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Exploring Moral Interests in the Intellectual Creations underlying Trade Marks¹

Introduction

Intellectual creations underlie inherently distinctive trade marks. The words and images underlying trade marks for famous brands including I love New York, Barbie and Marlboro are intellectual creations of human beings. The inalienable personal link between authors and intellectual objects was recognised in the development of two separate regimes: protection for moral rights in the Berne Convention for the Protection of Literary and Artistic Works (Berne Convention)² and human rights protection for moral interests in the International Covenant on Economic, Social and Cultural Rights (ICESCR).³ The relevance of these two types of protection to trade marks has been underexplored, a reflection of the emphasis historically placed on the commercial function of trade marks. Yet, it is increasingly apparent that trade marks can have moral, cultural and personal significance beyond their commercial significance as indicators of source. This chapter explores examples where parties other than owners of trade marks may have moral rights and interests in respect of trade mark subject matter.

How can moral rights and interests for creators of trade marks be justified? The second part of this chapter considers the drafting history of the two international agreements that can support this protection. These reflect an intention to protect the personal character of creations of the human mind and advance public goals of protecting the integrity of these products and advancing creativity.⁴ The third part of this chapter explores the implications of this for individual and collective human rights. Human rights protection for the moral interests of authors of literary and artistic productions found in the ICESCR⁵ may support authors seeking to control use of words and images underlying trade marks. Protection for moral interests underlies copyright-like rights to attribution and protection from adverse treatment, but does not depend on entitlement to copyright protection and can be used more broadly than copyright-based moral rights to control trade mark use. Human rights protection could also be used to control the content of registered trade marks such as trade marks derived from traditional cultural expressions that have significance for Indigenous persons. The fourth part of this chapter considers the way that the recent *Australia – Tobacco Plain Packaging* decision by the World Trade Organization (WTO) Appellate Body can support states that protect these human rights of Indigenous persons even if this encumber the use of trade marks by their owners.⁶

In many jurisdictions, creators of trade marks that contain subject matter protectable through copyright have entitlements as authors to control some uses of trade mark subject matter that are

¹ Genevieve Wilkinson, Lecturer, University of Technology Sydney. Many thanks to Isabella Alexander, Evana Wright and Louise Buckingham for their very helpful comments on earlier drafts of this chapter.

² *Berne Convention for the Protection of Literary and Artistic Works*, opened for signature 9 September 1886, 2186 UNTS 203 (entered into force 4 May 1896, revised at Stockholm 14 July 1967 and Paris 24 July 1971, amended 28 September 1979) (Berne Convention) art 6bis.

³ International Covenant on Economic, Social and Cultural Rights (opened for signature 16 December 1966, entered into force 3 January 1976) 993 UNTS 3 (ICESCR),) art 15(1)(c) ; Universal Declaration of Human Rights (adopted 10 December 1948) UNGA Res 217 A(III) (UDHR), art 27.

⁴ Committee on Economic, Social and Cultural Rights, 'The Right of Everyone to Benefit from the Protection of the Moral and Material Interests Resulting from Any Scientific, Literary or Artistic Production of which He or She is the Author (article 15, paragraph 1 (c), of the Covenant)' (2005) General Comment No 17 UN ESCOR E/C.12/GC/17; (GC17), para 12.

⁵ International Covenant on Economic, Social and Cultural Rights (opened for signature 16 December 1966, entered into force 3 January 1976) 993 UNTS 3 (ICESCR),) art 15(1)(c).

⁶ Appeal 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 (9 June 2020)) (Appeal Report).

inconsistent with their moral rights to attribution and to protect their works from derogatory treatment.⁷ The fifth section explores this and identifies additional moral rights found in some jurisdictions, to protect from false attribution, when the wrong author is named, and to withdraw a work in certain circumstances, where the authors has assigned alienable property rights but their personal relationship with the work has changed.⁸

⁹ Moral interests and copyright-based moral rights can be used to control trade mark use but this needs to be balanced against other considerations such as protection of freedom of expression. Although there may also be human rights protection available for material interests for some trade mark creators, moral rights and interests should be distinguished from the alienable property interests of corporate trade mark owners, particularly where owners assert broad rights such as entitlements to dilution and tarnishment protection. Dilution and tarnishment can sometimes be likened to moral rights or moral interests to protect trade marks because they are used to protect the reputation or honour of corporate trade mark owners. These rights also engage questions of control over the use of material underlying trade marks. However, dilution and tarnishment protections depend on transferrable economic interests that do not preserve the inalienable personal relationship between human beings and intellectual creations.

Justifications for moral protection of trade mark creators and their influence in international law

As authors, creators of signs that function as trade marks can be entitled to protection of moral rights based in copyright protection or moral interests based in human rights protection. International copyright and human rights law recognised moral protection for authors in 1928 and 1948, respectively. Pre-existing European recognition of moral rights strongly influenced the inclusion of moral rights in the Berne Convention.¹⁰ Rene Cassin, who led the French delegation was influential in debates that resulted in the inclusion of moral protection in the Universal Declaration of Human Rights (UDHR).¹¹ French advocacy for moral protection for authors during the drafting debates reinforces links between moral rights protection and Hegel's personality theory.¹² Hegel's arguments that products of the mind can become intellectual objects and the author has ownership in the property associated with those intellectual objects influenced French protection for authors' rights.¹³ These rights protect intellectual objects as an expression of the author. The author can alienate some property rights, for example by assignment of the right to reproduce the object, but certain rights are inalienable, such as rights of attribution and integrity.¹⁴ Article 6bis of the Berne Convention protects moral rights of attribution and rights of integrity, independent of economic

⁷ GC 17, para 13.

⁸ Graham Dutfield and Uma Suthersanen, *Dutfield and Suthersanen on Global Intellectual Property Law* (Edward Elgar 2020) 134.

⁹ ICESCR, article 15(1)(c); Universal Declaration of Human Rights (adopted 10 December 1948) UNGA Res 217 A(III) (UDHR), art 27.

¹⁰ Elizabeth Adeney, 'The moral right of integrity: the past and future of "honour"', (2005) 2 *Intellectual Property Quarterly*, 111, 113-118.

¹¹ Aurora Plomer, 'The Human Rights Paradox: Intellectual Property Rights and Rights of Access to Science' (2013) 35(1) *Human Rights Quarterly* 143, 167-168.

¹² Maria Green, *Implementation of the International Covenant on Economic, Social and Cultural Rights: Drafting History of Article 15 (1) (c) of the International Covenant on Economic, Social and Cultural Rights. Background Paper*, UN ESCOR, 24th sess, Agenda Item 3, UN Doc E/C.12/2000/15 (9 October 2000) [4]-[7]

¹³ Neil Netanel, 'Copyright Alienability Restrictions and the Enhancement of Author Autonomy: A Normative Evaluation,' (1993) 24(2) *Rutgers Law Journal* 347, 379-382.

