



UiT The Arctic University of Norway

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A Fundamental Trademarks Approach to the Protection of Indigenous Intangible Resources -

Unregistered trademarks in the indigenous context with examples from the Sámi People in Norway and Tlingit People in the United States

Jacob R Adams

A dissertation for the degree of PhD July 2024



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SUMMARY

When applied discretely, the protection of trademarks is oftentimes employed in a less than satisfactory manner. Which is especially true for the application of trademarks within the area of indigenous rights and the protection of indigenous resources. Many missteps stem from analyses built primarily upon an understanding of trademark protections drawn from modern statutory structures alone and have affected the results of efforts in this area. Specifically, much of the current commentary on the use of trademark protection within the area of indigenous resources concludes that the general trademark protection does not provide effective protection and then turn focus on specialized and limited species of trademark protection, such as geographic indicators or certification trademarks. Alternatively, they reject the usefulness of trademarks entirely and espouse the necessity of an entirely new system of intangible protection for indigenous resources – a *sui generis* regime.

This work reconceptualises the application of trademark protection within the indigenous resources context at a foundational level by first ensuring that the nature of trademark protection is explored and articulated. Foundational trademark protections are illuminated by distilling the available historical motivations, requirements, and protections of distinguishing marks and the development of trademark protection systems into the common foundational elements that make up a trademark. The work employs a dogmatic method to articulated what the law is now with direction from the historical understanding and historical foundational threads that are extant in the modern systems. It is with these foundational elements that a universal basic definition of a trademark is composed and the current modern trademark protection regimes are interpreted, viewed, and tested in their application to specific elements of indigenous resources.

Critically, a bottom-up approach is employed in this work, starting from the dogmatic composition and protections of trademarks first, before then exploring where within the indigenous resources space those mechanisms could find applicability. With such an approach the current relevant categorisations of indigenous resources, such as Traditional

Knowledge (TK), Traditional Cultural Expressions (TCEs), and Genetic Resources (GR), are examined, while ultimately not affecting the trademark analysis.

After the informed dogmatic construction of the foundational elements of trademark protection and their relevance within modern trademark protection systems, this new understanding of the modern systems is tested through the evaluation of specific indigenous exemplars – in essence articulating practical *de sententia ferenda* examples. Within the jurisdictions of Norway and the United States a specific exemplar from the Sámi people and Tlingit people, respectively, are presented, described, and examined as potential protectable marks within their relevant trademark structures. These exemplars are also placed within their cultural context within their respective indigenous culture to further a full understanding of how they interact with the foundational trademark motivations. It is from this hypothetical practical application, informed by the foundational approach, that an effective analysis of the protection of trademarks to similar items within similar indigenous resource groups can be deduced and, in turn, the appropriateness or effectiveness of trademark protections within the world of indigenous rights.

The work concludes by discussing the effects of the application of foundational trademark protection within the area of indigenous intangible resources. This views such protection through the lens of public policy effects, including preservation of indigenous cultures, economic foundations of indigenous groups, and consumer market protection.

SAMMENDRAG

Når varemerker brukes diskret, blir de beskyttet på en mindre tilfredsstillende måte. Dette gjelder særlig bruken av varemerker innenfor områdene urfolksrettigheter og beskyttelse av urfolksressurser. Mange feiltrinn stammer fra analyser bygget først og fremst på en forståelse av varemerkebeskyttelse hentet fra moderne lovpålagte strukturer og har påvirket resultatene av innsatsen på dette området. Mye av den nåværende litteraturen om bruk av varemerkebeskyttelse innenfor området urfolksressurser konkluderer med at den generelle varemerkebeskyttelsen ikke gir effektiv beskyttelse, og deretter rettes fokus på spesialiserte og begrensede typer av varemerkebeskyttelse, som geografiske indikatorer eller sertifiseringsvaremerker. Alternativt avvises verdien og bruken av varemerker fullstendig og det argumenteres for nødvendigheten av et helt nytt system for immateriell beskyttelse av urfolksressurser – et *sui generis*-regime.

Dette arbeidet rekonseptualiserer anvendelsen av varemerkebeskyttelse innenfor konteksten av urfolksressurser på et grunnleggende nivå ved først å sikre at varemerkebeskyttelsens natur blir utforsket og artikulert. Grunnleggende varemerkebeskyttelse belyses ved å destillere de tilgjengelige historiske motivene, kravene og beskyttelsene til kjennemerker og utviklingen av varemerkebeskyttelsessystemer til de vanlige grunnleggende vilkårene som utgjør et varemerke. Verket bruker en rettsdogmatisk metode for å artikulere hva loven er med utgangspunkt i den historiske forståelsen og de historiske grunntråder som eksisterer i de moderne systemene. Det er med disse grunnleggende vilkårene at en universell grunnleggende definisjon av et varemerke er komponert og dagens moderne varemerkebeskyttelsesregimer tolkes, betraktes og testes i deres anvendelse på spesifikke sider av urfolksressurser.

Nedenfra og opp-tilnærming er kritisk i dette arbeidet, med utgangspunkt i den rettsdogmatiske sammensetningen og beskyttelsen av varemerker, før man deretter utforsker hvor, innenfor urfolksressursrommet, disse mekanismene kan anvendes. Med en slik tilnærming blir relevante kategoriseringer av urfolksressurser, slik som tradisjonell kunnskap (TK), tradisjonelle kulturelle uttrykk (TCE) og genetiske ressurser (GR), undersøkt, men konklusjonen er at de ikke påvirker varemerkeanalysen.

Etter den rettsdogmatiske konstruksjonen av de grunnleggende vilkårene i varemerkebeskyttelsen og deres relevans innenfor moderne varemerkebeskyttelsessystemer, testes denne nye forståelsen av moderne systemer gjennom en evaluering av spesifikke urfolkseksempler – i hovedsak med hjelp av praktiske *de sententia ferenda*-eksempler. Avhandlingen analyserer hvordan norsk varemerkerett behandler det samiske folk og hvordan amerikansk varemerkerett behandler Tlingit-folket. Disse eksemplene plasseres også innenfor deres kulturelle kontekst og innenfor deres respektive urfolkskultur for å fremme en helhetlig forståelse av hvordan de samhandler med de grunnleggende varemerketilnærmingene. Det er fra denne hypotetiske-praktiske anvendelsen, basert på den grunnleggende tilnærmingen, at en effektiv analyse av beskyttelsen av varemerker til lignende gjenstander innenfor lignende urfolksressursgrupper kan utledes, og i sin tur hensiktsmessigheten og effektiviteten av varemerkebeskyttelsen i verdens urfolksrettigheter.

Arbeidet konkluderer med å drøfte effektene av grunnleggende varemerkebeskyttelse innenfor urfolks immaterielle ressurser. Drøftelsen inkluderer offentlige politiske aspekter, som bevaring av urfolkskulturer, økonomiske grunnlag for urfolksgrupper og beskyttelse av forbrukermarkeder.

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The substantive law of trademarks is in the wing rather than on center stage of the international intellectual property debate. Similarly, traditional knowledge and cultural property concerns of indigenous peoples in relation to trademarks have not taken the center stage of the debate regarding indigenous peoples' intellectual property rights.¹

1. Introduction

The above statement could not ring more true to those who have a knowledge of trademark law and work in, or research, indigenous rights issues. In the past half-century, or so, there has been a marked increase in the relevance of intellectual property to individuals, corporations, and countries. A world that has become more intimately connected through globalisation, combined with a significant rise in the use of technology and the ability to transfer vast amounts of information in split seconds has created an environment where intangibles have become a primary currency.

The reality of this intangible driven modern world is not lost on indigenous peoples. Indeed, much as indigenous peoples have long been significantly, and almost always negatively, affected by the world's desire for natural resources, today's indigenous peoples and individuals are perhaps some of the most vulnerable to the world's current desire for intangible resources.

This vulnerability can be seen in a number of scenarios that have played out in recent history. From the use of indigenous traditional music in popular songs and albums,² and the recreation of indigenous stories in modern movies,³ to the appropriation of

¹ Susy Frankel, 'Trademarks and traditional knowledge and cultural intellectual property' in Graeme B Dinwoodie and Mark D Janis (eds), *Trademark Law and Theory: a Handbook of Contemporary Research* (Edward Elgar 2008) pg 433. All references in this work are formatted according to the *Australian Guide to Legal Citation* (Melbourne University Law Review Association, 4th ed, 2018) and deviate only where necessary.

² Chiung-Wen (Michelle) Chang, "'Return to Innocence": In Search of Ethnic Identity in the Music of the Amis of Taiwan' (2009/2010) 49/50 *College Music Symposium* 327; 'Taiwan Aborigines Sue Enigma, Music Companies', *Taiwan Headline News*, 28 March 1998, available at <https://web.archive.org/web/20091027110752/http://www.geocities.com/enigmair/rtiarticle1.htm> (last accessed 25 June 2024).

³ Tina Grandinette, 'Moana might be great for representation but it's not all heartwarming for Hawaii', *The Guardian* (UK), 12 January 2017, <https://www.theguardian.com/film/2017/jan/13/moana-might-be-great-for-representation-but-its-not-all-heartwarming-for-hawaii> (last accessed 30 July 2023);

indigenous products,⁴ clothing,⁵ or reputation.⁶ The majority population society seems to view indigenous intangible resources as free to use - perpetuating an environment of exploitation and divorcing those elements from the control of the cultural from which they spring.

There have consistently been calls to find mechanisms to protect the cultural expressions of indigenous peoples in attempts to stem the tide of this exploitation. Professor James Anaya, formerly the United Nations Office of the High Commissioner for Human Rights Special Rapporteur on the rights of indigenous peoples, called upon member countries of the World Intellectual Property Organisation to take real steps towards curtailing the cultural appropriation problem.⁷ Indigenous peoples themselves

Anne Keala Kelly, 'Making Sense of Disney's 'Moana'', *Indian Country Today*, 28 October 2016, <https://indiancountrymedianetwork.com/news/opinions/making-native-sense-of-disneys-moana/> (last accessed 30 July 2023); Rayna Breuer, 'How Disney represents other cultures', *DW*, 09 Dec 2021 <https://www.dw.com/en/how-disney-represents-other-cultures/a-60065256> (last accessed 20 June 2024).

⁴ Michael Fanelli, 'Ketchikan's Native leaders speak out against fake totem poles as city considers action', *KRBD*, 24 May 2024, <https://www.krbd.org/2024/05/24/ketchikans-native-leaders-speak-out-against-fake-totem-poles-as-city-considers-potential-action/> (last accessed 26 May 2024); Elizabeth Roberts, 'Chanel's \$1,325 boomerang condemned as 'cultural appropriation'', *CNN Style*, 16 May 2017, <http://edition.cnn.com/2017/05/16/europe/chanel-boomerang/index.html> (last accessed 30 July 2023); Evan Ross Katz, 'Chanel is under fire for cultural appropriation for selling a \$1,325 boomerang', *Business Insider*, 17 May 2017, <http://www.businessinsider.com/chanel-boomerang-is-under-fire-for-cultural-appropriation-2017-5?r=US&IR=T&IR=T> (last accessed 30 July 2023).

⁵ Jessica Misener, 'Karlie Kloss wears Native American headdress at Victoria's Secret fashion show', *Huffington Post*, 8 November 2012, http://www.huffingtonpost.com/2012/11/08/karlie-kloss-victorias-secret-headdress-fashion-show_n_2091958.html (last accessed 30 July 2023); ICMN Staff, 'Here we go again: Victoria's Secret Angel Karlie Kloss dons headdress', *Indian Country Today*, 9 November 2012, <https://indiancountrymedianetwork.com/news/here-we-go-again-victorias-secret-angel-karlie-kloss-dons-headdress/> (last accessed 30 July 2023); *Sealaska Heritage Institute, et al. v. Neiman Marcus Group LTD, et al.*, 1:20-cv-00002-SLG (D. Ak. 2020); Michael S Lockett, 'Sealaska Heritage Institute sues Neiman Marcus for "blatant" copyright infringement', *Juneau Empire*, 20 April 2020 (last accessed 17 April 2024); Christian Allaire, 'Is Fashion Finally Turning the Page on Cultural Appropriation?', *VogueWorld*, 18 August 2023 <https://www.vogue.com/article/cultural-appropriation-appreciation-fashion-september-2023> (last accessed 20 June 2024).

⁶ Jean Teillet, 'Indigenous Identity Fraud – A Report of the University of Saskatchewan', (University of Saskatchewan, 17 October 2022) available at <https://indigenous.usask.ca/documents/deybwewin--taapwaywin--tapwewin-verification/jean-teillet-report.pdf> (last accessed 22 June 2024); *Navajo v Urban Outfitters*, Dist of NM (1:12-cv-195); *Ho-Chunk Nation, et al. v. Nature's Gift, Inc.*, 1999 WL 169319 (N.D.Ill 1999); *Ho-Chunk Nation, et al. v. J.C. Penney Company, Inc.*, 1999 WL 495899 (N.D.Ill. 1999); *Ho-Chunk Nation, et al. v. J.C. Penney Company, Inc.*, 1999 WL 1068700 (N.D.Ill. 1999).

⁷ Hilary Bird, 'Cultural appropriation: Make it illegal worldwide, Indigenous advocates say', *CBC News*, 13 June 2017 available at <http://www.cbc.ca/news/canada/north/cultural-appropriation-make-it-illegal-worldwide-indigenous-advocates-say-1.4157943> (last accessed 25 June 2024).

have also attempted to find solutions at the national level, including through the courts,⁸ special legislation,⁹ or demands for tailored protections.¹⁰

Today, the importance of intangible properties to indigenous peoples is well recognised and debate concerning the intellectual property rights of indigenous peoples is integrated into the overall indigenous rights discourse. As one effort to address the concerns surrounding indigenous intangible resources, the discussion has turned to the protection provided by the western intellectual property mechanisms. Though we have recently seen concrete results from these efforts,¹¹ after decades of work advancement in the protection of indigenous intangible resources through intellectual property regimes has been slow, to say the least.¹²

Furthermore, the examination of intellectual property that has taken place within the context of indigenous intangible properties has a significant bias toward the structures, justifications, and functions of only certain areas within the intellectual property family of laws and mechanisms. Specifically, focus has been on copyright and patent protection, or in some cases the prevention of non-indigenous people from gaining rights to indigenous intangible properties through those regimes.¹³ As stated by Susy

⁸ *Navajo v Urban Outfitters*, Dist of NM (1:12-cv-195); *Ho-Chunk Nation, et al. v. Nature's Gift, Inc.*, 1999 WL 169319 (N.D.Ill. 1999); *Ho-Chunk Nation, et al. v. J.C. Penney Company, Inc.*, 1999 WL 495899 (N.D.Ill. 1999); *Ho-Chunk Nation, et al. v. J.C. Penney Company, Inc.*, 1999 WL 1068700 (N.D.Ill. 1999); *Sealaska Heritage Institute, et al. v. Neiman Marcus Group LTD, et al.*, 1:20-cv-00002-SLG (D. Ak. 2020).

⁹ Law No. 20 of June 26, 2000 on the Special Intellectual Property Regime governing the Collective Rights of Indigenous Peoples for the Protection and Defense of their Cultural Identity and their Traditional Knowledge, and enacting other provisions. (Panama).

¹⁰ Rick Kearns, 'Mayan Weavers Seek Legal Protection of Their Designs', *Indian Country Today*, 11 June 2017 available at <https://indiancountrymedianetwork.com/news/indigenous-peoples/mayan-weavers-seek-legal-protection-designs/> (last accessed 20 June 2024); 'Spinning human rights in Guatemala: the struggle of the Mayan weavers', United Nations, 19 July 2021 <https://guatemala.un.org/es/146085-spinning-human-rights-guatemala-struggle-mayan-weavers> (last accessed 20 June 2024).

¹¹ 'WIPO Member States Adopt Historic New Treaty on Intellectual Property, Genetic Resources and Associated Traditional Knowledge', WIPO, 24 May 2024, available at https://www.wipo.int/pressroom/en/articles/2024/article_0007.html (last accessed 26 May 2024)

¹² Peter Drahos, *Intellectual Property, Indigenous People and their Knowledge* (Cambridge University Press, 2014) ('*Intellectual Property*'), pg 84.

¹³ 'WIPO Member States Adopt Historic New Treaty on Intellectual Property, Genetic Resources and Associated Traditional Knowledge', WIPO, 24 May 2024, available at https://www.wipo.int/pressroom/en/articles/2024/article_0007.html. (last accessed 26 May 2024)

Frankel in the opening statement, trademarks have essentially been left in the wings of this discussion.

The reasons for this are explored further in this work, but suffice it to say at this point that the current evaluations of the application of trademark protection have been constrained by non-fundamental trademark theories, thoughts, and requirements which have clouded the overall discourse. This has resulted in trademarks, when they are considered, being deemed of limited usefulness in the context of indigenous intangible properties. This is especially unfortunate as trademarks are the intellectual property mechanism that is particularly well suited to protection of identity, authenticity, and genuineness – including in the context of indigenous peoples. It is this particular intersection between in the indigenous rights and intellectual property discourse that are addressed in this work.

1.1. Research question and structure of this thesis

Engaging in this enquiry we will employ an approach to the protection of trademarks that rises from the fundamental protection of distinguishing marks. As is seen in Part 3, it is from these fundamentals that the modern systems of trademark protections were built and still exist. However, many of the common conceptions of trademark protection are centered on statutory and legislative constructs of trademarks, modified in certain circumstances by modern interpretive motivations. It is in the avoidance of latter reasoning that this work will focus on the mechanisms for the protection of unregistered trademarks, as they exhibit the most fundamental forms of trademark protections and principles in modern statutory trademark protection systems. The question we will seek to answer is:

To what extent are unregistered trademark protections in modern systems applicable to the protection of indigenous intangible resources?

Embarking on answering this question requires traversing a number of topical and legal areas, not least building a comprehensive understanding of the fundamental principles

of trademark protection. This work will begin by setting the framework for the enquiry, including the scope and limitations within which the enquiry is conducted.

In Part 2 the general placement of intellectual property within the indigenous rights realm is outlined. This is conducted by first giving a brief introduction into indigenous rights discourse and development and then proceeding to the intellectual property specific developments within. Additionally, in this Part, an acute concern relevant to indigenous rights, and in particular indigenous intangible property, are raised.

As stated by the research question, this work is primarily a trademark, and in turn intellectual property, undertaking. Indigenous rights is the context within which the fundamental unregistered trademark protections is tested, but the focus and analysis of this work is not primarily concerned with the rights of indigenous peoples as a whole or beyond their intersection with unregistered trademark protections. It is for this reason that the bulk of this thesis is devoted to the specific articulation and examination of trademarks, trademark protections, and protections of distinguishing marks.

In Part 3, that trademark specific analysis will begin in earnest by presenting trademarks within a historical context and tracing their development through to the modern legislative systems seen in jurisdictions today. This theme is built upon in Part 4, wherein the elements and motivations of a protectable trademark are articulated, dissected, and analysed. It is within this Part that a distilled definition of a trademark is established based on the fundamental requirements for a protectable mark. Part 5 will continue this foundational understanding of trademark protection by examining the role that the public plays in the life and nature of a trademark.

It is at this point in the work that the necessary knowledge of the enquiry will have been established and the conception of a protectable trademark will have been repositioned. Part 6 will then take this knowledge and apply it to two specific example scenarios using particular elements of indigenous culture from two indigenous peoples subject to two different systems of unregistered trademark protection. With the assistance of the fundamental principles, these example scenarios will illuminate the applicability of

unregistered trademark protection to indigenous intangible properties. It will be seen how the fundamental principles subsist within the existing law and systems and how those systems can find usefulness in the indigenous contexts.

With the learnings from the prior sections, Part 7 will then present the protection of indigenous intangible properties, and the tools that can be used for that protection, in the context of the public policy interests at play. Though the rights of indigenous peoples are oftentimes seen as independent and separate from the interests of the majority populations or even States, Part 7 will take a more nuanced view and articulate how indigenous intangible protections interact with, affect, and impact those larger interests.

1.2. Methodology and sources of law

In analysing the application of unregistered trademark protection to the areas of indigenous intangible properties, this enquiry will articulate what the law relating to unregistered trademark protections is at the moment by clarifying it through the lens of fundamental principles of trademark and distinguishing mark protections. It is only after establishing what the law 'is' that specific application of that law is exhibited through the example scenarios in Part 6, and through those example scenarios the existence of these fundamental principles within the current law are illuminated and established. In short, this enquiry will employ the legal dogmatic method.¹⁴

It is specifically the view of this work to articulate what the law is at this time, using the resources of the law itself¹⁵ – that being the sources of the law of unregistered

¹⁴ 'Med <<rettsdogmatikk>> menes fremstillinger av gjeldende rett, det vil si utredninger om innholdet av gjeldende rettsregler.' Jens Edvin A. Skoghøy, *Rett og rettsanvendelse* (Universitetsforlaget, 2nd ed 2023); 'Rettsvitenskapens hovedoppgave er å definere jussens metode – å trekke rammene for det faglig akseptable rettslige resonnement. Som en konsekvens av dette er rettsvitenskapens kjerneområde rettsdogmatikken. Med dette i siste instans praktiske formål med den rettsvitenskapelige virksomhet blir rettsforskerens virksomhet i vesentlig grad – på samme måte som den praktiske rettsanvenderen – rettet mot det å komme fram til konklusjoner mht. Hva som er gjeldende rett.' Jan Fridthjof Bernt, *Rettsdogmatikkens metode og rettspolitikken muligheter*, (1995) 1 Kritisk Juss 10, 12.

¹⁵ 'This method consists in clarifying the meaning of the rule of law, proceeding from its own content.' Alexander V Petrov and Alexey V Zyryanov, 'Formal-Dogmatic Approach in Legal Science in Present Conditions' (2018) 11(6) *Journal of Siberian Federal University* 968; 'Ordinarily legal dogmatics is, at least in the Nordic tradition, defined as the study of the content of the legal rules (norms) and of the

trademarks. The impact of this specificity should be noted as many are unfamiliar with the concept of law as it relates uniquely to unregistered trademarks, as opposed to registered marks or other statutory forms of trademark protection. This nuance is more clearly detailed and explored below in Parts 3 and 4, however, for the current purposes it should be noted that it affects the sources from which we draw guidance.

Unregistered trademark protection necessarily draws its foundations from areas outside of statute or codified law. Their existence arises from contextual uses and understandings, the involvement of the audience and public, historical development and motivations, and generally accepted principles. Additionally, unregistered trademark protections are separate and distinct from registered trademarks or other statutory protections.¹⁶ Thus the method to uncover foundational principles of unregistered trademark protections differs from that commonly associated with trademark analyses. Though this may appear to step outside the bounds of a dogmatic method at times, this results not from a misuse or misunderstanding of the dogmatic method but rather from the nature of unregistered trademarks themselves.¹⁷

Though this use of broader resources is not seen or presented in this work as an expansion of the dogmatic method, it must be noted that the boundaries of the dogmatic method are not static and more liberal approaches within the dogmatic framework have been accepted by certain legal scientists.¹⁸ It is unnecessary, however, to rely on any such extended construction of the dogmatic method in this work. It is the

systematic order of those.' Álvaro Núñez Vaquero, 'Five Models of Legal Science' (2013) 19 *Revus Journal for Constitutional Theory and Philosophy of Law* 53, 58 (quoting Albert Calsamiglia, *Introducción a la ciencia jurídica*, pg 12-13 (Ariel, 1986)).

¹⁶ Varemerkeutredningen II, NOU 2001:8, pg 60; Birger Stuevold Lassen and Are Stenvik, *Kjennetegnsrett* (Universitetsforlaget, 3rd ed, 2011), pg 54 ('*Kjennetegnsrett*').

¹⁷ 'Vi sitter da med tre grupper verdier som alle kan være legitime elementer i et rettslig resonnement: (i) positive verdier, (ii) Generelle rettslige verdier, (iii) Brederer samfunnsmessige verdier.' Jan Fridthjof Bernt, (n 14) at 29; Indeed, '...legal-dogmatic research is far from a unified concept.' Jan Vranken, 'Exciting Times for Legal Scholarship' (2012) 2(2) *Recht en Methode in onderzoek en onderwijs* 42, 48.

¹⁸ 'Others leave some room for external perspectives or data from beyond current positive law or other methods aside from textual analysis and prevailing judicial reasoning.' Jan Vranken (n 17) at 47; 'Til dette kan man føye at formålet med en rettsdogmatisk studie også kan være å frembringe nyheter av mer teoretisk karakter, som nye begreper, en ny systematikk eller utvikling av nye metoder for å foreta rettslige analyser.' Petter Graver, 'Vanlig juridisk metode? Om rettsdogmatikken som juridisk sjanger' (2008) 121(2) *Tidsskriv for Rettsvitenskap* 149, 160

law itself that dictates the sources from which to draw understanding, and when dealing with unregistered trademarks direction must be taken from interpretive sources, such as precedent, as well as general principles of trademark protection.¹⁹ This use is appropriately within the confines of the classic understanding of the dogmatic method.²⁰

It is necessary to distill the general principles at play within the area of this enquiry from broad yet targeted sources. Primarily, these general principles are built from an understanding of the historical uses, protection, and development of distinguishing marks including the genesis and crystallisation of the modern statutory systems. In this sense, one could have the impression that the historical and/or law-in-context methods have been deployed.²¹ However, because this path to illuminate the foundational general principles is integral to the currently existing law on unregistered trademarks, the use of historical sources is only in the service of a clear dogmatic goal. Even where the only available sources are non-legal in nature.²² In essence, the nature of unregistered trademark protection, in and of itself, injects into the dogmatic structure of the existing law a historical element and a dogmatic understanding of unregistered trademarks necessitates such sources.²³

Furthermore, in certain areas of this work insights are drawn, especially in Parts 3 and 4 and relating to the development of the modern statutory trademark systems, from resources topically connected but jurisdictionally diverse. This is necessary because trademarks, especially statutory regimes, were not developed in a jurisdictionally isolated manner. Indeed, much of the motivation behind statutory regimes was

¹⁹ 'Legal dogmatics is a combination of doctrine and dogmas of law.' Petrov and Zyryanov (n 15) at 969.

²⁰ 'Legal dogmatic research concerns researching current positive law as laid down in written and unwritten European or (inter)national rules, principles, concepts, doctrines, case law and annotations in the literature.' Vranken (n 17) at 43.

²¹ See generally, Mark Van Hoecke, 'Methodology of Comparative Legal Research' (2015) *Law and Method* 1, 16-21.

²² Frank I Schechter, *The Historical Foundations of the Law Relating to Trade-Marks* (Columbia University Press, 1925; Lawbook Exchange edition 2012), pg 19 *et seq*; section 3.2 *et seq*. below.

²³ 'Rettsdogmatisk argumentasjon opererer på en annen arena, der det er *selve refleksjonen* og debatten omkring den *generelle holdbarheten* ved gjeldende rett som står i fokus.' Synne Særher Mæhle, 'Gjelder det andre regler for rettslig argumentasjon i rettsdogmatikken enn for domstolene?' (2004) 39(5-6) *Jussens Venner* 329, 334.

developed by States in concert with one another, either through necessity of bi-lateral or multi-lateral treaties, or general international legal momentum.²⁴ These regimes were also built upon common trademark protection principles pre-dating the modern State-based polities. It is for this reason that in order to distill the general principles of trademark protections and their application, the legal and historical sources to which we turn are not restricted to the jurisdictions of Norway and the US – those being the jurisdictions in which the example scenarios of Part 7 will occur. This use of jurisdictionally broad sources is not in a comparative manner, but in a manner supportive of common trademark protection principles and the description of coordinated development.

The dogmatic method is utilized in this work with a view to not only critically articulate the state of the law of unregistered trademarks as it exists currently, but to suggest the proper application of this law with a new and fundamental understanding. In this way the work could be considered one of *de sententia ferenda* – it is not the law itself that requires evaluation, but the understanding of the law and its application in a specific context.²⁵

Above all, it must be noted that this is not a work concerning legal methodology or the nature of legal science. Thus an in-depth analysis of the methodological approach to the enquiry would be outside the scope of this work. Throughout the work it is endeavoured to hold to the dogmatic method and use those sources that serve the purpose of illuminating the law as it is now in a manner that would be familiar to the practitioner and comfortable to the legal researcher.

1.3. Literature review – the necessity of a fundamental trademark approach

Before embarking on the substantive examination in this work, it is necessary to understand the landscape of prior legal scholarship concerning intellectual property and

²⁴ See section 3.3 below.

²⁵ 'Nyheten kan bestå i at leseren mottar kunnskaper han eller hun ikke hadde på forhånd. Det kan være at det er et nytt problem som behandles, eller at gamle problemstillinger er underkastet en fordypet analyse eller er analysert på en ny måte. Det kan også være at nytt materiale er trukket inn.' Graver (n 18) at 159.

indigenous rights. The brief description in the introduction and section 1.1 was not to give the impression that there is a lack of scholarship or commentary on the application of trademark protections within the context of indigenous rights. Indeed, there is a modest wealth of works in the legal scholarship, political and diplomatic consideration, and even international and domestic legal instruments. A number of these have even focused specifically on the application of trademarks, as opposed to intellectual property generally. However, as is described below, a focused analysis of trademark protections supported by fundamental understanding of trademark principles has been lacking in the discourse.

While there were early inroads into the protection of indigenous intangible resources, such as the anonymous or unknown author provisions of the Berne Convention,²⁶ at the mid-twentieth century these were based mostly within a decolonialist justification – human rights, and assisting developing countries.²⁷ The intellectual property component of the indigenous rights discourse has only truly started to be formalized in the internationally arena within the last few decades, particularly with the establishment of the IGC and is still far from fully materialized.

From the latter half of the twentieth century to the present day there has been development of indigenous rights discourse and, in tandem, the discourse on protection of indigenous intangible properties. It is no mistake that an increasing interest in indigenous intangible properties also followed the rise in technological innovation, globalized commerce, and importance of intellectual property overall. The literature in the area of the protection of indigenous intangible properties has similarly proliferated. At the moment, this fair amount of research and discussion surrounding the intellectual property rights of indigenous groups extends through many different subject areas including ethnology, sociology, indigenous studies, and more formal legal arenas.

²⁶ Records of the Intellectual Property Conference of Stockholm June 11 to July 14, 1967, (WIPO: Geneva, 1971) Vol II, pg 876. Available at <https://tind.wipo.int/record/28763?v=pdf> (last accessed 19 June 2024), pg 1199.

²⁷ 1967, 1982, 1984: Attempts to Provide International Protection for Folklore by Intellectual Property Rights, (WIPO 1997) UNESCO-WIPO/FOLK/PKT/97/19 ('1967, 1982, 1984'), pg 2; Records of the Intellectual Property Conference of Stockholm June 11 to July 14, 1967, (WIPO: Geneva, 1971) Vol I, pg 685. Available at <https://tind.wipo.int/record/28766?ln=en&v=pdf> (last accessed 19 June 2024).

However, when viewed with a more critical intellectual property eye, a number of themes arise which have hindered a clear understanding of the application of trademark protections within the context of indigenous peoples' rights. Primary among these themes are the collapsing of all areas of intellectual property into one examinable area and misunderstanding the fundamental nature of trademark specific protection.

1.3.1. Literature and collapsing the intellectual property umbrella

Scholars and commentators treating the concept of intellectual property as a cohesive area, or a collection of intimately related areas, of law has in many instances led to concerning analysis of the application of discrete areas of intellectual property, especially trademarks. While this grouping may be helpful for short-hand conversation, when attempting an effective enquiry involving intellectual property it becomes a hindrance, and in some cases a flaw in the discussion. In reality, the only commonality shared by the differentiated areas of intellectual property law, namely trademarks, copyrights, and patents, is that they deal with 'properties' of an incorporeal nature. The motivations, legal underpinnings, justifications, and goals of each area are significantly different, and at times entirely opposed to those of other areas under the IP umbrella.

This misconception leads to inexact and sometimes incoherent examinations of the intellectual property rights of indigenous peoples. This may occur either by basing the examination on broad sweeping statements of intellectual property that are, in fact, only applicable to discrete areas of the intellectual property family, or by reducing all of intellectual property to the confines and structures of one of the areas to the exclusion of others. Examples of this misconception can be readily seen in non-legal literature commenting on intellectual property concerns. In *On revision and revisionism: American Indian representations in New Mexico*,²⁸ Theodore S. Jojola fell victim to conflating all of intellectual property into the one area and understanding of copyright law – '...most Native communities still must contend with the unabashed appropriation of their creative and intellectual knowledge base. At the crux of the matter, a legal concept of "intellectual property" steadfastly is emerging. Unlike the repatriation of cultural

²⁸ Theodore S Jojola, 'On revision and revisionism: American Indian representations in New Mexico' (1996) 20(1) *American Indian Quarterly* 41.

objects of artifacts, *that issue is centered around the legality of copyrighting cultural knowledge for profit.*²⁹ This statement is quite plainly a misunderstanding of intellectual property and copyright law which, unfortunately, led to an incorrect intellectual property conclusion in that work.

Yet this misconception is not limited to non-legal scholarship. Wanjiku Karanja similarly collapses all intellectual property into the confines of copyrights justifications. In Karanja's work *The Legitimacy of Indigenous Intellectual Property Rights' Claims*,³⁰ it was stated '[t]he IPR system as under the intellectual property law regime is premised on the following principles: i. Copyright ... [and] ... ii. Droit d-auteur and droit moral...'.³¹ No mention was made in that work of any other area of intellectual property, thus Karanja's seems to suggest that the intellectual property rights system as a whole is composed of copyrights, moral rights, and nothing else.³²

In *Intellectual Property Rights for Indigenous Peoples: a Sourcebook*³³ the conflation of intellectual property law was reinforced as Tom Greaves, editor of that work, states '[w]hen legal mechanisms are sought for indigenous [intellectual property rights], two central legal vehicles are most commonly mentioned: (1) the right to copyright or patent group ownership of cultural knowledge ...'.³⁴ Greaves then proceeds to articulate the certain various hurdles of applying patent and copyright protection to indigenous resources -

When lawyers first hear talk about according patent or copyright protection to indigenous culture, they roll their eyes. They see three immediate conceptual problems that make the whole plan seem ridiculous. The first problem is that copyrights and patents are for *new* knowledge, not for

²⁹ Id., pg 45 (emphasis added)

³⁰ Wanjiku Karanja, 'The Legitimacy of Indigenous Intellectual Property Rights' Claims' 1 *Strathmore Law Review* 165 (2016).

³¹ Id., pg 177-178.

³² See also, Paul Kuruk, *Traditional Knowledge, Genetic Resources, Customary Law and Intellectual Property* (Edward Elgar, 2020), pg 39; Janet Blake, *International Cultural Heritage Law* (Oxford, 2015), pg 231 - 'Moreover, IP rules are essentially individualistic in character and their underlying values place a high premium on the central concepts of authorship and innovation...'

³³ Tom Greaves (ed), *Intellectual Property Rights for Indigenous Peoples: A Sourcebook* (Society of Applied Anthropology, 1994)

³⁴ Tom Greaves, 'IPR, A current survey' in Tom Greaves (ed.), *Intellectual property rights for indigenous peoples: a sourcebook*, (Society for Applied Anthropology, 1994) pg 6. The second vehicle cited by Greaves was control of access to resources.

knowledge that already exists. ... The second problem is that copyrights and patents are conferred on individuals (or corporations, legal entities acting as individuals). They give individuals ownership rights that are thereby *denied* to the other members of their society. Thus, copyrights and patents go to individuals, not to whole societies. The third problem is that copyrights and patents are supposed to confer temporary rights.³⁵

Though in this instance the patent and copyright mechanisms are specifically identified they are dealt with as conceptually springing from the same common font. Perhaps more concerning, other than that the interpretation of the functioning of these areas is questionable, is that these parameters based around only patents and copyrights are the definition of intellectual property rights used throughout that work. Indeed, the other authors in Greaves' book put into practice that simplified intellectual property rights definition, such as Darrell Posey - '[Intellectual property rights] developed as a Western concept that was essentially established to protect individual, technological and industrial inventions.'³⁶

Intellectual property rights defined in this manner does not account for all of the various protections that fall under the intellectual property rights banner and thus reinforces an incomplete understanding of intellectual property. Unfortunately, Darrell Posey employed a similarly incorrect conception of intellectual property when a few years after the *Sourcebook* he definitively stated '[Intellectual property rights] were established to protect individual *inventions* and *inventors*, not the collective, ancient folklore and TEK [traditional ecological knowledge] of indigenous and local communities'.³⁷ Intellectual property rights were not, in fact, established to protect inventions and inventors – patents were, but patents are merely one area of the intellectual property system and their justifications should not be read as applicable to

³⁵ Id., pg 8.

³⁶ Darrell A Posey, 'International agreements and intellectual property rights protection for indigenous peoples' in Tom Greaves (ed.), *Intellectual property rights for indigenous peoples: a sourcebook*, (Society for Applied Anthropology, 1994) pg 225; see also Neil Jessop Newton (ed), *Cohen's Handbook of Federal Indian Law* (LexisNexis, 2012, 2023 Supplement) ('*Cohen's Handbook*'), 20.02 *et seq.*

³⁷ Darrell A Posey, The 'Balance Sheet' and the 'Sacred Balance': Valuing the knowledge of Indigenous and Traditional Peoples' (1998) 2 *Worldviews: Environment, Culture, Religion* 98 (emphasis added).

intellectual property generally.³⁸ Similarly, the idea that intellectual property was designed to protect the individual, as opposed to the collective, is arguable at best if indeed one could ascribe to all of intellectual property one grand design.

The above was not meant to single out the mentioned scholars, but rather to illuminate how authors can easily fall into the trap of ignoring the distinct, separate, and unique sectors of intellectual property which all require their own understanding. Intellectual property in these circumstances can end up being used in questionable manners, is perhaps seriously misunderstood, and can lead to unhelpful and ill-informed results.

1.3.2. The collapsed umbrella and trademarks

The effects of collapsing the branches of intellectual property becomes more apparent and exaggerated when attempting to conduct a discussion surrounding trademarks and trademark protection. Indeed, '[t]here is no end of misinformation among otherwise intelligent people as to how the right to a trade-mark is acquired. Every lawyer of much experience in trade-mark matters will instantly recall the client who tiptoes into his office, closes the door with an air of mystery and wants immediate protection of some name or device he has conceived. He says that he wants it "copyrighted" (this is the expression generally used) or registered immediately, and before anyone can steal it."³⁹ It is obvious that this stereotypical client in Edward Rogers' 1914 hypothetical is employing similar missteps of conflating the areas of intellectual property while also misunderstanding trademarks.

The concern of grouping trademarks together with other areas of intellectual property arises from the fact that trademark protection stems from entirely different circumstances and legal foundations than patents, copyrights, or other intellectual property mechanism. Indeed, it is not uncommon for commentators to approach intellectual property as a harmonized system with a common goal, without recognizing the inherent and entirely different nature that a trademark has when compared to its IP

³⁸ See also, Dennis S Karjala and Robert K Paterson, 'The failed case for property rights in intangible indigenous cultural property' in Christoph Antons and William Logan (eds), *Intellectual property, cultural property and intangible cultural heritage* (Routledge 2018)

³⁹ Edward S. Rogers, *Good Will, Trade-Marks and Unfair Trading* (A.W. Shaw Company, 1914; Lawbook Exchange edition 2004), pg 54.

relatives. This seems to be particularly prolific in the discussions surrounding the application of intellectual property protections to indigenous intangible resources. The perceived coherent intellectual property motivation has often been styled as the ‘proliferation of knowledge’, ‘creativity’, or ‘innovation’. Johanna Gibson has stated that ‘[i]n this way, intellectual property operates as what Jean-François Lyotard would call a “grand narrative,” justifying itself as progress, harmonized, and total in its rendition of knowledge, the narrative of innovation.’⁴⁰ Gibson further sees this narrative as extending to creativity – ‘Thus, “creativity” has emerged as a central value within the international and diverse debates surrounding intellectual property rights.’⁴¹

Dennis Karjala and Robert Paterson more recently employ a refinement of the ‘grand narrative’ of intellectual property law where they base their analysis and understanding of intellectual property upon the idea that it, as an area of law, is concerned with the protection of ‘information’.⁴² Indeed, in their assessment, ‘[r]ights in information – especially *property rights* in information – are a relatively new concept in human development.’⁴³ This understanding both conflates all areas of intellectual property while also making conclusory statements which become highly questionable especially because of that improper conflation.⁴⁴

However, reliance upon a single ‘grand narrative’ that applies to all intellectual property ignores the vast difference between the functioning and justifications supporting each individual area of intellectual property. Furthermore, doing so leads to perhaps the most discouraging misconception found within the indigenous intangible resource and trademark rights discourse. That being critical evaluations of the application of trademark right protections to indigenous intangible resources being based upon the

⁴⁰ Johanna Gibson, *Community Resources: Intellectual Property, International Trade and Protection of Traditional Knowledge* (Ashgate, 2005) (‘*Community Resources*’) pg 77.

⁴¹ Johanna Gibson, *Creating Selves: Intellectual Property and the Narration of Culture* (Ashgate, 2006) pg 40.

⁴² Dennis S Karjala and Robert K Paterson, ‘The failed case for property rights in intangible indigenous cultural property’ in Christoph Antons and William Logan (eds), *Intellectual property, cultural property and intangible cultural heritage* (Routledge 2018), pg 89 *et seq.*

⁴³ *Id.* at pg 91.

⁴⁴ To be clear, if we accept the grand narrative proposed by Karjala and Paterson as applying to all intellectual property then the following historical analysis of trademark protection in this work will undoubtedly show that protecting ‘information’ is not ‘a relatively new concept’. See Part 3.

idea that the perceived 'grand narrative' is equally applicable to trademarks as it is to patent and copyright protections.

In the majority of scholarly efforts that apply trademark protection within the indigenous context, the collapsing of this intellectual property umbrella and the reliance upon some sort of IP 'grand narrative' has given rise to certain common concerns that prevent valuable trademark application. These concerns can generally be distilled into two distinct areas. The first being that trademarks, through the conflation of all intellectual property, are of an individualistic nature unconcerned with the collective and thus of little use to indigenous peoples. While such an individualistic focus may be applicable to specific intellectual property areas,⁴⁵ it does not entirely apply to the area of trademarks and certainly not to all intellectual property. Yet, an individualistic attribute is commonly imputed to the entirety of the IP system as exemplified by Mary Riley's statement - '...Western intellectual property systems focus upon the needs and rights of the individual person (or the fictive corporate individual, such as the corporate entity) and the rights and relationship of this individual to any new creation or invention in which rights are vested...'.⁴⁶

Even when attempting to view trademarks in isolation from other areas of intellectual property, this attribute seems to remain. As is exhibited by Agnès Lucas-Schloetter stating that '[i]n practice, however, the application of trademark law to expression of folklore will certainly be restricted by the hesitation of the members of the community concerned to effect the registration, since they consider the symbols in question to belong to all and to have a sacred character for certain members of the community.'⁴⁷

⁴⁵ Though, the individualistic nature of these IP relatives has also been called into question, - see generally, Jan Rosén (ed), *Individualism and Collectiveness in Intellectual Property Law* (Edward Elgar 2012).

⁴⁶ Mary Riley (ed), *Indigenous Intellectual Property Rights: legal obstacles and innovative solutions* (Alta Mira Press, 2004), introduction pg x; see also, Paul Kuruk, *Traditional Knowledge, Genetic Resources, Customary Law and Intellectual Property* (Edward Elgar, 2020), pg 39; Janet Blake, *International Cultural Heritage Law* (Oxford, 2015), pg 231 - 'Moreover, IP rules are essentially individualistic in character and their underlying values place a high premium on the central concepts of authorship and innovation...'.⁴⁷

⁴⁷ Agnès Lucas-Schloetter, 'Folklore' in Silke von Lewinski, *Indigenous Heritage and Intellectual Property: genetic resources, traditional knowledge and folklore* (Wolters Kluwer, 2nd ed, 2008) pg 401; see also, Paul Kuruk, *Traditional Knowledge, Genetic Resources, Customary Law and Intellectual Property* (Edward Elgar, 2020), pg 47.

This incorrect individual aspect of trademarks, imported from other areas of intellectual property receives further validation from other prominent scholars such as Peter Drahos - 'A trade mark system offers indigenous people options. An *individual or an organization* may apply for a trade mark. Trade marks can be used to develop a regional approach to marketing.'⁴⁸

For the moment it is not critical to embark on an extensive explanation of the possible communal nature of trademark protection, that shall take place in more detail in subsequently. The important understanding to take from this section is how the idea of trademark protection being an individualistic protection arose from a blending of different areas of intellectual property. It is important to resistance this blending as was well stated by Professor William van Caenegem - 'individualism and novelty are in fact not central to all areas of intellectual property: protection and preservation of goodwill or reputation is a different matter altogether, and may therefore present better opportunities for the recognition of Indigenous law.'⁴⁹

1.3.3. The misunderstood trademark within indigenous discourse

The second concern that grows from analysis of the indigenous properties space with an infirm trademark foundation is the incorrect assumption that use of trademarks by an indigenous group⁵⁰ would require registration of such mark. As exemplified by Annette Kur and Roland Knaak when analysing the protection indigenous peoples could find under the national trademark systems for traditional names and designations –

The following discussion first addresses the issue of absolute grounds for refusal [of a registration], ... It then turns to a consideration of the possibility that registration is denied on the basis of relative grounds for refusal... Next, the question of whether registration of traditional insignia or names by entities...'.⁵¹

⁴⁸ Drahos, *Intellectual Property* (n 12) pg 189 (emphasis added); see also pgs 182-194 discussing certification marking.

⁴⁹ William van Caenegem, 'Geographical indications and indigenous intellectual property' in Matthew Rimmer (ed.), *Indigenous Intellectual Property: A Handbook of Contemporary Research* (Edward Elgar, 2015), pg 289.

⁵⁰ Or anyone for that matter.

⁵¹ Annette Kur and Roland Knaak, 'Protection of Traditional Names and Designations' in Silke von Lewinski (ed), *Indigenous Heritage and Intellectual Property: genetic resources, traditional knowledge and folklore* (Wolters Kluwer, 2nd ed, 2008) pg 313.

Though Kur and Knaak present well-reasoned and effective positive strategies that indigenous groups could put into practice, it can be seen that they entertain little possibility for the use of trademark protection outside of the structures of registration. Agnès Lucas-Schloetter seems to tentatively agree with certain trademark usage by indigenous groups, however is similarly constrained to a trademark analysis within registration system - 'the expressions of folklore, or at least some of them, can in principle be **registered** as a trademark.'⁵²

Johanna Gibson employs a similar reliance upon the trademark registration system, then dismisses the usefulness of the entire world of trademark protection based on this registration skewed view - 'Similarly, trade mark protection is not readily available [for indigenous groups] other than through efforts to "exclude" certain material from trade mark registration.'⁵³ Whereas Susy Frankel views certain trademark rights as only available and contingent upon registration - 'trade mark laws will not prevent the offensive use of TCEs where the user does not seek to register a trade mark'.⁵⁴

Some may see the primacy of a registration-based review justified particularly because certain jurisdictions have a trademark protection system structured to grant trademark rights through the registrations themselves, as opposed to rights-through-use regimes. However, even this significant difference between the two prevailing trademark systems in the modern legal world does not entirely explain basing a critical trademark examination upon the system of registration alone. To do so would ignore the fact that even in registration-based jurisdictions there are certain overt, or even residual, protections for unregistered marks.⁵⁵ Furthermore, there are outside factors that are incorporated into the registration systems that affect trademark rights.⁵⁶

⁵² Agnès Lucas-Schloetter (n 47) pg 400 (emphasis added).

⁵³ *Community Resources* (n 40) pg 9.

⁵⁴ Daphne Zografos, *Intellectual Property and Traditional Cultural Expressions* (Edward Elgar, 2010) pg 102.

⁵⁵ Verena von Bomhard and Artur Geier, 'Unregistered Trademarks in EU Trademark Law' (2017) 107(3) *Trademark Reporter* 677.

⁵⁶ See for example, varemerkkeloven §15, §16; 15 USC 1052; Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark (codification), articles 7, 8.

This tendency to evaluate all trademark rights according to a system of trademark registration does not take into account the protections provided to trademarks absent registrations and necessarily leads commentators to question the applicability of trademark protection, in its entirety, in the area of indigenous rights and properties. Primarily this is because of registration based requirements such as administrative formalities, use in commerce, prior registrations, and not least cost of registrations to cover all possible trademark protectable expressions.⁵⁷ For instance, Daphne Zografos has consistently brought up the issue of the costs of a registration scheme as a limiting factor to trademark protection of indigenous intangible resources. ‘The trademark system does not offer a comprehensive positive protection system, as it would be prohibitively expensive to register all existing traditional words, designs and symbols that indigenous communities may want to see protected as trade marks.’⁵⁸ While generally positive to the use of trademark protections, Zografos also rightly highlights the costs associated with such a system outside of the registration outlays –

The trade mark system can help indigenous communities benefit from the branding of their TCEs [traditional cultural expressions], and protect their economic interests in those TCEs by allowing the registration of distinctive indigenous names, signs or symbols. ... However, it should be noted that there are costs associated with the registration of a trademark... the enforcement of rights and the implementations of a marketing strategy.⁵⁹

This costs-based resistance to trademark protection for indigenous cultural properties is only supportable when an analysis is limited to registration-based values, structures, and functioning.

A further consequence of the prevailing registration-based commentary on trademarks and indigenous intangible resources is that it then places many registration-based actions as valuable goals within that context. As stated by Sari Sharoni, ‘[i]nstead of

⁵⁷ It must also be noted that the concept that trademark protection is designed only for individuals may also be connected with a myopically registration-based view. When a trademark analysis is centered on the requirements of a registration, the trademark registration application become central and trademark applications generally need an ‘owner’/ ‘applicant’.

⁵⁸ Zografos (n 54) pg 102.

⁵⁹ Daphne Zografos Johnsson, ‘The branding of traditional cultural expressions: to whose benefit?’ in Peter Drahos and Susy Frankel (eds.), *Indigenous Peoples’ Innovation: Intellectual Property Pathways to Development* (Australian National University E Press, 2012) pg 155.

trademark registration, some groups would prefer to see an absolute prohibition of registration of their cultural products.⁶⁰ Success in this manner has been achieved in certain jurisdictions, including the New Zealand Trade Marks Act 2002,⁶¹ the US Native Tribal Insignia Database,⁶² and of note the successful cancellation of the Redskins trademarks.⁶³ Unfortunately, these victories over the registration of certain indigenous cultural properties, offensive and disparaging usages, or even systems to address registration based concerns do not lead to any substantive or practical change in the context of actual trademark protection and usage. It must be made clear that prevention of the registration of a mark, or cancellation of a registration, does nothing in and of itself to prevent anyone from using that mark – whether it be offensive, disparaging, or misappropriating of cultural property.

1.3.4. The necessity of a fundamental trademark approach in the indigenous context

These persistent misconceptions regarding intellectual property, and in particular trademarks, have derailed the discourse of indigenous intellectual resource protection. Collapsing the discrete mechanisms under the IP umbrella into one ‘grand narrative’ has had the effect of focusing much of the current scholarship in indigenous intangible resources on the areas of patents and copyrights, whether consciously or unconsciously.

When Johanna Gibson states ‘[i]ntellectual property rights are based upon an identification of the individual source of the creation, whether the author of a copyright work, the inventor of a patentable invention, and so on.’,⁶⁴ it is within the ambiguous and unexplored ‘so on’ that all the other aspects of intellectual property including trademarks are found. Clearly the thought focus is upon the functions, structures, and motivations behind patent and copyright protections, yet they are used in a manner to colour the entirety of intellectual property. This, necessarily, excludes trademarks from

⁶⁰ Sari Sharoni, ‘The Mark of a Culture: The Efficacy and Propriety of Using Trademark Law to Deter Cultural Appropriation’ (2016-2017) 26 Federal Circuit Bar Journal 407, 428.

⁶¹ See section 2.3.1, *infra*.

⁶² Trademark Law Treaty Implementation Act of 1998, PL 105-330, 112 State 3071 (US), section 302.

⁶³ *Blackhorse v Pro-Football*, 111 USPQ2d 1080 (TTAB 2014); *Pro-Football v Blackhorse*, 112 F.Supp.3d 439 (ED Vir 2015); However, the basis of this judgment has been called into question by *Matal v Tam*, 137 S.Ct. 1744 (2017) ruling the disparagement clause of Lanham Act section 2, 15 USC 1052 as unconstitutional.

⁶⁴ *Community Resources* (n 40) pg 106.

the critical evaluation it deserves and, in turn, clouds the application and usefulness trademarks may lend to the protection of indigenous intangible resources.

