisetti et al (n 13) 398-399.

[16] Ibid 385-388.

[17] Cf Duncan Matthews, 'Counterfeiting and Public Health' in Christophe Geiger (ed), *Criminal Enforcement of Intellectual Property: A Handbook of Contemporary Research* (Edward Elgar, 2011).

[18] See Australia – Tobacco Plain Packaging (n 1).

[19] Marrakesh Agreement Establishing the World Trade Organization, opened for signature 15 April 1994, 1867 UNTS 3 (entered into force 1 January 1995) annex 1C ('Agreement on Trade-Related Aspects of Intellectual Property Rights') ('TRIPS').

[20] Christophe Geiger and Luc Desaunettes-Barbero, 'The Revitalisation of the Object and Purpose of the TRIPS Agreement: The *Plain Packaging Reports* and the Awakening of the TRIPS Flexibility Clauses' in Jonathan Griffiths and Tuomas Mylly (eds), *Global Intellectual Property Protection and New Constitutionalism: Hedging Exclusive Rights* (Oxford University Press, 2021) 267.

[21] Matthew Kennedy, *WTO Dispute Settlement and the TRIPS Agreement* (Cambridge University Press, 2016) 298-300.

[22] *Paris Convention for the Protection of Industrial Property*, opened for signature 20 March 1883, 828 UNTS 305 (entered into force 6 July 1884, revised at Stockholm 14 July 1967, amended 28 September 1979).

[23] *TRIPS* (n 19) pt II.

[24] Ibid pt III.

representatives of all WTO Member States. It addresses important issues raised by states regarding implementation of the agreements and it can amend *TRIPS* through agreement. The World Intellectual Property Organization ('WIPO') remains important as the institution responsible for intellectual property in the United Nations ('UN') system.[25] WIPO continues to administer the longest-standing international agreement addressing trade marks, the *Paris Convention,* and other international agreements concerning trade mark law. WIPO does not have a permanent observer role on the TRIPS Council but the two bodies cooperate on some activities. There is limited direct engagement between the TRIPS Council and human rights institutions.[26]

The key *TRIPS* provisions about the protection of trade mark rights are those specified in Part II, Section 2 of *TRIPS* in relation to trade marks and geographical indications, and in Part III relating to enforcement. *TRIPS* incorporated *Paris Convention* standards and further developed substantive trade mark standards.[27] Key obligations that extended *Paris Convention* protection included expansion of the definition of a trade mark;[28] the introduction of the presumption of registrability;[29] protection for well-known service marks; and protection for distinctiveness acquired through use.[30] Requirements that Member States provide mechanisms to address counterfeiting confer additional cross-border protection for trade marks and copyright owners.[31] The anti-counterfeiting protection regime provides rights that strongly benefit owners of trade marks who engage in international trade.[32] Prevention of counterfeit activities focuses on border control and the provisions of *TRIPS* establish mechanisms to effect this.[33] Part III of *TRIPS* addresses general obligations for enforcement procedures in Section 1[34] and specific requirements in Section 2.[35] Specific requirements include that civil judicial procedures be fair and equitable;[36] and that Member States provide judicial authority to make orders regarding production of evidence,[37] injunctions,[38] compensatory damages and indemnification of legal fees,[39] as well as other remedies to deter infringement.[40] There are special requirements related to border measures regarding the importation of counterfeit trade marks or pirated copyright goods that permit seizure of these goods in certain circumstances.[41] Article 1.1

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[25] Ibid art 2; Daniel J Gervais, *The TRIPS Agreement: Drafting History and Analysis* (Sweet & Maxwell, 4th ed, 2012) 10-11, 187-188.

[26] Klaus D Beiter, 'Establishing Conformity Between TRIPS and Human Rights: Hierarchy in International Law, Human Rights Obligations of the WTO and Extraterritorial State Obligations Under the International Covenant on Economic, Social and Cultural Rights' in Hanns Ullrich et al (eds), *TRIPS Plus 20: From Trade Rules to Market Principles* (Springer, 2016) 445.

[27] *TRIPS* (n 19) art 2(1). The *Agreement* also incorporated the relevant provisions of the *Paris Convention*.

[28] Sam Ricketson, The Paris Convention for the Protection of Industrial Property: A Commentary (Oxford University Press, 2015) 645.

[29] Working Party to Review the Trade Marks Legislation, *Recommended Changes to the Australian Trade Marks Legislation* (Australian Government Publishing Service, 1992) 41-42.

[30] Christopher J Arup, 'The Prospective GATT Agreement for Intellectual Property Protection' (1993) 4 *Australian Intellectual Property Journal* 181, 189-191.

[31] *TRIPS* (n 19) pt III.

[32] Peter K Yu, 'The comparative economics of international intellectual property agreements' in Theodore Eisenberg and Giovanni B Ramello (eds), *Comparative Law and Economics* (Edward Elgar, 2016) 282-283.

[33] *TRIPS* (n 19) pt III.

[34] Ibid art 41.

[35] Ibid art 49 extends the principles of section 2 to cases where a civil remedy is ordered as a result of administrative procedures on the merits of a case.

[36] Ibid art 42.

[37] Ibid art 43.

[38] Ibid art 44.

[39] Ibid art 45.

[40] Ibid art 46.

[41] Ibid pt III s 4.

retains some provision for WTO Members to determine appropriate implementation methods.[42] It can permit flexibility within the scope of the prescribed standards.[43] Flexibility is relevant to the ability of states to exercise domestic regulatory autonomy consistent with the object and purpose of the agreement found in Articles 7 and 8.

Enforcement of *TRIPS* is governed by the *WTO Dispute Settlement Understanding* ('*DSU*').[44] The *DSU* provides a range of remedies in cases where a party successfully complains that another party is non-compliant with *TRIPS*, including retaliatory trade sanctions.[45] However, only a small number of proceedings that interpret *TRIPS* have been finally decided by Dispute Settlement Bodies applying the *DSU*. [46] A number of other disputes have been initiated but resolved through negotiation.[47] This small number of decisions means guidance for the implementation of *TRIPS* is limited for WTO Member States.[48] This can contribute to a chilling regulatory environment where states are unwilling to test whether policy can be shaped to use the flexibility mechanisms of *TRIPS* to privilege justifiable domestic interests.[49] States may either be unable or unwilling to legislate in a manner that uses *TRIPS* flexibility mechanisms or emphasises national interests. This may limit the willingness of states to use *TRIPS* flexibility mechanisms to meet their human rights obligations. However, the recent *Australia – Tobacco Plain Packaging* decision indicates that the flexibility mechanisms embedded into *TRIPS* can support restrictions on intellectual property rights.

