

Trademarks Worth a Thousand Words : Freedom of Expression and the Use of the Trademarks of Others

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Résumé de l'article

Les marques de commerce jouent un rôle important dans l'expression du discours critique au sein de notre société de plus en plus capitaliste et corporative. Elles servent non seulement de repères pour explorer le contenu expressif sur Internet, mais elles peuvent en outre constituer des outils pour communiquer des messages de nature critique au sujet du titulaire de la marque de commerce ou de ses produits ou services. Dans l'article qui suit, l'auteure examine l'équilibre implicite qui, dans la Loi sur les marques de commerce, existe entre la protection des marques de commerce et le principe de la liberté d'expression. Selon elle, cet équilibre est menacé par la protection grandissante accordée aux marques de commerce. Elle met en évidence des problèmes spécifiques soulevés par la jurisprudence canadienne à ce sujet. Il s'agit notamment du fait que les tribunaux traitent les droits de propriété intellectuelle au même titre que les droits privés de propriété, de l'inattention quant au chevauchement existant entre le droit des marques de commerce et le droit d'auteur, de la distinction problématique entre les emplois commerciaux et non commerciaux ainsi que du phénomène des poursuites abusives. L'auteure soutient que la jurisprudence canadienne doit, sans tarder, évoluer de façon à établir les paramètres précis de l'utilisation des marques de commerce dans une perspective critique.

Trademarks Worth a Thousand Words : Freedom of Expression and the Use of the Trademarks of Others*

Teresa SCASSA**

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Trademarks play an important role in facilitating critical speech in an increasingly corporate capitalist society. Not only do they serve as markers for expressive content on the Internet, they can also be used as vehicles for the communication of critical messages about the trademark owner or its products or services. In this paper, the author examines the implicit balance in the Trade-marks Act between freedom of expression values and trademark rights, and argues that it is being significantly altered by the contemporary push for greater trademark protection. The author identifies specific problems that emerge from Canadian case law relating to freedom of expression and trademark law. These include the treatment by courts of intellectual property rights as private property rights, inattention to the trademark/copyright overlap, the troublesome distinction between commercial and non-commercial uses, and the phenomenon of trademark bullying. The author argues for a sharp evolution in Canadian case law that would establish clear parameters for critical speech using trademarks.

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To date, in Canada, relatively little attention has been given to issues of freedom of expression in trademark law, although the matter is gaining increased attention worldwide. This is not to say that the issues have been absent; rather, they have been diffused across different dispute resolu-

tion fora, lost in the pages of court decisions that focus primarily on other issues, and, perhaps most significantly, dealt with on the margins of the legal system, where disparities in economic power between trademark owners and the targets of their cease and desist letters leave little hope for the development of a viable jurisprudence. This paper explores some of the many ways in which freedom of expression interests intersect and conflict with trademark law and makes recommendations for the development of Canadian law in this area. The paper begins with a discussion of the communicative function of trademarks, and their relationship to the freedom of expression. It then considers two distinct roles for trademarks. The first is as the marker or locator for expressive content on the Internet, for example, in domain names that resolve to web sites critical of the trademark owner. The second is as a vehicle to communicate critical messages about the trademark owner or its products or services, for example, the parody of a trademark logo. On this second issue, the paper will examine the implicit balance in the *Trade-marks Act*¹ between freedom of expression values and trademark rights and how this balance is affected by the contemporary push for greater trademark protection. The paper identifies specific problems that arise in relation to freedom of expression and trademark law. These include the treatment by courts of intellectual property rights as private property rights, the trademark/copyright overlap, the distinction between commercial and non-commercial uses, the privileging of trademarks in domain names, and the phenomenon of trademark bullying.

1 The Communicative Function of Trademarks

It is the essence of a trademark to perform a communicative function². Bently observes that as modern trademark law evolved, “what made a sign a trade mark was how it functioned or how it was understood³”. A registered

1. *Trade-marks Act*, R.S.C. 1985, c. T-13.

2. Barton BEEBE, “The Semiotic Account of Trademark Doctrine and Trademark Culture”, in Graeme B. DINWOODIE and Mark D. JANIS (eds.), *Trademark Law and Theory*, Cheltenham, Edward Elgar, 2008, p. 42; Alan DURANT, “ ‘How Can I tell the Trade Mark on a Piece of Gingerbread from all the Other Marks on it?’ Naming and Meaning in Verbal Trade Mark Signs”, in Lionel BENTLY, Jennifer DAVIS and Jane C. GINSBURG (eds.), *Trade Marks and Brands. An Interdisciplinary Critique*, Cambridge, Cambridge University Press, 2008, p. 107.

3. Lionel BENTLY, “From Communication to Thing: Historical Aspects of the Conceptualisation of Trade Marks as Property”, in G.B. DINWOODIE and M.D. JANIS (eds.), *supra*, note 2, p. 3, at page 28.

trademark, which may consist of words, designs or a combination of both⁴, is meant to communicate a message about trade source. The definition of a trademark in the *Trade-marks Act* states that a trademark is “a mark that is used by a person for the purpose of distinguishing or so as to distinguish wares or services manufactured, sold, leased, hired or performed by him from those manufactured, sold, leased, hired or performed by others⁵”. The consumer who encounters a swoosh on the side of a running shoe or on the front of a sweatshirt, for example, will know that the products come from the Nike Corporation.

The definition of a trademark as an indicator of trade source, however, does not tell the full story of the communicative burden such marks are increasingly expected to bear. Relatively early in the evolution of trademark law, courts accepted that trademarks could communicate not only messages about source, but also messages about the quality of the wares or services based upon the reputation of the source and the consumer’s past purchasing experience⁶. Thus, a consumer encountering a familiar trademark on a new line of goods could expect those products to be of a similar quality to others produced by the same company. The source message remains, but is enhanced by other informational content.

More recently with the growth of the phenomenon of “branding”, trademarks have come to convey even more complex messages⁷. A brand conveys a corporate identity message; it tells consumers about the character or personality of the company behind the trademarked goods⁸. Although the term “brand” is often used interchangeably with the word “trade-

4. In other jurisdictions, registered trademarks may include sounds and smells. While these two may raise some rather interesting freedom of expression arguments, the focus in this paper will be on marks that are visually perceptible.

5. *Trade-marks Act*, *supra*, note 1, s. 2.

6. See, e.g.: *AG Spalding and Bros v. AW Gamage Ltd*, (1915) 84 L.J. Ch. 449; Jessica LITMAN, “Breakfast with Batman: The Public Interest in the Advertising Age”, (1999) 108 *Yale L.J.* 1717.

7. Jennifer DAVIS, “Between a Sign and a Brand: Mapping the Boundaries of a Registered Trade Mark in European Union Trade Mark Law”, in L. BENTLY, J. DAVIS, and J.C. GINSBURG (eds.), *supra*, note 2, p. 65, at pages 66 and 67. See also: Laura A. HEYMANN, “The Public’s Domain in Trademark Law: A First Amendment Theory of the Consumer”, (2009) 43 *Ga. L. Rev.* 651; Jonathan E. SCHROEDER, “Brand Culture: Trade Marks, Marketing and Consumption”, in L. BENTLY, J. DAVIS, and J.C. GINSBURG (eds.), *supra*, note 2, p. 161.

8. Chuck Brymer argues that great brands share three principal attributes: they represent a compelling idea, have a resolute core purpose and supporting values, and have a central organizational principle. Chuck BRYMER, “What Makes Brands Great”, in Rita CLIFTON and John SIMMONS (eds.), *Brands and Branding*, London, Profile Books, 2003, p. 65.

mark⁹”, the two are different. The brand expresses an identity message; the trademark is a symbol used to indicate trade source. Nevertheless, trademarks are increasingly relied upon to communicate brand messages. They can do so across linguistic and cultural barriers, making them exceptionally powerful symbols within an increasingly globalized economy¹⁰. Since famous marks now almost inevitably convey brand messages, it is not surprising that the owners of these marks have sought to have trademark protection extended. The law is now asked not only to protect *source* messages, but also to protect the broader brand message as well.

The brand messages conveyed by trademarks have given these marks a further communicative dimension. Brand identity messages are meant to have a different impact on consumers than simple source identification messages. The brand message appeals to the consumer’s sense of self, and as such these messages invite a certain level of interaction with the brand. In her landmark book in 2000, Naomi Klein wrote about the manner in which brands communicated identity-oriented messages. She argues that corporate branding “was about thirstily soaking up cultural ideas and iconography that their brands could reflect by projecting these ideas and images back on the culture as ‘extensions’ of their brands¹¹”. Just as the brands absorb and reflect back culture and identity messages, consumers are invited to “experience” the brand. Klein notes that by purchasing a product of a particular brand, a consumers may also be making an expressive choice through identifying themselves with the broader brand message¹². Thus, when worn or featured on items carried by the consumer, the trademark is used by the consumer to send a separate personal identity message¹³. In this

9. This is evident, for example, in the decision of the Supreme Court of Canada in *Mattel, Inc. v. 3894207 Canada Inc.*, 2006 SCC 22, [2006] 1 S.C.R. 772, par. 30 [hereinafter “*Mattel*”], where the Court writes: “No doubt some famous brands possess protean power [...] but other famous marks are clearly product specific.”