Additionally, where the subject of trademarks is addressed the *modus operandi* has been to view the issues through the lens of trademark registration, dismiss registered trademarks applicability and usefulness based on bars to registration or impracticality, turn attention to specific species of trademarks and trademark-like protection such as collective marks, certification marks, and geographical indicators, and finally to espouse that those species may be useful in certain commercial contexts. Alternatively, many use the same basis to espouse the need for *sui generis* protections,⁶⁵ new regimes and structures, and not least international instruments.

This pattern is apparent throughout the literature on the subject of the protection of indigenous rights. Betsy Fowler's evaluation articulates a typical train of logic in this fold

—

A trademark is either a word, phrase, symbol or design—or combination of words, phrases, symbols or designs—which identifies and distinguishes the source of goods of one party from those of others. Trademark duration after registration is a much shorter time period than copyright, but unlike copyright, can be renewed in perpetuity. Trademarks can be further broken down into two categories that hold promise for the protection of indigenous crafts. These are known as collective and certification marks.⁶⁶

Even commentators that take a more thorough approach to trademark law fall into this formulaic trope. Such as Sari Sharoni's *The Mark of a Culture: The Efficacy and Propriety*

⁶⁵ See generally, Robert K Paterson and Dennis S Karjala, 'Looking Beyond Intellectual Property in Resolving Protection of the Intangible Cultural Heritage of Indigenous Peoples,' (2003) 11 *Cardozo J. Internat'l & Comp L* 633, 652 *et seq*; Karjala (n 42) pg 99.

⁶⁶ Betsy J Fowler, 'Preventing Counterfeit Craft Designs', in J Michael Finger and Philip Schuler (eds.), *Poor People's Knowledge: promoting intellectual property in developing countries*, pg 115 (internal citations omitted). Other examples of this process can be found in Darrell A Posey and Graham Dutfield, *Beyond Intellectual Property: toward traditional resource rights for indigenous peoples and local communities*, (International Development Research Centre 1996), pg 84 *et seq*.; *Kur and Knaak*, above n51 pg 293 *et seq*.; Stephen Palethorpe and Stefaan Verhulst, Report on the International Protection of Expressions of Folklore Under Intellectual Property Law, Final Report October 2000, Contract Number ETD/2000/B5-3001/E/04, section 3.4 pg 32 *et seq*.; Caroline Joan "Kay" Picart, *Law In and As Culture: Intellectual Property, Minority Rights, and the Rights of Indigenous Peoples* (Fairleigh Dickinson University Press 2016) pg 143.

*of Using Trademark Law to Deter Cultural Appropriation*⁶⁷ where Sharoni takes a rather more positive view of the possibility of trademark protection and spares a few lines to consider unregistered marks. Yet, even here the reasoning is based upon the system of registration,⁶⁸ which is dismissed because of an individual/collective nature tension, and Sharoni eventually arrives at collective and certification marks -

While many cultural products would be eligible for trademark *registration* under the Lanham Act if used in commerce and distinctive of a single source, some may not even meet this threshold requirement. Cultural groups may seek to protect their products that are not used in the course of a sale and do not designate a single source, but instead designate the whole source community. Accordingly, cultural groups may find more suitable protection under the Lanham Act as collective or certification marks.⁶⁹

This, however, is not to say that the prior efforts in the protection of indigenous intangible resources have been valueless. Indeed, a great many strides have been made in this area, the contours of intellectual property have been challenged and expanded, and the discussion surrounding intellectual property's applicability to indigenous peoples rights has been elevated.

Where the protections afforded by trademark regimes have been invoked there has been esteemed progress. Most notably is the work of Daphne Zografos where she came to the conclusion that 'trade marks can provide both positive and defensive protection for TCEs and can offer a quick, practical and effective solution for their protection. There is no need for the creation of a new *sui generis* IP or IP related system, which would take a long time to establish, as trade mark laws can be used as such or with minor adaptations...'.⁷⁰ Professor William van Caenegem's also went to great lengths to critically view the foundational aspects and motivations behind trademark protections and their applicability to indigenous intangible resources while clearly separating them from the other areas of intellectual property.⁷¹ Yet, even these authors either maintain

⁶⁷ (2016-2017) 26 Federal Circuit Bar Journal 407.

⁶⁸ In this case the Lanham Act of the United States, 15 USC 1051, *et seq.*

⁶⁹ Sharoni (n 60) pg 428 (emphasis added); See also, Kuruk (n 32) pg 47.

⁷⁰ Zografos (n 54) pg 100.

⁷¹ van Caenegem (n 49) pg 289.

a focus upon the structures and requirements for registration of marks,⁷² or ultimately advocate for a strengthened system of geographical indications protection.⁷³

What has been lacking from the discourse on indigenous intangible resource protection and trademarks is a thoroughly foundational examination of trademarks from which to build. Unfortunately, the lack of such a foundational approach within the indigenous intangible resources context now permeates to even accomplished indigenous rights scholars' thinking. Mattias Åhrén clearly centered his discussion of trademark protections' applicability to indigenous groups upon registration when he stated '[i]f the sign is not already trademarked, the indigenous people hold property right to it and can prevent trademarking. If the sign has already been trademarked, no property right pertains.'⁷⁴ This has led to the discouragement of many in their use of trademark protections in the area of indigenous rights.

It is for these reasons that this work will embark on the fundamental approach to trademark protection within the area of indigenous rights. It will take a foundational approach to trademarks and attempt to form a more comprehensive understanding of their application to indigenous intangible resources, or rather set the scope of protection within which may be discovered what indigenous intangible resources could find protection.

Similarly, a more foundational approach to the indigenous intangible properties is employed in this work. Any effort in the indigenous rights and intellectual property area will never entirely be able to evaluate these issues absent the categorization inherent in the modern discourse. Indeed '...phrasing an interest in protecting indigenous peoples' intellectual property rights in a manner that makes this initiative intelligible, within law's own categories and using law's own terms, allows the initiative to become audible, and

⁷² Zografos (n 54) pgs 100-101.

⁷³ van Caenegem (n 49) pg 309

⁷⁴ Mattias Åhrén, *The Saami Traditional Dress and Beauty Pageants: Indigenous Peoples' Rights of Ownership and Self-determination over Their Cultures*, University of Tromsø PhD Thesis, Autumn 2010, pg 285 ('*The Saami Traditional Dress*').

to some extent, cognizable.⁷⁵ However, it is from an attempt to make indigenous intangible resource concerns ‘audible’ that the forced division of indigenous resources into categories has taken place, primarily those of Traditional Knowledge (TK), Traditional Cultural Expressions (TCEs), and Genetic Resources (GRs). This work shall set aside those categorization, at least as far as they are built from their own definitions. Instead, we will view the issues from the protection provided by trademarks first, at a foundational level, and may then resolve a grouping of indigenous resources to which that protection may apply.

There are some that believe that ‘[t]he law of trade marks, certification and collective marks, and GIs have not been designed, for the most part, with the protection of indigenous interests as an underlying policy goal. The utility of these laws as tools for holders of TCEs to protect their indigenous names, signs and symbols is therefore often coincidental.’⁷⁶ By approaching this question through a fundamental trademark lens and within an indigenous context unburdened by attempts to categorise indigenous properties it may be seen that trademark protections, when employed to the benefit of indigenous peoples, is not coincidental but rather exemplifies the a very use for which trademark protection was designed.

1.4. Scope and limitations of this work

1.4.1. Trademarks specifically – not an indigenous rights work

As outlined above, a primary concern within this work is to avoid the conflation of the areas of intellectual property and rather focus specifically on trademarks in a fundamental way. In this, the work is focused on the area of trademarks and trademark protections and thus any in-depth analysis of the other areas of intellectual property is outside the scope of this work. This limitation to trademark analysis is a deliberate choice because a fundamental analysis of trademark law, in the indigenous context, allows a dogmatic clarification of that law which may reveal protections as yet unrecognised.

⁷⁵ Picart (n 66) pg 94.

⁷⁶ Zografos Johnsson (n 59) pg 162. *See also*, Frankel (n 1) pg 435 - ‘The use of trademarks to protect signs and symbols of indigenous cultures is, at the most, happenstance.’.

Additionally, it is important to remember the impact that a clear understanding of existing trademark protection could have within the indigenous context. Trademarks are uniquely designed to address some of the most pressing concerns relating to indigenous rights in the modern world. By their nature they are a protection of identity, and it is just such an identity protection that would be powerful if it could be deployed on behalf of indigenous peoples, communities, and individuals. These impacts are explored in more depth in Part 7 of this work.

1.4.2. Limited to the Sámi and Tlingit People

It must also be stated that there are certain limitations in the work relating to the indigenous groups and resources that are presented. This is of particular note in Part 6 of the work, where the learnings relating to unregistered trademark protections are tested through specific example scenarios. It is at that point where the work is limited to the relevant law applicable to the Sámi and Tlingit respectively to elucidate the functioning of the trademark protection understanding within those jurisdictions. This occurs by evaluating Sámi elements within the Norwegian legal system, and Tlingit elements within the federal US system as applied within the state of Alaska.

This necessarily means that the ultimate conclusions of Part 6 may be seen as having limited applicability outside of the bound of the work. However, the limitation to cultural elements of specific peoples within specific jurisdictions will not diminish the usefulness of the enquiry within other contexts, jurisdictions, and applied to other resources of other peoples. The example scenarios act as merely concrete articulations of principles that are found within trademarks and will have applicability to similarly situated indigenous groups with similar intangible resources even in other jurisdictions.

With this in mind, before embarking on the substantive analysis it is helpful to have familiarity with the Sámi and Tlingit peoples, so as to understand the historical, geographical, and jurisdictional scope within which the example scenarios are conducted, and the background context of this enquiry.

1.4.3. The Sámi people

The Sámi are an indigenous people of Northern Europe. They ‘traditionally inhabit a territory known as Sápmi,⁷⁷ which spans the northern parts of Norway, Sweden and Finland, and the Russian Kola Peninsula.’⁷⁸ Though the national borders of four countries today divides Sápmi, the Sámi remain a unified and united people with linguistic, cultural, and social connections, and a common identity. ‘The Saami people continue to be one people, in spite of having their territory divided by borders drawn by others.’⁷⁹

The Sámi were traditionally sustained by a lifestyle of hunting, fishing, foraging, and primarily reindeer herding – for which the Sámi are well known today.⁸⁰ Certain Sámi groups also settled in coastal areas (‘Sea Sámi’) others maintained a more fixed abode in forested tracts, where they could also keep reindeer.⁸¹ However, irrespective of these variations in the Sámi traditional livelihoods and culture, the Sámi are to a large part still a nomadic people as the reindeer herding Sámi still migrate between pasteur areas according to the demands of the reindeer which they herd.⁸² The Sámi lifestyle, and in turn culture, is deeply connected with the land upon which these traditionally activities

⁷⁷ It should be noted that the Sámi language embraces a number of dialects. ‘Sápmi’ is the North Sámi word for this area. In South Sámi it is called ‘Saepmie’, while in Lule Sámi it is called ‘Sábme’ Other Sámi dialects include further versions of the word. Monica Grini, *Samisk kunst i norsk kunsthistorie: Historiografiske riss*, PhD Thesis June 2016, page 13, footnote 13. Below, this work will refer to a number of terms in the Sámi language. Doing so, it will consequently use the north Sámi dialect. Other Sámi dialects may often have variations of the words used.

⁷⁸ Report of the Special Rapporteur on the right of indigenous peoples, James Anaya, Addendum: The situation of the Sami people in the Sápmi region of Norway, Sweden and Finland, 6 June 2011, A/HRC/18/35/Add.2, page 4.

⁷⁹ Mattias Åhrén, ‘Indigenous Peoples’ Culture, Customs, and Traditions and Customary Law – The Saami People’s Perspective’ (2004) 21(1) *Arizona Journal of International & Comparative Law* 63, 65 (‘*Indigenous Peoples’ Culture*’); see also Report of the Special Rapporteur on the right of indigenous peoples, James Anaya, Addendum: The situation of the Sami people in the Sápmi region of Norway, Sweden and Finland, 6 June 2011, A/HRC/18/35/Add.2, page 4.; see also Report of the Special Rapporteur on the rights of indigenous peoples on the human rights situation of the Sami people in the Sápmi region of Norway, Sweden and Finland, 9 August 2016, A/HRC/33/42/Add.3, page 3

⁸⁰ Report of the Special Rapporteur on the right of indigenous peoples, James Anaya, Addendum: The situation of the Sami people in the Sápmi region of Norway, Sweden and Finland, 6 June 2011, A/HRC/18/35/Add.2, page 4.; see also Report of the Special Rapporteur on the rights of indigenous peoples on the human rights situation of the Sami people in the Sápmi region of Norway, Sweden and Finland, 9 August 2016, A/HRC/33/42/Add.3, page 3; and Åhrén, (n79) pg 65 *et seq.*

⁸¹ Åhrén, *Indigenous Peoples’ Culture* (n 79) pg 66.

⁸² Máret Hætta, Bjørn Aarseth, et al., *Håndbook i Duodji: samisk håndverk* (Forlaget Vett & Viten 2007) pg 13 *et seq.*; Åhrén, *Indigenous Peoples’ Culture* (n 79) pg 64.

took place in the past and continue today. 'Samerna i de nordiska länderna är en liten minoritet med en säregen kultur, som har djupa rotter i Nordens natur och historia.'⁸³

Much like other indigenous groups, given their oral tradition of passing knowledge, histories, and lore, within the Sámi there is a lack of written information pertaining to their early history of the Sámi.⁸⁴ As a consequence, there is for instance no manner in which it can be definitively identified when the Sámi arrived in Fenno-Scandinavia, nor for how long they have occupied Sápmi. However, it is clear that '[t]he Sami have the oldest languages and cultures of these countries, long pre-dating the present-day States...'.⁸⁵ Linguistic research also reveals that the Sámi were present in Scandinavia well before the year 800.⁸⁶

In the first written accounts of interactions between the Norsemen and other cultures, it was evidenced that the Norsemen were aware of the Sámi and that the latter population had occupied Sápmi well before the Norsemen began to move north into those territories.

Men etter Ottars merkvordige beretning til kong Alfred av England ca. 880 kan iallfall ikke på hans tid nordmenn ha vært bosatt ved Finnmarkens kyst og fjorder. Da han reiste østover fra sin gård, som jeg helst antar lå på Hillesøy på nordsiden av ytre Malangen, hadde han den hele tid på styrbord side det øde land hvor ingen andre bode enn <<finner>> med større eller mindre avstand innbyrdes, <<stycemælum>> som det heter på angelsaksisk. Hva Ottar meddelte kong Alfred om rein og reindrif er for øvrig den eldste beretning vi ha rom dette for samene karakteristiske erverv som kjennes fra européisk område. ... Hav Ottar videre meddelte om den skatt <<finnerne>> (altså samene) betalte vitner jo også om, at deres erverv i stor utstrekning var knyttet til havstrendene og fjellet.⁸⁷

⁸³ *Sámiid Dilít: Föredrag vid Den nordiska samekonferens – Jokkmokk 1953* (Merkur Boktrykkeri 1957) pg 11 ('*Sámiid Dilít*') ('The Sámi in the Nordic countries are a small minority with a special culture, which have deep roots in the Nordic nature and history.').

All translations in this work from Norwegian, Swedish, or Danish, to English are those of the author unless noted otherwise.

⁸⁴ Lennart Lundmark, *Så länge vi har marker – Samerna och staten under sexhundra år* (Prisma 1998) pg 13.

⁸⁵ *Special Rapporteur Report Add 2*, (n78) page 4; see also *Special Rapporteur Report Add 3*, (n79) page 3; and Åhrén, *Indigenous Peoples' Culture* (n 79) pg 65 et seq.

⁸⁶ *Sámiid Dilít* (n 83) pg 130 et seq.

⁸⁷ *Sámiid Dilít* (n 83) pgs 132-3; ('According to Ottar's remarkable account to King Alfred of England, at least, Norwegians may have lived at the Finnmark coast and fjords. As he traveled eastward from his farm, which I presume lay on Hillesøy on the north side of Malangen, he had all the time on the starboard side the desolate land where no one else lived than Finns with greater or lesser distance among

There is also mention of the Sámi in works written in the year 98 AD. According to Gunvor Guttorm, '[d]en som ofte blir betraktet som den første historikeren som skrev om samer, er romeren Tactius. I år 90 e.Kr. nevner han i sin bok Germania et folk som han kaller for fenn, og han skriver at disse menneskene gikk på trestykker og bar skinnklær.'⁸⁸ In sum, one can safely assume that the Sámi were the first inhabitants of their traditional territories, including in Norway.

Though commonly characterised by reindeer herding, the Sámi were also known for their unique products, clothing, and aesthetic. There is good evidence that even in the middle ages the Sámi were connected to larger trade networks and were well known outside of the local area. 'Etter det arkeologiske materialet å dømme hadde samene bred kontakt med handelsmenn over hele Nordvest-Europa på 1000-1200-tallet. Samene hadde attraktive handelsvarer, både pelsverk og husflidsvarer.'⁸⁹

Today the Sámi population is estimated to be between seventy and one-hundred thousand people in total. The majority of these live in Norway, with an estimate of between forty and sixty thousand people.⁹⁰ Though the Sámi are one people, there are

themselves, <<Stycemælum>> as it is called in Anglo-Saxon. What Ottar told King Alfred about reindeer husbandry is by far the oldest story we have in space for the Sami characteristics which separates them from Europeans area. ... Havar Ottar further informed of the tax <Finns> (ie Sami) paid witnesses also that their acquisition was largely linked to the oceans and mountains.') (Ottar was a powerful Norwegian Chieftain of the time). See also, Gunvor Guttorm, 'Den Samiske Drakten i Historiens Løp' in *Norsk Bunadleksikon: Alle bunader og samiske folkedrakter* (Cappelen Damm 2013), pg 889.

⁸⁸ Gunvor Guttorm, 'Den Samiske Drakten i Historiens Løp' in *Norsk Bunadleksikon: Alle bunader og samiske folkedrakter* (Cappelen Damm 2013), pg 890. ('the one who is often regarded as the first historian who wrote about the Sami is Roman Tactius. In 90 AC he mentions in his book Germania a people whom he calls 'fenn', and he writes that these people went on wooden pieces and carried leather clothes.')

⁸⁹ Hætta (n 82) pg 44 ('According to the determinations of the archaeological material, the Sami had wide contact with traders throughout Northwest Europe in the 1000-1200s. The Sami had attractive trading goods, both furs and household goods.')

⁹⁰ *Special Rapporteur Report Add 2* (n 78) page 4; *Special Rapporteur Report Add 3* (n 79) page 4; also Lennart Lundmark (n 84) pg 11 – with an earlier estimate of sixty thousand total of which thirty-five thousand lived in Norway; Tove Irene Slaastad, *Samisk Statistikk 2016*, Statistisk sentralbyrå Rapport 2022/5; Guttorm (n 88) pg 889.

regional, social, and family divisions within the society. This primarily arose from the nature of the traditional livelihood, geography, and language differences.⁹¹

Today the State borders of four countries cross Sápmi. As a consequence, the Sámi have become a transnational indigenous people. As a transnational people, the Sami ... face a different legal situation in each state,⁹² and for practicality purposes, it is therefore necessary to focus upon the legal system in only one of those state jurisdictions when considering Sámi examples. In this work that will primarily be the Norwegian legal regime. However, the applicability of the trademark principles explored as relating to Norway extend to most of the Nordic countries due to coordination amongst primarily Denmark, Sweden, Finland, and Norway in their trademark lawmaking.⁹³ Consequently, it can be assumed that the conclusions this work draws with regard to the extent the trademark regime extends protections to Sámi intangible resources apply in large part to the Sámi in Finland and Sweden, and, to a lesser degree, to those situated on the Kola Peninsula.

1.4.4. The Tlingit people

In the United States there are currently five hundred seventy-four Federally recognised tribal entities, in addition to a number of tribal entities recognised on the state level.⁹⁴ This work will, however, only directly deal with the Tlingit people when considering indigenous intangible properties examples in the United States. That said, it should be noted that, similar to the expanded application that an evaluation of Norwegian law can have in other Nordic countries, the principles of such an enquiry will have relevance

⁹¹ It should be noted here that a number of Sámi languages are under serious threat and are considered highly endangered.

⁹² Christina Allard and Susann Funderud Skogvang (eds), *Indigenous Rights in Scandinavia: Autonomous Sami Law* (Ashgate 2015) pg 5.

⁹³ NOU 2001:8 (n 16) pg 9 - 'Kjennetegnretten ble tidlig emne for nordisk lovsamarbeid. Allerede i 1881 ble det oppnevnt komisjoner i Danmark, Norge og Sverige med det oppdrag å utarbeide forslag til <<Love angaaende Handelsfirma og Prokura samt angaaende Beskyttelse for Varemærker, saa vidt muligt overensstemmende med de Lovforslag om de samme Æmner, som samtidigt maatte blive udarbejdede af Kommissionerne i de 2 andre Lande>>'. ('The law of distinguishing marks became an early topic for Nordic law cooperation. Already in 1881 appointments in Denmark, Norway and Sweden were commissioned to draw up proposals for <<Law regarding Trade Firm and Prokura together with the Protection for Trademarks, as far as possible with the Bills on the same ideas that should be prepared at the same time Of the Commissions of the other 2 countries.').

⁹⁴ Department of Interior Bureau of Indian Affairs, 'Indian Entities Recognized and Eligible To Receive Services From the United States Bureau of Indian Affairs' (2021) 86 FR 7554.

throughout the United States and be applicable to any indigenous groups within its borders.

The Tlingit people are an indigenous group situated on the Pacific Northwest Coast of North America. There are a number of indigenous groups that occupy the Northwest Coast. The main constituent cultures are, however, from north to south, Eyak, Tlingit, Haida, Tsimshian, Haisla, Haihais, Heiltsuk, Nuxalk, Coast Salish, Nuuchah-nulth, Makah, Quileute/Chemakum, Chinookans, Takelma, Alsean, Siuslaw, Coos, and Athapaskans.⁹⁵ In addition, the Northwest Coast stands apart as a distinct cultural region, due to hosting a number of widely recognized, shared cultural traits.⁹⁶

Within this larger local context, the Tlingit occupy the southeast coast of the US State of Alaska 'from Cape Fox, on Alaska's southern border with British Columbia, to Katalla in the Gulf of Alaska,'⁹⁷ an area generally known as the panhandle of Alaska. The United States Court of Claims described the Tlingit as –

a homogeneous and interrelated group of Indians speaking a single language different from that of their neighbors; ... a nonagricultural people who were noted primarily for their use of marine products and wood; that their social structure emphasized formalistic family groups or clans, each clan having rights, respected by other clans, to the use of particular land and water areas of economic importance such as ocean waterfronts, bays, rivers, streams, or inland hunting areas; that the clans were acutely aware of their identity as Tlingit Indians in general and as members of households and clans in particular; that they had no central political body to govern the entire Tlingit people, although collectively they occupied a contiguous stretch of coast on the mainland and adjoining islands and were closely unified by common customs, language, family ties, trade, ceremonials, and a consciousness of their oneness as a homogeneous group.⁹⁸

It is estimated that the Tlingit numbered around ten thousand people prior to contact by Europeans. This number decreased to less than 4,000 in 1920 and by 1985 recovered

⁹⁵ Peter H Stephenson and Steven Acheson, 'The Northwest Coast' in Carol Ember and Melvin Ember (eds), *Encyclopedia of Medical Anthropology Volume II: Cultures* (Kluwer 2004) pg 890

⁹⁶ *Id.* pg 891.

⁹⁷ Thomas F Thornton, 'Know Your Place: The Organization of Tlingit Geographic Knowledge' (1997) 36(4) *Ethnology* 295, 296.

⁹⁸ *Tlingit and Haida Indians of Alaska v US*, 177 FSupp 452, 454 (United States Court of Claims 1959).

to nearly 10,000.⁹⁹ The regional corporation that services the Tlingit, Haida, and Tshimshian people, established under to the Alaska Native Claims Settlement Act,¹⁰⁰ had 15,782 original shareholders and currently has more than twenty-two thousand shareholders.¹⁰¹

The Tlingit subsisted by hunting both on the land and of sea mammals, trapping, fishing, foraging, and making extensive use of the natural resources of their land,¹⁰² including the extraction and use of copper.¹⁰³ Primarily the lifestyle of the Tlingit revolved around the sea with the annual social cycle being connected to the seasonal changes of the wildlife, including the salmon run, herring spawn, and other animal movements.¹⁰⁴

The Tlingit, along with the other indigenous peoples on in Southeast Alaska, have surely occupied and used their land from time immemorial.¹⁰⁵ Yet, the first recorded contact between Tlingits and Europeans dates from 1741, when the Russian explorer Alexei Chirikov made contact with the group in what seems to have been a brief hostile encounter.¹⁰⁶ From that first encounter, contact between Europeans and the Tlingit

⁹⁹ Frederica de Laguna, 'Tlingit', in Wayne Suttles (ed), *Handbook of North American Indians: Northwest Coast – Vol 7* (Smithsonian 1990) pg 226.

¹⁰⁰ 14 USC 1601 *et seq.* It is outside of the scope of this work to attempt a full explanation of the institutional structure of the native people in the United States. Suffice it to say that the Alaskan Native peoples are unique within the native rights schemes in the United States as they are organised into corporations instead of reservation structures.

¹⁰¹ <http://www.sealaska.com/why-we-do-it/our-shareholders>

¹⁰² *Tlingit and Haida* (n98) 177 FSupp at 457; *de Laguna*, (n99) pg 226; George Thornton Emmons (Frederica de Laguna – ed), *The Tlingit Indians* (University of Washington Press 1991) pg 175.

¹⁰³ see generally Emmons (n102) chapters 1, 5, and 6.

¹⁰⁴ Emmons (n 102) pg 102.

¹⁰⁵ *Tlingit and Haida* (n 98) 177 FSupp at 457.

¹⁰⁶ de Laguna (n 99) pg 223; Aurel Krause, *The Tlingit Indians: Observations of an indigenous people of Southeast Alaska 1881-1882* (translated by Erna Gunther) (Epicenter Press, 1956/2013, originally published 1885 in German) pg 27-28; Caskey Russell, 'Cultures in Collision: Cosmology, Jurisprudence, and Religion in Tlingit Territory' (Spring 2009) 33(2) *American Indian Quarterly* 230, 232. In regard to this encounter it should be noted that there is a difference in the account as between the Russian and Tlingit histories. Caskey Russell notes 'The Tlingit account is quite different. Mark Jacobs, Jr., a Tlingit elder, recounted the Tlingit version during a conference on the Russian impact in Alaska: These eight men did not return to their ship. They took this opportunity to escape the cruel and harsh conditions on the Russian ship. As they left the ship, they decided among themselves that they would eventually perish in the hazardous waters of the North Pacific. Why suffer under such a cruel command until then? The decision to desert was easy ... They eventually made contact with some local natives and were accepted and treated with respect, instead of being murdered as the Russian history tells it.' It is quite probable that Russian perceptions of Indians gave birth to their hypothetical accounts. The Tlingit account comes from relatively recent oral history based on actual contact with the sailors. – at

increased, including attempts by Russia to colonise the area – to questionable effect.¹⁰⁷

The Tlingit were also known as consummate traders and were recorded as traveling as far south as modern day Victoria Canada by the 1850's.¹⁰⁸ Furthermore, the United States Court of Claims has recognised that the Tlingit and Haida carried on extensive trade not only with each other but with neighboring tribes and later with the Russians and the Americans.¹⁰⁹ George Emmons even described the Tlingit as born traders.¹¹⁰

We will return to both of these groups throughout this work, and in particular in Part 6, where the specific product traditions of both the Sámi and Tlingit are presented. With this general background of the indigenous context, the state of scholarship in the area of intellectual property and trademarks as applied within that context, and the necessity for a fundamental trademark approach to this enquiry, we will proceed with substantive presentation of analysis of the issues to ultimately understand –

To what extent are unregistered trademark protections in modern systems applicable to the protection of indigenous intangible resources?

232; see also Andrei V Grinëv (Richard L Bland trans.), 'Reflections on the Fate of Alexei Chrikov's Missing Men' (2005) 42(2) Arctic Anthropology 1-8.

¹⁰⁷ see Caskey Russell, 'Cultures in Collision: Cosmology, Jurisprudence, and Religion in Tlingit Territory' (2009) 33(2) American Indian Quarterly 230, 232.

¹⁰⁸ de Laguna (n 99) pg 223.

¹⁰⁹ *Tlingit and Haida* (n 98) 177 FSupp at 454.

¹¹⁰ Emmons (n 102) pg 53.

2. Intellectual Property within the Indigenous Rights Context

2.1. Introduction

In this Part we will more thoroughly and critically examine the indigenous rights context of intellectual property. It is within this background of developing indigenous rights and its intersection with intellectual property, and in particular trademarks, that many competing interests are found and the concerns raised in Part 1 have developed. Thus, to understand the place that unregistered trademark protection has within this world, it is necessary to articulate an understanding of indigenous rights generally and the path that they have taken. Certain specific linguistic concerns and sensitivities of conducting research, legal or academic work, or even rule making within the indigenous rights space will also be raised and articulated in section 2.6.

2.2. Indigenous rights development

The Peace of Westphalia is generally agreed as the birth of the modern system of States.¹¹¹ It was at this point that borders were drawn and established between States and the concepts generally applicable to the modern state system of international law were enshrined, most notably the concept of state sovereignty. The elevation of the State as the basic unit of polity in the international order also legitimated it as the principal valid actor on the world stage. Critically, States were the only entities that could create and apply international law.¹¹²

The borders of States were drawn according to the whim of the sovereign with little regard for the cultural, ethnic, or linguistic realities of the people within these new State boundaries. 'Statehood developed as a reference to the post-Westphalian political community and attendant bureaucracy, whose dominant organizing characteristic was territory.'¹¹³ This autonomous and sovereign nature of the State, and other developments and justifications, set the stage for the treatment of indigenous peoples.

¹¹¹ S. James Anaya, *Indigenous Peoples in International Law* (Oxford University Press, 2nd Edition 2004), pg 19-23; Mattias Åhrén, *Indigenous Peoples' Status in the International Legal System* (Oxford University Press, 2016) ('*Indigenous Peoples' Status*'), pg 10-19; generally, Martti Koskenniemi, *From Apology to Utopia: The structure of International legal argument* (Cambridge University Press, 2005).

¹¹² See generally, Åhrén, *Indigenous Peoples' Status* (n 111) pg 7-37.

¹¹³ Anaya (n 111) pg 21.

They were no longer an entity unto their own, but rather were now within a superior political body that was built upon the assumption that all within its borders were one and the same – the aggregate population within those borders was the people. Essentially the concept of the nation-state.¹¹⁴

During the era of colonisation the European states exported the post-Westphalian state system throughout the globe until the map of the world was no longer geographically, culturally, or socially concerned, but was rather overlain with a network of arbitrary lines based on territory. Upon one side of the line the supreme authority of one colonizing state and upon the other side of that line another.

The treatment of indigenous peoples during this time is a sordid history motivated by concepts such as nationalism, integrationism, cultural and social Darwinism, and is much too complex to do justice in this work. It is also a topic that has been thoroughly explored in other sources.¹¹⁵ For a well researched and enlightening work regarding the experiences of one particular indigenous people, and as an example of the treatment of indigenous peoples generally, it is helpful to point to *Indigenous Peoples' Culture, Customs and Traditions and Customary Law – the Saami People's Perspective*.¹¹⁶

It was this State-centric mindset that set the scene in which the rights of indigenous peoples historically played out, and still do, and indeed to some extent has defined the nature of indigeneity. While historically indigenous peoples were considered essentially without rights, the discussion of indigenous rights has more recently revolved most particularly around the issues that relate directly to these arbitrary lines and the impact that they have on indigenous groups. Specifically, rights to land, language, education, self-determination, and non-discrimination have been central to the indigenous rights

¹¹⁴ Åhrén, *Indigenous Peoples' Status* (n 111) – 'In sum, the theory of justice that took form in Europe in the wake of the Peace of Westphalia, and that would become entrenched during the following centuries, not only rests on the idea that state pre-date the law and that the aggregate populations of states constitute 'peoples'; it presupposes it.' at pg 13.

¹¹⁵ Åhrén, *Indigenous Peoples' Status* (n 111); Stuart Banner, *How the Indians Lost Their Land: Law and Power on the Frontier* (Harvard University Press 2005); Walter R Echo-Hawk, *In the Courts of the Conqueror: the 10 Worst Indian Law Cases Ever Decided* (Fulcrum 2010).

¹¹⁶ Åhrén, *Indigenous Peoples' Culture* (n 79).

discourse.¹¹⁷ However, the path to the concept and discussion of indigenous rights proper was not direct.

In the early 1900s the world began to see a collapse of the colonialist notion. An age of de-colonialism began and with it a movement concerned with the protection of minority rights.¹¹⁸ Post-World War Two the minority protections, earlier touched upon by the international community, evolved into a broader 'human rights' initiative.¹¹⁹ It was in this post-World War Two era that important human rights protections were enshrined in instruments such as the United Nations Charter¹²⁰ and the Universal Declaration of Human Rights.¹²¹ The decades after the establishment of the United Nations saw marked development of the human rights principles. In the 1960s the two primary international human rights instruments were created – the International Covenant on Civil and Political Rights¹²² ('CCPR') and the International Covenant on Economic, Social, and Cultural Rights¹²³ ('CESCR'). Additional similar instruments were enacted at that time such as the International Convention on the Elimination of All Forms of Racial Discrimination.¹²⁴

The value of these documents and the international community's concern for the protection of human rights is indisputable. However, this system perpetuated an idea of the nation-state modified only to secure certain rights to individuals as individuals. In essence they were not designed to address the concerns of indigenous peoples. The prevailing practice at the time was to view indigenous peoples as merely some species

¹¹⁷ See generally, *Cohen's Handbook* (n 36) §1.07.

¹¹⁸ Åhrén, *Indigenous Peoples' Status* (n 111) pg 21 *et seq.*

¹¹⁹ Josef Kunz, 'The Present Status of the International Law for the Protection of Minorities' (1954) 48(2) *American Journal of International Law* 282.

¹²⁰ United Nations, Charter of the United Nations, 24 October 1945, 1 UNTS XVI.

¹²¹ Universal Declaration of Human Rights, Adopted by the United Nations General Assembly Resolution 217A(III) of 10 December 1948.

¹²² UN General Assembly, International Covenant on Civil and Political Rights, 16 December 1966, 999 UNTS 171.

¹²³ UN General Assembly, International Covenant on Economic, Social and Cultural Rights, 16 December 1966, 993 UNTS 3.

¹²⁴ UN General Assembly, International Convention on the Elimination of All Forms of Racial Discrimination, 21 December 1965, 660 UNTS 195.

of minority¹²⁵ and it was assumed that indigenous peoples could find protection through the existing, or developing, protections for minorities and human rights.¹²⁶

Though there were consistent efforts by indigenous groups to assert their rights both at the domestic¹²⁷ and international level,¹²⁸ it was only around the 1980s that indigenous rights discourse began to be its own distinct topic of discussion in international bodies. The establishment of an indigenous rights discourse at the international level was truly solidified with the creation of the Working Group on Indigenous Peoples in 1982, which led directly to the drafting and subsequent adoption in 2007 of the primary international instrument concerning indigenous rights – the United Nations Declaration on the Rights of Indigenous Peoples ('UNDRIP').¹²⁹

In this modern indigenous rights era we see protections for indigenous groups through not only the minority and general human rights structures, but also through indigenous specific instruments or indigenous specific provisions within instruments. Prominent examples that are cited in the indigenous rights works are the Convention on Biological Diversity ('CBD')¹³⁰ and its accompanying Protocol on Access to Genetic Resources and the Fair and Equitable Sharing of Benefits Arising from their Utilization,¹³¹ the International Labour Organization's Indigenous and Tribal Peoples Convention, 1989 (No. 169)¹³² known as 'ILO 169', and, of course, the mentioned UNDRIP.

This is an obvious oversimplification of the history, genesis, and development of indigenous rights and their place within the international and domestic legal and social

¹²⁵ Augusto Willemsen Diaz, 'How Indigenous Peoples' Rights Reached the UN', in Claire Charters and Rodolfo Stavenhagen (eds), *Making the Declaration Work: The United Nations Declaration on the Rights of Indigenous Peoples* (International Work Group for Indigenous Affairs, 2009), pg 23.

¹²⁶ *Id.* pg 17.

¹²⁷ *Sámiid Dilit* (n 83); Stephen L Pevar, *The Rights of Indians and Tribes* (Oxford University Press 2012).

¹²⁸ Drahos, *Intellectual Property* (n 12) 72-76.

¹²⁹ UN General Assembly, United Nations Declaration on the Rights of Indigenous Peoples, GA Res 61/295, A/RES/61/295 (13 September 2007).

¹³⁰ 5 June 1992, 1760 UNTS 79 (entered into force 29 December 1993).

¹³¹ Nagoya Protocol on Access to Genetic Resources and the Fair and Equitable Sharing of Benefits Arising from their Utilization to the Convention on Biological Diversity, 29 October 2010, 3008 UNTS 3 (entered into force 12 October 2014).

¹³² adopted 27 June 1989, entered into force 5 September 1991.

realm. However, it provides sufficient background for this work, as here the focus is not on indigenous rights instruments or even their content, but rather upon the use of a specific mechanism in intellectual property to secure the intangible resources rights of indigenous peoples. Furthermore, there are many other valuable resources to which one can turn for a comprehensive history of indigenous rights discourse.¹³³

2.3. Indigenous rights and intangible resources

The intangible resource protection needs of indigenous peoples began to be addressed, in a manner, in the post-World War Two time frame. During this era, as outlined above, there was an increase in the desire to enshrine basic human rights into a codified system. This was combined with a movement of deconlonisation and self-determination for the colonies that then transformed into States. Contemporaneous with the general developments in human rights and decolonization, indeed only a year after the CESC, and CCPR, the first tentative steps were made to address the protection of traditional intangible resources.¹³⁴

At the Intellectual Property Conference of Stockholm in 1967 the protection of what was termed ‘folklore’ was discussed with relation to the Berne Convention¹³⁵ and copyright protection. Prior to the 1967 Conference the discussion of folklore had been taken up by individual states, such as Tunisia’s 1966 Copyright Law,¹³⁶ as well as at the East Asian Seminar on Copyright in 1967. However, there was a desire, especially from developing countries, that specific protection of folklore be included in the Berne Convention.¹³⁷

¹³³ Claire Charters and Rodolfo Stavenhagen (eds), *Making the Declaration Work: The United Nations Declaration on the Rights of Indigenous Peoples* (International Work Group for Indigenous Affairs, 2009); Anaya (n 111) pg 19-23; Åhrén, *Indigenous Peoples’ Status* (n 111) pg 10-19; generally, Koskeniemi (n 111); Allard and Skogvang (n 92).

¹³⁴ ‘Traditional intangible resources’ is used here because the early protection efforts were not addressed to the concerns of indigenous peoples, as such.

¹³⁵ Berne Convention for the Protection of Literary and Artistic Works (1886) (TRT/BERNE/009), 828 UNTS 107. The Berne Convention is one of the primary international instruments on substantive intellectual property law specifically copyright law.

¹³⁶ Records of the Intellectual Property Conference of Stockholm June 11 to July 14, 1967, (WIPO: Geneva, 1971) Vol II, pg 876. Available at <https://tind.wipo.int/record/28763?v=pdf> (last accessed 19 June 2024).

¹³⁷ Id., 876.

These first steps were still substantially rooted in a Westphalian – State centric – view of rights. This is best exhibited by Israel’s observations on the draft Stockholm document S/1. Israel’s representative stated that:

A serious omission in the Convention and Protocol is the absence of any provision dealing with folklore as such. The protection of folklore at an international level is a matter of importance to the developing countries which are probably nowadays its major source. ... It appears to the Government of Israel most desirable ... *that those States from which folklore emanates shall over a given period derive some benefit from its publication. Folklore must not be treated as being in the public domain, but the rights therein must belong to the States aforesaid.*¹³⁸

As can be seen by the observation of Israel, and the further discussion during the Stockholm Conference, protection for traditional intangible properties was couched in the concept of national folklore during this early period. It was not necessarily concerned with peoples or indigenous peoples, but rather the national interest in folklore. The focus of these efforts was on developing post-colonial countries, not indigenous peoples, with rights and supervision vested in the States.¹³⁹

Ultimately, at the Stockholm Conference, it was determined that works of folklore were covered and could be protected as works of unknown or anonymous authors.¹⁴⁰ However, this approach had little effect¹⁴¹ and the development of protections for traditional intangible resources continued to progress after the Stockholm Conference, both at a national and international level. In the late 1970s the World Intellectual Property Organisation (‘WIPO’) created a draft ‘of *sui generis* model provisions for intellectual-property-type protection of folklore against certain unauthorized uses and against distortion’.¹⁴² In the early 1980s WIPO and the United Nations Educational, Scientific and Cultural Organisation (‘UNESCO’) began collaboration which ultimately led to the Model Provisions for National Laws on the Protection of Expressions of Folklore

¹³⁸ Records of the Intellectual Property Conference of Stockholm June 11 to July 14, 1967, (WIPO: Geneva, 1971) Vol I, pg 685. Available at <https://tind.wipo.int/record/28766?ln=en&v=pdf> (last accessed 19 June 2024).

¹³⁹ See *Stockholm Vol II* (n 136) pgs 913-918.

¹⁴⁰ *Id.*, pg 1199.

¹⁴¹ *Zografos* (n 54) pg 14.

¹⁴² *1967, 1982, 1984* (n 27).

Against Illicit Exploitation and Other Prejudicial Actions.¹⁴³ During this time there was a proliferation of attempts to protect folklore in national copyright laws, particularly in developing countries.¹⁴⁴

Parallel to these intellectual property like protection efforts, the protection of ‘cultural properties’ began to develop particularly through UNESCO instruments. The cultural property instruments do not rely on an intellectual property justification for protection, thus they will not be dealt with in this work.¹⁴⁵ However, it is useful to keep in mind that ‘cultural property’ protections affected such things as the trade in antiquities, protection of culturally significant works in times of war, and the ‘world heritage’ system.¹⁴⁶

It was not until the late 1990s and early 2000s, with the work of WIPO and the establishment of the WIPO Intergovernmental Committee on Intellectual Property and Genetic Resources, Traditional Knowledge and Folklore (the ‘IGC’), that the protection of traditional intangible resources was viewed in a broader intellectual property context. With the establishment of the IGC the discussion moved from one based on folklore and copyright protection – most notably through the Berne Convention – to an evaluation of all areas of intellectual property. This was motivated not only by the needs that had been uncovered through fact finding missions, but also due to contemporary issues that

¹⁴³ Model Provisions for National Laws on the Protection of Expressions of Folklore Against Illicit Exploitations and Other Prejudicial Actions 1985, available at <http://www.wipo.int/edocs/lexdocs/laws/en/unesco/unesco001en.pdf> (last accessed 19 June 2024)

¹⁴⁴ 1967, 1982, 1984 (n 27) pg 2.

¹⁴⁵ For a review of the intangible cultural property protections see – Toshiyuki Kono (ed), *Intangible Cultural Heritage and Intellectual Property: Communities, Cultural Diversity and Sustainable Development* (Intersentia, 2009); Fiona Macmillan, ‘Human rights, cultural property and intellectual property: three concepts in search of a relationship’ in Christoph Beat Graber and Mira Burri-Nenova (eds), *Intellectual Property and Traditional Cultural Expressions in a Digital Environment* (Edward Elgar 2008) pg 73 *et seq.*

¹⁴⁶ Convention Concerning the Protection of World Cultural and Natural Heritage, UNESCO, 16 November 1972, 1037 UNTS 151; Convention on the Means of Prohibiting and Preventing the Illicit Import, Export and Transfer of Ownership of Cultural Property, UNESCO, 14 November 1970, 823 UNTS 231; Convention on the Protection of Cultural Property in the Event of Armed Conflict, UNESCO, 14 May 1954, 249 UNTS 215; and more recently – Convention for the Safeguarding of the Intangible Cultural Heritage, UNESCO, 17 October 2003, 2368 UNTS 3; and Convention on the Protection and Promotion of the Diversity of Cultural Expressions, UNESCO, 20 October 2005, 2440 UNTS 311.

had arisen in the intellectual property world itself, specifically within the realm of technology and patent protection.¹⁴⁷

The broader approach also expanded, or possibly refined, the scope of interested and affected parties. At the outset of the intellectual property concern for traditional intangible resources the discussion centered around developing states and ‘folklore’ because it arose out of a context and environment of decolonization. With the development of a discourse specific to the needs of indigenous populations, unconnected to minorities or developing states or ‘poor-people’,¹⁴⁸ a clearer concept of traditional intangible resources was employed which took in the understanding of indigenous peoples as distinct with their own cultural traditions, resources, and needs.¹⁴⁹ Thus the intellectual property protection efforts post-IGC establishment began a new era of more nuanced protection discussions. A more detailed discussion of the IGC efforts will occur below in section 2.4.

2.3.1. Specific attempts at addressing indigenous needs

As mentioned, the development of the indigenous rights discourse and the protection of indigenous intangible resources thus essentially developed in a three-tract manner. The first arose from the post-World War Two human rights instruments and their progeny. These instruments were founded upon concepts that were centered around the individual and were developed in a decolonisation environment. The second tract developed along the lines of cultural heritage and cultural property protections. These mostly concerned themselves with physical manifestations of culture¹⁵⁰ and were, for

¹⁴⁷ See, WIPO Background Brief - No. 2 (2016) (*Background Brief*) pg 2, available at <https://tind.wipo.int/record/28829?v=pdf> (last accessed 19 June 2024).

¹⁴⁸ Here the phrase ‘poor-people’ is used not in any disrespectful manner, but rather to show a focus that has been on developing countries, third world countries, underprivileged populations, and indeed ‘poor people’; see J. Michael Finger and Philip Schuler (eds), *Poor People’s Knowledge: Promoting Intellectual property in developing countries* (World Bank and Oxford University Press, 2004); Madhavi Sunder, *From Goods to a Good Life; Intellectual Property and Global Justice* (Yale University Press 2012); Inclusive Tourism: linking the handicraft sector to tourism markets, International Trade Centre, technical paper 2010, Doc No. SC-10r-182.E (*Inclusive Tourism*), pg 1.

¹⁴⁹ This has somewhat been blunted by the relatively recent inclusion of ‘traditional communities’ on the same level as indigenous peoples into the IGC discussions

¹⁵⁰ Until the relatively recent Convention for the Safeguarding of the Intangible Cultural Heritage 2003 (n 146).

the most part, stewarded by UNESCO. The third line of development began to deal specifically with intellectual property issues.

From these three related, but certainly separate, families of protection it can be seen that a comprehensive and understandable system was lacking. Perhaps to address the fact that no comprehensive system was in place for the protection of indigenous intangible resources, or perhaps in attempts to try and implement what protections were percolating out of the international system, or maybe to address specific concerns within their own borders, there became a patchwork of various targeted domestic laws.

It is outside the scope of this work to attempt to catalogue all of the domestic legislation concerning the protection of indigenous intangible resources, however a few examples are of note. Although the domestic instruments that address intangible resources are of specific interest, it is also of interest to briefly reference indigenous people specific efforts as well.

In Panama, Law No. 20 of June 26, 2000, on Special System for the Collective Intellectual Property Rights of Indigenous Peoples for the Protection and Defense of their Cultural Identity and their Traditional Knowledge, was one of the first instruments to not only specifically address the intellectual property rights of indigenous people but to also enshrine in the law collective ownership of those intellectual property rights.

Article 1 of that law states that:

The purpose of this Act is to protect the collective intellectual property rights and traditional knowledge of indigenous peoples in their creations, such as inventions, models, drawings and designs, innovations contained in the images, figures, symbols, graphics, stone carvings and other details; as well as the cultural elements of their history, music, art and traditional forms of artistic expression suitable for commercial use, via a special system to register, promote and market their rights, in order to highlight the social and cultural values of indigenous cultures and guarantee social justice for them.¹⁵¹

¹⁵¹ Available at <https://www.wipo.int/wipolex/en/text/177308> (last accessed 22 April 2024)

The law has provisions specifically relating to traditional dress – Article 3; instruments, music, dance, and performances – Article 4; prohibition on the importation of non-original products that imitate indigenous products – Article 17-19; as well as separate sanctions directly under the Act – Article 21; and provisions for the government support of promotion and development – Articles 10-14.¹⁵²

In New Zealand, in addition to other instruments specifically addressed toward the Maori people, an advisory committee was established according to sections 177-180 of the Trade Marks Act 2002,¹⁵³ to review trademark applications that include Maori signs and elements. The Committee 'is to advise the Commissioner [of trade marks] whether the proposed use or registration of a trade mark that is, or appears to be, derivative of a Maori sign, including text and imagery, is, or is likely to be, offensive to Maori.'¹⁵⁴ Though the decision of the Committee is only advisory, the New Zealand approach of active involvement of their indigenous people in the approval of trademark applications has been resoundingly praised by commentators.¹⁵⁵

In Norway there is no instrument that specifically addresses the intangible resource rights of indigenous peoples in an intellectual property sense. However, in 1987 Norway enacted a 'Lov om Sametinget og andre samiske rettsforhold (sameloven)'.¹⁵⁶ This law was specifically drafted to address certain issues specific to the Sámi people. Among other things, such as establishing the Sámi Parliament, the law implements protection of the Sámi language¹⁵⁷ and the Sámi flag.¹⁵⁸ Furthermore, the constitution of Norway was amended to include what is now section 108 which states:

¹⁵² The Panama Law must also be read together with the Executive Decree implementing it - Executive Decree No 12 of March 20, 2001 regulating Law No. 20 of June 26, 2000 on the Special Intellectual Property Regime governing the Collective Rights of Indigenous Peoples for the Protection and Defense of their Cultural Identity and their Traditional Knowledge, and enacting other provisions.

¹⁵³ available at <http://www.legislation.govt.nz/act/public/2002/0049/latest/DLM164240.html> (last accessed 30 July 2017).

¹⁵⁴ Trade Mark Act (NZ) 2002, s178.

¹⁵⁵ Zografos (n 54); Terri Janke, *Minding Culture: Case Studies on Intellectual Property and Traditional Cultural Expressions* (WIPO 2003).

¹⁵⁶ Lov 12 juni 1987 nr. 56 om Sametinget og andre samiske rettsforhold (sameloven) - 'Law on the Sami Parliament and other Sámi rights (the Sámi Law)'.

¹⁵⁷ §1-5 and Chapter 3 (§3-1 – 3-12) added in 1990.

¹⁵⁸ §1-6 added in 2003. It should be noted here that the Sámi flag is a modern creation adopted by the Sámi Conference of 1986. Many would consider it to fall outside of the definition of a traditional

Det påligger statens myndigheter å legge forholdene til rette for at den samiske folkegruppe kan sikre og utvikle sitt språk, sin kultur og sin samfunnsliv.¹⁵⁹

Additionally, Norway implemented one of the most sweeping evaluations of indigenous rights to land co-management of natural resources in Finnmarkloven (the 'Finnmark Act').¹⁶⁰

In the United States, addressing the intangible resources issues relating to the Native American peoples began relatively early with the Indian Arts and Crafts Act ('IACA') of 1935.¹⁶¹ The 1935 IACA established the Indian Arts and Crafts Board and vested the Board with certain powers in order 'to promote the economic welfare of the Indian tribes and the Indian wards of the Government through the development of Indian arts and crafts and the expansion of the market for the products of Indian art and craftsmanship'.¹⁶² The Board was also given certain powers to create, essentially, a national certification trademark for Indian arts and crafts products.¹⁶³ IACA 1935 also made it an offense for a person to 'willfully offer or display for sale any goods ... as Indian products or Indian products of a particular Indian tribe or group ... when such person knows such goods are not Indian products'.¹⁶⁴

cultural expression. In any case it has become, and is, a definite cultural identifier of modern Sámi society.

¹⁵⁹ 'The authorities of the state shall create conditions enabling the Sami people, as an indigenous people, to preserve and develop its language, culture and way of life.' (Norwegian government translation available at <https://lovdata.no/dokument/NLE/lov/1814-05-17?q=grunnloven>; 'It is incumbent upon the state authorities to make arrangements for the Sámi people to secure and develop their language, culture, and social life.' (author translation).

¹⁶⁰ Lov 17 juni 2005 nr. 85 om rettsforhold og forvaltning av grunn og naturressurser i Finnmark fylke (finnmarksloven); see Susann Funderud Skogvang, *Samerett* (Universitetsforlaget, 2nd ed 2009) ('*Samerett*'), pg 235 *et seq.*; Øyvind Ravna, *Finnmarksloven – og retten til jorden i Finnmark*, (Gyldendal Juridisk 2013); 'Finnmarksloven' can be translated into English as the Finnmark Law or Act. Finnmark is the northernmost region of Norway and finnmarksloven is drafted for application only within its boundaries. Thus even though finnmarksloven made sweeping changes it by no means addressed the concerns of all indigenous people within Norway.