¹⁴ Dutfield and Suthersanen (n8) 48-49.

rights.¹⁵ The nature of copyright-based moral rights protection and the type of trade marks that qualify for protection will vary depending on jurisdiction.¹⁶

Human rights law distinguishes between alienable material rights and inalienable moral rights for authors of intellectual objects. Human rights protection available for the moral interests for authors in article 27(2) of the UDHR is reaffirmed in article 15(1)(c) of the ICESCR. Both provisions recognise the rights of everyone to ‘protection of the moral and material interests resulting from any scientific, literary or artistic production of which he is the author’.¹⁷ The French again advocated for the inclusion of these rights in the ICESCR.¹⁸ Drafters intended protection for moral rights to safeguard the ‘intrinsically personal character of every creation of the human mind and the ensuing durable link between creators and their creations’.¹⁹ Green identifies recognition of public goals of ‘encouragement of creativity and the protection for the public of the integrity of finished products were recognized as important public goals’²⁰ during debates about the form of ICESCR article 15(1)(c). Interpreting the right, the Committee for Economic Social and Cultural Rights (CESCR) links material interests to the enjoyment of the right to an adequate standard of living stated that this right is not directly linked to the personality of the creator’.²¹ CESCR explicitly distinguishes Article 15(1)(c) rights from the rights found in intellectual property agreements that can be ‘revoked, licenced or assigned’.²² Material interests of authors may be ongoing but a single instance of remuneration may also satisfy those interests,²³ whilst domestic protection permits intellectual property owners to exploit broad rights within a defined grant of monopoly.²⁴ Although there appears to be more overlap between the examples of moral interests provided by CESCR and copyright protections for moral rights in many jurisdictions,²⁵ there are important differences in relation to scope of protection and eligibility for protection. For example, terms of moral interest protection will vary. Although the Berne Convention only requires moral rights protection for a term no shorter than the legislative protection subsisting for economic rights,²⁶ General Comment 17 recognises the moral interests conferred by ICESCR as enduring.²⁷

Human Rights for Moral Interests and Trade Marks

Human rights protection for authors’ moral interests expands opportunities for control over the use of culturally significant literary and artistic productions in trade marks. Article 15(1)(c) recognises the rights of everyone to ‘protection of the moral and material interests resulting from any scientific, literary or artistic production of which he is the author’. Protected moral interests include attribution rights and rights to object to derogatory actions in relation to productions ‘which would be prejudicial to their honour and reputation’.²⁸ Custodians of traditional knowledge may also be able

¹⁵ Berne Convention, art 6*bis*.

¹⁶ For example, moral rights protection is very limited in the United States, applying only to single copies of visual artwork: 17 U.S. Code S 106A.

¹⁷ ICESCR, art 15(1)(c); UDHR, art 27(2).

¹⁸ Green (n12) paras 22, 27, 35.

¹⁹ GC17, para 12.

²⁰ *Ibid*, para 46.

²¹ *Ibid*, para 12.

²² *Ibid*, para 2. Higher protection standards are permissible ‘provided that these standards do not unjustifiably limit the enjoyment by others of their rights under the Covenant’: GC17, para 11.

²³ GC17 also contemplates a limited duration monopoly for authors: para 16.

²⁴ GC17 states that ‘intellectual property regimes primarily protect business and corporate interests and investments’: para 2.

²⁵ GC17 paras 13-14.

²⁶ Berne Convention, art 6*bis*.

²⁷ GC17, para 12.

²⁸ GC17, para 13.

to use moral interests to ‘prevent the unauthorised use of scientific, literary and artistic productions of indigenous peoples by third parties’.²⁹ CESCR recognises that the realisation of article 15(1)(c) as intrinsically linked to the right to take part in cultural life found in article 15(1)(a).³⁰ The realisation of article 15(1)(c) is also dependent on the enjoyment of other rights including the right to own property, freedom of expression, the right to full development of the human personality and ‘rights of cultural participation, including cultural rights in specific groups.’³¹ Because human rights are indivisible and interdependent, human rights protection for moral interests must be balanced against other considerations such as the freedom of expression interests in permitting criticism of intellectual creations. The interplay of these rights is particularly complex in Europe where fundamental rights protect the right to property for corporate owners.³² Despite this, as Geiger recognises, the rights protected in article 15 need greater protection in European human rights instruments.³³ This should include explicit recognition of moral interests as fundamental rights.

Protection for ‘creations of the human mind’ in ICESCR article 15 ‘seeks to encourage the active contribution of creators to the arts and sciences and to the progress of society as a whole.’³⁴ The significant role of trade marked images and words in culture has been recognised for decades.³⁵ CESCR does not exhaustively define literary productions but interprets it to include poems, novels and paintings.³⁶ This means that article 15 has the potential to expand the kinds of things that could merit protection for moral interests beyond copyright works. One example could be the case of a highly distinctive word or short phrase. Attempts to use copyright to protect trade marks have failed on the basis that single word marks are too ‘trivial’ to meet protection thresholds;³⁷ only *obiter dicta* has contemplated that copyright protection may be available for distinctive titles.³⁸ Accordingly, protection for word marks is unlikely unless the words form part of a composite trade mark.³⁹ However, if a highly distinctive word mark constituted a ‘literary production’ within the meaning of ICESCR, protection of its author may be consistent with the objectives of encouraging creators to contribute to the arts and social progress.⁴⁰

The interpretation of moral interests by CESCR in General Comment 17 acknowledges that some protection for moral interests already exists in domestic legislation.⁴¹ However, CESCR also separates human rights protection for both moral and material interests from intellectual property protection for both agreements and domestic law.⁴² This is important for individuals and groups that are

²⁹ Ibid, para 32.

³⁰ Ibid, para 4.

³¹ Ibid.

³² *Anheuser-Busch Inc v Portugal* (2007) 44 EHRR 42, IHRL 3436 (ECHR).

³³ Geiger argues that fundamental protection for property should be broadened to consider Article 27/15: 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.

³⁴ GC17, para 4.

³⁵ Rosemary Coombe, *The Cultural Life of Intellectual Properties: Authorship, Appropriation and the Law* (Duke University Press 1999) 86.

³⁶ GC17, para 9.

³⁷ See *Exxon Corporation v Exxon Insurance Consultants International Ltd* [1982] Ch 119, 136-137 (Stephenson LJ).

³⁸ *Fairfax Media Publications Pty Ltd v Reed International Books Australia Pty Ltd* [2010] FCA 984, para 46.

³⁹ *Advantage-Rent-A-Car Inc v Advantage Car Rental Pty Ltd* (2001) 52 IPR 24.

⁴⁰ In human rights, culture is not defined qualitatively, so there is no reason that the cultural contribution of trade marks should be excluded from protection. See Janewa Osei Tutu, ‘Corporate “Human Rights” to Intellectual Property Protection?’ (2015) 55 Santa Clara Law Review 1, 47.

⁴¹ GC17, para 14.