10. It is not surprising that multinational corporations pay millions of dollars for sponsorship rights for major international sporting events such as the Olympics or the Fifa World Cup; their trademarks are well adapted to communicating to the broad international audiences that are attracted by such events. For a discussion of freedom of expression issues that arise in the context of the use of trademarks in relation to such sponsorships, see: Dana ELLIS, Teresa SCASSA and Benoit SÉGUIN, “Framing Ambush Marketing as a Legal Issue: An Olympic Perspective”, *Sport Management Review*, vol. 14, 2011, p. 297.

11. Naomi KLEIN, *No Space. No Choice. No Jobs. No Logo. Taking Aim at the Brand Bullies*, Toronto, Vintage Canada, 2009, p. 29.

12. *Id.*, p. 75-77.

13. For example, Aoki writes of the symbiotic relationship between the Harley-Davidson trademark and those individuals who adopt and embrace them. See Keith AOKI, “How the World Dreams Itself to be American: Reflections on the Relationship Between the Expanding Scope of Trademark Protection and Free Speech Norms”, (1997) 17 *Loy. L.A.*

context, Dreyfus has argued that consumers participate in generating the message borne by the mark¹⁴. It is interesting to observe that the rights of individuals to convey identity messages through trademarks have already been litigated, although this has chiefly been in contexts where the identity message is considered anti-social¹⁵.

Brand messages, because they are more complex, are also capable of subversion. In some cases trademarks are used to convey alternate messages within the context of a sub-culture. For example, the wearing of sweatshirts and other apparel bearing the logos of professional sports teams has been associated with gang affiliation in some U.S. cities¹⁶. The instances where consumers embrace or subvert the identity messages associated with trademarks illustrate the increasingly complex relationship between consumers and trademarks. In this environment, consumers are not simply the recipients of a brand message; they adapt the messages to their own communicative purposes. The conversion/subversion of brand messages is increasingly common. Such conversions are sometimes accepted or embraced by trademark owners who see a marketing oppor-

Ent. L.J. 523, 527 and 528.

14. Rochelle COOPER DREYFUSS, "Reconciling Trademark Rights and Expressive Values: How to Stop Worrying and Learn to Love Ambiguity", in G.B. DINWOODIE and M.D. JANIS (eds.), *supra*, note 2, p. 261, at page 262.
15. For example, in *R. v. Bitz*, [2009] S.J. n° 784, 2009 SKPC 138, [2010] 3 W.W.R. 322, an individual accused under Saskatchewan's *Safer Communities and Neighbourhoods Act*, S.S. 2004, c. S-0.1, of the offence of having worn gang colours into a bar, persuaded a judge that by barring him from wearing his trademarked Hell's Angels insignia, the law violated his freedom of expression. For a case challenging a municipal ordinance banning the wearing of gang-related indicia in the U.S., see: *City of Harvard v. Gaut*, 277 Ill. App. 3d 1; 660 N.E.2d 259; 1996 Ill. App. LEXIS 4; 214 Ill. Dec. 68. In the U.S., school bans on wearing trademarked apparel associated with gang membership have also been challenged. See, e.g.: *Jeglin v. San Jacinto Unified Sch. Dist.*, 827 F. Supp. 1459, 1993 U.S. Dist. LEXIS 14442 (school dress code for high school students was upheld, but struck down for elementary and middle school children); *Palmer v. Waxahachie Indep. Sch. Dist.*, 175 L. Ed. 2d 883 (2010 U.S. Dist. LEXIS 173), 78 U.S.L.W. 3392 (request for injunction to stop the enforcement of a school dress code denied).
16. *Palmer v. Waxahachie Indep. Sch. Dist.*, *supra*, note 15; *Jeglin v. San Jacinto Unified Sch. Dist.*, *supra*, note 15. Courts in these cases have clearly recognized the expressive rights of individuals to wear branded clothing, although many of the courts have also found the bans to be justified in the circumstances.

tunity or who find that the group identity message is compatible with their brand message¹⁷. Such interplay may also lead to strong resistance¹⁸.

The complexity of brand messages and their interactive nature are complicated by the desire of trademark owners to have the broadest possible control over their trademarks. On the one hand this seems like a sensible corporate practice: a company has an obligation to its shareholders to protect its assets, and trademarks are increasingly valuable assets. From another viewpoint, however, it is a bit like starting a conversation and then seeking to control where it goes¹⁹. Trademark law is being asked to favour the corporate message over all others. Aoki argues: "Increasingly, the only institute that is allowed to impregnate text with meaning is Corporate American. Hence, the self will increasingly be defined by Corporate American because the self will be forced to reconfigure personal identity so as to render it consistent with those identities articulated and approved by trademark owners²⁰."

Davis notes that the "shape" of the trademark monopoly is in a state of evolution. In her view, "the direction of such change will reflect broader ideological shifts as to where the balance of the public interest lies between proprietors, competitors and the public more generally²¹". The debate over freedom of expression and trademark law falls squarely within this context of multiple and shifting meanings²².

17. N. KLEIN, *supra*, note 11, p. 78, gives the example of Tommy Hilfiger reworking its clothing line to suit the hip hop culture that had embraced it, and in doing so, "walking the tightrope between the yacht and the ghetto".

18. *Id.*, p. 360 and 361, gives the example of how certain companies have experienced backlash after associating themselves with certain left wing views, only to find that those who genuinely embrace such views are prepared to attack those companies for the hypocrisy revealed in the space between the brand message and their corporate practices.

19. Kozinski writes: "Where trademarks come to carry so much communicative freight, allowing the trademark holder to restrict their use implicates our collective interest in free and open communication." Alex KOZINSKI, "Trademarks Unplugged", (1993) 68 *N.Y.U. L. Rev.* 960, 973.

20. K. AOKI, *supra*, note 13, 546.

21. J. DAVIS, *supra*, note 7, at page 68.

22. See, e.g.: Graeme B. DINWOODIE, "What Linguistics Can do for Trademark Law", in L. BENTLY, J. DAVIS, and J.C. GINSBURG (eds.), *supra*, note 2, p. 140; Graeme AUSTIN, "Tolerating Confusion about Confusion: Trademark Policies and Fair Use", in G.B. DINWOODIE and M.D. JANIS (eds.), *supra*, note 2, p. 368.

2 Freedom of Expression and Trademarks

The rights and freedoms set out in the *Charter*²³ apply only to legislation and to state action²⁴. Thus, unless it is a government or other state actor that is attempting to limit the use of its own trademarks by others²⁵, the necessary nexus with government action for the purposes of *Charter* application will be through the *Trade-marks Act* or related legislation such as the *Olympic and Paralympic Marks Act*²⁶. The provisions of the *Trade-marks Act*, which confer the trademark monopoly and set limits upon it, must be interpreted and applied in a manner that is consistent with *Charter* values²⁷. The same can be said of the common law rules that protect unregistered trademarks²⁸.

Section 2 (b) of the *Canadian Charter of Rights and Freedoms* guarantees the “freedom of thought, belief, opinion and expression, including freedom of the press and other media of communication²⁹”. As discussed above, trademarks are inherently communicative. They are symbols which convey often complex messages. As such, their use is a form of expression. The freedom of expression in Canada is not limited to explicit verbal messages. Expressions in signs, symbols, drawings, and gestures are all protected; only extremely anti-social forms of communication such as violence are not part of the *Charter* right³⁰.

23. *Canadian Charter of Rights and Freedoms*, part I of the *Constitution Act, 1982*, [enacted as Schedule B to the *Canada Act 1982*, 1982, c. 11 (U.K.)] [hereinafter “*Charter*”].

24. *SDGMR v. Dolphin Delivery Ltd.*, [1986] 2 S.C.R. 573, 1986 CanLII 5.

25. This does happen. Governments and their associated departments and agencies are increasingly using trademarks and branding to identify products and services and to convey messages. For a comment on how one government agency sought to use trademark law to limit expression, see: Donna DAVIS, “Too Much Protection, Too Little Gain: How Official Marks Undermine the Legitimacy of Intellectual Property Law”, (2009) 14 *Appeal* 1.

26. *Olympic and Paralympic Marks Act*, S.C. 2007, c. 25 [hereinafter “OPMA”]. This statute gave enhanced levels of protection to trademarks associated with the Olympic and Paralympic Games in the lead up to the Vancouver Winter Olympics of 2010. For a more detailed discussion of this legislation, see: Teresa SCASSA, “Faster, Higher, Stronger: The Protection of Olympic and Paralympic Marks Leading up to Vancouver 2010”, (2008) 41 *U.B.C. L. Rev.* 31.

27. There is case law that accepts this – see also Margreth BARRETT, “Domain Names, Trademarks and the First Amendment: Searching for Meaningful Boundaries”, (2007) 39 *Conn. L. Rev.* 973, 981.

28. It is well established that courts, where possible, should interpret and develop the common law in a manner that is consistent with *Charter* values. See, e.g.: *Dagenais v. Canadian Broadcasting Corp.*, [1994] 3 S.C.R. 835; *R. v. Golden*, [2001] 3 S.C.R. 679, 2001 SCC 83.

29. *Charter*, *supra*, note 23.

30. *R. v. Keegstra*, [1990] S.C.J. n° 131, [1990] 3 S.C.R. 697 [hereinafter “*Keegstra*”].