¹⁶¹ An Act to promote the development of Indian arts and crafts and to create a board to assist therein, and for other purposes, August 27, 1935 (S.2203 P.L. No. 355) ('IACA 1935').

¹⁶² *Id.*, section 2.

¹⁶³ *Id.*, sections 2 and 5.

¹⁶⁴ *Id.*, section 6.

Unfortunately, though there has been a recent surge cases,¹⁶⁵ the United States' IACA had little impact on securing the indigenous arts and crafts traditions in practice. It was not until 1998 that the first case was reported that based on a claim under IACA.¹⁶⁶ Notably, this was after sweeping changes were made to the Act in 1990¹⁶⁷ that allowed claims to be taken to court by entities other than the US Government. Further amendments were made to IACA in 2000¹⁶⁸ and 2010,¹⁶⁹ but the effectiveness of IACA as a protection of indigenous rights remains unclear.¹⁷⁰

This is by no means an exhaustive look at the specific attempts made to address the needs of indigenous peoples in the protection of intangible resources. However, it provides a few examples of how those attempts were made and in what form they manifested themselves. In the United States it was a piece of legislation with a very narrowed and focused application and essentially a negative protection – preventing others from doing something. In Panama the scope of protection was broader and the method was mainly by providing a positive protection. New Zealand took an approach that actively involved the indigenous peoples in administrative legal structures. Whereas Norway chose to integrate very broad aspirational principles into their national laws and constitution with no specific targeting of the protection of indigenous intangible resources.

¹⁶⁵ *US v Kowalis*, 5:21-cr-00145-XR (WD Tx 2021); *Navajo v Urban Outfitters*, Dist of NM (1:12-cv-195); *Ho-Chunk Nation, et al. v. Nature's Gift, Inc.*, 1999 WL 169319 (N.D.Ill. 1999); *Ho-Chunk Nation, et al. v. J.C. Penney Company, Inc.*, 1999 WL 495899 (N.D.Ill. 1999); *Ho-Chunk Nation, et al. v. J.C. Penney Company, Inc.*, 1999 WL 1068700 (N.D.Ill. 1999); *Sealaska Heritage Institute, et al. v. Neiman Marcus Group LTD, et al.*, 1:20-cv-00002-SLG (D. Ak. 2020); *US v Sippy*, 01:16-cr-00007 (D Ak 2016); *US v Gengler*, 01:16-cr-00006 (D Ak 2016); *US v Karim*, 01:16-cr-00005 (D Ak 2016); *US v Caradang*, 01:16-cr-00004 (D Ak 2016); *US v Rodrigo, et al.* 1:23-cr-00003-TMB-MMS (D Ak 2023); *US v Nael Ali*, 1:15-cr-03762-JCH (D NM 2015)

¹⁶⁶ *Native American Arts, Inc v Chico Arts, Inc*, 8 F.Supp.2d 1066 (N.D.Ill. 1998)

¹⁶⁷ Indian Arts and Crafts Act of 1990, PL 101-644, 104 Stat 4662.

¹⁶⁸ Indian Arts and Crafts Enforcement Act of 2000, PL 106-497, 114 Stat 2219.

¹⁶⁹ Indian Arts and Crafts Amendments Act of 2010, PL 111-211, 124 Stat 2258.

¹⁷⁰ William J Hapiuk, Jr., 'Of Kitsch and Kachinas: A Critical Analysis of the "Indian Arts and Crafts Act of 1990"' (2001) 53(4) *Stanford Law Review* 1009-1075; Gail K Sheffield, *The Arbitrary Indian: The Indian Arts and Crafts Act of 1990* (University of Oklahoma Press 1997).

These different approaches to securing the rights of indigenous peoples, especially in the area of intangible resources, exhibit that there remains no coordinated and generally accepted mechanism for protection on the national level.

2.4. World Intellectual Property Organisation Intergovernmental Committee

As touched upon earlier, in an effort to organise a generally accepted mechanism to protect indigenous intangible resources WIPO established the IGC in 2000.¹⁷¹ The IGC 'is a forum where WIPO member states discuss the intellectual property issues that arise in the context of access to genetic resources and benefit-sharing as well as the protection of traditional knowledge and traditional cultural expressions'.¹⁷² The IGC has been meeting periodically since its establishment and under its current mandate will:

...continue its work on the protection of genetic resources (GRs), traditional knowledge (TK) and traditional cultural expressions (TCEs), with the objective of finalizing an agreement on an international legal instrument(s), without prejudging the national outcome(s), relating to intellectual property, which will ensure the balanced and effective protection of TK and TCEs.¹⁷³

Ultimately the goal of the IGC is the production of international legal instruments regarding the protection of the three areas in the mandate, GRs, TK, and TCEs. Currently WIPO has produced draft documents in each of these areas¹⁷⁴ with one, relating to genetic resources and associated traditional knowledge, proceeding to adoption as a

¹⁷¹ This was done after extensive fact finding mission in the late 1990s, see *Janke* (n 155).

¹⁷² *Background Brief*, (n 147).

¹⁷³ WIPO Mandate, Assemblies of Members States of WIPO 64th session, July 6-14, 2023, Decision on Agenda Item 15(v) – Report on the Intergovernmental Committee on Intellectual Property and Genetic Resources, Traditional Knowledge and Folklore (IGC) DECISION. Available at <https://www.wipo.int/export/sites/www/tk/en/igc/docs/igc-mandate-2024-2025.pdf> (last accessed 21 Apr 2024).

¹⁷⁴ Text of a Draft International Legal Instrument Relating to Intellectual Property, Genetic Resources and Traditional Knowledge Associated with Genetic Resources (June 30, 2023), WIPO, WIPO/GRTKF/IC/SS/GE/23/2, available at https://www.wipo.int/edocs/mdocs/tk/en/wipo_grtkf_ic_ss_ge_23/wipo_grtkf_ic_ss_ge_23_2.pdf (last accessed 21 April 2024);

The Protection of Traditional Cultural Expressions: Draft Articles, Facilitators Rev. (June 7, 2023), WIPO, WIPO/CRTKF/IC/47/15 ANNEX, available at https://www.wipo.int/edocs/mdocs/tk/en/wipo_grtkf_ic_47/wipo_grtkf_ic_47_15.pdf (last accessed 21 April 2024);

The Protection of Traditional Knowledge: Draft Articles Facilitators' Rev. (Jun 7, 2023), WIPO, WIPO/GRTFK/IC/47/14 ANNEX, available at https://www.wipo.int/edocs/mdocs/tk/en/wipo_grtkf_ic_47/wipo_grtkf_ic_47_14.pdf (last accessed 21 April 2024).

treaty in 2024.¹⁷⁵ Since its first meeting in 2001, '[w]hat has followed is in its own quiet way a tribute to the philosophy of doing things slowly, in this case negotiating an agreement that might benefit indigenous peoples'.¹⁷⁶ Indeed, after nearly twenty-three years of work the drafts relating to traditional knowledge and traditional cultural expressions are riddled with alternatives, options, conditionals, and generally no consensus.¹⁷⁷ Even the recently adopted treaty on genetic resources and associated traditional knowledge avoids defining critical terms.¹⁷⁸ The complexities of the drafts is reflected in the IGC's Glossary of Key Terms¹⁷⁹ where many definitions are little more than a collection of various definitions from other sources, including other international instruments.

The IGC divides its efforts, as is stated in the Mandate, into three separate areas – Genetic Resources ('GRs'), Traditional Knowledge ('TK'), and Traditional Cultural Expressions¹⁸⁰ ('TCEs'). These areas roughly correspond to the general areas of intellectual property – those being patent, trademarks, and copyrights (and trade secrets in a quasi-intellectual property manner). In the most general sense GRs, TK, and TCEs are distinguished by the physical manifestations in which one finds them. GRs being the products of biology, TCEs being physical manifestations and expressions of a

¹⁷⁵ Diplomatic Conference to Conclude an International Legal Instrument Relating to Intellectual Property, Genetic Resources and Traditional Knowledge Associated with Genetic Resources (WIPO Geneva, 24 May 2024) GRATK/DC/7 available at https://www.wipo.int/edocs/mdocs/tk/en/gratk_dc/gratk_dc_7.pdf (last accessed 23 June 2024); 'WIPO Member States Adopt Historic New Treaty on Intellectual Property, Genetic Resources and Associated Traditional Knowledge', WIPO, (Geneva, 24 May 2024) available at https://www.wipo.int/pressroom/en/articles/2024/article_0007.html (last accessed 23 June 2024).

¹⁷⁶ Drahos, *Intellectual Property* (n 12) pg 84.

¹⁷⁷ Ibid.

¹⁷⁸ See WIPO Treaty on Intellectual Property, Genetic Resources and Associated Traditional Knowledge, adopted 24 May 2024, Article 2 available at https://www.wipo.int/edocs/mdocs/tk/en/gratk_dc/gratk_dc_7.pdf (last accessed 20 June 2024).

¹⁷⁹ Glossary of Key Terms Related to Intellectual Property and Genetic Resources, Traditional Knowledge and Traditional Cultural Expression, WIPO IGC, 27 June 2023, WIPO/GRTKF/IC/SS/23/INF/4, available at https://www.wipo.int/edocs/mdocs/tk/en/wipo_grtkf_ic_ss_ge_23/wipo_grtkf_ic_ss_ge_23_inf_4.pdf (last accessed 21 April 2024).

¹⁸⁰ Also described as 'expressions of folklore' – at the IGC these two terms are used interchangeably, though some say that the use of folklore and expressions of folklore has fallen out of favour – Sharon B. Le Gall, *Intellectual Property, Traditional Knowledge and Cultural Property Protection: Cultural signifiers in the Caribbean and the Americas* (Routledge, 2014) pgs 1-8. It is generally accepted that the use of TCEs is preferable to avoid any derogatory connotation.

culture in nearly any form non-biological, whereas the non-qualifiable TK is the knowledge, know-how, experience, and wisdom of one or more people that has been generated in a cultural context.¹⁸¹

‘Genetic resources’ is defined in the newly adopted treaty, and prior drafts, as ‘genetic material of actual or potential value’, whereas ‘genetic material’ is defined as ‘any material of plant, animal, microbial or other origin containing functional units of heredity’.¹⁸² These definitions mirror those in the Convention of Biological Diversity¹⁸³ and are substantially similar to those within the International Treaty on Plant Genetic Resources for Food and Agriculture.¹⁸⁴ Additionally, the newly adopted treaty puts forth disclosure requirements for ‘traditional knowledge associated with genetic resources’,¹⁸⁵ though the impact and functioning of these requirements and of this first, and only, WIPO treaty is still to be seen.

The definitions of TK and TCE are both as yet unclear, even after decades of discussion. In fact, both have been described as having no agreed definitions.¹⁸⁶ Within the IGC framework TK is understood in both a broad and a narrowing meaning. In the broad sense TK ‘embraces the content of knowledge itself as well as traditional cultural

¹⁸¹ Though for many purposes TK has been limited to that which attaches to Genetic Resources. For example, see the Notes to the Text of a Draft International Legal Instrument Relating to Intellectual Property, Genetic Resources and Traditional Knowledge Associated with Genetic Resources, available at https://www.wipo.int/edocs/mdocs/tk/en/gratk_dc/gratk_dc_inf_4.pdf (last accessed 21 April 2024)

¹⁸² WIPO Treaty on Intellectual Property, Genetic Resources and Associated Traditional Knowledge, adopted 24 May 2024, Article 2 available at https://www.wipo.int/edocs/mdocs/tk/en/gratk_dc/gratk_dc_7.pdf (last accessed 20 June 2024); Second Revision of the Consolidated Document Relating to Intellectual Property and Genetic Resources (as at the close of IGC 30 on June 3, 2016), WIPO, WIPO/CRTKF/IC/30/FACILITATORS, available at http://www.wipo.int/meetings/en/doc_details.jsp?doc_id=340736 (last accessed 20 June 2024), page 3.

¹⁸³ CBD (n 130) article 2.

¹⁸⁴ Adopted 3 November 2001 by the thirty-first session of the Conference of the Food and Agriculture Organization, entered into force 29 June 2004.

¹⁸⁵ WIPO Treaty on Intellectual Property, Genetic Resources and Associated Traditional Knowledge, adopted 24 May 2024, Article 2, Article 3, *et seq.* available at https://www.wipo.int/edocs/mdocs/tk/en/gratk_dc/gratk_dc_7.pdf (last accessed 20 June 2024).

¹⁸⁶ Daphne Zografos Johnsson and Hai-Yuean Tualima, ‘Cultural Heritage, Traditional Knowledge and Intellectual Property’, in Xanthaki, Valkonen et al. (eds.), *Indigenous Cultural Heritage: Rights, Debates and Challenges* (Koninklijke Brill 2017), pg 219; *Glossary of Key Terms* (n 179) pg 40.

expressions'¹⁸⁷ and includes cultural heritage, practices, and generally all unique cultural knowledge. Whereas, in the narrower meaning, TK refers to the knowledge as such – including among others agricultural, technical, and ecological knowledge, but excluding the physical manifestations of that knowledge.¹⁸⁸

TCEs in turn can be described as the expressions of traditional knowledge and indigenous culture. In the broadest sense this includes tangible and intangible things – such as handicraft but also dances, songs, and stories.¹⁸⁹ What is common between the concepts of TK and TCEs, and to an extent GRs, is the connection that they have with indigenous peoples and their cultures. TK and TCEs are often described not by what they are, but rather by the place that they hold within the community, how they are created and are maintained.

An example of this nature is provided by Martin Girsberger when describing TCEs as commonly including that they:

- are handed down from one generation to the next, either orally or by imitation, but rarely in writing;
- reflect the cultural and social identity of a community or group;
- consist of characteristic elements of the heritage of this community or group
- are made by unknown authors, artists or artisans; by communities and groups; and/or by individual members of these communities and groups communally recognized as having the right, responsibility or permission to make the TCE; and
- are often not created for commercial purposes, responsibility vehicles for religious and cultural expression.¹⁹⁰

Though the IGC has yet only translated its work into one agreed upon international instrument,¹⁹¹ it has provided a means for the protections of indigenous intangible

¹⁸⁷ *Glossary of Key Terms* (n 179) pg 40.

¹⁸⁸ *Ibid.*

¹⁸⁹ *Id.* pg 39.

¹⁹⁰ Martin Girsberger, 'Legal protection of traditional cultural expressions: a policy perspective,' in Christoph Beat Graber and Mira Burri-Nenova (eds), *Intellectual Property and Traditional Cultural Expressions in a Digital Environment*, (Edward Elgar 2008), pg 127. It must be noted that many of the elements articulated by Girsberger are not universally supported.

¹⁹¹ Diplomatic Conference to Conclude an International Legal Instrument Relating to Intellectual Property, Genetic Resources and Traditional Knowledge Associated with Genetic Resources (WIPO Geneva, 24 May 2024) [GRATK/DC/7](#) available at [at](#)

resources to be explored and has been one of the most valuable venues for the participation and involvement of indigenous peoples.

2.4.1. Certain issues with the IGC approach – the division of culture

It can be seen from the uncertainty of definitions that attempting to draw bright line rules in the area of indigenous intangible resources is not an easy task. By way of practical example there are many elements of Sámi reindeer herding that could potentially fall within the scope of the eventual protections envisioned by the IGC – as divided amongst GRs, TK, and TCEs. However, the ability to define where each of these elements would sit within the IGC structure sometimes becomes nearly impossible when considering the cultural and practical context.

Within the Sámi culture the composition of the reindeer herd – that being male v. female, castrated males v. intact males, overall size, and which animals shall be slaughtered in the autumn - is most certainly a piece of traditional knowledge. Yet this knowledge would also lead to genetic resources within the herd. Centuries of selective slaughter, castration, and overall herd composition of the reindeer have created unique genetics within the herd that may well be valuable. Though the newly adopted WIPO treaty may address certain concerns relating to the genetic resources and associated traditional knowledge,¹⁹² its applicability is narrow and limited, and does not encompass the practical reality because the knowledge associated with herd composition is intimately connected with other knowledge bases.

The Sámi also have vast traditional knowledge of the nature within which the herding takes place, and knowledge associated with reindeer herding follows that of nature. It is arguable that because of the reindeer the Sámi have such a deep connection with and knowledge of the land, yet it is also that deep connection with and knowledge of the

https://www.wipo.int/edocs/mdocs/tk/en/gratk_dc/gratk_dc_7.pdf (last accessed 23 June 2024); 'WIPO Member States Adopt Historic New Treaty on Intellectual Property, Genetic Resources and Associated Traditional Knowledge', WIPO, (Geneva, 24 May 2024) available at https://www.wipo.int/pressroom/en/articles/2024/article_0007.html (last accessed 23 June 2024).

¹⁹² WIPO Treaty on Intellectual Property, Genetic Resources and Associated Traditional Knowledge, adopted 24 May 2024, Article 3, Article 5 *et seq.* available at https://www.wipo.int/edocs/mdocs/tk/en/gratk_dc/gratk_dc_7.pdf (last accessed 20 June 2024).

land that allows them to herd reindeer. Understanding the environment within which herding is to take place directly impacts the composition of the herd in any given year. This leads one to necessarily ask, where then are the lines drawn when it comes to traditional knowledge associated with genetic resources within the herd? Would that encompass only the direct knowledge of reindeer herd management? Or, would it include the broader knowledge within which those management decisions are made? Is it even possible to separate the management knowledge into its own distinct area, divorced of context?

Furthermore, Sámi items, or products, that would fall under the rubric of TCEs also derive their nature from the Sámi knowledge, way of life, and connection to the specific environment and reindeer. The traditional Sámi knife is constructed so as to be useful in the tasks necessary for Sámi life. It is also made with materials available in a traditional lifestyle – those being primarily for this example wood, reindeer antler, and bone. In order to properly make such an item it takes not only knowledge of the knifemaking process, but also knowledge of the environment, nature, culture, and reindeer.¹⁹³

These ideas are explored in more depth later in this work. At this point, the practical example of Sámi reindeer herding was introduced to exhibit that when it comes to indigenous intangible resources efforts to categorise may sometimes not be easy or may even fail. Items of indigenous intangible resource must be viewed within the social and cultural context from which they arise. It is nearly impossible to view a piece of cultural expression devoid of its cultural context, nor an item of GR.

It is, however, understandable why the international community, lawmakers, and commentators have taken the approach of dividing cultural resources into defined categories. As stated by Caroline Picart, ‘...phrasing an interest in protecting indigenous peoples’ intellectual property rights in a manner that makes this initiative intelligible, within law’s own categories and using law’s own terms, allows the initiative to become

¹⁹³ Sámi products and traditions are discussed below in section 6.2.2.

audible, and to some extent, cognizable,'¹⁹⁴ and perhaps more poignantly, 'law appears most capable of moderating difference when these differences are translated into a semblance or a close enough guise of its own categories or frameworks.'¹⁹⁵

Yet, the parceling of indigenous culture and intangible resources into boxes with their own rules and regulations may not be the most effective approach. Indeed, according to Peter Drahos:

The WIPO drafts are a good example of how far states have moved away from recognizing the implication of cosmological connectionism from state lawmaking. Knowledge in an ancestral system takes on a flow characteristic. It may touch many different objects such as plants, paintings or ceremonial objects or be incorporated into rituals and activities, but the knowledge remains part of the unified system. Legal approaches that divide this system into different categories of protection based on a selection of objects and activities create more regulatory options for states. For example, if the unified system is divided into, amongst other things, traditional knowledge and traditional knowledge associated with genetic resources, this allows a state to develop different rules for regulating knowledge in these boxes. [And this] will open up the options of rule ritualism and legal ritualism when it comes to national implementation.¹⁹⁶

The international community and indeed scholars and commentators in the indigenous rights and indigenous intangible resource protection area have been focused on these definitions since the establishment of the IGC. And it is by this search for categories and definitions, divorced from the cultural context of the resources with which they deal that the protections available have not been effectively evaluated.

In this work we will abandon this currently employed, particularly within international negotiations, normative structure and its respective definitions and categories. This work will instead concern itself with the protections available within the intellectual property protection structures and systems first, and then test those protections within an indigenous intangible resource context. This necessarily means that the TK / TCE / GR divisional structure will not be employed substantively in this work, as the confines

¹⁹⁴ Picart (n 66) pg 94.

¹⁹⁵ *Id.* pg 97.

¹⁹⁶ Drahos, *Intellectual Property* (n 12) pg 84.

of those categories provide no valuable frame from which to examine the substantive intellectual property system.

2.5. Traditional cultural expressions within this work

With the above in mind, it is still necessary to position this work within the accepted contemporary framework to describe the context within which the enquiry is taking place. As described in the introduction and as is explored in further detail below, this work will address the application of trademark law to the protection of indigenous intangible resources and thus is constrained by certain fundamental functional definitions of what a trademark is and how it can be used.¹⁹⁷ As will be returned to, a trademark is most visibly seen in connection with a good or a service, thus the intersection between the protections afforded by trademarks and indigenous intangible resources will primarily centered in those areas in which a good or service is at issue.

Within the contemporary indigenous rights discourse, goods and services that exhibit indigenous intangible resources would lie under the umbrella of TCEs. However, TCEs as currently defined would also include forms of expression that would not be considered a ‘good or service’, such as dance, stories, songs, and certain forms or artistic expression.¹⁹⁸ The result of this mismatch in definitional boundaries means that the result of this work will necessarily speak to an application within the realm of TCEs however will not be applicable to or concerned with TCEs generally, as they are currently defined.

Because the central theme of this work is to evaluate indigenous intangible property protection from the standpoint of available trademark protections first, it is impossible to accurately identify where and to what extent the result will apply within the TCE category – even though it will necessarily fall within TCEs territory. What is clear

¹⁹⁷ See Part 4-5.

¹⁹⁸ It is at this fracture that a central issue with the current indigenous rights discourse on intangible resource protection is seen – that being a mismatch between the categories employed in on the indigenous rights side and the protection mechanisms of trademarks, copyrights, and patents on the other. It also evidences why a critical evaluation of the protection provided by trademarks is necessary independent of the categorizations of indigenous rights efforts.

however, is that this work will not deal with traditional knowledge or genetic resources as those categories are defined today.

This does not mean that the TCE concept is not useful for the purposes of this work. Indeed, it may be necessary, if only to frame the outside edges of the conceptual space within which trademark protection fits. There are certain products and services that are generally accepted as TCEs, such as handicrafts, traditional clothing, and tourism products. It is therefore helpful to understand how TCEs and indigenous intangible resources are used in these contexts before examining the substantive application of trademark protection.

2.6. Linguistic Misunderstandings

Research conducted within an indigenous context is constantly conducted under the shadow of possible confusion and misunderstanding, and one area where this manifests itself regularly is language. The misunderstandings surrounding language can be a substantial obstacle to effective protection of indigenous rights. To be clear, where the language and cultural connotations are not fully understood there is an apparent risk that the protection envisaged, and quite possibly implemented, by a majority population does not necessarily address the real concerns of the indigenous population.

When discussing indigenous intangible resources and their expressions it is natural that one of the first concepts, or group of items, to spring to mind is that of handicraft.¹⁹⁹ Though the concept of handicraft may seem naturally understandable, it is not without its definitional complexities. This is especially true when applied in a ‘native’ or indigenous context and compounded when the application further involves legal analysis.

¹⁹⁹ See, WIPO, IP and Traditional Handicrafts, available at <http://www.wipo.int/tk/en/resources/handicrafts.html> (last accessed 19 June 2024); Finger and Schuler (n 148); Palethorpe and Verhulst (n 66) pg 22; Indian Arts and Crafts: Size of market and extent of misrepresentation are unknown, Report to the Committee on Natural Resources, House of Representatives, Government Accountability Office, GAO-11-493 (*‘GAO Report’*).

2.6.1. The word 'handicraft'

The word 'handicraft' in English is defined as '[a] manual art, trade, or occupation; a craft involving making things (now typically domestic or decorative objects) by hand; the result of this, an item produced by such a craft; esp. a domestic or decorative object made by hand'.²⁰⁰ The leading American dictionary, for its part, more succinctly describes handicraft as 'manual skill; an occupation requiring skill with the hands; the articles fashioned by those engaged in handicraft'.²⁰¹ In indigenous rights discourse it has come to be used to denote handmade items of a traditional nature with a connection to the respective indigenous group and its culture. This can be seen from the many legal instruments, commentaries, legal precedent, and scholarly work that make use of the word and concept 'handicraft'. When directed toward indigenous groups and their protection, however, it is seen that the use of 'handicraft' can actually cause great confusion.

As one example, when looking at handicrafts (or rather the use of the English word 'handicraft') in the Sámi society one is confronted with the word 'duodji'. In fact many English-Sámi dictionaries refer to these two words as acceptable translations - as do Sámi-Norwegian / Norwegian-English dictionary attenuations.²⁰²

Yet this translation divorces the Sámi word duodji from its cultural context and the inherent meaning that it provides. Duodji as a concept, or rather as the concept to which the word refers, is much greater, broader, and deeper than handicrafts. Within the foundation documents for the Sámi Duodji certification mark, duodji is defined as 'traditionally made Sámi handicrafts and modern products with a foundation in traditional materials and methods, not products made as souvenirs and/or which have not been in traditional use'.²⁰³ While useful in the structure at the genesis of the Sámi

²⁰⁰ Oxford English Dictionary (online) - <http://www.oed.com/view/Entry/83862#eid1999435> (accessed 19 June 2024).

²⁰¹ Merriam-Webster Dictionary (online) - <https://www.merriam-webster.com/dictionary/handicraft> (accessed 19 June 2024).

²⁰² Gunvor Guttorm, Duodji – som begrep og som del av livet, available at <http://www.gierdu.no/pdf/GunvorGuttorm.pdf> ('Duodji – som begrep'); Davvi Girji, *Stor Norsk-Samisk Ordbok* (Davvi Girji, 2009).

²⁰³ Samesløjdstiftelsen Duodjimärket former regulations section 3.

Duodji certification mark system, that system has been recently restructured and reimplemented with different standards.²⁰⁴ A more nuanced definition of duodji can be articulated as ‘handicraft, accomplishment, achievement, feat, handwork, labour, work’.²⁰⁵ For its part, the Sami Parliament of Norway defines duodji as ‘all form for skapende aktivitet som omfatter husflid, håndverk, kunsthåndverk, sløyd og småindustri med basis i samisk kultur og tradisjoner’.²⁰⁶ These definitions, while not without their flaws, do a much better job of encompassing the entire understanding of what duodji truly is and means to the Sámi.²⁰⁷

Duodji is much more than the handmade product that results from the expressions of Sámi hands. Indeed it refers to many different and important aspects of the culture, and the products that were generated and used by the Sámi from time immemorial. As stated by Hanna Horsberg Hansen, ‘[t]he concept of *duodji* is almost impossible to translate from Sámi into other languages. While the common distinction is drawn between “art” and “sloid”, “craft” or “handicraft”, with references to functional aspects of the object; the makers’ training as artist or craftsperson; place, process and the result; *duodji* has a broader meaning’.²⁰⁸

Duodji, in contemporary views, has come to be known as a form of Sámi art, yet at its roots the word – and perhaps its center of the cultural understanding – is more than art, but also less. Gunvor Guttorm states that ‘[w]hen we look at duodji in a creative work

²⁰⁴ Aslak Paltto, ‘Saami people are trying to stop exploitation of indigenous handicrafts’, YLE 27 November 2015, available at <https://yle.fi/a/3-8485815> (last accessed 20 June 2024).

²⁰⁵ See P. Sammallahti, *Suoma-Sámi sátnegirji* (Girjegiiisá 2014); Gunvor Guttorm, ‘Duodji – Sami handicrafts – who owns the knowledge and the work’ in J.T. Solbakk,(ed.), *Traditional Knowledge and Copyright* (Samikopiiija Karasjok 2007) 65-66; Piia Nuorgam, ‘Wider Use of Traditional Saami Dress in Finland: Discrimination against the Saami?’ in Xanthaki, Valkonen et al. (eds.), *Indigenous Cultural Heritage: Rights, Debates and Challenges* (Koninklijke Brill 2017), pg 229.

²⁰⁶ *Duodji – som begrep* (n 202), ‘All types of creative activity that includes craftwork, handicraft, artistic handiwork, craftsmanship, and small productions based in the Sámi culture and traditions.’

²⁰⁷ See Gunvor Guttorm, *Duodji – árbediehtu ja oapmi*, available at http://www.samikopiiija.org/govat/doc/art_gg.pdf (last accessed 19 June 2024) (‘*Duodji – árbediehtu*’) - ‘With time, the concept of *duodji* has taken on several meanings. As a starting point, we can say that duodji is all forms of creative expression that require human thought and production. For example we can say that a work of books can be duodji. ... However, the term is mostly used to describe a specific work that is made with the hands ...’ at pg 65-66.

²⁰⁸ Hanna Horsberg Hansen, *Constructing Sami national heritage – Encounters between tradition and modernity in Sami Art*, pg 5, available at <https://munin.uit.no/handle/10037/10726> (accessed 19 June 2024)

context, we have to look at it on several levels. We cannot simply regard duodji as a finished product that has to be protected without further to-do...'.²⁰⁹ One important aspect of duodji is that it must be of use. If it were not of use, or rather were not used within the Sámi society, it was in effect not duodji.²¹⁰

This focus on useful objects, which may in their way also retain or display artistic tendencies – or even may be appreciated now as artistic by outside observers – is highlighted with an understanding of the word *dáidda*. *Dáidda* is the Sámi word for non-useful (high or aesthetic) art. *Dáidda* is a relatively recent addition to the Sámi lexicon and was created specifically to encompass those items of art that had no functional use, and therefore were not duodji, but were valued for their artistic and aesthetic value.

It is outside the scope of this work, and most probably improper, to attempt to establish here the exact contours of duodji, or what a perfect definition of duodji is in English – if indeed one can ever be found. Though duodji is explored in more depth in section 6.2.1 below, it is introduced here to highlight that duodji as a term and a concept is much more complex than the English word ‘handicraft’ conventionally conveys to an uninitiated reader. It can be seen that use of the word handicraft in an attempt to address concerns surrounding duodji results in two parties speaking in large part past one another as the concepts that those words connote do not correspond.

This example of duodji provides an instance where the English word to Sámi word translation directs the user to associate two words which may not be perfectly matched when considering the concepts surrounding those words and the place within society where the product and concept reside. Another similar situation occurs where the word to word direct translation may be more correct but the concept that those respective words invoke are substantially different.

²⁰⁹ *Duodji – árbediehtu* (n 207) pg 92.

²¹⁰ see, Samesløjdstiftelsen Duodjimärket regulations section 3.

2.6.2. The concept of 'property'

The Tlingit word 'at.óow' and its translation into the English language as 'property' confronts similar issues as the translation of 'duodji' to 'handicraft'. This situation differs, though, as it is a fairly reasonable translation when it comes to the words themselves. Indeed, even in the Tlingit society 'at.óow' and 'property' are popularly synonymous as words. The issue arises when one considers the concept of property within the Tlingit society, on the one hand, and that of the Western world, on the other.

Without delving too deeply into an evaluation of the legal and philosophical underpinnings of property in the western societies, at this point it is sufficient to establish only a few accepted points of the western property construct. It would commonly be agreed that property in the western society includes elements such as rights of possession and use, right to exclude, and the right to transfer – the term also attaches to items to which those rights may be exercised.²¹¹ Another inherent aspect of property in the Western world is the focus upon the personal and individual nature of property.²¹² Within this larger umbrella of property one finds many divisions, including among others personal property, real property, and intellectual property, each with its own system of protection, legal structure, and underpinnings.

While these concepts may be firmly entrenched in the minds of those familiar with the Western legal world, and indeed English speakers would reflexively call up in their mind these concepts when the word 'property' is employed, it takes a reevaluation of what property actually is to appreciate the misunderstandings inherent in an 'at.óow' to 'property' translation.

The first major divergence comes from a communal, as opposed to an individual, focus upon the ownership of property. Tlingit society is divided primarily between two

²¹¹ 'Property' in Black Law Dictionary (12th ed, 2024).

²¹² *Id.*

moieties, which are then subdivided into various clans. The clan being the primary unit of social interaction within and between the communities.²¹³ Furthermore -

The clan was traditionally the basic unit that held property in Tlingit society, ... Ownership resides within the clan as a unit rather than with specific individuals. Clan objects are owned at once by all its members and by none of its members individually.²¹⁴

The second major difference comes from the objects and items to which the term at.óow applies – and accordingly the rights, responsibilities, and obligations inherent in being classed as at.óow.

At.óow, ... includes both tangible and intangible components. (1) a supernatural event including the natural phenomena, the human and animal ancestors, and their spirits who were involved in the encounter; (2) the names, songs, and stories associated with the event; (3) the geographical location of site at which the event occurred; (4) the visual representation of the event and entities; and (5) the physical object on which the event is recorded (i.e. a house, house screen, ceremonial clothing, and other objects). Ownership of the at.óow confers rights for exclusive use of these five tangible and intangible elements.²¹⁵

In essence property-type rights apply not only to objects traditionally classed as property within the Western conception, but also to a broader range of items – both tangible and intangible – which may also include certain spiritual aspects. As a specific example, to assist us in understanding this broader Tlingit conception of at.óow, note can be taken of clan crests.

In the simplest terms, clan ‘crests are central to a clan and are regarded as multifaceted objects that serve social and spiritual purposes. They identify a clan and its membership.’²¹⁶ Commonly seen are depictions of bears, wolves, salmon, eagles, and ravens – though there are many more²¹⁷ - clan crests are firmly seated as the at.óow of

²¹³ For more information on the social structure of the Tlingit refer to Krause (n 106); Andrei Val’Terovich Grinev, *The Tlingit Indians in Russian America, 1741-1867* (translated by Richard L Bland & Katerina G Solovjova) (University of Nebraska Press, 2005); Emmons (n 102); de Laguna (n 99) pg 203 *et seq.*

²¹⁴ Rosita Worl, *Tlingit At.óowu: Tangible and Intangible Property* Draft Text, unpublished, on file with Author, pg 198; see also Grinev (n 106) pg 39; Krause (n 106) pg 147.

²¹⁵ Worl (n 214) pgs 78-79.

²¹⁶ Id. at pg 117.

²¹⁷ see, Krause (n 106) pgs 98-103; Emmons (n 102) pgs 31-35.

a clan.²¹⁸ Yet the interaction between a crest being at.óow and its depiction is more complex than stating that a crest is property. ‘The Tlingit legal regime makes no distinction between tangible and intangible property...’ and thus the rights surrounding crests as at.óow extend beyond the representation of the crest or even the right to make that representation.²¹⁹

To fully appreciate this, it is necessary to understand how rights to a clan crest were crystalised and where that fits within a Tlingit narrative. Clan crests, as at.óow, are commonly derived from an event and through this event the rights to that crest were acquired by the clan, normally through payment by the death of an ancestor. But, the crest is merely a representation of that event, and the at.óow nature of the crest attaches to that event. The event itself is the at.óow and objects or representations flowing from that are owned by the clan – this could include totem poles, clan crests depicting the event or actors or landscapes within that event, stories, songs, dances, et cetera. Crests are not merely badges that indicate membership, they convey deep spiritual meaning, ownership, and encompass stories of where the clan came from, the clan’s spiritual connection to various entities, and an individuals place within the society.²²⁰

2.6.3. Relevance of linguistic misunderstandings to this work

From these two examples it is evidenced that the risk of cultural and linguistic misunderstandings when dealing in the indigenous rights arena are very real. This becomes especially critical when contemplating any type of protection regime designed to encompass these items of cultural heritage. If the cultural orientation and importance of not only the words but also the concepts is not understood then any protection regime is destined to fail in its goals and fail the indigenous group(s).

These possibilities of cultural and linguistic misunderstanding also create issues within the researching of indigenous intangible rights protection. As is presented below, many attempts to understand indigenous peoples’ rights, needs, and resources have done so

²¹⁸ Krause (n 106) at 99; Worl (n 211) at 117.

²¹⁹ de Laguna (n 99) pg 213.

²²⁰ See, Emmons (n 102) pg 32 *et seq.* and pg 46 *et seq.*; Worl (n 214) pg 117 *et seq.*

through the cultural and linguistic lens of the majority population instead of with an understanding of the indigenous people. This tendency at times calls into question the validity of certain results.

Linguistic misunderstandings also loom large where attempts to analyse indigenous intangible resources are subject to categorisations built upon language outside of the applicable indigenous context. This evidences the need for a fundamental approach to understanding the protection provided by intellectual property regimes which first established the bounds of those protections and then applies them where they may find use independent of attempts to categorise.

Furthermore, throughout this work it is necessary to keep in mind the inadequacy of language to fully encompass the concepts necessarily imported into indigenous rights issues. Attempt are made to identify these as they arise and are relevant, however, the researcher, academic, legislator, and practitioner, must constantly be sensitive to areas of potential misunderstanding.

3. Trademarks – history, development, and current systems

The protection of trade-marks is the law's recognition of the psychological function of symbols. If it is true that we live by symbols, it is no less true that we purchase goods by them. A trade-mark is a merchandising short-cut which induces a purchaser to select what he wants, or what he has been led to believe he wants. The owner of a mark exploits this human propensity by making every effort to impregnate the atmosphere of the market with the drawing power of a congenial symbol. Whatever the means employed, the aim is the same—to convey through the mark, in the minds of potential customers, the desirability of the commodity upon which it appears. Once this is attained, the trade-mark owner has something of value. If another poaches upon the commercial magnetism of the symbol he has created, the owner can obtain legal redress.²²¹

3.1. Introduction

In this Part, through a complete review of the foundations and development of trademarks, and the protection of distinguishing marks the fundamental principles of trademark protection are articulated. It will then take a deeper look at the world of trademarks and present the intricacies of this area. It is only with a strong, and in depth, understanding of the foundations, functions, and nature of a trademark that those protections can properly be positioned within the world of indigenous resources.

In order to fully develop the understanding of the unregistered trademark protections, this section will address trademarks in general and broad terms with instruction from modern legal, historical legal, and other sources such as archaeological. Specific cases and situations will, however, be employed to assist in illuminating these general principles.

3.2. Trademarks and their use throughout history

There is universal agreement that '[t]he use of trade-marks dates from the very earliest times of which we have any knowledge.'²²² Indeed, there are examples of marks being

²²¹ *Mishawaka Rubber & Woolen Mfg Co v SS Kresge Co*, 316 U.S. 203, 205, 62 S. Ct. 1022, 1024, 86 L. Ed. 1381 (1942).

²²² Rogers (n 39) pg 34.

used in the course of commerce that far predate written history. WIPO begins its introduction to trademarks by stating that

Trademarks already existed in the ancient world. Even at times when people either prepared what they needed themselves or, more usually, acquired it from local craftsmen, there were already creative entrepreneurs who marketed their goods beyond their localities and sometimes over considerable distances. As long as 3,000 years ago, Indian craftsmen used to engrave their signatures on their artistic creations before sending them to Iran. Manufacturers from China sold goods bearing their marks in the Mediterranean area over 2,000 years ago and at one time about a thousand different Roman pottery marks were in use, including the FORTIS brand, which became so famous that it was copied and counterfeited.²²³

Edward S Rogers, in his 1914 book *Good Will Trade-marks and Unfair Trading*, points out that '[w]hen the eye salves of the Roman oculists became famous, and were sent all over the known world, trade-marks were placed upon them. When the tapestries of the Brussels makers were sold abroad, marks were adopted and used to identify them'.²²⁴ Professor McCarthy also confirms that '[i]n surveying history, it appears that humans have used symbols to identify ownership or origin of articles for thousands of years'.²²⁵

Examples of the historic use of marks is also evidenced in the work of archaeologists.²²⁶ A.W. Johnston conducted an extensive study of the trademarks used on Greek vases, tracing their use as far back as even the seventh and eighth century BCE.

The use of the underside of vases for decoration also became fairly widespread in the eighth and seventh centuries, most regularly on the Attic Geometric pyxis and Protocorinthian conical oenochoe, but also sporadically on other vases. One late seventh century usage comes particularly close to the more casual application of trademarks on this part of the vase, at Vroulia on Rhodes, where neat spirals appear in the shallow cone of the underside of several cups...²²⁷

²²³ WIPO, *WIPO Handbook Intellectual Property Handbook*, WIPO Publication No 489(E) (WIPO 2004) ('*WIPO Handbook*'), §2.315 pg 67.

²²⁴ Rogers (n 39) pg 34

²²⁵ J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* (Thomson, 4th ed, June 2017 Update) §5:1.

²²⁶ See Schechter (n 22) pg 19, for appropriateness of drawing from archaeological research.

²²⁷ A.W. Johnston, *Trademarks on Greek Vases* (Aris & Phillips Ltd, 1979) pg 1.

The use of trademarks for all varieties of goods has been documented throughout the ancient world. The work of Andrew Bevan provides a study of the use of marks and branding in the Mediterranean bronze age.²²⁸ '[I]n Pompeii a large number of small jars containing the fish sauces of which the ancients were so fond. One bears this inscription: "Scaurus's tunny jelly, Blossom brand put up by Eutyches, Slave of Scaurus."' ²²⁹ Even seals upon Neolithic (7000-3000 BC) ear jars exhibited

a unique shape and surface design and was perforated for attachment to the body, suggesting close relationships between particular persons, the seals they carried, and the images distributed from those seals. The act of placing a band of wet clay over the mouth of a container and impressing it with a carved stone amulet left a distinguishing mark that could be used to trace the product back to a particular individual or institution: a point of origin.²³⁰

Perhaps the most comprehensive work tracing the legal history of trademarks comes in the form of *The Historical Foundations of the Law Relating to Trade-Marks* by Frank I Schechter.²³¹ Nearly one hundred years after its publication Schechter's work remains a well-respected contribution delving into the development of trademark law.²³² In his evaluation of historical marks Schechter provides a journey through the use of various marking systems, including merchant, printer, baker, cutler, and guild marks and goes to great lengths to separate them from the modern trademark. He views the merchants' marks primarily as an indicator of ownership – used for the recovery of lost items,²³³ and other marks mainly as providing a means of tracing liability.²³⁴

²²⁸ Andrew Bevan, 'Making and marking relationships: Bronze Age brandings and Mediterranean commodities' in Andrew Bevan and David Wengrow (eds), *Cultures of Commodity Branding* (Left Coast Press, 2012), pg 35 *et seq.*

²²⁹ Rogers (n 39) pg 37.

²³⁰ Andrew Bevan and David Wengrow (eds.), *Cultures of Commodity Branding* (Left Coast Press, 2010), pg 17.

²³¹ Schechter (n 22).

²³² See, McCarthy (n 225); Keith M Stolte, 'How Early Did Anglo-American Trademark Law Begin? An Answer to Schechter's Conundrum' (1997) 8(2) *Fordham Intellectual Property, Media and Entertainment Law Journal* 505; Mark P McKenna, 'The Normative Foundations of Trademark Law' (2007) 82 *Notre Dame L Rev* 1839, describing Schechter's work as 'seminal' at 1851.

²³³ Schechter (n 22) pg 20 *et seq.*

²³⁴ *Id.*, pg 38 *et seq.*

Schechter states that in his work

we have seen that the characteristics of the typical craftsman's mark of the Middle Ages were: (1) that it was compulsory, not optional; (2) that its purpose was the preservation of gild standards of production and the enforcement of gild or other local monopolies rather than the impressing on the mind of the purchaser the excellence of the product in question and thereby the creation of a psychological need for that product; (3) that, consequently, while the modern trade-mark is distinctly an asset to its owner, the medieval craftsman's mark was essentially a liability.²³⁵

In this statement Schechter clearly views these craftsman's (or as some have styled them workman's)²³⁶ marks as something less than the modern trademark.

This separation of the early use of mark from the modern concept of a trademark has led to the idea of the evolution of trademarks. This evolutionary theory has been taken up in earnest by other scholars, most notably McCarthy when discussing historical marks - '[t]he prime function of such marks was to trace defective merchandise back to the workman, not to prevent buyer confusion. But what was once a device for fixing responsibility on the shoddy workman or for establishing a claim to shipwrecked goods, was the progenitor of today's multi-billion dollar advertising business.'²³⁷

Indeed, it seems that there is much truth to David Wengrow's statement that

Most people are aware of and talk about commodity branding on the assumption that it is the product of modern capitalist markets, and that we therefore know quite intuitively what it involves. ... There is a widespread perception that the branding of things, people, and knowledge is a distinctive creation of the postindustrial West, which is now being exported around the world...²³⁸

However, this evolutionary view of trademarks brings with it certain flaws. The first being temporal in nature, while the other relates to the functions of trademarks themselves.

²³⁵ Schechter (n 22).

²³⁶ Alexandra George, *Constructing Intellectual Property* (Cambridge University Press 2013), pg 255 *et seq.*

²³⁷ McCarthy (n 223) §5:1.

²³⁸ Bevan and Wengrow (n 228) pg 12.

3.2.1. Evolutionary understanding and the temporal concern

The evolutionary theory of trademark development relies heavily on the idea that the premodern protection of distinguishing marks is not equivalent to modern trademark systems essentially because of their basis in history – they are old. Or, perhaps more on point, that because they are old there is a lack of written evidence that explicitly describes the premodern protections as ‘trademarks’ to the satisfaction of evolutionary theory supporters. This leads evolutionary supporters to discount and simplify the historical use, functions, and structures of marks and truncate their concept of trademarks to a perfection in modern times. This understanding of the foundations of trademarks can be clearly seen in Schechter’s examination of trademark protections and historical systems.²³⁹ While identifying a variety of marking systems that had existed, such as merchants marks, cutlers marks, bakers marks, and the like, Schechter proclaimed that the earliest case ‘squarely involving’²⁴⁰ trademarks was *Sykes v Sykes*²⁴¹ of 1824.²⁴²

For nearly seventy-five years *Sykes v Sykes* was considered as the root of the trademark protection system in the English common law world. It was not until Keith Stolte published the article *How Early Did Anglo-American Trademark Law Begin? An Answer to Schechter’s Conundrum*²⁴³ that the foundations of the modern trademark protection were questioned and upended by the identification of a trademark case from nearly 250 years prior to *Sykes v Sykes*.

Stolte, after recounting the difficulty of conducting early precedent research,²⁴⁴ presented the *Sandforth’s Case*²⁴⁵ from 1584 as the true earliest recorded trademark

²³⁹ Schechter (n 22); see also McKenna, *Normative Foundations* (n 232).

²⁴⁰ Schechter (n 22) pg 137.

²⁴¹ *Sykes v Sykes*, [1824] 107 ER 834.

²⁴² Schechter discounted other marking systems, that he described, as being trademarks for various reasons that are dealt with in the subsequent section on functional and contextual concerns.

²⁴³ Stolte (n 232).

²⁴⁴ *Id.*, at 524 *et seq.*

²⁴⁵ *Sandforth’s Case*, Cory’s Entries, BL MS. Hargrave 123, Fo. 168 (1584); see J.H. Baker and S.F.C. Milsom, *Sources of English Legal History: Private Law to 1750* (Butterworths, 1986), pg 615 *et seq.*

case in the English common law world.²⁴⁶ *Sandforth's Case* concerned the unauthorized use of marks upon fabric in which it was found that the plaintiff had a right to the mark and a competitor was restrained from making use of it.²⁴⁷ The acceptance of a trademark case deriving from a time that was once considered devoid of true trademark protection casts doubt upon any evolutionary theory that considers the historical protection of distinguishing marks was merely an immature precursor to the modern system.

The challenge to the evolutionary theory's temporal justifications is not confined to the existence of *Sandforth's Case* alone. Indeed, even in that case it appears that there was an established system of trademark protection long prior to 1584. As Stolte alluded to when he commented on the complaint that had been filed in *Sandforth's Case* and stated that

The plaintiff's attorney seems to have framed the issues and facts in the complaint of *Sandforth's Case* in a manner that is remarkably modern, albeit too reliant on the now-discarded word "aforesaid" or its Latin counterpart. Can it be a mere coincidence that a practitioner of the mid-Elizabethan age had the tools and presence of mind to draft a complaint that, if the pleaded facts were found to be true, would sail to a summary judgment, complete with a grant of increased damages, attorney's fees and costs?²⁴⁸

Stolte came to the conclusion that 'actions of the sort found in *Sandforth's Case* may not have been uncommon during the sixteenth century, and that the plaintiff's attorney may have had doctrinal resources at hand'²⁴⁹ on trademark protection. Thus it would appear that there remain trademark authorities, and possibly documentation of an entire legal protection system for trademarks, that far predate *Sandforth's Case*.

Though it is undoubted that the modern trademark system has developed, it would be a mistake to think that this necessarily means that prior protections of distinguishing

²⁴⁶ Stolte (n 232). It should be noted Stolte credits Baker (n 245) with publishing references to *Sandforth's Case* in his 1971 work with the text to follow in 1986. However, the case did not receive much attention as a precursor to *Sykes v Sykes* until Stolte's article.

²⁴⁷ Baker and Milsom (n 245) pg 615; the complaint can also be found as an appendix to Stolte (n 230).

²⁴⁸ Stolte (n 232).

²⁴⁹ *Id.*, pg 532.

marks were in any manner undeveloped or unevolved. Indeed, it would seem, and it shall be explored more below, that the fundamental principles of trademark protection have been present as long as distinguishing marks have been in use. Clearly the legal tradition of protecting distinguishing marks extends much further back into history than what the written legal records, that are available today, can described.

This means that there is a danger in discounting historical protections of distinguishing marks as non-instructive, especially if that disregard is based on nothing more than a misplaced idea that those protections are old, or not well legally documented, and thus irrelevant. Traders, manufacturers, producers, and even consumers throughout history, and prehistory, have had the same concern for authenticity. Indeed, David Wengrow writes an explicit word of warning to those who view the historical uses of marks as merely trademark systems in their infancy. 'Clearly there are dangers...of reducing non-Western or premodern forms of branding to shadowy precursors of something apparently familiar.'²⁵⁰

In reality, in order to fully understand the general principles and norms of trademark protection it is necessary to, at a minimum, acknowledge the historical uses and view them not in contrast to modern protections, but rather in concert with them. This may prove difficult if one were to rely strictly on legal, and even more so written, sources, which necessitates taking into consideration other sources that may be useful in illuminating the use of distinguishing marks where legal sources are unavailable. In this attempt the work of archaeologists and anthropologists is enlightening.

Even Schechter endorsed the practice of including archaeological research in the effort of understanding the earliest uses of trademarks. He stated that '[t]he history of trademark law is of course inextricably association with the history of the trade-marks themselves,'²⁵¹ and praised the work of prior trademark authors who put to good use archaeological evidence of the use of trademarks.²⁵² Schechter highlighted the use of

²⁵⁰ Bevan and Wengrow (n 228) pg 21.

²⁵¹ Schechter (n 22) pg 19.

²⁵² Id., pgs 19-21.

archaeological research in the trademark scholarship of Joseph Kohler.²⁵³ However, Schechter also noted that it has been nearly forty years between his work and Kohler's, and made mention of the beneficial advancements made in archaeology in that time.²⁵⁴ It has now been nearly a century since Schechter's own seminal work and the archaeological science and research has advanced that much more, leading to even more beneficial and valuable archaeological resources in the trademark context.

Advancements in the studies of archaeology, as well as branding and its intersection with historical societies, provides a great wealth of information from which an understanding of how trademarks were historically used and what functions they served can be explored. In understanding the earliest uses of trademarks, it has been said that trademarks provided a vital form of communication that took on increasing value as the distances between production and consumption increased.

When trading was face to face, the purchaser of a commodity dealing directly with the producer, a trade-mark was not used because none was necessary. The purchaser necessarily knew whose product he bought, and by returning to the same place was sure again of trading with the same individual and again of purchasing the article desired. The locality of the place was the essential means of identification and the seat of the good will. As soon, however, as a particular maker, by the excellence of his manufacture, acquired a reputation outside of his immediate locality, in order to visualize and perpetuate that reputation he adopted and used a mark to distinguish his product from others.²⁵⁵

An interesting aspect to Rogers' description above is the idea that this distance was not necessarily a result of the means of distribution, but rather an expanding territory in which a reputation was recognised. The difference between these two situations has been styled by some as a 'bazaar economy' and a 'brand economy'. The 'bazaar economy' describes something akin to commerce that would take place locally within the context of neighbourhood markets and bazaars. In this situation transactions were

²⁵³ Joseph Kohler, *Das Recht des Markenschutzes* (Stahel, 1885), available at <https://archive.org/details/dasrechtmark00kohlgoog/mode/2up> (last accessed 19 June 2024).

