

Volume 5, Issue 1, April 2008

The Black Label: Trade Mark Dilution, Culture Jamming and the No Logo Movement

*Matthew Rimmer**



* Dr Matthew Rimmer, BA (Hons)/ LLB (Hons) (ANU), PhD (UNSW), is a Senior Lecturer and director of Higher Degree Research at the Australian National University College of Law, and an associate director of the Australian Centre for Intellectual Property in Agriculture (ACIPA). He is grateful for the feedback and comments of the anonymous referees, and Dr Maree Sainsbury of the University of Canberra. He would also like to thank Laugh It Off Promotions for the pictures of the T-Shirts and the legal protests. E-Mail Address: Matthew.Rimmer@anu.edu.au

Abstract

This article considers the ongoing debate over the appropriation of well-known and famous trade marks by the No Logo Movement for the purposes of political and social critique. It focuses upon one sensational piece of litigation in South Africa, Laugh It Off Promotions v. South African Breweries International (Finance) B.V. t/a Sabmark International. In this case, a group called Laugh It Off Promotions subjected the trade marks of the manufacturers of Carling Beer were subjected to parody, social satire, and culture jamming. The beer slogan “Black Label” was turned into a T-Shirt entitled “Black Labour/ White Guilt”. In the ensuing litigation, the High Court of South Africa and the Supreme Court of Appeal were of the opinion that the appropriation of the mark was a case of hate speech. However, the Constitutional Court of South Africa disagreed, finding that the parodies of a well-known, famous trade mark did not constitute trade mark dilution. Moseneke J observed that there was a lack of evidence of economic or material harm; and Sachs J held that there is a need to provide latitude for parody, laughter, and freedom of expression. The decision of the Constitutional Court of South Africa provides some important insights into the nature of trade mark dilution, the role of parody and satire, and the relevance of constitutional protections of freedom of speech and freedom of expression. Arguably, the ruling will be of help in the reformation of trade mark dilution law in other jurisdictions – such as the United States. The decision in Laugh It Off Promotions v. South African Breweries International demonstrates that trade mark law should not be immune from careful constitutional scrutiny.

DOI: 10.2966/scrip.050108.70



© Matthew Rimmer 2008. This work is licensed under a [Creative Commons Licence](#). Please click on the link to read the terms and conditions.

1. Introduction

Does the law have a sense of humour? This question is raised whenever the irresistible force of free expression, in the form of parody, meets the immovable object of property rights, in the form of trademark protection. And if international experience is anything to go by, it would seem that far from providing clear guidance court decisions on the topic have been as variable as judicial humour itself.

Sachs J in *Laugh It Off Promotions v. South African Breweries International (Finance) B.V. t/a Sabmark International*¹

In May 2005, the Constitutional Court of South Africa considered whether a series of transgressive T-shirts infringed the trade marks of the manufacturers of Carling Beer. The case was a *cause célèbre* highlighting the protection of famous trade marks, culture jamming and “adbusting”, and the freedom of political and artistic expression [Figure 1].

Laugh It Off Promotions² makes and sell T-shirts that employ "social satire or parody".³ Its principal, Justin Bartlett Nurse, a journalism graduate, has explained that he is one of many "conscientious objectors to niche-market selfhood and mass-market mediocrity" who "grew up to be brand atheists".⁴ He employs what he calls "ideological jujitsu".⁵ Nurse articulates his credos of culture jamming:

Jujitsu is a form of martial art that sees a fighter using his opponent's massive weight against him. In this same way, Laugh it Off has used the force of a massive entity (namely, the Black Label brand) back on itself... Like the political cartoonist scribbles on his inkpads, like the comedian does his interpretations on stage, we put our message on T-shirts. We have accepted that we operate in a capitalist economy and we have found a medium that affords us the

¹ J Sachs in *Laugh It Off Promotions CC v South African Breweries International* (Case CCT 42/04) [2005] (27 May 2005), the Constitutional Court of South Africa, <http://www.constitutionalcourt.org.za/Archimages/3549.PDF>.

² Laugh It Off Promotions URL: <http://www.laughitoff.co.za/>.

³ *Laugh It Off Promotions CC v South African Breweries International* (Case CCT 42/04) [2005] (27 May 2005), the Constitutional Court of South Africa, [14].

⁴ See note 14.

⁵ See note 14.

*opportunity of earning enough money to continue saying what we want to say.*⁶

Laugh It Off Promotions lampoons well-known, registered trade marks of large corporations to make a statement about corporate policies or practices. It also seeks to probe issues bearing on the broader society; to assert free expression and in so doing to challenge the inordinate use of trade mark laws to silence expressions that are unflattering about brands.

Laugh It Off Promotions marketed T-shirts using a range of brands - including those of Carling Beer. Sabmark International was the owner of trade marks, which it licensed to South African Breweries Ltd for use on beer bottles and related products. One of the trade marks states: "America's lusty, lively beer; Carling Black Label Beer; Brewed in South Africa" [Figure 2]. South African Breweries discovered that Laugh It Off Promotions had marketed T-shirts, which bore a print that was markedly similar, in lettering, colour scheme and background, to that of the "Carling Black Label" trade marks. The words "Black Label" on the registered trade marks were replaced, on the T-shirt, with "Black Labour". The trade mark "Carling Beer" was substituted with "White Guilt"; and the words "America's lusty lively beer" and "enjoyed by men around the world" were replaced with the print "Africa's lusty lively exploitation since 1652" and "No regard given worldwide" [Figure 3]. South African Breweries brought legal action against Laugh It Off Promotions on the grounds that the unauthorised use of its registered trade marks by the applicant in the course of trade offended the anti-dilution provisions of South African trade mark law.

In addition to the complaints of South African Breweries, Laugh It Off Promotions has also had to grapple with a host of complaints from other disgruntled trade mark owners. In *Kirkbi v Laugh It Off Promotions*, Lego brought a legal action against Laugh It Off Promotions over a T-shirt design, which featured two block figures in a suggestive position, with the word "Legover" printed underneath it.⁷ Lego argued that the T-shirts were "detrimental to the distinctive character or repute" of its trademarks. Justin Bartlett Nurse responded that it was not Lego behind the action but "expensive patent lawyers trying to scrounge Christmas bonuses from their wealthy clients."⁸ The trade mark owners of "Mr Min" complained about the parody of the term "Mr Min" – used in association with cleaning products - with T-shirts, bearing the logo "Mr Sin" and featuring representation of the United States President, George W. Bush [Figure 4].⁹ The trade mark owners complained about the parody of the term "Weet-bix" with T-shirts featuring the logo "Weed-brix" in connection with marijuana use [Figure 5].¹⁰ The holders of trade marks in respect of Red Bull objected to the sale of T-Shirts by

⁶ See note 93.

⁷ *Kirkbi v Laugh It Off Promotions* (Case 97502, 2002).

⁸ Agence France-Presse, "Suggestive T-Shirt Has Danish Toy Giant's Knickers in a Knot", *Agence France-Presse*, 17 December 2002.

⁹ Reckitt Benckiser SA Pty Ltd, "Trade Mark Infringement Notice in respect of 'Mr Min'", 1 December 2003.

¹⁰ Pioneer Foods, "Trade Mark Infringement Notice in respect of 'Weet-bix'" 28 June 2004.

Laugh It Off Promotions bearing the slogan “Dead Bull” [Figure 6].¹¹ The owners of the trade mark in respect of “Dettol” were offended by the T-shirt, “Death Toll” [Figure 7].¹² Similarly, the owners of the trade mark “Demostos” did not like the use of the sign “Domestic Violence”.¹³ The trade mark owners of the trade mark “Diesel for Successful Living” objected to T-shirts bearing the slogan “Denial for Successful Loafing” [Figure 8].¹⁴

The holders of copyright and trade marks in respect of the Billabong Wave Logo objected to its use by Laugh It Off Promotions.¹⁵ Colgate Palmolive objected to the use of its trade mark “Black Like Me” [Figure 9].¹⁶ There were also complaints from trade-mark owners about the use of the trade marks, “Husky Dog”, “Incredible Connection”, “Joshua Doore” and “Ouma”, in what they felt was unsavoury contexts.¹⁷ The Coca-Cola Company accused Laugh It Off Promotions of trade mark infringement and passing off in respect of its “Corruption” T-Shirt [Figure 10].¹⁸ This litany of trade mark infringement notices illustrates that action by the South African breweries was not merely an isolated occurrence.

Other trade mark owners refrained from taking action against Laugh It Off Promotions. In other T-shirts, Kentucky Fried Chicken was depicted as “Unlucky Fried Chicken”; “Standard Bank” turned into “Standard Wank”; Shell Ultra City became “Hell Ultra Shitty”; McDonalds was adorned with the logo, “Moo, Make every day a cow’s last” [Figure 11]; “Virgin” became “Viagra” [Figure 12] and the National Lottery was depicted as “National Robbery”.¹⁹ A commentator has observed of the work of Laugh It Off Promotions: “Culture jamming draws on the carnivalesque, anaesthetic that sites resistance in humour, the grotesque (just think of the “Standard Wank” shirt), the disguised, the turning of common sense on its head”.²⁰

¹¹ Red Bull GmbH, “Trade Mark Infringement Notice in respect of ‘Red Bull’”, 11 August 2000.

¹² Reckitt Benckiser SA (Pty) Ltd, “Trade Mark Infringement Notice in respect of ‘Dettol’”, 22 December 2003.

¹³ Unilever PLC and Lever Bonds SA Pty Ltd, “Trade Mark Infringement Notice in respect of ‘Demostos’”, 20 February 2004.

¹⁴ Diesel s.p.a. “Trade Mark Infringement Notice in respect of ‘Diesel’”, 18 December 2001.

¹⁵ GSM (Trademark) Pty Ltd and Billabong SA CC, “Copyright and Trade Mark Infringement Notice in respect of ‘Wave Logo’”, 20 November 2003.

¹⁶ Colgate Palmolive, “Trade Mark Infringement Notice in respect of ‘Black Like Me’”, 23 July 2002.

¹⁷ M W Slabbert, “Trade Mark Infringement Notice in Respect of Husky Dog”, 3 April 2002; Incredible Connection Pty Ltd, “Trade Mark Infringement Notice in respect of ‘Incredible Connection’”, 23 May 2002; JDG Trading Pty Limited, “Trade Mark Infringement Notice in respect of ‘Joshua Doore’ Brand”, 4 December 2003; and Foodcorp (Pty) Limited, “Trade Mark Infringement Notice in respect of ‘Ouma’ Brand”, 4 August 2004.

¹⁸ Coca Cola, “Trade Mark Infringement and Passing Off Notice in respect of ‘Coca-Cola’ Script”, 8 July 2002. In *Coca-Cola Co. v Gemini Rising, Inc.* 346 F. Supp. 1183 (E.D.N.Y. 1972), the defendant sold posters that replaced the slogan “Enjoy Coca-Cola” with the phrase “Enjoy Cocaine.” The court granted an injunction in favour of Coca-Cola. For a history of Coca-Cola, see H McQueen, *The Essence of Capitalism: The Origins of Our Future* (Sceptre, Sydney, 2001).

¹⁹ E Ellis, “Big Battle Brews over ‘Joke’ T-Shirt”, *Africa News Service*, 14 May 2002.

²⁰ J Jonker, “Touching the Trade Mark”, (2003), 23 *Rhodes Journalism Review* 42-43.

This article uses the dramatic conflict in *Laugh It Off Promotions v. South African Breweries International (Finance) B.V. t/a Sabmark International* to consider the relationship between trade mark dilution, culture jamming, and freedom of expression. It advances three main arguments. First, this paper recognises that the owners of famous trade marks have legitimate rights to protect their brands from dilution – whether through tarnishment or blurring. Nonetheless, it maintains that there is a need for trade mark owners to demonstrate material and economic harm in order to establish a case for trade mark dilution. Second, this analysis considers the impact of trade mark dilution laws in the context of cultural discourse. Patricia Loughlan notes that there is increasing conflict between trade mark owners and culture jammers:

*Famous trade marks can and do become significant cultural resources and important elements of public discourse and popular expression. The problem is that trade mark proprietors have and increasingly assert an interest in controlling, not just the traditional "badge of origin" use of their trade marks by rivals in the marketplace, but also these other, potentially culturally significant uses of the marks.*²¹

It is contended that trade mark owners should not be able to limit parody, satire, or culture jamming on the basis of arguments about trade mark dilution. Third, this article explores the long-standing tension between the rights accorded to trade mark owners and freedom of speech.²² It is argued that courts should not assume that intellectual property laws are necessarily compatible with constitutional protections of freedom of speech.²³ There is a need to subject trade mark rights to strict scrutiny to ensure that they do not have an adverse impact upon the protections of freedom of speech afforded by constitutional law and other legal doctrines.

This article considers how a succession of South African courts have interpreted the transgressive image of the "Black Labour, White Guilt" T-shirt. It highlights the range of hermeneutic strategies that were deployed to make sense of this unstable, ambiguous icon. Indeed, the "Black Labour, White Guilt" T-Shirt proved to be a Rorschach ink blot for judicial methodologies. There are three parts to this piece. Part 2 considers the dispute over the appropriation of the Carling Black Label mark in the context of wider debates over trade mark law, culture jamming, and the No Logo anti-global capitalism movement. Part 3 explores the various approaches of the High Court

²¹ P Loughlan, "Protecting Culturally Significant Uses Of Trade Marks (Without A First Amendment)", (2000) 22 *European Intellectual Property Review* 328.

²² For a history and taxonomy of trade marks, see P Mollerup, *Marks of Excellence: The History and Taxonomy of Trademarks* (Phaidon Press, 1999).

²³ For instance, J Ginsburg in the majority in *Eldred v Ashcroft*, 537 U.S. 186 (2003) 239 F.3d 372 observes of United States law: "The Copyright Clause and First Amendment were adopted close in time. This proximity indicates that, in the Framers' view, copyright's limited monopolies are compatible with free speech principles. Indeed, copyright's purpose is to *promote* the creation and publication of free expression. As *Harper & Row* observed: "[T]he Framers intended copyright itself to be the engine of free expression. By establishing a marketable right to the use of one's expression, copyright supplies the economic incentive to create and disseminate ideas.""

of South Africa, the Supreme Court of Appeal and the Constitutional Court of South Africa to the "Black Labour, White Guilt" T-shirts. The lower courts maintained that the appropriation of the mark was an instance of "hate speech", and an abuse of freedom of speech. Moseneke J in the Constitutional Court of South Africa maintained that trade mark dilution requires economic or material harm. Sachs J emphasized the importance of parody, laughter, and freedom of expression. Part 4 provides a comparative analysis of the protection of well known and famous trade marks. It charts the evolution and the development of trade mark dilution in the United States; and considers recent reforms to the legal doctrine. It is contended that the decision in *Laugh It Off Promotions CC v. South African Breweries International* could be a useful precedent to guide superior courts in dealing with litigation over parodies of well-known and famous trade marks.

2. Culture Jamming

By attempting to enclose our shared culture in sanitized and controlled brand cocoons, these corporations have themselves created [a] surge of opposition... By thirstily absorbing social critiques and political movements as sources of brand "meaning," they have radicalized that opposition still further. By abandoning their traditional role as direct, secure employers to pursue their branding dreams, they have lost the loyalty that once protected them from citizen rage. And by pounding the message of self-sufficiency into a generation of workers, they have inadvertently empowered their critics to express that rage without fear.

Naomi Klein, *No Logo: Taking Aim At The Brand Bullies*²⁴

The dispute in *Laugh It Off Promotions CC v. South African Breweries International* is not a mere isolated skirmish between a group of provocateurs and a disgruntled corporation. It is emblematic of a larger cultural conflict between social activists and owners of famous trade marks. Justin Bartlett Nurse draws his strategies and tactics from a well-established aesthetic tradition of culture jamming. He is sympathetic to the cause of a socially-progressive, anti-capitalist politics. A number of pundits and commentators have championed the No Logo movement. The Canadian journalist and political philosopher, Naomi Klein, has helped popularize the tactics and strategies of culture jamming in her manifesto. She has described the dispute over the Carling Black Label as "potentially bigger than the McLibel case".²⁵ Rosemary Coombe, Kembrew McLeod, and David Bollier have sought to analyse the use of trade mark infringement and dilution actions. Sonia Katyal has suggested that the adoption of culture jamming techniques is a form of "semiotic disobedience". There has been a

²⁴ N Klein, *No Logo: Taking Aim at the Brand Bullies* (2000), p. 441-442.

²⁵ T Koenderman, "Trademarks: No Laughing Matter", *Financial Mail*, 20 December 2002, p. 12. The "McLibel case" was a famous defamation case involving the McDonald's Restaurants suing environmental activists, David Morris and Helen Steel: *McDonald's Restaurants v Morris and Steel (McLibel case)* [1997] EWHC QB 366; *Morris and Steel v. McDonald's Restaurants* [1999] EWCA Civ 1144; and *Steel and Morris v. The United Kingdom* [2005] ECHR (Application no. 68416/01).

strong counter-reaction to such popular and academic critiques of trade mark law and practice. The *Economist* magazine has attacked and ridiculed the No Logo thesis presented by Naomi Klein. Trade mark traditionalists have defended the value of trade marks, maintaining that they fulfil the original objectives set for them. Marketing experts have protested that trade marks can serve useful and progressive purposes. Such sceptics of the No Logo movement have questioned its revolutionary credos. They have suggested that, far from being an economic critique, culture jamming is ultimately complicit with consumer capitalism.

2.1 The No Logo Movement

The phrase culture jamming was inspired by the technique of electronically interfering with broadcast signals.²⁶ The agitprop band, Negativland, coined the phrase “culture jamming” in 1984 to describe a range of subversive activities.