<c> 2.2 Human rights institutions and enforcement

As human rights derive from 'the dignity and worth inherent in the human person', the human person is the central subject and principal beneficiary of human rights.[50] Human rights are universal, inalienable and indivisible. The *Charter of the United Nations* ('*UN* Charter') establishes that states have obligations to recognise and protect human rights and should cooperate and assist in the global realisation of human rights.[51] Subsequently, states have established key human rights treaties that define the scope of human rights protection and guide our understanding of individual human rights entitlements. This book uses human rights standards found in key human rights instruments, particularly the *Universal Declaration of Human Ri*ghts ('*UDHR*'),[52] the *International Covenant on Civil*

[42] Ibid art 1(1).
[43] Kennedy (n 21) 123.
[44] *Marrakesh Agreement Establishing the World Trade Organization*, opened for signature 15 April 1994, 1867 UNTS 3 (entered into force 1 January 1995) annex 2 ('*DSU*').
[45] See Kennedy (n 21) 4-8, 28.
[46] Peter K Yu, 'TRIPS and its Achilles Heel' (2011) 18(2) *Journal of Intellectual Property Law* 479, 508-511.
[47] See Kennedy (n 21), xxxiv-xxxvi.
[48] Antony Taubman, 'Australia's Interests under TRIPS Dispute Settlement: Trade Negotiations by Other Means, Multilateral Defense of Domestic Policy Choice, or Safeguarding Market Access' (2008) 9(1) *Melbourne Journal of International Law* 217, 234.
[49] See Lukasz Gruszczynski, 'Australian Plain Packaging Law, International Litigation and Regulatory Chilling Effect' (2014) 5(2) *European Journal of Risk Regulation* 242.
[50] Vienna Declaration and Programme of Action: Adopted by the World Conference on Human Rights, UN GAOR, UN Doc A/CONF.157/23 (25 June 1993) Preamble para 2 ('Vienna').
[51] Charter of the United Nations arts 55, 56.
[52] *Universal Declaration of Human Rights*, GA Res 217A (III), UN GAOR, UN Doc A/810 (10 December 1948) ('*UDHR*').

and Political Rights ('*ICCPR*'),[53] the *International Covenant on Economic, Social and Cultural Rights* ('*ICESCR*')[54] and the *Convention on the Rights of the Child* ('*CRC*').[55]

Within the UN, human rights issues are the focus of UN charter-based bodies such as the Human Rights Council, which monitors human rights issues and state compliance with human rights, and treaty making bodies, which implement specific human rights treaties, such as *ICESCR*, by monitoring compliance and guiding implementation of state parties.[56] Human rights treaties are often interpreted by treaty making bodies of appointed experts in general comments regarding the interpretation of each treaty following consultation.[57] This permits dynamic interpretation of the law as comments can be reissued.

Human rights law is often described as lacking teeth.[58] Although all UN Members are bound by the *UN Charter* and the *UDHR* can be characterised as an authoritative interpretation of the references to human rights, not all UN Members belong to all human rights treaties that transform the *UDHR* into binding and enforceable obligations. States that are parties may also make reservations when they sign the treaty. The nature of enforcement mechanisms available for implementation of human rights is criticised as contributing to widespread failure to implement many human rights.[59] This perception of toothlessness is relevant to understanding the relationship between intellectual property and human rights, which may influence states that are required to choose between competing obligations in international human rights law and international intellectual property law. WTO enforcement mechanisms available for *TRIPS* breaches include powerful deterrents.[60] These remain stronger deterrents than the consensus-based mechanisms available for human rights institutions.[61] Progressive realisation of economic, social and cultural rights can make it more difficult to demonstrate how compliance with trade laws compels breaches of human rights, such as the right to health.[62]

The continuing distinction made between economic, social and cultural rights and civil and political rights is also relevant to enforcement and the status of the respective obligations, in comparison to other systems of law such as international intellectual property law obligations. Historically, civil and political rights have been perceived to be of higher status and more enforceable than economic, social and cultural rights.[63] There is less interpretation of how economic, social and cultural rights should protect individuals because of the relatively recent entry into force in 2013 of the *Optional Protocol to the International Covenant on Economic, Social and Cultural Rights* ('*ICESCR Protocol*'), which

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[53] *International Covenant on Civil and Political Rights*, opened for signature 16 December 1966, 999 UNTS 171 (entered into force 23 March 1976) ('*ICCPR*').

[54] *International Covenant on Economic, Social and Cultural Rights*, opened for signature 16 December 1966, 993 UNTS 3 (entered into force 3 January 1976) ('*ICESCR*').

[55] *Convention on the Rights of the Child*, opened for signature 20 November 1989, 1577 UNTS 3 (entered into force 2 September 1990).

[56] Oliver De Schutter, *International Human Rights Law: Cases, Materials, Commentary* (Cambridge University Press, 3rd ed, 2019) 943-944, 869-872.

[57] Ibid 872.

[58] Rhona K M Smith, *Textbook on International Human Rights Law* (Oxford University Press, 7th ed, 2016) 51.

[59] ILC Study Group Report (n 11) 51.

[60] Kennedy (n 21) 288.

[61] See Murumba (n 2) 135-136.

[62] Laurence R Helfer, 'Mapping the Interface between Human Rights and Intellectual Property' in Christophe Geiger (ed), *Research Handbook on Human Rights and Intellectual Property* (Edward Elgar, 2015) 6, 11-12.

[63] This distinction is and should be questioned: see, for example, Andrew Byrnes, 'The Protection and Enjoyment of Economic Social and Cultural Rights' in Paula Gerber and Melissa Castan (eds), *Contemporary Perspectives on Human Rights Law in Australia* (Thomson Reuters, 2012) 125, 130-131; Peggy Ducoulombier, 'Interaction between Human Rights: Are All Human Rights Equal?' in Christophe Geiger (ed), *Research Handbook on Human Rights and Intellectual Property* (Edward Elgar, 2015).

established complaint and inquiry mechanisms pursuant to *ICESCR*.[64] In contrast, the *First Optional Protocol to the International Covenant on Civil and Political Rights*, permitting individuals to make complaints against states regarding compliance with the *ICCPR*, entered into force on 23 March 1976.[65] Although the majority of states are party to both the *ICESCR* and the *ICCPR*, in domestic jurisdictions civil and political rights are often accorded higher status than economic, social and cultural rights.[66]

The differences in structure between the two agreements regarding derogation can also influence the value accorded to them.[67] While the *ICCPR* provides states with clearer standards to guide compliance, the *ICESCR* approach is more dynamic and facilitates continuous improvement of economic, social and cultural rights standards within states. The *ICESCR* recognises that economic, social and cultural rights are dependent on resources and should be progressively realised.[68] Interpretation of the *ICESCR* provides guidance on core obligations for specific rights and prohibits retrogression once standards are realised.[69] The *ICCPR* provides less flexibility. States can derogate from civil and political rights in times of public emergency but they need to notify the UN Secretary-General of the details.[70] Certain rights, such as the right to freedom from torture, cannot be derogated from. These non-derogable provisions are more likely to align with *jus cogens* norms.[71] These norms have primacy over other international laws.[72] *Jus cogens* norms can be used to justify the primacy of human rights over intellectual property and are relevant to hierarchy between international laws. However, determining which human rights can be considered peremptory is not settled in international law and the application of *jus cogens* arguments to support primacy remains unclear.[73]