²⁵⁴ 'Joseph Kohler, with his wide range of scholarship, utilized a great deal of the then available archaeological material in his reconstruction of the early history of trade-marks and trade-mark law. The great achievements of archæology in the forty years that have elapsed since the publication of Kohler's work have added much to our knowledge of the early use of trade-marks.' Schechter (n 22) pg 19-20

²⁵⁵ Rogers (n 39) pgs 33-34.

based upon personal interaction, good faith and ‘the mobilization of personal networks of loyalty and affiliation between traders and consumers, so that any breach of trust...threatens the integrity of a larger social whole.’²⁵⁶

In a ‘brand economy’ the relationship between the consumer and the goods centers upon familiarity with the brand itself. The consumer would develop a relationship with the brand, create an association with that brand, and hold specific expectations as to what they would receive.²⁵⁷

In this context the importance of trademarks, branding, and the protection of distinguishing marks becomes relatively simple to understand. Indeed, the complexities of a ‘brand economy’ seems to make its appearance in modern critiques of the effect that globalism has on modern trademark usages. What is forgotten at times is the extent to which premodern societies were part of the brand economy. The thought that premodern societies dealt only in locally made and produced items, traded only in village markets where they had direct relationships with the producers of goods ignores the extent to which premodern societies lived within global trade networks.

In his review of bronze age branding in the Mediterranean, Andrew Bevan states that ‘[i]n terms of exchange, we see a marked increase in the range and quantity of goods circulating across this area over the course [of] the Bronze Age (roughly-speaking the 3rd and 2nd millennia BC...).’²⁵⁸ Unsurprisingly, accompanying the long distance Mediterranean trade networks was the use of distinguishing marks.²⁵⁹ Evidence even suggests that long distance trade networks were common even in the copper age. As a metallographic analysis of the copper axe found with the famous ‘Ötzi the iceman’,²⁶⁰

²⁵⁶ Bevan and Wengrow (n 228) pg 22.

²⁵⁷ Ibid.

²⁵⁸ Id., pg 43.

²⁵⁹ Ibid.

²⁶⁰ Ötzi the Iceman is a man who lived around 3300 BC and was found as a naturally preserved mummy in the Ötztal Alps in 1991. Brenda Fowler, *Iceman* (University of Chicago 2001); Georges Bonani, *et al.*, ‘AMS 14C Determinations of Tissue, Bone and Grass Samples from the Ötztal Ice Man’, (1994) 36(2) Radiocarbon 247.

the origins of the copper used in that axe were traced to a great distance from where he was eventually found.²⁶¹

Bevan's work provides a wealth of historical examples of the use of marks in a premodern society. Including the use of distinguishing shapes for ingots,²⁶² markings on textiles,²⁶³ and the shapes and markings on containers for perishables.²⁶⁴ Bevan also provides the context within which these marks were used. Looking specifically at the trade in metals, Bevan states '...while the restricted nature of metals as a resource led to some highly directional and sometimes carefully managed exchanges, the popularity of particular metal commodities, from particular sources and handled by particular distributors, was something that had a lot to do with their marketing.'²⁶⁵ In order to facilitate this marketing and distinguishment of products

A complex range of distinctions were made to describe different grades, types, and sources ... that referred, for examples, to the copper's purity and colour, shape as an ingot, and whether it was whole or broken up. In the case of Old Assyrian trade, the finer graders of Anatolian copper were sometimes worth over twice the price in silver of the poorer ones.²⁶⁶

Bevan specifically identifies a particular form of ingot described as 'oxhide' given its particular and distinctive shape. '[T]he key point ... is that this trade in Cypriot metal should not be interpreted simply as the export of raw material from a geographically favoured locale but as something that required regular and intensive promotion.'²⁶⁷ The recognition of this ingot shape was so widespread that 'it is no accident that many of the representations of ingots in Bronze Age iconography do not merely depict the shape, but are also careful to show this stippling²⁶⁸ on one side.'²⁶⁹

²⁶¹ Gilberto Artioli, Ivana Angelini, Günther Kaugmann, Caterina Canovaro, Gregorio Dal Sasso, Irgor Maria Villa, 'Long-distance connections in the Copper Age: New evidence from the Alpine Iceman's copper axe' PlosONE 12(7):e0179263, 5 July 2017, available at: <https://doi.org/10.1371/journal.pone.0179263>.

²⁶² Bevan and Wengrow (n 228) pg 50 *et seq.*

²⁶³ *Id.*, pg 57.

²⁶⁴ *Id.*, pg 62.

²⁶⁵ *Id.*, pg 48.

²⁶⁶ *Id.*, pg 50.

²⁶⁷ *Id.*, pg 51.

²⁶⁸ The stippling that Bevan mentions has to do with the particular method of production. *Id.*, pg 51 *et seq.*

²⁶⁹ *Id.*, pg 53.

Interestingly, he also articulates that the trade at that time was not devoid of attempts by the unscrupulous to exploit the value of distinguishing marks. ‘Counterfeits of popular commodities were very common, whether these were impressive synthetic versions such as “lapis lazuli of the kiln” rather than “lapis lazuli of the mountain...or merely cheap local copies.’²⁷⁰ Furthermore, there were penalties imposed for unscrupulous behavior and counterfeiting.²⁷¹

Bevan’s comments regarding textiles in the Mediterranean region is just as illuminating. ‘A clear and widely agreed sets of types and quality grades are present and associated with many of these, also indications of provenance (some still meaningful, other long since become notional). Marks on the edges of bolts of cloth, on finished garments, and / or on packets of several textiles are important signifiers of reliable value.’²⁷² In the case of Egyptian textiles these markings were so well known and understood that they appear in ‘wall paintings and decorative reliefs ... with great attention to known quality grades and details of weave, colour, edge finishing, and / or diaphony.’²⁷³ This is not entirely unlike a modern desire to be captured wearing a particular brand of clothing, though clearly being etched in stone is more lasting than an Instagram post. In short, Bevan suggests the contribution by Garcia Clark in his book ‘should make it clear that a whole range of product marking and market-led manipulation was behind the perceived value of these textiles, with good evidence for the kinds of symbolic abstraction that we commonly associate with modern branding practices.’²⁷⁴

Gracia Clark meaningful study on cloth selvages as marks and their meaning in the textiles trade specifically between Dutch producers and West Africa describes the development of the brand identity of the selvages used from the early colonial era to present day. Even in the medieval age ‘[m]erchants and wealthy customers could become familiar with the selvedge patterns and seals of popular cloths where they lived

²⁷⁰ Id., pg 43.

²⁷¹ Id., pg 59.

²⁷² Id., pg 57.

²⁷³ Id., pg 61.

²⁷⁴ Id., pg 59.

without direct contact with Flanders or further knowledge of their methods of manufacture.²⁷⁵ The trade in textiles between Flanders and West Africa increased by the end of the 15th century,²⁷⁶ and the selvedge marks became established to the West African consumer. ‘The display of selvedges reflects a persistent ranking of European over other provenances that goes beyond simple quality assurance. Selvedges that read “genuine Dutch was” or “real Java print” are frequently worked into the dress design somehow, to flaunt the authenticity of the cloth to those who might not notice.’²⁷⁷ In the West African market these selvedge markings were established as a brand, and could be considered a trademark. David Wengrow advises that within Clark’s work ‘[t]here is a lesson ... for archaeologists who would minimize the role of consumer demand in premodern economies, and equally for experts in contemporary marketing who would identify consumer manipulation of brand values as a recent trend, contingent upon technologies such as the Internet.’²⁷⁸ The same could be advised for trademark scholars and practitioners.

The lack of definitive legal sources establishing that trademarks were employed, and possibly protected, in premodern societies in manners that we would find recognizable is not entirely surprising. However, interpreting what evidence is available on marks and their usage should not fall victim to a prejudice that premodern societies were not capable of developing, maintaining, and protecting a comprehensive trademark system. The archaeological evidence, in fact, is entirely contrary to the idea that premodern societies did not have functioning trademark protection systems. Bevan’s work in the bronze age Mediterranean is situated in an era where there is a lack of clear written legal authority on trademark rights yet the evidence clearly exhibits the valuable use of distinguishing marks. Furthermore, the use of marks in many other premodern cultures has been documented.²⁷⁹ Indeed, even in an example of the Bazaar economy, though

²⁷⁵ Garcia Clark, ‘Lincoln Green and Real Dutch Java Prints: Cloth Selvedges as Brands in International Trade’ in Andrew Bevan and David Wengrow (eds.), *Cultures of Commodity Branding* (Left Coast Press, 2010), pg 199.

²⁷⁶ Id., pg 201.

²⁷⁷ Id., pg 203.

²⁷⁸ Bevan and Wengrow (n 228) pg 28.

²⁷⁹ Andrew Bevan and David Wengrow (eds), *Cultures of Commodity Branding* (Left Coast Press 2010) - studies on branding in China at pg 12, and the Mayan empire at pg 167; Rogers (n 39) - Roman empire, pg 35; A.W. Johnston (n 225) for the Greek civilization.

often employed to support the idea that mark usage evolved in step with the temporal or geographic expansion of trade, one can easily conceptualise how marking would be employed to great effect.

The fact that transactions happened face to face, or close to, in a bazaar economy does not preclude the idea that marks were used to the same purpose and effect as the use in brand economies. Indeed, anyone would be familiar with the situation of coming across a product in the possession of a friend or acquaintance that attracts the eye. It is only natural to enquire as to where that acquaintance acquired the product and seek to acquire one ourselves. 'Where did you get those shoes?', 'I like that shirt?', 'Who made your tableware?'. None of these questions would seem out of place today and each would require an answer that would direct the enquirer to the source of that product. To assume that situations would not occur in ancient times, or that the traders of the day would not seek distinguish their wares through mark, name, or brand, is akin to arrogance.

Rogers' assessment of the use of marks in the Roman empire - 'It is hardly too much to say that trade-marks played almost the same part in Ancient Roman commercial life as they do today.'²⁸⁰ – is applicable to all of these situations.

Though much of what the modern world can understand of the historical and premodern uses of distinguishing marks comes not from legal documents on the matter but rather from evidence of actual use, such as the archaeological record, this does not mean that those marking systems can be disregarded as mere precursors to the modern system. It is clear even from the available evidence that marking systems were in wide use, were of value, and were protected in a manner. They exhibit the functions, and were ruled by the same general principles, as are seen today, and should not be disregarded but rather included in any examination of a foundational understanding of trademarks.

²⁸⁰ Rogers (n 39) pg 35.

3.2.2. Evolutionary understanding and the functional / contextual concern

Garcia Clark's work²⁸¹ brings brand usage into a more papered era of history, that of the medieval ages. While Clark establishes the impact and value that selvedge marking had in the West African market, the value of Flemish textile marks in Flanders during the middle ages is evidenced first and foremost by an edict with viciously severe penalties for infringement of such marks.

An edict of Charles V. of May 16, 1544, concerning Flemish tapestries, provided that any master workman who makes or causes to be made any such tapestry, shall work upon one end and upon the bottom of the said tapestry a mark or symbol, and such signs as the city may require; that it may be known by the said tapestry is a product. Infringers were punished by cutting off the right hand.²⁸²

It also is in this medieval time that documentation is seen for the proliferation of workman, guild, printers, bakers, and marking systems that have been described previously. Which conveniently leads to the second concern regarding an evolutionary view of trademarks, that being the functional or contextual concern.

There are many systems of marking that have a rather rich documented history. These include the marks identified and dealt with by Schechter – the craftsman/workman, merchant, production, guild, bakers, cutlers, and printers marks – though similar marking systems or requirements can be found in many jurisdictions in the medieval and post-medieval timeframe. In Norway the first documented marking type system was established in Magnus Lagabøters landslovs, an early Norwegian code of law from between 1274 to 1276. In a section detailing the equipment that men, by law, should have it was stated that

Og hver skjoldmaker skal på de skjold som han gjør, ha et merke som er vedtatt på bymøtet, for at man kan vite hvem der har gjort det, om det finnes fusk i det; men om noen ikke har, da er skjoldene opptøk til Kongens hånd.²⁸³

²⁸¹ Clark (n 275) pg 197 *et seq.*

²⁸² Rogers (n 39) pg 39 (internal citations omitted).

²⁸³ Magnus Lagabøters landslov, Land protection section, chapter 11 on bearing weapons, point 2; 'And every shieldmaker shall put on the shield that he makes, having a mark that is approved at the city meeting, that one may know who has made it, if there is any cheating (flaw) in it; but if someone does not have [a mark], then the shields are confiscated by the King's hand', available at [http://heimskringla.no/wiki/Magnus_Lagab%C3%B8ters_landslov_\(III._Landevernsbolken\)#Kap._11._Om_vaabenbunad](http://heimskringla.no/wiki/Magnus_Lagab%C3%B8ters_landslov_(III._Landevernsbolken)#Kap._11._Om_vaabenbunad). (last accessed 19 June 2024).

Interestingly, this marking requirement can trace its pedigree to shield quality standards in earlier Norwegian written laws. The law of coastal defense in Gulatingsloven, which is believed to have been between the late 1000s and 1100s, specifically stated that ‘A man shall have a broadax or a sword, a spear, and a shield which at the worst must have three small plates of iron laid across it and shall have the hand grip fastened with iron nails.’²⁸⁴ A similar quality requirement can be found in Frostatingsloven which dates from even earlier at around the year 950. In the section of the law concerning coastal defense it was articulated that ‘[e]very wooden shield shall be regarded as properly made if three iron bands are laid across it and the grip is [fastened] on the inner side.’²⁸⁵

The functional/contextual concern regarding an evolutionary theory of trademarks arises from historical mark usage being viewed with a modern registration based view, much like the concern in the applicability of trademark protections to indigenous intangible resources discussed in section 1.3.3. In modern scholarship this view manifests itself by considering historical marking systems as merely the result of statutory or governmental requirements, proprietary marks to identify property, or marks to trace the liability of products. However, this necessarily ignores the function of trademarks and what they actually protect.²⁸⁶

At this point the functional concern can be exhibited by stating that the means by which a mark is established, or rather the statutory mechanism from which it arises, does not preclude those marks from performing the functions of a trademark, and thereby attracting the corresponding protection. Irrespective of how the mark came into

²⁸⁴ Gulatingsloven, The law of coastal defense, section 309 concerning weapon things (translated by Laurence M Larson), in *The Earliest Norwegian Laws: being the Gulathing Law and the Frostathing Law* (Columbia University Press, 1935, Lawbook Exchange edition 2008), pg 196.

As an aside, according to the English translation, Gulatingsloven also provides us with a definitive definition of ‘hair pulling’ in the law of personal rights – ‘If a man seizes another by the hair and jerks him forward he shall pay him a half atonement. But if he does this and also shakes him up, that is called hair pulling, and he shall pay him a full atonement for that.’ *Id* pg 142-143. This has nothing to do with the topic, just thought you’d like to know.

²⁸⁵ Frostatingsloven, law of the coast defense, section 15 concerning a satisfactory shield, (translated by Laurence M Larson), in *The Earliest Norwegian Laws: being the Gulathing Law and the Frostathing Law*, (Columbia University Press, 1935, Lawbook Exchange edition 2008), pg 320.

²⁸⁶ Which are explored Part 4.

existence, be it from the imagination of the mark user, or by virtue of governmental prescription, the protection afforded by a trademark is unconcerned. Trademark protection attaches to how a mark is used and interpreted by the public, and in essence the value that arises from those elements.

Though many would point to the lack of evidence that premodern marks were used in a trademark context, there is archaeological and interpretive evidence that the consumers added some trademark-like value to the marks themselves. In Roman Britain there are many examples of sandals with markings that indicate their high value and that they had traveled a great distance to get to Britain. Some of these marks have even been described as a 'more patent attempt at branding in the modern sense of the word...'.²⁸⁷ Yet, it is clear from the archaeological record that there were competent leather workers in Roman Britain at that time producing footwear. In Egypt there was a substantial desire for Cypriot metals, though '[t]here is no inherent reason...why a state such as Egypt should have sought large quantities of copper from Cyprus, given the substantial supplies it had in the Sinai and Eastern Desert'.²⁸⁸

In both of these situations it is much more logical to interpret the evidence to exhibit that there must have been some perceived value in the mark and branding of a product, rather than ignoring any possibility of brand values and assuming that these societies were only capable of some un- or underdeveloped proto-trademark usage.

Similarly, one can question the common view of the shield marking requirements in early Norwegian law. The popular view being that 'bestemmelsen har mer karakter av en politimessig forordning om kontroll og ansvar, enn om hvilke rettigheter som knytter seg til varemerket. Sånn sett skiller den seg nok fra det som er siktemålet med våre dagers varemerkelovgivning.'²⁸⁹ However, if this regulation were a mere regulatory

²⁸⁷ Charlotte R Douglas, 'A comparative study of Roman-period leather from northern Britain', MPhil(R) thesis, available at <http://theses.gla.ac.uk/7384/7/2015douglassmphil.pdf>, pg 82.

²⁸⁸ Bevan and Wengrow (n 228) pg 51.

²⁸⁹ Farger som varemerke: om adgangen til å registrere fargemerker, kandidatnummer 661, masteroppgaven, UiO, 25.apr.2014, pg 2 ('The provision has more of a character of a police regulation on control and responsibility than about the rights that are attributable to the trademark. In that way it is different from what is the purpose of our trademarks today.').

quality control, it would seem odd to structure it by allowing each craftsman to trade under individual marks. A much more logical approach, if the goal were state sponsored quality, would be to create something akin to today's CE or FCC marking standards. Indeed, though '[l]ikevel illustrerer den det som tradisjonelt og fremdeles blir ansett som varemerkets hovedfunksjon; opprinnelsesgarantifunksjonen,'²⁹⁰ the view that the shield marking is merely a state requirement ignores what those marks may have meant to the purchasers, as they did indeed identify the source of those shields or the value of their attributes.

Furthermore, the vast majority of these historical marks, or marking systems, would easily fall within some form of trademark protection in the modern framework. That could occur as a registered trademark, certification mark, collective mark, or other form of modern understanding.

Within Schechter's articulation of the use of merchant/proprietary marks²⁹¹ good examples of specific regulations relating to the marks of merchants can be found, as well as situations in which those marks were evaluated in the courts. Schechter places great weight upon their usefulness in situations of lost sea cargo and piracy²⁹² and explains that ability distinguishes those marks from modern trademarks. This approach, however, fails to take into consideration how merchants' marks could be perceived by the consuming public and thus find further value and use. Furthermore, the frameworks cited by Schechter are not generally prescriptive to all merchants, but rather regulations on how rights to goods could be traced according to marks upon the goods, 'if the goods was so marked'.²⁹³ Thus, it would seem that the use of merchants marks, though highly useful,²⁹⁴ were at the election of the merchants. The fact that the state would recognise those marks as indications of ownership holds little bearing on how those marks would

²⁹⁰ Farger som varemerke: om adgangen til å registrere fargemerker, kandidatnummer 661, masteroppgaven, UiO, 25.apr.2014, pg 2 ('Nevertheless, it illustrates what is traditionally and still regarded as the main function of trademarks; the guarantee of origin function.').

²⁹¹ Schechter (n 22) pg 19 *et seq.*

²⁹² *Id.*, pg 27 *et seq.*

²⁹³ *Ibid.*

²⁹⁴ *Id.*, pg 23.

be used in a consumer context, nor whether they had value to the merchant outside of the situations of piracy and shipwreck.

What has been outlined above highlights the importance of the contextual concern. Though a mark may be useful in one context, in the above example that of indicating ownership in the case of shipwrecks or piracy, in a different context it can also exhibit all of the necessary attributes of a trademark.

Alexandra George describes this contextual conundrum thus -

What is different about the context of signs that leads to the outcome that they are not intellectual property when regulated as workers' marks (ie, by doctrines such as guild marks, hallmarks, and standards), but they are intellectual property when regulated by the parallel and overlapping doctrine of trademark law (whether as standard, collective, or certification marks)? Bearing in mind that it may be exactly the same mark being treated differently—as an 'intellectual property object', on the one hand, and not as an 'intellectual property object', on the other—the answer must surely be as follows: as the two doctrines that each regulate with respect to the identical documented form do so simultaneously, and do so in the same context, it is something outside the regulatory doctrine itself that is the additional factor determining whether an object is or is not intellectual property. Identical documented forms thus serve different functions in different contexts, and the context can help explain the reason for this in a given situation.²⁹⁵

In other words, the context within which a mark is used informs us of the value of that mark, or rather the value of that use of the mark, and thus the protections it attracts. When viewing the historical uses of marks, it is thus incumbent upon us to not be blinded by a single context and discount the possible trademark usage that a certain mark may have had in other contexts. The above examples of historical marks provide us with many iterations of this contextual challenge. Though the shield mark in early Norwegian law may have been promoting the minimum quality of shields, that does not mean that within the context of shield purchasers the marks of individual craftsmen did not hold differing values and prestige. Even the Dutch cloth selvedge marks changed drastically between their home geography and the marketplace of West Africa. It is also interesting

²⁹⁵ George (n 236) pg 321.

to note that arguably the first true trademark case in the English common law world relates to the marking of cloth.²⁹⁶

The reluctance to acknowledge that premodern marking use was more than a ‘proto-trademark’ use draws its support not from any documentation or evidence to that effect, but rather from the absence of evidence of a system that mirrors the modern statutory schemes and a refusal to view the use of those marks through the lens of the fundamental principles of trademarks and premodern consumers.

In the end, Rogers provides an eloquent relevant passage when discussing the inscriptions upon Roman bricks –

Whatever may have been the direct reason for these inscriptions, whether they were voluntary advertising, or the result of governmental regulation, the fact remains that from a very early date they were used exactly as trademarks are today, to indicate the origin of the article.²⁹⁷

With this more nuanced view of premodern marking there are compelling reasons to reject the idea that those marking systems were merely a proto-trademark mechanism awaiting evolution and maturation. Though it must be said that the word ‘trademark’ itself may not be found in use at that time, the possibility that these marking systems were in use in the same, or very similar, manners that one would consider modern trademark usage must reasonably be accepted. It would appear from the archaeological record and current research that premodern marks had commercial value outside of simple regulatory, proprietary, or liability schemes, that premodern marks held the intangible desirables which are seen today, and even carried with them penalties for infringement – all hallmarks of a trademark system that would be comfortable in the modern era. The acceptance of premodern marking systems as a form of trademark protection assists in developing a clearer definition of a trademark which, as alluded to previously, revolves around the functions that a trademark performs and are articulated more clearly in Part 4.

²⁹⁶ *J.G v Samford (Sandforth)*, (1584) Corys entries, BL MS. Hargrave 123, fo. 168v.; Baker (n 245) pg 615; See generally, Stolte (n 232).

²⁹⁷ Rogers (n 39) pg 35.

3.3. Developing toward the modern trademark system

The previous section explored the uses of marks in premodern history and expanded the understanding in relation to the concept of a modern trademark. However, it is necessary to draw a line connecting the modern system which is in use today and those of the premodern era. Though the protection of distinguishing marks has been present since those early times, the structure of the modern trademark protection regimes has been built around instruments developed in the mid-nineteenth century.

In the early to mid 1800s the first statutory systems of trademark protection began to appear. In some cases these included a national registration mechanisms and registers,²⁹⁸ while in other jurisdictions it took further law making for the registration of trademarks to emerge.²⁹⁹ Prior to statutory regimes, marks found protection through a variety of legal areas. Indeed, it was stated in 1853 that '[t]he principle is well settled, that a manufacturer may, by priority of appropriation of names, letters, marks, or symbols of any kind to distinguish his manufactures, acquire a property therein, as a trade mark, for the invasion of which an action for damages will lie, and in the exclusive use of which he may have protection, when necessary, by injunction.'³⁰⁰ In the English common law world protection arose mainly from an action in deceit or fraud in the court of law, and through injunctions in the courts of equity.³⁰¹

The first statutes written to encompass a more comprehensive approach to the protection of marks made their appearance just after the mid-point of the nineteenth century. By way of example, in France the 1857 *Manufacture and Goods Mark Act* established 'a trademark deposit system that embodied theories of both use-based and examination-based trademark registration systems.'³⁰² The United Kingdom saw the 1862 *Merchandise Marks Act*, though it was later in the 1875 *Trade Marks Registration*

²⁹⁸ Such as the United States Trademarks Act of 1870 section 4937 *et seq.*, Rev.Stat., ch. 2, p. 963.

²⁹⁹ *Merchandise Marks Act* 1862 (UK); *Manufacture and Goods Mark Act* (23 June 1857) (France).

³⁰⁰ *Stokes v Landgraff*, 17 Barb 608, 608-609 (NY Sup Ct 1853).

³⁰¹ *Sykes v Sykes*, 107 ER 834 (Kings Bench 1824); *Blofeld v Payne*, 110 ER 509 (Kings Bench 1833), *Blanchard v Hill* 26 ER 692 (Chancery 1742), *Snowden v Noah*, 1 Hopk.Ch. 347 (NY Chancery 1825), *Taylor v Carpenter*, 11 Paige Ch 292 (NY Chancery 1844).

³⁰² Shoen Ono, *Overview of Japanese Trademark Law* (Yuhikaku, 2nd ed, 1999) Chapter 2, section II, Pg 2, available at https://www.iip.or.jp/e/e_publication/ono/.

Act³⁰³ that a system of registration followed. In the United States the statutory scheme for trademark protection and registration began in 1870 with trademark provisions being added to a House of Representatives bill to 'revise, consolidate, and amend the statutes relating to patent and copyright'.³⁰⁴ Norway saw its first law on trademarks in 1884.³⁰⁵ Other countries that integrated some form of trademark protection into their national laws around the same time include, Australia, Japan, Argentina, Brazil, Germany, and New Zealand.³⁰⁶

The activity in trademark law making during this period was not limited to within national borders. On the international stage there was a proliferation of bilateral treaties relating to, essentially, mutual recognition of trademark registrations. In the United Kingdom 'the complexity of the [pre-statutory trademark] law was also seen as an impediment to attempts to gain protection for British traders abroad. And there was certainly a sense that British traders needed protection abroad, as the markets for their goods, in the UK, the British colonies and elsewhere, were being penetrated by counterfeit goods originating outside the UK.'³⁰⁷ This led to the United Kingdom negotiating treaties 'with Russia in 1859, and was closely followed by agreements with France, Belgium, Italy, the Zollverein and Austria.'³⁰⁸ Similarly, between the years 1868-1892 the United States negotiated eleven bilateral treaties on the mutual recognition of trademarks in the respective countries.³⁰⁹

³⁰³ *Trade Marks Registration Act 1875* (UK).

³⁰⁴ An Act to revise, consolidate, and amend the statutes relating to patent and copyright, HR 1714, 41st congress (1870). The trademark provisions of this statute were subsequently amended in 1875 to include criminal provisions and was subsequently ruled unconstitutional by the US Supreme Court in the *Trademark Cases* 100 US 82 (1879).

³⁰⁵ Lov om varemerker av 26 mai 1884 (Norway).

³⁰⁶ See, Adriana Casati, 'Early Trademark Legislation Around the World-Part I' (15 Sep 2002) 57(17) *INTA Bulletin*; Adriana Casati, 'Early Trademark Legislation Around the World-Part II,' (1 Oct 2002) 57(18) *INTA Bulletin*.

³⁰⁷ Lionel Bently, 'The marking of modern trade mark law: the construction of the legal concept of trade mark (1860-1880)' in Lionel Bently, Jennifer Davis, and Jane C Ginsburg (eds), *Trade Marks and Brands: An Interdisciplinary Critique* (Cambridge University Press, 2008) pg 7.

³⁰⁸ *Id.*, pg 15.

³⁰⁹ Treaties between the US and Austria 25 Nov 1871, 17 Stat 917; Belgium, 20 Dec 1868, 16 Stat 765; United Kingdom, 24 Oct 1877, 18 Stat 829; Russia, 27 Jan 1868, 16 Stat 725; Switzerland, 14 May 1883; Spain, 19 June 1883, 22 Stat 979; the Netherlands, 10-16 Feb 1883; Germany, 11 Dec 1871, 17 Stat 921; France, 16 Apr 1869, 16 Stat 771; Denmark, 15 June 1892, 27 Stat 963; Brazil 24 Sep 1878, 21 Stat 659.

International efforts on the protection of trademarks, as well as in other areas of intellectual / industrial property, were similarly progressing and ultimately culminated in the drafting and signing of the Paris Convention for the Protection of Industrial Property.³¹⁰ The Paris Convention grew out of negotiations that took place between 1873 and its signing in 1883, and entered into force on July 7, 1884.³¹¹ Within the Paris Convention the articles relevant to trademarks were contained in Articles 6 through 10.

This flurry of activity in the trademark arena has been attributed to the changing commercial conditions at that time, including an increase in the use of advertising, an increasingly industrialised nature of trade, and growth in international commerce.³¹² Merchants, producers, and traders of the time were putting pressure on their respective governments to codify certain aspects of trademark law, not only for clarity, but in order to procure registrations that could then be enforced abroad.³¹³

Though the statutes and treaties of this era established the foundation of the current system of trademark protection and registration, it must be remembered that the majority of these statutes did not supplant the protections afforded to trademarks that were in place at the time of their enactment. In essence, the statutory schemes brought with them certain benefits, especially when it came to simplifying recognition and enforcement of registered trademarks abroad, but they also created an arbitrary divide between what was once protection given to marks because of their function and trademarks that were capable of registration based on whatever the statutory definitions happened to be.

³¹⁰ Paris Convention for the Protection of Industrial Property, 20 Mar 1883, 21 UST, 828 UNTS 305.

³¹¹ GHC Bodonhausen, *Guide to the application of the Paris Convention for the Protection of Industrial Property* (WIPO/BIRPI 1968) pg 9.

³¹² This could also be one explanation as to why the trademark registration schemes of the day focused so heavily on the use of trademarks in written medium. Indeed, it was not unusual to explicitly bound trademarks within a definition that has been styled the 'technical trademark'. Definitions of the time inevitably began with word, devices, numbers, letters, logos, and slogans, even where the protection afforded to other forms of indications and marks was already well established in the jurisdiction. Holdovers from those days still exist in modern jurisprudence.

³¹³ See generally, Congressional Globe, 41st Congress 2nd Session 4821 (1870); Bently, *Marking of modern trademark* (n 307) pg 7 *et seq.*

In most cases, this arbitrary divide was reinforced by the restrictive definitions of marks employed in the legislation that were limited to signs, logos, names, words, and numbers. For example, the United Kingdom Trade Mark Registration Act of 1875, section 10 articulated that

a trade-mark consists of one or more of the following essential particulars; that is to say, a name of an individual or firm printed, impressed, or woven in some particular and distinctive manner; or a written signature, or copy of a written signature, of an individual or firm; or a distinctive device, mark, heading, label, or ticket, and there may be added to any one or more of the said particulars any letters, words, or figures, or combination of letters, words, or figures; also any special and distinctive word or words, or combination of figures or letters, used as a trade-mark before the passing of this Act may be registered as such under this Act.³¹⁴

Similar standards were incorporated into other national trademark statutes including the concepts such as ‘technical trademarks’,³¹⁵ and ‘naturlige merker’.³¹⁶ Because of these rather restrictive definitions, and other issues, the protection of marks developed in a rather parallel yet separate manner. On the one hand protection was provided through the mechanisms of registration, on the other through the broader protections styled as falling under the umbrella of ‘unfair competition’, ‘concurrance déloyale’, and ‘palming off’.

When describing the effect of the first trademark acts in the United Kingdom, Lionel Bently stated that ‘[a]lthough the two Acts and the Select Committee constitute key developments in the period, trade mark protection was being developed apace in other fora.’³¹⁷ The ‘other fora’ that Bently refers to here is the common law protections provided pre-statute. In the UK this first took the form of testing of the bounds of the registration system and finding protection by placing marks outside of the requirements of registration found in the Acts. Thus relying upon the pre-statutory protections that were not affect by the legislation.³¹⁸ In the US this maneuvering was unnecessary as the

³¹⁴ Trade Mark Registration Act 1875 (UK) section 10.

³¹⁵ McCarthy (n 225) §4:4, §5:3.

³¹⁶ See Ot.prp.nr.6, utkast til lov om varemerker og om utilbørlige varekjendtegn og forretningsnavne (1908).

³¹⁷ Bently, *Marking of modern trademark* (n 307) pg 11.

³¹⁸ Id., pgs 34-36.

unreserved preservation of pre-statutory protection was specifically written into the statutory instrument. Section 4945 of the 1870 trademark provisions states –

Former Rights and Remedies preserved. – Nothing in this chapter shall prevent, lessen impeach, or avoid any remedy at law or in equity, which any party aggrieved by any wrongful use of any trademark might have had if the provisions of this chapter had not been enacted.³¹⁹

The preservation of the pre-statutory/registration rights and remedies remained substantially the same throughout the iterations of the trademark acts in the United States.³²⁰

Essentially, trademark protections established prior to statutory regimes progressed and developed alongside any protections provided by registration – whether that be through mark holders attempts to avoid the statutory system or by integration of those protections directly into the statutory system. However, the overlap between the two bases of protection was substantial and resulted in courts employing substantially similar, or identical, tests and justifications irrespective of registration.³²¹

Though, ‘[l]imiting the initial coverage of the registration system to a specific types of signs seemed sensible, given the impossibility of predicting confidently how the system would operate and what its impact would be,’³²² these strict divisions between the registration schemes, or rather the understanding of trademarks as seen through registration schemes, and the broader protections provided to marks by other legal mechanisms began to attract criticism and blur almost immediately. As stated by Bently in respect to the United Kingdom Acts –

The passage of the 1875 Act was by no means the end of the debates over the definition of a trade mark. In fact, the registration processes intensified

³¹⁹ United States Trademarks Act of 1870 section 4945, Rev.Stat., ch. 2.

³²⁰ Sections 10 of the 1881 Act, and 23 of the 1905 Act; additionally, pre-statutory/registration rights are preserved in the current US Trademark Act by virtue of it not preempting the law of the States (see generally *McCarthy* (n 225), §22:2) and by through its section 43 (15 USC 1125) relating to broader unfair competition claims.

³²¹ See generally, *Weinstock, Lubin & Co v Marks*, 109 Cal 529 (Cali Sup 1895); *Cook & Bernheimer Co v Ross*, 73 F. 203 (SDNY Circuit Court 1896); *Chartreuse Cases – Baglin v Cusenier*, 221 US 580 (1911), 12 F 78 (7th Cir 1903), 141 F 497 (2nd Cir 1905), 156 F 1016 (SDNY Circuit Court 1907), 164 F 25 (2nd Cir 1908), *Rey v Lecouturier*, [1908] 2 Ch 715 (Court of Appeal), [1910] AC 262 (House of Lords).

³²² Bently, *Modern marking of trademark* (n 307), pg 34.

the amount of discussion over what could be protected as a trade mark. With many thousands of applications, the registrars were required to make many thousands of decisions.³²³

This is not entirely surprising considering that marks which up to that point in time would have been considered protectable found no home in the new registration system. Indeed, instances of the protection of marks such as packaging,³²⁴ trade dress,³²⁵ and unique product shape³²⁶ can be found well prior to and during the institution of registration schemes. This tension was not unnoticed by the courts or commentators. Oliver R Mitchell, when discussing ‘dressing up’ cases, took the view

... that they are in reality trade mark cases of a rather refined sort, too late upon the scene to obtain admittance where they belong, for it is impossible to draw any distinction of principle between an unregistered trade mark, which indicates the origin of the article to which it is applied, and the “dress” of an article, which equally and in the same way serves to indicate origin. Whatever distinction there may be, it cannot be said to be of much practical importance ...³²⁷

Indeed, national courts seemed to agree with Mitchell’s analysis and viewed these distinctions between registered marks and other distinctive indications as largely a moot point in practice. ‘That certain names and designations which may not become technical or specific trade-marks may become the names of articles or of places of business, and thereby the use therefore receive the protection of the law, cannot be doubted, for the cases everywhere recognize that fact.’³²⁸

Even where there were definitive rights as composed through the statutory understanding of a trademark, the Courts easily justified judicial interference to prevent other forms of infringement.

It may be that the plaintiffs have avoided liability for an infringement of the name of the article as a trade mark; and yet it is manifest, as found, that

³²³ Id., pg 33.

³²⁴ *Blofeld v Payne*, 110 ER 509 (1833); *Walton v Crowley*, 3 Blatchf 440 (SDNY Circuit Court 1856).

³²⁵ *Knott v Morgan*, 48 ER 610 (Ct of Chancery 1836); *Weinstock, Lubin & Co v Marks*, 109 Cal 529 (Cali Sup Ct 1895).

³²⁶ *Cook & Bernheimer Co v Ross*, 73 F 203 (NY Circuit Court 1896).

³²⁷ Oliver R Mitchell, *Unfair Competition* (1896) 10 Harvard Law Review 275, 284; see also *Rogers* (n 39), pg 110.

³²⁸ *Weinstock, Lubin & Co v Marks*, 109 Cal 529, 535-6 (Cal Sup Ct 1895); see also, *Coats v Thread Co*, 149 US 562, 566 (1893).

they have adopted such a course as is calculated to secure a portion of the good-will of the defendants' business---to which they have no moral right at least. Competition in business is justifiable and desirable; but a business built up by one man, by the use of peculiar packages [*author's note: in this matter the unique shape of bottles*] and names, should not be appropriated by another by contrivances which, although not strictly within the rule of liability, yet are designed to accomplish a purpose equally injurious.³²⁹

In the years following the establishment of the registration systems '[a] large number of cases also made their way to court. All this activity threw up inconsistencies of interpretation and exposed difficulties of application,³³⁰ eventually prompting statutory reform in 1883 and again in 1888 [in the United Kingdom].'³³¹ A similar trend of increased trademark cases could be seen in the United States, with fourteen cases between 1805 and 1835, fifty-nine cases between 1835 and 1855, then one-hundred four between 1855 and 1865, and one-hundred eight between 1865 and 1875, with the similar effect of highlighting the inconsistencies and inadequacies in the registration regime of the day.³³²

Attempts to rectify the conflicts between the registration systems and the existing protections of marks are evidenced in many different statutory changes between the late 1800s and early 20th century. From its initial statute on the protection of marks in 1862³³³, the United Kingdom's trademark statute saw changes in 1875, 1883, 1888, 1905, 1919, and 1938.³³⁴ In the United States amendments were made to trademark statutes in 1870, 1876, 1881, and 1905.³³⁵ And, Norway saw amendments to trademark

³²⁹ *Wolfe v Bruke*, 56 NY 115, 122 (Court of Appeals of NY 1874).

³³⁰ Mitchell, (n 327) – 'There is another consequence of the earlier development of trade mark law to which it is important as a practical matter to direct attention, namely, the firm hold which the strict rules of technical trade mark and the trade mark terminology have acquired in the legal mind, with the consequent and very confusion result that a great number of Unfair Competition cases are argued and decided in terms of trade marks, while other cases of Unfair Competition are tried and decided upon theories applicable only to technical trade mark cases.' at 276.

³³¹ Bently, *Modern marking of trademark* (n 307), pg 33.

³³² Charles E. Coddington, *A Digest of the Law of Trademarks, as presented in the Reported Adjudications of the Courts of the United States, Great Britain, Ireland, Canada, and France, from the earliest period to the present time; together with an appendix containing the United States statutes and the Treaties of the United States concerning trademarks, and the rules and forms of the United States Patent Office for their registration*, (Ward & Peloubet, 1878), preface vii.

³³³ Merchandise Marks Act 1862 (UK).

³³⁴ excluding more modern amendments.

³³⁵ excluding more modern amendments.

protections in 1884, 1898, and 1910, and 1936.³³⁶ Most of these changes arose from a refined understanding where the newly crafted statutory 'trademark' was actually positioned within the broader context of the protection of distinguishing marks – a context which predated statutory regimes and from which they were initially birthed.

In the preparatory works to the 1910 Norwegian varemerkeloven this new understanding was formulated as -

Som resultat av de sidste aartiers udvikling, praktisk og teoretisk, paa dette omraade kan det fastslaas, at man er naadd til en stadig almindeligere erkjendelse av at de specielle varemerkelove ikke kan betragtes som et i sig selv avgrænset og afsluttet emne av væsentlig formel natur, men maa ses som et utslag av et almindelig retsprincip, hvis fulde anerkjendelse i det praktiske retsliv ikke er uttømt ved en varemerkelov i snevrere forstand. Det almindelig retsprincip, som der her er tale om, er princippet om retsstridigheten av <<concurrance déloyale>>, om det resstridige i konkurranse ved utilbørlige eller forkastelige midler.³³⁷

In justifying the amendments to registration systems as rectifying the place that trademarks hold within a larger context, legislators were actually rediscovering the underlying functional purposes of the protection of distinguishing marks that had been established as far back as premodern times. This is something that the courts had long recognised. Throughout the overall trademark precedent there is one overarching concern. As stated by the United Kingdom Court of Chancery in 1865

The fundamental rule is that one man has no right to put off his goods for sale as the goods of a rival trader. ... [H]e cannot, therefore...be allowed to use names, marks, letters, or other *indicia*, by which he may induce purchasers to believe that the goods which he is selling are the manufacture of another person.³³⁸

³³⁶ excluding more modern amendments.

³³⁷ Ot.prp.nr.6 (1908) pg 40 ('As a result of the development in the last years, both practical and theoretical, in this area it can be concluded, that there has been reached an increasingly common understanding that the special trademark laws can not be regarded as a self-defined and complete subject of materially formal nature, but must be seen as a manifestation of a common principle of law, whose full recognition in practical law is not exhausted by a trademark law in a narrower sense. The general principle of law, as the case may be, is the principle of the unlawfulness of <<concurrance déloyale>> of the opposition in competition of undue or reprehensible means.')

³³⁸ *Glenny v Smith*, 62 ER 701, 702 (Court of Chancery, July 18, 1865) (internal citations omitted).

This overall principle was also supported in the 1910 amendments to the original Norwegian trademark law –

Men dernæst: jo mere konkurranse utvikler sig, jo videre omsætningen brer sig og blir international, desto større betydning erholder alle de karakteristiske betegnelser for varerne, som uten at falde indenfor varemerkerne i snevrere forstand dog har lignende øiemed som disse, idet de skal tjene til rask og let at forvise kjøperen om varernes oprindelse eller beskaffenhet.

Der trænges – utaller kommissionen – ogsaa for disse betegnelser en vis retsbeskyttelse, hvis uredelighet i omsætningen paa virksom maate skal bli hindret. Den offentlige mening er ikke i tvil herom, og man maa derfor vistnok gi det sin tilslutning, at lovgivningen erholder en fuldstændiggjørelse derhen, at man utenfor den snevrere varemerkebeskyttelse ogsaa forøvrig søker at motvirke de misbruk, som den uredelige konkurranse pleier at benytte sig av for at skaffe sine frembringelser at omdømme, som skyldes fremkaldelse av en forveksling.³³⁹

This realignment of the statutory regimes with more foundational trademark principles was a welcome and possibly necessary change. It was not lost on scholars of the day that the restrictive statutory and registration schemes were having certain ill effects. Perhaps the most colourful criticism of the understanding of trademarks built upon registration and statutory schemes was laid down by Edward S Rogers when he stated that

[w]hile the registration of a legally valid and practically efficient trade-mark is of undoubted value, it is unfortunate that an undue emphasis is put upon registration by many persons who either have no real notion of what a trade-mark is and how the right to it is acquired, or who expect to charge fees for securing a government certificate decorated with seals and ribbons. A certificate of trade-mark registration is made a fetish by many who look upon a trade-mark as an end in itself rather than a means to an end, to whom some inefficient and purposeless symbol is a thing to be striven for, nurtured and safeguarded.³⁴⁰

³³⁹ Ot.prp.no.6 1909, pg 41 ('But then, the more competition is evolving, the more the revenue grows and becomes international, the greater the significance of all the characteristic designations of the goods, which without falling within trademarks in the narrow sense, however, have the same appearance as them, in that they serve to quickly and easily assure the buyer of the goods origin or nature. There needs, according to the commission, to be a certain legal protection for these designations, if fraud in trade shall be hindered. Public opinion is in no doubt about this, and one must therefore probably give its approval, that the legislation receives a completion to that effect, that outside of the narrower trademark protection, one also otherwise seeks to counteract the misuse, that unfair competition tends to make use of to acquire to its creations that reputation, which is due to the inducement of a confusion').

³⁴⁰ Rogers (n 39), pg 35.

This emphasis on the trademark certificate and registration when viewed through the lens of enforcement and protection is of limited usefulness, and possibly irrelevant, without other factors that attract the protection of distinguishing marks. Yet, the focus of the time upon certificates is perhaps not that surprising considering some of the original motivations for acquiring a certificate – one such as the ability to have a trademark recognised in foreign countries through the certificate.³⁴¹

The recognition of trademarks in States abroad was primarily achieved through the network of bilateral treaties and the Paris Convention system. However, modifications of trademark instruments in line with a more holistic view of their place within the law was also occurring at the international level. The Paris Convention was drafted from the beginning to allow for periodic revisions and from its signing in 1883 to 1911 six conferences took place which resulted in modification of the Convention.³⁴² These conferences resulted in various protocols, as well as revised Conventions in 1900 (the Brussels Act), and 1911 (the Washington Act).³⁴³

The 1883 text of the Paris Convention was fairly limited in scope with, as far as trademarks were concerned, focus upon the mutual recognition of registered trademarks.³⁴⁴ Although, it did also incorporate protection for trade names³⁴⁵ and limited false designation of origin protections.³⁴⁶ By the time of the Washington Act in

³⁴¹ Congressional Globe, 41st Cong 2nd Ses 4821 (1870).

³⁴² Professor GHC Bodenhausen, *Guide to the Application of the Paris Convention for the Protection of Industrial Property as Revised at Stockholm in 1967* (BIRPI, 1968) pg 9.

³⁴³ Revision of the Paris Conventions continued including the Hague Act (1925), London Act (1934), Lisbon Act (1958) and Stockholm Act (1967). Generally historical versions of the Paris Conventions are available at <http://www.wipo.int/wipolex/en/details.jsp?id=12633>.

³⁴⁴ Article 6 – Every trade or commercial mark regularly deposited in the country of origin shall be admitted to deposit and so protected in all the other countries of the Union. Shall be considered as country of origin, the country where the depositor has his principal establishment. If this principal establishment is not situated in one of the countries of the Union, shall be considered as country of origin that to which the depositor belongs. The deposit may be refused, if the object, for which it is asked, is considered contrary to morals and to public order. (text taken from US 25 Stat 1372, Treaty Series 379).

³⁴⁵ Article 8 – The commercial name shall be protected in all the countries of the Union without obligation of deposit, whether it forms part or not, of a trade or commercial mark. (text taken from US 25 Stat 1372, Treaty Series 379).

³⁴⁶ Article 10 - The provision of the preceding article [on the seizure of imported goods] shall be applicable to every production bearing falsely as indication of origin, the name of a stated locality, when this

1911, however, the text had expanded to include more general elements of mark protection as well as protection not originally found within statutory schemes, such as a definitive prohibition against marks ‘devoid of all distinctive character’,³⁴⁷ the filing and protection of collective marks,³⁴⁸ and a general prohibition against unfair competition.³⁴⁹

A clearer understanding of statutory and registration schemes requires placing them within this internationally connected developing context and understanding the motivations behind their establishment. The statutory schemes developed initially from a system based on a very restricted and narrow definition of a trademark – a new conception as to definition that was created by the statutes, but certainly not a new creation of rights. This was motivated primarily by the desire for simplicity, the reduction of rights to a register number, and the convenience that would bring with protection in other jurisdictions. While registration offered certain benefits, in practice the Courts found ever more justifications for their intervention in matters substantially similar to infringement of the newly crafted, narrow, trademark, yet falling outside of the narrow statutory scheme. Essentially, the Courts were continuing to implement pre-statutory protection principles overlain with a new statutory structure that applied in a narrow manner.

indication shall be joined to a fictitious commercial name or a name borrowed with fraudulent intention. Is reputed interested party every manufacturer or trader engaged in the manufacture or sale of this production, when established in the locality falsely indicated as the place of export. (text taken from US 25 Stat 1372, Treaty Series 379).

³⁴⁷ Washington Act 1911, Article 6(2). – [However, there may be refused or invalidated:] 2. Marks devoid of all distinctive character, or even composed exclusively of signs or data which may be used in commerce, to designate the kind, quality, quantity, destination, value, place of origin of the products or the time of production, or become common in the current language or the legal and steady customs of commerce of the country where the protection is claimed. In the estimation of the distinctive character of a mark, all the circumstances existing should be taken into account, particularly the duration of the use of the mark. (text taken from US 38 Stat 1645, Treaty Series 579).

³⁴⁸ Washington Act, 1911, Article 7.5. – The contracting countries agree to admit for filing and to protect marks belonging to associations the existence of which is not contrary to the law of the country of origin, even if these associations do not possess an industrial or commercial establishment. Every country shall be judge of the special conditions under which an association may be admitted to have the marks protected. (text taken from US 38 Stat 1645, Treaty Series 579).

³⁴⁹ Washington Act, 1911, Article 10.5. – All the contracting countries agree to assure to the members of the Union an effective protection against unfair competition. (text taken from US 38 Stat 1645, Treaty Series 579).

This narrow definition of a trademark, one that was created by the statutory schemes, quickly began to change and accept more of the trademarks' original pre-statutory nature into the statutory fold. The statutory/registration defined trademark began to be placed in a more holistic, pre-existing, context which motivated changes to national legislation and international instruments.³⁵⁰ It became an imperfect return to pre-statutory protection principles.

3.4. The modern trademark system

The preceding sections articulated the background from which the modern trademark system developed and described the genesis of the trademark registration system at the same time as highlighting its separation from prior existing, and in most cases continuing to exist, protections for distinguishing marks.

Since the establishment of the nineteenth and early twentieth century registration mechanisms the law of trademarks has become an area increasingly concentrated upon, refined, and expanded. Yet much of that has been in furtherance of the registration of trademarks. Indeed, currently the registration of trademarks within national jurisdiction is standard and those registrations are supported by a well-developed international framework.

3.4.1. International aspects of the modern system

There is a great deal of scholarship on the international trademark system. It has proven to be a useful tool in coordinating the applications systems of various countries and is extensively used. However, it is outside the scope of this work to evaluate the international instruments to any great extent. This is primarily because the bulk of the international instruments dealing with trademarks are concerned with the coordination and standardization of registrations and applications for registrations. They are presented here merely to exhibit the growth of trademark law on a large scale.

The international mechanisms for registration of trademarks began in 1891 with the Madrid Agreement Concerning the International Registration of Marks, which was

³⁵⁰ See, lov no. 5 av 2 Jul 1910 om varemerker og om utilbørlige varekjendetegn og forretningsnavene "varemerkeloven 1910", §§ 10, 23, 24 *et seq.*

supplemented by the Madrid Protocol³⁵¹ in 1989. Together these instruments govern what is commonly termed the ‘Madrid System’ which ‘makes it possible to protect a mark in a large number of countries by obtaining an international registration that has effect in each of the designated Contracting Parties.’³⁵² This description, however, is a bit of a misnomer as the Madrid system is much more akin to an administrative mechanism. Applications filed within the Madrid System must be based off of a national office registration³⁵³ or application.³⁵⁴ The application is then forwarded to member countries that have been designated in the Madrid System application where it will then undergo substantive review according to the national law within that each designated member country. Essentially, the Madrid System is a coordination of filings, with a minimum standard of basic review, combined with multilateral recognition.

This is not to say that the Madrid System does not carry with it great advantages. Indeed, the main advantages are listed in the Guide to the International Registration of Marks Under the Madrid Agreement and the Madrid Protocol.³⁵⁵ Specifically, the system requires only one formal application in one language, which results in one registration. Changes to this registration, including address, name, and ownership changes, are made only once, instead of to multiple registrations if the trademark holder had separate registration in all designated countries. It is also claimed that the system allows for ‘simplicity and financial savings’.³⁵⁶

Other international instruments have also been implemented that deal in the modern protection of trademarks, including the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks,³⁵⁷ the Vienna Agreement Establishing an International Classification of the Figurative Elements

³⁵¹ Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks – 27 Stat 958, Treaty Series 385 (‘Madrid Protocol’).

³⁵² WIPO at <http://www.wipo.int/treaties/en/registration/madrid/> (last accessed 30 July 2017).

³⁵³ Madrid Agreement Concerning the International Registration of Marks, as amended on 28 September 1979, Article 1(2).

³⁵⁴ Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks Article 2 (27 Stat 958, Treaty Series 385).

³⁵⁵ WIPO Publication No. 455(E)/22 (WIPO 2022) available at <https://www.wipo.int/publications/en/details.jsp?id=4600&plang=EN> (last accessed 20 June 2024).

³⁵⁶ Id. at pg A.4.

³⁵⁷ June 15, 1957, TRT/NICE/004; currently as amended on September 28, 1979 TRT/NICE/001.

of Marks,³⁵⁸ and the Trademark Law Treaty.³⁵⁹ These instruments, however, are again concerned with harmonizing the registration of marks and have minimal impact on the substantive rights or protection afforded to trademarks.