⁴² Ibid, paras 2-3.

excluded from domestic moral rights protection because it is linked to eligibility for copyright protection.⁴³ In Australia, moral rights protection implementing the Berne Convention is part of copyright legislation that primarily protects economic interests of copyright owner.⁴⁴ The term of protection for literary and artistic works extends until 70 years following the death of the author.⁴⁵ This contrasts to the obligation in ICESCR article 15 for states to provide enduring protection for moral interests, to ensure a 'durable link between creators and their creations'.⁴⁶

Recognition of group or community ownership of enduring moral interests in literary and artistic productions could support efforts to protect traditional cultural expressions by custodians of traditional knowledge. Traditional cultural expressions may include 'art, designs, names, signs and symbols'⁴⁷ but it can be difficult for traditional owners to protect them effectively through intellectual property structures that only recognise fixed expressions and require clear identification of authors or owners.⁴⁸ Trade mark protection can sometimes be used to control use of signs and prevent others from using them commercially. However, this often requires not only ongoing commercial use by the custodians of traditional cultural expressions but establishing first commercial use for relevant goods or services if another party has appropriated that mark. Although the US Patent and Trade Mark Office has a list of traditional insignia that can be used to restrict domestic registration of these signs by unauthorised parties, this does not protect many traditional cultural expressions.⁴⁹ The situation is even more complex if public authorities appropriate traditional cultural expressions. The Zia are Indigenous persons historically residing in New Mexico in the United States. They are well-known for their pottery and their distinctive sun symbol that is used in ceremonial activities.⁵⁰ The Sun symbol was depicted on the flag of Madison, the capital city of Wisconsin, from 1962.⁵¹ Although it was removed in 2018 in response to concerns regarding the cultural appropriation of the sacred symbol,⁵² the Sun symbol remains featured in the flag of New Mexico and this restricts the ability of the Zia people to obtain trade mark registration.⁵³ Requirements of commercial use further restrict the ability of the Zia to register related symbols.⁵⁴ In other jurisdictions, traditional knowledge custodians have been able to use trade mark registration defensively to restrict use of these types of symbols⁵⁵ but this type of protection is not always available or appropriate.⁵⁶

⁴³ *Bulun Bulun v R & T Textiles Pty Ltd* [1998] FCA 1082.

⁴⁴ Francina Cantatore and Jane Johnston., 'Moral rights: Exploring the myths, meanings and misunderstandings in Australian copyright law' (2016) 21 *Deakin Law Review* 71, 74-75.

⁴⁵ Copyright Act 1968 (Cth) s 33.

⁴⁶ GC17, para 12.

⁴⁷ World Intellectual Property Organization, 'Traditional Cultural Expressions' <<http://www.wipo.int/tk/en/folklore>>.

⁴⁸ Dalindyabo Bafana Shabalala 'Intellectual Property, Traditional Knowledge, and Traditional Cultural Expressions in Native American Tribal Codes,' (2017) 4(5) *Akron Law Review* 1125, 1133-1134.

⁴⁹ Stephanie B. Turner, 'The Case of the Zia: Looking Beyond Trademark Law to Protect Sacred Symbols,' (2012) 11 *Chicago -Kent Journal of Intellectual Property* 116, 130.

⁵⁰ *Ibid*, 119-120.

⁵¹ Logan Wroge, 'Madison City Council approves modified flag design', *Wisconsin State Journal* (24 July 2018) https://madison.com/wsj/news/local/govt-and-politics/madison-city-council-approves-modified-flag-design/article_1d486328-1424-5693-9a50-2299097f545b.html

⁵² *Ibid*.

⁵³ Turner (n49), 121-122, 124.

⁵⁴ *Ibid*.

⁵⁵ See Michael Brown *Who Owns Native Culture* (Harvard University Press 2003) 83-87.

⁵⁶ See Susy Frankel, 'Trademarks and Traditional Knowledge and Cultural Intellectual Property Rights' in Graeme B Dinwoodie and Marc D Janis (eds), *Trademark Law and Theory: A Handbook of Contemporary Research* (Edward Elgar, 2008) 433.

Protection against inappropriate use of traditional cultural expressions using intellectual property is very limited in Australia: an opposition to the registration of the Yugumbah word for koala, Borobi, for use in relation to the 2018 Commonwealth Games Corporation in Brisbane highlighted that there is no requirement in Australian trade mark law for the applicant to consult with relevant parties when using a traditional cultural expression.⁵⁷ Although consultation with traditional owners had occurred so that consent could be obtained, the opposition evidenced dispute about the validity of this consent within the Yugumbah people.⁵⁸ The Australian trade mark system is not structured to adjudicate these concerns, and nor is the copyright regime - a 2003 bill to introduce communal moral rights protection for Indigenous persons never became law.⁵⁹ By contrast, in New Zealand, trade mark legislation recognises that certain marks should not be registered because they are offensive; a Maori Advisory Board advises the Trade Marks Commissioner on what is offensive to Maori.⁶⁰ The legislation does not explicitly recognise ICESCR obligations but the operation of the board can protect the moral interests of indigenous peoples.

Drawing upon the concept of moral interests found in the ICESCR could offer a better solution for traditional knowledge custodians wishing to contest offensive use of traditional cultural expressions in trade marks.⁶¹ Marketing activities of tobacco companies have highlighted the potential need to assert moral interests against corporate actors to protect traditional cultural expressions. In 2005, Philip Morris launched a cigarette brand called Maori Mix in Israel. The package displayed 'quasi-Maori' images.⁶² This generated complaints from Maori representatives and ultimately the company apologised.⁶³ Asserting obligations to comply with ICESCR article 15 obligations could strengthen similar complaints in the future.⁶⁴ Recognition that these types of uses of artistic productions are derogatory actions that are inconsistent with moral interests of Indigenous communities could become a powerful tool to safeguard expressions of cultural heritage and traditional knowledge from exploitative, unauthorised uses.⁶⁵ Recognising these interests within a human rights framework means that they can be balanced against other important interests such as freedom of expression.

Moral aspects of trade marks and *Australia – Tobacco Plain Packaging*

Another area in which moral interests may also be relevant is in relation to trade law disputes about intellectual property. Several aspects of the recent decision of the WTO Appellate Body in *Australia – Tobacco Plain Packaging* suggest that states could use human rights obligations to justify restricting

⁵⁷ *Jabree Ltd v Gold Coast 2018 Commonwealth Games Corporation* (2017) 132 IPR 80; [2017] ATMO 156.

⁵⁸ *Ibid.*

⁵⁹ See criticisms of the proposal in Jane Anderson, 'The Politics of Indigenous Knowledge: Australia's Proposed Communal Moral Rights Bill' (2004) 27 *University of New South Wales Law Journal*, 585.

⁶⁰ Section 17(1)(b)(ii) of the Trade Marks Act 2002 (N.Z.). See Susy Frankel, *Third-Party Trade Marks as a Violation of Indigenous Cultural Property: A New Statutory Safeguard*, (2005) 8 *Journal of World Intellectual Property* 83, 89-91. Inconsistency with the ground for objection can also support revocation proceedings commenced by culturally aggrieved parties: Trade Marks Act 2002 (N.Z.). s73(1).