<c> 2.3 Seeking common ground

Fragmentation is problematic when standards within separate fields of law appear to operate inconsistently with each other and states need to reconcile competing obligations internally and in their dealings with other states. When these perceived inconsistencies result in disputes between states, fragmentation creates difficulty in finding appropriate mechanisms for the interpretation of issues that engage multiple specialised bodies of international law.[74]

In the absence of a cohesive mechanism for dispute settlement, the approach taken within public international law to competing systems emphasises interpretation guided by the rules of treaty

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[64] *Optional Protocol to the International Covenant on Economic, Social and Cultural Rights*, adopted 10 December 2009, 869 UNTS 34 (entered into force 5 May 2013). Byrnes identifies lack of justiciability of economic, social and cultural human rights as one of the bases for according them less status that civil and political rights: Byrnes (n 63) 130-131.

[65] *Optional Protocol to the International Covenant on Civil and Political Rights*, opened for signature 16 December 1966, 999 UNTS 302 (entered into force 23 March 1976).

[66] See Andrew Byrnes, 'Second-Class Rights Yet Again? Economic, Social and Cultural Rights in the Report of the National Human Rights Consultation' (2010) 33(1) *UNSW Law Journal* 193.

[67] See Philip Alston and Ryan Goodman, *International Human Rights* (Oxford University Press, 2013) 394. See also Philip Alston and Gerard Quinn, 'The Nature and Scope of States Parties' Obligations under the International Covenant on Economic, Social and Cultural Rights' (1987) 9(2) *Human Rights Quarterly* 156, 216-219.

[68] *ICESCR* (n 54) art 2.

[69] Committee on Economic, Social and Cultural Rights, *General Comment No 3: The Nature of States Parties' Obligations (Art 2, Para 1 of the Covenant)*, UN ESCOR, 5th sess, UN Doc E/1991/23 (14 December 1990) [9].

[70] *ICCPR* (n 53) art 4.

[71] See examples in De Schutter (n 56) 85.

[72] Ibid.

[73] Ibid.

[74] See Henning Grosse Ruse-Khan, 'A Conflict-of-Laws Approach to Competing Rationalities in International Law: The Case of Plain Packaging between Intellectual Property, Trade, Investment and Health' (2013) 9(2) *Journal of Private International Law* 308.

interpretation found in the *Vienna Convention on the Law of Treaties* ('*VCLT*').[75] However, finding an appropriate forum to resolve conflicts between intellectual property and human rights is more complex. Although the International Court of Justice could address inter-systemic conflicts involving human rights agreements and the *Paris Convention*, it does not have binding jurisdiction over WTO agreements and disputes. Decision makers within institutions that are focused on one field of law will have a greater understanding of that field of law and may exhibit systemic bias.[76] Ruse-Khan proposes a 'conflict-rule of integration'.[77] This approach applies to potentially conflicting systems, such as human rights and intellectual property. Where there are 'two or more valid and applicable rules which point to an incompatible decision' and one approach needs to be selected, '[t]he underlying rule system which is more able to integrate the other system's rules [applies]'.[78] This values the ability of a rule system 'to integrate the objectives and interests represented by other rules as a connecting factor', which can be linked to 'the public international law principle of integration'.[79]

Approaches to both human rights and intellectual property dispute resolution systems respectively have limitations for this type of systemic integration. Treaty-making bodies, including the Human Rights Committee and the Committee on Economic, Social and Cultural Rights ('CESCR'), receive complaints of human rights breaches from individuals and focus consideration on breaches of human rights rather than resolving conflicts between competing legal systems.[80] The main human rights treaties include mechanisms for the resolution of disputes between states parties over a state's fulfilment of its obligations under the treaty. These are very rarely used although individual compliance is addressed by the treaty-making bodies through state reporting and the mechanisms of the Human Rights Council. Human rights treaties prescribe limited permissible exceptions or limitations that may accommodate some interests related to intellectual property protection, such as the restrictions that trade mark protection can pose on commercial freedom of expression.[81]

The WTO provides a clear approach to dispute resolution binding on WTO Members. The *Paris Convention* permits resolution of disputes through the International Court of Justice, but intellectual property disputes have not been addressed in this forum.[82] There is no reference to human rights in *TRIPS*, yet the flexibility mechanisms of the agreement could permit consideration of human rights in settlement of disputes surrounding *TRIPS* statutes.[83] Interpretations of relevant provisions that could permit greater domestic regulatory autonomy, including Articles 7 and 8, are limited. [84] Article 8 of *TRIPS* privileges policy protecting public health, which is relevant to the human right to health.[85] Yet Article 8 provides no clear provision for the right to freedom of expression, although the exercise of

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[75] Ibid 310-311; *Vienna* (n 50); *ILC Study Group Report* (n 11) 207 [412].
[76] Ruse-Khan (n 74) 335–337.
[77] Ibid 331.
[78] Ibid.
[79] Ibid.
[80] Committee on Economic, Social and Cultural Rights, *Views: Communication No. 1/2013*, 57th sess, UN Doc E/C.12/57/D/1/2013 (20 April 2016, adopted 4 March 2016) ('*López Rodríguez v Spain*').
[81] See *ICCPR* (n 53) art 19(3).
[82] Ricketson (n 28) 323.
[83] See, for example, Sub-Commission on the Promotion and Protection of Human Rights, Economic, Social and Cultural Rights: The Impact of the Agreement on Trade-Related Aspects of Intellectual Property Rights on Human Rights – Report of the High Commissioner, UN ESCOR, 52nd sess, Agenda Item 4, UN Doc E/CN.4/Sub.2/2001/13 (27 June 2001) [65]-[67].
[84] Taubman (n 48). But see '*Australia – Tobacco Plain Packaging*' (n 1) [7.2429].
[85] Genevieve Wilkinson, 'The Human Rights (Parliamentary Security) Act 2011 (Cth) and the Increasingly Visible Intersections between the Human Right to Health and Intellectual Property in Australia' (2016) 105 *Intellectual Property Forum* 46.