With regard to the substantive nature of trademarks there are primarily two international two international instruments that must be taking into account. The first being the Paris Convention, introduced above, and the other being the TRIPS Agreement.³⁶⁰ The Paris Convention incorporated the protection of ‘well-known marks’,³⁶¹ service marks,³⁶² collective marks,³⁶³ and unfair competition³⁶⁴ into the international conception of trademarks, as well as the prohibition against registration of certain official emblems.³⁶⁵ The TRIPS Agreement provided certain minimum international substantive standards to the nature of trademarks, including protectable subject matter,³⁶⁶ conferred rights,³⁶⁷ term of protection,³⁶⁸ and use requirements.³⁶⁹ However, like other international instruments the TRIPS Agreement is again mostly concerned with registered marks.

3.4.2. The modern system at the state level

At the State level the solidification and growth of registration systems was no less hindered. This was especially driven by the development of two different legislative models for the acquisition of trademark rights – those being rights derived through *use* of a trademark, and rights resulting from the trademark *registration* itself. By way of example, in France the system of mark protection began, as was previously mentioned,

³⁵⁸ June 12, 1973, TRT/VIENNA/002; currently as amended on October 1, 1985, TRT/VIENNA/001.

³⁵⁹ October 27, 1994, TRT/TLT/001; the Trademark Law Treaty has little to do with the ‘law’ of trademarks. Instead, it is described by WIPO as a document ‘to standardize and streamline national and regional trademark registration procedures.’. <http://www.wipo.int/treaties/en/ip/tlt/> (last accessed 20 June 2024).

³⁶⁰ Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS Agreement), Annex 1C of the Marrakesh Agreement Establishing the World Trade Organization, 1869 UNTS 299, 33 ILM 1197 (1994).

³⁶¹ Id., Article 6*bis*.

³⁶² Id., Article 6*sexies*.

³⁶³ Id., Article 7*bis*.

³⁶⁴ Id., Article 10*bis*.

³⁶⁵ Id., Article 6*ter*.

³⁶⁶ Id., Article 15.

³⁶⁷ Id., Article 16.

³⁶⁸ Id., Article 18.

³⁶⁹ Id., Article 19, 20.

through the implementation of the *Manufacture and Goods Mark Act* in 1857.³⁷⁰ This system was formulated upon the principle that protectable rights arose from the use of a mark. In 1964 France implemented a new trademark system that changed the underlying principle to the acquisition of trademark rights alone through the registration of the mark. This registration based system has continued and is now enshrined in the *Code of Intellectual Property*.³⁷¹

One of the most visible evolutions of registration systems is that implemented within the European Union. The EU efforts to establish a harmonized trademark registration system throughout the common market began with the European Trademarks Directive³⁷² which established a unitary system of trademark registration. This system was governed by the Community Trade Mark ('CTM') Regulation.³⁷³ Recently the EU has undergone amendment to its trademark law and implemented a new Directive³⁷⁴ and Regulation.³⁷⁵ In stark contrast to the international instruments the EU system deals not only with the mechanism of registration of trademarks, but also with the substantive rights and obligations afforded trademark owners.

When viewing the trademark protection systems of jurisdictions based upon rights through registration it is imperative to note that the tensions that were manifest in the late-eighteen century and early nineteenth century do not present themselves to the same extent today. The current registration systems of registration-based jurisdictions are not those restrictive-definition based methods of one hundred or more years ago.

³⁷⁰ *Manufacture and Goods Mark Act*, 1857, France.

³⁷¹ Article L712-1 *et seq.* Available at https://www.legifrance.gouv.fr/codes/section_lc/LEGITEXT000006069414/LEGISCTA000006161746/ (last accessed 20 June 2024).

³⁷² First Council Directive 89/104/EEC of 21 Dec 1988, codified as European Parliament and Council Directive No. 2008/95/EC of 22 Oct 2008.

³⁷³ Council regulation No 40/94 of 20 Dec 1993, codified as Council Regulation No 207/2009 of 26 Feb 2009.

³⁷⁴ European Parliament and Council Directive 2015/2436 of 16 Dec 2015 to approximate the laws of the Member States relating to trade marks.

³⁷⁵ Regulation of the European Parliament and Council 2015/2424 of 16 Dec 2015 amending Council Regulation (EC) No 207/2009 on the Community trade mark and Commission Regulation (EC) No 2868/95 implementing Council Regulation (EC) No 40/94 on the Community trade mark, and repealing Commission Regulation (EC) No 2869/95 on the fees payable to the Office for Harmonization of the Internal Market.

Indeed, the definitions of contemporary registration-based systems are quite expansive and include marks that were arguable outside of the scope of trademark protection under the historical systems.

For instance Article L711-1 of the present day French Code of Intellectual Property articulates the ‘Constituent Elements of Marks’ –

A trademark or service mark is a sign capable of graphic representation which serves to distinguish the goods or services of a natural or legal person.

The following, in particular, may constitute such a sign:

- a) Denominations in all forms, such as: words, combination of words, surnames and geographical names, pseudonyms, letters, numerals, abbreviations;
- b) Audible signs such as: sounds, musical phrases;
- c) Figurative signs such as: devices, labels, seals, selvedges, reliefs, holograms, logos, synthesized images; shapes, particularly those of a product or its packaging, or those that identify a service; arrangements, combinations or shades of color.³⁷⁶

As can be clearly seen this is not the narrow conception of a protectable trademark of the era of the genesis of trademark registration systems. Indeed, the controlling elements of the French definition are essentially restricted only by a sign being capable of graphic representation and that it be used by a legal or natural person.

Similarly, the EU has implemented a broad definition of what a trademark may be.

Article 3 of the EU Directive 2015/2436 states –

A trade mark may consist of any signs, in particular words, including personal names, or designs, letters, numerals, colours, the shape of goods or of the packaging of goods, or sounds, provided that such signs are capable of:

- a) distinguishing the goods or services of one undertaking from those of other undertakings; and
- b) being represented on the register in a manner which enable the competent authorities and the public to determine the clear and precise subject matter of the protection afforded to its proprietor.³⁷⁷

³⁷⁶ Code of Intellectual Property, Book VII Trademarks, Service Marks and Other Distinctive Signs, Title I – Trademarks and Service Marks, Chapter II – Acquisition of Rights in Marks, Article L711-1 (France).

³⁷⁷ EU Directive 2015/2436, Article 3.

The operative elements of the EU definition are even more lenient than found in the French Code. As seen, a mark under the EU Directive is limited only by it being a 'sign' capable of 'distinguishing' and being 'represented on the register'. It must be noted here, however, that marks under these systems, in common with other similar systems, are both limited by a number of grounds for refusal, such as being devoid of distinctiveness, genericness, and contrary to public good.³⁷⁸

These expansive definitions evidence an evolution of the registration systems to encompass a broader range of possible marks motivated by the underlying functions of a trademark. This harkens back to the statements made within the preparatory works of the Norwegian 1910 *varemerkeloven* that trademarks must be placed within a wider general rule of law – 'Det almindelig retsprincip, som der her er tale om, er princippet om retsstridigheten av <<*concurrance déloyale*>>, om det retsstridige i konkurranse ved utilbørlige eller forkastelige midler'.³⁷⁹

While certain jurisdictions implemented trademark protection systems based upon the rights through registration model, jurisdictions that based their trademark law on a rights through use model were developing in parallel, and indeed in coordination through international cooperations.³⁸⁰ The rights through use model is primarily attached to English common law jurisdictions and finds its home in England and its former colonies, including the United States. As has been previously mentioned the Federal statutory trademark schemes in the United States specifically preserved the common law mark protection.³⁸¹ Yet even within rights through use jurisdictions the restrictive statutory definitions of old have likewise been abandoned in favour of more expansive trademark foundations.

³⁷⁸ EU Directive 2015/2436, Articles 4-5; Code of Intellectual Property, Book VII Trademarks, Service Marks and Other Distinctive Signs, Title I – Trademarks and Service Marks, Chapter II – Acquisition of Rights in Marks, Articles L711-2 – L711-3.

³⁷⁹ Ot.prp.nr.6 (1908) pg 40, ('The general principle of law, spoken of here, is the principle of the unlawfulness of <<*concurrance déloyale*>>, of the unlawfulness in competition with undue or reprehensible means.').

³⁸⁰ such as the Madrid System, Paris Union, and WTO.

³⁸¹ United States Trademarks Act of 1870 section 4945, Rev.Stat., ch. 2.

The current definitions used in the United States' trademark statute – the 'Lanham Act'³⁸² set out a much broader scope for trademarks than seen in older iterations -

Title 15 section 1127 of the United States Code articulates that trademarks within the Act are defined as

...any word, name, symbol, or device, or any combination thereof –

- (1) used by a person, or
- (2) which a person has a bona fide intention to use in commerce...
to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown.³⁸³

Where person 'includes a juristic person as well as a natural person. The term "juristic person" includes a firm, corporation, union, association, or other organization capable of suing and being sued in a court of law.'

This definition is undoubtedly broader than that used in the original US trademark registration system of 1870. Notwithstanding, it must be remembered that the Lanham Act is nonetheless somewhat limited in its scope. The Lanham Act is primarily an act regulating the registration of trademarks at the federal level.³⁸⁴ Thus, the definition of a trademark in 15 USC 1127 is not controlling on the entire trademark law of the United States but merely upon the registration of marks with the United States Patent and Trademark Office.³⁸⁵

This is the single largest difference between jurisdictions based on a right through use, and right through registration model – in one the trademark statute controls all relevant trademark law, in the other it only applies specifically to the registration of, or registered, trademarks. In rights through use jurisdictions a registration is merely a means of unlocking certain benefits contained in the statute, not of establishing the

³⁸² Title 15, Chapter 22 of the United States Code (15 USC 1051 *et seq.*).

³⁸³ 15 USC 1127

³⁸⁴ The Lanham act also contains other protections such as section 43 (15 USC 1125) regarding false designations of origin, false descriptions, and dilution.

³⁸⁵ Of course the case law precedent concerning Lanham Act issues is highly persuasive in instances of the protection of marks outside of the preview of the Lanham Act.

substantive rights to a mark. The statements of Rogers is just as current today as it was when made in 1914 –

Registration creates no rights in a trade-mark. The right to the mark depends upon priority of adoption and use. Registration is simply a public record of a claim of right already acquired. Registration does not confer a government monopoly analogous to patent and copyright. It deprives no one of any rights possessed before, and confers upon the registrant no property rights that he would not have without such registration. If the registrant is not the owner of the mark, the registration does not make him the owner.³⁸⁶

Rogers' conclusions as to the nature of the US trademark system was recently echoed by the US Supreme Court in the case of *Matal v Tam* – 'Federal law does not create trademarks. Trademarks and their precursors have ancient origins, and trademarks were protected at common law and in equity at the time of the founding of our country.'³⁸⁷

In the Nordic countries the trademark protection regime exhibits a type of hybrid between a rights through use and through registration system. In Norway³⁸⁸ the rights to the protection of marks, at least in the trademark context, are contained in the 2010 *varemerkeloven*³⁸⁹ which enumerates the protections afforded marks within the Kingdom of Norway. *Varemerkeloven* employs a broad definition of marks that can act as trademarks, similar to other rights through registration jurisdictions.

§2 *Tegn som kan være varemerke*

Et varemerke kan bestå av alle slags tegn som er egnet til å skille en virksomhets varer eller tjenester fra andres, for eksempel ord og ordforbindelser, herunder salgord, navn, bokstaver, tall, figurer, avbildninger, farger og lyder, eller en vares form, utstyr eller emballasje.³⁹⁰

³⁸⁶ Rogers (n 39) pg 109.

³⁸⁷ *Matal v Tam*, 137 S.Ct. 1744, 1751 (2017).

³⁸⁸ Norway is used as an example, however, the principles apply equally to the Sweden, Finland, and Denmark given the manner in which the *varemerkeloven* was negotiated and implemented. This is discussed in more depth in section 6.3.3.

³⁸⁹ Lov 26 mars 2010 nr.8 om beskyttelse av varemerker (*varemerkeloven*). *Varemerkeloven* can translate into English as 'the Trademark Law'.

³⁹⁰ Lov 26 mars 2010 nr.8 om beskyttelse av varemerker (*varemerkeloven*), §2. ('§2 Signs that may be a trademark – A trademark can consist of all kinds of signs that are suitable to distinguish one undertaking's goods or services from another's, for example words and combinations of words, including sales words, names, letters, numbers, figures, images, colour, and sounds, or a products shape, equipment or packaging.' The use of the term 'undertaking' in this translation is explored in section 6.3.4.3).

However, unlike rights through registration systems, unlocking the benefits of protection contained in *varemerkeloven* can be done through registration or through establishment (*'innarbeidelse'*).³⁹¹

Varemerkerett kan oppnås for hele riket ved registrering i varmerkeregisteret etter bestemmelsene i kapittel 2.

...

Varemerkerett oppnås uten registrering når markedet er innarbeidet. Et varemerke anses innarbeidet når og så lenge det i omsetningskretsen her i riket for slike varer eller tjenester det gjelder, er godt kjent som noens særlige kjennetegn. Foreligger innarbeidelse bare i en del av riket, gjelder eneretten bare for dette området.³⁹²

This provision provides a means for the protection of unregistered marks unique to Norway, and by way of the cooperation in trademark lawmaking other Nordic countries,³⁹³ and places it between a strict rights through registration system and a rights through use one. However, as can be seen, the unregistered rights come with geographic and temporal restrictions at their foundation through statute.

Having thus emphasized the single largest difference between jurisdictions based on a rights through use, and rights through registration model, it is for the present purposes cardinal to, at the same time, underline one thing that is common to all trademark system – including those that rely heavily on the registration model - is the statutory acceptance of a more expanded and inclusive conception of what may constitute a trademark. Contemporary trademark systems have abandoned the form restrictions that were seen earlier and instead render protection contingent upon the functional abilities of a mark. In this aspect of both systems the general principles of trademark

³⁹¹ Lov 26 mars 2010 nr.8 om beskyttelse av varemerker (varemerkeloven), §3. (*'innarbeidelse'* can be translated as *'establishment'*).

³⁹² Vml. §3 (*'Trademark rights can be obtained for the entire Kingdom with registration in the trademark register in accordance with the provisions in Chapter 2. ... Trademark rights are obtained without registration when the mark is established. A trademark is considered to be established when and so long as, in the trade area here in the Kingdom for such goods or services, it is well known as the particular mark of someone. If the establishment is for only a part of the Kingdom, the exclusive right is only in that area.'*).

³⁹³ The cooperation of Nordic countries in the drafting and implementation of trademark law is explored in section 6.3.3.

law, which are discussed below, can be seen and the focus on a mark performing trademark functions is the primary concern.

Some commentators have been critical of these broader definitions, claiming that ‘courts and the Patent and Trademark Office, and to a lesser extent Congress, have gradually relaxed these limitations and have allowed the registration and protection of slogans, trade names, and trade dress as trademarks. We can explain some of this expansion by stretching trademark’s traditional deception-based rationale.’³⁹⁴ Additionally, resistance to an expanded definition of what can constitute a trademark has been criticized as being ‘premised on a “falsely imagined past”’.³⁹⁵ Though it must be noted that much of the current debate surrounding the trademark definition, including an expanded nature of statutory ‘trademarks’ and the recompensible harms, is couched in the controversy of whether trademarks are property or not.³⁹⁶ These positions are explored in more depth below and for the moment it is sufficient to appreciate that the definitions of trademarks used in contemporary legislative models have shifted towards a focus upon the function of a mark, or rather returned to pre-statutory understanding of function, as the primarily defining factor.

3.4.3. The modern system in context

The prior sections review the systems that were in place to protect marks from premodern times up to today. The current system sees, at least as a starting point, a division between the rights through use and the rights through registration models at the national level and increasing coordination and mutual recognition of trademark registration systems through international instruments. Additionally, certain substantive features of trademarks have been agreed upon and included in various binding documents, including the Paris Convention and the TRIPS Agreement.

Within the context of the national systems there has been a consistent expansion of the foundational definitions in order to expand the scope of statutory trademark protections. Though this also occurred, to an extent, in jurisdictions employing a rights

³⁹⁴ Glynn S Lunney, ‘Trademark Monopolies’ (1999) 48(2) Emory Law Journal 367, 374.

³⁹⁵ McKenna (n 232) at 1847.

³⁹⁶ This is explored in Part 4.

through use model, much of the substantive nature of a trademark in rights through use jurisdictions is still found within the still relevant pre-statutory precedent.

The benefit of exploring the history of the protection of marks, and statutory trademarks, to such an extent is to place the registration schemes within an overall context. Prior to statutory registration schemes the protection of marks lived entirely within whatever mechanisms was employed to protect the general principle against unfair competition, unfair trading, and concurrence deloyale. That is not to say that trademarks as a concept did not exist, but rather that they found protection wherever they could find a cognisable claim. With the implementation of trademark registration systems the protections of distinguishing marks became fractured into those that were registrable and those that were protectable through other means. As was seen above, however, the initial definitions used by statutory registration schemes severely restricted the marks that were capable of registration, and non-registrable marks not uncommonly and perhaps consistently, found protection outside of the statutory regimes based on general principles of trademark law that remained intact.

States, legislators, and the international community responded to this divide by expanding the definitions in use by, and applicability of, the statutory schemes – bringing them more in line with the protections that were provided to marks prior to the establishment of registration regimes with a focus upon marks providing a protectable valuable function. This process was happening contemporaneously throughout the majority of jurisdictions of the world, as their actions and developments were intimately tied together in this context by bi-lateral treaties and formative international instruments which were arguably a central source of the motivation for the statutory trademark registration scheme.

It is this context that is important when attempting to understand the current state of trademark protection, as well as its application to the protection of indigenous intangible properties. As was outlined in section 1.3, the vast majority of commentators in this area approach the intersection between trademark protection and indigenous intangible property from the standpoint of trademark registration. However, this

approach does not fully examine the protections offered by trademarks and is often derailed by inputting requirements into the analysis that are applicable to registration concerns only. This is particularly true for jurisdictions where the trademark protection can be obtained absent a registration, but a holistic understanding of trademarks and their nature is not irrelevant for jurisdictions based on a rights though registration model. It must be remembered that ‘all trade-mark cases are in fact cases of unfair competition and the law of trade-marks is a part only of the broader subject of unfair trade; that unfair trade is the genus, trade-mark infringement is a species’.³⁹⁷ In Rogers’ day that species was quite small considering the restrictive definitions used in statutory schemes. In modern legislation those foundational definitions have expanded to identify more of the species. However, they do so not to stake claim to previously undiscovered protectable ground, but rather to bring into the statutory and registration fold more of what was already available under the overarching ‘genus’.

³⁹⁷ Rogers (n 39), pg 127. See also, S. Rep. No. 1333, 79th Cong., 2d Sess., 1946 U.S.C.C.A.N. 1275; *Hanover Star Milling v Metcalf*, 240 US 403 (1916) – ‘This essential element is the same in trademark cases as in cases of unfair competition unaccompanied with trademark infringement. In fact, the common law of trademarks is but a part of the broader law of unfair competition.’ at 413; *Two Pesos v Taco Cabana*, 505 US 763 (1992); Ot.prp.no 6 (1908); Oliver R Mitchell, *Unfair Competition* (1896) 10 HarvLRev 275 – ‘Logically speaking, the fact is that Unfair Competition is properly a generic title, of which trade mark is a specific division...’ at 275.

4. General principles of trademark protection

In the prior sections the development of trademark protections and protection regimes was explored. Beginning with premodern systems, it was seen that the use of distinguishing marks in antiquity provides valuable context with which to view the subsequent trademark protections systems. Despite commentators taking the view that premodern mark usage was merely a precursor to the modern trademark protection system, it was established that an evolutionary view of premodern marking did not take into account the functions of trademarks and were not supported by temporal claims of irrelevance.

From the premodern usage and protection of distinguishing marks sprung a web of statutory regimes and registration systems which developed in an environment of collaboration between State actors. While drawing from the pre-existing protection of distinguishing marks, these statutory schemes were restrictive as to their requirements for a 'trademark' and based their structures and protections upon formalities, application processes, and the goal of gaining a registration number. Some of these new systems specifically preserved the pre-existing protections within their operation, while others attempted to entirely eliminate them.

In the modern era these statutory and registration schemes divided into two primary judicial models, one based the rights to a trademark on registration, the other basing those rights on use supplemented by registration structures. Though these two models differ in their acquisition of trademark rights they both grew from, and maintain, connection with the general principles of trademark protection.

In this section those general principles are explored in depth and a fundamental and foundational definition of a trademark is articulated. These principles are reviewed with a view to the modern workings of the protection of distinguishing marks, however it is informed by the knowledge that these principles have been relatively consistent and by taking into account the precedent available throughout the legal history of the

protection of distinguishing marks. Additionally, it will be seen that these principles are applicable, and indeed discernable, in nearly all jurisdictions.

4.1. Function of a trademark

The modern system of trademark protection, whether in a rights through use or registration model, have evolved in the understanding of trademarks and their composition within by statutory schemes. Nearly universally statutory and registration systems have abandoned definitions that restrict forms or attributes of the marks themselves and have adopted a concept based on the foundational function that a mark serves and for what purpose.³⁹⁸ In order to understand trademarks then it is necessary to explore that function.

In various jurisdictions' legislative functional definitions of trademarks are found. For instance, the UK the Trade Marks Act 1994 defines a trademark as 'any sign capable of being represented graphically which is capable of *distinguishing* the goods or services of one undertaking from those of other undertakings'.³⁹⁹

The EU Directive 2015/2436 similarly states that '[t]he protection afforded by the registered trade mark, the function of which is in particular to guarantee the trade mark *as an indication of origin...*'⁴⁰⁰ and further that '[a] trade mark may consist of any signs capable ... of *distinguishing* the goods or services of one undertaking from those of other undertakings...'.⁴⁰¹ While in the US the Lanham Act articulates that

The term "trademark" includes any word, name, symbol, or device, or any combination thereof—

(1) used by a person,

...

³⁹⁸ See, *varemerkeloven* §1; 15 USC 1127; *Two Pesos, Inc v Taco Cabana, Inc*, 505 US 763, 769; *Boston Duck Tours, LP v Super Duck Tours, LLC*, 531 F3d 1, 12 (1st Cir, 2008); *Mercado-Salinas v Bart Enterprises Int'l, Ltd*, 852 Fsupp2d 208, 222 (D PR, 2012).

³⁹⁹ Trade Marks Act (UK) 1994 s1(1) (emphasis added).

⁴⁰⁰ Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Members States relating to trade marks (recast), (2015) OJ L 299/25, preamble 16. (emphasis added).

⁴⁰¹ *Id.*, article 2. (emphasis added).

to *identify and distinguish* his or her goods, including a unique product, from those manufactured or sold by others and to *indicate the source* of the goods, even if that source is unknown.⁴⁰²

In Norway, *varemerkeloven* states that 'Et varemerke kan bestå av alle slags tegn som er egnet til å *skille* en virksomhets varer eller tjenester fra andres...'.⁴⁰³

Definitions at the international level follow in much the same vein, such as the TRIPS agreement⁴⁰⁴ Article 15(1) –

Any sign, or any combination of signs, *capable of distinguishing* the goods or services of one undertaking from those of other undertakings, shall be capable of constituting a trademark.⁴⁰⁵

Whereas the WIPO Handbook section 2.318, for its part, provides possibly the broadest conception –

A trademark is any sign that individualizes the goods of a given enterprise and distinguishes them from the goods of its competitors.⁴⁰⁶

All of these definitions, and indeed the conception of a trademark in use currently, have two very basic elements in common. The first being that a trademark must indicate something – in most legislative models it must indicate the origin or source of a good or a service. Second, in order to do this, a trademark must be distinctive – it must be able to distinguish, or in the words of WIPO individualize, those good or services from others.⁴⁰⁷ Indeed, without a trademark being distinctive it utterly fails to achieve the goal of indicating that 'something'.⁴⁰⁸

While the statutory definitions provide a solid foundation from which to understand the protection of trademarks, and indeed have obvious authoritative weight, note must be

⁴⁰² 15 USC 1127 (emphasis added).

⁴⁰³ Lov av 26 mars 2010 nr.8 om beskyttelse av varemerker (varemerkeloven), §3. (emphasis added) ('A trademark can consist of all types of designations that are capable of distinguishing one undertaking's goods and services from another's...').

⁴⁰⁴ Annex 1C to the GATT, Agreement on Trade-Related Aspects of Intellectual Property Rights.

⁴⁰⁵ Annex 1C to the GATT, Agreement on Trade-Related Aspects of Intellectual Property Rights, Article 15(1).

⁴⁰⁶ *WIPO Handbook* (n 223), section 2.318 page 68.

⁴⁰⁷ See also, *Jack Daniel's Properties, Inc v VIP Products, LLC*, 143 S Ct 1578, 599 US ___, 2-3 (2023)

⁴⁰⁸ The use of 'something' here is intentional, as the concept of 'source' is explored below

taken of how these definitions are understood and employed in practice and by commentators. In many instances further conditional elements are added to the basic understanding of trademarks. In many cases these include connection to commerce, trade, and products, or manufacturers and traders.

McCarthy states that ‘a trademark is a designation used to identify and distinguish the source of goods and services of a *person or company*’.⁴⁰⁹ Similarly, case law suggests that ‘[a] trademark is a distinctive mark of authenticity, through which the *products of particular manufacturers ...* may be distinguished from those of others.’⁴¹⁰

With regard to Norwegian trademark protection Lassen / Stenvik state that ‘[t]radisjonelt har utgangspunktet for varemerkelovgivningen vært at hensikten med varemerkebruk er å *markere produktenes kommersielle opprinnelse*. Denne såkalte *opprinnelsesgarantifunksjonen* er fortsatt å betrakte som varemerkets hovedfunksjon.’⁴¹¹

Though commentators and judges may be attempting to make trademarks more understandable with increasingly specific definitions, and elements such as attachment to products, manufacturers, commerce and the like, further refinement of a trademark definition can prove unhelpful. Each trademark case is highly fact dependent. One must not cleave too tightly to commentator definitions for authoritative value without understanding the entire trademark context. They must also be read with a broader understanding of trademark protections as a whole, and how the statutory systems

⁴⁰⁹ McCarthy (n 225), §3:1 (emphasis added).

⁴¹⁰ *Slep-Tone Entertainment Corp v Kalamata, Inc*, 75 Fsupp3d 898, 902 (ND Ill 2014) (quoting *Hoopla Sports & Entertainment, Inc v Nike*, 947 F.Supp 347, 353 (ND Ill 1996)); The placement of registered trademarks in the US are indeed bounded by their use in commerce, yet it must be remembered that this is only for registered trademarks and the reasons for that have more to do with the constitutional limits of the Federal judiciary than the nature of a trademark. The power to regulate trademarks has been tied to the commerce clause of the US Constitution. Thus only marks falling within the bounds of use in interstate or international commerce are covered. This was the downfall of the 1870 act – see Trademark Cases.

⁴¹¹ Birger Stuevold Lassen og Are Stenvik, *Kjennetegnsrett* (Universitetsforlaget 2011) (‘*Kjennetegnsrett*’), pg 25. (‘Traditionally, the principle for trademark law making has been that the purpose of trademark use is to mark a product’s commercial origin. This so-called origin guarantee function is still considered as trademarks main function.’).

evolved, as has been discussed above. This is not least because the statutory definitions come with a multitude of exceptions that are necessary in order to create a solid functional base for justifying trademark protection, which are obscured in most trademark discourse and commentator created definitions. As is clear from the above, the authoritative sources on trademarks law have largely shied away from attempts to narrow the focus of trademark protection through conditional elements.

Two of those specific conditional elements that tend to be added to the popular understanding of trademarks require a more critical evaluation. The first being the concept of 'source' itself, and the other being anything of a 'commercial' nature.

4.2. Source

Already during the establishment and early refinement of the registration systems the concept of source was being brought into question. Though it must be remembered that at the time the concept of a trademark, and in turn source, as seen through the statutory schemes was quite restrictive. The oft heralded Frank Schechter specifically raised a concern with the idea of a trademark identifying a single source.

To say, as courts frequently do, that a trade-mark indicates either origin or ownership may have been an adequate explanation of its function to Gerard Malynes and his contemporaries, but today only by ignoring realities can one say that to the consuming public a trade-mark actually indicates the specific ownership or origin of goods to which such trade-mark is affixed.⁴¹²

Similarly, in response to the draft of the *varemerkeloven* in Norway in 1904, the Kristiania Haandverks- og Industriforenings bestyrelse stated that

Et varemerke kan aldrig bli nogen absolut sikker veileder for det kjøpende publikum. Mangen bedrift skylder innehavernes personlige dygtighet det renommé, som dens varer og varemerker nyder. Ved bedriftens overgang paa andre, fremmede hænder vil det ofte vise sig, at grundlaget for dette renommé er borte, og at den gode tradition ikke længer opretholdes; men de gamle merker benyttes fremdeles, og publikum har blot efterhvert at indrette sig efter de gjorte erfaringer. Varemerket gir i det hele ingen sikker oplysning om oprindelses- eller forfærdegelsesstedet for varerne. Det maa nemlig erindres, at ogsaa handelsmænd for sin bedrift kan indregistrere merker; de kan indkjøbe sine varer (av same art) fra hvilkesomhelst

⁴¹² Schechter (n 22), pg 147.

fabrikker og fra hvilket som helst lande; men paa alt, som de forhandler, sætter de – naar dette av fabrikanten indrømmes – sit eget varemerke, uten hensyn til at derved vil varer av same art, men av forskjellig kvalitet, forhandles under samme merke.⁴¹³

In the above passages, Schechter was highlighting the inadequacy of a single source identity of trademarks because of what he saw as the changing nature of commerce – that being it has become more international in nature - and Kristiania Haandverks- og Industriforeningen highlighted the nature of distributed manufacturing.

Issues with the concept of source were echoed more recently by Lassen / Stenvik in *Kjennetegnsrett*⁴¹⁴ -

Utviklingen har medført at dette ikke lenger gir hele sannheten. Som *Arne Midelfart* understreket – i et ufullført arbeid fra 1992 – har den utstrakte lisensiering av varemerker som nå finner sted, ført til <<at varemerkene i dag har en utvidet funksjon, utover det kun å sikte på å angi kilden, produktenes kommersielle opprinnelse>>.⁴¹⁵

The modern concept of source in the trademark context is thus certainly not the same as it was at the turn of the 20th century, at least as it relates to statutory renditions of it. It has necessarily expanded to cover such situations as articulated above. The modern concept of source must be read with the understanding that it can often represent an anonymous source. The meaning of an anonymous source is well articulated in the 1933 US case of *Manhattan Shirt v Sarnoff-Irving*⁴¹⁶ -

⁴¹³ Ot.prp.nr. 6, 1908, bilag s1. ('A trademark can never be some absolutely sure guide for the purchasing public. Many businesses goods and businesses are the result of the proprietors personal skill and reputation. Upon the transfer of the company to other foreign hands, it will often prove that the basis for this reputation is gone and the good tradition is no longer maintained; But the old brands are still being used and the audience simply adjusts to the experiences they have had. The trademark does not provide any confident information about the origin or [place of production?] for the goods. It must be recalled that traders for their business can also register marks; they can buy in their products (of the same sort) [that they can have third party producers] from whatever factory in whichever land; but on all that they trade; they set –when this is permitted by the factory- they own trademark without regard to the fact that the goods of the same kind, but different quality, be traded under the same mark.')

⁴¹⁴ *Kjennetegnsrett* (n 411).

⁴¹⁵ *Kjennetegnsrett* (n 411), pg 26. ('The development has meant that this is no longer gives the whole truth. As Arne Midelfart emphasized – in an incomplete work from 1992 – the extensive licensing of trademarks that now takes place led to the fact that trademarks today have an expanded function beyond its sole purpose of specifying the source, the commercial origin of the products.')

⁴¹⁶ *Manhattan Shirt Co v Sarnoff-Irving Hat Stores*, 19 Del Ch 151 (Del Chancery 1933).

When the courts speak of the public's identifying the source of origin they do not mean thereby that the purchasing public can identify the maker by his specific name or the place of manufacture by precise location. What they mean by such expression is that the purchaser of goods bearing a given label believes that what he buys emanated from the source, whatever its name or place, from which goods bearing that label have always derived.⁴¹⁷

Or as Lassen / Stenvik state – 'Det kreves ikke at de som kjenner market også skal ha forestillinger om hvem merkehaveren er.'⁴¹⁸

In practical terms this is entirely understandable. There are few who would be able to definitively identify the exact source of the goods they purchase and own outside of the brand name to which they have become accustomed. An illuminating example of this is found in Rogers' work, which could easily be said today –

The following is a brief transcript of certain testimony taken in a case involving the use of the name "Baker" for chocolate and shows the mind of the consumer better than any amount of windy disquisition. Edward A Keil, a San Francisco grocer:

We never have occasion to call it "Walter Baker's", I had to look on this package to find out what his first name was. I had really forgotten it.

Mrs. J. C. Echols, Columbus, Nebraska, a housekeeper for twenty-one years and familiar with Baker's chocolate all that time, said:

Well, it is Baker's. I don't know that I noticed the name of it.

Mrs. Julia McGowen, Columbus, Nebraska:

I just call for Baker's chocolate and I supposed that was the only kind. I thought it was just Baker's. I didn't know what his other name was.

W.J. Eisenman, Columbus, Nebraska:

I don't know whether the man's name is Walter or Peter or what it is. Baker's, that is all I know. That is all I have paid any attention to.⁴¹⁹

Rogers' also points out that the consumer would be able to recognise a brand name such as 'Budweiser' and 'Blue Ribbon Beer' for beer, but may still not make the connection to their sources – those being Anheuser-Busch and Pabst, respectively.⁴²⁰

⁴¹⁷ id, at 164.

⁴¹⁸ *Kjennetegnrett* (n 411) pg 40. ('It is not required that those who know the mark also have ideas about who the mark owner is.').

⁴¹⁹ Rogers (n 39) pg 204.

⁴²⁰ Ibid.

Furthermore, it is commonly agreed that trademarks now not only indicate a direct source of products and services, but also products and services that are under the control and authority of the source. This interpretation can be seen in the *Arsenal* case, as well as other cases concerning licensed products.⁴²¹

Another aspect of the construction of source within trademark protection systems deals not with the physical derivation of the products, but with the composition of the source itself. The idea of an anonymous source has been introduced above, yet one can also view this idea of source through modern protectable marks such as collective and certification marks. In these situations, though the modern system clearly allows such marks protection under the trademark system,⁴²² the traditional idea of a source of products or services becomes quite blurred.

Collective and certification marks are structured so as to not be used by their owners⁴²³ – by design they are obtained for the use of either the members of a collective, or by those who fulfill certain criteria, or offer services or products that comply with set standards. This obviously calls into question what source is being implicated in the use of such marks, especially if that source must be connected in some manner to the production or sale of the product or service.

It may seem that these concepts are the invention of an expanding modern trademark system. However, even at the time that Schechter and Kristiania Haandverks- og Industriforening voiced their concerns there were clear precedents for the protection of distinctive marks in such situations.

Indeed, the protection of marks that did not comply with a simplistic interpretation of source in this manner were prevalent enough at the turn of the 20th century to warrant

⁴²¹ *Arsenal Football Club v Matthew Reed*, Case C-206/1 judgement of 12 November 2002, ECLI:EU:C:2002:651 at 48.

⁴²² Paris Conventions Article 7bis; *Varemerkeloven* §1; 15 USC 1054.

⁴²³ *WIPO Handbook* (n 223) section 2.325 *et seq.*, pg 69.

a separate chapter in Rogers' 1914 work, which he styled 'The Deceptive Use of Community Marks'. Rogers thereby stated that

By "community marks" I mean not necessarily marks applicable to geographical communities, but those which are rightfully used by a group of persons, or at least by more than one. Certain geographical names, which will readily occur to anyone, illustrate one aspect of what I have in mind.⁴²⁴

Even prior to Rogers' work it seems that the expanded concept of source was already in acceptance by the courts. In *Schmalz v Wooley*, a case was filed 'by the president of the Union Hat Makers' Association of Newark, for the use and benefit of all the members thereof, to enjoin the defendants from using a counterfeit trade-mark and label...'.⁴²⁵ Though in this specific case the trademark at issue had been filed in New Jersey, USA by virtue of newly enacted legislation geared toward the marks of associations, the court stated its conclusions in terms applicable to all trademarks.

A different objection to a suit of this nature was sustained in *Weener v Brayton*...namely that the label did not indicate by what persons the articles labeled were made, but only indicated that they were made by one of many persons who were not connected with each other in any business. The first clause of this objection would unduly restrict the law of trade-marks as everywhere recognized; for it is established that, whatever be the quality indicated by a trade-mark, the mark need not point out the particular person from whom that quality is derived.⁴²⁶

The court also articulated that the protection sought by tradesmen's associations furthered the goals of trademarks -

The public object sought in the protection of trade-marks is to bring upon the market a better class of commodities, and the means for attaining that

⁴²⁴ Rogers (n 39) pg 243.

⁴²⁵ *Schmalz v Wooley*, 443 LRA 86, 57 NJ Eq 303, 304 (NJ Court of Errors and Appeals 1898); however, compare with *Schneider v Williams*, 44 NJ Eq 391 (NJ Chancery 1888) where infringement was not found when a Cigar Makers' Union had not established title to the trademark; *Cigar Makers' Protective Union v Conhaim*, 3 LRA 125 (1889), where infringement was denied on similar grounds as *Schneider*, however Mitchell J (dissenting) stated '...I think that it but needs a correct application of old principles to the new state of facts to protect the membership of this union, in the benefits of their superior skill and experience as cigar-makers, against the unfair competition of one who fraudulently imitates or counterfeits the label adopted to distinguish their workmanship from that of others.'; *Carson v Ury*, 5 LRA 614 (ED Missouri 1889), where infringement was found but plaintiff was not only a member of the union but also a manufacturer.

⁴²⁶ *Schmalz v Wooley*, 443 LRA 86, 57 NJ Eq 303, 310 (NJ Court of Errors and Appeals 1898).

object is by securing to those who are instrumental in supplying the market whatever reputation they gain by their efforts towards that end. The workman by whose handicraft the commodity is made is one of these instruments, just as is his employer who furnishes the raw material and owns and sells the finished product...⁴²⁷

Clearly the current concept of source as used in trademark law is not interpreted narrowly. It has as much to do with the public's perception of the source, as it does with the trademark user's composition. As described by WIPO, reference to a source 'does not mean that it must inform the consumer of the actual person who has manufactured the product or even the one who is trading in it. It is sufficient that the consumer can trust in a given enterprise, not necessarily known to him, being responsible for the product sold under the trademarks.'⁴²⁸ When examining decisions and commentary in this arena, and trademarks generally, it must be remembered that the source referred to is more than the word might imply in non-trademark contexts – and that this has direct implications for the scope of protection, indications to which trademark rights apply, and the ownership of such trademarks.

4.2.1. Commercial Nature

As has been seen from the above, the idea that a trademark must be an indicator of a single source has been soundly excluded from the modern trademark systems. Yet, it would also appear that it never quite existed either in trademark theory or practice to begin with, or at least as strongly as has been suggested by some commentators.

Still, as indicated, there is one further conditional element that some add to a definition of a trademark which is also asserted to limit the application of trademark protection, namely the commercial nature of a mark. In many definitions employed by commentators and the courts, a commercial element is added. For example, Lassen / Stenvik state that '[t]radisjonelt har utgangspunktet for varemerkelovgivningens vært at hensikten med varemerkebruk er å *markere produktenes kommersielle opprinnelse*.'⁴²⁹ Similarly, it is necessary that a trademark be used in interstate commerce to attract the

⁴²⁷ *Schmalz v Wooley*, 443 LRA 86, 57 NJ Eq 303, 310 (NJ Court of Errors and Appeals 1898).

⁴²⁸ *WIPO Handbook* (n 223) section 2.319, page 68.

⁴²⁹ *Kjennetegnsrett* (n 411) pg 25. ('Traditionally, the principle for trademark law making has been that the purpose of trademark use is to mark a products commercial origin.').

protection of the Lanham Act in the United States.⁴³⁰ Yet, further scrutiny reveals that commerce in this context need not mean a strict exchange of money for goods or services.

In this vein one can take note of trademark protections afforded to non-profit organisations. There is little question that non-profits would be afforded the protection of their marks in the courts today. However, it could be questioned in what ‘commerce’ they actually deal.

This issue, much like those regarding source above, are not new. In the case of *Benevolent and Protective Order of Elks v Improved Benevolent and Protective Order of Elks*, the plaintiff filed a case to restrain the defendant from making use of what was a similar name. The Court stated –

We are of the opinion that the injunction was properly awarded and made perpetual. While the complainant was not engaged in business for profit, in the sense of commerce and trade, yet it employed certain business activities for the purposes of maintaining itself and to procure funds to carry out the purpose of its organization, and it maintained certain business institutions, its clubhouses, and its home for aged and invalid members. The name it had acquired and appropriated had become very valuable, in the nature of a trade-name, by which it was accustomed to appeal to the public, and on the faith and reputation of which it was accustomed to obtain and receive from the public large sums of money.⁴³¹

Though it was noted that the plaintiff had conducted ‘certain business activities’, the Court clearly placed more weight upon the reputation of the plaintiff’s name and its ability to fundraise as the protectable interest unattached to the ‘business activities’.

⁴³⁰ However, it must be remembered in this context that the Lanham Act is a Federal statute where the US Congress based its power to legislate upon the commerce clause of the US Constitution. Thus, though use of a mark in interstate commerce may be required for Lanham Act protection, it is not a substantive element of trademark protection law in its entirety.

⁴³¹ *Benevolent and Protective Order of Elks v Improved Benevolent and Protective Order of Elks*, 14 Cates 141, 118 SW 389, 389-90 (Tenn Sup Ct 1909); it should be noted here that the plaintiff’s organisation was made up of an entirely white membership. The Court noted that ‘[t]he fact that the defendant’s membership is composed of colored people will not materially change the result.’ At 390. Though the Court was correct in its assessment, one would wonder whether the defendants put forth the defense that their use of ‘Improved Benevolent and Protective Order of Elks’ was merely descriptive. One would hazard that such a defense would not find much purchase in 1909 Tennessee.

Similarly, in *Young Women's Christian Ass'n v The International Committee of Young Women's Christian Ass'ns*⁴³² the Court noted –

Here the appellant was for years confessedly occupying a great field of charitable work under a name that in a marked degree commanded respect and confidence. Charitably disposed persons knew of the good work in which it was engaged, and through its name appellant had acquired reputation as a dispenser of gifts to charity.

Into the midst of that work and into the presence of that reputation, the appellee, under the guise of a name that none but the wary investigator might separate from the appellant, has entered, and gone into competition with the appellant.⁴³³

Clearly, even in the case of a non-profit institution there is still value in a mark that is protected by trademark law. This is further evidenced by the many trademark registrations held by non-profit organisations throughout the world.⁴³⁴

The question of commerce, in the strict sense of the meaning, arises in the context of certification and collective marks as well. Though they are undoubtedly firmly seated in the modern trademark protection systems, including in the Paris Convention article 7*bis*, because of the fact that they are not used by the trademark owner, as such, one may question if the mark is actually being used in commerce.

This issue was raised in *Schneider v Williams*,⁴³⁵ where infringement was not found when a Cigar Makers' Union had not established title to the trademark. In *Schneider* the complainant stated that the Union's

label is a guaranty that the cigars contained in the box to which it is attached have been manufactured by a skillful workman, and are not coolie, prison, or tenement-house work, the sale of cigars thus marked has, since the adoption of the label, largely increased, and they now command a higher price in the market than cigars not thus distinguished, and so the exclusive right to use the label is now a very valuable right.⁴³⁶

⁴³² *Young Women's Christian Ass'n v The International Committee of Young Women's Christian Ass'ns*, 86 Ill App 607 (Ill App Ct 1899).

⁴³³ *Id.* at 616-617.

⁴³⁴ By way of example – SAVE THE CHILDREN, held by International Save The Children Alliance, international registration 542382, 532390, 003507696; MED ISRAEL FOR FRED, Norwegian registration 201502540, -541, -542, -546, - 511; Universitet- og høyskole utdannedes forbund, Norwegian registration 199902738.

⁴³⁵ *Schneider v Williams*, 44 NJ Eq 391 (NJ Chancery 1888).

⁴³⁶ *Id.* at 392.

The Court adjudged that -

Taking the averments made in the bill to be true, it is manifest that nothing can be said in defense, or even extenuation, of the defendant's conduct in its moral aspects; for, whether the complainants have a legal right they claim or not, the facts stated in the bill show beyond dispute that the defendant is conducting his business in such a manner as to deceive and cheat all who deal with him by representing that to be true which he knows to be false.⁴³⁷

However, reasoning that the Court could only intervene if a property right was established, the Court refused to restrain the defendants. When evaluating this property justification the Court noted '[i]t would seem to be settled beyond question that there can be no such thing as a trade-mark distinct from and unconnected with a vendible commodity.'⁴³⁸

And further that

The defect is this: the bill does not show that the complainants [the Union] have applied their mark or label to a vendible commodity of which they are the owners, or in which they trade, and that they have put such commodity, marked with their mark, on the market.⁴³⁹

The Court here, though basing its final determination on a lack of property right in the trademark, was ultimately questioning the use of that mark in commerce by an association of workmen.

It was not long, however, until this view was called into question⁴⁴⁰ and ultimately abandoned.⁴⁴¹ Today the trademark protections for associations and the like is well

⁴³⁷ Id. at 393.

⁴³⁸ *Schneider v Williams*, 44 NJ Eq 391, 395 (NJ Chancery 1888).

⁴³⁹ Id. at 396.

⁴⁴⁰ *Carson v Ury*, 5 LRA 614 (ED Missouri 1889), where infringement was found but plaintiff was not only a member of the union but also a manufacturer; *Cigar Makers' Protective Union v Conhaim*, 3 LRA 125 (1889), where infringement was denied on similar grounds as *Schneider*, however Mitchell J (dissenting) stated '...I think that it but needs a correct application of old principles to the new state of facts to protect the membership of this union, in the benefits of their superior skill and experience as cigar-makers, against the unfair competition of one who fraudulently imitates or counterfeits the label adopted to distinguish their workmanship from that of others.'

⁴⁴¹ *Schmalz v Wooley*, 443 LRA 86, 57 NJ Eq 303, 304 (NJ Court of Errors and Appeals 1898).

enshrined in the Paris Convention and national laws. Indeed, the concept of commerce in the context of trademarks must be seen with the goals and functions of trademark protection in mind.

... i tvilstilfelle må begrepet 'næringsvirksomhet' (<<in the course of trade>> i den engelske versjonen) fastlegges i lys av varemerkets hovedformål, som er å fungere som opprinnelsesgaranti for varer og tjenester. Utgangspunktet bør derfor være at varemerkebruk anses som skjedd i næringsvirksomhet i varemerkelovens forstand, dersom den er egnet til å skade de interesser som varemerkeloven (og direktivet) tar sikte på å beskytte, først og fremst varemerkets evne til å fungere som kommersiell opprinnelsesgaranti.⁴⁴²

These examination of source and commerce, however, must inform the understanding of any definition of a trademark that incorporates those, or similar, terms. A 'source' is not one of a strictly defined nature; it does not relate to a specific location, or even a specific person or company, but must be considered in more conceptual terms. It must also be considered through the eyes of the public which is dealt with later in this work.⁴⁴³ Furthermore, 'commerce' in the trademark setting cannot be restricted to a simple money for goods or services model. The concept of commerce, or business, must be understood to extend beyond a formalistic capitalist understanding. There are many situations in which a trademark rights are recognised even where a mark is not used in a strict sense, or is not used in commerce in a money for goods/services transaction.

With a refined understanding of these two elements it can be seen how an infirm understanding of the definitional trademark can create complications. Though it is undoubtedly necessary that there be a source in any trademark definition, it must be read with an expanded understanding of what a source may be. This necessarily flows from the ultimate function of trademarks. The addition of commercial aspects to a

⁴⁴² *Kjennetegnsrett* (n 411) page 281. ('According to the Directive, trademark use is deemed to have taken place in business activity <<when it finds itself in connection with a business activity seeking economic gain and not in private relations>> ... in the event of doubt, the term 'business activity' (<<in the course of trade>> in the English version) is determined in the light of the trademarks primary purpose, which is to function as a guarantee of origin for goods and services. The starting point should therefore be whether the trademark usage is considered to have occurred in the course of trade according to the trademark law, if it is capable of harming the interests that the trademark law (and the directive) view to protect, first and foremost trademarks' ability to function as a commercial guarantee of origin.')

⁴⁴³ See Part 5.

foundational trademark definition can also create uneven results and make the definition inapplicable where there is indeed a protectable trademark right.

4.2.2. A Trademark Definition

With the above in mind it is necessary to consider an appropriate definition of a trademark at a foundational level. In order to do so, the statutory definitions are most instructive. They, for the most part, have stripped away many questionable elements that have at times been conflated to the function of a trademark. What is left invariably distills to a mark being distinctive and indicative of attributes, whether those attributes be of source, quality, certification, membership, approval, or endorsement.

Thus, for the purposes of this work the definition of a trademark shall articulate only its base functions – ***A trademark is a distinguishing communicator of certain specific attributes.***

A trademark as a distinguishing communicator that guarantees certain specific attributes may seem like an impermissible expansion of the theory of trademarks well into the area of unfair competition. However, this is not the case. It must be remembered that trademarks are merely a species within the overall genus of unfair competition⁴⁴⁴ and that prior to the establishment of the trademark registration systems the definition of a trademark, or rather the scope of marks that were protectable, was nearly unlimited. It was only after the institution of trademark registration systems that trademark definitions began to appear. They also began as highly restrictive – limited to words, logos, phrases, numbers and the like.⁴⁴⁵ This, however, did not mean that the marks that found protection prior to the statutory definitions were no longer trademarks or were no longer protectable (though there is certainly confused initial precedent attempting to sort this out). Instead those marks found protection outside of what had become an area ruled by restrictive definitions.

⁴⁴⁴ Rogers (n 39) pg 127. See also, S. Rep. No. 1333, 79th Cong., 2d Sess., 1946 U.S.C.C.A.N. 1275; *Hanover Star Milling v Metcalf*, 240 US 403 (1916) – ‘This essential element is the same in trademark cases as in cases of unfair competition unaccompanied with trademark infringement. In fact, the common law of trademarks is but a part of the broader law of unfair competition.’ at 413; *Two Pesos v Taco Cabana*, 505 US 763 (1992); Ot.prp.no 6 (1908).

⁴⁴⁵ See section 3.3.

This incongruence led to the expansion of the trademark definition used in statutory schemes and in turn to debate surrounding what was seen as an expansion of trademark rights. However, this entire debate is cast in the wrong light. The expansion of the definitions and coverage of trademarks, ‘proper’ in the modern view, is not a true expansion of protection, but merely a rediscovery of the protection that has always been afforded such indications. Essentially it is a recognition of trademarks true place within the genus of unfair competition; an identification and rediscovery of similar trademark forms that should be identified under their proper species.

One necessarily must ask, then, what is the difference between trademarks and unfair competition? In reply - trademarks, in whatever form and time, have one defining feature that other areas of unfair competition do not – that being a communicator. Whether that communicator be in the form of smell, shape, sound, colour, words, names, logos, or numbers, or any combination of these, trademarks must have a communicator. This is quite different from the other areas of unfair competition which relate not to communicators, but to actions taken by competitors – including trade secret protection, bait and switch trade, and passing off proper.

Thus a proper definition of the species of trademarks hinges upon that communicator, and its ability to differentiate. All other aspects within the trademark protection discourse become comments upon the use of that communicator, the permissible protection, and fact based evaluations within specific situations.

4.3. Communicator – Distinctiveness

Having drawn this conclusion, attention must necessarily turn to the ‘communicator’ within the trademark definition. In the context of goods and services, a trademark need be capable of distinguishing those of one source from another, which necessarily requires distinctiveness. Indeed, ‘[a] trademark, in order to function, must be distinctive.’⁴⁴⁶

⁴⁴⁶ *WIPO Handbook* (n 223) s2.343, pg 71.

The concept of distinctiveness in trademark law arises directly from a mark's ability to distinguish. The distinctiveness of a trademark is also the foundation upon which other aspects of trademark protection are built, including infringement, likelihood of confusion, and secondary meaning.

The requirement for a mark to be distinctive, or rather the inability for non-distinctive marks to perform trademark functions, can be seen as part of the principle of free competition.

Dessuten gjør det seg gjeldende et særlig *friholdelsesbehov* for slike tegn, dvs. et behov for å unngå monopolisering av ord og tegn som også andre næringsdrivende har en berettiget interesse i å bruke: Retten til å bruke f.eks. betegnelsen <<grovbrød>> må ikke gjennom varemerkeregistrering bli forbeholdt én næringsdrivende, men må holdes fri for enhver.⁴⁴⁷

There is truly no satisfying bright-line definition of what is and what is not distinctive. This arises from distinctiveness being entirely relative and based upon the perception of the consumer and the context within which a mark is encountered. Many definitions fall into circular reasoning referring to a mark's ability to distinguish and by reference to certain spectrums of distinctiveness.