The primary trademark message is commercial in nature, and trademark owners are usually (although not always) corporations. Since the early days of the *Charter*, the Supreme Court of Canada has made it clear that commercial expression is protected by the freedom of expression³¹. Further, the freedom of expression can be asserted not just by individuals, but also by corporations³². Commercial expression can be conveyed in a variety of ways, including, notably, in advertising³³. In *RJR-MacDonald Inc. v. Canada (Attorney General)*³⁴, the Supreme Court of Canada also established that the right to freedom of expression includes the right to use one's own trademarks³⁵. As with other forms of expression, commercial expression is subject to reasonable limits demonstrably justified in a free and democratic society³⁶. In the case of commercial speech, the reasonable limits may include restrictions on the size, location and language of advertising content³⁷. They may also include limits on how and when certain audiences are targeted³⁸.

Clearly, the Supreme Court of Canada has recognized the right of corporations to communicate via their trademarks. Yet trademark owners are not the only ones who use these marks to communicate. As noted above, individuals may use trademarked goods to convey their own identity messages. The ability of trademarks to convey, in an elliptical manner, complex messages of source, quality and brand experience also make them the ideal target for expression that is critical of the product or company that is represented by the mark³⁹. Such expression can take many forms,

31. See, e.g.: *Ford v. Quebec (Attorney General)*, [1988] S.C.J. No. 88, [1988] 2 S.C.R. 712 [hereinafter "*Ford*"]; *Devine v. Quebec (Attorney General)*, [1988] S.C.J. No. 89, [1988] 2 S.C.R. 790; *Irwin Toy Ltd. v. Quebec (Attorney General)*, [1989] S.C.J. No. 36, [1989] 1 S.C.R. 927 [hereinafter "*Irwin Toy*"]; *Rocket v. Royal College of Dental Surgeons of Ontario*, [1990] S.C.J. No. 65, [1990] 2 S.C.R. 232 [hereinafter "*Rocket*"].

32. See, e.g.: Allan C. HUTCHINSON, "Money Talks: Against Constitutionalizing (Commercial) Speech", (1990) 17 *Can. Bus. L.J.* 2.

33. *Irwin Toy*, *supra*, note 31.

34. *RJR-MacDonald Inc. v. Canada (Attorney General)*, [1995] S.C.J. No. 68, [1995] 3 S.C.R. 199 [hereinafter "*RJR MacDonald*"].

35. The court found that the Attorney-General's concession that the bans on advertising and trademark use violated freedom of expression was a wise one (see, e.g. *id.*, par. 58 of the reasons of La Forest J., dissenting on a different point).

36. *Charter*, *supra*, note 23, s. 1. See also: *Keegstra*, *supra*, note 30; *Rocket*, *supra*, note 31; *Ford*, *supra*, note 31.

37. See, e.g.: *Ford*, *supra*, note 31; *Canada (Attorney General) v. JTI-Macdonald Corp.*, 2007 SCC 30, [2007] 2 S.C.R. 610 [hereinafter "*JTI-Macdonald*"].

38. *Irwin Toy*, *supra*, note 31; *JTI-Macdonald*, *supra*, note 37.

39. *R. v. Guignard*, [2002] S.C.J. No. 16, [2002] 1 S.C.R. 472, 2002 SCC 14 [hereinafter "*Guignard*"].

including parodies in art, song or print⁴⁰. It can also consist of Internet-based websites that are critical of corporate practices or products⁴¹, or that seek to organize consumer boycotts or criticize politicians or governments⁴².

The trademark becomes an ideal vehicle for critical expression precisely because of the elliptical way in which a recognizable word or design can convey complex messages. Indeed, as corporate owners have enhanced the messages conveyed by trademark (from source to quality to brand identity), the symbols become more densely packed with meaning. It is not surprising, then, that critics of companies and their practices would wish to target their trademarks in their critical expression. By using the trademark, the critics can leverage the same direct connection that consumers make between the mark and its trade source. Further, a parody of the mark can be an effective parody of the brand message conveyed by the mark. This was apparent in *Michelin*, where the court described the effect of the defendant Union's parody of Michelin's Bibendum design mark (the "Michelin Man") in these terms: "Rather than the cuddly marshmallow creature of

40. *Cie générale des établissements Michelin – Michelin & Cie c. National Automobile, Aerospace, Transportation and General Workers Union of Canada (CAW – Canada)*, [1996] F.C.J. n° 1685, [1997] 2 F.C. 306 [hereinafter "*Michelin*"]; *Rôtisseries St-Hubert Ltée c. Syndicat des travailleurs(euses) de la Rôtisserie St-Hubert de Drummondville*, [1986] J.Q. n° 2613, [1987] R.J.Q. 443 (Sup. Ct.) [hereinafter "*Rôtisseries St-Hubert*"]; *Canadian Tire Corp. v. Retail Clerks Union, Local 1518*, [1985] F.C.J. n° 1005, [1985], 7 C.P.R. (3d) 415; *Corporation Sun Media c. Syndicat canadien de la fonction publique*, 2007 QCCS 2943 [hereinafter "*Sun Media*"].

41. *British Columbia Automobile Assn. v. Office and Professional Employees' International Union, Local 378*, [2001] B.C.J. No. 151, 10 C.P.R. (4th) 423 (S.C.) [hereinafter "*BCAA*"]. A recent dispute between Wal-Mart Canada and the United Food and Commercial Workers of Canada saw Wal-Mart apply for an injunction to stop the Union's use of its trademarks in domain names and on its web site which was critical of the Wal-Mart company. See: Nathalie DES ROSIERS, "No Trademark on Free Speech", *Toronto Star*, August 29, 2009, [Online], [www.thestar.com/comment/article/687584] (June 18th 2012). In France, see: Com. 8 avril 2008, *Bull. civ.*, n° 79.

42. A campaign by a group of municipalities to pressure the federal government to return a portion of GST revenues to municipalities to pay for infrastructure, titled "One Cent Now", was hit with a demand for payment of license fees for the use of the Royal Canadian Mint's official mark (the image of the Canadian penny) on the campaign's website and other advertising. See the discussion of this matter in: D. DAVIS, *supra*, note 25. In April 2010, the Canadian Civil Liberties Association criticized the Rocky View County Council in Alberta after it sent a cease and desist letter to the operators of a website that criticized the county's development practices. The County alleged infringing uses of its trademarks on the web site. See: CANADIAN CIVIL LIBERTIES ASSOCIATION, *Letter to Rocky View Council Members*, April 13, 2010, [Online], [cccla.org/wordpress/wp-content/uploads/2010/04/2010-04-13-Letter-to-Council.PDF] (June 18th 2012).

safety and responsibility, 'Bibendum' became the boss's henchman about to stomp two workers into submission⁴³."

Although the Supreme Court of Canada has not ruled directly on the issue of the rights of individuals to use the trademarks of others in their expression, it has found that consumer counter-advertising is a protected form of expression⁴⁴. In *R. v. Guignard*, the court wrote:

Consumers may express their frustration or disappointment with a product or service. Their freedom of expression in this respect is not limited to private communications intended solely for the vendor or supplier of the service. Consumers may share their concerns, worries or even anger with other consumers and try to warn them against the practices of a business. Given the tremendous importance of economic activity in our society, a consumer's "counter-advertising" assists in circulating information and protecting the interests of society just as much as does advertising or certain forms of political expression. This type of communication may be of considerable social importance, even beyond the merely commercial sphere⁴⁵.

In this passage, the Court not only recognizes the protected nature of consumer counter-advertising; it also finds that limited vehicles are available to consumers who are substantially economically disadvantaged in communicating their counter-corporate messages. The court stated: "simple means of expression such as posting signs or distributing pamphlets or leaflets or, these days, posting messages on the Internet are the optimum means of communication for discontented consumers⁴⁶". Clearly, then, the vehicle for counter-advertising is important to the expression of the message; access to these vehicles ensures a viable means of communication. Although the court did not discuss the use of trademarks in counter-advertising, trademarks themselves are vehicles for this form of expression, particularly where the recognizability of the parodied mark facilitates the communication of the message in the context of a significant disparity in power⁴⁷.

43. *Michelin*, *supra*, note 40, par. 71.

44. *Guignard*, *supra*, note 39.

45. *Id.*, par. 23.

46. *Id.*, par. 25.

47. This point is implicitly recognized by the Cour de cassation in France, when it declined to overturn the decision of the Court of Appeal that the use of parodies of Esso's trademarks by Greenpeace in a campaign to highlight the efforts made to derail the Kyoto Accord was a proportional means by which the organization expressed its criticisms. See: Com. 8 avril 2008, *supra*, note 41.

2.1 Trademarks as Signposts: Internet Domain Names

Trademarks may play multiple roles on the Internet⁴⁸. One of these remains the traditional source identification function. But trademarks can also serve as location or addressing tools for content. A trademark used in a domain name can indicate a website that provides information or sells products or services linked to the trademark holder. As noted by the Court in *Guignard*, the Internet is a medium for inexpensive and accessible global communication. As such, it is not surprising that it has become an important site for both critical speech and counter-advertising. The issues of trademarks and freedom of expression intersect nicely in disputes around the use of trademarks in domain names. Domain names are a crucial element of any website. They are a signpost or marker for the content of the site to which they resolve.