trade mark rights can restrict commercial expression.[86] In WTO disputes about *TRIPS* compliance, human rights arguments have not yet been addressed. The WTO Appellate Body has acknowledged that the agreement should not be read in isolation from public international law.[87] The reference to public international law by WTO dispute settlement mechanisms is limited in practice.[88] The decision in *Australia – Plain Packaging* confirms a trend towards recognition of national interests supported by those flexibilities and shows that agreements like the *Framework Convention on Tobacco Control* can influence disputes.[89] However, the interpretation of the scope of rights protected by *TRIPS* Article 20 also suggests that this provision can provide owners with broad trade mark protection.[90] The scope of protection offered by Article 20 for trade mark use in the course of trade[91] was 'not limited to the use of a trademark for the specific purpose of distinguishing the goods and services of one undertaking from those of other undertakings' and includes 'a wider range of commercial, advertising and promotion activities'.[92]

Even where there has been greater consideration of *TRIPS* flexibilities, the WTO dispute settlement bodies have not placed great emphasis on human rights. This may reflect failures by the disputants to emphasise human rights-based arguments, disinterest in human rights or the limited number of disputes. However, this may be slowly changing: the Dispute Settlement Body recently recognised the relevance of the right to health to a claim contesting the inconsistency of requirements on foreign pharmaceutical suppliers with national treatment protection, provided in a WTO covered agreement, *GATT 1994*.[93]

<c> 2.4 Further fragmentation

Forum shifting of intellectual property standard setting to bilateral and plurilateral trade and investment agreements has further fragmented the international landscape. Some bilateral and plurilateral trade and investment agreements seek to expand protection for trade mark owners beyond minimum standards found in *TRIPS* and the *Paris Convention*. Ong identifies two areas where the United States has used bilateral free trade agreements to export domestic trade mark obligations.[94] Firstly, agreements require strong protection for non-visually perceptible marks, such as sound marks.[95] The second, more controversial, area is additional protection for well-known marks, including protection against tarnishment, dilution and misappropriation of associated goodwill.[96] Ong suggests that this expands the protection provided for well-known marks in *TRIPS* to include the first six articles of the 'Joint Recommendation Concerning Provision of the Protection of Well-Known

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[86] See Andreas Rahmatian, 'Trade Marks and Human Rights' in Paul Torremans (ed), *Intellectual Property and Human Rights: Enhanced Edition of Copyright and Human Rights* (Kluwer Law International, 2nd ed, 2008) 335, 347-356. See also Jonathan Griffiths, 'Is There a Right to an Immoral Trademark?' in Paul Torremans (ed), *Intellectual Property Law and Human Rights* (Kluwer Law International, 3rd ed, 2015) 425.

[87] Appellate Body Report, *United States – Standards for Reformulated and Conventional Gasoline*, WTO Doc WT/DS2/AB/R, AB-1996-1 (20 May 1996) [19].

[88] Gabrielle Marceau, 'WTO Dispute Settlement and Human Rights' (2002) 13(4) *European Journal of International Law* 753, 766–767.

[89] See Australia – Tobacco Plain Packaging (n 1) [7.2604].

[90] Genevieve Wilkinson, 'Packaging Domestic Interests into Intellectual Property Law: Lessons from Tobacco Plain Packaging Disputes' 47(2) *Monash University Law Review* (forthcoming).

[91] Australia – Tobacco Plain Packaging (n 1) [7.2260].

[92] Ibid [7.2286].

[93] See Turkey – Pharmaceutical Products (n 1).

[94] Burton Ong, 'The Trademark Law Provisions of Bilateral Free Trade Agreements' in Graeme B Dinwoodie and Marc D Janis (eds), *Trademark Law and Theory: A Handbook of Contemporary Research* (Edward Elgar, 2008) 229, 240–242.

[95] Ibid. See *Australia-United States Free Trade Agreement*, signed 18 May 2004, [2005] ATS 1 (entered into force 1 January 2005) art 17.2.2 ('*Australia-United States Free Trade Agreement*').

[96] Ong (n 94) 242–248.

Marks', adopted by the General Assembly of WIPO and the Assembly of the Paris Union in 1999.[97] This recommendation encouraged states to protect well-known marks beyond protection later enshrined in *TRIPS*. Ong argues that the *US-Jordan Free Trade Agreement* and the *US-Singapore Free Trade Agreement* oblige the signatory states to give effect to these *TRIPS*-plus recommendations.[98]

The impact of increasing protection for trade mark owners of well-known marks has been most evident in the United States,[99] but such protection has also increased in other jurisdictions, including Europe.[100] The link between trade mark protection and brand protection is used to justify expansion of rights domestically but has also been criticised. Decisions of the European Court of Justice have generated debates questioning increasing protection for well-known marks in Europe.[101] Gangjee and Burrell argue that even where the essential function of the mark as 'a guarantee of origin and thus consistent quality' is not harmed, the European Court of Justice is prepared to protect the image of a mark from free riders.[102] This guarantee of origin rationale originally balanced concerns that trade marks impede the free movement of trade.[103] Davis argues that the European Court of Justice should maintain the distinction between trade marks and branding.[104] It should not be influenced by the 'need to protect brand values at all costs', in part because brand valuation should be treated with caution.[105]

The high value attributed to branding and trade marks has given trade mark owners strong incentives to seek expansive protection.[106] These interests can influence legislative development that responds to well-resourced lobbying.[107] Courts can respond to this by interpreting legislation narrowly, although this can also prompt corrective legislation that entrenches broad trade mark monopolies.[108]

For net exporters of intellectual property and net importers with strong export markets, it is advantageous for expanded protection to operate in other jurisdictions.[109] When strong exporters enter bilateral or plurilateral agreements they can negotiate for these to include expanded intellectual

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[97] Ibid 242.
[98] Ibid.
[99] *Trademark Dilution Revision Act*, 15 USC § 1125(c) (2006); Michael Handler, 'What Can Harm the Reputation of a Trademark? A Critical Re-Evaluation of Dilution by Tarnishment' (2016) 106(3) *Trade Mark Reporter* 639.
[100] Dev Gangjee and Robert Burrell, 'Because You're Worth It: L'Oreal and the Prohibition on Free Riding' (2010) 73(2) *Modern Law Review* 282; Handler (n 99) 643–647.
[101] Gangjee and Burrell (n 100).
[102] Ibid 294–295.
[103] Ibid.
[104] Jennifer Davis, 'The Value of Trade Marks: Economic Assets and Cultural Icons' in Ysolde Gendreau (ed), *Intellectual Property: Bridging Aesthetics and Economics – Propriété Intellectuelle: Entre L'Art et L'Argent* (Editions Themis, 2006).
[105] Ibid 122.
[106] Jennifer Files Beerline, 'Anti-Dilution Law, New and Improved: The Trademark Dilution Revision Act of 2006' (2008) 23(1) *Berkeley Technology Law Journal* 511, 514.
[107] Ibid 523–524; John Braithwaite and Peter Drahos, *Global Business Regulation* (Cambridge University Press, 2000) 61–63.
[108] Beerline (n 106) 521–522.
[109] Susan K Sell, 'TRIPS Was Never Enough: Vertical Forum Shifting, FTAs, ACTA and TPP' (2011) 18(2) *Journal of Intellectual Property Law* 447, 452–455. For recent statistics about major exporters and importers of charges for the use of intellectual property, see World Trade Organization, *World Trade Statistical Review 2017* (World Trade Organization, 2017) 135 <https://www.wto.org/english/res_e/statis_e/wts2017_e/wts17_toc_e.htm>.