WIPO articulates a well reasoned general understanding of distinctiveness in its Handbook - 'The test of whether a trademark is distinctive is bound to depend on the understanding of the consumer, or at least the persons to whom the sign is addressed. A sign is distinctive for the goods to which it is to be applied when it is recognized by those to whom it is addressed as identifying goods from a particular trade source, or is capable of being so recognized.'⁴⁴⁸ Additionally, '[d]istinktiviteten skal alltid bedømmes ut fra det *helhetsinntrykket* som varemerket etterlater hos

⁴⁴⁷ *Kjennetegnrett* (n 411) pg 55. ('Moreover, there is a particular free holds need [freedom of use?] for such marks, that is to say a need to prevent monopolization of words and signs which other businesses also have an eligible interest in the use of: the right to the use, for example, the mark 'grainbread' must not, though trademark registration, be reserved for one business, but must be held free for everyone.'). Though this concept of *friholdelsesbehov* also covers other bars to registration and enforcement, distinctiveness aspect of trademarks clearly fall under its principles.

⁴⁴⁸ *WIPO Handbook* (n 223) s2.344, pg 72.

gjennomsnittsforbrukeren.⁴⁴⁹ The public perception of a mark, and its effect on protection is examined subsequently in Part 5.

‘For at et tegn skal ha særpreg i varemerkelovens forstand, må det ha evne til å tiltrekke seg en viss oppmerksomhet, og være av slik art at det er egnet til å feste seg i erindringen til dem som møter markedet i handelen.’⁴⁵⁰ Essentially, distinctiveness is a mark’s relative ability to distinguish as viewed by the targeted audience.

Though the methods of determining distinctiveness vary between jurisdictions, it is unquestionable that distinctiveness is an essential requirement to trademark protection in all jurisdictions. In certain systems this is formulated as a positive requirement that marks must be capable ‘to identify and distinguish’ or ‘egnet til å skille’,⁴⁵¹ others create a negative restriction against ‘trade marks which are devoid of any distinctive character’.⁴⁵² There is no specific degree of distinctiveness drafted into the Norwegian *varemerkeloven*, however, the very definition of a trademark is based upon a mark’s being ‘egnet til å skille’. Furthermore, ‘[e]t merke som skal registreres, behøver i alminnelighet verken å være nytt eller originalt. Men *særpreg* må det ha; det vil si at de må være egnet til å skille innehaverens varer eller tjenester fra andres.’⁴⁵³

Lassen / Stenvik further state that

Særpregskravet i vml. § 2 første led gjelder – i motsetning til bestemmelsen i § 14 – også for innarbeidede varemerker. Noen reell betydning har det imidlertid neppe at loven stiller krav om særpreg også for de varemerker som skal få vern i kraft av innarbeidelse. Et innarbeidet varemerke må nemlig nødvendigvis være egnet til å skille en virksomhets varer eller

⁴⁴⁹ *Kjennetegnsrett* (n 411) pg 55 (‘Distinctiveness shall always be judged based on the overall impression the trademark leaves in the mind of the consumer.’).

⁴⁵⁰ *Kjennetegnsrett* (n 411) pg 55 (‘In order for a mark to have distinctiveness under the trademark law, it must be able to attract a certain attention and be of such a nature that it is suitable to adhere to the memory of those who meet the mark in commerce.’).

⁴⁵¹ varemerkeloven §2.

⁴⁵² EU Directive 2015/2436, Article 4(1)(b).

⁴⁵³ Kåre Lilleholt (ed), *Knops oversikt over Norges Rett*, (14th ed, Universitetsforlaget, 2014), pg 369. (‘A mark to be registered does not generally need to be new or original. But it must be distinctive; that is to say that it must be able to distinguish the holder’s goods or services from others.’) However, it must be noted that §14 of vml applies to the registration of marks.

tjenester fra andres, ellers kan det ikke være innarbeidet som særlig kjennetegn for noen.⁴⁵⁴

When accepting the self-referential and circular understanding of distinctiveness, we can place certain marks upon a spectrum of strength of distinctiveness. Essentially, the distinctiveness of a mark can range from the purely descriptive (a mark that merely describes the product or service or attributes of a product or service) to the entirely fanciful (a mark that is an entirely unique and original creation never seen before). As stated by WIPO - '[t]here are, of course, different degrees of distinctiveness, and the question is how distinctive a sign must be in order to be registrable. In that connection a distinction is generally made between certain typical categories of marks—fanciful or coined trademarks which are meaningless and others.'⁴⁵⁵

The most comprehensive categorization on this spectrum of distinctiveness is established in the trademark law of the United States. Within US trademark law '[m]arks are often classified in categories of generally increasing distinctiveness; following the classic formulation set out by Judge Friendly, they may be (1) generic; (2) descriptive; (3) suggestive; (4) arbitrary; or (5) fanciful.'⁴⁵⁶ This spectrum is combined with the concept of inherent distinctiveness and acquired distinctiveness in order to evaluate the availability of protection and suitability for registration.

Similarly as explained by Lassen / Stenvik –

Variasjonsbredden når det gjelder distinktiviteten er svær. Vi har *sterke* varemerker, rene fantasibetegnelser som slår godt an i syns- og hørselserindringen, og som ingen tidligere har satt i forbindelse med slike varer som innehaveren bruker dem for... *Svake* er varemerker som helt eller delvis består av ikke distinktive elementer, og hvis distinktive evne ligger i

⁴⁵⁴ *Kjennetegnsrett* (n 411) pg 54. ('The distinctiveness requirement in *varemerkeloven* § 2 first paragraph is applicable – contrary to the provision in section 14— also to rights derived through use. The real meaning however does not necessarily mean that the law imposes distinctive character on those trademarks that will receive protection through establishment. An established trademark must necessarily be appropriate to distinguish an entity's goods or services from others, otherwise it may not be established as a mark for someone.')

⁴⁵⁵ *WIPO Handbook* (n 223) section 2.346, pg 72.

⁴⁵⁶ *Two Pesos v Taco Cabana*, 505 US 763, 768 (1992).

*sammenstillingen av elementene, eller skyldes bare et teller enkelte av de elementene varemerket er bygd opp av ...*⁴⁵⁷

One method to understand the nature of distinctiveness is to evaluate what marks are incapable of the necessary distinctiveness.

4.4. Limits to distinctiveness

4.4.1. Descriptive

A descriptive mark is that which merely describes some aspect of the good or service and as such, at the outset, lack the distinctiveness to distinguish goods and services. Descriptive marks 'convey an immediate idea of the ingredients, qualities or characteristics of the goods to which they are attached... such as SPORTS ILLUSTRATED for a sports magazine.'⁴⁵⁸ Additionally, descriptive marks can describe the 'function, use, characteristic, size, or intended purpose of the product such as '5 Minute glue' or 'After Tan post-tanning lotion''.⁴⁵⁹

Because descriptive marks and terms do nothing more than describe some aspect of a product or service, they lack the necessary ability to distinguish. Other products or services of a similar nature may have the same attributes described and will not be prevented from using similar or identical terms to do such descriptive work. Jurisdictions generally state that terms which 'are merely descriptive of a product are not inherently distinctive. When used to describe a product, they do not inherently identify a particular source, and hence cannot be protected.'⁴⁶⁰ Lassen / Stenvik describe descriptive marks as '[d]en største og viktigste gruppen av tegn som mangler særpreg...'.⁴⁶¹

⁴⁵⁷ *Kjennetegnsrett* (n 411) pg 63. ('The range of variability in terms of distinctiveness is difficult. We have strong trademarks, pure fantasy designations that are useful in the visual and hearing recall, and which none before have used in connection with the type of goods that the owner uses them for ... Weak are the trademarks which either wholly or in a portion consist of non-distinctive elements, and if the distinctive nature lies in a collection of elements, or just because it individually accounts for elements that the trademark is built upon.').

⁴⁵⁸ *Boston Duck Tours, LP v Super Duck Tours, LLC*, 531 F3d 1, 13 (1st Cir, 2008); see also *Kjennetegnsrett* (n 411) - 'utfjøres imidlertid av dem som er *beskrivende* for ytelsens art, egenskaper osv. (deskriptive merker).' at 55.

⁴⁵⁹ *Grayson O Company v Agadir Int'l*, 856 F3d 307, 315 (4th Cir 2017).

⁴⁶⁰ *Two Pesos v Taco Cabana*, 505 US 763, 769 (1992).

⁴⁶¹ *Kjennetegnsrett* (n 411) pg 55. ('the largest and most important group of marks that lack distinctiveness...').

However, ‘whether a mark is descriptive cannot be determined in the abstract. Descriptiveness must be evaluated in relation to the particular goods for which registration is sought, the context in which it is being used, and the possible significance that the term would have to the average purchaser of the goods because of the manner of its use or intended use.’⁴⁶²

The use of a descriptive mark does not necessarily mean that it would be afforded no protection under the trademark laws. ‘[D]escriptive marks may acquire the distinctiveness which will allow them to be protected...’⁴⁶³ This is achieved through consistent and widespread use of the term so that in the mind of the consumers it has acquired the ability to distinguish. This is generally termed acquired distinctiveness or secondary meaning.⁴⁶⁴

4.4.2. Generic

‘A generic mark merely employs the common name of a product or service and is ineligible for trademark protection.’⁴⁶⁵ Though there is substantial overlap between descriptive and generic terms, one defining difference is that generic terms are generally incapable of distinctiveness and thus attract no protection under trademark regimes even if extensively used. In short, they contain no inherent distinctiveness and are incapable of acquiring distinctiveness or secondary meaning.⁴⁶⁶

In Norwegian law generic marks are dealt with in ‘[varemerkel]ovens § 14 annet led bokstav b) inneholder en regel som gjennomfører Varemerkedirektivets art. 3(1), og forbyr registrering av varemerker som utelukkende består av tegn eller betegnelser som

⁴⁶² *In re Chamber of Commerce of the US*, 675 F3d 1297, 1300 (Fed Cir 2012), citing *In re Bayer Aktiengesellschaft*, 488 F3d 960 (Fed Cir 2007); See also *Windsurfing Chiemsee v Boots- und Segelzubehör Walter Huber*, Case C-108/97 and C109/97, Judgment of 4 may 1999, ECLI:EU:C:1999:230.

⁴⁶³ *Boston Duck Tours, LP v Super Duck Tours, LLC*, 531 F3d 1, 13 (1st Cir, 2008); see also *Two Pesos v Taco Cabana*, 505 US 763 (1992); *Kjennetegnsrett* (n 411) pg 60-61.

⁴⁶⁴ Secondary meaning and acquired distinctiveness are reviewed in section 5.2.2.1 below.

⁴⁶⁵ *JFJ Toys v Sears*, 2017 WL 679219, at *9 (Dist Maryland 2017) (quoting *EndoSurg Med v EndoMaster Med*, 71 F.Supp.3d 525, 547 (D Md 2014)).

⁴⁶⁶ This, of course, is contingent upon the specific mark being generic. That is not to say that a mark’s generic nature may not change over time. See *Miller Brewing v Falstaff Brewing* 503 F.Supp 896, 906-907 (D RI 1980).

er blitt vanlige i alminnelig språkbruk eller i lojal og etablert forretningspraksis.⁴⁶⁷ In this context generic marks extend further than those that merely describe a product or service. 'Forbudet i art. 3 (1)(d) er imidlertid *ikke* – til forskjell fra art. 3(1)(c) [on descriptive marks] – begrenset til å gjelde tegn og betegnelser som er *beskrivende* for de varer det gjelder. Forbudets oppgave blir dermed først og fremst å ramme det man kan kalle *alminnelige reklameuttrykk* som ikke er beskrivende for varenes art, egenskaper etc.'⁴⁶⁸

Generic terms can be considered a broader category than that of descriptive terms. Generic terms include those that not only describe the product or service, but also terms that are in common use for the relevant area of trade. '[A] sign is generic when it defines a category or type to which the goods belong. It is essential to the trade and also to consumers that nobody should be allowed to monopolize such a generic term.'⁴⁶⁹

An oft used example to illustrate genericness is the use of the term APPLE. When used with the sale of the apple fruit the term APPLE would do nothing more than describe the product that is being sold – it is referring to the overall category of goods. It would entirely lack the distinctiveness necessary to distinguish those specific apple fruits from the apple fruits of other sources, thus could not function as a trademark. However, when placed in a different context the term APPLE may in fact be removed from the descriptive nature and then acquire the necessary distinctiveness – such as its use with electronics. Other '[e]xamples of generic terms are “furniture” (for furniture in general, and also for tables, chairs, etc.) and “chair” (for chairs).'⁴⁷⁰

⁴⁶⁷ *Kjennetegnsrett* (n 411) pg 57 ('The trademark law's §14 second paragraph letter b) contains a rule which implements the trademark directive's article 3(1), and prohibits registration of trademarks which exclusively consist of signs or names which have become common in the general language use or in loyal and established business practice'); see also vml §14. Directive §3(d).

⁴⁶⁸ *Kjennetegnsrett* (n 411) pg 57. ('The prohibition in Article 3(1)(d), however, is not – unlike Article 3(1)(c) restricted to applicable signs and designations that are descriptive of the goods in question. Thus, the task of the prohibition is first and foremost to affect what can be called common commercial [advertising] expressions which are not descriptive of the goods nature, characteristics, et cetera.').

⁴⁶⁹ *WIPO Handbook* (n 223) section 2.354, pg 73.

⁴⁷⁰ *Ibid.*

4.4.3. Functional

Descriptiveness and genericness arise most commonly in regard to terms, however, in the context of other non-word marks the assessment of distinctiveness in the terms of descriptiveness and genericness becomes more difficult. This is especially true for three dimensional and sensory marks. In these circumstances the functionality of a mark must be taken into account. In order for a mark to be capable of acting as a trademark it must be non-functional. '[W]here the features are 'functional' there is normally no right to relief.'⁴⁷¹

A functional element is not merely one that performs a physical function. This category also includes '[a] functional characteristic is an important ingredient in the commercial success of the product...'.⁴⁷²

'Functional' in this sense might be said to connote other than a trade-mark purpose. If the particular feature is an important ingredient in the commercial success of the product, the interest in free competition permits its imitation in the absence of a patent or copyright. On the other hand, where the feature or, more aptly, design, is a mere arbitrary embellishment, a form of dress for the goods primarily adopted for purposes of identification and individuality and, hence, unrelated to basic consumer demands in connection with the product.⁴⁷³

The functional limitation to trademarks can be seen in the Norwegian *varemerkeloven* section 2 -

Det kan ikke oppnås varemerkerett til tegn som utelukkende består av en form som følger av varens art, er nødvendig for å oppnå et teknisk resultat eller tilfører varen en betydelig verdi.⁴⁷⁴

Further, section 5(c) provides –

Varemerkeretten er ikke til hinder for at noen i samsvar med god forretningskikk broker:

⁴⁷¹ *Pagliario v Wallace China Co.*, 198 F2d 339, 343 (9th Cir 1952).

⁴⁷² *Inwood Labs v Ives Labs*, 456 US 844, 863 (1982); *Koninklijke Philips Electronics v Remington Consumer Products*, Case C-299/99 Judgment of 18 June 2002, ECLI:EU:C:2002:377; *Bang & Olufsen v OHIM*, Case T-508/08, Judgment of 6 October 2011, ECLI:EU:T:2011:575.

⁴⁷³ *Pagliario v Wallace China Co.*, 198 F2d 339, 343 (9th Cir 1952).

⁴⁷⁴ Vml. §2. ('Trademark rights can not be obtained to marks which exclusively consist of a shape that follows from the goods nature, is necessary to obtain a technical result or adds significant value to the product.').

- c) varemerket, når det er nødvendigt for å angi bruksformålet for en vare eller tjeneste, for eksempel når market angir at varens bruksformål er som tilbehør eller reservedel.⁴⁷⁵

However, it must be remembered that the functionality of a mark is not determinative of its ability, or non-ability, to identify and distinguish. '[T]he fact that an item serves or performs a function does not mean that it may not at the same time be capable of indicating sponsorship or origin, particularly where the decorative aspects of the item are nonfunctional.'⁴⁷⁶ In other words, just because a mark is capable of performing a function that does not necessarily mean that it is not able to also be distinctive and distinguishing.⁴⁷⁷

4.4.4. Summary of distinctiveness

Distinctiveness is necessarily a difficult concept to define in isolation. By its nature it is subjective and only by evaluating the distinctiveness of a mark within the context in which it is used is it possible to determine distinctive qualities. As is explored further in this work the concept of distinctiveness is also highly dependent on other aspects of the trademark protection enquiry, such as the public perception which is explored in Part 5.

With that in mind, however, it is possible to gain an understanding of distinctiveness through the purpose it serves and the identification of categories which are incapable of distinctiveness. Ultimately distinctiveness is necessary in order of a trademark to perform one of its fundamental functions – that being distinguishing. If a mark is, for one reason or another, incapable of distinguishing then it will necessarily lack distinctiveness. In this understanding there are certain categories of marks in which distinctiveness is precluded – there is no ability to distinguish – or there must be an added element to exhibit the requisite distinctiveness – such as acquired distinctiveness through extensive use.

⁴⁷⁵ Vml. §5(c). ('Trademark law shall not prevent anyone, while complying with good business practices, use ... the trademark when it is necessary to indicate the purpose of use for a good or service, for example when the mark indicates that the goods use is as an accessory or spare part.').

⁴⁷⁶ *Dallas Cowboys Cheerleaders v Pussycat Cinema*, 604 F2d 200, 204 (2nd Cir 1979).

⁴⁷⁷ *In Re Penthouse*, 565 F2d 679 (USCCPA 1977) – 'Or in other words, 'possession of a function and of a capability of indication origin are not in every case mutually exclusive.' at 681.

These concepts are returned to and explored in more depth as this work proceeds. At this point it is only necessary to understand the basis of distinctiveness, how it informs the definition of a trademark, and its fundamentality to distinguishing marks throughout all jurisdictions.

4.5. Forms of a trademark

When discussing distinctiveness of a mark, it is helpful to understand the form that a mark may take. Members of the general public surely most commonly associate the term ‘trademark’ with mental images of a word, phrase, or possibly a logo. Such associations are reinforced by daily interaction with such indications and their common usage as identifying marks.

As dealt with above, ‘[i]t follows from the purpose of the trademark that virtually any sign that can serve to distinguish goods from other goods is capable of constituting a trademark.’⁴⁷⁸ As the US Supreme Court has stated - ‘It is the source-distinguishing ability of a mark—not its ontological status as color, shape, fragrance, word, or sign—that permits it to serve these basic purposes [of a trademark].’⁴⁷⁹

For illustrative purposes the Interbrand 2023 report on the best global brand⁴⁸⁰ provides a list of the most valuable brands in the world. The top three global brands, according to the report, are exemplified by the following trademarks –

- 1) Apple, Inc –
 - a) APPLE (word mark)⁴⁸¹
 - b) APPLE LOGO mark

⁴⁷⁸ *WIPO Handbook* (n 223), s2.333 pg 70.

⁴⁷⁹ *Qualitex Co v Jacobson Products Co, Inc*, 514 US 159, 164 (1995).

⁴⁸⁰ Interbrand, Best Global Brands 2023, available at <https://interbrand.com/best-brands/> (the Interbrand report is focused upon total brand value not specifically the valuation of separate trademarks. Yet, it provides valuable context to the value of trademarks in practice).

⁴⁸¹ US trademark application serial number 73120444, filed 25 March 1977, US trademark registration number 1078312 (international registration number 0870749), registered 29 November 1977.



- 2) Microsoft Corp
 - a) MICROSOFT (word mark)⁴⁸³
- 3) Amazon, Inc.
 - a) AMAZON (word mark)⁴⁸⁴
 - b) AMAZON (stylized mark)



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These registrations, and the brands themselves, provide near perfect examples of the use of logos and word marks as trademarks. They also exemplify, the general public's typical understanding of trademarks derived from their constant exposure to and recognition of the word marks and logos of commercial enterprises. This, unfortunately, leads to an imperfect understanding of the depth of trademark law and the variety of forms that may exhibit the distinctiveness necessary to perform a trademark function.

Individuals are constantly surrounded by, and familiar with, non-word and non-logo trademarks though they may not consciously think of these identifying and distinctive non-word/logo indicators as trademarks.

4.5.1. More than a logo

It is now universally agreed that the distinctiveness necessary to distinguish one's goods and services from another's is not limited to the use of logos and word marks. As has

⁴⁸² US trademark application serial number 73162799, filed 20 March 1978, US trademark registration number 1114431, registered 6 March 1979.

⁴⁸³ US trademark application serial number 73236080, filed 22 October 1979, US trademark registration number 1200236 (international registration number 1737949), registered 6 July 1982.

⁴⁸⁴ US trademark application serial number 75277670, filed 18 April 1997, US trademark registration number 2167345, registered 23 June 1998.

⁴⁸⁵ US trademark application serial number 75895250, filed 12 January 2000, US trademark registration number 2970898, registered 19 July 2005.

been seen from, for instance, the statutory sections within the Lanham Act (US)⁴⁸⁶ and varemerkeloven (Norway),⁴⁸⁷ trademark law does not necessarily make a distinction between the form that a trademark can take, but rather is concerned with whether that indication, in whatever form, is capable of functioning as a trademark.

The WIPO Intellectual Property Handbook⁴⁸⁸ provides an informative list of ‘signs’ that may achieve those functions –

If we adhere strictly to the principle that the sign must serve to distinguish the goods of a given enterprise from those of others, the following types of categories of signs can be imagined:

- *Words*: This category includes company names, surnames, forenames, geographical names, and any other words or sets of words, whether invented or not, and slogans.
- *Letters and Numerals*: Examples are one or more letters, one or more numerals or any combination thereof.
- *Devices*: This category includes fancy devices, drawings and symbols and also two dimensional representations of goods or containers.
- Combinations of any of those listed above, including logotypes and labels.
- *Colored Marks*: This category includes words, devices and any combination thereof in color, as well as color combinations and color as such.
- *Three-Dimensional Signs*: A typical category of three-dimensional signs is the shape of the goods or their packaging. However, other three-dimensional signs such as the three-pointed Mercedes star can serve as a trademark.
- *Audible Signs (Sound Marks)*: Two typical categories of sound marks can be distinguished namely those that can be transcribed in musical notes or other symbols and others (e.g. the cry of an animal).
- *Olfactory Marks (Smell Marks)*: Imagine that a company sells its goods (e.g. writing paper) with a certain fragrance and the consumer becomes accustomed to recognizing the goods by their smell.
- *Other (Invisible) Signs*: Examples of these are signs recognized by touch.⁴⁸⁹

⁴⁸⁶ 15 USC 1127.

⁴⁸⁷ Vml. §2.

⁴⁸⁸ WIPO Handbook (n 223).

⁴⁸⁹ WIPO Handbook (n 223) s 2.334, pg 70.

These specific non-restrictive categories are endorsed by patentstyret⁴⁹⁰ when explaining trademark types⁴⁹¹ and trademark registers for both Norway and the United States are likewise replete with registrations that evidence the different forms that a trademark may take.⁴⁹²

4.5.2. A product of many marks

One manner in which trademarks and other indicators of origin are found outside of the word and logo world, is by incorporating many different design elements that are unique to the source of a product. These can take on nearly any design element, as long as they can perform the trademark function, and normally constitute separate trademarks in themselves.

4.5.3. The Ford F-350 and its distinctive elements

In the automotive world there are many instances of products that incorporate many distinguishing elements that are considered trademarks. Below is an image of the 1999-2004 model Ford F-350 standard cab dual rear wheel pickup truck, as sold in the United States.



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⁴⁹⁰ the Norwegian authority tasked with registration of patents and trademarks.

⁴⁹¹ <https://www.patentstyret.no/varemerke> (last accessed 20 June 2024)

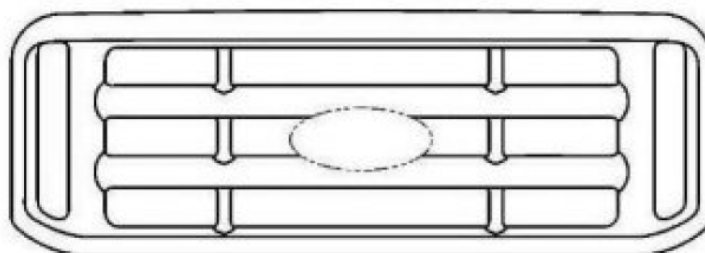
⁴⁹² By way of example - US2821863 – AOL ‘You’ve Got Mail’; US2463044 – Mantel mark which ‘consists of a cherry scent’; US2210506 – Edgar Rice Burroughs mark which consists ‘of the famous Tarzan yell’; US3332910 – Lactona mark which ‘consists of the scent of strawberry’; US2323892 – Ballantyne mark which consists ‘of a pre-programmed rotating sequence of a plurality of high intensity columns of light protected into the sky to locate a source at the base thereof’; US2741129 – NYSC mark which ‘consists of the sound of a brass bell tuned to the pitch D...’. US1108661 – Apple mark for the shape of an accessory cable; US1097249 – Apple mark for the FaceTime logo; US4726738, US4726737 and INT1246707 – Apple mark for the shape of a USB wall charger; NOR0883509 – John Deere Colour Mark; NOR1191051 – Nuetella jar shape mark; NOR0820269 – Nokia motion mark; NOR1213527 – distinctive mark upon clothing.

⁴⁹³ IFCAR, under creative commons license

While nearly anyone would be able to view this vehicle and surmise that it is a product of the Ford Motor Company through the conspicuous use of the standard FORD OVAL trademark,⁴⁹⁴ the visual indicators that reveal the F-350 as a product of Ford extend beyond the FORD OVAL logo and word mark. Visual indicators that would serve this purpose include the general shape of the vehicle, the configuration of the grille, the shape and placement of vehicle lights, shape of the doors and body paneling, and many other elements unique to this particular vehicle line and producer.

In the case of the Ford F-350 of this timeframe there are many features that set it apart from its competitors and identify it as a product of the Ford Motor Company. While any number of these may be the basis for trademark, or trademark like protection, Ford Motor Company has applied for and ultimately received trademark registrations for certain specific elements of this vehicle.

Ford Motor Company in fact holds at least three separate trademark registrations for specific design elements of the F-350. US trademark registration number 3580534⁴⁹⁵ ‘consists of a configuration of a vehicle grille’.



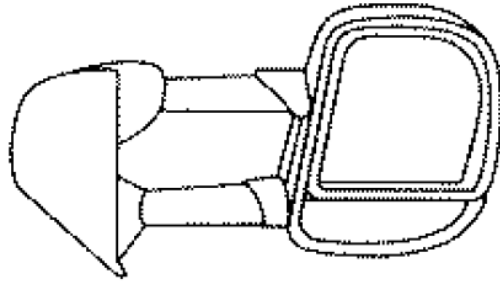
US trademark registration number 2853770,⁴⁹⁶ ‘consists of the configuration of the double-arm telescoping mirror’.

<https://commons.wikimedia.org/w/index.php?curid=1206907> (last accessed 20 June 2024).

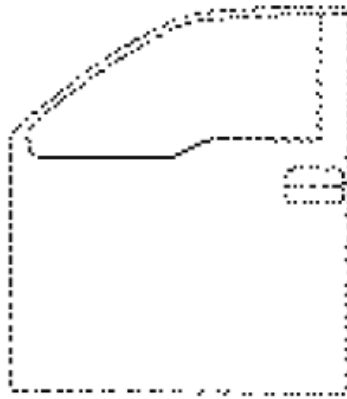
⁴⁹⁴ For example, US Registration 3658024, registration date 21 July 2009.

⁴⁹⁵ Serial number 78759326 filed 22 November 2005, registration number 3580534, registration date 24 February 2009.

⁴⁹⁶ Serial number 78258330 filed 4 June 2003, registration number 2853770 registration date 15 June 2004.



And, US trademark registration number 2853769,⁴⁹⁷ 'consists of the configuration of the beltline of the driver's side door' of a vehicle.



While the marks that are articulated in the '769, '770, and '534 registration do not encompass all of the elements incorporated into the Ford F-350 that may serve a trademark function, especially to those well versed in the area of American trucks, the F-350 registrations provide a classic scenario where incorporated elements serve a trademark function, are worthy of protection, and are even placed upon the trademark register.⁴⁹⁸ Through this example and others,⁴⁹⁹ it can be seen that there are distinctive elements incorporated into many products that serve a trademark function.

4.5.4. A product within a mark

Another form in which distinguishing and source identification functions of a mark or design can be found is in the world of packaging. Perhaps one of the most famous trademarks in this conceptual category is that of the Coca-Cola bottle. The first registration in the United States for the distinctive shape of the Coca-Cola bottle comes

⁴⁹⁷ Serial number 78258317 filed 4 June 2003, registration number 2853769 registration date 15 June 2004.

⁴⁹⁸ See also *DaimlerChrysler Corp v OHIM*, Case T-128/01, Judgment of 6 March 2003, ECLI:EU:T:2003:62.

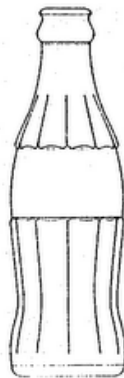
⁴⁹⁹ NOR1213527 – distinctive mark upon clothing; NOR1211001; NOR1203353; NOR1107997; NOR1330870.

from 1960. US trademark registration number 0696147⁵⁰⁰ ‘consists of the distinctively shaped contour, or confirmation, and design of the bottle as shown’ –



While it may seem interesting that the registration for such a famous bottle contour was issued so recently, in its application the Coca-Cola company claimed use in commerce of this bottle contour starting from at least 8 July 1916.⁵⁰¹

Other US trademark registrations followed, including US trademark registration number 1057884⁵⁰² which ‘consists of the three dimensional configuration of the distinctive bottle as shown’ specifically without the wording incorporated into the mark –

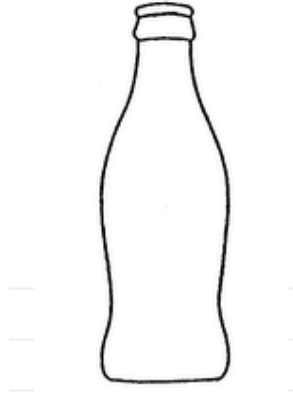


⁵⁰⁰ Serial number 72069873 filed 19 March 1959, registration number 0696147 registration date 12 April 1960.

⁵⁰¹ In addition, there were cases in the US on the successfully protecting unique bottles shapes prior to the institution of statutory and registration trademark schemes, see *Cook & Bernheimer v Ross*, 73 F 203 (1896); *Baglin v Cusenier*, 221 US 580 (1911), 12 F 78 (7th Cir 1903), 141 F 497 (2nd Cir 1905), 156 F 1016 (SDNY 1907), 164 F 25 (2nd Cir 1908).

⁵⁰² Serial number 73088384 filed 25 May 1976, registration number 1057884 registration date 1 February 1977.

As well as US trademark registration number 2085197,⁵⁰³ which 'consists of a drawing of the outline of a curved contour shaped bottle' thus removing the elements of the wording and vertical fluting elements from the distinctive contour.⁵⁰⁴



The distinction between this scenario and that of the Ford F-350 may not be entirely apparent. However, they represent two distinct forms of trademarks and an increasing integration of a trademark with the product. In the Ford F-350 situation the marks and signs that functioned as trademarks were integrated into the products as a whole while remaining discrete and distinct from the vehicle. In theory one could remove the distinguishing marks from the Ford F-350 and maintain the integrity of the product itself as a vehicle.

In the matter of the distinctive Coca-Cola bottle this separation of product and mark would prove to be, practically, much more difficult.⁵⁰⁵ Attempts to sell Coca-Cola to the consumer without the distinctive bottle within which to place it would result in divesting the brown sugary liquid of its identity of being Coca-Cola. The bottle as an communicator of the attribute of being Coca-Cola is nearly inseparable from the product in this situation, notwithstanding the ability to physically separate the two. Further

⁵⁰³ Serial number 74611506 filed 15 December 1994, registration number 2085197 registration date 5 August 1997.

⁵⁰⁴ However, registration of the Coca-Cola bottle without fluting was recently denied registration as a Community Trade Mark in the EU, Judgment of the General Court of 24 February 2016 in case T-411/14 *The Coca-Cola Company v OHIM*, ECLI:EU:T:2016:94, see also <https://curia.europa.eu/jcms/upload/docs/application/pdf/2016-02/cp160016en.pdf>.

⁵⁰⁵ Though of course this occurs in the context of fountain drinks and mixed drinks at bars and the like – *Coca-Cola Co v Snow Crest Beverages*, 162 F2d 280 (1st Cir 1947).

examples of this relationship between distinctive mark and product can also be found in other commercial areas.⁵⁰⁶

4.5.5. The inseparable trademark

With the cohesive identity nature of a distinctive mark and the product having been examined above, one can wonder whether the distinctive nature of a mark may be integrated further into the physicality of a product. As a baseline answer to that question, it must be remembered that there is no restriction on what form a trademark may take as long as it performs the proper functions. Thus, there is no legal nor practical reason why the integration of the identity and physicality of a product and a mark cannot coincide, and indeed there are marks in which this happens.

Perhaps one of the best, and least controversial, examples of the inseparability of not only the identity function of a mark and product but also the physical nature of the same, are the marks associated with Toblerone chocolate. Toblerone is well known not only for its distinctive chocolate, but also for the packaging and shape of that product and one finds support in the trademark registers for the protection of these distinctive elements.⁵⁰⁷ On the international register maintained by WIPO for the international application system, one can locate a great variety of trademark registrations covering the configuration of the Toblerone chocolate product. International registration 615992A⁵⁰⁸ consists of the classic Toblerone packaging including color and word mark elements -

⁵⁰⁶ By way of example - Nutella jar mark – reg. no. 1191051, Stolichnaya elite bottle – reg. no. 0789448K, Beefeater bottle – reg. no. 1327352, Rémy Martin bottle – reg. no. 1317531, Kinder Joy mark – reg. no. 1288269, Hermès fixture mark – reg. no. 1218393, Marco Polo Cigars mark – reg. no. 1218454 (International registrations, Norway designated); Bulgari perfume bottle mark – reg. no. 5108559, Nail polish bottle mark – reg. no. 5181959, LVMH perfume bottle mark – reg. no. 4966666, Red-Rose Tequila bottle mark – reg. no. 5147687, L’Oreal nail polish bottle mark – reg. no. 5147382, Tanqueray Gin bottle mark – reg. no. 0897970, Mumm Champagne bottle mark – reg. no. 5134109 (US Registrations).

⁵⁰⁷ See also, *In Re World’s Finest Chocolate*, 474 F2d 1012 (USCCPA 1973).

⁵⁰⁸ International registration number 615992A, registration date 17 February 1994.



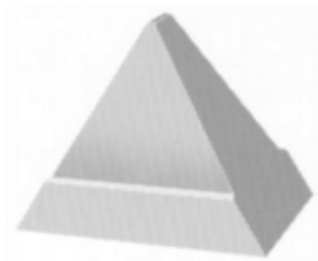
International registration 615993A/B⁵⁰⁹ consists of the shape of the Toblerone packaging absent the color and word mark elements –



International registration 615994A/B⁵¹⁰ begins to fuse more solidly together the mark functions and the products and consists of the physical shape of the Toblerone chocolate bar –



Dividing this even further, the 669792⁵¹¹ international registration consist of a single piece of the Toblerone pyramid shaped chocolate -



⁵⁰⁹ International registration numbers 615993A and 615993B, registration date 17 February 1994.

⁵¹⁰ International registration numbers 615994A and 615994B, registration date 17 February 1994.

⁵¹¹ International registration number 669792, registration date 7 February 1997.

In this protection scenario, the trademark functioning elements of the products are inseparable from the product itself. The actual shape of the product itself serves as an indication of origin and is distinctive enough to distinguish the chocolate of Toblerone from that of others. Placing these marks in a practical scenario, a piece of chocolate absent the benefit of packaging or markings could still be identified as coming from Toblerone because of the distinctive pyramid form. To restate this in a negative sense – anyone may produce chocolate, they are however restrained from producing chocolate in a confusingly similar shape of a pyramid either alone or connected to other pyramids, because that would be infringing the trademark rights of Toblerone. These marks clearly show the extent to which a trademark and a product may be inseparable and similar examples can be found in other areas of commerce.⁵¹²

4.5.6. The endless variety of trademark forms

The prior few sections outlined an expanded understanding of the forms that a trademark may take with practical physical examples. However, as further touched upon, the forms of a trademark do not necessarily need to be physical in order to have the necessary distinctiveness.

Because the ability of an indication to be protected as a trademark is derived from it being capable of performing the necessary functions, which in turn requires a level of distinctiveness, the form that it may take is nearly unlimited. '[H]uman beings might use as a "symbol" or "device" almost anything at all that is capable of carrying meaning.'⁵¹³ This functional ability transcends physicality and protection for a distinctive mark has been found in cases such as sound, colour, and scent marks.

The United States of America is the first country to have recognized the registrability of a smell mark – fresh floral fragrance reminiscent of Plumeria blossoms for sewing thread and embroidery yarn. In a decision on 11 February 1999, the Board of Appeal of the office for Harmonization in the Internal Market (Trademarks and Designs) of the European Community supported the registrability of the smell mark "the smell of fresh cut grass" for tennis balls.⁵¹⁴

⁵¹² *In Re Penthouse*, 565 F2d 679 (USCCPA 1977) – 'The present decision, however, is governed by a special fact of record. The design is the mark. Penthouse is not merely attempting to register a jewelry design as a trademark; it seeks to register its established mark used as a jewelry design.' at 682.

⁵¹³ *Qualitex*, 514 US at 162.

⁵¹⁴ *WIPO Handbook* (n 223) pg 71. (internal citation omitted).

In the US, '[t]he courts and the Patent and Trademark Office have authorized for use as a mark a particular shape (of a Coca-Cola bottle), a particular sound (of NBC's three chimes), and even a particular scent (of plumeria blossoms on sewing thread).'⁵¹⁵ Moreover, in discussing the protection afforded to colour the US Supreme Court stated that it could not 'find in the basic objectives of trademark law any obvious theoretical objection to the use of color alone as a trademark, where that color has attained "secondary meaning" and therefore identifies and distinguishes a particular brand (and thus indicates its "source").'⁵¹⁶

The EU has also found a basis for the protection of colours as trademarks –

Colours or combinations of colours which are the subject of an application for registration as a trade mark, claimed in the abstract, without contours, and in shades which are named in words by reference to a colour sample and specified according to an internationally recognised colour classification system may constitute a trade mark for purposes of Article 2 of the First Council Directive (89/104/EEC) of 23 December 1988 to approximate the laws of the Member States relating to trade marks where:

- it has been established that, in the context in which they are used, those colours or combinations of colours in fact represent a sign, and
- the application for registration includes a systematic arrangement associating the colours concerned in a predetermined and uniform way.⁵¹⁷

Colour protection has also been enshrined in the international framework - as found in the TRIPS Agreement article 15(1) which states that 'combinations of colours ...shall be eligible for registration as trademarks'.⁵¹⁸ Additionally, Norwegian trademark law has also recognized these trademark forms.⁵¹⁹

It must also be kept in mind that the great variety of forms which a mark may take is not an expansion of modern trademark law in the sense that it is a discovery of newly protectable areas. On the contrary, protection of various forms predates the modern

⁵¹⁵ *Qualitex*, 514 US at 162.

⁵¹⁶ *Qualitex*, 514 US at 163.

⁵¹⁷ Judgment of the Court (Second Chamber) 24 June 2004, ECLI:EU:C:2004:384, Case C-49/02 Heidelberg Bauchemie GmbH.

⁵¹⁸ TRIPS Agreement Article 15(1).

⁵¹⁹ Varemerkeloven §2; *Kjennetegnsett* (n 411) pg 116 *et seq.*

statutory systems. Various instances of the protection of non-logo/word mark can be found throughout the early precedent.⁵²⁰

4.5.7. Summary of trademark forms

As is evidenced by the discussion above, the forms in which trademarks may be found are nearly limitless. This, however, is not entirely surprising especially with the aid of a fundamental definition of trademarks. Prior to registration and statutory system establishing in the late 1800s there was little question of the form of protectable distinguishing marks. Indeed, as was articulated above, protection extended to all manner of marks as long as they were capable of performing the trademark function of distinguishing. Though the statutory systems were established with very restricted definitions of a registrable trademark, including restrictions as to form, those restrictive constructs have been roundly abandoned in nearly all jurisdictions today. It is now accepted that the primary and pivotal focus is upon whether a designation is capable of performing trademark functions, not on arbitrary determinations based upon form.

The above discussion explored this concept with practical examples of trademark forms and established that form is no longer a limited factor in a trademark protection enquiry, if indeed it ever truly was. This aspect of the general principles of trademark protection should be kept in mind in the application of trademark protection to indigenous intangible resource, which will take place in Part 6. It will be seen during the application that indigenous intangible resources come in many forms, however, one must not read into trademark protection outdated form requirements.

4.6. The two faces of a trademark

Through the preceding sections it has been established that defining what a trademark is necessarily flows from the function that a trademark performs and that function is to communicate certain attributes by distinguishment. In essence, a trademark is a distinguishing communicator of certain specific attributes, and the form that this

⁵²⁰ *Knott v Morgan*, 2 Keen 213 (1836); *Blofeld v Payne*, 110 ER 509 (1833); *Walton v Crowley*, 3 Blatchf 440 (1856); *Weinstock, Lubin & Co v Marks*, 109 Cal 529 (1895); *Cook & Bernheimer Co v Ross*, 73 F 203 (1896); *Chartreuse Cases - Baglin v Cusenier*, 221 US 580 (1911), 12 F 78 (7th Cir 1903), 141 F 497 (2nd Cir 1905), 156 F 1016 (SDNY Circuit Court 1907), 164 F 25 (2nd Cir 1908), *Rey v Lecouturier*, [1908] 2 Ch 715 (Court of Appeal), [1910] AC 262 (House of Lords).

communicator may take is only limited by its ability to perform the necessary distinguishing function. However, with this background understanding of what a trademark is, it is necessary to ask why is there protection of trademarks? To what end should and do distinguishing communicators of certain aspects attract the protection of the law? Essentially what is the purpose of a trademark?

There are two prevailing theories on the primary purpose of a trademark. The first theory emphasizes the trademark as a protection of the source,⁵²¹ insulating the source from the competition of imitations, and securing the goodwill that the source has built in relation to the use of the distinguishing mark. The second theory emphasizes the protection of the public, often in the form of the consumer, and the preservation of the public's expectation.

Proponents of trademarks being primarily a protection of the consumer include Glynn Lunney,⁵²² and Mark Lemley⁵²³. 'Originally, trademark law was justified on grounds of preventing consumer deception.'⁵²⁴

Whereas the primary purpose of trademarks being the protection of the source is championed by, for instance, none other than Schechter⁵²⁵ and Mark P McKenna.⁵²⁶ 'Whether the American cases were based on trademark infringement or unfair competition, however, the underlying concern, just as it was in English cases, was trade diversion.'⁵²⁷ and, '[t]raditional trademark law was predominantly producer-centered...'.⁵²⁸

⁵²¹ Keeping in mind that use of 'source' here is merely for convenience, as source has been analysed above in section 4.2 and is revisited in section 5.3.

⁵²² Glynn S Lunney, 'Trademark Monopolies' (1999) 48(2) Emory Law Journal 367.

⁵²³ Mark A Lemley, 'The Modern Lanham Act and the Death of Common Sense' (1999) 108(7) Yale Law Journal 1687-1715.

⁵²⁴ Lunney (n 522) 417.

⁵²⁵ Schechter (n 22).

⁵²⁶ McKenna (n 232)

⁵²⁷ Id., at 1862.

⁵²⁸ Id., at 1896.

Notwithstanding these differences of opinion, trademarks derive their purpose not from one or the other of these goals, but from both. In the opinion of McCarthy,⁵²⁹

To select as paramount either protection of trademark property or protection of consumers would be to oversimplify the dual goals of trademark law, both historical and modern. Trademark law serves to protect both consumers from deception and confusion over trade symbols *and* to protect the plaintiff's infringed trademark as property. Both [US] Congress and the [US] Supreme Court in modern times have stressed that trademark has these two goals.⁵³⁰

The dual purpose is echoed by the Norwegian High Court –

For så vidt er det riktig, som fremhevet i forarbeidene til 1961-loven, at forbudet tar sikte på å beskytte allmennheten. Men samtidig vil bestemmelsen, slik det er forutsatt i forarbeidene til 1910-loven, verne de næringsdrivende mot at noen skaffer seg konkurransefordeler ved å villedde publikum. ... Spørsmålet om varemerkeloven §14 første ledd nr 2⁵³¹ bare beskytter publikum, eller om de også verner næringsdrivende mot illojal konkurranse, lar seg etter min mening ikke besvare i denne absolute form. Jeg ser det slik at både lovens ordlyd og forarbeidene tilsier at det avfjørende spørsmål må være om det kjøpende publikum blir villedet.⁵³²

This notion of the dual function of trademark protection was even present in the early formation of Norwegian trademark law –

At de forskjellige lovgivninger sikrer fabrikanter og handlende en eneret til vise varemerker og beskytter denne ret ved straffe- og erstatningsbestemmelser beror i virkeligheten paa erkjendelse av det berettigede i, at det omdømme, som en mand har erhvervet for sine varer i vedkommende forretnings- eller kundekreds, bevares for ham og ikke uhjemlet kommer fremmede varer tilgode.

Idet almenheten gjennom denne beskyttelse av varemerker vænnes til at betrakte disse merker som kjendetegn paa, at varen stammer fra en bestemt fabricant eller handlende, kommer andres misbruk av varemerkene ogsaa til

⁵²⁹ McCarthy (n 225)

⁵³⁰ Id. at s2.2.

⁵³¹ Lov 3 mars 1961 (nr 4) om varemerker - §14 Varemerke må ikke registreres hvis det: ... (2) er egnet til å villedde.

⁵³² HR-1995-167-B – RT-1995-1908 (Mozell-dommen) (Insofar as it is appropriate, as highlighted in the preparatory works of the 1961 law, the ban aims to protect the public. But, at the same time the provision, as provided in the preparatory works of the 1910 law, protecting the trader against anyone gaining a competitive advantage by deceiving the public. ... 'The question of trademark law §14 first paragraph number 2 only protects the public, of if they also protect traders against unfair competition, lays down to my understanding is not answerable in this absolute form. I see that in both the law's wording and preparatory works suggest that the crucial question must be if the purchasing public is being misled.').

at indeholde en krænkelse av almenhetens krav paa ikke at vildledes eller føres bak lyset.
Men dette dobbelte hensyn har ogsaa sin fulde betydning utenfor de enkelte varemerker.⁵³³

However, the discussion surrounding the original purpose of trademark protection remains lively. The discourse regarding the purpose of trademark protection becomes articulated in modern scholarship most visibly as a critique of what is seen as the ‘expansion’ of trademark rights. Many commentators decry what they view as non-traditional areas of the protection of marks for which there is no justification. Protections that have been identified by various scholars in this regard include trade-dress,⁵³⁴ trademark dilution,⁵³⁵ branding practices, and certain forms of confusion.⁵³⁶

Critics of this ‘expansion’ find motivation through ‘[w]orking from the premise that trademark law was designed to reduce consumer search costs, commentators have criticized a variety of modern doctrinal innovations on the ground they do not seem motivated by concern for consumers.’⁵³⁷ Not only are the expansion areas not seen as protecting consumers, they are instead furthering the protection of the trademark user and the trademark itself as property.

We can explain some of this expansion by stretching trademark’s traditional deception-based rationale: As marketing methods have changed in the twentieth century, some consumers may have come to rely on slogans, trade names, or trade dress to identify the source of goods or services. Yet, we must also acknowledge that much of this expansion has little to do with any plausible concern over consumer deception and rests squarely on the sense that someone who creates something of value ought to receive the fruits of her labors.⁵³⁸

⁵³³ Ot.prp.nr. 6 (1908) pg 41. (‘the fact that the different laws ensure manufacturers and traders an exclusive right to display trademarks and protect this right by means of penalties and compensation provision, are you really aware of the legitimate reputation that a man has acquired for his goods in the relevant business or clientele, preserved for him, and not inadvertently, foreign goods will benefit. As the public through this trademark protection is accustomed to regard these brands as hallmarks of the product from a particular fabricant or merchant, others’ abuse of the trademarks will also violate the public’s requirement not to be misled or led by the light. But this dual concern also has its full significance beyond the individual trademarks.’).

⁵³⁴ Lunney (n 522) at 374.

⁵³⁵ Clarisa Long, ‘Dilution’ (2006) 106 Columbia Law Review 1029.

⁵³⁶ Eric Goldman, ‘Deregulating Relevancy in Internet Trademark Law’ (2005) 54 Emory Law Journal 507.

⁵³⁷ McKenna (n 232) at 1847.

⁵³⁸ Lunney (n 522) at 374; Mark A Lemley, ‘The Modern Lanham Act and the Death of Common Sense’ (1999) 108(7) Yale Law Journal 1687, 1693-94 (‘there is an increasing tendency to treat trademarks as

Thus, critics of ‘expansion’ see the original, or traditional, motivating purpose behind trademark protection as that of protecting consumers and from that foundation they find no basis for protections that they see as a modern expansion grounded in the protection of the property in trademarks.⁵³⁹

These ‘anti-expansion’ positions necessarily spawned contrary views that the original, or traditional, motivating purpose of trademarks was indeed the protection of the trader, through property justifications, and thus arguments against expansive trademark protection that find their foundation in traditional public protection purpose are unfounded. Indeed, McKenna sees the public protection explanation of trademark’s traditional purpose as ‘premised on a “falsely imagined past.” In reality, “traditional” American trademark law was unapologetically producer-oriented.’⁵⁴⁰

Supporters of both of these views comb through the early, and not so early, trademark precedent to provide support for their respective view of ‘traditional’ trademark law – with each finding purchase in one manner or another. Most notably the property right proponents rely heavily on the judgments of Lord Westbury.⁵⁴¹ The early trademark precedent, however, is heavily confused with regard to a clear purpose and motivation behind the protection of trademarks.⁵⁴² As stated by César Ramirez-Montes -

assets with their own intrinsic value, rather than as a means to an end. In part, this change reflects a broader trend towards “propertizing” intellectual property ... I think this last explanation—treating trademarks as property—is a remarkable trend worthy of further attention. Why should the law create property rights in trademarks, particularly the strong, unfettered property rights that seem to underlie the “trademarks as property” concept?’).

⁵³⁹ Lunney (n 522) at 418 *et seq.*

⁵⁴⁰ McKenna (n 232) at 1848.

⁵⁴¹ McKenna (n 232) at 1851-1859; Oliver R Mitchell, ‘*Unfair Competition*’ (1896) 10 Harvard Law Review 275, 281 - ‘In the *Leather Cloth Co. v. The American Leather Cloth Co.*, Lord Westbury, C, says: “The true principle therefore would seem to be, that the jurisdiction of the court in the protection given to trade marks rests upon property, and that the court interferes by injunction because that is the only mode by which property of this description can be effectually protected.”’.

⁵⁴² The list of confused precedent could fill volumes. For illustrative purposes – *Weinstock, Lubin & Co v Marks*, 109 Cal 529 (1895) - It has been said by some judge or law writer that ‘no fixed rules can be established upon which to deal with fraud, for, were courts of equity to once declare rules prescribing the limitations of their power in dealing with it, the jurisdiction would be perpetually cramped and eluded by new schemes which the fertility of man’s invention would contrive.’ By device, defendant is defrauding plaintiff of its business. He is stealing its good will, --a most valuable property,-- only secured after years of honest dealing and large expenditures of money; and equity would be impotent, indeed, if it could contrive no remedy for such a wrong.’ at 539; *Schneider v Williams*, 44 N.J.Eq 391

...one finds numerous cases in which the courts regarded the defendant's use of his own name, being the same as that of the claimant, as an "avowed" fraud on the public, while in other instances they found no evidence of fraud on the claimant's customers to intervene. Sometimes, courts, even in the same decision, referred to the right of the claimant to be protected against fraud but described the defendant's wrongful conduct as fraud on the public. Yet, some judges also said that the defendant could be guilty of fraud towards the buyer as well as towards the claimant.⁵⁴³

Though both the purpose for protection of trademarks as a property right and as a protection of the public can find ample support in the history of mark protection, 'appeals to "original conception" and "tradition" are problematic in the face of the history, which is certainly messy.'⁵⁴⁴ Indeed, even in the time of Schechter

The cases appear to be in irreconcilable conflict not only with each other but occasionally even with themselves. ... Compare the sweeping decisions there [in the *Trade-Mark Cases*⁵⁴⁵] as to "the whole system of trade-mark property" with the cautious and qualified statement of the same court in 1915, that "the trade-mark is treated as merely a protection for the goodwill, and is not the subject of property except in connection with an existing business."⁵⁴⁶

(1888) – 'The complainants can have no relief at the hands of this court unless their bill shows both a clear property right, and an invasion of that right by the defendant. Unless their bill shows that they have property in the label or mark, which they say is the exclusive property of their association, they have no case.' at 813; *Schmalz v Wooley*, 57 NJ Eq 303 (1898) – 'According to these principles, we think a workman, or a number of workmen engaged in the same branch of industry and banded together for their mutual profit, in the pursuit of their common vocation, may acquire a right of property in a trade-mark designed to distinguish their workmanship from that of other persons, and that a trade mark so owned is entitled to the same protection as other trade-marks.' At 311; *Bloss v Bloomer*, 23 Barb 604 (NY Sup Ct 1857) – In this case what would appear to be a licensing contract was held to be void as against public policy. The defendant had purchased a number of empty seed bags from the plaintiff, which he was to fill with good quality seed and sell in a specific geographic area. The defendant, however, filled the bags with poor quality seed and sold them in areas outside of the specific county designated in the contract. The Court reasoned that 'but if it be a crime to counterfeit labels, words or devices previously appropriated to distinguish property, or to vend goods thus stamped, without disclosing the fact to the purchaser, it is equally an offense against the spirit of the law, equally injurious to trade and commerce, and equally an imposition upon the public to palm off spurious goods under cover of genuine labels and devices.' At 610. The court also interestingly mentioned 'perhaps the provision in the contract, that the defendant should fill the bags with seeds of a good quality, might save the parties from a conviction for a conspiracy to commit an act "injurious to trade or commerce" ...' at 610.