For someone who seeks to engage in criticism, parody or counter-advertising, a website, with its associated domain name, is an important vehicle of communication⁴⁹. Yet Canadian case law in this area reveals a marked ambivalence about the use of trademarks in domain names to direct Internet users to critical content on the Internet. In *Bell ExpressVu Ltd. Partnership v. Tedmonds & Co. Inc.*, Justice Nordheimer of the Ontario Superior Court found that the use of the plaintiff's BellExpressvu trademark by the defendant in the domain name "bellexpressvu.org" did not infringe trademark rights. He noted that the domain name resolved to a site critical of the plaintiff company, and wrote:

The evidence here does not establish any commercial use of the plaintiff's trademark. The website does not promote wares or services in competition to those of the plaintiff. Rather, the website promotes criticism of the plaintiff as a commercial enterprise. In that regard, its function could be characterized as the exercise of free speech and, consequently, may well be said to be protected by virtue of section 2 (b) of the *Charter of Rights and Freedom's*, although that issue was not raised before me⁵⁰.

48. These include the use of trademarks in meta tags, in keyword advertising, in domain names, and on web sites. Trademark issues are also arising in social media contexts. For a discussion of these issues, see: Teresa SCASSA, *Canadian Trademark Law*, Markham, LexisNexis, 2010, ch. 9.

49. Protest or criticism sites are fairly common, and a number have already been referenced in this paper. Not all sites that interact with trademarks are critical. Fan sites are established by fans of music, books, movies or other cultural works. These sites may use trademarks associated with the cultural product in domain names, meta tags, and on the websites themselves.

50. *Bell ExpressVu Ltd. Partnership v. Tedmonds & Co. Inc.*, 2001 CanLII 28350, [2001] O.J. No. 1558, par. 43 (Sup. Ct.).

Nevertheless, the idea that one can use an unmodified trademark as the domain name for a critical website has not taken hold in the Canadian jurisprudence. In *BCAA*, a web site established by a trade union in relation to a labour dispute with the trademark owner used the plaintiff's trademarks in its domain names. In finding no passing off with respect to a second version of the defendant's website, the court noted that the inclusion of additional text alongside the plaintiff's trademarks in the domain names was "significant", as it assisted in dispelling confusion. The domain names "bcaoonstrike.ca" and "bcaabacktowork" were considered sufficiently indicative of the critical or informational content of the site to avoid a finding of passing off⁵¹.

Other courts have also held that the unmodified use of a trademark in the domain name of a critic's web site can amount to passing off⁵². Thus, although a critic or commentator may freely use the word marks of competitors to convey their substantive messages, the use of the same mark as a navigational tool to direct users to the critical content can be considered to create actionable confusion, even if any confusion is immediately dispelled on arrival at the critical site.

At the same time, courts have expressed the view that qualifying language in a domain name can rescue the use of the trademark from a finding of infringement where the qualified web site address clearly reveals its critical perspective. This is so even though trademark jurisprudence does not suggest that the author of a tract critical of a corporation would infringe trademark rights simply by using that company's trademark in a title, whether accompanied by other language or not. This position in the jurisprudence remains constant, even though domain name resources are constantly expanding, with the addition of numerous new top level domains. More importantly perhaps, for those who seek to engage in this kind of criticism, it is not clear what limits courts will set on the words that accompany the trademarks in domain names. While "bcaoonstrike" passed muster in *BCAA*, it is unclear whether "aboutbcaa" or "bcaafacts" would have satisfied the court.

Similar approaches to the use of trademarks in domain names are evident in the domain name dispute resolution case law emerging from

51. *BCAA*, *supra*, note 41, par. 123 and 124.

52. *United Food and Commercial Workers International Union v. Sigurdur (c.o.b. Members for Democracy)*, 2005 BCSC 1904, [2005] B.C.J. No. 3144, par. 14 and 15; *Law Society of British Columbia v. Canada Domain Name Exchange Corp.*, (2004), 243 D.L.R. (4th) 746, 753. Passing off is a tort at common law (a similar recourse is available under the general law of delict in Quebec), which is available to protect the goodwill in unregistered trademarks.

the processes operated by the Internet Corporation for Assigned Names and Numbers (ICANN), or in the case of the “.ca” domain, by the Canadian Internet Registration Association (CIRA). These dispute resolution processes are intended to provide a relatively inexpensive and expeditious route for trademark owners to seek a remedy for the bad faith registration of their trademarks in domain names. Every registrant of a domain name must agree to submit to such a process if a complaint is filed with respect to their registration⁵³. Although such processes do not remove the jurisdiction of the courts, the vast majority of disputes regarding bad faith registration are dealt with through these systems.

Domain names registered in the popular “.com” and other top level domains are dealt with under the UDRP⁵⁴. To succeed in a challenge mounted against a domain name, the complainant has to demonstrate that they have rights in the trademark that has been incorporated into the domain name, that the domain name was registered in bad faith, and that the registrant has no legitimate interest in the domain name⁵⁵. The UDRP defines a legitimate interest as including “making a legitimate non-commercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue⁵⁶”. This, in theory, leaves room for the use of trademarks in association with sites that are critical of the products or companies to which they relate, although the reference to tarnishment—a form of trademark dilution—has a restricting effect.

Case law under the UDRP dealing with both fan and criticism sites is mixed. Indeed, two dominant views have emerged with respect to such sites⁵⁷. The first view is that an individual has no right to use the trademark of another on its own in a domain name, even for the purposes of critical, non-commercial speech⁵⁸. This includes not just the actual trademark, but a version that could be confusingly similar with the mark. On this view, the use of someone else’s trademark in a domain name could only be justified if it was accompanied by language that makes it clear that the site to which

53. *Uniform Domain Name Dispute Resolution Policy*, August 26, 1999, clause 4 (a), [Online], [www.icann.org/en/help/dndr/udrp/policy] (June 18th 2012) [hereinafter “UDRP”].

54. *Id.*

55. *Id.*

56. *Id.*, clause 4 (c) (iii).

57. WORLD INTELLECTUAL PROPERTY ORGANIZATION, “Overview of WIPO Panel Views on Selected UDRP Questions, Second Edition (‘WIPO Overview 2.0’)”, 2011, [Online], [www.wipo.int/amc/en/domains/search/overview/index.html] (June 18th 2012).

58. *Id.*, par. 2.4.

the domain name resolves is a criticism site. Such language might include the word “sucks”, for example, as in “trademarksucks.com”.

The second view is more open to the registration of trademarks in domain names, with or without additional language, on the basis that individuals have a legitimate interest in freely expressing their views⁵⁹. A number of panellists have observed that this approach only applies when both parties to the dispute are based in the U.S.⁶⁰, because U.S. trademark law is considered to be much more open to the application of freedom of expression values than the law of other jurisdictions, including Canada.

Domain name disputes in Canada’s “.ca” domain are dealt with under the CIRA Dispute Resolution Policy⁶¹. A complainant must establish the same three elements required under the UDRP (trademark rights, bad faith registration and no legitimate interest on the part of the registrant). However, the CIRA Dispute Resolution Policy (CDRP) has its own definitions. Under the CDRP, a registrant may establish a legitimate interest in a domain name where the registrant uses it “in good faith in association with a non-commercial activity including, without limitation, criticism, review or news reporting⁶²”. Jurisprudence under the CDRP is less extensive than under the UDRP. Nevertheless, what case law there is suggests that no uniform position has yet emerged in Canada. In one case, a panel found bad faith registration where the domain name featured the name of the complainant company and resolved to a clearly non-commercial critical web site. The panel found that the “unqualified use of a mark in relation to its owner or its owner’s commercial activities⁶³” did not give rise to a legitimate interest. The panel went on to state that “[a] right to freedom of expression does not confer upon a registrant the right to register a domain name that is identical to a third party trade-mark or trade name⁶⁴”. This

59. M. BARRETT, *supra*, note 27, 1010.

60. As Barrett notes, however, this approach is not consistently followed in the U.S. (*id.*, 1012 and 1013).

61. CANADIAN INTERNET REGISTRATION AUTHORITY, “CIRA Domain Name Dispute Resolution Policy. Version 1.2”, [Online], [www.cira.ca/assets/Documents/CDRPpolicy.pdf] (June 18th 2012) [hereinafter “CDRP”].

62. *Id.*, par. 3.6 (d).

63. *Diners Club International Ltd. v. Planet Explorer Inc.*, CIRA Decision No. 2004-00016, par. 48, [Online], [www.cira.ca/assets/Documents/Legal/Dispute/2004/00016-award.ca.pdf] (February 4, 2004).

64. *McKee Homes Ltd. v. Gerlinde Honsek*, CIRA Decision No. 2007-00079, par. 62, [Online], [www.cira.ca/assets/Documents/Legal/Dispute/2007/00079-mckeehomes.ca.pdf] (June 18th 2012) [hereinafter “McKee Homes”].

restrictive interpretation belies the apparent breadth of the language of “legitimate interest” in the CDRP⁶⁵.