property protection.[110] The impact of these agreements is amplified by international obligations of national treatment and most favoured nation requirements for intellectual property.[111]

The *Paris Convention* enshrined principles of national treatment: each state party was required to protect the covered intellectual property rights of nationals of other Members of the agreement with standards equivalent to protection provided to its own nationals.[112] The national treatment requirements were retained and extended to all areas of intellectual property covered by *TRIPS*.[113] Most favoured nation obligations are characteristic of other trade agreements covered by the WTO regime.[114] This restricts discrimination between trading partners by requiring the benefits agreed between WTO Members and other countries to be extended by those Members to all other WTO Members.[115] Consequently, benefits agreed between any WTO Members that are relevant to the areas of intellectual property covered by the agreement are extended to all Members.[116] There are certain exceptions, such as agreements made prior to the conclusion of *TRIPS*.[117] However, states that agree to expand intellectual property protection through subsequent bilateral and plurilateral trade agreements must offer the same protection to all *TRIPS* Members.[118] Including these standards in future trade agreements with other parties becomes advantageous: it increases foreign protection for their own nationals, which *TRIPS* requires them to provide to all nationals of WTO Member States.[119]

The incorporation of intellectual property provisions into trade agreements between developing countries and developed countries has frequently increased standards as a result of the operation of national treatment and most favoured nation principles in *TRIPS*.[120] This contributes to an expansion of intellectual property rights. These expanded protections are problematic if they restrict the ability of states to meet their international human rights obligations. There is limited evidence available of systematic human rights analysis of these often secretly negotiated trade agreements, so conflicts are foreseeable.

A human rights culture is designed to limit the impact of systemic fragmentation. Dispute resolution mechanisms that can accommodate both systems are valuable, but are only one part of that culture. The HRATM framework for analysis developed in Chapter Two is designed so that states can proactively address conflicts between intellectual property and human rights and monitor their ongoing compliance with human rights obligations. This is increasingly important because of expanding global protection for trade mark monopolies. It is problematic that there are no clear mechanisms for addressing the human rights implications of the increasing protection of trade mark owner rights found in plurilateral and bilateral trade and investment agreements and endorsed by the dispute settlement panel for protection of owners beyond the traditional source identification of trade marks. Like the WTO agreements, trade and investment agreements include enforcement

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[110] Sell (n 109) 452–455.

[111] *TRIPS* (n 19) arts 3, 4. The combination of national treatment and most favoured nation principles in *TRIPS* with explicit standards has meant that intellectual property standards have increased for many states. See Osei Tutu, who argues that this combination is more restrictive than other WTO agreements: J Janewa Osei Tutu, 'Value Divergence in Global Intellectual Property Law' (2012) 87(4) *Indiana Law Journal* 1640, 1654–1656.

[112] Ricketson (n 28) 336–339.

[113] *TRIPS* (n 19) art 3.

[114] Kennedy (n 21) 207–212.

[115] Gervais (n 25) 209–211.

[116] *TRIPS* (n 19) art 4.

[117] Ibid art 4(d).

[118] Anselm Kamperman Sanders and Dalindyebo Shabalala, 'Intellectual Property Treaties and Development' in Daniel J Gervais (ed), *Intellectual Property, Trade and Development: Strategies to Optimize Economic Development in a TRIPS-Plus Era* (Oxford University Press, 2nd ed, 2014) 41, 68.

[119] *TRIPS* (n 19) arts 3, 4. Kamperman Sanders and Shabalala argue that many developing countries have resisted this: Kamperman Sanders and Shabalala (n 118) 68.

[120] Kamperman Sanders and Shabalala (n 118) 68.

mechanisms that are stronger than the consensus-based approach used by human rights institutions. The protection of intellectual property rights as assets, through investor state dispute mechanisms that protect foreign investors, is now a common feature of trade and investment agreements between states.[121] This strengthens protection for trade mark owners. The next section explores how both normative and positivist considerations support increased consideration of the human rights implications of trade mark law.

<b> 3. Normativism, Positivism and the Relationship Between Intellectual Property and Human Rights

Both human rights law and intellectual property law have normative and positivist dimensions. A deliberative or positivist conception of human rights law is much closer to the instrumentalist approach taken in international intellectual property law than a natural law conception.[122] However, normative legitimacy means that it is also important to understand what law ought to be, and human rights law remains much more closely linked to normative considerations of justice.[123] This section identifies normative justifications for both human rights and trade marks, and recognises the problems of a legal order where intellectual property rights that expand beyond normative justifications for its protection have increasing primacy over human rights and considerations of justice.

<c> 3.1 Justifications for human rights protection

Human rights are an articulation of rights inherent to all human beings. A natural rights approach posits that human rights are derived from a transcendental source, such as human reason or a religious basis.[124] Murumba characterises natural rights as the forerunner of the modern doctrine of human rights, and argues that natural rights privileged entitlement in natural law's universe of duty during the Enlightenment period and 17th and 18th century European and American revolutions.[125] Natural rights justifications support the primary interest in human rights law: the protection of the inalienable human rights of individuals. The binding nature of both human rights and intellectual property obligations also means that positivist justifications can support them as a system of authoritative rules.

The connection between law and morality is contested by positivism, which developed in reaction to natural law to emphasise the importance of rules and authority to law.[126] Austin argued that law is command backed by sanction.[127] Hart developed positivist theory, arguing that law constitutes a system of rules that are given authority and meaning by social practices and conventions.[128] This contrasts to Strauss's argument, derived from Plato and Aristotle, that natural law provides validity for all positive law.[129] Positive law is invalid if it contradicts natural law. [130] The positivist separability theory, that there is 'no necessary connection between law and morality', should be questioned on the basis that facts cannot be completely separated from values but are grounded in a fact-value

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[121] Rochelle C Dreyfuss and Susy Frankel, 'From Incentive to Commodity to Asset: How International Law is Reconceptualizing Intellectual Property' (2015) 36(4) *Michigan Journal of International Law* 557, 566–575.
[122] Murumba (n 2) 133–134.
[123] Ibid.
[124] Marie-Bénédicte Dembour, 'What are Human Rights? Four Schools of Thought' (2010) 32(1) *Human Rights Quarterly* 1, 2–3.
[125] Murumba (n 2) 132. See Leo Strauss, *Studies in Platonic Political Philosophy* (University of Chicago Press, 1983) 141–146.
[126] Murumba (n 2) 131–132.
[127] Ibid 132, citing John Austin, *The Province of Jurisprudence Determined* (John Murray Publishers, 1832).
[128] Murumba (n 2) 132–133.
[129] Strauss (n 125) 141.
[130] Ibid.