⁶¹ Brown (n 55) 69-87; Turner (n49) 121-122, 124.

⁶² A van der Sterren, EM Greenhalgh, D Knoche and MH Winstanley, '8.12 The tobacco industry and Indigenous communities' in MM Scollo and MH Winstanley, MH (ed) *Tobacco in Australia: Facts and issues* (Cancer Council Victoria, 2016) Available from <<https://www.tobaccoinustralia.org.au/chapter-8-aptsi/8-12-the-tobacco-industry-and-indigenous-communiti#x6>>.

⁶³ ABC news, 'Philip Morris pulls Maori Mix cigarettes' (28 April 2006) <<https://www.abc.net.au/news/2006-04-28/philip-morris-pulls-maori-mix-cigarettes/1740882>>.

⁶⁴ GC17 recognises that states are obliged 'to ensure the effective protection of the moral and material interests of authors against infringement by third parties:' para 32.

⁶⁵ Williams-Davidson identifies demoralising impact of reproduction of cultural objects on Indigenous persons: Terri-Lynn Williams-Davidson, *Sacred Objects, Art and Nature in a Global Economy*, in *Paradigm Wars: Indigenous Peoples' Resistance to Globalization* 98 (Jerry Mander & Victoria Tauli-Corpuz eds., 2006).

the rights of trade mark owners to protect moral interests in the future.⁶⁶ This could support legislation addressing moral interests related to uses of traditional cultural expressions in trade marks.⁶⁷

In *Australia – Tobacco Plain Packaging* the Appellate Body considered Australian plain packaging legislation that requires standardised packaging of all tobacco products that includes very visible graphic health warnings.⁶⁸ The requirements only permit the use of work marks in standardised font, where they are used to indicate the source of origin of the product; they do not permit trade mark owners to use trade marks on packaging where they are images or device marks that combine images and text.⁶⁹ The complainants unsuccessfully argued that these requirements were contrary to the prohibition on special requirements on the use of trade marks found in article 20 of TRIPS.⁷⁰ The Appellate Body confirmed the earlier Dispute Settlement Body Panel decision that Australia did not breach the provision. Although the trade mark requirements imposed by Australia's plain packaging measures did constitute special requirements that encumbered the use of the relevant trade marks in the course of trade, TRIPS only prohibits such requirements where they are imposed unjustifiably.⁷¹

The Appellate Body recognised the Panel's assessment that the special requirements on the use of trade marks in the course of trade were "far reaching".⁷² In making this assessment, the Panel found that the relevant interests of the trade mark owner were not limited to the use of the trade mark to distinguish goods from other goods but included economic interests such as communication of the 'tangible or intangible benefits' of a product.⁷³ The interpretation of article 17 in *EC – Trade Marks and Geographical Indications (United States)* provided contextual guidance for this assessment.⁷⁴ In that complaint the Panel interpreted the interests protected by article 17 to include the trademark owner's legitimate interest 'in the economic value of its mark arising from the reputation that it enjoys and the quality that it denotes'.⁷⁵ These broader economic interests were also relevant to the weighing and balancing assessment of the nature of the encumbrances on trade mark use that resulted from Australia's plain packaging measures. However, using TRIPS Article 7 and 8, the Panel recognised that societal interests are relevant to determining whether the measures were unjustifiable.⁷⁶ Australia's public health justifications for applying these encumbrances to protect

⁶⁶ Christophe Geiger & Luc Desautettes-Barbero, 'The Revitalisation of the Object and Purpose of the TRIPS Agreement: The Plain Packaging Reports and the Awakening of the TRIPS Flexibility Clauses', Centre for International Intellectual Property Studies (CEIPI) Research Paper No. 2020-01, available at SSRN: <https://ssrn.com/abstract=3556585>. Forthcoming in: J. Griffiths and T. Mylly (eds), *Constitutional Hedges of Intellectual Property* (Oxford University Press 2020) 45.

⁶⁷ Protection of copyright-based moral rights found in the Berne Convention is expressly excluded from the TRIPS Agreement: *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') art 15 ('TRIPS') art 9(1).

⁶⁸ Tobacco Plain Packaging Act 2011 (Cth) s 21.

⁶⁹ *Ibid* s 20.

⁷⁰ Appeal Report, para 7.13

⁷¹ TRIPS, art 20.

⁷² Appeal Report, para 6.675.

⁷³ Panel Report, 'Australia – Certain Measures Concerning Trademarks, Geographical Indications and Other Plain Packaging Requirements Applicable to Tobacco Products and Packaging' (June 2018) WT/DS435/R, WT/DS441/R, WT/DS458/R, WT/DS467/R (Panel Report), para. 7.2562.

⁷⁴ Panel Report, para 7.2562.

⁷⁵ Panel Report, *European Communities – Protection of Trademarks and Geographical Indications for Agricultural Products and Foodstuffs. Complaint by Australia*, WTO Doc WT/DS290/R (15 March 2005) para 7.664.

⁷⁶ Panel Report, para 7.2404, Appeal Report, para 6.660.

health and life as part of a comprehensive tobacco control regime were sufficiently supported societal interests so they were not unjustifiable, despite the extensive nature of the encumbrance.⁷⁷ The importance of Australia's public health objective was further supported by the fact that plain packaging measures were developed consistently with the 'emerging multilateral consensus' evident from the Framework Convention on Tobacco Control (FCTC).⁷⁸ Australia explicitly recognised its obligations as a party to the FCTC in the objectives clause of the primary legislation use to implement tobacco plain packaging measures.⁷⁹

This decision can support protection of indigenous moral interests, where traditional cultural expressions underlie trade marks and WTO members develop mechanisms to control use of trade marks that is offensive to Indigenous persons. Even where a sophisticated system for protecting traditional cultural expressions in registrations exists, as it does in New Zealand, there is still potential that a mark may be registered but its use in certain circumstances may be offensive.⁸⁰ Whilst such use could support a revocation proceeding, this may be unappealing as it requires lengthy and expensive litigation or inappropriate as there is a long history of inoffensive use.⁸¹ A complaint mechanism for culturally aggrieved groups about such use could strengthen protection for moral interests for Indigenous persons.⁸² An advisory body could assess use in these circumstances and provide rulings recommending changes to use. Requiring owners to implement such rulings could result on encumbrances on the use of trade marks. However, a mechanism that protects the moral interests of Indigenous persons can also be consistent with the protection of societal interests by WTO members and justify encumbrances on the use of trade marks. Although Articles 7 and 8 provide guidance for the content of these societal interests, societal interests are not restricted to 'measures necessary to protect public health and nutrition, and to promote the public interest in sectors of vital importance to their socio-economic and technological development'.⁸³ As Australia used the FCTC as further support for its public health objectives, a WTO member could explicitly recognise that measures providing Indigenous persons with greater control over use of traditional cultural expressions in trade marks implements ICESCR article 15 obligations.⁸⁴ Further support is available for this position from the United Nations Declaration on the Rights of Indigenous Persons (UNDRIP). UNDRIP recognises the rights of indigenous peoples over traditional cultural expressions (Article 31) and manifestations of their cultures (Article 11).