The ability to use trademarks as navigation aids to direct Internet users to critical content is important, and the uneven jurisprudence is troubling. Also troubling is the extent to which so many decisions of this kind are made in the context of domain name dispute resolution proceedings. The expertise required to serve as a domain name panellist so often coincides with having worked in a trademark law related capacity⁶⁶ that many panel-lists may be conditioned to approach issues from a trademark owner’s perspective. This is likely to be quite different from the perspective of someone who seeks to engage in consumer counter-advertising. The relatively quick and low-cost dispute resolution forum gives trademark owners an expedient means by which they can challenge disruptive uses of their trademarks. The dominant position that has emerged globally from case law under the UDRP, and to some extent the CDRP, seems to be that no one but the trademark owner may use the bare trademark in a domain name, even if the use is critical and non-commercial. This view is also reflected in the case law from Canadian courts.

The restrictive approach to using trademarks as markers of critical content is a matter of some concern. It is worth recalling that in *Guignard*, the Supreme Court of Canada particularly emphasized the important role the Internet played in facilitating consumer criticism and commentary. On

65. Note that the same panel also found the registration to be in bad faith. It did so by finding that the use of the domain name by the registrant was likely to cause some confusion, with the result that “Internet traffic properly destined for the Complainant may be misdirected to the Registrant’s website. This would cause a disruption to the Complainant and its commercial interests.” (*id.*, par. 50). Note that this decision was criticized in *Canderel Stoneridge Equity Group Inc. v. Michael*, [2008] 75 C.P.R. (4th) 34, par. 28, [Online], [www.cira.ca/assets/Documents/Legal/Dispute/2008/00100-canderelstoneridge.ca.pdf] (June 18th 2012), where the panellist wrote: “The interpretation of the policy must leave room for legitimate criticism sites even when their domain names incorporate a Mark that is ‘Confusingly Similar’. While it is true that a criticism site can have the effect of diverting customers away from a business, it is perfectly permissible for legitimate criticism to have that effect. If the host of a legitimate criticism site is engaged in a non-commercial activity, it is hard to see how they can also be a competitor.”

66. For example, a quick look at the roster of panellists for BCICAC, the largest dispute resolution provider under the CDRP shows that the vast majority of panellists are lawyers, many of whom work for major law firms: BRITISH COLUMBIA INTERNATIONAL COMMERCIAL ARBITRATION CENTER, “Selecting a Panellist”, [Online], [www.bccac.com/panellists/current-panellists/] (June 18th 2012). The panellists for Resolution Canada are also predominantly lawyers, although they also include a number of law professors: RESOLUTION CANADA, “Roster of Adjudicators”, [Online], [www.resolutioncanada.ca/roster.php] (June 18th 2012).

the Internet, trademarks can be used to connect information with those most likely to have an interest in it. Yet the case law shows that barriers are often put in the way of critical speech that relies on trademarks to reach its target audience.

2.2 Trademarks as Vehicles of Expression

The *Trade-marks Act* reflects an implicit balance between the rights of trademark owners and the freedom of expression values of others⁶⁷. While the Act confers an intangible property right on trademark owners and gives them exclusive rights to use their trademarks in Canada, it also sets some fairly significant boundaries to these rights. The exclusive right to use the trademark is a right to use it *as a trademark*. In other words, a company that is granted a monopoly over a word may only control the use of that word to distinguish the source of wares or services. The high technology giant's monopoly on the word Apple, for example, does not extend to the use of the word as the name of a fruit or as a description of rosy cheeks. Trademark rights are also limited to the use of the trademark in association with specified wares or services (or ones that might reasonably be associated with those wares or services for which the mark has been registered). Thus, the word Apple can legitimately serve as a trademark for companies that offer sufficiently different wares or services⁶⁸.

This would suggest that there is considerable scope for the use of marks, not to distinguish wares or services, but to criticise either the wares or services associated with the mark or the owner of the trademark. In *Canada Safeway Ltd.*, the court stated:

I do not think [trademark laws] prevent individuals, corporations, or even competitors from using the trademark of another for purposes unrelated to protection for commercial or trade reasons. For example, a journalist may surely refer to the trademark when writing a story about its owner. Others may use the trademark if the purpose is only to identify the holder [...] I am satisfied the Canadian trademark law does not intrude into this area. If it were otherwise, that law would represent a rather significant restriction on free speech and the circulation of ideas or opinions⁶⁹.

67. T. SCASSA, *supra*, note 48, p. 526; Pierre N. LEVAL, "Trademark: Champion of Free Speech", (2004) 27 *Colum. J.L. & Arts* 187.

68. For example, in Canada there are many trademark registrations incorporating the term Apple, which include: Apple Auto Glass & Design (TMA494495); Apple Paperbacks (TMA586694); Apple Time & Design (TMA461424); Appel Blossom (TMA575693).

69. *Canada Safeway Ltd. v. Manitoba Food & Commercial Workers, Local 832*, [1983] M.J. No. 94, par. 10.

Yet although this balance may appear evident on the face of things, it has had a perilous existence in Canada. While word marks are often accepted as playing a role within ordinary speech (as where a company is referred to by its trademark name), logos have received a significantly different treatment in the case law, as will be discussed below. At the same time, the expanding function of trademarks has a concurrent limiting effect on the space allowed for speech that does not interfere with trademark function. As Craig cautions, it is possible for courts to unpick the boundaries that have been built into the law through interpretations that expand the trademark function from one of source identification to one of the communication of a broader range of messages⁷⁰. In other words, if the trademark monopoly is recognized as extending beyond a source-identification function, then expressive uses may increasingly conflict with these other messages that are now part of the extended monopoly.

3 The Push for Greater Trademark Protection

The push for expansion of trademark rights necessarily has an impact on the freedom of expression⁷¹. This impact will most likely be felt in areas where consumers individually or collectively, seek to interact with famous trademarks for their own purposes, whether these are critical, laudatory, playful, or self-referential. As Coombe notes, the amplified protection for famous marks means, in practical terms “that the more powerful the corporation’s position in the market, the more successfully it can immunize itself against oppositional cultural strategies⁷²”. The dominant discourse around the need for greater levels of intellectual property protection in order to counter piracy obscures the fact that trademarks occupy an increasing breadth of communicative space. Enhanced trademark protection can even be used to control conversations that the trademark owners themselves have provoked. In such a context, the values of freedom of expression must be carefully protected.

The phenomenon of large industry lobby groups putting pressure on governments to augment the protection available for intellectual property has been most evident in the area of copyright law, where a growing succes-

70. Carys J. CRAIG, “Perfume by Any Other Name May Smell as Sweet... But Who Can Say? A Comment on *L’Oreal v. Bellure*”, (2010) 22 *I.P.J.* 319, 330.

71. As Craig observes, “As trade-mark rights expand beyond the protection against consumer confusion, the tension between these rights and free speech values becomes harder to ignore” (*id.*, 328).

72. Rosemary J. COOMBE, *The Cultural Life of Intellectual Properties. Authorship, Appropriation, and the Law*, Durham, Duke University Press, 1998, p. 144.

sion of international treaties⁷³ has led to consistent demands for stronger rights, more vigorous enforcement, and even new rights⁷⁴. Similar pressures have been evident in the trademark area as well. Treaties like the *Anti-Counterfeiting Trade Agreement*⁷⁵ create new state obligations with respect to enforcement and border measures.

Beyond such international agreements, trademark owners have also pushed for enhanced protection for trademarks against what is known as “dilution” and “tarnishment” in the United States, and “depreciation of goodwill” in Canada. Such provisions permit trademark owners to seek recourse for harm to the goodwill that they have established in their trademarks. This is quite different from seeking recourse for the use by another of a trademark that creates confusion in the marketplace. Confusion analysis generally takes place within a commercial context, and a finding of confusion will often turn on the degree of similarity between the plaintiff’s and defendant’s wares or services⁷⁶. By contrast, in Canada, “depreciation of goodwill” addressed in section 22 of the *Trade-marks Act*, does not require that a trademark be used *as a trademark*, thus broadening the range of contexts in which an infringing use may be found. Recourse for depreciation is available against uses that harm a mark’s reputation, that divert customers, or that otherwise undermine the value of the goodwill associated with the mark. Craig has cautioned that “[t]he potential scope of this right is enormous, and clearly capable of restricting basic competitive practices as well as commercial (and other) speech⁷⁷”.

73. These include the *Agreement on Trade-Related Aspects of Intellectual Property Rights, Including Trade in Counterfeit Goods*, (1994) 25 I.I.C. 209, and the *WIPO Copyright Treaty*, 20 December 1996, 36 I.L.M. 65, art. 5 (entered into force 6 March 2002), [Online], [www.wipo.int/treaties/en/ip/wct/trtdocs_wo033.html] (June 18th 2012) [hereinafter “WCT”].

74. For example, the WCT obliges states to create new rights for copyright holders to protect their use of technological protection measures, and to provide a recourse against those who remove rights management information.

75. *Anti-Counterfeiting Trade Agreement* (ACTA), [Online], [www.international.gc.ca/trade-agreements-accords-commerciaux/fo/intellect_property.aspx?view=d] (June 18th 2012).

76. The similarity between wares and services of the plaintiff and the defendant is one of the factors to consider in a confusion analysis (*Masterpiece Inc. v. Alavida Lifestyles Inc.*, 2011 SCC 27, [2011] 2 S.C.R. 387, par. 44 and 45.) The list of factors is set out in s. 6 (5) of the *Trade-marks Act*, *supra*, note 1. In both *Mattel*, *supra*, note 9, and *Veuve Clicquot Ponsardin v. Boutiques Cliquot Ltée*, 2006 SCC 23, [2006] 1 S.C.R. 824 [hereinafter “*Veuve Clicquot*”], the Supreme Court of Canada acknowledged that it was possible for a famous mark to transcend the categories of wares or services for which it was registered, but such transcendence is not automatic, and depends upon the circumstances of each case.