In 1993, Mark Dery wrote the provocative pamphlet, “Culture Jamming: Hacking, Slashing and Sniping in the Empire of Signs”. He sought to define provide a short history of the aesthetic and political credos of culture jamming:

Culture jamming... is directed against an ever more intrusive, instrumental technoculture whose operant mode is the manufacture of consent through the manipulation of symbols...

Part artistic terrorists, part vernacular critics, culture jammers, like Eco's "communications guerrillas," introduce noise into the signal as it passes from transmitter to receiver, encouraging idiosyncratic, unintended interpretations. Intruding on the intruders, they invest ads, newscasts, and other media artifacts with subversive meanings; simultaneously, they decrypt them, rendering their seductions impotent. Jammers offer irrefutable evidence that the right has no copyright on war waged with incantations and simulations. And, like Ewen's cultural cryptographers, they refuse the role of passive shoppers, renewing the notion of a public discourse.

Finally, and just as importantly, culture jammers are Groucho Marxists, ever mindful of the fun to be had in the joyful demolition of oppressive ideologies.²⁷

Dery noted that culture jamming had a number of historical antecedents – including samizdat, underground literature; Situationistdetournement; and subculturalbricolage. He noted that culture jamming could assume a number of guises – such as sniping and subvertising; media hoaxing; audio agitprop; and billboard banditry. Dery predicted

²⁶ V Carducci, “Culture Jamming: A Sociological Perspective”, (2006), 6 *Journal of Consumer Culture* 116-138 at 116.

²⁷ M Dery, “Culture Jamming: Hacking, Slashing and Sniping in the Empire of Signs”, (1993), <http://www.levity.com/markdery/culturjam.html>.

that hackers, slashers, and snipers would take advantage of the possibilities presented by the Internet and virtual communities.

There are a range of groups and collectives employing culture jamming strategies. In a contribution to *Censoring Culture*, Giselle Fahimian provides case studies of the long term-goals and organizational styles of three famous organisations - ®TMark, Adbusters, and Negativland.²⁸ ®TMark is an anonymous group of media provocateurs who engage in acts of cultural sabotage – perhaps most famous for swapping the voice boxes of Barbie and G.I. Joe Dolls.²⁹ Fahimian notes: “In order to limit the legal liability of its members, ®TMark is structured in the most decentralized and anonymous manner possible.”³⁰ The Adbusters Media Foundation is “a global network of artists, activists, writers, pranksters, students, educators and entrepreneurs who want to advance the new social activist movement of the information age”.³¹ The non-profit organization engages in the publication of a monthly magazine, *Adbusters*, an advertising advocacy campaign called “PowerShift”, and the maintenance of a culture jammers network [Figure 13]. Negativland is a musical collective, which have engaged in the appropriation of copyright works and trade mark signs in their sound recordings.³² The group has sought to promote a philosophy of free artistic appropriation.³³

In *No Logo: Taking Aim at the Brand Bullies*, Naomi Klein launched a polemic against the corporate control of well-known brands and trade marks [Figure 14].³⁴ She explored the growing opposition among culture jammers to corporate rules. Naomi Klein considers the treatment of well-known brands and trade marks. She explains the title of her best-selling book: “The book is hinged on a simple hypothesis: that as more people discover the brand-name secrets of the global logo web, their outrage will fuel the next big political movement, a vast wave of opposition squarely targeting transnational corporations, particularly those with very high name-brand recognition”.³⁵

Klein first examines the surrender of culture and education to marketing. She reports on how the promise of cultural choice was betrayed by the forces of mergers, predatory franchising, synergy and corporate censorship. Klein considers the corporate assault on employment, civil liberties, and civil space. She focuses upon the growing opposition among culture jammers to corporate rules. Klein seeks to explain the popularity of the practice of “culture- jamming”:

²⁸ G Fahimian, ‘How the IP Guerillas Won: ®TMark, Adbusters, Negativland, and the “Bullying Back” of Creative Freedom and Social Commentary’, in R Atkins, S Mintcheva, *Censoring Culture: Contemporary Threats to Free Expression*, (2006), p. 132-148.

²⁹ ®TMark <http://www.rtmrk.com/>

³⁰ Fahimian, see note 28, p. 135.

³¹ Adbusters, http://www.adbusters.org/network/about_us.php.

³² Negativland, <http://www.negativland.com/>.

³³ Negativland, “Two Relationships to a Cultural Public Domain”, (2003), 66 *Law and Contemporary Problems* 239-262.

³⁴ N Klein, *No Logo: Taking Aim at the Brand Bullies* (2000).

³⁵ *Ibid*, p. xviii.

Culture jamming is enjoying a resurgence, in part because of technological advancements, but also more pertinently, because of the good old rules of supply and demand. Something not far from the surface of the public psyche is delighted to see the icons of corporate power subverted and mocked. There is, in short, a market for it. With commercialism able to overpower the traditional authority of religion, politics and schools, corporations have emerged as the natural targets for all sorts of free-floating rage and rebellion. The new ethos that culture jamming taps into is go-for-the-corporate jugular.³⁶

Klein warned against seeing culture jamming as merely an aesthetic practice, without political significance or import: “Perhaps the gravest miscalculation on the part of both markets and media is the insistence on seeing culture jamming solely as harmless satire, a game that exists in isolation from a genuine political movement or ideology”.³⁷ She notes: “It is simply a tool – one among many – that is being used, loaned, and borrowed in a much broader political movement against the branded life”.³⁸

Klein comments that the tactics of culture jamming have been particularly effective when targeted against the labour practices of corporations:

The more ambitious a company has been in branding the cultural landscape, and the more careless it has been in abandoning workers, the more likely it is to have generated a silent battalion of critics waiting to pounce. Moreover, the branding formula leaves corporations wide open to the most obvious tactic in the activist arsenal: bringing a brand’s production secrets crashing into its marketing image. It’s a tactic that has worked before.³⁹

Klein considers the emergence of the “Fair Trade” movement: “Ethical shareholders, culture jammers, street reclaimers, McUnion organizers, human rights hacktivists, school-logo fighters and Internet corporate watchdogs are at the early stages of demanding a citizen-centered alternative to the international rule of the brands”.⁴⁰ She notes: “That demand, still sometimes in some areas of the world whispered for fear of a jinx, is to build a resistance – both high-tech and grassroots, both focused and fragmented – that is as global, and as capable of coordinated action, as the

³⁶ Ibid, p. 287.

³⁷ Ibid, p. 309.

³⁸ Ibid, p. 309.

³⁹ Ibid, p. 345.

⁴⁰ Ibid, p. 445-446.

multinational corporations it seeks to subvert.”⁴¹ Her subsequent books, *Fences and Windows*, and *The Shock Doctrine*, further explore the politics of globalization.⁴²

In her classic text, *The Cultural Life of Intellectual Properties*, Rosemary Coombe discussed "the lure of trademarks as visual symbols of hegemonic power and as vehicles for alternative articulations in consumer societies".⁴³ She considered the increasing commodification of the public sphere, the branding of cityscapes, the role of trade marks in national imagery, struggles around the prohibition of racial stereotypes as forms of trade mark, as well as rumours that circulate about the origins of trade marks. In "Fear, Hope and Longing for the Future of Authorship and a Revitalized Public Domain in Global Regimes of Intellectual Property," Rosemary Coombe comments:

*Copyright and trademark are increasingly used as tools of corporate harassment and censorship. This is, moreover, no longer the position of a few critical legal scholars - the enormous success of Naomi Klein's book No Logo (and the anticorporate politics it both documents and incites) is evidence that the issue is becoming one of widespread social concern (and not just amongst teenagers who want free music, as conservative legal theorists dub those who are committed to creating alternative moral economies of sharing intellectual work, creativity, and democratic dialogue in digital environments).*⁴⁴

Elsewhere, Coombe has remarked: "Protests against sweatshop labour practices, and the movement of big box stores and fast food franchises into communities, suggest that the trademark now provides a site and a symbol around which to resist forms of commodification that people find contrary to their understandings of community and social justice".⁴⁵ She wonders: "If the trademark serves as a surrogate for the goodwill that consumers have towards the company, can we also use them as a means to hold corporations accountable for their activities?"⁴⁶ She poses the question: "To what extent are 'rogue websites,' 'culturejamming,' 'subvertizing', and 'No Logo' movements effective forms of resistance to the hegemony of commodified signs?"⁴⁷

⁴¹ Ibid, p. 445-446.

⁴² N Klein, *Fences and Windows: Dispatches from the Front Lines of the Globalization Debate*. (2002); and N Klein, *The Shock Doctrine: The Rise of Disaster Capitalism* (2007).

⁴³ R Coombe, *The Cultural Life of Intellectual Properties: Authorship, Appropriation, and the Law*, (1998), p. 130.

⁴⁴ R Coombe, "Fear, Hope and Longing for the Future of Authorship and a Revitalized Public Domain in Global Regimes of Intellectual Property", (2003), 52 *DePaul Law Review* 1171-1191.

⁴⁵ R Coombe, "The Politics of Intellectual Property", The Joint Graduate Programme in Communication and Culture, <http://www.finestone.ca/aa/comcult/faculty/coombe.html>.

⁴⁶ Ibid.

⁴⁷ Ibid.

In *Freedom of Expression*^(R), Kembrew McLeod complains about the incursions by trademark law into freedom of political speech and artistic expression.⁴⁸ In 1998, he obtained a trade mark from the United States Patent and Trademark Office in respect of the phrase "freedom of expression", as an ironic comment to demonstrate how the American culture had become commodified and privately owned [Figure 15].⁴⁹ He sought to publicise this event through a media prank. McLeod hired a lawyer to write a cease-and-desist letter to a colleague who was complicit in the joke:

*Your company has been using the mark Freedom of Expression. Such use creates a likelihood of confusion in the market and also creates substantial risk of harm to the reputation and goodwill of our client. This letter, therefore, constitutes formal notice of your infringement of our client's trademark rights and a demand that you refrain from all further use of freedom of expression.*⁵⁰

Dealing with reporters, McLeod observed poker-faced: "I didn't go to the trouble, expense, and the time of trademarking freedom of expression^(R) just to have someone else come along and think they can use it whenever they want".⁵¹ His stooge responded that McLeod was an "opportunist". This staged dispute was reported, with great earnestness, by the *Hampshire Gazette*. This incident has echoes of the controversy in Australia over a Melbourne patent attorney, John Keough, obtaining innovation patent for a wheel - a "circular transportation device".⁵²

In *Brand Name Bullies*, David Bollier is critical of the development of the *Federal Trademark Dilution Act* 1995 (US), observing:

The perverse result is that the more power and influence a company acquires, the more able it is to stifle robust public discussion about it and its products – even where no consumer would be confused. As if from the sky, well-heeled trademark holders can figuratively deploy a gigantic Monty Python foot to squash unauthorized uses of a trademarked name or image, no matter how innocent, non-commercial, or trivial. All that matters is whether the offending reference to the trademark “dilutes” or “tarnishes” it. Often, the legal merits of an offending usage may be irrelevant because the hapless defendant cannot begin to consider litigation against the likes of McDonald’s or Microsoft. This imbalance of power enables large trademark holders to make threats they know to be legally

⁴⁸ K McLeod, *Freedom of Expression*^(R): *Overzealous Copyright Bozos and other Enemies of Creativity* (2005).

⁴⁹ *Ibid*, p. 118-122.

⁵⁰ *Ibid*, p. 120.

⁵¹ *Ibid*, p. 120.

⁵² N Cochrane. "Melbourne Man Patents The Wheel", *The Age*, 2 July 2001.

*dubious or erroneous. Very few of the bullied victims can afford to ascertain their rights, let alone fight back in court.*⁵³

Bollier complains that the legislation is a "blunt instrument of cultural intimidation and censorship".⁵⁴ He maintains that "there is no reason that trademark protection should trump all other interests in our society, especially free speech and artistic commentary".⁵⁵

In her paper, "Semiotic Disobedience", Sonia Katyal notes: "Principles of trademark and copyright ownership have allowed corporations to consecrate their symbols and images, allowing for a particularly robust form of incontestability".⁵⁶ Katyal observes that "semiotic disobedience has created new and particularly vexing problems for lawyers and law enforcement officials, both of whom are often bemused by artists' increasingly creative and confrontational approaches".⁵⁷ She seeks to analyse the tactics of "semiotic disobedience":

*Just as previous discussions of civil disobedience focused on the need to challenge existing laws by using certain types of public and private property for expressive freedoms, today's generation seeks to alter existing intellectual property by interrupting, appropriating, and then replacing the passage of information from creator to consumer. In many cases, the object of artistic attention is the appropriation and occupation of intellectual, tangible, or even bodily property. I call these recent artistic practices examples of 'semiotic disobedience' because they often involve the conscious and deliberate re-creation of property through appropriative and expressive acts that consciously risk violating the law that governs intellectual or tangible property.*⁵⁸

Katyal maintains that "semiotic disobedience offers a cautionary lesson for intellectual property enforcement: as law attempts to suppress creativity, it may also give rise to an even more innovative process of comment and criticism than was previously imagined."⁵⁹

2.2 The Pro Logo Counter-Movement

Against this new genre of cultural criticism of advertising and marketing, there has been a rearguard defence of the value and integrity of trade marks.

⁵³ D Bollier, *Brand Name Bullies: The Quest to Own and Control Culture*, (2005), p. 83-84.

⁵⁴ *Ibid*, p. 84.

⁵⁵ *Ibid*, p. 84.

⁵⁶ S Katyal, "Semiotic Disobedience", (2006), 84 (2) *Washington University Law Review* 489-571 at 491.

⁵⁷ *Ibid* at 494.

⁵⁸ *Ibid* at 493.

⁵⁹ *Ibid* at 571.

In response to the Naomi Klein book *No Logo*, *The Economist* magazine released a special edition on branding entitled *Pro Logo*, with the tag line "Why brands are good for you".⁶⁰ Its front cover is a replication of the cover of the book "No Logo", with "No" replaced with "Pro" and the tag line "Why brands are good for you" [Figure 16]. *The Economist* attacks Naomi Klein's book *No Logo* as the representative of a wider anti-branding movement.

*Brands have thus become stalking horses for international capitalism. Outside the United States, they are now symbols of America's corporate power, since most of the world's best known brands are American. Around them accrete all the worries about environmental damage, human-rights abuses and sweated labour that anti-globalists like to put on their placards. No wonder brands seem bad.*⁶¹

First, *The Economist* defends trade marks in terms of their original objectives: "[Brands] began as a form not of exploitation, but of consumer protection".⁶² Second, *The Economist* offers a defence of trade marks, with the case statement: "Far from being instruments of oppression, they make firms accountable to consumers".⁶³ The editorial notes: "A failed advertising campaign, a drop-off in quality or a hint of scandal can all quickly send customers fleeing".⁶⁴ The leader states: "Indeed, protestors, including Ms Klein's anti-globalisation supporters, can use the power of the brand against companies by drumming up evidence of workers ill-treated or rivers polluted."⁶⁵ Third, *The Economist* accuses Naomi Klein of claiming that consumers are merely pawns: "Her thesis is that brands have come to represent 'a fascist state where we all salute the logo and have little opportunity for criticism because our newspapers, television stations, Internet servers, streets and retail spaces are controlled by multinational corporate interests.'"⁶⁶ *The Economist* concludes that Naomi Klein's arguments are wrong-headed: "The idea is utterly wrong-headed. Brands do not rule consumers; consumers rule brands."⁶⁷

Taking umbrage at the piece, Naomi Klein wrote a letter to *The Economist* complaining that her views had been misrepresented and placed out of context.⁶⁸ She scornfully replied: "Your publication, on the other hand, appears to believe that

⁶⁰ Editorial, "Pro Logo: Why Brands are Good For You", (2001), 360/8238 *The Economist* 9.

⁶¹ Ibid.

⁶² Ibid.

⁶³ Ibid.

⁶⁴ Ibid.

⁶⁵ Ibid.

⁶⁶ Ibid.

⁶⁷ Ibid.

⁶⁸ N Klein, "Naomi Responds to the Economist Cover", 7 September 2001, <http://www.naomiklein.org/articles/2001/09/naomi-responds-economist-cover>.

political activism is unnecessary since we apparently can rid the world of corporate abuses simply by shopping for better brands.”⁶⁹

In *Pro Logo*, a pair of Gallic marketeers, Michel Chevalier and Gerald Mazzalovo, sought to rebut the notion that brands are inherently evil; that they are the foundation of a system of hegemony and alienation; and that, by attacking them, one is attacking the heart of the "capitalist machine" [Figure 17].⁷⁰ Indeed the writers contend that brands are authentic indicia of social progress:

*Brands exist and are neither good nor evil in themselves. They can be criticized, but calling for their abolition is absurd. They are and will remain an essential tool of marketing, international competition, and contemporary social life. It's impossible to imagine that supermarkets would suddenly begin selling exclusively generic products. If that were to happen, the need for differentiating these products would immediately arise – and brands would reappear, or else the store's name would take their place. In fact, there is no such thing as a world without brands.*⁷¹

Chevalier and Mazzalovo conclude that “brands are a force for progress to the degree that they are well managed and that the consumer behaves responsibly.”⁷² The authors seek to “convince consumers determined to defend their rights that brands are not *The Enemy*, and companies that they have everything to gain by making their customers’ point of view a priority.”⁷³

It is perhaps worth interpolating that certain social movements have relied upon trade marks to promote progressive social causes. Fairtrade Labelling Organizations International uses Fairtrade marks to provide an independent guarantee that disadvantaged producers in the developing world are benefiting from the sale of goods.⁷⁴ A product can only display the Fairtrade mark if it meets international Fairtrade standards. The “Make Poverty History” campaign was designed to promote trade justice, humanitarian aid and the reduction of debt.⁷⁵ The name and logo “Make Poverty History” was registered as a trade mark by Comic Relief, and licensed to member organisations who met certain guidelines as to the use of the brand. “(Red)” is a brand created to raise awareness and money for the Global Fund to Fight AIDS, Tuberculosis and Malaria by teaming up with the world's most iconic brands to

⁶⁹Ibid.