⁷⁷ Appeal Report, para 6.699.

⁷⁸ Ibid, para 6.706. WHO Framework Convention on Tobacco Control (opened for signature 21 May 2003, entered into force 27 February 2005) 2302 UNTS 166 (FCTC)The FCTC Guidelines recognise the relevance of tobacco packaging to tobacco control measures: WHO FCTC, Conference of the Parties, *Guidelines for Implementation of Article 11 of the WHO Framework Convention on Tobacco Control (Packaging and Labelling of Tobacco Products)*, Decision FCTC/COP3(10) (2 November 2008).

⁷⁹ Tobacco Plain Packaging Act 2011 (Cth), s 3.

⁸⁰ *Jabree Ltd v Gold Coast 2018 Commonwealth Games Corporation* (2017) 132 IPR 80 indicates that even where consent for registration has been given, there may be unanticipated use that needs to be regulated, or concerns about the nature of that consent.

⁸¹ Waikato argues that such actions are unlikely to result in revocation of established marks: Tania Waikato, 'He Kaitiaki Mātāwhiri: Building a protection regime for Māori traditional knowledge' (2005) 8.2 *Yearbook of New Zealand Jurisprudence* 344.

⁸² Senftleben gives examples where this mechanism could also be relevant for non-Indigenous persons who can demonstrate that the cultural impact of a trade mark poses significant cultural concern. 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' (2017) 48(6) *IIC-International Review of Intellectual Property and Competition Law*, 683-720.

⁸³ Panel Report, para. 7.2406. Article 7 recognises that the 'protection and enforcement of intellectual property shall contribute to.. a balance of rights and obligations': TRIPS art 7.

⁸⁴ The protection provided for traditional knowledge in UNDRIP is also relevant: G.A. Res. 61/295, United Nations Declaration on the Rights of Indigenous Peoples 4 (Oct. 2, 2007) at 11.

Navigating the complexities of copyright-based moral rights protection for individual trade mark creators

Individuals who author artistic or literary productions underlying trade marks may also assert moral interests in those works and may be able to rely on domestic copyright protection for moral rights. The extent to which this protection is consistent with the objective of human rights protection for moral interests of encouraging creators to contribute to the arts and social progress will vary, depending on the circumstances surrounding the creation of that trade mark. This can influence the extent to which those moral interests could be protected if they conflicted with other human rights such as the right to freedom of expression. Although it is assumed that many creators of trade marks contractually assign their moral rights in associated works to those who commission their creation, there are other circumstances where an author may claim a more meaningful connection with the work underlying a trade mark as an intellectual creation. In some cases, an author's work may be used as a trade mark after copyright expires and that use can arguably conflict with the deceased author's moral interests.⁸⁵ In other cases, a living author may claim that their work contributes to the arts and social progress.

Milton Glaser is an exceptional example of a well-known trade mark creator. He created the famous I (heart logo) NY trade mark for the City of New York in the late 1970s. He did not accept payment for the underlying artwork and is not a registered owner; he created it to support New York tourism during a difficult economic period.⁸⁶ If a pro-gun lobby commissioned an artist to use Glaser's iconic logo and replaced the heart logo with a gun logo, Glaser would not have standing in trade mark law to object to subsequent use of his work to promote the gun lobby. Nor would American moral rights protection for visual artists protect Glaser, as this only protects artworks that exist in single copy.⁸⁷ If his moral rights were protected, Glaser could contest this gun artwork as a distortion of his drawn logo.⁸⁸ In a different jurisdiction,⁸⁹ he might have a strong argument that the derivative artworks breaches his moral right in the integrity of his artistic work because the gun artwork undermines the purpose of his expression, celebrating New York, in a manner that is particularly offensive to him and detrimental to his honour or reputation.⁹⁰ However, although other jurisdictions permit copyright-based protection for moral rights, creators often remain unknown and their invisibility makes it difficult to respect their personality rights as authors. Glaser is an exceptional example of a well-known trade mark creator.

To explore the way that domestic moral rights protection found in domestic copyright law can protect moral rights for creators of trade marks that constitute artistic works, this section focuses on the intellectual property law of Australia, a common law country with an IP system that was originally influenced by English law. It investigates barriers to copyright-based protection of moral

⁸⁵ It is beyond the scope of this chapter to discuss the complex issues raised by cumulative protection of copyright and trade mark rights. See Senftleben (n82).

⁸⁶ When Glaser later created a derivative 'I [heart symbol] New York more than ever' following 911 and permitted use of the derivative for fundraising he was threatened with an intellectual property infringement by the City of New York: Chip Kidd, 'An interview with Milton Glaser' (1 September 2003) <<https://believermag.com/an-interview-with-milton-glaser/>>

⁸⁷ 17 U.S. Code § 101 – Definitions.

⁸⁸ 17 U.S. Code § 106A(a)(3)(A).

⁸⁹ See, for example, Copyright Act 1968 (Cth), s 195AQ.

⁹⁰ Glaser has also created artwork that criticised federal government failures to reform gun laws. Joe Nocera, 'The Gun Report – April 19 2013' (19 April 2013) <<https://web.archive.org/web/20130422085919/https://nocera.blogs.nytimes.com/2013/04/19/the-gun-report-april-19-2013/>>.

rights for trade mark creators in Australia. These include the practice of not protecting copyright in words or short titles, the absence of an effective mechanism for attribution for creators of trade marks and the likelihood that where trade marks are created in a commercial environment, business efficacy will strongly influence a standard practice of waiver of moral rights for trade mark creators.

The *Copyright Act 1968 (Cth)* provides moral rights protection for authors of literary or artistic works.⁹¹ A trade mark that constitutes an artistic work, such as a logo that includes artistic material,⁹² is likely to entitle its creator to moral rights protected through copyright. The threshold for protection for relevant artistic works such as drawings and paintings does not require an assessment of artistic merit.⁹³ In contrast, thresholds for protection of literary works mean that word trade marks are rarely considered to constitute literary works: protection of single word marks has been rejected.⁹⁴ It is possible that a title may reach a threshold of originality that entitles it to copyright protection but protection is much more certain for trade marks containing artistic works.⁹⁵

In Australia, moral rights were introduced to ensure consistency with the Berne Convention⁹⁶ and correspond to the term of copyright.⁹⁷ Moral rights are only conferred on individuals and cannot be assigned to other parties.⁹⁸ An author must be identified whenever an artistic work is reproduced or communicated⁹⁹ and an individual is also entitled not to have authorship of works falsely attributed to them.¹⁰⁰ However, it is not an infringement if the alleged infringer can establish that it was reasonable not to identify the author of an artistic work.¹⁰¹ The function of trade marks as symbols that reduce search costs for consumers¹⁰² and the industry practice of not identifying the creators of trade marks make it likely that attribution would not be considered reasonable where trade marks contained artistic works.¹⁰³

Rights of integrity permit a holder of moral rights 'to prevent derogatory treatment of a work that is detrimental to their honour or reputation'¹⁰⁴ unless they give consent or the treatment is found to be reasonable in the circumstances. Derogatory treatment includes material distortion or mutilation of the work that is prejudicial to the author's honour or reputation, exhibition in a context that prejudices the author's honour or reputation and 'the doing of anything else in relation to the work

⁹¹ Copyright Act 1968 (Cth) Part IX.