77. C.J. CRAIG, *supra*, note 70, 330.

The test for “depreciation of goodwill” recently formulated by the Supreme Court of Canada in *Veuve Clicquot*⁷⁸ gives some hope that the recourse, in Canada at least, will remain more or less confined to commercial contexts. Justice Binnie cautioned that “[t]he depreciation or anti-dilution remedy is sometimes referred to as a ‘super weapon’ which, in the interest of fair competition, needs to be kept in check⁷⁹”. Describing the test for depreciation, he wrote :

Section 22 has four elements. Firstly, that a claimant’s registered trade-mark was used by the defendant in connection with wares or services — whether or not such wares and services are competitive with those of the claimant. Secondly, that the claimant’s registered trade-mark is sufficiently well known to have significant goodwill attached to it. Section 22 does not require the mark to be well known or famous (in contrast to the analogous European and U.S. laws), but a defendant cannot depreciate the value of the goodwill that does not exist. Thirdly, the claimant’s mark was used in a manner *likely* to have an effect on that goodwill (i.e. linkage) and fourthly that the *likely* effect would be to depreciate the value of its goodwill (i.e. damage)⁸⁰.

The first element identified by the court would seem to require a use in a commercial context, since the terms “wares” or “services” have generally been interpreted to be commercial in nature⁸¹. This would appear to leave space for non-commercial uses of trademarks. Yet there may well be a free speech balance to be struck even with the use of trademarks in commercial contexts. It should not be presumed that all expressive uses of trademarks with a commercial dimension are inherently infringing⁸². The Court in *Veuve Clicquot* did nothing to limit the use of section 22 in this respect, and indeed it indicated that its decision did not address all possible forms of depreciation under section 22⁸³. There is reason to be pessimistic ; in *Source Perrier (Société Anonyme) v. Fira-Less Marketing Co. Limited*, a case that predates *Veuve Clicquot*, and that involved a commercial parody of a trademark, the court stated : “the most liberal interpretation of ‘freedom

78. *Veuve Clicquot*, *supra*, note 76.

79. *Id.*, par. 45.

80. *Id.*, par. 46.

81. For example, in *Michelin*, *supra*, note 40, the court ruled that the defendant trade union did not “use” the plaintiff’s marks in its campaign literature. The court did not consider the distribution of this literature to be “advertising” since it was not engaging in this activity for the purpose of generating profits.

82. In *University of Alabama Board of Trustees v. New Life Art Inc.*, 677 F. Supp. 2d 1238 (N.D. Ala. 2009), the court found that the defendant artist could sell “fine art” paintings and limited edition prints that incorporated the plaintiff’s trademarks, but could not licence the reproduction of his works on t-shirts, mugs or other such items without a licence agreement with the plaintiffs. The case is currently under appeal.

83. *Veuve Clicquot*, *supra*, note 76, par. 67.

of expression' does not embrace the freedom to depreciate the goodwill of registered trade marks⁸⁴.

The fragility of the built-in limits on the scope of trademark rights is evident in the enactment of the *Olympic and Paralympic Marks Act*. This legislation was introduced so as to enhance the protection available for Olympic and Paralympic marks in the lead-up to the 2010 Vancouver Winter Games. The Bill did not initially contain exceptions aimed at preserving freedom of expression through parody or artistic expression; the government's position may have been that the right to use trademarks for critical or artistic non-commercial speech was implicit in trademark law. However, the Bill was amended⁸⁵ to include two exceptions prefaced with the words "for greater certainty" that permit the use of Olympic and Paralympic marks for criticism or parody, or in artistic works⁸⁶. The need to make these exceptions explicit is revelatory of at least two things. The first is a deep unease over the reliability of implicit limits on the scope of the trademark monopoly; the second is the chilling effect that merely implicit limits may have on ordinary individuals who do not have easy or affordable access to legal advice on the boundaries of the legitimate use of trademarks.

The inclusion of express exceptions to preserve freedom of expression in relation to trademarks, such as those in the OPMA, is at least superficially interesting. However, such an approach raises its own concerns. The inclusion of some exceptions may lead courts to determine that other expressive acts are precluded. Further, as will be discussed below, the wording chosen for the exceptions may have the effect of unduly limiting their scope⁸⁷.

4 Interpretive Challenges

The preceding sections have described both the expansion of trademark rights and the implicit balance that courts have struck between the trademark monopoly and expressive rights under the legislation. This section considers the jurisprudence more closely to identify patterns of interpretation that threaten a more expansive approach to freedom of expression in the trademark context. These problems, which collectively

84. *Source Perrier (Société Anonyme) v. Fira-Less Marketing Co. Limited*, [1983] 2 F.C. 18, par. 20.

85. CANADA, HOUSE OF COMMONS, Committee on Industry, Science and Technology, Minutes of Proceedings, June 5, 2007, [Online], [www.parl.gc.ca/HousePublications/Publication.aspx?DocId=3006079&Language=E&Mode=1&Parl=39&Ses=1] (June 18th 2012).

86. OPMA, ss. 3 (5) and 3 (6).

87. For example, in copyright law, the exception for fair dealing for the purposes of criticism or comment has been consistently interpreted by courts to exclude parody and satire.

demonstrate the fragile state of freedom of expression rights in the ever-expanding trademark universe, flow from the tendency of some courts to treat intellectual property rights as private property, the trademark/copyright overlap, and the distinction drawn between commercial and non-commercial trademark use.

5 Trademarks as Private Property

A significant problem for freedom of expression and trademarks is the body of jurisprudence in Canada that equates intellectual property interests with private property rights. Where this occurs, courts have shown a reluctance to allow expressive rights to “trespass” upon private property. In *Michelin*, discussed above, the court stated “[t]he *Charter* does not confer the right to use private property [...] in the service of freedom of expression⁸⁸”. Similarly, in *Sun Media*, another case involving a union’s parody of the employer’s trademarks in the context of a labour dispute, the court ruled that the freedom of expression did not confer a right to use another’s personal property⁸⁹. The court stated that intellectual property laws⁹⁰, rather than limiting freedom of expression, placed certain limits on the use of the property of others⁹¹.

This position is based upon pre-*Charter* jurisprudence that reinforced the sanctity of physical property. For example, in *Harrison v. Carswell*, a case which raised the issue of the right to picket on private property, the majority of the Supreme Court of Canada stated: “Anglo-Canadian jurisprudence has traditionally recognized, as a fundamental freedom, the right of the individual to the enjoyment of property and the right not to be deprived thereof, or any interest therein, save by due process of law⁹².” This fundamental right to the enjoyment of property is buttressed, according to the court, by trespass laws. The court in *Michelin* equated the use of Michelin’s intellectual property for the purposes of union protests as constituting an equivalent sort of trespass. Justice Teitelbaum expressly rejected arguments that intellectual property rights are different from private property rights because they are created by the state. He wrote:

88. *Michelin*, *supra*, note 40, par. 81. This same passage is cited with approval in *Canwest Mediaworks Publications Inc. v. Horizon Publications Ltd.*, 2008 BCSC 1609, [2008] B.C.J. No. 2271, par. 13 [hereinafter “*Horizon*”]. This decision was later upheld in *Canwest Mediaworks Publications Inc. v. Murray*, 2009 BCSC 391, [2009] B.C.J. No. 565.

89. *Sun Media*, *supra*, note 40, par. 32.

90. *Copyright Act*, R.S.C. 1985, c. C-42.

91. *Sun Media*, *supra*, note 40, par. 33. Note that the court, at the same time, acknowledged that the union’s parody was an effective means of conveying its message (par. 41).

92. *Harrison v. Carswell*, [1976] 2 S.C.R. 200, 219.

“The fact that the Plaintiff’s copyright is registered by a state-formulated system under the aegis of the *Copyright Act* in no way diminishes the private nature of the right⁹³.”

The court’s approach in *Michelin* is not easily reconciled with the Supreme Court of Canada’s subsequent decision in *Théberge v. Galerie d’Art du Petit Champlain*⁹⁴, which articulates the purpose of copyright law in light of the balance struck in the legislation between the interests of creators and the interests of society. The Court later refers to these interests as “users’ rights⁹⁵”, drawing a line under the fact that copyright law conveys certain rights to the owner of copyright but that the same subject matter may be subject to the competing “rights” of those who seek to make use of it for certain purposes. In the trademark context the boundaries between the rights of the trademark owner to use the protected image or words are carefully constrained and do not constitute an absolute right to use that image or those words in all contexts or circumstances.

Although the private property approach adopted in *Michelin* has been roundly criticized⁹⁶, there is no Canadian case law that expressly rejects it⁹⁷. This creates a problematic jurisprudence in which to situate disputes over critical uses of trademarks. As Coombe notes, where trademarks play a role in expressive conduct, their protection as private property “freez[es] the connotations of signs and symbols and fenc[es] off fields of cultural meaning with ‘No Trespassing’ signs⁹⁸”. In his treatise on intellectual property law, Vaver argues for a shift in Canadian judicial approaches

93. *Michelin*, *supra*, note 40, par. 98.