complex encompassing extremities of legal order and justice.[131] Law is partly rooted in justice so concerns of justice cannot be ignored, but law also depends on order as it necessarily responds to the 'demands of justice in a systematic and orderly manner'.[132] The emphasis we place on certain facts reflects our values.[133] The tension between facts and values corresponds to the tension identified between legal positivism and traditional natural law.[134] If we conceive of '[l]aw as a fact-value complex', we find a place for synthesis of legal positivism and moral concerns.[135] Murumba links 'facticity' to intellectual property law and 'normativity' to human rights law, but argues that it is a distortion to equate the fields to a dichotomy of positivism and normativism and contends that the fields lie on a spectrum between the dichotomies.[136]

This book establishes the need for a more proactive culture to support and promote human rights in trade mark law. In current practice, Murumba suggests that global intellectual property law is a regression towards command-sanction legal positivism, and human rights as a corrective has only been directly successful as a last resort.[137] Confining the role of human rights to a last resort to balance unjust intellectual property laws is problematic for building a harmonising relationship between human rights and intellectual property. Prescriptive models addressing the relationship between human rights and intellectual property need to comprehensively consider these legal trends. Murumba uses the nature of legality to show that normative concerns still have an important role in the international legal framework.[138] The dichotomy between positivism and natural law should be minimised by recognising an inclusive spectrum when assessing conflicts between the fields and the legitimacy of competing rights.[139]

Positivism is a very useful tool for resolving political, philosophical and religious disagreements between states that are parties to human rights agreements.[140] However, human rights justifications remain tied to normative origins in natural law that emphasise the inherent dignity of the individual and the universal and inalienable nature of individual rights. These principles influence the HRATM framework developed in Chapter Two. Justice links natural law, natural rights and human rights. However, they have each evolved differently.[141] For Locke, law moved away from justice and developed to serve the individual and 'his desire expressed through free will'.[142] The doctrines of both Locke and Rousseau derive not from a hierarchic order of man's natural ends, but the lowest of those ends – self-preservation.[143] Locke ties self-preservation to the right to property and develops his theory from this point.[144] Locke's emphasis on property rights potentially justifies intellectual property rights. Importantly, egalitarian social concerns in the 19th century balanced the strong individual and libertarian influence of the 18th century, and synthesis between these movements can be found in the modern human rights regime.[145]

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[131] Ibid 139.
[132] Ibid 141.
[133] Ibid 139.
[134] Ibid 140–141.
[135] Ibid 140.
[136] Ibid 141.
[137] Ibid; Noah Novogrodsky, 'After AIDS' (2013) 14(2) *Melbourne University Law Review* 643.
[138] Murumba (n 2).
[139] Ibid 140–141.
[140] See Jennifer Prah Ruger, 'Toward a Theory of a Right to Health: Capability and Incompletely Theorized Agreements' (2006) 18(2) *Yale Journal of Law & the Humanities* 273, 304–305.
[141] Costas Douzinas, *The End of Human Rights* (Hart Publishing, 2000) 84.
[142] Ibid.
[143] Strauss (n 125) 143–144.
[144] Ibid 145.
[145] Murumba (n 2) 130, citing Louis Henkin, *The Age of Rights* (Columbia University Press, 1990).

Human rights standards used in this research are rights that have been agreed on and derive from societal agreement in key human rights instruments.[146] Where relevant, customary international law is considered. A significant advantage of a positivist approach is the way it permits states with diverse philosophical and religious backgrounds to agree, despite these differences.[147] However, these laws should be consistent with normative underpinnings of justice.[148]

<c> 3.2 Justifications for intellectual property protection

Theoretical justifications can be used to contest laws that are inconsistent with them.[149] Theoretical justifications also assist in the understanding of the beneficial aspects of intellectual property laws and the different stakeholders, whose interests should be considered in assessing the function and value of trade mark law. For trade mark protection, Loughlan identifies three potentially competing interests: owner interests in protecting goodwill and property, consumer interests in recognising trade marks as a badge of origin and not being deceived or confused, and public interests in competition and open communication.[150] Protection of these interests shapes the development of domestic intellectual property legislation, which is a focus of the case studies in this book. Fisher identifies four main theoretical approaches to intellectual property: the utilitarian approach, the Lockean approach, personality theory and social planning theory.[151] Each theory can be blended in intellectual property legislation, explanatory materials and decisions.[152] The relevance of each justification to trade mark law, discussed in the paragraphs below, supports assessment of the normative basis for specific types of trade mark protection and how closely they align with considerations of justice.

In economic theory, trade mark law benefits social welfare by reducing search costs, protecting consumers and providing an incentive for maintaining consistent quality.[153] The function of trade marks strongly influences the underlying rationale and theoretical justifications for trade mark law.[154] Trade marks convey information that permits consumers to distinguish goods and services from other goods and services in trade.[155] Trade marks can also have a semiotic value by increasing the number of words that efficiently describe things, reducing communication and information costs.[156] They can contribute to the development of generic words, as well as culturally significant terms that enrich language with their 'intrinsic pleasingness'.[157] The strength of the model relies on the efficiency of

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[146] Dembour (n 124) 3.
[147] See Ruger (n 140) 304–305.
[148] Murumba (n 2) 140–141.
[149] William Fisher, 'Theories of Intellectual Property' in Stephen R Munzer (ed), *New Essays in the Legal and Political Theory of Property* (Cambridge University Press, 2001) 168, 194–199.
[150] Patricia Loughlan explains that these interests are often in contest in Australian trade mark law: Patricia Loughlan, 'The Campomar Model of Competing Interests' (2005) 27(8) *European Intellectual Property Review* 289, 292.
[151] Fisher (n 149) 169–173.
[152] See ibid 175, 194–199.
[153] William M Landes and Richard A Posner, The Economic Structure of Intellectual Property Law (Harvard University Press, 2003) 173 ('The Economic Structure of Intellectual Property Law').
[154] JT International SA v Commonwealth of Australia; British American Tobacco Australasia Ltd v Commonwealth of Australia (2012) 250 CLR 1, 27-28 (French CJ).
[155] Trade Marks Act 1995 (Cth) s 17.
[156] Landes and Posner, The Economic Structure of Intellectual Property Law (n 153) 167–168.
[157] William M Landes and Richard A Posner, 'Trademark Law: An Economic Perspective' (1987) 30(2) *Journal of Law and Economics* 265, 271 ('Trademark Law: An Economic Perspective'); Landes and Posner, *The Economic Structure of Intellectual Property Law* (n 153) 168–169. See also Thomas D Drescher, 'The Transformation and Evolution of Trademarks: From Signals to Symbols to Myth' (1992) 82(3) *Trademark Reporter* 301, 339.