⁹² Device marks composed of words and images were found to constitute protectable artistic works in *Aussie Home Loans v Phillips* (1998) 40 IPR 392 and *Advantage-Rent-A-Car Inc v Advantage Car Rental Pty Ltd* [2001] FCA 683.

⁹³ Copyright Act 1968 (Cth), s 10. However, a logo containing only stylised text was too 'trivial' to qualify for protection in *Cortis Exhaust Systems Pty Ltd v Kitten Software Pty Ltd* (2001) ATPR 41-837 at [33] per Tamberlin J.

⁹⁴ *Exxon Corporation v Exxon Insurance Consultants International Ltd* [1982] Ch 119, 143 (Stephenson LJ).

⁹⁵ In *Fairfax Media Publications Pty Ltd v Reed International Books Australia Pty Ltd*, Bennett J recognised copyright might be possible in a title but did not find copyright in the newspaper titles under consideration: [2010] FCA 984, para 46.

⁹⁶ Copyright Amendment (Moral Rights) Bill 1999 Revised Explanatory Memorandum.

⁹⁷ Copyright Act 1968 (Cth), s 195AM (except for cinematographic films).

⁹⁸ *Ibid*, ss 190, 195AN(3).

⁹⁹ *Ibid*, (Cth), s 195AO.

¹⁰⁰ *Ibid*, (Cth) s 195AP.

¹⁰¹ *Ibid*, s 195AR.

¹⁰² William M Landes and Richard A Posner, *The Economic Structure of Intellectual Property Law* (Harvard University Press 2003) 172, 166–168.

¹⁰³ Copyright Act 1968 (Cth), s 195AR. Industry practice is reflected in registration harmonisation treaties such as the Trademark Law Treaty that only recognise owners, not authors: *Trademark Law Treaty*, opened for signature 27 October 1994, 2037 UNTS 35 (entered into force 1 August 1996).

¹⁰⁴ Copyright Act 1968 (Cth), s 195AQ (2)

that is prejudicial to the author's honour or reputation'.¹⁰⁵ It may be difficult to establish prejudice to the reputation of a trade mark author if they are unknown. However, damage to honour extends beyond reputational harm; Adeney argues that the drafters of the Berne Convention intended it to be read broadly.¹⁰⁶ Prejudice is determined both subjectively, considering the author's response to the use, and objectively, considering the reasonableness of that response.¹⁰⁷ Defences to breach of moral rights consider the reasonableness of the alleged breach.¹⁰⁸ Assessments of reasonableness include considerations of the nature and purpose of the work; the manner and context in which the work is used; the industry practice relevant to the work or its use; any circumstances of employment surrounding use of the work and the views of the treatment by other authors, where there is more than one.¹⁰⁹

Considerations such as the manner and context in which the work can be important if it is necessary to balance moral concerns against other interests such as freedom of expression interests: irreverently referencing well-known trade marks can be an important part of cultural dialogue.¹¹⁰ If Glaser could assert a moral interest to stop the use of his logo by the pro-gun parodist, the parodist may argue that this restricts freedom of expression and it will be necessary to assess whether protection of Glaser's interests is a necessary, direct and proportionate restriction.¹¹¹ A necessary restriction to protect the rights of Glaser needs to be for a legitimate purpose.¹¹² If protection of Glaser's interest could be achieved in other ways, it may be unnecessary. Any restriction must also be proportionate and there must be a 'direct and immediate connection between the expression and the threat'.¹¹³ This assessment requires an understanding of the precise nature of the threat. Multiple considerations are likely to be relevant. If the creator of a trade mark is hired to create a commercial work for a specific brief, it is less likely that they will view their work as an intellectual creation and any moral interest may be weak. Glaser's purpose is more difficult to categorise as it was both commercial and altruistic. If the moral interest is strong, restricting parodies of the logo may be proportionate because there are alternative ways to express an opinion about gun control that do not impact the integrity of the work.

The fact that there are barriers to effective protection of attribution rights for the creators of trade marks does not mean that copyright-based moral rights protection is not justified. The Milton Glaser example suggests that there will be situations where there is an enduring personal connection between an author and their work as an expression of themselves, even though the work is used to signify origin in trade. In these cases, the protection of moral rights for creators of trade marks that constitute artistic works fit with personhood based justifications for preserving the integrity of a work. The recognition that industry practice is relevant in defences to breaches does not mean that industry practice necessarily results in adequate protection of the moral rights of authors.¹¹⁴ It may

¹⁰⁵ Ibid 195AK.

¹⁰⁶ Adeney, (n10) 123.

¹⁰⁷ This approach was taken in *Perez v Fernandez* [2012] FMCA 2, paras 60-65. See Dennis ['Prejudice to Honour or Reputation in Copyright Law' \(2007\) 33\(2\) Monash University Law Review 290](#).

¹⁰⁸ Copyright Act 1968 (Cth) s 195AS.

¹⁰⁹ Ibid, s 195AS.

¹¹⁰ See Genevieve Wilkinson 'Mitey Marks and Expressive Uses of Culturally Significant Trade Marks in Australia' (2019) 30(1) *Australian Intellectual Property Journal* 46.

¹¹¹ UN Human Rights Committee, *General Comment No 34 – Article 19: Freedoms of Opinion and Expression*, 102nd sess, UN Doc CCPR/C/GC/34 (12 September 2011) (GC34), para 22.

¹¹² Ibid, para 33.

¹¹³ Ibid, paras 34-35.

¹¹⁴ See criticism of Australian industry practice for moral rights protection for authors of literary works: Cantatore and Johnston (n44) 71.

be reasonable to change the operation of the law so that authors of trade marks can be more easily identified.

One way of doing this could be through the trade marks register. Copyright does not require registration in Australia but this should not mean that creators of trade marks who are entitled to moral rights protection should not be able to register their authorship through the trade mark register, in much the same way that an inventor of a patentable invention is recorded on the Australian patent register.¹¹⁵ It seems probable that trade mark owners would generally wish to obtain a moral rights waiver from the creator of the trade mark at the same time that they obtain an assignment or licence of the economic rights in any copyright work subsisting in the trade mark.¹¹⁶ This information could be recorded on the register. This might also encourage both parties to turn their mind to the need for a waiver or the consequences of that waiver.¹¹⁷ The current practice of not systematically identifying these authors may present problems both for authors and for derivative users. Derivative users like parodists may use trade marks for social commentary but may not intend to offend the honour of the trade mark author, nor be involved in lengthy court proceedings disputing moral right entitlements. However, it is difficult to understand the connection that creators of trade marks feel to their work when industry practice means that they remain largely invisible.