⁷⁰ M Chevalier, G Mazzalovo, *Pro Logo: Brands as a Factor of Progress*, (2004).

⁷¹ Ibid, p. 3.

⁷² Ibid. p. 4

⁷³ Ibid, p. 5.

⁷⁴ Fairtrade Labelling Organizations International, <http://www.fairtrade.net/>. See also R Layton “Enhancing Intellectual Property Exports Through Fair Trade”, in J M Finger and P Schuler, *Poor People's Knowledge: Promoting Intellectual Property in Developing Countries* (2004), p. 75-94; and S Courville, “Use of Indicators to Compare Supply Chains in the Coffee Industry”, (2004), 43 *Greener Management International* 93-105.

⁷⁵ Make Poverty History, <http://www.makepovertyhistory.org/>.

produce “(Red)”branded products. A portion of profits from each product sold goes directly to the fund to invest in African AIDS programs, with a focus on women and children.⁷⁶ The various initiatives of “Fairtrade”, “Make Poverty History” and “(Red)” all use and deploy trade marks to advertise and raise awareness for certain progressive causes. The ventures can be contrasted with the tactics of culture jamming, which seek to undermine trade marks in order to promote social and political causes.

In *The Rebel Sell: Why the Culture Can't Be Jammed*, Joseph Heath and Andrew Potter engaged in a critique of the culture jamming strategies of Naomi Klein, *Adbusters*, and Michael Moore [Figure 18].⁷⁷ The authors observe: "In a world of this type, countercultural rebellion is not just unhelpful, it is positively counterproductive".⁷⁸ Heath and Potter comment:

*Books like No Logo, magazines like Adbusters and movies like American Beauty do not undermine consumerism; they reinforce it. This isn't because the authors, editors or directors are hypocrites. It's because they've failed to understand the true nature of consumer society. They identify consumerism with conformity. As a result, they fail to notice that it is rebellion, not conformity, that has for decades been the driving force of the marketplace.*⁷⁹

The authors maintain that Naomi Klein offers little in the way of a positive, constructive, political agenda: “One of the biggest ironies of the anti-globalization movement in general is that for all its opposition to consumerism, it effectively reduces citizenship to consumer action”.⁸⁰ Heath and Potter observe, acerbically: “The reason *No Logo* has had such dramatic success is that it serves as a how-to manual for the virtuously hip shopper, full of case studies in how consumers can try to influence corporate behaviour”.⁸¹ The pair lament that Klein “focuses entirely on corporate awareness campaigns, consumer boycotts, street protests, and culture jamming, while completely ignoring the role played by citizens working through government”.⁸²

The scholar of academic publishing, Simone Murray, comments that the book *No Logo* is itself open to being co-opted:

Canadian journalist Naomi Klein's handbook of the anti-corporate movement, No Logo: Taking Aim at the Brand Bullies (2000), was published in Australia and the UK by News Corporation subsidiary HarperCollins and has, perhaps even to its publisher's surprise, achieved bestseller status internationally. Yet, the exceptionalism of

⁷⁶ (Red), <http://www.joinred.com/>.

⁷⁷ J Heath, A Potter, *The Rebel Sell: Why the Culture Can't Be Jammed*, (2004).

⁷⁸ *Ibid*, p. 8.

⁷⁹ *Ibid*, p. 99.

⁸⁰ *Ibid*, p. 330.

⁸¹ *Ibid*, p. 330.

⁸² *Ibid*, p. 330.

*this text's print history in the current media environment tends rather to confirm the dominant publishing industry rule that individual media products reinforce the market profile of their parent corporation. There may well be leeway for abstract critique of the political and economic philosophies to which the company's directors subscribe, but rarely for explicit and extended criticism of the corporation's activities per se.*⁸³

She notes the ironies of *No Logo* being marketed by a publisher under the ownership of the powerful News Corporation: 'Explicitly oppositional books are always themselves open to commodification in a marketplace hungry for new ideas and willing to pay for them'.⁸⁴

The ebullient Jeremy Phillips devotes a whole chapter of his scholarly text, *Trade Mark Law: A Practical Anatomy*, to a rejoinder to the "No Logo" thesis of Naomi Klein.⁸⁵ The section is entitled "Trade marks, Images, Icons and Social Responsibility". Phillips responds to the manifesto of "No Logo" thus:

*Naomi Klein's anxieties concerning the power and influence of major brands are not misplaced, but the abuses which she addresses are not confined to owners: they are found within large corporations of many descriptions. The rectification of those abuses is not the exclusive province of the trade mark and brand-protection community. While it helps to protect brand manipulators by granting them a powerful exclusive right, that same body of law provides for a wide range of defences to infringement in the interests of freedom of speech, competition and honest use.*⁸⁶

Phillips contended that Klein's case did not relate to the misfeasance of all brand owners in respect of all brands. Rather, he emphasized that the target of her criticism was a small number of brand-mighty corporate potentate. Phillips doubted whether the "consumer apocalypse" or "Armageddon" predicted by Klein would in fact eventuate.⁸⁷

2.3 Culture Wars

It is useful to contextualise the dispute over the appropriation of the Carling Black Label mark in the context of wider debates over trade mark law, culture jamming, and the No Logo anti-global capitalism movement. The dispute between Laugh It Off

⁸³ S Murray, "Media Convergence's Third Wave: Content Streaming", *Inaugural Public Right to Know Conference*, Australian Centre for Independent Journalism, University of Technology, Sydney 26-28 October 2001. See also S Murray, "Brand Loyalties: Rethinking Content within Global Corporate Media", (2005), 27 (3) *Media, Culture & Society* 415-435.

⁸⁴ *Ibid.*

⁸⁵ J Phillips, *Trade Mark Law: A Practical Anatomy* (2003).

⁸⁶ *Ibid.*, p. 668.

⁸⁷ *Ibid.*, p. 664.

Promotions and the brewers of Carling Black is part of a larger struggle over well-known and famous trade marks. In this context, there has been an intense discussion over the value and worth of trade marks. Trade mark owners and their legal representatives, economists, and marketing agents have defended the value of trade marks, saying that they fulfil their original aims and objectives. Thus, they have maintained that trade marks serve as a badge of origin of goods and services; they guarantee the quality of goods and services; and promote consumer welfare.⁸⁸ By contrast, the No Logo movement has emphasized the economic, social and cultural costs associated with the expansive protection of trade marks. The civil society activists complain that corporations have deployed trade marks to mesmerize and indoctrinate consumers. There has been much debate over the legitimacy of the tactics and strategies of culture jamming, “adbusting”, and the No Logo Movement. The owners of well-known and famous trade marks would maintain that such conduct constitutes trade mark infringement and dilution. The No Logo movement would justify such methods of resistance as a form of “semiotic disobedience.” There has also been larger debate about the political intentions and motivations of the No Logo movement. Trade mark owners have questioned the political efficacy of culture jamming, suggesting that it does as much to reinforce consumer capitalism, as critique it. The No Logo movement maintains that the appropriation of well-known and famous marks is a useful means of promoting fair trade.

3. Black Labour, White Guilt

South Africa has suffered so many interferences with the rights of free speech that the tendency to let everybody say what they want, when they want, how they want is very strong. At the same time there is an awareness that racism can ignite explosive passions and destroy the very fabric of a tolerant and democratic society... The problem, then, is how to reconcile the need for openness and the right to speak one's mind with the necessity for healing the wounds created by racism.

Justice Albie Sachs⁸⁹

The South African Breweries sued Laugh It Off Promotions under South Africa’s anti-dilution trade mark laws. Section 34 (1) (c) of the *Trade Marks Act 1993* (RSC) provides that the rights acquired by registration of a trade mark are infringed by “the unauthorized use in the course of trade in relation to any goods or services of a mark which is identical or similar to a trade mark registered, if such trade mark is well known in the Republic and the use of the said mark would be likely to take unfair advantage of, or be detrimental to, the distinctive character or the repute of the registered trade mark, notwithstanding the absence of confusion or deception.”

The directors of the company, Jaap Romein, and Graham Holford, observed in papers tendered to the court:

⁸⁸ *Ibid.*, p. 21-28.

⁸⁹ A Sachs, “Free Speech: Unlimited or Qualified”, (1990), *Democracy in Action*: 20.

We take particular objection to the wording on their label... We have worked extremely hard to avoid racial discrimination in our labour practices, to the extent the SAB has recently received recognition as the best employer in South Africa. The mark applied to clothing by Laugh It Off is undoubtedly intended to suggest that improper racial discrimination is a factor in the business of SAB and to harm our reputation and the reputation of Black Label marks and products. It is distasteful and undesirable.⁹⁰

South African Breweries was concerned that the racial slur was likely to erode the exclusiveness of the mark, discourage people from purchasing the respondent's Black Label Beer and adversely curtail its opportunities to sponsor domestic sport.

In response, Laugh It Off Promotions contended that its use of the trade marks had not infringed the anti-dilution provisions because the likelihood of detriment to the reputation of the marks had not been established. In any case, the group maintained that it was exercising freedom of expression protected by the *South African Constitution* 1996 (RSC). Section 16 (1) of the *South African Constitution* 1996 (RSC) provides: "(1) Everyone has the right to freedom of expression, which includes– (a) freedom of the press and other media; (b) freedom to receive or impart information or ideas; (c) freedom of artistic creativity; and (d) academic freedom and freedom of scientific research." Section 16 (2) of the *South African Constitution* 1996 (RSC) provides: "The right in subsection (1) does not extend to – (a) propaganda for war; (b) incitement of imminent violence; or (c) advocacy of hatred that is based on race, ethnicity, gender or religion, and that constitutes incitement to cause harm."

The advocate for Laugh It Off, Peter Hodes, argued: "We are dealing here with a form of creative expression ... that should endure protection by the constitutional right to freedom of expression".⁹¹ He submitted that South African Breweries had not succeeded in proving that the shirts caused the brewery economic harm: "If you want to limit someone's freedom of expression, you will have to establish economic harm."⁹² Hodes maintained that the T-Shirt conveyed a social comment, rather than a racial attack on South African: "It says nothing about beer, about SAB or about their labour practices."⁹³ Hodes also argued that freedom of expression should be considered a more important right than protecting intellectual property rights.

The Supreme Court of Appeal and the Constitutional Court of South Africa admitted the Freedom of Expression Institute (FXI) as an *amicus curiae*, a friend of the court. The FXI observed that South African Breweries should tolerate some criticism and mockery because the brewery has "opted to place a particular brand identity with certain images, virtues and values in the public domain".⁹⁴ In a statement, FXI observed:

⁹⁰ E Ellis, "Big Battle Brews over 'Joke' T-Shirt", *Africa News Service*, 14 May 2002.

⁹¹ E Hollemans, "Court Hears of 'Death of the Trademark'", *Mail & Guardian On-line*, 9 March 2005.

⁹² *Ibid.*

⁹³ *Ibid.*

⁹⁴ *Ibid.*

*SAB must not enjoy special immunity from the spoofing and criticism that is generated by its own choice of branding. The words 'Black Labour - White Guilt' are a parody and constitute nothing more than the fair use of a registered trademark, which is protected by the constitutional right to freedom of expression. The right to parody is one of the hallmarks of the right to freedom of expression and in order for parody to be exercised effectively, an individual must be able to borrow, copy or imitate an original work, mark or object.*⁹⁵

FXI stated that the case is also about the relation between trade mark law and freedom of expression: "We accept there cannot be an *a priori* hierarchy."⁹⁶ FXI maintained that the form of the communication was acceptable: "It lies in the essence of freedom of expression that it includes the freedom to choose the means of communication."⁹⁷ FXI noted: "In the 21st century we do not shout messages from rooftops or hang them on lamp posts."⁹⁸ The FXI submitted that trade mark dilution law should allow parody as an instance of "fair use" in the light of the constitutional right to freedom of expression.

This section considers how a succession of South African courts have interpreted the transgressive image of the "Black Labour, White Guilt" T-shirt. It highlights the range of hermeneutic strategies that were deployed to make sense of this unstable, ambiguous icon. Indeed, the "Black Labour, White Guilt" T-Shirt proved to be a Rorschach ink blot for judicial methodologies. It first considers the "Pro Logo" approach of the High Court of South Africa, and the Supreme Court of Appeal to the "Black Labour, White Guilt" T-shirts. Such lower courts maintained that the appropriation of the mark was an instance of "hate speech", and an abuse of freedom of speech. It secondly evaluates the judgment of Moseneke J in the Constitutional Court of South Africa that trade mark dilution requires economic or material harm. It also examines the jurist's reluctance to address wider constitutional issues. It finally examines the judgment of Sachs J in the Constitutional Court of South Africa, and his discussion of the importance of parody, laughter, and freedom of expression.

3.1 The High Court of South Africa (the Cape of Good Hope Provincial Division)

The litigation in the High Court of South Africa (the Cape of Good Hope Provincial Division) attracted a great deal of media attention – with the supporters of Laugh It Off Promotions staging colourful protests outside the court.

In the course of argument, the advocate for South African Breweries, Philip Ginsberg, SC, alleged that Laugh It Off Promotions had tarnished the Carling Black Label trade marks:

⁹⁵Ibid.

⁹⁶Ibid.

⁹⁷Ibid.

⁹⁸Ibid.

His [Nurse's] purpose is to create something that is controversial, eye-catching and sells T-shirts. This is shown by his other T-shirts that range from pornographic to derogative. The message of Laugh It Off is degrading and racially inflammatory, and it cannot be seen as humour or a parody. The purpose of the message is to attract attention in order to sell T-shirts and make money at the expense of someone else's property. If you allow T-shirts now, it will be mugs tomorrow. Inevitably, it will be everywhere and it will be the death of the trademark.⁹⁹

South African Breweries was concerned that the racial slur was likely to erode the exclusiveness of the mark, discourage people from purchasing the respondent's Black Label Beer and adversely curtail its opportunities to sponsor domestic sport.

At first instance, the High Court of South Africa (the Cape of Good Hope Provincial Division) considered the claims of South African Breweries that the words used on the T-Shirts conveyed the message that "the applicant has, in the past, exploited and continues deliberately to exploit black labour and is guilty of racial discrimination."¹⁰⁰ It was furthermore alleged: "The words used conjure up South Africa's racist past by falsely attributing to the applicant the "Lusty" and "lively exploitation of Black Labour since 1652".¹⁰¹ It was submitted that such messages were racially inflammatory.

The High Court of South Africa held that the message on the T-shirts carried a likelihood of material detriment to the distinctive character or repute of the marks. Cleaver J considered that Laugh It Off Promotions could not raise the defence of free expression because they had exploited the marks for gain: "The dividing line between the freedom of speech and the statutory protection afforded the applicant is a thin one, but is nonetheless one which has been transgressed by the respondent."¹⁰² The High Court held that the use of the marks was not mere parody that poked fun at the trade marks. Rather, it intimated that the publication engaged in "hate speech":

Its lampooning or parodying of the applicant's marks is not a "harmless clean pun which merely parodies or pokes fun" at the respondent's marks. It goes further than that by introducing the race factor, something which our Constitution and our new democracy are at pains to avoid. While the respondent's use of the marks may not amount to hate speech as contemplated in sections 16 (2) (c) of the Constitution, it can, I believe, be said to border on hate speech. The provisions of the Promotion of Equality and Prevention of Unfair Discrimination Act, No 4 of 2000 highlight the

⁹⁹ E Hollemans, "Court Hears of 'Death of the Trademark'", *Mail & Guardian Online*, 9 March 2005.

¹⁰⁰ *South African Breweries International v Laugh It Off Promotions CC* (3271/2002), the High Court of South Africa (Cape of Good Hope Provincial Division) [13].

¹⁰¹ *Ibid*, [13].

¹⁰² See note 18.

*importance which the legislature places on eliminating racial friction.*¹⁰³

The judge concluded: "In my view the use by the respondent of the applicant's marks can be said to demonstrate an intention to be hurtful or harmful to the applicant inasmuch as they are based on race, ethnic or social origin, and colour."¹⁰⁴

The decision for the High Court shows an antipathy towards culture jamming. First, the judgment suggests that Laugh It Off Promotions is contemptuous of law. It suggests that the T-shirts show a wilful disobedience and disrespect for the authority of the court. Second, the ruling maintains that the T-shirts display more than mere bad taste; there are a form of hate speech. The decision suggests that Laugh It Off Promotions is a purveyor of racial taunts and ethnic slurs. Third, the judgment shows no sympathy or understanding for the cultural modes of production used by Laugh It Off Promotions. The decision suggests that the work of the agent provocateurs shows bad taste and poor artistic standards, which do not meet the high standards of puns, parodies, and fun. Finally, the language of the decision shows a peculiar anthropomorphism. The judge attributes to a corporate entity – South African Breweries – hurt feelings and a wounded disposition. The phrase "hate speech" is usually directed towards groups and collectives – rather than a corporate entity.

Arguably, this is a peculiar misreading of the facts of the case. It would seem to be a distortion of the controversy to view it as an aggressive racist attack by Laugh It Off Promotions upon the delicate sensibilities of a helpless corporation.