trade marks as a naming function of things, provided that it is quicker to use trade marks and the products that are named by those trade marks are of consistent quality.[158]

Economic theory justifying trade marks corresponds to utilitarian justifications for intellectual property.[159] Trade mark rights reward investment and the production of quality products and are justifiable in economic theory where their role in increasing market efficiency improves social welfare.[160] Trade marks function to permit variety by ensuring that products from different sources can be efficiently and effectively identified, reducing search costs.[161] Trade marks also constitute an incentive for consistent quality: a lack of consistent quality can impair goodwill associated with a product.[162] By protecting distinguishing signs, trade mark laws can be linked to justice as they incentivise consistent quality and the development of goodwill by protecting against freeriding. However, trade marks are increasingly valued by trade mark owners for the information they convey about brands, which functions to advertise trade marked goods.[163]

Natural rights support grants of intellectual property where there is sufficient labour exerted in the creation of intellectual products and granting rights to the labourer does not unjustifiably deplete the public domain or commons.[164] However, characterising trade marks as creations in their own right can be problematic as this ignores the role of consumers and the public in the associations between a mark and a source of goodwill.[165] The owner (often not the creator) also exerts labour in establishing reputation in the mark.[166]

Personality theory characterises intellectual creations as an extension of a person and a means of recognising their significance to personhood, justifying grants of attribution and integrity as a vehicle for the actualisation of the individual.[167] However, the explicit protection that Article 15(1)(c) of the *ICESCR* provides for the moral interests of authors of artistic or literary creations is rarely legally recognised for the authors of trade marks, who frequently create trade marks and assign their interests in those marks to corporations (through specific contract or employment contract).[168]

Social planning theory recognises the role of intellectual property in achieving 'a just and attractive culture'.[169] A trade mark system structured to achieve a just and attractive culture balances the rights of trade mark owners, other traders and competitors, 'stressing the cultural and expressive rights of

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[158] Fisher (n 149) 167–168.
[159] Ibid 169.
[160] Lionel Bently and Brad Sherman, *Intellectual Property Law* (Oxford University Press, 4th ed, 2014) 816; Stacey L Dogan and Mark A Lemley, 'A Search-Costs Theory of Limiting Doctrines in Trademark Law' (2007) 97(6) *Trademark Reporter* 1223.
[161] Landes and Posner, The Economic Structure of Intellectual Property Law (n 153) 173.
[162] Elmer William Hanak, III, 'The Quality Assurance Function of Trademarks' (1974) 43(3) *Fordham Law Review* 301, 363–364, citing Frank I Schechter, 'The Rational Basis of Trademark Protection' (1927) 40(6) *Harvard Law Review* 813, 818.
[163] See Davis (n 104).
[164] Fisher identifies several problems with the application of Lockean theory to intellectual property generally: (n 149) 170, 184–189.
[165] Bently and Sherman (n 160) 815.
[166] See Steven Wilf, 'Who Authors Trademarks?' (1999) 17(1) *Cardozo Art and Entertainment Law Journal* 1, 2.
[167] Fisher (n 149) 171–172.
[168] Genevieve Wilkinson, 'Exploring Moral Interests in the Intellectual Creations underlying Trade Marks' in Ysolde Gendreau (ed), *Research Handbook on Intellectual Property and Moral Rights* (Edward Elgar, forthcoming).
[169] Fisher (n 149) 172–173.

the public in trade marks'.[170] These arguments support limiting expansive rights for trade mark owners as there is a public interest in being able to use culturally significant marks in communication.[171]

Narrow legislative recognition for creators of trade marks in registration systems suggests that natural law and personality theory justifications have limited modern relevance. Social planning theory indicates more recently recognised public interests, which are arguably more consistent with human rights. The 20th century dominance of economic theory persists, but the extent to which it can be used to justify expansion of the rights of owners is controversial.[172] The increased economic value of trade marks and branding has encouraged trade mark owners to protect their property interests assertively.[173] Trade mark interests have increasingly moved away from traditional normative justifications for protection of intangible property towards a property-based justification.

Criticisms of expansion of trade mark rights beyond search costs justifications are often linked to expansion of trade mark protection rights that protect owners against dilution and tarnishment[174] reflecting increasing value on branding and trade marks.[175] Dilution of a mark is alleged to occur if use on unrelated goods or services negatively impacts on the reputation and distinctiveness of the mark.[176] Tarnishment occurs when a mark is associated with another, usually unrelated, good or service in a manner that invites negative associations with the original brand and negatively impacts on the reputation of the mark.[177]

Griffiths argues that a law and economics approach (founded largely in the work of Landes and Posner) is primarily based on the essential function of a trade mark as a guarantee of a specific origin, so that it can simultaneously reduce search costs for consumers and become a focal point for goodwill that can increase economic benefits associated with reputation.[178] An economic argument can be made that blurring or tarnishment protects the communicative function of a trade mark. However, these broader rights should be limited to cases where the expanded protection is a necessary incentive for production, which would improve social welfare sufficiently that it outweighed costs associated with adverse impacts on competition.[179] Griffiths notes that patent and copyright laws focus on balancing incentives against adverse impact, and suggests that overall contribution to social impact and trade mark law should be similarly balanced.[180] Even if trade mark rights are likened to tangible property, the economic justification for extending legal protection would be limited to ensuring 'their effectiveness and reliability as trade marks unless the resulting benefits would outweigh the costs'.[181] Problematically, the costs of these monopolies can expand if owners use letters of demand to make spurious claims against individuals with limited resources and legal knowledge who do not have the capacity to defend themselves, even though their expressive uses of marks are completely defensible.[182]

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[170] Ibid.
[171] Richardson discusses nuances of this argument: see Megan Richardson, 'Trade Marks and Language' (2004) 26(2) *Sydney Law Review* 193, 216–220.
[172] See Andrew Griffiths, 'A Law-and-Economics Perspective on Trade Marks' in Lionel Bently, Jennifer Davis and Jane C Ginsburg (eds), *Trade Marks and Brands: An Interdisciplinary Critique* (Cambridge University Press, 2008) 241; Bently and Sherman (n 160) 816–818.
[173] See Davis (n 104) 97.
[174] Dogan and Lemley (n 160) 1238; Handler (n 99).
[175] Beerline (n 106) 514.
[176] Handler (n 99) 639–640.
[177] Ibid 640.
[178] Griffiths (n 172) 245–255.
[179] Ibid 264.
[180] Ibid.
[181] Ibid 266.
[182] This will be explored in Chapter Four