Do corporate trade mark owners possess moral rights?

The broad economic interests of trade mark owners in many jurisdictions should remain clearly distinguished from claims of moral rights or moral interests for trade mark creators. For well-known marks, owners' trade mark rights have expanded beyond the traditional protection available to exclude third parties from using similar marks on similar goods.¹¹⁸ In Australia, protection against confusing use remains the focus of trade mark legislation,¹¹⁹ but in other jurisdictions including Europe and the United States, trade mark owners have broader rights to restrict non-confusing uses of their marks and some authors have characterised these as moral rights for trade mark owners.¹²⁰ Protection exists for owners to restrict dilution of a mark (also known as dilution by blurring) when a well-known mark is used on unrelated goods or services in a manner that negatively impacts on the reputation and distinctiveness of the mark.¹²¹ Tarnishment (also known as dilution by tarnishment) is alleged to occur when a mark is associated with another, usually unrelated, good or service in a

¹¹⁵ Patent Act 1990 (Cth) s15. This is consistent with the right of recognition granted in the Paris Convention: *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) art 4*ter*. No analogous right exists for creators of trade marks.

¹¹⁶ *Copyright Act 1968* (Cth) 195AWA.

¹¹⁷ This could have further commercial benefits of prompting trade mark owners to ensure that copyright materials contained in trade marks are properly assigned. For example of problems with failing to assign copyright in a trade mark see *Re State Government Insurance Corporation and State Government Insurance Commission v Government Insurance Office of New South Wales; Gio Holdings Ltd and Gio Life Ltd* [1991] FCA 121 (9 April 1991) French J, para 120.

¹¹⁸ 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, 265.

¹¹⁹ Handler argues this is consistent with TRIPS: Michael Handler, 'Trade Mark Dilution in Australia?' (2007) 70 *Intellectual Property Forum* 36, 37-38.

¹²⁰ Danny Friedmann, *Trademarks and Social Media: Towards Algorithmic Justice* (Edward Elgar Publishing, 2015).

¹²¹ 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.

manner that may not be confusing but arguably invites negative associations with the original brand and negatively impacts on the reputation of the mark.¹²² These actions protect the material interests of trade mark owners who are often corporations.¹²³ Hegel's theories have been used to argue that, as symbols of a corporation's personality, trade mark rights should be broadly protected.¹²⁴ Friedmann proposes expansion of rights protecting mark integrity to grant owners a 'moral right' to integrity for their trade marked logos that would prevent any unauthorised uses of those marks in social media, even if those marks were used for expressive rather than commercial purposes and even if they did not result in confusion.¹²⁵ Such attempts to use personhood theories to support broad trade mark rights for corporate trade mark owners fail to recognise the emphasis on the individual author in both the Berne Convention and the ICESCR. Even if claims that the limited grant of personhood for corporations mean that personhood theory can also justify rights for corporate trade mark owners,¹²⁶ this is relevant only to material interests and should not be extended to justify moral rights or moral interests for corporate owners.¹²⁷

The grant of inalienable moral rights or protection for moral interests to authors recognises an enduring personal link between the author and the work itself.¹²⁸ Trade mark rights may be enduring for a corporate owner, but that is dependent on use.¹²⁹ Unlike an author with inalienable moral rights or the custodian of those rights, an owner of a trade mark can assign their rights in many jurisdictions without assigning goodwill attached to the mark.¹³⁰ The 'personal' connection between a company and a trade mark largely depends on whether or not it is economically beneficial to use the mark and the connection to be maintained. The attitude of Mattel to Aqua's references to the Barbie trade mark in their song 'Barbie Girl' highlights this economic interest. In *MCA Records*, Mattel unsuccessfully alleged dilution and tarnishment of their trade mark by Aqua and its record company, arguing that the song depicted the iconic doll as a vacuous bimbo.¹³¹ Over a decade later, Mattel licenced the song that they had impugned in extensive litigation and used a modified version in advertising and promotion.¹³²

MCA Records illustrates that the human rights implications of trade mark protection are not limited to protection for moral and material interests of authors. Protection for trade mark owners to restrict non-confusing uses of their marks in dilution or tarnishment actions raises complex freedom of expression concerns.¹³³ In 'Barbie Girl', Aqua made expressive use of the well-known Barbie mark

¹²² Ibid 640.

¹²³ Sandra Rierson, 'The Myth and Reality of Dilution' (2012) 11(2) *Duke Law & Technology Review* 212, 279-281.

¹²⁴ Richard Spinello 'Online Brands and Trademark Conflicts' (2006) 16(3) *Business Ethics Quarterly* 343, 351-354. See Justin Hughes, 'The Philosophy of Intellectual Property,' (1988) 77(2) *Georgetown Law Journal* 287, 353-354.

¹²⁵ Danny Friedmann, (n120).

¹²⁶ Spinello (n124), 352-353.

¹²⁷ Rierson argues that the introduction of laws protecting dilution in the United States relates directly to the economic-based power of owners of well-known trade marks: (n123) 281.

¹²⁸ GC17, para 2.

¹²⁹ See for example, non-use provisions for removal of unused marks in Trade Marks Act 1995 (Cth) Part 9.

¹³⁰ TRIPS article 21 explicitly permits this but some jurisdictions, including the United States, do not: Robert Burrell and Michael Handler, *Australian Trade Mark Law* (OUP, 2nd edition, 2016) 521.

¹³¹ *Mattel Inc v MCA Records Inc* 296 F.3d 894 (9th Cir. 2002).

¹³² Robert Burrell and Dev Gangjee, 'Trade Marks and Freedom of Expression: A Call for Caution' (2010) 41(5) *International Review of Industrial & Copyright Law* 544, 551.