3.2 The Supreme Court of Appeal

The Supreme Court of Appeal considered the arguments of Laugh It Off Promotions and FXI that the message was a parody of Sabmark's trade marks and, as such, entitled to freedom of expression protection.¹⁰⁵ In the course of the appeal, Harms JA considered comparative law on trade mark law and freedom of expression: "Although reliance will be placed in the course of this judgment on foreign case law it must be understood that it is done principally in order to illustrate or to compare."¹⁰⁶ With such caveats in mind, the judge considered legal developments on trade mark law and parody in the United States, Canada, and the European Union.

After this somewhat selective review of the comparative case law on trade mark law and parody, the Supreme Court of Appeal doubted whether the T-Shirts of Laugh It Off Promotions qualified as "fair parody". The judge observed:

Mr Nurse, who should know, ironically enough, described his use as satire and not as parody. Mr Welz, the editor of Noseweek who filed an affidavit in support of Nurse, was able to give a number of

¹⁰³ Ibid.

¹⁰⁴ Ibid.

¹⁰⁵ *Laugh It Off Promotions CC v South African Breweries International* (242/2003) [2004] ZASCA 76 (16 September 2004).

¹⁰⁶ See note 19.

*examples of true parody of trade marks as used in his publication. And as counsel for FXI accepted during argument, some of the appellant's other caricatures can be classified as parody and others not.*¹⁰⁷

The judge held that the appellant's reliance on parody as a defence was misconceived: "The appellant is using the reputation of Sabmark's well-known trade mark, which has been established at considerable expense over a lengthy period of time, in the course of trade in relation to goods to the detriment of the repute of the mark without any justification."¹⁰⁸ The judge concluded that the use and detriment was unfair and constituted an infringement of the trade mark dilution provisions.

The Supreme Court of Appeal held that the mark on the T-shirts conveyed the message that Sabmark was guilty of exploiting black labour and of racial discrimination, and that the message is likely to take unfair advantage or cause detriment to the trade marks. The judge acknowledged that a T-shirt could be a vehicle for political communication:

*One should recognise that in latter-day societies one-liners, sound bytes and SMS messages have become the favourite method of communication, replacing political, religious and social monographs and tracts. T-shirts fall in the same class and provide a powerful medium for making socio-political comments. As PJ O'Rourke once remarked somewhat sardonically – 'If Martin Luther were a modern ecologist, he would have to nail ninety-five T-shirts to the church door at Wittenberg.'*¹⁰⁹

The judge noted that "courts are in general not amused by sex- and drug-related 'parodies', even if they are clever or funny, simply because the prejudice to the trade mark tends to outweigh freedom of expression."¹¹⁰ His Honour also observed: "On the same principle, unfair or unjustified racial slurs on a trademark owner (even if not hate speech or approximating it) should in general not be countenanced, more so in a society such as ours."¹¹¹ The judge concluded that the constitutional right to freedom of expression did not protect Laugh It Off Promotions because it fed off the reputation of the trade mark in order to sell T-shirts, and could still express itself in other ways that do not harm Sabmark. His Honour noted: "The appellant's reliance on the freedom of expression is misplaced. It did not exercise its freedom, it abused it."¹¹²

The judgment was received with acclaim by some commentators. Writing in the *European Intellectual Property Review*, Dario F. Tanziani enthused:

¹⁰⁷ See note 36.

¹⁰⁸ See note 41.

¹⁰⁹ See note 29.

¹¹⁰ See note 31.

¹¹¹ Ibid.

¹¹² See note 41.

*This is a landmark decision by the Supreme Court of Appeal which sets out the limits to freedom of speech in using a trade mark to criticise the activities of the trade mark proprietor. Not only did the court set out limits to what would normally be regarded as parody or satire, but much emphasis was placed on the fact that Sabmark's trade marks were used by the infringer in relation to goods or services and in the course of trade.*¹¹³

The suggestion here is that Laugh It Off Promotions merely used the guise or semblance of parody and satire to engage in commercial activities.

However, the "Pro Logo" reasoning of the Supreme Court of Appeal can be criticised on a number of grounds.

First, the lower courts are too quick to accept that the "Black Labour, White Guilt" T-shirt tarnishes and dilutes the trade mark, without any firm evidence of economic or material harm. It is unclear how the corporate behemoth of South African Breweries has been harmed by the T-Shirt released by Laugh It Off Promotions. There is no evidence that the parody has resulted in a diminution in the sales of alcohol to South African consumers. Moreover, the judges tend to be selective in their reading of international precedents, ignoring the clear trend towards providing a safe harbour for parodies under trade mark law.

Second, the judges are rather prim and puritanical in misreading the T-shirt as a racial slur, without any qualities of humour or parody. It could be questioned whether the T-shirt produced by Laugh It Off Promotions constitutes "hate speech".¹¹⁴ The academic, Katharine Gelber, has sought to explain the phenomenon of "hate speech":

Hate speech enacts hatred, not just a psychological dislike for another human being but a manifestation of prejudice; systematic and institutionalised marginalisation which can be identified via considerable historical evidence. The 'hate' in hate speech is shorthand for a broader conception. Thus hate speech enacts prejudice in complex ways, and with concrete negative consequences for its targets. Subjected to an assessment of the operative principle of what it is that an expressive activity does in the saying of it, the minefield of whose free speech claims may be regarded as valid, and whose may not, becomes easier to navigate. Difficult cases, and differences of opinion, will always arise. But the

¹¹³ D Tanziani, "South Africa – Trade Marks – Tarnishing of Marks – Defence of Freedom of Speech", (2005), 27 *European Intellectual Property Review* N4-9 at 9.

¹¹⁴ It is perhaps, though, not surprising, that there should be a heated debate over the racial connotations of the work of Laugh It Off Promotions. Such disagreements and misunderstandings have been not uncommon post-apartheid South Africa. Notably, there was an ill-tempered debate over *Disgrace*, a novel by Nobel Laureate, J.M. Coetzee. Opinion was divided as to whether the book was an enlightened work of literary endeavour, or a thinly veiled racist text. The controversy, in part, led to Coetzee leaving South Africa to live in Australia. ANC. 'Statement of the ANC Statement of the ANC at the Human Rights Commission Hearings on Racism in the Media', 5 April 2000, <http://www.anc.org.za/ancdocs/misc/2000/sp0405.html>; and G Makhaya 'The Trouble with Coetzee', (2005), 4 (2) *The Oxonian Review of Books*, <http://www.oxonianreview.org/issues/3-2/3-2-5.htm>.

*primary consideration ought to be a measure of the impact of one's expressive activities on oneself and others.*¹¹⁵

In light of such a definition, it is difficult to accept that the T-Shirt disseminated by Laugh It Off Promotions is an instance of “hate speech” designed to enact racial hatred. It also appears to be very strange to characterise criticism of a corporation as “hate speech”, and attribute to such an entity hurt and wounded feelings. It would be more accurate to say that the South African Breweries are complaining of so-called “corporate libel” and “product disparagement”.¹¹⁶ It is not clear that trade mark law should provide such collateral protection for corporate reputation.

Third, the Supreme Court of Appeal tended to crudely define the cultural production of Laugh It Off Promotions. The judges draw a binary opposition between “parody” and “satire”. The Supreme Court of Appeal suggests that “parody” – or at least “fair parody” is acceptable, because it involves the criticism of the trade mark itself. However, in its view, “satire” is not acceptable, because it involves larger political and social commentary. The judges seem to accept that the arguments of the South African Breweries that the particular T-shirt in question is something less than a “parody”; but might constitute a “satire”. Confusingly, the judges accepted the argument of the South African Breweries that some of the appellant’s other caricatures can be classified as parody and others not. Such quibbling, pettifogging reasoning is questionable. Scholars have shown that there are strong inter-connections between the practices of “parody” and “satire”.¹¹⁷ Margaret Rose notes that “there are several distinct differences between parody and satire – such as the way in which the parody may make its target contribute to its own text – but that parody may be used by the satirist to attack an author or reader through the evocation and mockery of a particular work with which they may be associated.”¹¹⁸ In any case, it is arguable that “satire” is more deserving of protection as free speech because of its political content. A larger concern is that the terminology of “parody” and “satire” seems aesthetically distant and remote from the cultural practices of culture jamming. There is a failure on the part of the Supreme Court of Appeal to comprehend the aesthetic tradition of culture jamming and “adbusting” that Laugh It Off Promotions is working in.

Finally, the lower courts wrongly give short shrift to constitutional protections of freedom of expression in their analysis. Eric Barendt has complained about the tendency of courts to avoid dealing with the constitutional ramifications of intellectual property rights: “These areas of law have developed apart from free speech jurisprudence”.¹¹⁹ He maintains: “No historical or doctrinal account can justify the immunity of these rights from careful free speech scrutiny.”¹²⁰ Similarly, Neil Netanel

¹¹⁵K Gelber “Hate Speech and the Australian Legal and Political Landscape” in K Gelber, A Stone (eds), *Hate Speech and Freedom of Speech in Australia* (2007), p 16.

¹¹⁶ J Latham, “The First Amendment and the Basis of Liability in Actions for Corporate Libel and Product Disparagement”, (1978), 27 *Emory Law Journal* 755-790.

¹¹⁷ M Rose, *Parody: Ancient, Modern, and Post-Modern*, (1993).

¹¹⁸ *Ibid.*, p. 86.

¹¹⁹ E Barendt, *Freedom of Speech: Second Edition*, (2005), p. 263.

¹²⁰ *Ibid.*

has noted similar tendencies at work in the field of copyright law.¹²¹ He comments that copyright law has failed to be an “engine of free expression”: “Copyright’s speech burdens cut a wide swath, chilling core political speech such as news reporting and political commentary, as well as church dissent, historical scholarship, cultural critique, artistic expression, and quotidian entertainment”.¹²² There is a need to subject intellectual property rights to much greater constitutional scrutiny as to their impact upon freedom of speech. The scope, nature and character of intellectual property rights should be shaped according to its impact upon the constitutional goals of “robust debate and expressive diversity”.¹²³

3.3 The Constitutional Court of South Africa

In *Laugh It Off Promotions v. South African Breweries International*, the Constitutional Court of South Africa upheld the appeal by Laugh It Off Promotions against the decisions of the lower courts that it had committed trade mark dilution.¹²⁴ Moseneke J wrote the lead judgment for the unanimous Constitutional Court of South Africa. There is a supplementary judgment from Sachs J. Although respectful of the judgment of Moseneke J, his Honour believed that the decision failed to grasp some of the substantive matters at hand: “I believe that when balancing the different interests involved it failed to appreciate why the parodic use of the trademark in the milieu in which Laugh it Off operated was central to its critical project.”¹²⁵ The Constitutional Court of South Africa considered four key issues: the role of trade mark dilution protection; the need for evidence of material harm; the nature of culture jamming; and the ramifications of constitutional protection of freedom of speech.

First, the judges considered the history and nature of trade mark dilution as a legal doctrine.

Moseneke J observes that the dilution of a trade mark can occur in two ways, by blurring or by tarnishment. He notes: “Blurring takes place when the distinctive character or inherent uniqueness of the trade mark is weakened or reduced.”¹²⁶ By contrast, he observes: “Tarnishment occurs where unfavourable associations are created between a well-known registered trade mark and the mark of the unauthorised user.”¹²⁷ Moseneke J commented that the South African provisions similar were to those found in the European Directive,¹²⁸ United Kingdom trade mark law,¹²⁹ and the

¹²¹ N Netanel, *Copyright's Paradox*, (2008).

¹²² *Ibid.*, p. 6.

¹²³ *Ibid.*, p. 11.

¹²⁴ *Laugh It Off Promotions CC v South African Breweries International* (Case CCT 42/04) [2005] (27 May 2005), the Constitutional Court of South Africa.

¹²⁵ See note 74.

¹²⁶ See note 41.

¹²⁷ *Ibid.*

¹²⁸ Article 5(2) of the First Directive of the Council of the European Union (89/104 of 21 December 1988) provides that: “Any Member State may also provide that the proprietor shall be entitled to prevent all third parties not having his consent from using in the course of trade any sign which is

United States *Federal Trademark Dilution Act* 1995 (US).¹³⁰ However, there was one important difference. The South African legislation required a likelihood of unfair advantage or detriment - rather than proof of actual detriment or unfair advantage.

In his judgment, Sachs J recognises the social importance of trade mark protection. He cites the words of Frankfurter J, "The protection of trade-marks is the law's recognition of the psychological function of symbols."¹³¹ Sachs J comments:

*From the producer's side, trademarks promote invention, protect investment and enhance market-share by securely identifying a product or service. From the consumer's point of view, they facilitate choice by identifying the product and guaranteeing its provenance and presumed quality. Furthermore, although this case has been presented as a David and Goliath contest, it is not only the Goliaths of this world who need trademark protection. Small entrepreneurs fighting to increase their share of the market against the Goliaths strive energetically to identify their uniqueness and that of their products and services.*¹³²

His Honour observed: "In a society driven by consumerism and material symbols, trademarks have become important marketing and commercial tools that occupy a prominent place in the public mind."¹³³ The judge commented: "Consequently, companies and producers of consumer goods invest substantial sums of money to develop, publicise and protect the distinctive nature of their trademarks; in the process, well-known trademarks become targets for parody."¹³⁴

identical with, or similar to, the trade mark in relation to goods or services which are not similar to those for which the trade mark is registered, where the latter has a reputation in the Member State and where use of that sign without due cause takes unfair advantage of, or is detrimental to, the distinctive character of the repute of the trade mark."

¹²⁹ Section 10(3) the *Trade Marks Act* 1994 (UK) provides: "A person infringes a registered trade mark if he uses in the course of trade a sign which - (a) is identical or similar to the trade mark, and (b) is used in relation to goods and services which are not similar to those for which the trade mark is registered, where the trade mark has a reputation in the United Kingdom and the use of the sign, being without cause, takes unfair advantage of, or is detrimental to, the distinctive character or repute of the trade mark."

¹³⁰ Section 43 (c) (1) of the *Trademark Act* of 1946 (15 U. S. C. 1125) as amended in 1996 provides: "The owner of a famous mark shall be entitled, subject to the principles of equity and upon such terms as the court deems reasonable, to an injunction against another person's commercial use in commerce of a mark or trade name, if such use begins after the mark has become famous and causes dilution of the distinctive quality of the mark, and to obtain such other relief as is provided in this subsection."

¹³¹ *Laugh It Off Promotions CC v South African Breweries International* (Case CCT 42/04) [2005] (27 May 2005), the Constitutional Court of South Africa, [80].

¹³² See note 80.

¹³³ See note 78.

¹³⁴ *Ibid.*

Second, the judges questioned whether South African Breweries had provided sufficient evidence of material harm, which could be attributed to the T-shirts of Laugh It Off Promotions.

Citing the Supreme Court of the United States decision in *Moseley v. Victoria's Secret Catalogue, Inc.*,¹³⁵ Moseneke J emphasized that "in order to succeed the owner of the mark bears the onus to demonstrate likelihood of substantial harm or detriment which, seen within the context of the case, amounts to unfairness."¹³⁶ Moseneke J comments that the evidence that there had been material detriment in this particular case was weak:

*It is appropriate to observe that the mere fact that the expressive act may indeed stir discomfort in some and appear to be morally reprobate or unsavoury to others is not ordinarily indicative of a breach of section 34(1)(c). Such a moral or other censure is an irrelevant consideration if the expression enjoys protection under the Constitution. Of course freedom of expression is not boundless but may not be limited in a manner other than authorised by the Constitution itself such as by the law of defamation. The constitutional guarantee of free expression is available to all under the sway of our Constitution, even where others may deem the expression unsavoury, unwholesome or degrading. To that extent ordinarily such meaning should enjoy protection as fair use and should not amount to tarnishment of the trade marks.*¹³⁷

His Honour comments that "in a claim under section 34 (1) (c), a party that seeks to oust an expressive conduct protected under the Constitution must, on the facts, establish a likelihood of substantial economic detriment to the claimant's mark."¹³⁸ The judge stressed the need for economic and trade harm: "In essence the protection is against detriment to the repute of the mark; and not against the dignity but the selling magnetism of the mark."¹³⁹ The judge noted: "In an open democracy valuable expressive acts in public ought not to be lightly trampled upon by marginal detriment or harm unrelated to the commercial value that vests in the mark itself."¹⁴⁰ Considering the facts of the case, Moseneke J commented: "There is not even the slightest suggestion that, from the time the T-shirts saw the light of day to the date the interdict proceedings were launched, there had been a real possibility of a reduction of its market dominance or compromised beer sales".¹⁴¹

¹³⁵ *Moseley v Victoria's Secret Catalogue, Inc.*, 537 U.S. 418 (2003).

¹³⁶ *Laugh It Off Promotions CC v South African Breweries International* (Case CCT 42/04) [2005] (27 May 2005), the Constitutional Court of South Africa, [50].

¹³⁷ See note 55.

¹³⁸ See note 56.

¹³⁹ *Ibid.*

¹⁴⁰ *Ibid.*

¹⁴¹ See note 57.

Sachs J agrees with the central proposition of the lead judgment - "namely, that in the context of our country's free speech values SAB have failed to prove the likelihood of any appreciable detriment to the marketability of their beer."¹⁴² The judge considers the argument that the imputation of racist labour practices in the past would tarnish the goodwill associated with the trade mark thereby creating unfair detriment. His Honour doubts that the sale of the T-Shirts had a negative impact upon the image of the Carling Black Label: "There is no proof whatsoever that imputations of racist labour practices in the past by SAB would in any way affect the eagerness of present day customers to down another glass of Carling Black Label".¹⁴³ The judge observed ruefully: "There is hardly an institution in South Africa that has not in the recent period been accused of being associated in one way or another with racist practices".¹⁴⁴ Indeed, the judge noted that the evidence suggested that the small community of media-literate purchasers acquired the T-shirt precisely because it poked fun at enterprises considered as taking themselves too seriously: "The game in which they participated was one of vivacious word-play, not solemn social history."¹⁴⁵ The judge concluded: "The Laugh it Off campaign was to get them to laugh, not to hate; and laugh, it appears, is what they did."¹⁴⁶

Third, the judges discussed whether the cultural content of the Laugh It Off Promotions T-Shirt was relevant to a determination of trade mark infringement and dilution.