94. *Théberge v. Galerie d’Art du Petit Champlain*, [2002] 2 S.C.R. 336.

95. *CCH Canadian Ltd. v. Law Society of Upper Canada*, 2004 SCC 13, [2004] 1 S.C.R. 339.

96. See, e.g.: Carys J. CRAIG, “Putting the Community in Communication: Dissolving the Conflict Between Freedom of Expression and Copyright”, (2006) 56 *U.T.L.J.* 75; Jane BAILEY, “Deflating the Michelin Man: Protecting Users’ Rights in the Canadian Copyright Reform Process”, in Michael GEIST (ed.), *In the Public Interest. The Future of Canadian Copyright Law*, Toronto, Irwin Law, 2005, p. 125; David FEWER, “Constitutionalizing Copyright: Freedom of Expression and the Limits of Copyright in Canada”, (1997) 55 *U.T. Fac. L. Rev.* 175; Teresa SCASSA, “Intellectual Property on the Cyber-Picket Line: A Comment on *British Columbia Automobile Assn. v. Office and Professional Employees’ International Union, Local 378*”, (2002) 39 *Alta. L. Rev.* 934. For a critique of this approach in the U.S., see Pratheepan GULASEKARAM, “Policing the Border Between Trademarks and Free Speech: Protecting Unauthorized Trademark Use in Expressive Works”, (2005) 80 *Wash. L. Rev.* 887, 906-910.

97. See, for example: *Sun Media*, *supra*, note 40; *Horizon*, *supra*, note 88. This private property orientation is also troubling in the context of Internet domain names (discussed below), where courts have begun to recognize domain names as something in which property rights subsist. See: T. SCASSA, *supra*, note 48, p. 445-447.

98. R.J. COOMBE, *supra*, note 72, p. 69.

to intellectual property rights in this area—away from a property rights focus towards one that adopts an approach that balances a broader set of values⁹⁹. This would certainly seem to be consistent with the strong message sent by the Supreme Court of Canada in relation to copyright law in its more recent jurisprudence¹⁰⁰. On this view, private property arguments cannot be used to artificially exclude others from the expressive space occupied by trademarks.

In this respect, lessons may be drawn from the opinion of Justice Sachs of the South African Constitutional Court in *Laugh it Off Promotions*¹⁰¹. In assessing whether a parody of a trademark logo infringed the trademark anti-dilution provisions in South African law, Justice Sachs took a nuanced view and noted that it would not always be possible or effective for a critic to use some means other than a parody of a trademark itself. He wrote: “the more the trade mark itself is both directly the target and the instrument, the more justifiable [...] its parodic incorporation [will] be¹⁰²”. This approach regards the trademark not simply as a piece of property, but rather as something which conveys sufficient meaning to itself become the target of parody or satire. In such a context, the trademark is both the target of the criticism, but also the communicative vehicle by which that criticism is most effectively expressed.

6 Trademark/Copyright Overlap

As noted above, trademarks must generally be used in a commercial context before infringement can be found, thus leaving space for non-commercial critical speech. However, in the case of design marks, this space is virtually eliminated by the way in which Canadian courts have approached their interpretation of copyright in trademark designs. Thus, in *Michelin*, discussed earlier, the Union was found not to have infringed the company’s *trademark* rights by using a parody of the Michelin man in its pamphlets and on placards. However, these same uses were considered to amount to copyright infringement, and were enjoined by the court. The court’s opinion that parody did not constitute “criticism” for the purposes of the fair dealing exception negated the room that trademark law created

99. David VAVER, *Intellectual Property Law. Copyright, Patents, Trade-Marks*, 2nd ed., Toronto, Irwin Law, 2011, p. 47.

100. See, for example: *Théberge v. Galerie d’Art du Petit Champlain*, *supra*, note 94; *CCH Canadian Ltd. v. Law Society of Upper Canada*, *supra*, note 95.

101. *Laugh It Off Promotions CC v. South African Breweries International (Finance) BV t/a Sabmark International* (2005), 8 B. Const. L.R. 743 [hereinafter “*Laugh it Off Promotions*”].

102. *Id.*, par. 86.

for the non-commercial use of the trademark. The absurdity of protecting Michelin's Bibendum as nothing more than an "artistic work" is evident in Justice Teitelbaum's statement that "if copyright is not respected and protected, the creative energies of authors and artists in furthering the diversity of ideas will not be adequately compensated or recognized¹⁰³". Whether this is true or not in the abstract, in the context of a design created to serve as a trademark, it is nonsensical. The only incentive needed to develop trademark logos is the incentive to benefit from their communicative functions as trademarks. Similar results have occurred in other cases where trademark logos were parodied¹⁰⁴. These decisions are highly problematic because they fail to acknowledge the semantic burden borne by the trademark.

The recognition of the trademark subtext as inherent to the design itself will be particularly important now that the fair dealing exception in the Copyright Act has been amended. The amended provision expressly allows parody and satire to qualify as fair dealing. This will open the door to arguments that any given parody of a trademark logo amounts to a fair dealing with the work. The contextual analysis of fair dealing mandated by the Supreme Court of Canada in *CCH Canadian*¹⁰⁵ would therefore have to take into account the design's trademark function. In considering the nature of the work, for example, the analysis should take into account the fact that the work is a trademark and that non-commercial, critical or parodic speech is generally permitted by trademark law.

7 Commercial/Non-Commercial Distinction

As discussed earlier, the trademark case law finds non-commercial uses of trademarks to be generally non-infringing (although as is noted in the previous section, problems may arise where there are also copyright issues at play). However, in Canada, *commercial* parodies are generally enjoined under trademark law¹⁰⁶. For example, in *Source Perrier (Société Anonyme) v. Fira-Less Marketing Co. Limited*, the court found that a defendant's political spoof, which used the trademark Perrier bottle as its vehicle infringed section 22 of the *Trade-marks Act*. The defendant sold bottles of water that were also for sale under the mark Pierre, Eh?, a sly reference to then Prime Minister Pierre Elliot Trudeau¹⁰⁷. The Court found

103. *Michelin*, *supra*, note 40, par. 100.

104. See, e.g.: *Sun Media*, *supra*, note 40; *Rôtisseries St-Hubert*, *supra*, note 40.

105. *CCH Canadian Ltd. v. Law Society of Upper Canada*, *supra*, note 95.

106. See, e.g.: *Source Perrier (Société Anonyme) v. Fira-Less Marketing Co. Limited*, *supra*, note 84.

107. *Id.*

that this parody of the plaintiff's trademark was captured by the definition of "use" in section 4 of the Act. Similarly, in *Green v. Schwartz*, a passing off case, a court enjoined the defendant from producing and selling sweat-shirts that featured, in a parody of the Roots trademark and its beaver logo, the word Rots over a skeletal beaver¹⁰⁸.

These cases appear superficially to constitute commercial uses of the parodied marks, as in each case the parodied mark was affixed to wares that were for sale in a commercial context. Yet these cases are also suggestive of the difficulties inherent in the commercial/non-commercial dichotomy. Some forms of parody may be relatively ineffective if they do not reach consumers in the same commercial space occupied by the original mark. As Dreyfus notes, the "dichotomy between the marketing and expressive spheres, which was always somewhat indistinct, has collapsed"¹⁰⁹. Further, there may be costs associated with the critical campaign in which the parody is used that must be recuperated. Thus, where t-shirts bearing parodied logos are sold to recover the costs of their production, the use may appear commercial, although it may be more communicative than commercial in its primary purpose. Where the purchase price also goes to support an organization's critical campaign, the waters are murkier still. While trademark owners should not be expected to tolerate parodies that exploit the renown of their marks for commercial gain, there must nevertheless be a sufficiently nuanced analysis to allow distinctions between the commercial exploitation of a mark's goodwill and a genuinely critical use.

It is not obvious that all parodies with some commercial dimension should necessarily be enjoined. As Illsley writes, "almost every trade mark parody involves some form of commercial expression"¹¹⁰. Further, "commercial activity" may not be sufficiently well-defined to ensure adequate space for free expression¹¹¹. For example, in the Internet context described earlier, the use of trademarks in domain names that resolve to sites critical of the trademark holder have been found to have "commercial"

108. *Green v. Schwartz*, 12 C.P.R. (3d) 84, [1986] O.J. No. 1003 (S.C.).

109. R. COOPER DREYFUSS, *supra*, note 14, at page 265.

110. Thea ILLSLEY, "How to Tell a Take-off from a Rip-off: Trade Mark Parody and Freedom of Expression in South Africa", (2006) 22 *S.T.A.J.H.R.* 119, 123.

111. R. COOPER DREYFUSS, *supra*, note 14, at page 285, argues that economic benefit should not be a sole or sufficient measure in assessing whether there was commercial use of a trademark for trademark infringement proceedings.

dimensions simply because they may divert the trademark owner's Internet traffic to the critical site¹¹².