¹³³ See Megan Richardson, 'Trade Marks and Language' (2004) 26(2) *Sydney Law Review* 193, 195, 217-220; Jason Bosland, *The Culture of Trade Marks: An Alternative Cultural Theory Perspective* (2005) 10 *Media & Arts Law Review* 99.

to comment on gender stereotypes promoted by the popular toy.¹³⁴ Expressive use of a mark occurs when someone uses or references the mark for a purpose other than distinguishing the goods or services from those of others.¹³⁵ Spence argues that there is a speech based justification for permitting a trade mark owner to maintain the distinctive characters of the mark by restricting some types of allusions (although others must still be able to comment on the mark).¹³⁶ If the meaning of the mark becomes unstable, the commentary may be less effective.¹³⁷ However, protecting a stable meaning of a famous trade mark so that it can be used effectively in cultural dialogue may restrict the freedom of expression rights of expressive users. Even if trade mark rights can support speech, these rights must still be consistent with permissible restrictions on commercial speech.¹³⁸ A trade mark monopoly restricts the ability for others to use that mark and that restriction must be necessary and proportionate, consistent with the permissible limitations found in Article 19 of the International Covenant on Civil and Political Rights (ICCPR).¹³⁹ Restricting unauthorised use by third parties may be permissible as protection for the 'rights of others' because it prevents confusing uses of speech in the marketplace but that restriction must be necessary and proportionate.¹⁴⁰ Although *MCA Records* demonstrates that freedom of expression interests may be recognised eventually, the nature of lengthy dilution and tarnishment actions place strong emphasis on the protection of owner interests.¹⁴¹

Protection for non-confusing uses where there are significant resources disparities between trade mark owners and expressive users may operate to enable trade mark owners to assert rights that are not necessary, direct and proportionate restrictions on freedom of expression.¹⁴² Expressive use was made of the Marlboro trade mark on a Tshirt available for sale in the United States that depicted an image of a tobacco packet with design elements distinctive to Marlboro trade marked cigarettes but replaced the word Marlboro with death, using the same font.¹⁴³ The relevant trade marks were the vector logos that were modified to resemble dripping blood. Although significant visual differences between the registered mark and the parodic image clearly distinguished source, Philip Morris sent a letter of demand to the artist alleging breach of dilution protections for available

¹³⁴ *Mattel, Inc. v. MCA Records, Inc.* 28 F. Supp. 2d 1120 (1998) 1138.

¹³⁵ William McGeeveran, 'Rethinking Trademark Fair Use' (2008) 94 *Iowa Law Review* 49, 54. Rochelle Dreyfuss, 'Expressive Genericity: Trademarks as Language in the Pepsi Generation' (1990) 65 *Notre Dame Law Review* 397, 401.

¹³⁶ Spence recognises that both speech and property rights operate; *The Mark as Expression/The Mark as Property*, (2005) 58(1) *Current Legal Problems* 491, 510.

¹³⁷ Robert Goldman and Stephen Papson, *Sign Wars: The Cluttered Landscape of Advertising* (1996) 255. Compare Aoki's arguments against freezing a sign's meaning in different social and cultural contexts: Keith Aoki, 'Authors, Inventors and Trademark Owners: Private Intellectual Property and the Public Domain-Part II' (1993) 18 *Colum.-VLA JL & Arts* 191, 266.

¹³⁸ GC34, para 11.

¹³⁹ *Ibid*, para 22. International Covenant on Civil and Political Rights (opened for signature 16 December 1966, entered into force 23 March 1976) 999 UNTS 171 (ICCPR) art 19.

¹⁴⁰ Wilkinson (n110) 50.

¹⁴¹ Considering the links between corporate personality rights and dilution and tarnishment protection in Europe, Westkamp notes that fundamental rights in reputation and honour are usually balanced against other rights including freedom of expression but this balancing is less likely to occur where trade mark tarnishment is alleged: Guido Westkamp, 'Intellectual Property and Human Rights: Reputation, integrity and the advent of corporate personality rights' in Geiger (n33) 392.

¹⁴² Wilkinson (n110) 62-63.

¹⁴³ Joe Mullin, Philip Morris Attacks Marlboro Parody, Runs into 'Web Bully's Worst Enemy,' ARSTECHNICA (June 17, 2014), <<https://arstechnica.com/tech-policy/2014/06/philip-morris-attacks-marlboro-parody-runs-into-web-bullys-worst-enemy/>>.

for its famous trade mark.¹⁴⁴ In cases like this, artists may not have access to legal advice or the resources to contest assertions of owner rights and so they might agree to the owner's demands and cease making expressive use of the mark.¹⁴⁵ Such assertions of trade mark rights can accordingly chill freedom of expression without court supervision. Even if there is legislative protection against unjustified threats, these activities can go unreported.¹⁴⁶

The size of damages claims in litigation commenced by Philip Morris to protect its rights to use trade marks in packaging suggests that economic interests strongly motivate the corporation to threaten or commence action.¹⁴⁷ The artist who created the Marlboro logo may also assert moral rights or interests to protection and argue that the parody of his or her artwork is detrimental to their honour or reputation. Should this claim restrict the parodists' right to freedom of expression? Restrictions based on protection of the author's moral rights would need to be necessary and proportionate.¹⁴⁸ Reasonableness defences to moral rights actions may be consistent with these requirements but the potential impact of moral rights claims on freedom of expression rights remains an area for further consideration.¹⁴⁹

It may be that, once the serious negative health impacts of tobacco consumption and the role of trademarks in inducing tobacco consumption become known, the author of the Marlboro artwork would prefer to withdraw it from circulation. A moral right of withdrawal exists in some jurisdictions for authors who have transferred economic rights so they can withdraw their work from circulation if it no longer represents the personality of the author. However, this requires the author to 'indemnify the transferee for prejudice caused'.¹⁵⁰ The significant value of the Marlboro brand to Philip Morris makes any withdrawal action inconceivable. Authors of material underlying other valuable trade marks are likely to face similar deterrents to exercising rights of withdrawal. This reflects the complex interplay between material and moral interests in trade marks, but does not mean alienable economic rights should be conflated with inalienable moral rights and interests.

Conclusion

This chapter has drawn out several ways in which trade marks engage questions of moral rights for authors of trade marks and moral interests for authors of the literary and artistic productions and traditional cultural expressions that may underlie or be used in trade marks. These rights permit control over the use of trade marks for individuals and groups of individuals that is consistent with recognition that there is an enduring link between authors and their intellectual creations. The inalienable interests they protect should not be conflated with rights for trade mark owners to expand protection for trade marks beyond non-confusing uses. This chapter has suggested that human rights protection for moral interests may provide valuable support where trade marks are used inconsistently with the values of custodians of traditional knowledge. The WTO Appellate Body decision in *Australia – Tobacco Plain Packaging* suggests that WTO members who legislate to protect these interests may be able to use their human rights obligations as support for justifiable restrictions on trade mark owners. A human rights approach reveals that interests underlying trade

¹⁴⁴ Ibid.

¹⁴⁵ William T Gallagher, 'Trademark and Copyright Enforcement in the Shadow of IP Law' (2012) 28(3) Santa Clara High Technology Law Journal 453, 492–496.

¹⁴⁶ McGeeveran (n135) 740.

¹⁴⁷ See estimate of claim of billions of dollars in *Philip Morris Asia Ltd v Australia* (2012) UNCITRAL PCA 2012-12, para 11.

¹⁴⁸ General Comment 34, para 48.

¹⁴⁹ See Eugene C. Lim, 'On the Uneasy Interface between Economic Rights, Moral Rights and Users' Rights in Copyright Law: Can Canada Learn from the UK Experience' (2018) 15 SCRIPTed 70.

¹⁵⁰ Dutfield and Suthersanen (n8) 134.

marks are not just economic, they are moral, cultural and expressive. Protecting these interests in a human rights framework enables us to recognise that these rights are not absolute but need to be balanced against other important human rights such as freedom of expression.