Moseneke J observed that parody is a relevant factor in determining whether the use of a work is fair within the meaning of section 34 (1) (c) but not an absolute defence to a claim of infringement of a trade mark. He considered whether the message on the T-Shirt was an unjustified racial slur, or a justified parody. Moseneke J considered the competing interpretative meanings given to the protest:

*The difficult issue is whether the interpretation of the offending message in this case yields more than one plausible meaning. Before us the respondent argued that like the SCA this Court must grasp the nettle and support only one plausible meaning of the message. The applicant and the amicus argue that the message lends itself to at least one other reasonable meaning being that the statement is a critical but parodic comment on the methods used by SAB to market its beer by targeting male workers and in particular black male workers and should therefore be protected as fair use under section 34 (1) (c) read with the Constitution.*¹⁴⁷

¹⁴² See note 73.

¹⁴³ See note 98.

¹⁴⁴ Ibid.

¹⁴⁵ See note 99.

¹⁴⁶ Ibid.

¹⁴⁷ See note 61.

However, Moseneke J refrained from making any finding on the question of the fair use of a trade mark under section 34 (1) (c) and freedom of expression. His Honour observed that it was unnecessary to consider the fairness of the parody or the satire because "no likelihood of economic prejudice has been established."¹⁴⁸ The judge concluded: "It must always be kept in mind that, unlike in the US, in our jurisprudence there are no enclaves of protected expression such as parody or satire and therefore the mere characterisation of an expression as such would not be decisive of what is fair use under our anti-dilution protection of section 34(1)(c) because ordinarily all categories of expression, save those excluded by the Constitution itself, enjoy constitutional shield and may be restricted only in a way constitutionally authorised."¹⁴⁹

By contrast, Sachs J is much more appreciative of the cultural practices of culture jamming. Sachs J argued that the earlier decisions had "over-emphasised the fact that the T-shirts were sold at a profit" and at the same time "gave far too little regard to the uniquely expressive weight of the parodic form used".¹⁵⁰ Sachs J notes: "At the heart of this matter lies the legal dilemma posed by the fact that Laugh it Off utilised the SAB brand, not adventitiously, but deliberately and precisely in order to challenge SAB's use of branding".¹⁵¹ His Honour recognised that Laugh It Off "employed the enemy's brand to denounce the power of branding in general, and to confront the employment of trademark law, in our country as elsewhere, to suppress free speech."¹⁵² The judge noted: "There is nothing in our law to suggest that parody is a separate defence."¹⁵³ Rather, in his view, it was a factor that should be considered as an element in the overall analysis. Citing the United States Court of Appeals decision in *Dr Seuss Enterprises v. Penguin Books*,¹⁵⁴ Sachs J observed: "Parody, like any other use, has to work its way through the relevant factors and be judged case by case, in light of the ends of trademark law and the free speech values of the Constitution."¹⁵⁵ His Honour observes that an independent observer must "say that the harm done by the parody to the property interests of the trademark owner outweighs the free speech interests involved."¹⁵⁶ The judge held: "The fact that the comedian is paid and the newspaper and T-shirts are sold, does not in itself convert the expression

¹⁴⁸ See note 66.

¹⁴⁹ Ibid.

¹⁵⁰ See note 74.

¹⁵¹ See note 75.

¹⁵² Ibid.

¹⁵³ See note 81.

¹⁵⁴ *Dr. Seuss Enterprises v Penguin Books USA* (1997) 109 F. 3d 1394.

¹⁵⁵ *Laugh It Off Promotions CC v South African Breweries International* (Case CCT 42/04) [2005] (27 May 2005), the Constitutional Court of South Africa, [81].

¹⁵⁶ See note 82.

involved into a mere commodity."¹⁵⁷ He noted that Laugh It Off Promotions "chose parody as a means, and invited young acolytes to join their gadfly laughter."¹⁵⁸

Finally, the judges considered the relationship between anti-dilution protection and freedom of expression.

Moseneke J emphasized that the litigation in this matter was not a frivolous matter:

*The interplay between free expression and intellectual property in the form of trade marks is not merely academic. It is a matter that has important and abiding implications for the workings of our economy and is of concern to the broader public.*¹⁵⁹

His Honour highlights the key constitutional issue at play in the litigation: "This case brings to the fore the novel, and rather vexed, matter of the proper interface between the guarantee of free expression enshrined in section 16 (1) of the Constitution and the protection of intellectual property rights attaching to registered trade marks as envisaged by section 34 (1) (c) of the *Trade Marks Act* 194 of 1993."¹⁶⁰ The judge favoured a construction of trade mark law, which was compatible with the right to free expression: "The anti-dilution provision must bear a meaning which is the least destructive of other entrenched rights and in this case free expression rights".¹⁶¹ The judge cites with approval the earlier decision in *Klimax Manufacturing Ltd v. VanResnburg*¹⁶² which emphasized that the new trade mark dilution laws must be interpreted, so "that the legitimate interests of proprietors of *well-known* trade marks are protected while, at the same time, not creating an absolute monopoly or a form of copyright in a trade mark."¹⁶³

In his judgment, Sachs J expressed concern from a constitutional point of view that even the threat of litigation can stifle legitimate debate. He notes that companies have a significant power advantage in such conflicts because of their access to wealth, the media, and the government: "The companies that own famous trademarks exert substantial influence over public and political issues, making them and their marks ripe and appropriate targets for parody and criticism."¹⁶⁴ Sachs J comments:

Yet when applied against non-competitor parody artists, the tarnishment theory of trademark dilution may in protecting the

¹⁵⁷ See note 108.

¹⁵⁸ *Ibid.*

¹⁵⁹ See note 30.

¹⁶⁰ See note 1.

¹⁶¹ See note 48.

¹⁶² *Klimax Manufacturing Ltd v Van Resnburg* [2004] 2 All SA 301(O).

¹⁶³ *Laugh It Off Promotions CC v South African Breweries International* (Case CCT 42/04) [2005] (27 May 2005), the Constitutional Court of South Africa, [48, footnote 56].

¹⁶⁴ See note 105.

reputation of a mark's owner, effectively act as a defamation statute. As such it, could serve as an over-deterrent. It could chill public discourse because trademark law could be used to encourage prospective speakers to engage in undue self-censorship to avoid the negative consequence of speaking – namely, being involved in a ruinous lawsuit. The cost could be inordinately high for an individual faced with a lawsuit aimed at silencing a critic, not only in terms of general litigation expenses, but also through the disruption of families and emotional upheaval. Such protracted vexation can have the effect of discouraging even the hardest of souls from exercising their free speech rights.¹⁶⁵

Sachs J considers that constitutional law should seek to prevent the suppression of subversive acts of laughter and humour: “The Constitution cannot oblige the dour to laugh. It can, however, prevent the cheerless from snuffing out the laughter of the blithe spirits among us”.¹⁶⁶ The judge observed that “we are obliged to interpret the law in a manner which protects the right of bodies such as Laugh it Off to advance subversive humour.”¹⁶⁷ His Honour noted: “The protection must be there whether the humour is expressed by mimicry in drag, or cartooning in the press, or the production of lampoons on T-shirts.”¹⁶⁸ Sachs J emphasized: “What has been relevant in the present matter is that the context was one of laughter being used as a means of challenging economic power, resisting ideological hegemony and advancing human dignity.”¹⁶⁹ The judge concluded: “Indeed, if our society became completely solemn because of the exercise of state power at the behest of the worthy, not only would all irrelevant laughter be suppressed, but temperance considerations could end up placing beer-drinking itself in jeopardy.”¹⁷⁰

The decision of the Constitutional Court of South Africa is an enlightened judgment on trade-mark dilution, culture jamming, and freedom of expression. The decision provides a strong explanation of the origins, nature, and evolution of the doctrine of trade mark dilution. The judges emphasize, though, the need for trade mark owners to prove the likelihood of any appreciable detriment to the reputation of trade marks. The two judgments of the Constitutional Court of South Africa consider the culture nature of the work of Laugh It Off Promotions. The decision of Sachs J is superior in this regard because it shows a particular sensitivity and understanding of the practices of culture jamming. The ruling of the Constitutional Court of South Africa also considers the interplay between intellectual property and constitutional law in a deft and elegant way. The two judgments offer a thoughtful meditation on the how intellectual property rights should be read in light of larger constitutional considerations about freedom of political expression and freedom of artistic creativity.

¹⁶⁵ See note 106.

¹⁶⁶ See note 107.

¹⁶⁷ See note 108.

¹⁶⁸ Ibid.

¹⁶⁹ Ibid.

¹⁷⁰ Ibid.

3.4 Aftermath of the Litigation

Laugh It Off Promotions was understandably elated by the decision of the Constitutional Court of South Africa. The t-shirt company's founder Justin Bartlett Nurse observed: "It's cool: I feel like Steven Gerrard [sublime Liverpool and England football player], except without the boots".¹⁷¹ He conjectured: "It is an important case, and in some respects an international legal precedent has been set."¹⁷² In celebration of the decision, Laugh It Off Promotions auctioned 1,000 "Black Labour/White Guilt" t-shirts off on its website, and donated the proceeds to an anti-alcohol abuse charity. The group has been emboldened and reinvigorated by the decision of the Constitutional Court. Laugh It Off Promotions has released its latest annual book under a Creative Commons licence that permits copying and re-mixing. A partner of the company observed: "If people want to use the work as an inspiration or a point of departure for a new work and they give the authors credit, that's great."¹⁷³ The judgment of the Constitutional Court of South Africa has also deterred and discouraged various trade mark owners from pursuing actions for trade mark infringement and dilution against Laugh It Off Promotions.

FXI emphasized that the decision "sends a strong message to commercial companies in the country who attempt to trump freedom of expression in future that the Court will speak with one voice in rejecting the Constitutionality of such attempts."¹⁷⁴ FXI hailed the judgment:

*The ruling represents a triumph of freedom of expression over intellectual property rights. The Court has prioritized the right of cultural activists to engage in speech that is critical of the pervasive power of trademarks in everyday life over the right of SAB to protect its intellectual property; in the process, it has opened the space for activists who engage in 'cultural jamming' - or the criticism of commercial speech through parody - to have their activities constitutionally protected. Trademarks such as the 'Black Label' logo are pervasive in South African public space; they command significant public attention given the financial resources they command to get their messages across. It is correct that cultural activists like the Laugh it Off team are allowed to put their parodies of these trademarks into public space as well, and that this right should be protected.*¹⁷⁵

FXI noted that the fact that Laugh it Off gained commercially from the sale of their T-shirt mattered little, because it had not resulted in significant prejudice to the Black

¹⁷¹A Taylor, "SAB 'Surprised' at Ruling", *Finance* 24, 27 May 2005, http://www.finance24.com/articles/default/display_article.asp?Nav=ns&ArticleID=1518-24_1712335.

¹⁷² Ibid.

¹⁷³ Ibid.

¹⁷⁴ Freedom of Expression Institute. "FXI welcomes court ruling on Laugh It Off's "Black Labour, White Guilt" T-shirt", 31 May 2005.

¹⁷⁵ Ibid.

Label trade mark. It observed: "The SAB action can only be interpreted as bully-boy tactics trying to stamp on the rights of ordinary people, and the FXI welcomes the fact that the Court has put them in their place."¹⁷⁶ FXI concluded: "The judgement should hopefully ensure that commercial companies will desist from using their financial muscle to play corporate bullies, threatening to run those who parody the commodification of public space out of business".¹⁷⁷ The decision has had immediate repercussions for other South African cases dealing with intellectual property and freedom of expression. As a result of the decision, the South African telecommunications carrier, Telkom, withdrew its defamation and copyright infringement case against the creators of Hellkom, a satirical site protesting against the high tariffs and poor service of the company [Figures 19 and 20].

In response to the decision, South African Breweries complained that trade marks were threatened by the decision of the Constitutional Court that a t-shirt maker has the right to mock its Carling Black Label brand:

The decision suggests the dignity or reputation of a trademark will not be afforded protection in itself. In other words, you can disparage a brand as long as the sales of that brand are not likely to be reduced. This, we believe, could be of concern to trademark holders.

*We fully support freedom of expression. However, it has always been our view that this issue is not one that involves genuine freedom of expression. Trade marks are important commercial assets of a company and, like any other company, large or small, we have an obligation to protect our trade mark rights and brand equity and reputation.*¹⁷⁸

Perhaps the company needs to reconsider its policy in respect of trade mark enforcement. As Jeremy Phillips counsels, "brand owners should be taught that litigation need not be the first step but the last course of action, after all else fails."¹⁷⁹ He also recommends that "brand owners have to realize that trade mark laws have built-in mechanisms which require them to face criticism, even if that criticism explicitly mentions the trade marks upon which it is based."¹⁸⁰ Indeed, it is striking that a number of trade mark owners targeted by Laugh It Off Promotions – including such well-known entities such as Kentucky Fried Chicken, Shell, e-tv, Diesel, McDonald's,¹⁸¹ Virgin, and National Lottery – refrained from litigation. Some of

¹⁷⁶ Ibid.

¹⁷⁷ Ibid.

¹⁷⁸ A Taylor, "SAB 'Surprised' at Ruling", *Finance 24*, 27 May 2005, http://www.finance24.com/articles/default/display_article.asp?Nav=ns&ArticleID=1518-24_1712335.

¹⁷⁹ J Phillips, *Trade Mark Law: A Practical Anatomy*, (2003), p. 667.

¹⁸⁰ Ibid, p. 667.

¹⁸¹ McDonald's was perhaps wary of entering into litigation after the public relations disaster of the 'McLibel' case. *McDonald's Restaurants v Morris and Steel (McLibel case)* [1997] EWHC QB 366;

those parties, though, have been willing to take action for trade mark infringement in other factual circumstances and scenarios.

4. **Trade mark dilution**

Trade marks are often selected for their effervescent qualities, and then injected into the stream of communication with the pressure of a firehose by means of mass media campaigns. Where trade marks come to carry so much communicative freight, allowing the trade mark holder to restrict their use implicates our collective interest in free and open communication.

Justice Alex Kozinski¹⁸²

The decision of the Constitutional Court of South Africa in *Laugh It Off Promotions v. South African Breweries International* has attracted the odd admirer outside South Africa – particularly for the eloquent prose of Sachs J.¹⁸³ However, the decision has been thus far overlooked by superior courts in other jurisdictions. Arguably, the ruling in *Laugh It Off Promotions v. South African Breweries International* is a persuasive precedent, which should be followed in other jurisdictions. Katja Weckström has observed that there is a need to take notice of decisions of superior courts, such as the Constitutional Court of South Africa: “Since national trademark rules share a common source, national courts should look to prior decisions on the issue by other courts and engage in an international dialogue”.¹⁸⁴ It remains to be seen whether other jurisdictions will follow the decision of the Constitutional Court of South Africa, especially those with weaker constitutional protections of civil and political rights to freedom of expression. As Sachs J notes: “The tension in modern society between the need to protect both free speech and intellectual property... results in court decisions that are highly fact-sensitive, and not easily transported.”¹⁸⁵

Arguably, the decision of the Constitutional Court of South Africa in *Laugh It Off Promotions CC v. South African Breweries International* could be helpful in resolving policy disputes over trade mark dilution in other jurisdictions. The judges in the Constitutional Court of South Africa demonstrate a larger awareness of comparative law dealing with trade mark dilution and parodies. Particular reference is made to United States case law on trade mark dilution and parodies. The Supreme Court of the

Morris and Steel v McDonald's Restaurants [1999] EWCA Civ 1144; and *Steel and Morris v The United Kingdom* [2005] ECHR (Application no. 68416/01).

¹⁸² A Kozinski, “Trademarks Unplugged”, (1993), 68 *New York University Law Review* 960 at 973.

¹⁸³ D Pannick, ‘When Is A Joke A Constitutional Issue? When It’s A Brand Of Parody; Bar Conference 2005’, *The Times*, 11 October 2005.

¹⁸⁴ K Weckström, “The Lawfulness of Criticizing Big Business: Comparing Approaches to the Balancing of Societal Interests Behind Trademark Protection”, (2007), 11 *Lewis & Clark Law Review* 671-700.

¹⁸⁵ *Laugh It Off Promotions CC v South African Breweries International* (Case CCT 42/04) [2005] (27 May 2005), the Constitutional Court of South Africa, [70, footnote 2].

United States considered the operation of the *Federal Trademark Dilution Act 1995* (US) in *Moseley v. Victoria's Secret Catalogue, Inc.*¹⁸⁶ There has been much consternation about this decision, especially from trade mark loyalists who fear that the Bench has set the standard of harm for trade mark dilution far too high. There has been concern that lower courts have inconsistently applied the principles of trade mark dilution. Certainly, there have been conflicting outcomes and results in respect of trade mark actions against parodists. In response to such concerns, the United States Congress has passed the *Trademark Dilution Revision Act 2006* (US). This legislation seeks to lower the standard of harm for trade mark owners, and clarifying the meaning of key concepts; but broadening the available defences for trade mark users. Arguably, there is a need to subject such intellectual property rights to constitutional scrutiny to ensure that they do not have a chilling effect upon freedom of speech, and freedom of communication.