Given that trademarks convey brand messages within a highly consumer-capitalist society, one wonders why parodies and satires are excluded from operating in the same commercial realm as the trademark¹¹³. Through anti-dilution and anti-depreciation provisions, trademark protection has expanded into new spheres that trademark owners have chosen to occupy. If a mark is embraced by a segment of the population as conveying an identity or status message of some sort (and indeed, for what other reason would people choose to wear corporate logos emblazoned on their clothing?), it is not clear why an explicitly critical counter-message is not permissible in the same medium. According to the courts, the reason is that the owners of the parodied marks have built up a substantial amount of goodwill in their marks and commercial parodies both trade on this and undermine it. Yet it is precisely the "loud" brand messages communicated by famous trademarks that make them tempting targets for parody. It is their place in consumer culture that also leaves them vulnerable to attack. An approach that automatically silences parody and criticism that operates within the same commercial sphere as the original is unduly limiting. In *Laugh it Off Promotions*¹¹⁴, Justice Sachs opined that the use of trademarks in parodies with commercial dimensions should not automatically be considered infringing. He argued that courts should focus on the primary goal of the parody. If it is primarily commercial, it may be infringing; if it is primarily communicative, and incidentally commercial, it should be allowed greater latitude.

The commercial/non-commercial distinction can be problematic in other instances as well. For example, artists may incorporate trademarks into their works for a range of expressive purposes. If the sale of such works is treated as commercial, then the scope for such artistic expressions

112. In the U.S., see: *Jews for Jesus v. Brodsky*, 933 F. Supp. 282 (D. N.J. 1998); *PGC Prop. LLC v. Wainscott/Sagaponak Prop. Owners*, 250 F. Supp. 2d 136 (E.D. N.Y. 2003). Consider also: *Mutual of Omaha Ins. Co. v. Novak*, 836 F. 2d 397 (8th Cir. 1987), where the fact that the defendant's critical parodies of the plaintiff's Mutual of Omaha marks were sold on mugs and t-shirts appeared to weigh against him. In Canada, see: *McKee Homes*, *supra*, note 64.

113. In *Green v. Schwartz*, *supra*, note 108, 85, the court finds passing off with minimal analysis, even though the judge finds that "the defendant is obviously spoofing the plaintiff's trademark".

114. *Laugh it Off Promotions*, *supra*, note 101.

is genuinely limited¹¹⁵. The OPMA, discussed earlier, contains an express exception for the use of Olympic marks in artistic works. However, the exception is only available “if the work is not reproduced on a commercial scale¹¹⁶”. While this might not capture the production and sale of a single painting or sculpture, a series of prints or photographs produced for sale might well fall outside the scope of the exception. Further, for some artists, such distinctions might limit their ability to licence their work in contexts where they may derive revenue streams, such as for reproduction on posters, greeting cards, calendars, mugs or other gallery gift shop items. Exceptions for “non-commercial” uses, whether in statutes such as the OPMA, or crafted by judges, may therefore only benefit certain types of artists and artistic works.

Arguably an exception for artistic or parodic works that limits their commercial exploitation achieves a balance between the artist’s expressive rights and the rights of trademark owners to control the messages conveyed by their marks. In *University of Alabama Board of Trustees v. New Life Art Inc.*¹¹⁷, an Alabama court found that a well-established artist who had made his career painting football scenes featuring the University of Alabama’s famous “Crimson Tide” football team did not infringe the team’s trademark rights by featuring trademarked jerseys, team logos and other insignia in his paintings, which were protected speech. Yet the court drew a line between the sale of the paintings or fine art prints of them (which was considered legitimate) and the licensing of those works for reproduction on mugs, t-shirts or other such items. The latter type of activity could only be carried out under licence from the University of Alabama. The court’s decision, which seems to map quite closely onto the exception incorporated into the OPMA, achieves a balance that carves out a fairly wide ambit of protection for the trademark holder and grants it the power to control or limit exploitations of the artists’ work that cross from the perceived realm of “art” into that of “commerce”. The balance might be easier to accept if these realms were in fact separate, and not increasingly blended in a commercialized cultural environment.

115. In the *University of Alabama*, *supra*, note 82, the court found that an artist’s canvasses and limited edition prints that incorporated the plaintiff’s trademarks were protected under the First Amendment, but ruled that the artist could not licence these works for reproduction on mugs, t-shirts or other such commercial items without the trademark holder’s permission.

116. OPMA, s. 3 (6).

117. *University of Alabama Board of Trustees v. New Life Art Inc.*, *supra*, note 82.

8 Trademark Bullying

In any discussion of freedom of expression and trademarks the economic disparity that typically exists between trademark owners and those who criticise corporations or their wares or services must also be taken into account. In the case of well known or high profile marks, the trademark owners are often powerful corporations with deep pockets. All too frequently, cease and desist letters from trademark owners to those who parody or criticize using trademarks bring an abrupt end to that form of criticism¹¹⁸. The cost of advice on trademark infringement issues is steep; for a non-commercial critic it may well be prohibitive. Further, the costs of fighting a battle in court would be crippling for many. It is telling that in Canada the trademark/freedom of expression jurisprudence flows almost exclusively from labour disputes, where the defendants are unions with some means to respond to the employer's legal manœuvres. Disputes over trademarks are most certainly not funded by legal aid regimes. Further, advice on trademark issues generally must come from specialized professionals at premium prices. In smaller communities outside Canada's larger cities, such advice may be difficult to find locally.

Ordinary individuals are also most likely to be caught by rote enforcement of trademark rights. For example, companies that are routinely on the lookout for trademark misuses may automatically send out cease and desist letters without much reflection as to possible claims of legitimate or non-commercial use of the marks. Where the recipients of such letters have limited resources, they may feel that they have little choice but to comply with the trademark owners' demands.

In a conflict that received a great deal of media attention in Canada, the Conservative Party of Canada sent a cease and desist letter to Michaela Keyserlingk, who had created a website to protest the Canadian government policy on asbestos sales overseas following the death of her husband as a result of asbestos-related cancer¹¹⁹. The site reproduces the Conservative Party logo next to a statement that "Canada is the only western country that still exports deadly asbestos"¹²⁰. The cease and desist letter alleged

118. It is very difficult to document cases where cease and desist letters lead to the cessation of activities, since without the records created by litigation these instances are difficult to track. However, in some cases, those in receipt of such letters reach out to other organizations or the media. This was the case, for example, with the letter sent by the Canadian Civil Liberties Association in response to the cease and desist letter sent to two individuals who created a web site to protest decisions of a county council: CANADIAN CIVIL LIBERTIES ASSOCIATION, *supra*, note 42.

119. The website is found at: www.canadianasbestosexports.ca/Home.

120. *Id.*

trademark infringement flowing from the use of the logo¹²¹. In a newspaper article discussing this tactic, one author described it as “bullying”, arguing that it was directed more at silencing Mrs. Keyserlingk’s message than at protecting trademark rights¹²². The blast of negative media coverage of the dispute may have led the Conservative Party to back off from its demands; the logo remains on the website¹²³. The case illustrates, however, how legal rights may be asserted even if they lack strong foundation, raising further concerns about the freedom of expression.

Conclusions

There are fundamental flaws in the Canadian jurisprudence relating to critical, parodic or artistic uses of trademarks, leaving only limited scope to use trademarks as vehicles for these forms of expression. This position is in contrast with the growing role of trademarks in culture and society which suggests, in contrast, that individuals should be permitted to interact with these marks and to harness their expressive power for creative or critical expression. The narrow approach taken by courts to expressive rights is reflected as well in the evolving case law around the use of trademarks as domain names.

Freedom of expression values would appear to have some role to play in support of critical, parodic and artistic expression, particularly since they already play an implicit role in the balance reflected in the *Trade-marks Act*. Nevertheless, the case law has left little room for critical or parodic uses of trademarks. This is due to a judicial tendency to equate intellectual property rights with absolute private property rights, problematic interpretations of copyright law that ignore the trademark functions of logos, and by often forced distinctions between commercial and non-commercial uses. The result is an impoverished and one-sided jurisprudence. When combined with the frequent sharp disparities in economic power between trademark owners and their critics, an environment is created in which it is simply too easy for trademark owners to assert their rights against those with limited resources and little helpful jurisprudence on their side.

Although one apparent solution is to codify rights to critical or other forms of expression using trademarks, such provisions may be problematic

121. Text of letter on file with the author.

122. Alex REINHART, “Why the Conservatives are Bullying a Widow. A Lack of Compassion for Victims of Asbestos-related Cancers Highlights the Conservatives’s Lack of Respect for the Poor”, Canadian University Press, Toronto, September 22, 2011, [Online], [www.cupwire.ca/articles/47161] (June 18th 2012).

123. The logo was last verified to be on the website on February 22, 2012.

either because they are underinclusive of the myriad forms of potential expression, or because they incorporate some of the relatively unquestioned elements of the case law, such as the problematic distinction between commercial and non-commercial uses.

It might be preferable to see the development of a jurisprudence that is sensitive to and protective of expressive rights, and that recognizes the limited nature of the trademark monopoly. Such jurisprudence would necessarily have to take into account the expanding role of trademarks both in terms of the messages they carry and the extent to which they embed themselves within culture and invite consumers to interact with them. These increased functions of trademarks demand an increase in the expressive space open to those who seek to criticize the trademark source, its wares or its services, who challenge or critique the brand message, or who engage with the cultural embeddedness of certain marks. Unfortunately, the disparities in economic power between major corporations and their critics often mean that conflicts never arrive in court. This makes it even more imperative for the few courts seized with such issues to show greater openness to legal arguments that address the balance between the interests of rights holders and broader social and community values.