The utilitarian emphasis of intellectual property on net social welfare encourages the identification of a common goal of human welfare between intellectual property and human rights, which can be linked to justice.[183] Rights that move beyond utilitarian justifications do not necessarily embody social welfare objectives. This is relevant to the legitimacy of such expansion, particularly if it is inconsistent with human rights protection.[184] Broader rights for trade mark owners may also be inconsistent with the underlying rationales for trade mark protection.[185] Expansion of trade mark law in some jurisdictions can influence attempts to enlarge these rights at a multilateral level by forum shifting and including them in plurilateral and bilateral agreements.[186] A strong approach to protecting trade mark rights should be scrutinised. It is only appropriate for certain economic conditions.[187] International obligations that are not sensitive to these local conditions and restrict domestic regulatory autonomy can have a significant impact on a broad range of interests and concerns, including but not limited to sustainable development and human rights.[188]

Expansion of trade mark protection is also significant because of their functional role. While other intellectual property rights stimulate the production of commodities, trade marks are signs that attach to the product themselves.[189] Intellectual property theory emphasises this stimulation function. Machlup and Penrose identify rationales for patents underpinning a utilitarian approach that emphasises the benefits for society of innovation, which becomes public but is protected by patents.[190] Inventors are rewarded for their innovation with a limited patent monopoly; patents provide a monopoly, which enables inventors to profit from their work; or patents are granted in exchange for the disclosure of secrets.[191] Copyright protection similarly encourages creators to share their cultural contributions through publication of work by protecting creators against copying.[192]

Trade marks can support other intellectual property rights by continuing to protect the associated products after the rights expire, but overlapping protection should be carefully scrutinised.[193] The auxiliary function of trade marks can beneficially protect innovative contributions to science and culture that may not easily obtain protection using the mechanisms of copyright and patent protection. However, the auxiliary role of trade marks in expanding the material interests of creators can potentially interfere with a balance of interests provided by other regimes, such as copyright and patent law.[194] Trade mark protection for copyright works that have entered the public domain can

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[183] See Estelle Derclaye, 'Intellectual Property and Human Rights: Coinciding and Cooperating' in Paul Torremans (ed), *Intellectual Property and Human Rights: Enhanced Edition of Copyright and Human Rights* (Kluwer Law International, 2nd ed, 2008) 133.

[184] See J Janewa Osei Tutu, 'Humanizing Intellectual Property: Moving Beyond the Natural Rights Property Focus' (2017) 20(1) *Vanderbilt Journal of Entertainment and Technology Law* 207.

[185] Fisher (n 149) 194–199.

[186] Ong (n 94) 240–248.

[187] Beerline describes amendments to the *Trademark Dilution Revision Act* as a compromise between interests in the United States: Beerline (n 106) 523–524.

[188] Kamperman Sanders and Shabalala (n 118).

[189] Ibid.

[190] Fritz Machlup and Edith Penrose, 'The Patent Controversy in the Nineteenth Century' (1950) 10(1) *Journal of Economic History* 1, 10.

[191] Ibid.

[192] Fisher (n 149) 169, citing William M Landes and Richard A Posner, 'An Economic Analysis of Copyright Law' (1989) 18(2) *Journal of Legal Studies* 325.

[193] Catherine Colston, *Principles of Intellectual Property Law* (Cavendish Publishing, 1999) 31.

[194] In relation to patents and trade marks, see Peter Drahos, 'Negotiating Intellectual Property Rights: Between Coercion and Knowledge' in Peter Drahos and Ruth Mayne (eds), *Global Intellectual Property Rights: Knowledge, Access and Development* (Palgrave Macmillan, 2002) 161, 174–175, citing Joe Staten Bain, *Barriers to New Competition: Their Character and Consequences in Manufacturing Industries* (Harvard University Press, 1956).

undermine user interests by extending restrictions over the relevant material.[195] Trade marks can entrench higher prices for originator pharmaceutical brands after the expiration of patent protection, which arguably interferes with the bargain inherent in the patent monopoly that the public will benefit from the innovation once the monopoly expires.[196] As this bargain often justifies the conferral of intellectual property monopolies, it is an important concern.[197]

<b> 4. Conclusion

International intellectual property law is expanding, but the fragmentation between intellectual property and human rights and the inadequacy of existing dispute mechanisms to support systemic integration makes it difficult to ensure that the expansion reflects normative concerns important to both human rights and intellectual property. The HRATM framework used in this book to ensure recognition for economic, social and cultural rights as well as civil and political rights is designed to be used with existing models to found a global human rights culture for trade marks.[198] This pluralistic, flexible approach is an important foundation for a human rights culture for trade marks that can effectively harmonise the two fields.

Rather than proposing a single harmonising framework, the book expands the literature by assessing the applicability of mechanisms recommended by existing conceptual models to domestic legislation. States should place greater emphasis on recognising economic, social and cultural rights, but should also consider the valuable analytical approaches recommended by existing models conceptualising the relationship between intellectual property and human rights and adapt their use so it is appropriate to their own local conditions. Policymakers need guidance on balancing economic, social and cultural rights with protection of intellectual property rights. The HRATM framework is a significant contribution to recognising the importance of economic, social and cultural rights in their relationship to trade marks but it is only part of the solution. Applying the framework in three case studies demonstrates why protecting, respecting and promoting human rights is critical in domestic trade mark law and in international agreements that protect intellectual property.

The book will assist states to recognise why protecting, respecting and promoting human rights is critical in domestic trade mark law and in international agreements that protect intellectual property. Monitoring serious human rights concerns accompanying domestic implementation of international intellectual property obligations is a necessary step towards founding a globally relevant human rights culture for trade marks and a necessary foundation for transformation of trade mark protection to address associated human rights concerns. The HRATM framework also embeds rights-based principles to support adjustments to trade mark law necessary to realise human rights. This supports proposals for transformation through multilateral agreement and rethinking approaches to negotiating trade agreements in the final part of the book. A human rights culture for trade marks must be dynamic but the foundations explored in this book provide a valuable roadmap for realigning order with justice in domestic protection for trade marks.

For a pertinent discussion of the impact of trade marking materials previously protected by copyright, see Martin Senftleben, 'Vigeland and the Status of Cultural Concerns in Trade Mark Law – The EFTA Court Develops More Effective Tools for the Preservation of the Public Domain' 48(6) *IIC - International Review of Intellectual Property and Competition Law* 683.

[195] See Sentfleben (n 194).

[196] Drahos (n 194) 174–175, citing Bain (n 194).

[197] For example, in relation to patents, see Machlup and Penrose (n 190) 27.

[198] See Ruth Okediji, 'Does Intellectual Property Need Human Rights?' (2018) 50(1) *New York University Journal of International Law and Politics* 1.