⁵⁴³ César Ramirez-Montes, 'A re-examination of the original foundations of Anglo-American trademark law' (2010) 14 *Marquette Intellectual Property Law Review* 91, 92, 108.

⁵⁴⁴ Lionel Bently, 'From communication to thing: historical aspects of the conceptualization of trade marks as property' in Graeme B Dinwoodie and Mark D Janis (eds), *Trademark Law and Theory: A Handbook of Contemporary Research* (Edward Elgar, 2008) pg 4 footnote 5 ('From Communication').

⁵⁴⁵ *Trade Mark Cases*, 100 US 82 (1879).

⁵⁴⁶ Schechter (n 22) pg 154, quoting *Hanover Star Milling v Metcalf* 240 US 403, 414.

It is undeniable at this point that trademarks are, indeed, some form of property.⁵⁴⁷ However understanding the context from which those property justifications began to be referenced, informs the understanding of what property rights are entailed in a trademark. In this Bently states –

The adoption of the language of property (at least for some time) may have had little substantive impact because it was recognised that the “property” label was just that, a label. It was a label adopted to solve a specific problem: that of explaining Equity’s extended jurisdiction beyond that of the Common Law and the availability of injunctive relief at all. Adoption of that label did not mean that trade marks were property, like land or goods, or even like copyrights or patents.⁵⁴⁸

César Ramirez-Montes takes up the task of finding reconciliation between the ideas that the purpose of trademark protection is either for the protection of the public, based on an action through fraud or deceit, or the owner, through property justifications in his work *A Re-examination of the Original Foundations of Anglo-American Trademark Law*.⁵⁴⁹ Ramirez-Montes work was primarily drafted as a response to that of McKenna, who in *The Normative Foundations of Trademark Law*⁵⁵⁰ while recognizing a modern expansion of trademark law also noted that ‘because critics have mischaracterized traditional trademark law, they have misunderstood the nature of its expansion’.⁵⁵¹ The traditional trademark law in McKenna’s view was ‘unapologetically producer-oriented’.⁵⁵²

After thoroughly articulating and examining the conflict between the two views of trademark purpose and comprehensively reviewing the history of mark protection, Ramirez-Montes concluded that ‘[t]rademark law has never served the interests of one

⁵⁴⁷ *Trademark Cases*, 100 US 82 (1879), Property in trademarks has long been recognized and protected by the common law and by the statutes of the several states, and does not derive its existence from the act of Congress providing for the registration of them in the Patent Office.; *McCarthy*, above n 258, §2:10 – Because a trademark is undoubtedly a “right to exclude,” a trademark is a form of “property”; The Congressional Globe, June 24 1870, Senate 41st Congress, 2nd Session, pg 4822 – ‘Another remark may be made in that connection: that these trade-marks are a kind of private property; they are not like an invention that gives a man an exclusive privilege; but they are the evidence of a private right, which time should not impair.’.

⁵⁴⁸ Bently, *From communication* (n 544) pg 36.

⁵⁴⁹ (2010) 14 Marquette Intellectual Property Law Review 91.

⁵⁵⁰ (2007) 82 Notre Dame Law Review 1839.

⁵⁵¹ McKenna (n 232) at 1915.

⁵⁵² *Id.*, at 1848.

master; rather, it has always endeavoured to accommodate and balance adequately the interests of traders, consumers, and competitors. With this accommodation of interests in mind, the courts sought to achieve and preserve the ultimate goal envisaged by trademark doctrine: fair competition.⁵⁵³

Indeed, it may be that any trademark understanding that would elevate either the protection of the public or of the owner as the primary purpose of trademark protection would be building that understanding from a ‘falsely imagined past’. A view of trademark protection that balances the interests of the consumer, trader, and competitor provides a much more reasonable and rational understanding of trademark law as a whole and provides context for the confused precedent prior to and during the implementation of statutory protection systems.

Furthermore, it places trademarks into their proper context within the larger narrative discussed above with regard to the true function and forms of a trademark as well as the evolution and placement of trademark registration systems. It must be remembered that much of the discussion surrounding the expansion of modern trademark rights is centered on protections that are not in truth an expansion of the substantive rights that protect distinguishing marks. Indeed, as discussed previously protection of marks in many forms,⁵⁵⁴ including trade dress⁵⁵⁵ and non-competing goods,⁵⁵⁶ is clearly supported when viewing the entire system of the protection of mark. It must thus be firmly concluded that present day trademarks serve to protect the consumer, the public, and the user of the mark including in non-English common law jurisdictions.⁵⁵⁷

⁵⁵³ César Ramirez-Montes, ‘A Re-Examination of the Original Foundations of Anglo-American Trademark Law’ (2010) 14 Marquette Intellectual Property Law Review 91, 164.

⁵⁵⁴ *Blofeld v Payne*, 110 ER 509 (1833); *Walton v Crowley*, 3 Blatchf 440 (1856); *Cook & Bernheimer v Ross*, 73 F 203 (1896); *Wolfe v Burke*, 56 NY 115 (1874); *Chartreuse Cases - Baglin v Cusenier*, 221 US 580 (1911), 12 F 78 (7th Cir 1903), 141 F 497 (2nd Cir 1905), 156 F 1016 (SDNY Circuit Court 1907), 164 F 25 (2nd Cir 1908), *Rey v Lecouturier*, [1908] 2 Ch 715 (Court of Appeal), [1910] AC 262 (House of Lords).

⁵⁵⁵ *Knott v Morgan*, 2 Keen 213 (1836); *Weinstock, Lubin & Co v Marks*, 109 Cal 529 (Cali Supreme Court 1895).

⁵⁵⁶ *Eastman Photographic Materials Co, Ltd v The John Griffiths Cycle Corporation, Ltd*, (1898) 15 RPC 105; *Aunt Jemima Mills Co v Rigney & Co*, 247 F 407 (2nd Cir 1917); *Wall v Rolls-Royce*, 4 F2d 333 (3rd Cir 1925).

⁵⁵⁷ See section 6.3.3 below; *Kjennetegnsett* (n 411) pg 364 *et seq.*; *Jack Daniel’s Properties, Inc v VIP Products, LLC*, 143 S Ct 1578, 599 US ___, 4 (2023)

4.6.1. Economic understanding of trademarks

In the late 1980s a new justification for the protection of trademarks began to gain traction that was based in economic theories. In some ways this is an offshoot of the protection of the public and focuses on the reduction of consumer search costs and perfection of market efficiencies.

Primary champions of the economic theory of trademark protection are William Landes and Richard Posner who in 1987 published their oft-cited article *Trademark Law: An Economic Perspective*.⁵⁵⁸ In Landes and Posner's economic explanation '[t]he implicit economic model of trademarks that is used in that law is our model, in which trademarks lower search costs and foster quality control rather than create social waste and consumer deception.'⁵⁵⁹

Since its inception, the economic understanding and justification for the protection of trademarks has become engrained in many commentators and courts⁵⁶⁰ thinking. Indeed, McKenna even stated that '[i]t would be difficult to overstate the level of consensus among commentators that the goal of trademark law is – and always has

⁵⁵⁸ William M Landes and Richard A Posner, 'Trademark Law: An Economic Perspective' (1987) 30(2) *The Journal of Law & Economics* 265.

⁵⁵⁹ *Id.*, pg 275, and, '[t]he essential economic function of trademarks -- that of reducing consumer search costs' at 275; see also *McCarthy* (n 225) at §2:3.

⁵⁶⁰ *Qualitex Co v Jacobson Products Co*, 514 US 159 (1995) – 'In principle, trademark law, by preventing others from copying a source-identifying mark, reduces the customer's costs of shopping and making purchasing decisions.' at 163-4 (quoting *McCarthy*, above n 225); *Kohler v Moen*, 12 F3d 632 (7th Cir 1993) – 'Innovation in product design and marketing for the purpose of enhancing producer identity reduces the costs to consumers of informing themselves about the product source so that they can either continue purchasing the products from particular producers or avoid the products from those producers altogether.' at 643-4; *WT Rogers v Keene*, 778 F2d 334 (7th Cir 1985) – 'The purpose is to reduce the cost of information to consumers by making it easy for them to identify products or producers with which they have had either good experiences, so that they want to keep buying the product (or buying from the producer), or bad experiences, so that they want to avoid the product or the producer in the future.' at 338; *Scandia Down Corp v Euroquilt*, 772 F2d 1423 (7th Cir 1985) – 'Trademarks help consumers to select goods. By identifying the source of the goods, they convey valuable information to consumers at lower costs. Easily identified trademarks reduce the costs consumers incur in searching for what they desire, and the lower the costs of search the more competitive the market.' at 1429; *Blau Plumbing, Inc. v. SOS Fix-It, Inc.*, 781 F.2d 604 (7th Cir, January 14, 1986) – 'The goal of trademark protection is to allow a firm to affix an identifying mark to its product (or service) offering that will, because it is distinctive and no competitor may use a confusingly similar designation, enable the consumer to discover in the least possible amount of time and with the least possible amount of head-scratching whether a particular brand is that firm's brand or a competitor's brand.' at 609.

been—to improve the quality of information in the marketplace and thereby reduce consumer search costs.’⁵⁶¹ However, economic justifications are not without their critics and flaws.

As explained by McKenna these theories have –

a broader methodological flaw in some application of the law and economics approach. Law and economics scholars gained prominence in trademark discourse, as they did in many other contexts, by claiming that economic analysis explained various legal doctrines. Underneath the formal doctrinal means through which courts reached their results, they argued, many legal rules were best understood as attempts to promote economic efficiency. Courts simply lacked the necessary sophistication to articulate the true bases of their decisions. The law and economics scholars then relied on this descriptive account to lend legitimacy to their normative conclusions; economic analysis not only explained legal doctrines, but efficiency was the right goal for the law to pursue.

This form of intellectual bootstrapping cannot be sustained, however, when the foundational descriptive claims prove erroneous. And at least in the trademark context, courts were not pursuing economic efficiency when they developed the doctrine. They sometimes reach outcomes in trademark cases that improved the quality of information in the marketplace. But they also tolerated substantial confusion in many cases. Rather than forcing square pegs into the round holes of economic efficiency, advocates of the efficiency approach should acknowledge that courts traditionally operated under a different theoretical framework and be upfront about their own normative agenda.⁵⁶²

In *The economic rationale of trade marks: an economist’s critique*,⁵⁶³ Jonathan Aldred approached the economic explanations of trademark protection in a more economics substantive manner. In Aldred’s opinion the law-and-economics approach⁵⁶⁴ ‘rests on a very particular approach to economics, one arguably not shared by the majority of economists. Law-and-Economics rests on what might be loosely termed ‘Chicago economics’...’ and thus ‘assumes that individuals are self-interested, in a narrow sense:

⁵⁶¹ McKenna (n 232) pg 1844.

⁵⁶² Id. at pg 1842.

⁵⁶³ Jonathan Aldred, ‘The economic rationale of trade marks: an economist’s critique’ in Lionel Bently, Jennifer Davis, and Jane Ginsburg (eds), *Trade Marks and Brands: An Interdisciplinary Critique* (Cambridge University Press 2008), pg 267.

⁵⁶⁴ This being the approach also taken by Landes and Posner (n 558).

individuals always maximize their own personal material benefits. Law-and-Economics, then, is the world of that caricature, *homo economicus*.⁵⁶⁵ In the end, Aldred -

remains surprised by the dominance of this economic worldview in thinking about trade mark law. Chicago economics no longer reflects mainstream economic thought (if it ever did), and the gap has recently widened with developments in behavioural economics, happiness research and our understandings of the ubiquitousness of increasing returns to scale.⁵⁶⁶

The economic justification for the protection of trademarks is now questioned not only from legal scholarship, but also from the economic world from which it sprung. However, both of these lines of critique do not account for the practical use of trademarks either historical or current.

The economic approach as presented by Landes and Posner consistently employed the idea of a repeat customer. Many of their assumptions were built from the value that a consumer could find what they liked or avoid what they did not. Though a consumer may have a wealth of repeat experience with daily wares such as groceries or cleaning products, extending the idea of repeat experience to all goods and services in which trademarks are utilized and protected begins to highlight a foundational flaw in the theory. The experience that a consumer would have with daily wares differs significantly from that which one would have with vehicles, medical services, home furnishing, or any number of other products and services where the protection of trademarks would be no less necessary.

The economic theory of trademarks also emphasizes that the protection of trademarks incentivizes an increase in product or service quality.⁵⁶⁷ 'A trademark also may induce the supplier of goods to make higher quality products and to adhere to a consistent level of quality.'⁵⁶⁸ Leaving aside the obvious issue that quality is an entirely subjective metric, it again is not supported by the many situations where a trademark user is not motivated to ever increase the subjective quality of their goods or services or may, in

⁵⁶⁵ Aldred (n 563) pg 267.

⁵⁶⁶ Id., pg 281.

⁵⁶⁷ Landes and Posner (n 558) at 270.

⁵⁶⁸ *Scandia Down Corp v Euroquilt*, 772 F2d 1423, 1429 (7th Cir 1985).

fact, seek to reduce a quality. There are many products and services that occupy a specific market segment and are targeted not to the best quality but to that specific segment. One could consider house-labeled alternatives to brand items, such as grocery items, the products of discount type retailers, or the mass market elements of house brands.⁵⁶⁹ Though marketers may describe such products as ‘quality’, it is certainly obvious that they were created for a specific market segment at the expense of ‘high quality’. To assume, as the economic theory of trademarks does, that a trademark owner is constantly striving for some theoretical increase in ‘quality’ is to ignore the realities of commerce and trademark use. Indeed, the value of trademark protection is merely to communicate a specific attributes, which may be ‘good’ quality or ‘mediocre’ quality, or even the attributes of ‘expensive’ or ‘cheap’ which some may equate to the same.

Whether the protection of trademarks may be evaluated through an economic theory, or the effect of the use of trademarks may be seen in an economic model, does not support the idea that economic theories explain the establishment of, and justification for, trademarks and their protection and use. Indeed, the economic commentary on trademarks has little effect on the fundamental function - that of being a distinguishing communicator of certain specific attributes,⁵⁷⁰ nor the primary purpose of trademarks – the accommodation and balancing adequately of the interests of traders, consumers, and competitors to achieve fair competition.⁵⁷¹

4.6.2. Uses as ‘functions’ or ‘purposes’

Beginning in section 4.1 an understanding of trademarks through the functions that a trademark performs was articulated and a definition of what a trademark is was provide

⁵⁶⁹ *Kjennetegnssrett* (n 411) when discussing the Kodakregelen in varemerkeloven – ‘Det er intet til hinder for at varemerker for eksempel høyst ordinære halspastiller eller enklere husgeråd av middels kvalitet kan nyte godt av det utvidede vernet hvis merket bare er tilstrekkelig godt kjent. Også slike varemerker kan ha en høy goodwillverdi. Endog et varemerke som er kjent for varer av lav kvalitet kan komme i betraktning, dersom det samtidig er kjent som et merke for lavprisvarer.’ At pg 370-71. (‘There is nothing to prevent trademarks such as, for example, the most common necklaces or simple medium-quality household appliances to benefit from the extended protection if the mark is only well-known. Also such trademarks may have a high goodwill value. Even a trademark that is know for low-quality goods can be taken into consideration, if it is also known as a mark for low cost products.’).

⁵⁷⁰ See section 4.2.2; *Jack Daniel’s Properties, Inc v VIP Products, LLC*, 143 S Ct 1578, 599 US ___, 14 (2023)

⁵⁷¹ See section 4.6.

in 4.2.2 – *a distinguishing communicator of certain specific attributes*. The immediately preceding sections explored the purpose of a trademark and the reasoning behind their protection. The articulation of a trademark in such a bare bones manner was intentionally distilled to the essence of what a trademark is, what it does, and why. With this distilled understanding it is possible to understand trademarks more thoroughly in the historical environment, evolution, and placement within modern usage and protection systems.

In many situations the definition of a trademark becomes encumbered with elements that resemble not a trademark's structure or purpose, but rather what functions it *can* perform and the manner in which it is used. In particular, the ability for a trademark to guarantee the quality of the goods or services, demonstrate investment, or be used for advertising have all been found in a commentator or court drafted definition of a trademark or have been elevated to the importance of a core element of a trademark. 'Those functions include not only the essential function of the trade mark, which is to guarantee to consumers the origin of the goods or services ('the function of indicating origin'), but also its other functions, in particular that of guaranteeing the quality of the goods or services in question and those of communication, investment or advertising.'⁵⁷² While each of these is most certainly a function that a trademark *can* perform, they must be understood in a broader context and not be elevated to a defining element of a trademark.

In exploring the core definition of a trademark, it was necessary to place the understanding of 'source' and 'commerce' in a more contextual and practical landscape. The same must be done for the understanding of these uses of a trademark – most importantly because they are not requirements but are rather possibilities.

⁵⁷² C-236/08 C-238/08 Google Case, paragraph 77; see also *Kjennetegnsett* (n 411) pg 26.

4.6.2.1. Quality

It is often asserted that trademarks are the indicators, protectors, or incentivisation for the quality of a product or service.⁵⁷³ While this may be true in many situations, it does not follow that it is an essential element of a trademark.

The first criticism with a quality-based view of trademark protection arises from the subjective nature of the term 'quality' itself. To discuss the increase, decrease, or maintenance of quality necessarily assumes that there is an objective scale by which it can be measured. For many products and services, this is an impossibility.

Additional complications for a quality-based view of trademarks become exposed when viewed through the practical use of protectable marks. There is little question that protection of a distinguishing mark is not dependent upon a disparity in the quality of competing or infringing goods.⁵⁷⁴ Or to view such a situation through a different lens, to state that a trademark indicates quality would then absolve any competing product of an identical or similar quality from liability for infringement. Furthermore, to understand trademarks as indicators of quality will, in certain circumstances, bar such a mark from protection as being merely descriptive.⁵⁷⁵

Some commentators claim that a trademark as an indicator of quality is actually an indicator of consistent quality. This explanation, however, has its own logical missteps. If indeed a trademark is an indicator of consistent quality, one must question what happens when a source decides to change the quality of the product or service that they offer. Because the Coca-Cola Company decided to change the recipe of Coca-Cola in the late 1980's does that necessarily mean that they lost protection for the Coca-Cola trademark? Or because Mercedes-Benz changed the place of manufacture for certain vehicle models from Germany to Georgia, USA does that mean that the consistent

⁵⁷³ An example of this mentality was seen in the economic theory of trademarks.

⁵⁷⁴ *Blofeld v Payne*, 110 ER 509 (1833); *Taylor v Carpenter*, 2 Woodb & M 1, 10 Law Rep 35 (D Mass 1846).

⁵⁷⁵ *Amoskeag Manufacturing v Trainer*, 101 US 51 (1879) – '...letters or figures which, by the custom of traders, or the declaration of the manufacturer of the goods to which they are attached, are only used to denote quality, are incapable of exclusive appropriation; but are open to use by anyone, like the adjectives of language.' at 55; however, compare to quality indicating marks such as US0529746, US0684888 – BLUE RIBBON; US0704081, US1313998, 1944676 – A-1; US1760282.

quality indication function of the Mercedes-Benz trademark was compromised? These may seem like wild questions with obvious answers – that the source necessarily retains their rights; that they may change their product as they wish.⁵⁷⁶ However, this was not always a clear position.

As an example, in the early case of *Bloss v Bloomer*,⁵⁷⁷ the New York Supreme Court appeared to place a mark's indication of the quality and source of goods above all other interests. What could be interpreted as a licensing contract was held to be void as against public policy. The defendant had purchased a number of empty seed bags from the plaintiff, which he was to fill with good quality seed and sell in a specific geographic area. The defendant, however, filled the bags with poor quality seed and sold them in areas outside of the specific county designated in the contract. The Court reasoned that

but if it be a crime to counterfeit labels, words or devices previously appropriated to distinguish property, or to vend goods thus stamped, without disclosing the fact to the purchaser, it is equally an offense against the spirit of the law, equally injurious to trade and commerce, and equally an imposition upon the public to palm off spurious goods under cover of genuine labels and devices.⁵⁷⁸

The court also interestingly noted that 'perhaps the provision in the contract, that the defendant should fill the bags with seeds of a good quality, might save the parties from a conviction for a conspiracy to commit an act "injurious to trade or commerce"...'.⁵⁷⁹

Furthermore, though in different circumstances, the United States Court of Appeals for the Seventh Circuit seemed to take a very pro-public protection stance when it stated that

It must be remembered that the trade-mark laws and the law of unfair competition are concerned not alone with the protection of a property right existing in an individual, but also with the protection of the public from fraud and deceit ... and it is obvious that the right of the public to be so protected

⁵⁷⁶ In a more recent example one could question the continued validity of the Toblerone trademarks in the United Kingdom after they chose to reduce the amount of chocolate in their products, while at the same time significantly changing the actual shape – and possibly trademark – of their chocolate bars. <http://www.bbc.com/news/uk-37904703> (last accessed 20 June 2024).

⁵⁷⁷ 23 Barb 604 (NY Sup Ct 1857).

⁵⁷⁸ Id. at 610.

⁵⁷⁹ Ibid.

is a right which transcends the rights of the individual trade-mark owner and is beyond his power to waive.⁵⁸⁰

Though quality may be an attribute that a trademark references and trademarks, or rather the desire to maintain a satisfied customer base that recognises the mark, may even provide an incentive for maintaining consistent or improving quality, this should not be considered a foundational aspect of a trademark or a requirement for protection.

The variety of situations in which a trademark may find protection outside of a question of quality are manifest. This is especially true when taking into account collective and certification marks. Indeed, the specific attribute that is being guaranteed to the public in the use of a collective or certification mark may have nothing to do with objective or subjective quality. Even though a professional may be a member of their professional association, and thus able to advertise the membership by use of a collective trademark, that membership denotes no indication of the quality of service or product that one will receive.

Similarly, even though a product or service may carry a certification mark, that mark in no way speaks to the quality of that product or service only that it conforms to a certain standard. Consider the wide range of quality in USB cables – which would need to meet minimum standards in order to carry the USB certification mark,⁵⁸¹ or the vast difference between the quality of PC computers even though they may all have gone through WHQL⁵⁸² certification.⁵⁸³ Even a certification program such a ‘Fair Trade’ does not mean quality, merely conformance to a standard.⁵⁸⁴

⁵⁸⁰ *Stahly v Jacobs*, 183 F2d 914, 917 (7th Cir 1950).

⁵⁸¹ http://www.usb.org/developers/logo_license/ (last accessed 20 June 2024).

⁵⁸² Windows Hardware Quality Labs.

⁵⁸³ [https://msdn.microsoft.com/en-us/library/dn423132\(v=vs.85\).aspx](https://msdn.microsoft.com/en-us/library/dn423132(v=vs.85).aspx) (last accessed 20 June 2024).

⁵⁸⁴ <https://www.fairtrade.net/standards.html> (last accessed 20 June 2024).

Perhaps the most illustrative example of the disconnect between quality and a mark, when it comes to certification trademarks, is the matter of ‘Dolphin Safe’ labeling of tunafish in the United States.⁵⁸⁵

Most Americans think that the existence of a dolphin-safe label means that no dolphins were harmed when the tuna were caught. In truth, the label only means that one particular fishing method was not used in one particular part of the ocean.⁵⁸⁶

The case of ‘Dolphin Safe’ labeling in the United States highlights not only that a certification mark only communicates to the public the attribute of conforming to a certain standard, but also that it is important for the public to seek out and understand that standard.⁵⁸⁷

4.6.2.2. Advertising

Another aspect of trademark use and protection that some see as a central function is that of the use of trademarks in advertising. ‘Finally, a third right out of the series of rights incorporated in the right to use a trademark is the trademark owner’s right to use his mark in advertising...’⁵⁸⁸ Much like the examination of quality before it, this feature of trademarks is one that arises from use and, indeed, is an optional use.

Though it is unquestionable that the use of trademarks in advertising is of value, and the protection of those marks and their misuse by others must be secured, that does not raise advertising to the level of a core or necessary purpose – such as distinguishing of products or services. Indeed, there are many examples in practice of mark users foregoing the advertising of their products, or advertising in very selective manners, and yet maintaining substantial value. One could compare the advertising activities of luxury

⁵⁸⁵ Though this is a state sponsored, statutory implemented certification system, it provides a valuable example of the principles. <http://www.nmfs.noaa.gov/pr/dolphinsafe/dsp.htm>; <http://www.nmfs.noaa.gov/pr/dolphinsafe/dolphinsafemark.htm> (last accessed 20 June 2024).

⁵⁸⁶ K William Watson, ‘Dolphin Safe’ Labels On Canned Tuna Are A Fraud’, *Forbes*, 29 April 2015, available at <https://www.forbes.com/sites/realspin/2015/04/29/dolphin-safe-labels-on-canned-tuna-are-a-fraud/#6f36b917295e> (last accessed 20 June 2024); see also 16 USC § 1385.

⁵⁸⁷ This certification program is the subject of a dispute between Mexico and the US, see US – Tuna II (Mexico) WT/DS381 https://www.wto.org/english/tratop_e/dispu_e/cases_e/ds381_e.htm (last accessed 20 June 2024).

⁵⁸⁸ *WIPO Handbook* (n 223) s 2.451, pg 85.

brands to brands of broader market segments.⁵⁸⁹ Or even situations in which trademark owners have been prohibited from advertising.⁵⁹⁰ In these situations if advertising were to be considered as central a function to a trademark as that of being a distinguishing communicator, it would lead to unreasonable results.

Furthermore, holding advertising in the same esteem as the central function of a trademark does not take into consideration the many protectable uses of a trademark that have little to do with advertising, such as those relating to spare parts, or situations where a mark is protected outside of advertising, such as cross border protection.

In essence, advertising is undoubtedly a pervasive and valuable use of a trademark, yet it must be understood in the overall context of what a trademark is and can do, and find its place merely as a possible protected use of a trademark not a central function.

4.6.2.3. Uses as functions summary

Much like 'source' and 'commerce', any use or possible function of a trademark must be viewed in the proper context and perception of those to which the trademark is targeted. To some it might indicate a consistent quality, to others it might indicate a degree of quality, it might indicate a lifestyle that the consumer would like to emulate or make a statement in which they want to join. In any case, however, each of these is a specific attribute that is being communicated by the trademark in an effort to distinguish – and thus the definition of a trademark as a distinguishing communicator of certain specific attributes remains a proper expression of the unencumbered foundational trademark. It is that distinguishing function and that communication that is key to a trademark and motivation for protecting them.

⁵⁸⁹ Jean Halliday, 'Ultraluxury cars avoid traditional marketing path: prestige brands such as Ferrari, Rolls-Royce spend little on ads,' *AdvertisingAge*, 27 April 1998, available at <http://adage.com/article/news/ultraluxury-cars-avoid-traditional-marketing-path-prestige-brands-ferrari-rolls-royce-spend-ads/66023/> (last accessed 20 June 2024).

⁵⁹⁰ Directive 2003/33/EC of the European Parliament and of the Council of 26 May 2003 on the approximation of the laws, regulations and administrative provisions of the Member States relating to the advertising and sponsorship of tobacco products.

One must be careful to not allow the ancillary functions or possible uses of a trademark to colour the vision of what a trademark truly is. As stated by Kur and Dreier, '[a]ll those effects form an important part of economic reality. However, under legal aspects only one of them—the function of indicating commercial origin—is *indispensable* in the sense that trade mark law would not operate as such if no protection were granted against disruptions of that function by third parties.' Of course this statement must be tempered by a broader understanding of the distinguishing function of a trademark as outlined above in this work, especially where it references commercial origin.

5. Public Perception and Trademarks

While the above reoriented a foundational definition of a trademark as *a trademark is a distinguishing communicator of certain specific attributes* and articulated various issues with current definitions having become bloated with unnecessary and sometimes unhelpful elements, there is one aspect of trademarks which is critical and common to any understanding – that being the Public Perception. To whichever theory of trademark protection one subscribes, whether it be the protection of the public, the producer, a balance between the two, or even a strictly economic model, and for whatever functions one sees the value of trademark protection, the power that the public perception holds over trademark law is undeniable.

Whether deception of the public be a substantive ground or an evidential test ... it is, without a doubt, a factor which enters into every court's consideration of what it shall find to be dishonest and unfair dealing and of what it shall require for the protection not only of the owner...but those constituting the public. This statement captures the essence of a paradox that those suggesting trademark law was originally producer-oriented fail to account for. That in order to protect the trader and other competitors, the courts have had to focus on consumer interest to ascertain first, whether the allegedly dishonest act was one from which the law provided a remedy and, second, whether the extent of the redress necessary to preserve adequately the producers' commercial interests.⁵⁹¹

In fact the role that the public plays is much larger than even that suggested by Ramirez-Montes above. The perception of the public plays a part in nearly all aspects of the protection of a trademark, beginning at its very existence. Though the protection of the public goal in trademark law is only one half of the identity of trademarks, the impact of this goal and indeed of the public on the nature, value, effectiveness, and enforceability of trademarks themselves cannot be understated. 'The value of a trademark is, in a sense, a "hostage" of the consumers; if the seller disappoints the consumer, they respond by devaluing the trademark. The existence of this hostage gives the seller another incentive to afford consumers the quality of goods they prefer and expect.'⁵⁹²

⁵⁹¹ César Ramirez-Montes, 'A Re-examination of the Original Foundations of Anglo-American Trademark Law' (2010) 14 *Marquette Intellectual Property Law Review* 91, 146 (quoting *Rosenberg v Elliot* 7 F.2d 962, 966 (3rd Cir. 1925)).

⁵⁹² *Scandia Down Corp v. Euroquilt, Inc.*, 772 F.2d 1423, 1430 (7th Cir. 1985).

This power of the public to shape the boundaries and nature of specific marks can be illustrated in many different circumstances. It can be both negative, in that the protection afforded by a certain mark is diminished, or it can even be positive, increasing or maintaining the protection. The public perception and understanding of a mark can even affect the very existence of a protectable mark. As discussed in section 4.1, an indispensable element of a functioning trademark is its ability to distinguish, and in order to do so it must be distinctive. However,

[t]he test of whether a trademark is distinctive is bound to depend on the understanding of the consumers, or at least the persons to whom the sign is addressed. A sign is distinctive for the goods to which it is to be applied when it is recognized by those to whom it is addressed as identifying goods from a particular trade source, or is capable of being so recognized.⁵⁹³

Indeed, the public holds not only the ‘value’ of the trademark hostage, but the entirety of its being. As stated by Oliver R Mitchell when speaking of the necessity of use in ‘dressing up’ cases –

...obviously the general rules applicable to trade marks may be applied, including the fundamental one that actual user[sp] by the plaintiff is necessary to establish a right, and the rules governing the length of user[sp] necessary to establish a right. These rules arise out of the nature of the right, which is established only by knowledge on the part of the public, and obviously such knowledge cannot be created without user[sp], and cannot exist apart from the user[sp]...⁵⁹⁴

Without use the public would have no recognition of the mark itself, and without that recognition there could be no protectable mark.

Even for those who support the idea of protection through the property aspects of a trademark, the perception of the public still plays a vital part of the trademark enquiry. ‘But it should be held in mind that property in matters such as we are considering differs of necessity, in many important particulars, from property in other subjects of

⁵⁹³ *WIPO Handbook* (n 223) section 2.344, page 72.

⁵⁹⁴ Oliver R Mitchell, ‘Unfair Competition’ (1896) 10 *Harvard Law Review* 275, 285; see also *Hanover Star Milling Co. v. Metcalf*, 240 US 403 (1916) 36 S.Ct 357, 60 L.Ed. 713.

ownership. A trade mark, a business name, or a trade name, derives its value from the esteem in which it is held by the public...'.⁵⁹⁵

Indeed, as stated by Rogers –

[i]f a trade-mark has value it is because it means something, because it indicates to the purchaser that a certain goods have a certain commercial origin, and if the fact of their having this origin makes them desirable and more readily accepted by the public than goods having a different origin, then the trade-mark is of value exactly as the information it conveys is of value. It is a sign that the article to which it is applied is the one which the consumer by faith or experience believes to be good. It is a name, symbol or device which distinguishes the merchandise of one producer from that of others.⁵⁹⁶

There many manners in which the public perception affects the law of trademarks, most notably being the questions encountered during infringement proceedings. However, at the foundational validity or existence level there are two areas that are of primary concern. Those being the public perception as it relates to the mark itself and the public perception of the source.

5.1. The relevant public

It should be noted here that when discussing the public, it is more accurate to refer to the 'relevant public'. A mark is not required to be known by all and can only be evaluated according to the market segment to which it is directed. When speaking of distinctiveness WIPO stated that it could only be determined with 'the understanding of the consumers, or at least the persons to whom the sign is addressed.'⁵⁹⁷

Similarly, Lassen / Stenvik relevantly state –

Omsetningskretsen er helt enkelt den krets slike varer eller tjenester som det gjelder falbys til eller avtas av—de forbrukere, brukere eller mellomhandlere som er (aktuelle eller potensielle) avtagere eller formidlere av slike varer eller tjenester. For vise dyre spesialvarer—eller for svært spesielle varer i det hele—kan det være en Ganske liten gruppe, for margarin og tannpasta kan det være hele eller iallfall en stor del av landets befolkning. <<Det relevante offentlighed er den, som dette varemærke er relevant for, når henses til den

⁵⁹⁵ Oliver R Mitchell, 'Unfair Competition' (1896) 10 Harvard Law Review 275, 281-82.

⁵⁹⁶ Rogers (n 39) pg 53.

⁵⁹⁷ WIPO Handbook (n 223) section 2.344, page 72.

udbudte vare eller tjenesteydelse, og kan enten være den brede offentlighed eller en mere specialiseret kreds...>⁵⁹⁸

The idea of the relevant public was also explored in the EU case of *Björnekulla v Procordia*⁵⁹⁹ - 'depending on the features of the product market concerned, the influence of intermediaries and decisions to purchase, and thus their perception of the trade mark, must also be taken into consideration.'⁶⁰⁰

When evaluating the relevant public for a black metal band, Oslo tingsrett stated -

Det aktuelle omsetningskrets utføres her av det spesialiserte og forholdsvis <<smale>> marked for black metal musikk i form av plater, konserter og <<fan>>-artikler, men omfatter for dette marked hele den vertikale omsetningskjede bestående av blant annet artister, produsenter, distributører, arrangører og slutt kunder.⁶⁰¹

Thus, when referencing the 'public' it is necessary to understand that as the relevant public. The relevant public being the segment of actual and potential interested parties to which the use of a trademark is directed. While also taking into consideration the nature of the goods and services, the channels of distribution, the targeted market, and in essence the entirety of circumstances surround the goods and services.

5.2. Public Perception and the Trademark

5.2.1. Knowledge of the mark – geographically

One of the first situations in which the public perception is critical is in determining whether the public is aware of the mark at all, and its trademark usage. Fundamentally,

⁵⁹⁸ *Kjennetegnsrett* (n 411) pg 244 (quoting EU Case C-301/07 Pago). ('The trade area is simply the circles in which such goods or services are offered for sale to or taken up by consumers, users, or retailers which are actual or potential collectors or communicators of such goods and services. With a view to expensive goods-or very specialized goods at all – it can be a very small group, for margarine and toothpaste it can be the whole, or in any case a large part, of the country's people. <<The relevant public is the one which this trademark is relevant for, in terms of the offered product or service and may either be the general public or a more specialized group...>>').

⁵⁹⁹ ECJ Case C-371/02, *Björnekulla Fruktindustrier v Procordia*, [2004] ECR I-5791.

⁶⁰⁰ at paragraph 25; See also *Bayer v United Drug* 272 F 505 (SDNY 1921) – where a decree was issued to prevent the use of the term Aspirin when dealing with 'manufacturing chemists, wholesale or retail druggists, or physicians', but the defendant was free to use the term in sales to the public.

⁶⁰¹ TOSLO-2008-140784, pg 8 ('The relevant trade area is shown here are the specialized and relatively <<narrow>> market for black metal music in the form of records, concerts and <<fan>> articles, but for this market the entire vertical sales chain includes artists, manufacturers, distributors, organisers, and end customers.').

and without assistance of the operation of a registration system, the rights to a trademark essentially extend as far as they are known by the public.

The property in a trademark is not limited in its enjoyment by territorial bounds, but may be asserted and protected wherever the law affords a remedy for wrongs, is true in a limited sense. Into whatever markets the use of a trademark has extended, or its meaning has become known, there will the manufacturer or trader whose trade is pirated by an infringing use be entitled to protection and redress.⁶⁰²

In essence the protection of a trademark begins first with the knowledge of the public of that mark and its usage. In the inverse wording, if the public is not aware of the mark, or its trademark usage, then no amount of invoking trademark protections will overcome the fact that the mark as a trademark does not exist. Overcoming this geographically, and exposure, bounded limit to trademark protections was one of the motivating factors behind the establishment of trademark registration systems. Indeed, one of the benefits typically associated with the registration of a trademark is that it provides nationwide notice of the use of that mark in a trademark manner, and with that presumes that the public within a state's borders is aware of the mark as a trademark.⁶⁰³

Nationwide notice attached to trademark registrations, however, has not eliminated the relevance of the public being aware of the existence and use of a trademark. This is especially true in jurisdictions that maintain provisions for the protection of trademarks without registration such as the United States and Norway. 'Geographic considerations are also particularly relevant where a plaintiff holds only common-law trademark rights in a mark because it is well-established that the scope of protection accorded his mark is coextensive only with the territory throughout which it is known and from which it has drawn its trade.'⁶⁰⁴

⁶⁰² *Hanover Star Milling Co v Metcalf*, 240 US 403, 415-6, 36 S Ct 357 (1916); see also *varemerkeloven §4*, 'for et varemerke som er velkjent her i riket', and, *The Eastman Photographic Materials Company Ltd., and Another v. The John Griffiths Cycle Corporation, Ltd., and The Kodak Cycle Company, Ltd., and In the Matter of The Trade Mark No. 207,006 (Kodak)*, [1898] 15 RPC 105

⁶⁰³ *varemerkeloven §3*; 15 USC § 1072.

⁶⁰⁴ *Tana v Dantanna's*, 611 F3d 767, 780 (11th Cir 2010).

In the Norwegian *varemerkeloven* this geographic aspect takes the form of provisions relating to marks that acquire protection through establishment (*innarbeidesle*).

Et varemerke anses innarbeidet når og så lenge det i omsetningskretsen her i riket for slike varer eller tjenester det gjelder, er godt kjent som noens særlige kjennetegn. Foreligger innarbeidelse bare i en del av riket, gjelder eneretten bare for dette området.⁶⁰⁵

It is easily understood how the exposure and understanding of the public can limit the protection of a distinguishing mark to a certain limited geographic area within a jurisdiction. However, this is not the only manner in which the public's recognition of a mark as a trademark affects its protection. As the scope of protection follows the area in which it is known, conceptually there is no reason why that protection cannot be extended outside of the borders of a specific jurisdiction.

In the modern trademark system this extraterritorial scope of protection is widely accepted for what has been termed 'well known' or 'famous' marks and is enshrined in Article 6*bis* of the Paris Convention. Which –

obliges a member country to refuse or cancel the registration and to prohibit the use of a trademark that is liable to create confusion with another trademark already well known in that member country. The effect of this Article is to extend protection to a trademark that is well-known in a member country even though it is not registered or used in that country.⁶⁰⁶

These protections are also found integrated into the national laws. For example, *varemerkeloven* §3 in Norway articulates that rights through *innarbeidelse* only require that a mark be 'godt kjent som noens særlige kjennetegn'. This does not mean that a mark must be used in Norway – 'at varemerket skal være *brukt* i Norge, kreves imidlertid ikke'.⁶⁰⁷ Thus, if a mark is well known for specific goods or services, irrespective of whether it has been used within the jurisdiction, it is possible that it would attract the protection of the relevant trademark laws.⁶⁰⁸ Critically, this protection

⁶⁰⁵ *varemerkeloven* §3. ('A trademark is considered established when and so long as it in the trade area here in the Kingdom for such goods and services it applies, is well known as the particular mark of someone. If establishment exists only in part of the Kingdom, the exclusive rights apply only to this area.').

⁶⁰⁶ *WIPO Handbook* (n 223) s5.82, pg 251.

⁶⁰⁷ *Kjennetegnsrett* (n 411) pg 244.

⁶⁰⁸ TOSLO-2003-9203A – RG-2004-1542 (Google); PS-2007-7628 REDBULL.

is independent of that provided to ‘well-known’ or ‘famous’ marks through varemerkeloven §4.

5.2.2. Knowledge of the mark – conceptually

Establishing that the public is aware of the mark and of its use, however, does not necessarily mean that a mark then attracts the protection of trademark laws. It is still necessary to consider the functions of a trademark. As was articulated in section 4.3, a trademark must distinguish between the products and services of one from those of another – and in order to be capable of this it must have distinctiveness. The assessment of distinctiveness is inherently connected to the perception of that mark in the minds of the relevant public. ‘The test of whether a trademark is distinctive is bound to depend on the understanding of the consumer, or at least the person to whom the sign is addressed. A sign is distinctive for the goods to which it is to be applied when it is recognized by those to whom it is addressed as identifying goods from a particular trade source, or is capable of being so recognized.’⁶⁰⁹

Essentially, in order to find a mark distinctive the relevant public must be capable of understanding that mark as distinguishing – setting it apart from others. It is within this construct that the tests of non-functionality, descriptiveness, and fair competition are found. In many ways distinctiveness is the threshold conceptual equivalent to the geographic familiarity boundaries we explored above. The use of a mark must extend to the geographically relevant public, but it must also occupy a distinctive nature within the mind of that relevant public to qualify as a functioning trademark.⁶¹⁰

Most jurisdictions deal with the public perception of a mark, with regard to distinctiveness, by evaluating a mark according to the spectrum of distinctiveness – from weak (descriptive) to strong (fanciful), as discussed in 4.3. Once the mark’s relative strength of distinctiveness is determined the Courts will then find certain protections, requirements, or tests that attach to that mark’s placement upon the spectrum.

⁶⁰⁹ *WIPO Handbook* (n 223) s 2.344, pg 72.

⁶¹⁰ See section 4.3.

Upon that spectrum of the strength of distinctiveness there are certain levels that are incapable of being distinctive enough to function as a trademark – generic marks, as well as those which can begin as not having the necessary distinctiveness but which may acquire such – descriptive marks. ‘Marks which are merely descriptive of a product are not inherently distinctive. When used to describe a product, they do not inherently identify a particular source, and hence cannot be protected. However, descriptive marks may acquire the distinctiveness which will allow them to be protected...’.⁶¹¹ In the determinations of genericness, acquired distinctiveness, or really in any evaluation of distinctiveness, it is the public perception that is pivotal and determinative.

5.2.2.1. *Secondary meaning / acquired distinctiveness*

The terms ‘secondary meaning’ and ‘acquired distinctiveness’ are near practically synonymous. Commentators and courts connect the two terms by stating that a descriptive mark can gain a secondary meaning outside of its descriptive meaning, and it is through that secondary meaning that the mark acquires the distinctiveness necessary to function as a trademark.⁶¹² Thus reference to one term will necessarily call upon the other.

It is within the area of acquired distinctiveness that the perception of the public is most visible.⁶¹³ Indeed, ‘[t]he fact is that almost any symbol can achieve status as a legal trademark if it has achieved that degree of buyer association and recognition which the law calls secondary meaning.’⁶¹⁴

If a designation used as a mark is classified as *not* being “inherently distinctive,” then to achieve trademark status, that designation must be proven to have acquired distinctiveness as a mark in buyers’ minds. Secondary meaning is a new and additional meaning that attaches to a non-

⁶¹¹ *Two Pesos v Taco Cabana*, 505 US 763, 769.

⁶¹² McCarthy (n 225) §15:1.

⁶¹³ Though seen particularly when dealing with descriptive terms, there are other situation in which acquired distinctiveness is required. McCarthy lists ‘Descriptive Marks; Geographically Descriptive Marks, Personal Name Marks; Corporate, Business and Professional names which fall into the preceding categories; Title of Single Literary Works; Descriptive Titles of a Literary Series; Noninherently Distinctive Designs and Symbols; Noninherently Distinctive Trade Dress in Packaging; and Trade Dress in Product Shapes’ as mark categories that require acquired distinctiveness for protection (*McCarthy*, above n225, §15:2); Larssen and Stenvik reference marks of an physically insignificant nature that may gain protection through acquired distinctiveness – *Kjennetegnsrett* (n 411) pg 60 *et seq.*; additionally, the public perception is central to any determination of distinctiveness.

⁶¹⁴ McCarthy (n 225) §15:3.

inherently distinctive word or symbol. The public then uses that word or symbol as a trademark or service mark to identify and distinguish a single commercial source.⁶¹⁵

In order to clarify the working of acquired distinctiveness with regard to descriptive terms McCarthy provides the example of BEST being used on dairy products –

Take as an example, a descriptive, self-laudatory word like BEST for milk. The word “best” is well-known in the language and when applied to milk, connotes to buyers a laudatory, self-serving assertion of quality. ... Extensive advertising and sales, over a period of time, by the seller of BEST milk, may give the word “best” a new and different meaning to milk buyers.⁶¹⁶

In this example, though the term ‘best’ could be considered descriptive at the outset, through use, advertising, or some other means it can become associated in the mind of the relevant public with a certain source. Essentially it can achieve the functional goal of trademarks – to be a distinguishing communicator of a certain specific attribute (in this case source). ‘The prime element of secondary meaning is a mental association in buyers’ minds between the alleged mark and a single source of the product...’⁶¹⁷ taking into account all of the circumstances surrounding the use of the mark and the relevant market.⁶¹⁸

Even though the association in the mind of the public can be to a source, the concept of ‘source’ must still be read with the expanded understanding. That is, even in a situation of acquired distinctiveness it is not necessary that the public must specifically identify or know what the source is, it must merely be an association in the mind of the public with a consistent source.⁶¹⁹

⁶¹⁵ McCarthy (n 225) §15:1; see also *Two Pesos v Taco Cabana*, 505 US 763 (1992) (‘ The general rule regarding distinctiveness is clear: an identifying mark is distinctive and capable of being protected if it *either* (1) is inherently distinctive *or* (2) has acquired distinctiveness through secondary meaning. - at 769).

⁶¹⁶ McCarthy (n 225) §15:6.

⁶¹⁷ *Id.*, §15:5; see precedent cited in §15:5.

⁶¹⁸ See *Windsurfing Chiemsee Case* (C-108/97 and C109/97, EU:C:1999:230); C-20/14, ECLI:EU:C:2015:167.

⁶¹⁹ See section 4.2 supra, and 5.3infra discussing source; also *McCarthy* (n223) §15:8.

This raises questions on how one is capable of determining the association within the mind of the public. In general, this is an issue of fact that must be supported by evidence. Evidence commonly offered in support of a claim of acquired distinctiveness includes duration of the use of the mark, costs, extent, and scope of advertising efforts, sales figures, market surveys, and actual confusion.⁶²⁰

However, it must be remembered that the association in the mind of the public is always the determining factor. As highlighted by the US Circuit Court of Appeals for the Second Circuit when evaluating the trademark protection for cellophane –

It, therefore, makes no difference what efforts or money the DuPont Company expended in order to persuade the public that ‘cellophane’ means an article of DuPont manufacture. So far as it did not succeed in actually converting the world to its gospel it can have no relief.⁶²¹

In essence, though evidence may be offered and claims may be made that a mark has acquired the distinctiveness necessary to function as a trademark, and therefore the protection of trademark law, this is always determined by the actual association in the mind of the relevant public.

This, indeed, leads to the next highly visible area in which one finds the public perception as being a primary element – genericness and genericide.

5.2.2.2. Genericness and genericide

The above examination of the public’s involvement in determining acquired distinctiveness articulated the ability of the public to imbue a mark with positive trademark protection through association with a source. On the converse, the public perception of a mark is also able to determine that it is incapable of the distinguishing function, or even to strip a mark of what distinctiveness it once had.

⁶²⁰ McCarthy (n 225) §15:28; see also TOSLO-2015-62184 for the use of evidence and market surveys in determining distinctiveness; Monica Viken, *Markedundersøkelser som bevis i varemerke- og markedsføringsrett* (Gyldendal akademisk, 2012).

⁶²¹ *Dupont Cellophane v Waxed Products*, 85 F.2d 75, 81 (2nd Cir 1936).

In the first situation this would be seen as an initial determination, by a court or registration authority, that the mark is non-distinctive.⁶²² In other words, the court or authority concludes that the public perception of a mark at the outset 'defines a category or type to which the goods belong. It is essential to the trade and also to consumers that nobody should be allowed to monopolize such a generic term.'⁶²³ In this situation the mark would be incapable of performing a distinguishing function and could not qualify for trademark protection.⁶²⁴ 'Of course, if the symbol or device is already in general use, employed in such a manner that its adoption as an index of source of origin would only produce confusion and mislead the public, it is not susceptible of adoption as a trademark.'⁶²⁵

In the other situation a mark, which once may have had the requisite distinctiveness to function as a distinguishing mark, then loses this distinctiveness and can, as a consequence, no longer function as a mark. This is commonly styled 'genericide' or 'degeneration'. Even where there is a protectable, or even registered trademark, the public perception of the mark can render it generic and thus eliminate its existence as a protectable mark. 'Genericide occurs when the public appropriates a trademark and uses it as a generic name for particular types of goods or services irrespective of its source.'⁶²⁶

Professor McCarthy describes this concept of genericide by stating -

Even if a seller starts selling a new product under a protected mark – whether it be coined, or descriptive, a personal name or a geographic name – such a mark can become generic merely by use by the public in such a way as to be recognized not as a mark, but as the very name of that genus of goods, no matter what the source.⁶²⁷

The concept of genericide is integrated into the Norwegian trademark system through *varemerkeloven* §36 on *degenerasjon* –

⁶²² *Varemerkeloven* §§ 2, 5, 14; EU Trade Mark Directive Article 12; Lanham Act section 2, 15 USC 1052.

⁶²³ *WIPO Handbook* (n 223) section 2.354, pg 73.

⁶²⁴ See section 4.4.

⁶²⁵ *Hanover Star Milling Co v Metcalf*, 240 US 403, 415, 36 S Ct 357 (1916).

⁶²⁶ *Elliott v Google*, No.15-15809, Case No. 2:12-cv-01072 (9th Cir 2017) at page 6.

⁶²⁷ McCarthy (n 225) § 12.25.

En registrering av et varemerke skal helt eller delvis slettes ved dom eller ved administrative overprøving etter bestemmelsene i §§ 38 til 40 hvis:

...

- c) merket, som følge av merkehaverens handlinger eller passivitet, er blitt den alminnelige betegnelsen innen bransjen for slike varer eller tjenester som det er registrert for.⁶²⁸

‘At et varemerke degenererer betyr at det mister sin individualiserende evne, og at det <<innen bransjen>> ikke lenger oppfattes som særmerke for en bestemt virksomhet.’⁶²⁹

Though *varemerkeloven* §36 is concerned with the validity of the registration of a mark itself, it necessarily follows that if a mark is determined to be an ‘alminnelige betegnelsen’ for a certain good or service it would then lack the necessary ‘særpreg’⁶³⁰ to function as a trademark. Furthermore, the question of *degenerasjon* can be approached as having occurred prior to registration and therefore removing the necessary *særpreg* from the mark – as occurred in the *Potetgull* case.⁶³¹

Genericide occurs, in most cases, when a mark is attached to a new and innovative product or service and through some manner, such as misuse or non-enforcement on behalf of the source, the mark becomes recognised in the mind of the public as a designator of that entire class of product or service instead of those originating from that particular source. This can also arise in situations where a source controls a disproportionate majority share of the market for a particular good or service.⁶³²

Yet, much like an inquiry regarding acquired distinctiveness ‘... the critical enquiry is not to the actions of the seller, but to the usage of the public.’⁶³³ This was stated succinctly

⁶²⁸ vml. § 36. (‘A registration of a trademark shall be wholly or partly erased by judgment or by administrative review pursuant to the provisions of section 38-40 if: b) the mark, as a result of the trademark owner’s actions or passiveness, has become the general term in the industry for such goods or services which it is registered for.’).