4.1 Trade Mark Dilution and Victoria's Secret Catalogue

The phrase, "trademark dilution", was first coined by Frank Schechter in the *Harvard Law Review* in 1927.¹⁸⁷ He observed that "dilution" involved "the gradual whittling away or dispersion of the identity and hold upon the public mind of the mark or name by its use upon non-competing goods".¹⁸⁸

The magisterial treatise writer on trade mark law, J. Thomas McCarthy, has lamented that trade mark dilution has been the source of great confusion and misunderstanding in the judiciary, the profession, and the academy:

*No part of trademark law that I have encountered in my forty years of teaching and practicing IP law has created so much doctrinal puzzlement and judicial incomprehension as the concept of 'dilution' as a form of intrusion on a trademark. It is a daunting pedagogical challenge to explain even the basic theoretical concept of dilution to students, attorneys and judges. Few can successfully explain it without encountering stares of incomprehension or worse, nods of understanding which mask and conceal bewilderment and misinterpretation.*¹⁸⁹

There has been much debate about the merits of trade mark dilution. Some commentators see trade mark dilution as an unwelcome sui generis regime, which distorts the traditional balances laid by trade mark law. Robert Klieger has argued that trade mark dilution law poses an anti-competitive threat to market efficiency and

¹⁸⁶ *Moseley v Victoria's Secret Catalogue, Inc.*, 537 U.S. 418 (2003).

¹⁸⁷ Frank Schechter, "The Rational Basis of Trademark Protection", (1927), 40 *Harvard Law Review* 813, 825.

¹⁸⁸ *Ibid.*

¹⁸⁹ J T McCarthy, "Dilution of a Trademark: European and United States Law Compared", (2004), 94 *Trademark Reporter* 1163-1181.

consumer welfare.¹⁹⁰ However, others have embraced trade mark dilution as a welcome judicial and legislative innovation. Jason Bosl and has defended the merits of trade mark dilution: "Trade mark dilution is not only a private concern for the trade mark owner - it also involves a concurrent public detriment in the lessening of a relatively stable language by which to contribute to public and cultural discourse".¹⁹¹

On January 16, 1996, United States President Bill Clinton signed into law new federal trade mark dilution laws. Section 43 (c) (1) of the *Federal Trademark Dilution Act 1995* (US) provides: "The owner of a famous mark shall be entitled, subject to the principles of equity and upon such terms as the court deems reasonable, to an injunction against another person's commercial use in commerce of a mark or trade name, if such use begins after the mark has become famous and causes dilution of the distinctive quality of the mark, and to obtain such other relief as is provided in this subsection." The legislation stipulated a number of factors to be taken into account in such determinations.¹⁹² Section 45 provided: "The term 'dilution' means the lessening of the capacity of a famous mark to identify and distinguish goods or services, regardless of the presence or absence of (1) competition between the owner of the famous mark and other parties, or (2) likelihood of confusion, mistake, or deception."

In *Moseley v. Victoria's Secret Catalogue, Inc.*, the Supreme Court of the United States considered a claim for trade mark dilution by the lingerie store, Victoria's Secret, against a Kentucky store selling lingerie under the brand "Victor's Little Secret".¹⁹³ The decision offered the bench an opportunity to rule upon the *Federal Trademark Dilution Act 1995* (US).

There were a number of submissions from *amicus curiae*, friends of the court. Moseley was supported in part by the United States Government. An intellectual property professor, Malla Pollack, contended that trade mark dilution required evidence of actual harm because of larger constitutional concerns: "Removing the actual harm element of the Federal Trademark Dilution Act 1995 (US) would unnecessarily multiply constitutional issues under both the First Amendment and the Copyright and Patent Clause".¹⁹⁴ Victoria's Secret Catalogue Inc. was supported by the International Trademark Association, the American Bar Association, the American Intellectual Property Law Association, Intellectual Property Professors, the

¹⁹⁰ R Klieger, "Trademark Dilution: The Whittling Away of the Rational Basis for Trademark Protection", (1997), 58 *University of Pittsburgh Law Review* 789.

¹⁹¹ J Bosland, "The Culture of Trade Marks: An Alternative Cultural Theory Perspective", (2005), 10 *Media & Arts Law Review* 99-116.

¹⁹² Factors to be taken into account included "the degree of inherent or acquired distinctiveness of the mark"; "the duration and extent of use of the mark in connection with the goods or services with which the mark is used; "the duration and extent of advertising and publicity of the mark"; "the geographical extent of the trading area in which the mark is used;" the channels of trade for the goods or services with which the mark is used;" "the degree of recognition of the mark in the trading areas and channels of trade used by the marks"; "owner and the person against whom the injunction is sought"; and "the nature and extent of use of the same or similar marks by third parties."

¹⁹³ *Moseley v Victoria's Secret Catalogue, Inc.*, 537 U.S. 418 (2003).

¹⁹⁴ M Pollack, "Brief in support of the appellants in *Moseley v Victoria's Secret Catalogue, Inc.*", 2002 WL 1404641 (24 June 2002).

Intel Corporation, Ringling Bros-Barnum & Bailey Combined Shows and various other trade mark owners.

In the course of oral argument, the parties discussed the impact of trade mark law upon parodies. On behalf of the respondents, Moseley, Mr Dellinger observed: "Congress... made it absolutely clear that it wanted the safe harbors read as broadly as possible to ensure that there was no restriction on First Amendment rights, so the courts are warmly invited to create as large a safe harbor for parody."¹⁹⁵ He observed that tarnishment had been restricted in case law to unsavoury associations, with sex and drug use:

*People can use the term, Victoria's Secret, for any purpose they want in parody and commentary, on the steps of the courthouse. They just can't make this one use of it, that is a commercial use in commerce that lessens the capacity of that mark to carry out its function that Congress so clearly had in mind when it passed the Federal Trademark Dilution Act 1995 (US).*¹⁹⁶

His suggestion was that the Moseley brand "Victor's Little Secret" did not constitute trade mark dilution.

In the leading opinion, Stevens J observed that the *Federal Trademark Dilution Act 1995 (US)* intended "to protect famous trademarks from subsequent uses that blur the distinctiveness of the mark or tarnish or disparage it."¹⁹⁷ His Honour emphasized that actual dilution had to be established, not merely a likelihood of dilution:

*The record in this case establishes that an army officer who saw the advertisement of the opening of a store named "Victor's Secret" did make the mental association with "Victoria's Secret," but it also shows that he did not therefore form any different impression of the store that his wife and daughter had patronized. There is a complete absence of evidence of any lessening of the capacity of the Victoria's Secret mark to identify and distinguish goods or services sold in Victoria's Secret stores or advertised in its catalogs. The officer was offended by the ad, but it did not change his conception of Victoria's Secret. His offense was directed entirely at petitioners, not at respondents. Moreover, the expert retained by respondents had nothing to say about the impact of petitioners' name on the strength of respondents' mark.*¹⁹⁸

Stevens J observed that "direct evidence of dilution such as consumer surveys will not be necessary if actual dilution can reliably be proven through circumstantial evidence

¹⁹⁵ Oral argument in *Moseley v Victoria's Secret Catalogue, Inc.*, 2002 WL 31643067.

¹⁹⁶ Oral argument in *Moseley v Victoria's Secret Catalogue, Inc.*, 2002 WL 31643067.

¹⁹⁷ *Moseley v Victoria's Secret Catalogue, Inc.*, 537 U.S. 418 at 431 (2003).

¹⁹⁸ *Ibid*, at 434.

-the obvious case is one where the junior and senior marks are identical".¹⁹⁹ He concluded that the evidence in the present record was insufficient to support the summary judgment on the dilution count.

Concurring, Kennedy J provided this gloss on the meaning of trade mark dilution: "If a mark will erode or lessen the power of the famous mark to give customers the assurance of quality and the full satisfaction they have in knowing they have purchased goods bearing the famous mark, the elements of dilution may be established".²⁰⁰ His Honour concluded: "Diminishment of the famous mark's capacity can be shown by the probable consequences flowing from use or adoption of the competing mark."²⁰¹

4.2 Trade Mark Parodies

There has been a large amount of litigation on trade mark law and parodies in the United States, which has attracted significant commentary.²⁰²

In a grand overview of this field, Bruce Keller and Rebecca Tushnet comments that there have been two major developments in the United States law of trade mark parodies since the mid-1990s.²⁰³ First of all, the judiciary has applied the fair use test developed in relation to copyright law and parody in the context of trade mark law.²⁰⁴ Second, the courts have been forced to consider whether parodies are diluting of trade marks in light of the new *Federal Trademark Dilution Act* 1995 (US). Keller and Tushnet observe:

Parodies can be funny or offensive. What is certain is that they are frustrating, enough so that intellectual property owners may litigate out of a sense of wounded dignity even when there is a strong fair use defense. Because parody determinations are fact-intensive – and sometimes dependent on a judge's response to their humor or lack thereof – predictions remain extremely difficult. We have no ready answer to this problem; we can only suggest that the parody/ satire divide has proved a frolic and detour ill suited to proper intellectual

¹⁹⁹ Ibid, at 434.

²⁰⁰ Ibid, at 435.

²⁰¹ Ibid, at 435-436.

²⁰² R Dreyfuss, "Expressive Genericity: Trademarks as Language In The Pepsi Generation", (1990), 65 *Notre Dame Law Review* 397; R Coombe, A Herman, "Trademarks, Property, and Propriety: The Moral Economy of Consumer Politics and Corporate Accountability on the World Wide Web", (2000), 50 *De Paul Law Review* 597-632; and R Coombe, A Herman, "Culture Wars on the Net: Trademarks, Consumer Politics and Corporate Accountability on the World Wide Web", (2001), 100 *South Atlantic Quarterly* 919-947; P Gulasekaram, "Policing the Border Between Trademarks and Free Speech: Protecting Unauthorized Trademark Use in Expressive Works", (2005), 80 *Washington Law Review* 887.

²⁰³ B Keller, R Tushnet, "Even More Parodic Than The Real Thing: Parody Law Suits Revisited", (2004), 94 *Trademark Reporter* 979-1016.

²⁰⁴ *Campbell v Acuff-Rose Music Inc.* (1994) 127 L Ed 2d 500.

*property policy. Courts should take a broader view of transformation when they address humorous (and nonhumorous) unauthorized uses of works, marks or images.*²⁰⁵

The authors lamented that “courts generally have responded to parodies accused of dilution by ignoring the First Amendment value of parodic commentary or by defining dilution narrowly rather than by invoking Campbell-type First Amendment concerns are providing special solicitude for parodies.”²⁰⁶

Some of the earlier case law is very much hostile to parodies in trade mark law. In *Dallas Cowboys Cheerleaders v. Pussycat Cinema Ltd*, the United States Court of Appeals for the Federal Circuit granted an injunction to Dallas Cowboys against a pornographic film, “Debbie Does Dallas”.²⁰⁷ The judge rejected the argument that the film constituted a parody: “Although, as defendants assert, the doctrine of fair use permits limited copyright infringement for purposes of parody, defendants' use of plaintiff's uniform hardly qualifies as parody or any other form of fair use.”²⁰⁸ In *San Francisco Arts and Athletics Inc. v. US Olympic Committee*, the Supreme Court of the United States upheld the United States Olympic Committee's rights to the words “Olympic” and held that it could prohibit any uses of the term “Olympic” that it found offensive – in this case, the “Gay Olympic Games”.²⁰⁹

In *Mutual of Omaha Insurance Co v. Novak*, the court considered the use of the trade mark of an insurance company on T-shirts and coffee mugs to make a point about nuclear proliferation [Figure 21].²¹⁰ This use was found not to be parody because the defendant was not commenting on the plaintiff's trade mark or business. In *Anheuser-Busch Inc v. Balducci Publications*, the court considered a fake advertisement, in which the plaintiff's beer Michelob was represented as an oily product [Figure 22].²¹¹ The intended message concerned an oil spill which had no connection with Michelob and water pollution in general. In balancing the trademark owner's rights against that protected under the First Amendment, the court found that the First Amendment defence had to yield to Michelob's rights.

In *New Kids On The Block v. News America Publishing Inc*, a boy band brought a law suit for trade mark infringement against newspapers which used telephone polls to judge who was the most popular member of the band. Kozinski J observed: “Most useful social and commercial discourse would be all but impossible if speakers were under threat of an infringement lawsuit every time they made reference to a person, company or product using its trade mark”.²¹² His Honour held that, in the trade mark

²⁰⁵ B Keller, R Tushnet, “Even More Parodic Than The Real Thing: Parody Law Suits Revisited”, (2004), 94 *Trademark Reporter* 979-1016 at 1016.

²⁰⁶ *Ibid*, 1009.

²⁰⁷ *Dallas Cowboys Cheerleaders v Pussycat Cinema Ltd* 604 F 2d 200 (2nd Cir., 1979).

²⁰⁸ *Ibid*.

²⁰⁹ *San Francisco Arts and Athletics Inc. v US Olympic Committee* 483 US 522 (1987).

²¹⁰ *Mutual of Omaha Insurance Co v Novak* 836 F 2d 397 402 (1987).

²¹¹ *Anheuser-Busch Inc v Balducci Publications* 28 F3d 769 (1994).

²¹² *New Kids On The Block v News America Publishing Inc* 971 F.2d 302 (9th Cir. 1992).

context, nominative use becomes fair use when a plaintiff proves three elements: “First, the plaintiff’s product or service in question must be one not readily identifiable without use of the trademark; second, only so much of the mark or marks may be used as is reasonably necessary to identify the plaintiff’s product or service; and third, the user must do nothing that would, in conjunction with the mark, suggest sponsorship or endorsement by the trademark holder”.²¹³ Kozinski J held that the newspapers were entitled to a nominative fair use defence. His Honour maintained that the fact that newspapers had used toll telephone numbers to conduct a poll did not make the defence unavailable.

In *Hormel Foods Corp. v. Jim Henson Productions Inc*, Hormel, the producers of the processed meat product Spam[®] sued Jim Henson Productions for trade mark infringement and dilution for including a pig character named Spa’am to its film *Muppet Treasure Island*.²¹⁴ The Court of Appeals reiterated that a parody of a strong mark is less likely to be confusing than a parody of a weak mark. The appellate court also noted that the Muppets were well-known for parodies, which would increase the likelihood that viewers would expect and get the joke.

In *Dr Seuss Enterprises v. Penguin Books*, the Court of Appeals also considered whether there was a trade mark infringement as a result of confusion in the market place as to the source of Penguin and Dove’s *The Cat NOT in the Hat!* Penguin and Dove argue that their identical and confusingly similar use of Seuss’ marks was offset by the work’s parodic character [Figure 23].²¹⁵ The Court of Appeals noted: “In several cases, the courts have held, in effect, that poking fun at a trademark is no joke and have issued injunctions”.²¹⁶ It concluded that the “claim of parody is no defense ‘where the purpose of the similarity is to capitalize on a famous mark’s popularity for the defendant’s own commercial use’”.²¹⁷ The Court of Appeals warned that “the cry of ‘parody!’ does not magically fend off otherwise legitimate claims of trademark infringement or dilution.”²¹⁸

In *Elvis Presley Enterprises v. Capece*, the Elvis Presley estate sued restaurant operators, alleging, inter alia, that their service mark, “The Velvet Elvis,” infringed or diluted plaintiff’s federal and common-law trade marks, and violated its right of publicity in Elvis Presley’s name.²¹⁹ The Court of Appeals observed that “parody is not a defense to trade mark infringement, but rather another factor to be considered, which weighs against a finding of a likelihood of confusion”.²²⁰ It cited the view of a treatise:

²¹³ Ibid.

²¹⁴ *Hormel Foods Corp. v Jim Henson Productions Inc*, 73 F.3d 497 (1996).

²¹⁵ *Dr. Seuss Enterprises v Penguin Books USA* 109 F. 3rd 1394 (1997).

²¹⁶ Ibid.

²¹⁷ Ibid.

²¹⁸ Ibid.

²¹⁹ *Elvis Presley Enterprises v Capece* 141 F.3d 188 (1998).

²²⁰ Ibid.

*Some parodies will constitute an infringement, some will not. But the cry of "parody!" does not magically fend off otherwise legitimate claims of trademark infringement or dilution. There are confusing parodies and non-confusing parodies. All they have in common is an attempt at humor through the use of someone else's trademark. A non-infringing parody is merely amusing, not confusing.*²²¹

The Court of Appeals held that the district court failed to consider impact of defendants' advertising practices on their use of the service mark and misapplied the doctrine of parody. It found that the plaintiff was entitled to an injunction because "The Velvet Elvis" mark infringed the plaintiff's marks.

In *Starbucks v. Dwyer*, Kieron Dwyer was sued by Starbucks for copyright infringement, trade mark infringement, trade mark dilution and unfair competition.²²² The cartoonist had created a parody of Starbucks' siren logo – which featured the tag "consumer whore". He placed the picture on coffee mugs, t-shirts, and stickers that he sold on his website and at comic book conventions. The United States District Court for Northern California held that that the corporation was unlikely to succeed on its copyright and trade mark infringement claims because Dwyer's drawing was likely to be deemed a legitimate parody. However, the court granted an injunction because it also found that the defendant's parody tarnished Starbucks' image, and constituted trade mark dilution. Dwyer was asked to remove the parody from his website. The case was ultimately settled out of court because Dwyer was unable to afford the costs of any appeals.

The academic Kembrew McLeod has observed that there has been a shift in United States jurisprudence towards the protection of parodies:

*The internal policies that regulate the behaviour and output of universities, movie studios, book-publishing houses, and other culture-producing entities have grown more conservative and cautious in recent years. At the same time, ironically, some American judges have increasingly been reaffirming the value of free speech when commenting on privately owned images, logos, or phrases. Although no tidal wave has swept across the judicial system, washing away all overzealous trademark bozos, a few key recent cases have established important precedents.*²²³

The pundit cites the precedent of *Mastercard v. Nader*, in which the United States District Court ruled that Ralph Nader's parody of MasterCard's "Priceless" advertising campaign in the 2000 presidential race did not constitute trade mark

²²¹ Ibid.

²²² *Starbucks v Dwyer* (2000) C00 1499. For an extended discussion of this case, see S M Schlosser, "The High Price of (Criticizing) Coffee: The Chilling Effect of the Federal Trademark Dilution Act on Corporate Parody", (2001), 43 (4) *Arizona Law Review* 931-964.

²²³ K McLeod, *Freedom of Expression^(R): Overzealous Copyright Bozos and other Enemies of Creativity* (2005), p. 220-221.

infringement because it created little likelihood of consumer confusion.²²⁴ In this matter, the District Court held “that Ralph Nader's use of plaintiff's trademarks is not commercial, but instead political in nature and that therefore, it is exempted from coverage by the Federal Trademark Dilution Act 1995 (US)”.²²⁵ Since that the ruling, there has been a broad range of political parodies – from satirical political groups, such as “Billionaires for Bush”, to “mash-up” Internet videos of United States Presidential candidates, such as Hillary Clinton and Barack Obama, and even Australian politicians.²²⁶

In *Mattel Inc. v. MCA Records Inc.*, the Ninth Circuit considered Mattel's claim of a trade mark infringement and dilution against the producers of a 1997 top 40 hit song by the band Aqua entitled “Barbie Girl”.²²⁷ Kozinski J characterized the facts of the case with his customary legal wit: “If this were a sci-fi melodrama, it might be called *Speech-Zilla meets Trademark Kong*”.²²⁸

Kozinski J commented that trade marks can transcend their identifying purpose and enter into the public discourse and become part of the general vocabulary: “Once imbued with such expressive flavour, the trademark becomes a word in our language and assumes a role outside the bounds of trademark law”.²²⁹ His Honour emphasized that the First Amendment protects such expressive uses of trade marks: “The trademark owner does not have the right to control public discourse whenever the public imbues his mark with a meaning beyond its source-identifying function”.²³⁰ Kozinski J observed: “The song does not rely on the Barbie mark to poke fun at another subject but targets Barbie herself”.²³¹ His Honour concluded that MCA Records' use of Barbie was not an infringement of Mattel's trademark. Kozinski J held that the use of trade mark was not purely commercial speech, and therefore was protected against a claim of trade mark dilution. His Honour observed that “the song also lampoons the Barbie image and comments humorously on the cultural values Aqua claims she represents”.²³² Finally, Kozinski J dismissed a counterclaim by MCA Records for defamation based on a representative of Mattel accusing the company of being a “bank robber” engaged in “heist”, “crime”, “theft”, and “piracy”. His Honour quipped: “No one hearing this accusation understands intellectual property owners to be saying that infringers are nautical cutthroats with eye patches and peg legs who

²²⁴ *MasterCard Intern. Inc. v Nader 2000 Primary Committee, Inc.* 2004 WL 434404 S.D.N.Y., (2004).

²²⁵ *Ibid.*, at 9.

²²⁶ Billionaires for Bush, <http://billionairesforbush.com/index.php>; Hillary 1984, <http://www.youtube.com/watch?v=FJklyhWniDQ>; Changes - Presidential Candidates, <http://www.youtube.com/watch?v=gEaS-K3j3M8>; and Kevin Rudd – Chinese Propaganda, <http://www.youtube.com/watch?v=ptccZze7VxQ>.

²²⁷ *Mattel Inc. v MCA Records Inc* 296 F.3d 894 (2002).

²²⁸ *Ibid.*

²²⁹ *Ibid.*

²³⁰ *Ibid.*

²³¹ *Ibid.*

²³² *Ibid.*

board galleons to plunder cargo".²³³ Dismissing such terms as "rhetorical hyperbole", Kozinski J concluded: "The parties are advised to chill".²³⁴

The decision of Kozinski J cannot be dismissed as the musings of a maverick judge. The Supreme Court of the United States upheld the judgment by refusing to give the company Mattel leave to appeal the decision of the Ninth Circuit.²³⁵

More recently, in *Mattel Inc. v. Walking Mountain Productions*, the United States Federal Court considered a legal action brought by Mattel against an artist who produced photographs which parodied the lifestyle represented by Barbie dolls.²³⁶ The court considered the claims of Mattel that Forsythe was engaged in trademark infringement [Figure 24].²³⁷ The judge cited McCarthy's opinion that "[t]arnishment caused merely by an editorial or artistic parody which satirizes plaintiff's product or its image is not actionable under an anti-dilution statute because of the free speech protections of the First Amendment".²³⁸ His Honour dismissed the claims of Mattel: "Forsythe's artistic and parodic work is considered noncommercial speech and, therefore, not subject to a trademark dilution claim."²³⁹

It is striking that this large corpus of jurisprudence makes no specific mention of the aesthetic practices of culture jamming, notwithstanding its influence and significance. The courts instead reduce the various cultural practices to the dialectic of legitimate "parody" versus trade mark infringement and dilution. There is a need for the judiciary to show a greater level of cultural awareness, and transcend such schematic oppositions. There is a need to enlarge the scope of protection afforded to cultural discourse to protect a range of transformative works – including culture jamming, "adbusting", and "mash-ups" – from the threat of action for trade mark infringement and dilution.²⁴⁰

4.3 Trademark Dilution Revision Act 2006 (US)

The House of Representatives Subcommittee on Courts, the Internet, and Intellectual Property held an inquiry into the operation of the trade mark dilution laws.

The International Trademark Association lobbied the United States Congress for a revision of trade mark dilution law. The President of the organisation, Anne Gundelfinger, lamented that trade mark dilution was in need of repair: "Nine years and hundreds of cases after the Federal Trademark Dilution Act 1995 (US) was

²³³ Ibid.

²³⁴ Ibid.

²³⁵ Writ of certiorari denied by the Supreme Court of the United States. *Mattel, Inc. v MCA Records, Inc.* 537 U.S. 1171, 123 S.Ct. 993 (Mem) U.S., (2003).

²³⁶ *Mattel Inc v. Walking Mountain Productions* 353 F. 3d 792 (2004).

²³⁷ M Rimmer, "The Valley Of The Dolls: Brand Protection And Artistic Parody", (2004), 16 (10) *Australian Intellectual Property Bulletin* 160-163.

²³⁸ *Mattel Inc v Walking Mountain Productions* 353 F. 3d 792 (2004).

²³⁹ Ibid.

²⁴⁰ B Fitzgerald, D O'Brien, "Digital Sampling and Culture Jamming in a Remix World: What Does the Law Allow?", (2005), 10 (4) *Media and Arts Law Review* 279-298.

enacted, virtually everyone—courts, litigants, commentators alike—agree that the law is a mess”.²⁴¹ The President observed: “This means more costly litigation, forum shopping, inconsistent application of the law, and greater risk to the ability of famous marks to function effectively as strong brands for their owners and for American consumers.”²⁴²

In the proceedings, the American Civil Liberties Union raised the concerns about the over-reaching impact of trade mark dilution laws upon freedom of speech and artistic criticism. Its spokesperson, Marvin Johnson, commented: “Trademark law provides an important tool for preventing confusion or deceptive marketing, but trademark laws should not be used as a pretext to stifle criticism, parody or legitimate competition when there is no reasonable likelihood of confusion and no actual dilution caused by use of the trademark.”²⁴³ He illustrated his concerns with an example:

*An example is Adbusters Media Foundation and its magazine, Adbusters. This publication features advertisement parodies, called “subvertisements,” which use trademarks and corporate logos to generate awareness about social and political issues. One issue featured “Joe Chemo,” a parody of the “Joe Camel” character used by Camel cigarettes, to raise awareness of the health issues surrounding smoking. These ads represent a type of important civic speech that is traditionally protected under the First Amendment. It makes critical commentary on the trademark holder, furthering the traditional goals of trademark law by informing the consumer about the goods and services they purchase. While the speech is predominantly civic in nature, the commercial element of selling the magazine could well mean that the trademark holder under the Federal Trademark Dilution Act 1995 (US) could silence its critical speech.*²⁴⁴

He concluded: “Where, however, a trademark is used for parody, commentary, or criticism of a product or service, confusion is far less likely, and the government’s interest in protecting a trademark over free speech is minimal.”²⁴⁵

In 2006, the United States Congress passed the *Trademark Dilution Revision Act 2006* (US).²⁴⁶ Republican Representative Lamar Smith explained that the legislation

²⁴¹ A Gundelfinger, “Trademark Dilution Revision Act of 2005 Hearing”, Subcommittee on Courts, the Internet, and Intellectual Property of the Committee on the Judiciary, House of Representatives, 109th Congress, 1st Session, HR 683, 17 February 2005.

²⁴² *Ibid.*

²⁴³ M Johnson, “Trademark Dilution Revision Act of 2005 Hearing”, Subcommittee on Courts, the Internet, and Intellectual Property of the Committee on the Judiciary, House of Representatives, 109th Congress, 1st Session, HR 683, 17 February 2005.

²⁴⁴ *Ibid.*

²⁴⁵ *Ibid.*

²⁴⁶ *Trademark Dilution Revision Act 2006* (US), Pub. L. No. 109-312, § 2, 120 Stat. 1730 (codified at 15 U.S.C. § 1125(c)(3)).

“clarifies a muddled legal landscape and enables the Federal Trademark Dilution Act 1995 (US) to operate as Congress intended”.²⁴⁷ He observed that the legislation was designed to respond to, and overturn, “a 2003 Supreme Court decision involving Victoria's Secret ruled that the standard of harm in dilution cases is actual harm”.²⁴⁸ The legislation has three main sets of legislative provisions. First of all, the legislation overrules the decision of the Supreme Court of the United States, and establishes that actual harm is not a necessary requirement; it is sufficient to demonstrate that a mere likelihood of harm is established.²⁴⁹ Second, the *Trademark Dilution Revision Act 2006* (US) was intended to resolve disputes between regional circuits as to the meaning of what constitutes a "famous" mark, and the definitions of "distinctiveness," "blurring," and "tarnishment."²⁵⁰ Thus, the legislation provides further definitions of such critical concepts.²⁵¹ Finally, Smith commented that the “amendments developed by the subcommittee and the other body will more clearly protect traditional first amendment uses, such as parody and criticism”.²⁵² The legislation provides that certain activities shall not be actionable as dilution by blurring or dilution by tarnishment – including “any fair use, including a nominative or descriptive fair use, or facilitation of such fair use”, “all forms of news reporting and news commentary” and “any non-commercial use of a mark.”²⁵³

²⁴⁷ L Smith “Trademark Dilution Revision Act of 2006”, The United States House of Representatives, 25 September 2006.

²⁴⁸ *Ibid*,

²⁴⁹ Section 43 (c)(1) of the *Trademark Dilution Revision Act 2006* (US) provides that “the owner of a famous mark that is distinctive, inherently or through acquired distinctiveness, shall be entitled to an injunction against another person who, at any time after the owner's mark has become famous, commences use of a mark or trade name in commerce that is likely to cause dilution by blurring or dilution by tarnishment of the famous mark, regardless of the presence or absence of actual or likely confusion, of competition, or of actual economic injury.”

²⁵⁰ L Smith “Trademark Dilution Revision Act of 2006”, The United States House of Representatives, 25 September 2006.

²⁵¹ Section 43 (c)(2)(A) of the *Trademark Dilution Revision Act 2006* (US) provides that “a mark is famous if it is widely recognized by the general consuming public of the United States as a designation of source of the goods or services of the mark's owner.” Relevant factors include “the duration, extent, and geographic reach of advertising and publicity of the mark, whether advertised or publicized by the owner or third parties”; “the amount, volume, and geographic extent of sales of goods or services offered under the mark”; and “the extent of actual recognition of the mark.”

Section 43 (c)(2)(B) provides that “‘dilution by blurring’ is association arising from the similarity between a mark or trade name and a famous mark that impairs the distinctiveness of the famous mark.” In determining whether a mark or trade name is likely to cause dilution by blurring, the court may consider all relevant factors, including the following: “the degree of similarity between the mark or trade name and the famous mark”; “the degree of inherent or acquired distinctiveness of the famous mark”; “the extent to which the owner of the famous mark is engaging in substantially exclusive use of the mark; “the degree of recognition of the famous mark; “whether the user of the mark or trade name intended to create an association with the famous mark” and “any actual association between the mark or trade name and the famous mark.” S 43 (c)(2)(C) provides that “‘dilution by tarnishment’ is association arising from the similarity between a mark or trade name and a famous mark that harms the reputation of the famous mark.”

²⁵² L Smith “Trademark Dilution Revision Act of 2006”, The United States House of Representatives, 25 September 2006.

²⁵³ Section 42 (3)(2)(c) of the *Trademark Dilution Revision Act 2006* (US).

The new legislation has been tested in a recent case. In *Louis Vuitton Malletier S.A. v. Haute Diggity Dog*, the manufacturer of luxury handbags sued maker of plush dog chew toys, alleging trade mark infringement, trade mark dilution, and copyright infringement.²⁵⁴ The United States District Court for the Eastern District of Virginia granted summary judgment for toy maker. The manufacturer appealed. Niemeyer J of the Court of Appeals held: “We agree with the district court that the “Chewy Vuiton” dog toys are successful parodies of LVM handbags and the LVM marks and trade dress used in connection with the marketing and sale of those handbags”.²⁵⁵ The judge ruled that there is no blurring or tarnishment of the original trade mark: “Even as Haute Diggity Dog's parody mimics the famous mark, it communicates simultaneously that it is not the famous mark, but is only satirizing it”.²⁵⁶ The judge concluded: “And because the famous mark is particularly strong and distinctive, it becomes more likely that a parody will not impair the distinctiveness of the mark.”²⁵⁷

The American Civil Liberties Union remains concerned about the operation of the legislation, noting: “Unfortunately, courts, in construing trademark law have often undertaken a parsimonious parsing of the statutory language instead of applying broader constitutional principles.”²⁵⁸ The organisation observes: “If the trademark holder can stop criticism through the use of trademark law, it diminishes free speech and impoverishes the marketplace of ideas the First Amendment was intended to nurture.”²⁵⁹

In his magnum opus, *Freedom of Speech*, Eric Barendt has observed that, theoretically, satire and parody should be afforded protection under First Amendment constitutional guarantees of freedom of speech:

Trade mark laws confer on the proprietor of a mark an exclusive right to use a particular sign or symbol in connection with specified commercial activities. Trade marks give consumers information about the origin of the goods or services; they, therefore, imply that the products are of an established quality, and in a sense promote or advertise it. For a business to use the trade mark of its competitor to market its own goods misleads consumers and clearly amounts to unfair competition. Even if such use were treated as commercial speech, its restriction would clearly be justified. Harder free speech questions are posed by the use of another's trade mark for the purpose of satire or parody. In principle, that should

²⁵⁴ *Louis Vuitton Malletier S.A. v Haute Diggity Dog, LLC*, 507 F.3d 252, 2007 Copr.L.Dec. P 29,476, 84 U.S.P.Q.2d 1969, C.A.4 (Va.), November 13, 2007 (NO. 06-2267).

²⁵⁵ Ibid.

²⁵⁶ Ibid.

²⁵⁷ Ibid.

²⁵⁸ American Civil Liberties Union, “Letter to the Senate Judiciary Committee Regarding H.R. 683, the Trademark Dilution Improvement Act of 2005”, 2 October 2006.

²⁵⁹ Ibid.

*certainly be covered, and perhaps protected, by a free speech provision.*²⁶⁰

Nonetheless, in United States jurisprudence, Barendt noted that “it seems that while free speech is often considered more important than the privacy or dignity of individuals, it is not as important as the ability of an organization to protect its monopoly right to use particular words and symbols”.²⁶¹ There is a need to ensure that trade mark dilution law does not stifle forms of cultural production, such as the various strategies of culture jamming, and new artistic forms, such as “mash-ups”.²⁶²

5. Conclusion

In the case of *Laugh It Off Promotions v. South African Breweries International*, the Constitutional Court of South Africa has provided succour for “adbusters”, culture jammers, and the No Logo movement against claims of trade mark owners. In his judgment, Sachs J comments upon the need for constitutional protection of levity and humour:

*A society that takes itself too seriously risks bottling up its tensions and treating every example of irreverence as a threat to its existence. Humour is one of the great solvents of democracy. It permits the ambiguities and contradictions of public life to be articulated in non-violent forms. It promotes diversity. It enables a multitude of discontents to be expressed in a myriad of spontaneous ways. It is an elixir of constitutional health.*²⁶³

The ruling of the Constitutional Court of South Africa provides support for the reformation of trade mark law to provide greater latitude for the practices of culture jamming.²⁶⁴ A high standard of proof should be demanded in respect of trade mark dilution – the actual harm standard articulated by the Supreme Court of the United States is preferable to lesser thresholds. Graeme Austin has observed: “Smarter, more self-critical, more engaged, less mesmerized consumers are less likely to be easily confused”.²⁶⁵ Accordingly, there should also be a re-conception of consumer impressions of “confusion”, “deception”, “blurring” and “tarnishment”. As Megan Richardson suggests, there is a need to expand the range of exceptions and limitations for trade mark law, in light of the expansion of protection for well-known and famous

²⁶⁰ E Barendt, *Freedom of Speech: Second Edition*, (2005), p. 263-264.

²⁶¹ *Ibid*, p. 265.

²⁶² B Fitzgerald, D O'Brien, “Digital Sampling and Culture Jamming in a Remix World: What Does the Law Allow?”, (2005), 10 (4) *Media and Arts Law Review* 279-298.

²⁶³ *Laugh It Off Promotions CC v South African Breweries International* (Case CCT 42/04) [2005] (27 May 2005), the Constitutional Court of South Africa, [109].

²⁶⁴ S M Schlosser, “The High Price of (Criticizing) Coffee: The Chilling Effect of the Federal Trademark Dilution Act on Corporate Parody”, (2001), 43 (4) *Arizona Law Review* 931-964 at 963-964.

²⁶⁵ G W Austin, “Trademarks and the Burdened Imagination”, (2004), 69 *Brooklyn Law Review* 827.

trade marks.²⁶⁶ There is a need to particular for broad latitude to be given not only to parody and satire, but various forms of culture jamming. The decision in *Laugh It Off Promotions v. South African Breweries International* demonstrates the need to take into account larger constitutional considerations about freedom of speech. The case shows a need to carefully consider the interplay between intellectual property rights and constitutional law.²⁶⁷

Furthermore, the litigation highlights the need for a change in attitudes amongst trade mark owners and their legal advisers. Giselle Fahimian hopes that intellectual property lawyers become “a bit more appreciative of the importance of parody, artistic reworking, and social commentary in shaping a diverse and creative culture, and a bit more concerned with balancing zealous client advocacy with respect for creativity and free speech”.²⁶⁸ Justin Bartlett Nurse of Laugh It Off Promotions emphasizes the social benefits of free speech and criticism in a deliberative democracy:

*We scream a lot about free speech, because it achieves a very simple and powerful thing: Where the half-lies of both sides clash and burn each other out, the truth emerges from the ashes. Without that intellectual exchange of fire, you don't even have the beginnings of a progressive, forward-looking society. You have mental quicksand, a group of people slowly sinking into their own half-formed ideas of the world, because that's the only way they know to survive. Keeping our mental channels open is the only way to avoid that, and more people everyday are convinced that can't be done if an emotive symbol like a brand is considered untouchable.*²⁶⁹

It is imperative that the courts prevent trade mark owners from relying upon trade mark dilution laws to stifle artistic expression and freedom of speech – particularly in respect of the creative activities of culture jamming and “adbusting”.

²⁶⁶ M Richardson, “Copyright in Trade Marks? On Understanding Trade Mark Dilution”, (2000) 1 *Intellectual Property Quarterly* 66-83.

²⁶⁷ The ruling may also be useful in other contexts – for instance, there has been much debate in South Africa about the constitutionality of the compulsory licensing of patented pharmaceutical drugs to treat infectious diseases, such as HIV/AIDS. In *The Pharmaceutical Manufacturers' Association of South Africa v The Government of South Africa*, Case number: 4183/98, High Court of South Africa (Transvaal Division), thirty-nine pharmaceutical drug companies brought legal action against the South African government over the *Medicines Act 1997* (RSA), arguing that the parallel importation of medicines breached their patent rights. The companies also argued that the legislation violated South Africa's new constitutional protections of the right to property. In response, the South African government argued that it was entitled to engage in parallel importation and compulsory licensing under the *TRIPS Agreement 1994*. The state maintained that the patent rights violated constitutional protections of the right to health. In response to the protests over non-government organisations such as the Treatment Action Campaign, Oxfam and Médecins Sans Frontières, which obtained international media attention, the pharmaceutical drugs manufacturing companies withdrew the action.

²⁶⁸ G Fahimian, ‘How the IP Guerillas Won: [®]TM, Adbusters, Negativland, and the “Bullying Back” of Creative Freedom and Social Commentary’, in R Atkins, S Mintcheva, *Censoring Culture: Contemporary Threats to Free Expression*, (2006), p. 135.

²⁶⁹ J Nurse, “Not Your Average Revolution”, www.laughitoff.co.za.

Figure 1. March to the High Court of South Africa.



Figure 3. Black Labour/ White Guilt T-Shirt

Laugh It Off T-shirt:

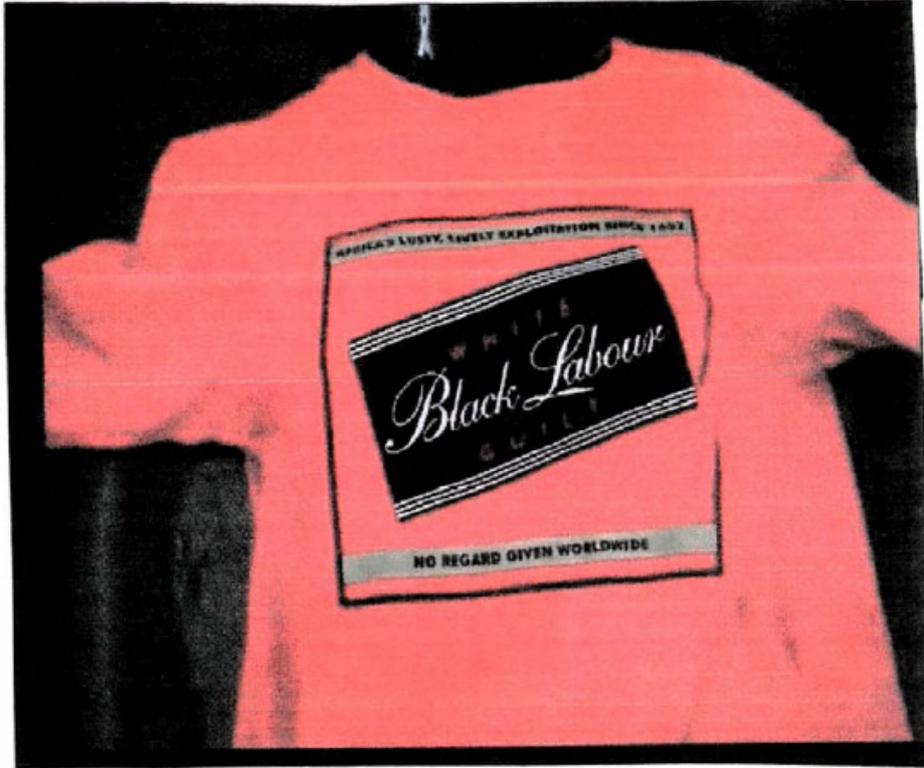




Figure 4. Mr Sin



Figure 5. Weed-Brix



Figure 6. Dead Bull.



Figure 7. Death Toll.



Figure 8. Denial for Successful Loafing



Figure 9. Blacks Like Me.



Figure 10. Corruption.



Figure 11. Moo: Make Every Day A Cow's Last.



Figure 12. Viagra



Figure 13. Adbusters Billboard.



Figure 14. No Logo.

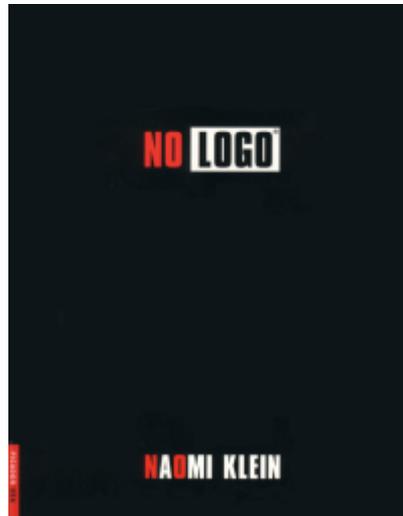


Figure 15. Conceptual



Figure 16. Pro Logo.

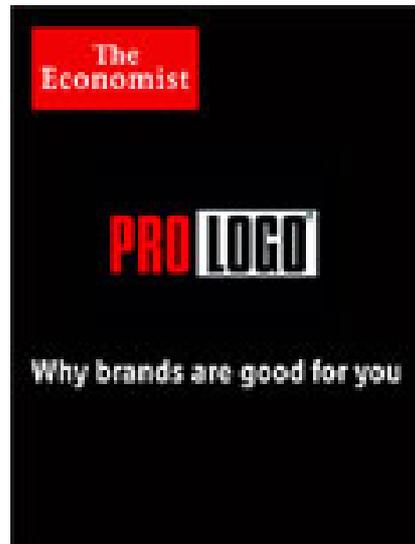


Figure 17. Pro Logo.



Figure 18. The Rebel Sell

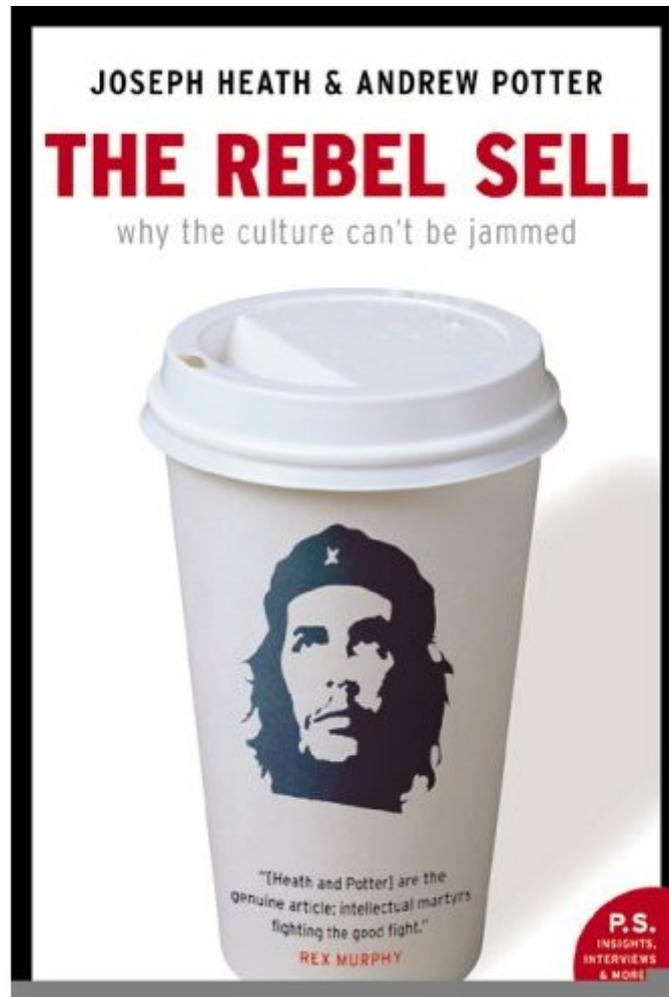


Figure 19. Telkom.



Figure 20. Hellkom.



*Prices that'll
make you sweat*

Figure 21. Omaha Insurance Trademarks and "Mutant of Omaha" Anti-Nuclear Icons.



Figure 22. Michelob Fake Advertisement.

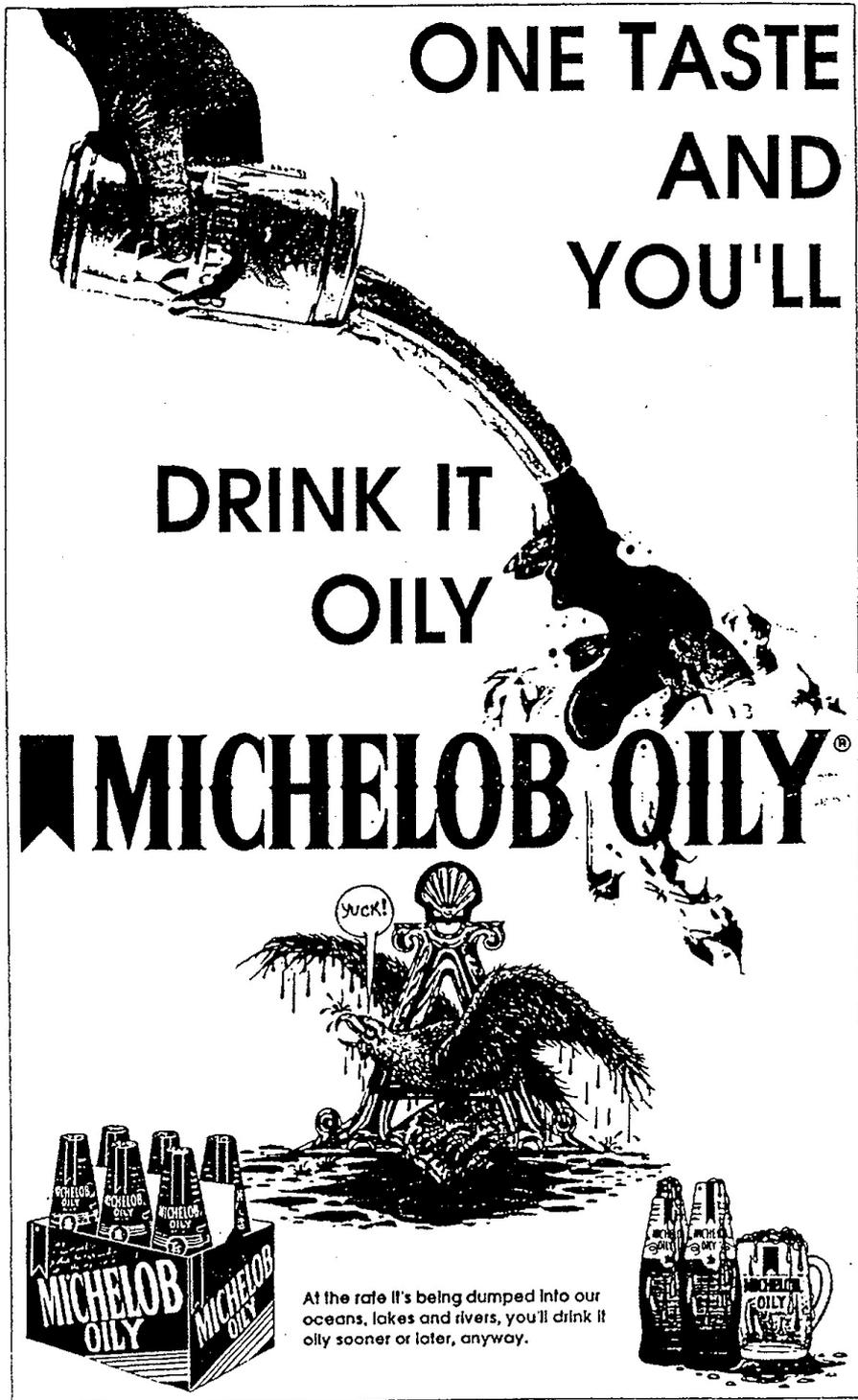


Figure 23. The Cat Not In The Hat.

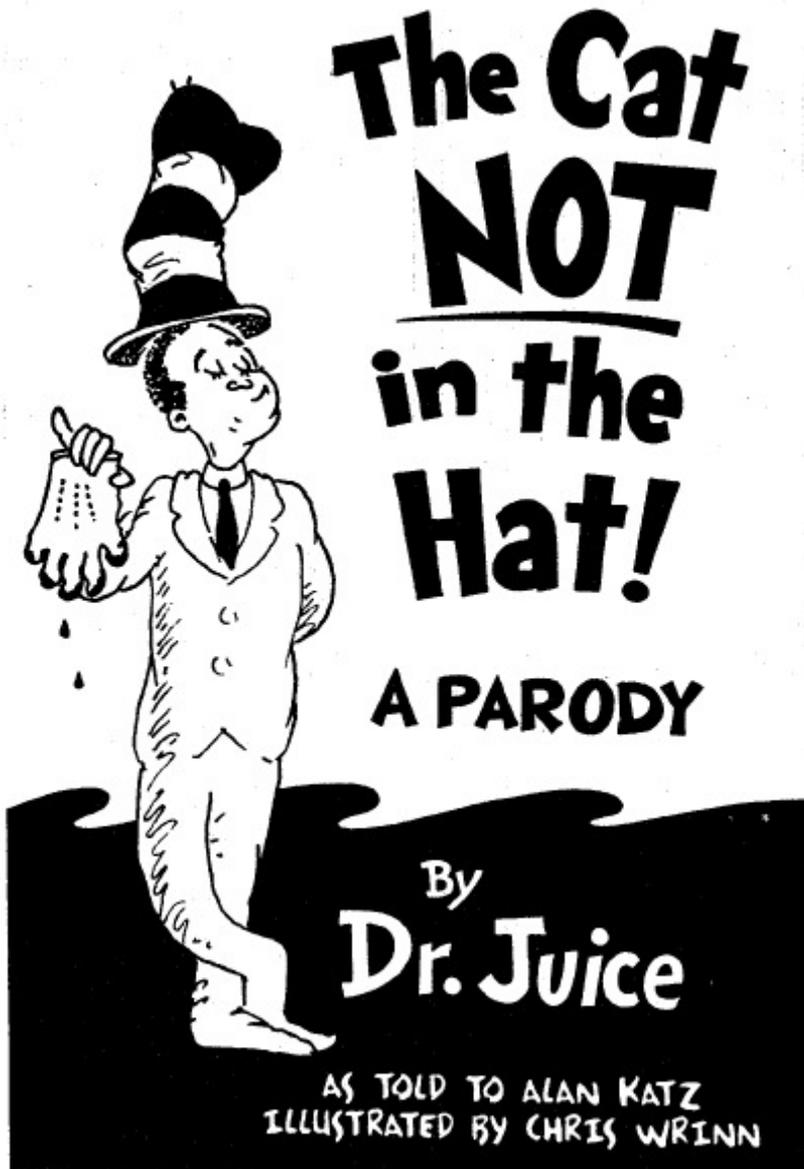


Figure 24. Tim Forsythe. "Food Chain Barbie" 1999.