⁶²⁹ *Kjennetegnsrett* (n 411) pg 123 (The fact that a trademark degenerates means that it loses its individualizing ability and that it <<within the industry>> is no longer perceived as a distinctive mark for a particular entity.’).

⁶³⁰ varemerkeloven §2.

⁶³¹ See, TOSLO-2015-62184, LB-2015-195012, HR-2017-550-U.

⁶³² TOSLO-2015-62184 pg 9; *Kjennetegnsrett* (n16) pg 124 *et seq.*

⁶³³ McCarthy (n 225) §12:25.

in the *Thermos Case* – ‘...the test is not what is available as an alternative to the public, but what the public’s understanding is of the word that it uses.’⁶³⁴

Though genericide is a rare occurrence the situations in which it has been examined are instructive as to the power of public perception.

The *Potetgull Case* (Orkla Confectionery & Snacks v Estrella Maarud Brands and Maarud)⁶³⁵ provides insight into the Norwegian perspective of generic marks. Here Maarud began to use the term *potetgull* for potato chips in 1938 and maintained the dominant market position even until the case came before the courts in 2015.⁶³⁶ This case came to court by way of Orkla taking issue with Maarud’s 2010 trademark registration for POTETGULL, thus the issue was the validity of that registration (in 2010) and whether the necessary distinctiveness was present at the time of the application for registration. Though not based on *varemerkeloven* §36,⁶³⁷ the factors that the courts evaluated were analogous to a genericide inquiry just done with the view that the mark had lost its distinctiveness prior to the point of application.

In order to determine whether the term ‘potetgull’ had the requisite distinctiveness necessary for registration, and in that manner necessary to function as a trademark, the Court evaluated Maarud’s use of the mark, market surveys regarding the public’s understanding of the term, and third party uses of the term. The Court determined that even though ‘[h]istorisk sett hadde Maarud åpenbart et eierforhold til betegnelsen potetgull, da selskapet startet produksjonen i Norge i 1938 og gav navnet til produktet,’⁶³⁸ the term ‘er i det norske språk beskrivende (generisk) for potetskiver stekt i olje’.⁶³⁹

⁶³⁴ *King-Seeley Thermos Co. v. Aladdin Industries, Inc.*, 321 F.2d 577, 580 (2nd Cir 1963).

⁶³⁵ LB-2015-195012 (Potetgull case, Borgarting Lagmannsrett); see also TOSLO-2015-62184, HR-2017-55-U.

⁶³⁶ 75% market share in the 1960s, and 45% market share in 2015.

⁶³⁷ the section of the Norwegian trademark law dealing with genericide – *denegresjon*.

⁶³⁸ Potetgull case, LB-2015-195012, at pg 14 (‘Historically Maarud obviously had an ownership of the name potetgull when the company started production in Norway in 1938 and gave the name to the product.’).

⁶³⁹ *Id.*, at pg 9 (‘is in the Norwegian language descriptive (generic) for potato slices fried in oil.’).

Ultimately, '[u]t fra en totalvurdering av alle bevisene i saken og alle omstendigheter om bruk som forelå på søknads-/registreringsdagen, finner lagmannsretten det klart at potetgull av forbrukere ble oppfattet som en generisk (beskrivende) betegnelse.'⁶⁴⁰

It is clear that the distinctiveness of the term 'potetgull' was entirely dependent upon the use that the public made of that term. 'Det er i prinsippet uten betydning at Maarud begynte å markedsføre potetgull i 1938, og har gjort det nå i nærmere 80 år. Det er også uten betydning hvilke ressurser som er brukt på markedsføring. Det er virkningen av dette som blir det sentrale.'⁶⁴¹

The case of *DuPont Cellophane v Waxed Products*⁶⁴² is often referenced as authority on the evaluation of genericide. In this matter the use of the term 'cellophane' was at issue. The Court reviewed the marketing practices of DuPont and other relevant circumstances within the market and determined that – 'The course of conduct of the complainant and its predecessors, and especially complainant's advertising campaign, tended to make cellophane a generic term descriptive of the product rather than of its origin and, in our opinion, made it so to at least a very large part of the trade.'⁶⁴³ This determination was based upon the perception that the public had of the term.

The District Court erred in concluding that 'the trade-mark cellophane does not depend upon what was in the customer's mind' and in deciding the case on the theory that the public understanding as to the meaning of the word was immaterial. Such a theory is out of accord with the essence of the law of trade-marks. The rights of the complainant must be based upon a wrong which the defendant has done to it by misleading customers as to the origin of the goods sold and thus taking away its trade. Such rights are not founded on a bare title to a word or symbol but on a cause of action to prevent deception. It, therefore, makes no difference what efforts or money the DuPont Company expended in order to persuade the public that 'cellophane' means an article of DuPont manufacture. So far as it did not succeed in actually converting the world to its gospel it can have no relief.'⁶⁴⁴

⁶⁴⁰ Id., at pg 14 ('based on an overall assessment of all the evidence in the case and all circumstances of use that existed on the application/registration date, the Court of Appeal finds that it is clear that potetgull is perceived as a generic (descriptive) term by consumers.')

⁶⁴¹ Id., LB-2015-195012, pg 8.

⁶⁴² *DuPont Cellophane v Waxed Products*, 85 F.2d 75 (2nd Cir 1936).

⁶⁴³ *DuPont*, 85 F.2d at 80.

⁶⁴⁴ *DuPont*, 85 F.2d at 81.

Even after determining that the term ‘cellophane’ was generic and could be used by other manufacturers, the Court tailored its decree to ensure that use of cellophane would not lead to confusion within the market.

The defendant should be allowed to use the word cellophane unconditionally in dealing with those to whom it means no more than the product and should be able to fill orders for cellophane received from such persons either with Sylvania cellophane or any other cellophane. But as the complainant’s use of the word ‘cellophane’ has had a wide publicity, there may be some persons who desire DuPont cellophane. Accordingly, it seems to us in the interest of justice that, when filling orders for cellophane, the defendant should state that the product sold is Sylvania cellophane or the cellophane of whomsoever may be the maker, and need state nothing more. The defendant may likewise use the word cellophane in its advertisements provided it shall prefix the maker’s name as a possessive.⁶⁴⁵

This determination evidences not only the power of public perception to change the nature of a trademark term, but also the Court’s overarching goal of avoiding consumer confusion.

In the case of *King-Seeley Thermos v Aladdin Industries*,⁶⁴⁶ the Court found that ‘the major significance of the word ‘thermos’ is generic.’⁶⁴⁷ Despite efforts by King-Seeley to reassert the distinctiveness of the term through diversification of its product line, and increased advertising and policing efforts, and the availability of alternative generic terms for its products, the Court stated –

... King-Seeley has enjoyed a commercial monopoly of the word ‘thermos’ for over fifty years. During that period, despite its efforts to protect the trademark, the public has virtually expropriated it as its own. The word having become part of the public domain, it would be unfair to unduly restrict the right of a competitor of King-Seeley to use the word.⁶⁴⁸

The pivotal concern for the Court was not the availability of alternative terms, or the efforts of King-Seeley to assert its rights but rather ‘what the public’s understanding is of the word that it uses. What has happened here is that the public had become accustomed to calling vacuum bottles by the word ‘thermos’.’⁶⁴⁹

⁶⁴⁵ *DuPont*, 85 F2d at 82.

⁶⁴⁶ *King-Seeley Thermos v Aladdin Industries*, 321 F2d 577 (2nd Cir 1963).

⁶⁴⁷ *King-Seeley*, 321 F2d at 579.

⁶⁴⁸ *King-Seeley*, 321 F2d at 581.

⁶⁴⁹ *King-Seeley*, 321 F2d at 580.

It must be noted that in this case, similarly to *DuPont*, even where the word ‘thermos’ was deemed to be generic for vacuum bottles this did not eliminate the rights of King-Seeley in that term, nor did it allow competitors to use the word thermos in such a way as to deceive the public as to the source of the vacuum bottles. The court dealt with this situation by only allowing the descriptive use of the word ‘thermos’ by competitors, disallowed their use of a capitalized form as well as any use without a possessory term preceding the word. Thus, in this way, even where a term was deemed generic, the public’s right not to be deceived as to the source of the products was still present and protectable.⁶⁵⁰

Through these examples it can be seen that even where there possibly was, or may be, a protectable trademark, that trademark’s continued existence, value, enforceability, and effectiveness is determined by the perception of the public and balanced by the public’s right not to be deceived. ‘[W]hen the primary significance of the registered mark to the relevant public is as the name for a particular type of good or service irrespective of its source’⁶⁵¹ the public has essentially limited or entirely extinguished the trademark protection afforded to a mark.

5.3. Public perception and the ‘source’

The public perception’s ability to augment trademark rights is not limited to the mark itself. Indeed, as was stated previously, the public is in control of nearly all aspects of whether a mark is a trademark and to what extent it enjoys protection. Perhaps the most interesting aspect of the public’s positive perception powers, at least for the purposes of this work, is the public’s ability to determine the true ownership of a trademark.

As discussed in section 4.2, the concept of the source as it relates to trademark protection is not one of a single identifiable entity or person, and it is ultimately the public - and more particularly the association created in the mind of the relevant public

⁶⁵⁰ See also *Singer v Loog* (1882) 8 App Cas 15 (House of Lords 1882).

⁶⁵¹ *Elliott v Google*, No.15-15809, Case No. 2:12-cv-01072 (9th Cir 2017) at page 7.

- that determines who is the source, and the nature of that source, for trademark purposes.⁶⁵² The source in a trademark sense essentially is wherever the public expects the communicated attribute to be derived from, whether that attribute be subjective quality, objective superiority, consistent quality, membership in an association, production location, or any number of other attributes that may be communicated by the trademark usage. '[F]rom the standpoint of realities, the consumer does not regard the trade-mark as an indication of origin, but rather as a guaranty that the goods purchased under the trade-mark will have the same meritorious qualities as those previously noted by him in his purchases of other goods bearing the same mark.'⁶⁵³ In this way nearly all the attributes of a source are at the mercy of the public's perception of it, including its composition.

This dependent nature of the concept of source is evidenced in the below cases, which assist in articulating how the public can and does modify the source.

5.3.1. *Biltilsynet* case⁶⁵⁴

The Norwegian *Biltilsynet* case, concerned trademark rights to the term 'Biltilsynet' (roughly translated as the 'Motor Vehicle Authority'). From 1971 to 1996 the mark Biltilsynet was used by an official Norwegian government agency that dealt with motor vehicles. One service that this government agency provided was the ability to retrieve various information on any vehicle registered in its databases. Common use of this service was to find out when one's own car was due for various inspections and registration, what the status was of a car that you wished to purchase, and other similar questions. Importantly, this service was provided for no-fee from the government. After 1996 this government agency was subsumed into a larger authority and the use of

⁶⁵² *Manhattan Shirt Co. V. Sarnoff-Irving Hat Stores*, 19 Del. Ch. 151 (1933) (United States) - 'When the courts speak of the public's identifying the source of origin, they do not mean thereby that the purchasing public can identify the maker by his specific name of the place of manufacture by precise location. What they mean by such expression is that the purchaser of goods bearing a given label [mark] believes that what he buys emanated from the source, whatever its name or place, from which goods bearing that label [mark] have always been derived.'; *Kjennetegnsrett* (n 411) - 'Et varemerke anses å være innarbeidet når det i omsetningskretsen her i riket er <<godt kjent som noens særlige kjennetegn>>, bestemmer vml. § 3 tredje led. Det kreves ikke at det er kjent i omsetningskretsen *hvem* som har varemerket, jfr lovens uttrykk <<noens ... kjennetegn>>. Men markedet må være godt kjent *som kjennetegn* for varer eller tjenester.' at pg 243.

⁶⁵³ Schechter (n 22) pg 150.

⁶⁵⁴ THAUG-2010-68241 (*Biltilsynet*-dommen); LG-2011-23049 – RG-2012-578.

the mark Biltilsynet was entirely ceased, with all services continuing under a new name of 'Statensvegvesen'.

In 2000, an individual named A. Kalveland registered the business name 'Biltilsynet A Kalveland' and in 2001 the domain name biltilsynet.no. Kalveland operated a telephone and internet service using the *biltilsynet* mark where people could receive motor vehicle related information similar or identical to what they could have received from the old government run Biltilsynet or the new Statensvegvesen. Importantly, the service that Kalveland provided through the 'Biltilsynet A Kalveland' business and associated biltilsynet.no website charged a fee to retrieve the requested information.

It was not until 2010 that the rights to the use of the mark *biltilsynet* came before the Norwegian courts. It was stated that '[o]pp gjennom årene har der fremkommet klager til Statens vegvesen, forbrukermyndighetene og andre på Kalvelands virksomhet. Dette har gått på at publikum har følt seg lurt da de har blitt krevd betaling etter å ha vært i kontakt med ham. Foranledningen til det har vært at de har oppfattet Kalvelands virksomhet under betegnelsen <<biltilsynet>> som et offentlig organ.'⁶⁵⁵

The court of first instance determined that even where Statens Vegvesen, the successor to Biltilsynet, was unclear regarding its remaining rights to the mark *biltilsynet* in the years after its use had been ceased,⁶⁵⁶ the public still associated that mark with the services offered by the renamed authority. 'I vår sak så har Statens Vegvesens virksomhet fortsatt i same form kontinuerlig, og betegnelsen <<<Biltilsynet>> har vært brukt av publikum på denne virksomheten uavbrutt siden Vegvesenet egen bruk av

⁶⁵⁵ THAUG-2010-68241, pg 3 ('Through the years, complaints have been made to the Norwegian Public Roads Administration, the consumer authorities, and others about Kalveland's business. This has meant that the public has felt cheated when they have been required payment after being in contact with him. The reason for this has been that they have perceived Kalveland's business under the name <<biltilsynet>> as a public body.')

⁶⁵⁶ Evidence was presented and testimony taken in court which indicated that Kalveland had contacted Statensvegvesen to clarify if they maintained rights to the mark Biltilsynet, and that Statensvegvesen were unclear whether it was still theirs. Statensvegvesen had, furthermore, issued public notices that they had affirmatively abandoned the use of Biltilsynet.

betegnelsen hadde opphørt.⁶⁵⁷ Because the public still associated the mark with the services of the renamed authority, this association fulfilled the requirements for the mark to qualify for protection as an *innarbeidet* mark of Statens Vegvesen.⁶⁵⁸

This determination was affirmed on appeal at the Gulating lagmannsrett (the Court of Appeal) -

Etter Varemerkeloven (2010) §3 tredje led oppnås varemerkerett uten registrering når merket er innarbeidet. Innarbeidingen varer så lenge det i omsetningskretsen er kjent som noens særlige kjennetegn. ... Lagmannsretten finner det klart at Statens vegvesen innarbeidet Biltilsynet som et varemerke gjennom den publikumsrettede virksomhet som ble revet ved det som i dag er Statens trafikkstasjoner. ... Det kan ikke være tvilsomt at begrepet ble innarbeidet.⁶⁵⁹

The appeals court also placed weight upon the public's perception of the *biltilsynet* mark. Interestingly, the lagmannsrett went so far as to, essentially, take judicial notice of the reputation of the mark.

Lagmannsretten er heller ikke i tvil om at i bevisstheten hos folk flest knyttes begrepet Biltilsynet fortsatt til denne statlige virksomhet, selv om den har fått et nytt navn. Forholdet er etter lagmannsrettens oppfatning en åpenbar kjensgjerning som ikke trenger ytterligere bevis. Biltilsynet var en kort og fengende betegnelse, langt mer beskrivende enn Statens trafikkstasjon, på en virksomhet som svært mange må forholde seg til.⁶⁶⁰

⁶⁵⁷ THAUG-2010-68241, pg 7 ('In our case, the Norwegian Public Roads Administration's activities continue to be in continuous form and the name <<Biltilsynet>> has been used by the public in connection with this entity uninterrupted since the Road Authority's own use of the term had ceased.').

⁶⁵⁸ varemerkeloven §3 – 'Varemerkerett oppnås uten registrering når merket er innarbeidet. Et varemerke anses innarbeidet når og så lenge det i omsetningskretsen her i riket for slike varer eller tjenester det gjelder, er godt kjent som noens særlige kjennetegn.'

⁶⁵⁹ LG-2011-23049 – RG-2012-578, pg 5 ('Under the Trade Marks Act (2010) §3 third indent, trademark rights are obtained without registration when the mark is established. The establishment lasts for as long as it in the trade area [relevant public] is known as someone's particular mark. The Court of Appeals finds it clear that the Norwegian Road Administration established Biltilsynet as a trademark through the publicly owned business which was shut down by what is currently the State traffic stations. There can be no doubt that the term was established.').

⁶⁶⁰ LG-2011-23049 – RG-2012-578, pg 5 ('The Court of Appeals is also in no doubt that in the minds of the public the mark Biltilsynet is still mostly connected to the state organisation, even though it has been renamed. The relationship is, according to the Court of Appeal's opinion, an obvious fact that does not require further evidence. Biltilsynet was a short and catchy term, far more descriptive than the State's traffic station, on a business that many people need to deal with.'). The High Court of Norway denied appeal, thus the Gulating lagmannsretts decision was undisturbed – HR-2012-1556-U.

To put this case into context, especially with regard to the public perception aspect, it is necessary to reframe the facts. Though Statensvegvesen, or the prior authority, had used *biltilsynet* for a number of years, it had entirely ceased its use of *biltilsynet* four years prior to Kalveland taking it up. Furthermore, Kalveland was conducting an ongoing business for another near ten years under the *biltilsynet* mark before the case came to court, during which time Statensvegvesen made no attempt to oppose his use and were even admittedly unsure of their own trademark rights.

When viewing this case in that light, one must query how the state authority could still claim rights in the mark. The answer to that question is simply the demand of the public perception. In the years that Kalveland was trading upon the mark *biltilsynet* the public was still associating that mark with what it had known previously – indeed, even having documented complaints of confusion regarding Kalveland’s use of the mark.

Essentially the public still made an association with a previous source and, because of that association and demand, the rights remained with Statensvegvesen whether they knew of it, wanted it, or not. In this manner the public perception was determining the source.

5.3.2. Chartreuse cases

The *Chartreuse cases*⁶⁶¹ concerned the production and sale of the liqueur Chartreuse by the Carthusian Monks. The facts of this case are complex and involved the rights to the use of various trademarks originally owned by the Carthusian Monks, including the name ‘Chartreuse’, labels, and bottle shape spread over at least three countries. Without attempting to dissect the case, it is best to rely on the summary put forth by the US Supreme Court –

The facts, so far as we deem it necessary to state them, are as follows: For several hundred years prior to 1903, -- save for a comparatively brief period following the French Revolution, -- the Order of Carthusian Monks occupied the Monastery of the Grande Chartreuse, near Voiron, in the Department of Iserre, in France. ... There, by a secret process, they made the liqueur or

⁶⁶¹ The *Chartreuse cases* include - *Baglin v Cusenier*, 221 US 580 (1911), 141 F 497 (2nd Cir 1905), 156 F 1016 (SDNY 1907), 164 F 25 (2nd Cir 1908), 156 F 1015 (SDNY 1905); *Bauer v Order of Carthusian Monks, Convent La Grande Chartreuse*, 120 F 78 (7th Cir 1903); *Rey v Lecouturier*, [1908] 2 Ch 715, [1910] AC 262.

cordial which, at first sold locally, became upwards of fifty years ago the subject of an extensive trade and is known throughout the world as 'Chartreuse.' The monks originally manufactured the liqueur at the monastery itself, and later at Fourvoirie, close by. It was marketed, here and abroad, in bottles of distinctive shape [with distinctive labels]. In 1876, the then procureur registered two trademarks in the Patent Office...

In the year 1903, having been refused authorization under the French law of July 1, 1901, known as the associations act, the congregation of the Chartreux was held to be dissolved by operation of law, and possession was taken of their properties in France by a 'sequestering administrator and liquidator' appointed by the French court. Forcibly removed from their former establishment, and taking their secret with them, the monks set up a factory at Tarragona, in Spain, and there according to their ancient process they have continued the manufacture of the liqueur, importing from France such herbs as were needed for the purpose.

The French Liquidator, Henri Lecourturier, employing a skilled distiller and chemical assistant, undertook by experimentation to make at Fourvoirie a liqueur either identical with or resembling as closely as possible the famous 'Chartreuse;' and, having succeeded in this effort to his satisfaction, he placed his product upon the market under the old name.

...

The liquidator's cordial was shipped to this country, and sold here in bottles of precisely the same description, and with the same marks and symbols which had been used by the monks; if there was any difference it is frankly stated to have been unintentional.

Meanwhile the monks, debarred by the proceedings in France from the use of their old marks and symbols in that country, devised a new designation for their liqueur, in which prominence was given to the words 'Pères Chartreux.' The new label bore the inscription 'Liqueur Fabriquée à Tarragone par les Pères Chartreux;' and this was accompanied by the statement that 'this liqueur is the only one identically the same as that made at the Monastery of the Grand Chartreuse in France, previous to the expulsion of the monks, who have kept intact the secret of its manufacture.' To negative the claim of abandonment they made a small shipment to this country under the old labels. And both here and in other countries, the monks have sought by legal proceedings to prevent the use of the word 'Chartreuse' as a designation of the liqueur made at Fourvoirie since their expulsion, and the use or imitation by the liquidator or by those claiming under him of the marks which the monks had associated with their product, and the simulating in any way of the dress or packages in which it had been sold.⁶⁶²

As can be seen from the brief recitation of facts by the US Supreme Court, many legal issues were present in this matter in addition to substantive trademark rights. It is,

⁶⁶² *Baglin v Cusenier*, 221 US 580, 586-8 (1911).

however, not necessary to dwell on all of those legal issues in this work. Rather, what is important for the purposes of this work, and the understanding of the public perception's effect on the 'source', is that the courts in both the United States and United Kingdom placed the public's perception of the 'Chartreuse' marks⁶⁶³ as central to ruling that the Monks, wherever they may be located, retained their rights to the marks.

As stated in the court of first instance in New York –

Maybe the monks have lost the right to use their old trade-marks, but it does not follow that some one else can use them here on goods which they do not make. To offer for sale cordial made by [defendant] as cordial made by the monks ... is a fraud upon the public in this country, which even the authority of the French government cannot permit.⁶⁶⁴

The District Court's ruling was reversed upon appeal at the 2nd circuit. Yet there was a strong dissent that maintained –

[Baglin's] claim to the trade-mark 'Chartreuse' rests upon the fundamental doctrine of the law of trade-marks, the right of the public to be protected against deception. One of the chief objects of the law is to prevent the commission of a fraud on the public by the sale of an article with an imitated trade-mark in such a manner as to deceive purchasers.⁶⁶⁵

Interestingly the District Court recognised that '[i]f one entitled to a trade-mark does abandon it, that does not justify a rival in appropriating the same and using it to induce the public to believe that the rival's products sold under the old label is the same thing so long and favorably known thereunder and still being sold under the new label by the original proprietor.'⁶⁶⁶ This is similar to the disposition of the Norwegian courts in the *Biltilsynet* case recognizing the public's association of a mark with a source that has

⁶⁶³ including the distinctive labels, signatures, bottle form, and overall look.

⁶⁶⁴ *Baglin v Cusenier*, 156 F 1015, 1015 (SDNY 1905).

⁶⁶⁵ *Baglin v Cusenier*, 141 F 497, 499-500 (2nd cir 1905); also, upon reversal at the 2nd cir, in dissent – '...is an attempt by fraud to make a gain out of the confidence of the public in the individual skill of the members of said order, and to appropriate, in violation of the law and without consideration, the intangible, and incorporeal, but no less sacred, right of property, the good will of the complainant' at 500.

⁶⁶⁶ *Baglin v Cusenier*, 156 F 1016, 1018-19 (SDNY 1907) (Also consider the *Biltilsynet* case, where a similar principle can be seen in the courts judgment.).

ceased using that particular mark. ‘Lastly, the rights of the public are to be considered; they are entitled to protection from simulation and fraud.’⁶⁶⁷

The Carthusian Monks were successful in the United Kingdom with similar weight placed on the public’s perception and expectation.

Chartreuse has had a hold on the public as being the manufacture of these Carthusian monks. ... the result of their industry was that the article they manufactured had acquired a commercial value as “Chartreuse,” which meant to the public a liqueur manufactured by the monks by their own process.⁶⁶⁸

The court further held that

It has been recognized that in this country the name has attached exclusively to the liqueur manufactured by the persons who possess this particular recipe.⁶⁶⁹

Ultimately in the US, the Carthusian Monks’ rights to their marks, including the distinctive shape of the bottles and unique labels, were upheld in the US Supreme Court.⁶⁷⁰ This case provides a unique view of the public perception’s controlling ability in trademark disputes. By all accounts, the French liquidator in this case took possession of the properties of the Monks. One would assume this means the intellectual properties as well as the physical properties. It seems counterintuitive that courts in both the US and UK would disregard these transfers of property. However, when viewing the situation through the expectation of the purchasing public and an understanding of the fundamentals of trademark protection, it is quite explainable – the public’s association of the Chartreuse marks remained attached to the product of the Carthusian Monks wherever they may be located.⁶⁷¹

⁶⁶⁷ *Baglin v Cusenier*, 164 F 25, 29 (SDNY 1908).

⁶⁶⁸ *Rey v Lecouturier* [1908] 2 Ch 715.

⁶⁶⁹ *Id.*, 2 Ch at 726.

⁶⁷⁰ *Baglin v Cusenier*, 221 US 580 (1911).

⁶⁷¹ Whether this was because of the quality of the product, the ingredients, the trade secrets involved in its production, or any other aspect is an irrelevant inquiry. Whatever the reason may be for the association, it is the fact that the association remained that was controlling.

5.3.3. Band cases

In trademark disputes surrounding the names and marks of musical groups the perception of the public and its effect on the concept of source can be particularly highlighted. There are many structures and methods that may be employed by musical groups to secure their intellectual property rights, but in cases where this is undetermined or disorganized it often falls to the court to determine ownership of distinguishing marks.

In certain cases the courts attempt to understand a band as some species of business structure and then evaluate the ownership of the mark as an asset owned by that business structure.⁶⁷² However, '[r]esolving conflicting claims of ownership of a single group mark creates unique problems which cannot properly be solved merely by reference to traditional rules of corporation and partnership law. Such problems can only be dealt with adequately by giving weight to customer perception and the identification of source and quality policies of trademark law.'⁶⁷³

These cases provide a unique look at the public's association with a 'source' as it must be determined what it is that the public is associating a musical group's distinguishing mark with, and who within that musical group controls that aspect of the musical group. In certain cases the public's association does not adhere to the talent within the musical group, but rather to a certain musical style or aesthetic regardless of membership.⁶⁷⁴

⁶⁷² See, *Boogie Kings v Guillory*, 188 So.2d 445, 448; 151 USPQ 133 (Court of Appeal of Louisiana 1966) – 'In our opinion, this band, when first organised in 1955, became an unincorporated association, and it has continued to be such an organisation since that time. The evidence convinces us, as it apparently did the trial judge, that the original trade name, 'The Boogie Kings,' was adopted by mutual agreement of the members of the band, that a proprietary interest in that name became vested in the band, as an unincorporated association, and that it did not become vested in any individual member of that band. Miller, therefore, had no right or authority to 'give' or transfer to defendant Guillory the exclusive right to use that name.' at 448; *Gorgoroth* case TOSLO-2008-140784, - 'Gorgoroth fremstår for tingretten som en sammenslutning, uten at det finnes påkrevd å foreta en mer presis sammenslutningsrettslig kategorisering. Rettslig sett deles sammenslutningene gjerne inn i hovedgruppene selskaper og foreninger.' pg 12.

⁶⁷³ McCarthy (n 225) at §16:45.

⁶⁷⁴ *Cheng v Dispeker* 1995 WL 86353, 35 USPQ2d 1493 (SDNY 1995) – regarding 'BRAVO Broadway!' mark; compare *Crystal Entertainment & Filmworks v Jurado*, 643 F3d 1313 (11th Cir 2011) – regarding 'Exposé' mark.

‘[T]he issue to be resolved is whether the mark signifies personalities or style and quality regardless of personalities.’⁶⁷⁵

As stated in *Bell v Streetwise Records* –

The role of “public association” in determining ownership has been much disputed in this case. ... But defendants are wrong when they say that public association plays no part in determining ownership. It is crucial in establishing just what the mark has come to identify, i.e., what the “goods” are. In order to determine ownership in a case of this kind, a court must first identify that quality of characteristic for which the group is known by the public. It then may proceed to the second step of the ownership inquiry, namely, who controls that quality or characteristic.⁶⁷⁶

It is only with a firm understanding of the public perception of the mark in use, and the association that the public creates between that mark and a specific attribute, that the rights in these types of disputes can be resolved. Only once that association is articulated is it possible to determine the source and therefore the actual ownership of the distinguishing mark.

5.3.4. Other diverse cases

With a more expanded understanding of source the interaction between the perception of the public and the characterization of that source can be observed in other situations. Most notably surrounding the early protections of geographic indicators. Cases such as *Pillsbury-Washburn Flour Mills v Eagle*,⁶⁷⁷ *Elgin National Watch Co v Illinois Watch Case Co*,⁶⁷⁸ *Newman v Alvord*,⁶⁷⁹ and *Anheuser-Busch Brewing Association v Piza*⁶⁸⁰ evidence that the public’s association could extend, and be protectable, beyond a strict single source conception. Additionally, the early association mark cases show the same in the context of what are currently termed collective or certification marks.⁶⁸¹

⁶⁷⁵ *Cheng v Dispeker* 1995 WL 86353, 35 USPQ2d 1493 (SDNY 1995) at *4.

⁶⁷⁶ *Bell v Streetwise Records*, 640 FSupp 575, 580-81 (D Mass 1986).

⁶⁷⁷ *Pillsbury-Washburn Flour Mills v Eagle*, 82 F 816 (ND Ill 1897), 41 LRA 162 (7th Cir 1898) – injunction granted for the use of ‘Minnesota’ on flour.

⁶⁷⁸ *Elgin National Watch Co v Illinois Watch Case Co*, 179 US 665 (1901) – injunction denied for the restraint of the use of the term Elgin, however discussion regarding the possible secondary meaning.

⁶⁷⁹ 51 NY 189, 1872 WL 11601 (NY Court of Appeals 1872) – injunction to restrain the use of Akron on cement.

⁶⁸⁰ 24 F 149 (SDNY 1885) – injunction to restrain the use of ‘St. Louis Lager Beer’.

⁶⁸¹ See *Schmalz v Wooley*, 43 LRA 86 (NJ Court of Errors and Appeals 1898).

5.4. Ownership of a mark

The articulation of an understanding of the ownership of a trademark necessitates the combination of the definition of a trademark, including its function, form, and nature, with the concept of source, and the manner in which the perception of the public plays in all of these aspects of a trademark.

In the simplest of trademark situations, such as a single commercial entity owning a single trademark registration, the idea of ownership is not initially a complex concern. However, as can be seen from the discussion of the past few sections, these simple concepts in trademark law can grow from complex motivations and underpinnings. The same is true for ownership of a mark.

At the outset, ownership is tied to one's ability to exclude others from the benefit of the mark. 'Trademark law, like contract law, confers private rights, which are themselves rights of exclusion. It grants the trademark owner a bundle of such rights...'.⁶⁸² Some attach this idea of exclusivity to a property right –

The hallmark of a protected property interest is the right to exclude others. That is one of the most essential sticks in the bundle of rights that are commonly characterized as property. ... The Lanham Act may well contain provisions that protect constitutionally cognizable property interests – notably, its provisions dealing with infringement of trademarks, which are the “property” of the owner because he can exclude others from using them.⁶⁸³

In whatever manner one characterizes the rights attached to trademark protection, the essence of those rights as an owner arise from the ability to exclude – thus the question of ownership becomes one of who can exclude. This question of ownership is particularly relevant when viewed in conjunction with the expanded understanding of source and the public's ability to define that source.

⁶⁸² *K Mart Corp v Cartier*, 485 US 176, 185-6 (1988).

⁶⁸³ *College Savings Bank v Florida Prepaid Postsecondary Education Expense Board*, 527 US 666, 673 (1999).

It has already been established that the public perception of mark, and the association that the public makes between that mark, the attribute that it is communicating, and the source can all play a role in defining the boundaries of what that source actually is. Necessarily, this means that the ownership of a trademark could coincide with the borders of that defined source.

In cases determining the ownership of a mark in a music group, this can lead to ownership of a mark vesting in the individual members of the group as a collective. In *Robi v Reed*,⁶⁸⁴ it was determined that ‘prior to the transfer to the corporate entity [of the band’s trademark rights] the five members of the group owned the mark collectively...’.⁶⁸⁵ In *Fuqua v Watson*⁶⁸⁶ not only was the mark owned by the members of the band, but ‘the pecuniary value of this “trade name” was derived solely as a result of the *personal skills* of the *four original members* of the vocal group and, therefore, could not be *truthfully* used by others after this group disbanded’.⁶⁸⁷ In the case of *Bell v Streetwise Records*,⁶⁸⁸ ‘[b]ased on the totality of the evidence’ the Court concluded ‘that the quality which the mark New Edition identified was first and foremost the five plaintiffs with their distinct personalities and style as performers. The “goods” therefore are the entertainment services they provide. They and no one else controlled the quality of those services. They own the mark.’⁶⁸⁹

Similarly, in the Norwegian *Gorgoroth* case, the Court of First Instance held that ‘de innarbeidete rettigheter til navn og varemerke innehas av bandet Gorgoroth som sådant, dvs av alle bandets til enhver tid faste medlemmer i fellesskap.’⁶⁹⁰

⁶⁸⁴ *Robi v Reed*, 173 F3d 734 (9th Cir 1999).

⁶⁸⁵ *Id.*, 173 F3d at 740; it must also be noted that the transfer of right to the corporate entity in this case was ruled invalid, and the rights reverted back to the band members collectively.

⁶⁸⁶ *Fuqua v Watson*, 1955 WL 6611, 107 USPQ 251 (NY Supreme Court 1955).

⁶⁸⁷ *Fuqua v Watson*, 1955 WL 6611, 107 USPQ 251 (NY Supreme Court 1955).

⁶⁸⁸ *Bell v Streetwise Records*, 640 FSupp 575 (D.Mass 1986).

⁶⁸⁹ *Id.*, 640 FSupp at 580.

⁶⁹⁰ TOSLO-2008-140784, pg 6 (‘The district court has come to the conclusion that the established rights to the name and trademark are held by the band Gorgoroth as such, that is to say by all of the bands’ members at any one time in common.’).

Though musical group cases again provide an illuminating view of the ownership aspects of a trademark, especially in light of the public perception considerations, they are not the only situation in which the ownership of a mark is extended beyond conventional thinking.

In the case of *Lunatrex v Cafasso*,⁶⁹¹ a number of individuals were engaged, as a team, in the Google Lunar X Prize competition which would reward as much as 20 million USD ‘for a private effort to land a robot on the surface of the moon’.⁶⁹² The team had a falling out and a dispute arose over the continued use of the team name LunaTrex. The parties each filed for a preliminary injunction against the other to restrain the use of the team name. In deciding the request for the preliminary injunction, the court found that ‘the LunaTrex mark was developed and used by a defacto partnership or joint venture. All members of that partnership or joint venture are equally entitled to use the mark, and none are entitled to use it over the objections of the others.’⁶⁹³ Furthermore, ‘each team member is harmed when an entity other than the entire team uses the mark. Each team member has the right to put a stop to any use by an entity other than the entire team.’⁶⁹⁴ Essentially, ‘the LunaTrex trademark belong[ed] to all members of the team’⁶⁹⁵ and therefore, the court took ‘the unusual step of granting both sides’ motions for preliminary injunction.’⁶⁹⁶

Additionally, there are a number of situations where trademark cases were filed on behalf of collective trademark owners, such as the *Chartreuse case*⁶⁹⁷ and the association mark cases.⁶⁹⁸ From this it can be seen that the ownership of a trademark

⁶⁹¹ 674 F.Supp.2d 1060 (SD Ind 2009).

⁶⁹² *Lunatrex v Cafasso*, 674 F.Supp.2d 1060, 1062 (SD Ind 2009).

⁶⁹³ *Ibid.*

⁶⁹⁴ *Id.*, 674 F.Supp.2d at 1072.

⁶⁹⁵ *Id.*, 674 F.Supp.2d at 1074.

⁶⁹⁶ *Id.*, 674 F.Supp.2d at 1062.

⁶⁹⁷ *Baglin v Cusenier*, 221 US 580 (1911) – ‘Père Baglin, Superior General of the Order of Carthusian Monks, for himself and the other members of the order, brought this bill in equity...’ at 586; *Rey v Lecouturier*, [1908] 2 Ch 715 – ‘The plaintiffs were the representatives of the Carthusian order of monks...’ at 716, ‘the present action was commenced by Célestin Marius Rey ... and others on behalf of the members of the Carthusian order...’ at 719.

⁶⁹⁸ *Schmalz v Wooley*, 43 LRA 86, 57 NJ Eq 303 (NJ Court of Errors and Appeals 1898) – ‘The bill in this case was filed...by the president of the Union Hat Makers’ Association of Newark, for the use and benefit of all the members thereof...’ at 304; *Cigar Makers’ Protective Union v Conhaim*, 3 LRA 125 (Minnesota

is intimately connected to the concept and construction of the source to which that mark attaches. Essentially, source is the intersection between public perception and the specific attribute that the distinguishing mark is communicating, and owner is the intersection between public perception, source, and the right to exclude. It is worth noting that these cases speak to the principle that not only can the source be determined by the public perception, but that the public can also consider that source without regard to membership. In other words, much like the source can be anonymous as described previous, the membership of that source can likewise be anonymous. Controlling is the construct of the valued attribute the public associates with a mark and the source itself with which the relevant public makes that association.

Supreme Court 1889); *Carson v Ury*, 5 LRA 614 (ED Missouri 1889); *Schneider v Williams*, 44 NJ Eq 391 (NJ Court of Chancery 1888); *see also* Rogers (n 39) Chapter 25, pg 243 *et seq.*

6. Sámi and Tlingit examples in Norwegian and US Trademark Law

6.1. Introduction

In the above Parts of this work a reexamination of the fundamentals of the protection of distinctive marks was undertaken in an effort to more fully understand trademark protection as it exists in our legal world today and to find the contours of a foundational definition of a trademark. This began with a critical examination of the premodern use of marking drawing on advances in anthropological and archaeological research unavailable to the legal commentators of prior eras. This set the scene for the analysis of trademark protection systems prior to the statutory and registration regimes that were introduced in the nineteenth century.

It was concluded that only with understanding the historical aspects of the use of distinguishing marks and the systems that were available for their protection can one be informed about how the modern system of trademark protection was established, as well as how it evolved into what is seen in use today. Such historical lens allows a clearer view of what a trademark truly is at its core and how it functions within the modern framework. In reaching these conclusions, this work identified that certain commentators and critics have historically, and to the present day, employed conceptions of trademarks that lead to clouding of a comprehensive understanding of what a trademark is, how it functions, and the protections it affords, particularly when applied in indigenous contexts.⁶⁹⁹ In a similar vein, it was further articulated that in order to undertake a thorough examination of trademarks and their application to any specific situation one must not be limited merely to the text of statutes or the requirements of a registration, but must view trademarks within their broader context taking into account their fundamental nature.

Having laid this foundation this work proceeded to examine the discrete elements that make up a functioning trademark. Here, the first step was to establish a definition for a functioning trademark, distilled to its core elements and unburdened by extraneous

⁶⁹⁹ See section 1.3

aspects. In this the concepts of distinguishment, source, and commercial nature were examined and a base definition was articulated. That being –

A trademark is a distinguishing communicator of certain specific attributes.

This definition was then employed in exploration of the nature of the communicator itself - the form, ability to distinguish (descriptiveness, genericness, and functionality). Building on these analyses, we then proceeded to articulate the purpose of trademark protection, concluding that the nature of a trademark can fluctuate according to context, setting, market, and not least the public perception.

It was through that process that it was demonstrated how the totality of a trademark is not contained within a registration certificate. On the contrary the above parts of the work showed how there are many, oftentimes, complex enquires that must be employed to truly understand the extent and limits of trademark use and protection. Most importantly, it concluded, at all times these issues must be evaluated according to the context within which a mark is used based upon the fundamental principles and understandings.

The base definition of a trademark thus formulated was intentionally left to the very distillate of a trademark. It was concluded that the adding of more elements to a definition of a trademark, such a commercial nature, quality, or referencing advertising functions, et cetera removes that definition from the actual core of a trademark. It merely integrates certain aspects of the possibilities of use, or possible expectations that the public could associate with the use of a mark.

Eliminating those peripheral elements not only more clearly defines a trademark at its core, but also requires one to recall the broad goals necessary to properly evaluate the use of a trademark – such as the near infinite possible forms, ability to communicate any attribute regardless of commercial nature, the use of quality both subjectively and objectively, the concept of an anonymous source, and not least the necessity to understand the public perception and placement within context.

This analysis was assisted by the broad set of resources used in the above Parts, in order to better illustrate the general evolution of the protection of distinguishing marks and to more fully examine the common elements of all functioning trademarks. This was especially relevant in understanding the development of the trademark space as many jurisdictions were essentially on the development journey together and the modern system of trademark protection grew from common ambitions.

In this Part, the trademark knowledge that was established, the reoriented trademark definition, and the understanding the components that make up a functional trademark are employed in an application to the protection of indigenous intangible resources. To effectively analyse the application of trademark protection within the context of indigenous intangible resources, it is necessary to conduct a deep yet targeted examination. Attempting to such a task with applicability to all indigenous resources in all jurisdictions would produce little more than broad generalisations and unenlightening results, especially where we aim to first build from the protection provided by the trademark system.

Thus, the following enquiry is focused on specific trademark protection structures in specific jurisdictions as applied to specific elements of cultural resources from specific indigenous groups. In this manner, it is hoped to illuminate what protections trademarks could provide with a fundamental approach, exhibit their usefulness or lack thereof, and to which resources they may lend that protection. And from those specific examples further learnings could be built.

In the follow sections we will focus on how trademark protection could be employed specifically in the United States as applied to an appropriate example of Tlingit resources, and in Norway as applied to an appropriate example of Sámi resources. As has been discussed previously, the resource world in which trademarks may find the most purchase, and from which we will draw exemplars, is that of handicraft – as imperfectly as that English word captures the concept. It is, thus, with an introduction to the handicrafts of the Sámi and Tlingit people that the following sections will begin.

From that world, specific exemplars are selected and described, and the remainder of this Part is devoted to testing those exemplars within their applicable trademark regime.

6.2. Handicraft traditions among the Sámi and Tlingit

Before exploring the handicraft traditions amongst the Sámi and Tlingit, it is necessary to remember the inadequacy of the English language to fully convey the meaning behind the indigenous items or traditions that are being discussed.⁷⁰⁰ While being fully aware of this inadequacy, and the follow on issues that it can cause, it is still necessary to use an English term to convey the relative subject of what is being dealt with.

It must also be clearly stated that this is not a work on Sámi or Tlingit handicraft, their nature or places within their respective societies, or their meaning to the Sámi or Tlingit people. The author is no expert on these areas, and arguably can never be an expert in these areas, as that expertise is reserved to those of the culture and people from which the cultural resources come. Information on these aspects were drawn, as much as could possibly be done, from appropriate indigenous resources and any analysis should be understood as for the purpose adding context to the trademark discussion – not attempting to define what these resources are. That task is appropriately for the Sámi and Tlingit people themselves.

6.2.1. Sámi handicraft

The Sámi culture has always been rich in art, handicrafts, and aesthetics. For the most part these traditions are collectively described under concept of *duodji*.⁷⁰¹ As described in section 2.6.1 above, *duodji* is rather difficult to define with any certainty outside of the cultural understanding, especially when attempting to describe it using non-Sámi words and understanding.⁷⁰² However, *duodji* at its foundation arose from the products that were made by hand and necessary for life in Sápmi. ‘Det tradisjonelle samiske håndverket bærer preg av “nødvendighetens kunst”. Det er nyttegjensstander til bruk i

⁷⁰⁰ See section 2.6.

⁷⁰¹ And *daidda* where appropriate

⁷⁰² Because of this linguistic difficulty, there are many words that are used to describe *duodji*, as a whole, or in part. In English, such words include handicraft, handwork, arts and crafts (as well as art, and craft, separately). In Norwegian and Swedish one will see the words *kunstverk*, *håndverk*, *handarbete*, *slöjd*, *slöjd*, *brukskunst*, *husflid* or any number of other descriptors.

husholdningen, til fiske, fangst og jakt, reindrift, jordbruk og sanking av bær og planter.⁷⁰³ Duodji thus essentially sprung from items of practical use. In this way duodji was a part of all aspects of Sámi life and the creating, using, and understanding of duodji was present in all sectors of Sámi society. 'Håndverk og husflid – *duodji* – har alltid hatt en grunnfestet og høyaktet plass innenfor alle samiske yrkeskombinasjoner.'⁷⁰⁴ It permeated all aspects of everyday life in any Sámi area - 'Samenes formkunst har lange og rike tradisjoner i alle samiske distrikter.'⁷⁰⁵

However, despite its practical basis, in the development of the practical items for life in Sápmi, duodji was also designed to be pleasing. 'Grunntanken i duodji er formgiving av bruksting i en praktisk og vakker form.'⁷⁰⁶ As a result the designs, forms, and uses of colours and patterns on practical everyday objects began to create a unique collective Sámi aesthetic, though with slight regional differences. 'På dette område var samisk folkekunst rik. Samisk husflid vitner om ekte kunstsans, stilfast og nøktern, med sterk kjensle for geometriske former og sikkerhet i valg av farger.'⁷⁰⁷ It is primarily through this common Sámi aesthetic that one can identify items of duodji⁷⁰⁸ - 'Materialbehandling, form, farge og dekor (pynt), og ikke minst utformingen til praktisk bruk, har gitt de ferdig produktene et klart samisk preg.'⁷⁰⁹

These distinctive elements of duodji are also clearly and distinctively present in the modern products and duodji traditions of today. 'Moderne samisk kunsthåndverk og billedkunst kan i stor utstrekning betegnes som en videreutvikling av tradisjonelt

⁷⁰³ Hætta (n 82) pg 15 ('The traditional Sami craft is characterized by 'art of necessity'. There are utensils for use in households for fishing, trapping and hunting, reindeer husbandry, farming and sowing of berries and plants.').

⁷⁰⁴ Id., pg 14 ('Crafts and craftsmanship – duodji- has always had a well-founded and high-ranking place within all Sami professional combinations. It also permeates all areas of Sápmi – the Sami form of art has long and rich traditions in all Sami districts.').

⁷⁰⁵ Id., pg 14 ('The basic idea is the formation of useable objects in a beautiful and practical form.').

⁷⁰⁶ Id., pg 45 ('In this area, Sami folk art was rich. Sami home crafts testifies to true artistic sense, stylish and sober, with a strong appreciation of geometric form confidence in choice of colour.').

⁷⁰⁷ *Sámiid Dilid* (n 83) pg 103

⁷⁰⁸ Here, of course, using the term duodji is a rather restrictive sense of products.

⁷⁰⁹ Hætta (n 82) pg 14 ('Material handling, shape, colour and décor (decoration), and not least the design for practical use, have given the finished products a clear Sami characters.').

håndverk.⁷¹⁰ Indeed, the material used, designs, patterns, colours, and overall Sámi aesthetic not only identifies items as duodji, and Sámi, but also have been imbued with deep cultural, identity, and in some cases spiritual meaning.

Though it is nearly impossible to make an account of all the possible forms that duodji may take,⁷¹¹ there are some well-known examples of products that clearly fall within the concept duodji. When used in the common parlance duodji unquestionable includes such things as Sámi weaving, leatherwork, carvings, clothing, drum making, and tin and silverwork. All of which conform to certain standards that have been passed down through the duodji tradition.⁷¹²

A particularly relevant example of the duodji tradition is that of Sámi knives. Though Sámi knives come in different designs and forms dependent on intended use, and there are regional and local variations, one particular design which is specifically Sámi evidences not only a common aesthetic but also the deep interaction between duodji and Sámi culture and history. This particular design includes a sheath that extends below the tip of the enclosed knife and then angles from the centerline to a blunt taper. The sheath is traditionally constructed of two pieces of reindeer antler which envelope the knife, back and front. It is a striking, distinctive, unique, and particularly Sámi design.

⁷¹⁰ Id., pg 14 ('Modern Sami crafts and visual arts can largely be referred to as a further development of traditional crafts.').

⁷¹¹ *Duodji – árbediehtu* (n 207) pg 65 - 'With time, the concept of *duodji* has taken on several meanings. As a starting point, we can say that duodji is all forms of creative expression that require human thought and production. For example we can say that a work of books can be duodji. ...'

⁷¹² Note, however, that this should by no means be taken as an exhaustive catalogue of duodji, nor of Sámi TCEs, or cultural properties. The highlighted items are only listed in order to evidence the rich history of unique and distinctive Sámi duodji tradition.



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However, when the history and context is also understood the Sámi nature of this design is even more apparent. The unique design of the sheath came directly from the material that was used – reindeer antler – and is a necessity in order to use the antler in the most efficient and least wasteful manner. Thus the form followed directly from the Sámi cultural necessity, and in turn became a distinctive mark of a knife’s ‘Sáminess’. This distinctive shape, originally necessitated by the specific form and use of reindeer antler, continues where other materials are used as seen in the below example. ‘These shapes of the sheaths are often regarded as Sami knife and sheath shapes, and in today’s terms, we could almost say that the Sami knives and sheaths have become trademarks.’⁷¹⁴

⁷¹³ Author’s own work. Knives from author’s collection; duojar Ilmari Tapiola.

⁷¹⁴ *Duodji – árbediehtu* (n 207) pg 77. (The use of language in particular the reference to “trademarks” is telling, although Guttorm was using trademark in a more general and not necessarily strictly legal sense.)



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Another uniquely Sámi practice found within duodji is tin thread embroidery – ‘datneárpu’. Datneárpu is seen in the embroidery on many items of ‘soft duodji’⁷¹⁶ and not only adds a characteristic eye catching element to the items but is also used to highlight certain meaningful designs and patterns which often identify the family, region, or affiliation of the item or individual wearing the item.

Historical evidence traces Sámi datneárpu back to at least the 11th century. ‘Det eldest kjente funnet av [samisk] tinntråd er fra 1000-talet fra furen i småland. Noe yngre er det såkalte gråtræsk-funnet i Norrbotten, so mantas å være fra en samisk offerplass. Der fant de biter av flat tinntråd og spiraler av tinntråd som var spunnet ruddt en ulltråd. Disse funnene viser at samene på 1000-tallet kjente til kunsten å lage tråd av tinn.’⁷¹⁷ It

⁷¹⁵ Author’s own work. Knives from author’s collection; duojar Ilmari Tapiola, Ovlla Gaup.

⁷¹⁶ Soft duodji can be loosely equated to handicrafts that utilise primarily textiles, as opposed to ‘hard duodji’ which marks use of horn, stone, bone, and wood.

⁷¹⁷ Hætta (n 82) pg 44 (‘The oldest known finding of [Sámi] tin wire is from the 1000s from borders of Småland. Somewhat younger is the so-called grey-wood discovery in Norrbotten, so thought to be from a Sami sacrificial site. There they found pieces of flat tin wire and spirals of tin thread that were

is believed that tin is the only metal which the Sámi refined and worked within Sápmi – that is, it was not imported from elsewhere – and the Sámi use of tin in *datneárpu* was unique.⁷¹⁸ In short, there is strong evidence that *datneárpu* was unique to the Sámi and has been an integral part of *duodji* and the Sámi culture for millenia.⁷¹⁹

The production of clothing is also a central element of *duodji*. ‘Klærne har en spesiell plass innenfor håndverket.’⁷²⁰ The traditional Sámi clothing, ‘*gákti*’,⁷²¹ much like other items of *duodji* has deep meaning to Sámi people both as a connection to their identity, but also as an means of communication.

Duodji is a living tradition of Sámi culture that maintains the deep connection with the Sámi people’s way of life, identity, individuality, uniqueness, and collectiveness even today. ‘*Duodji* har en ubrutt tradisjon fra de eldest tider til i dag.’⁷²² It has also become an ever increasingly important occupation for many Sámi as the market for *duodji* has grown, nationally, internationally, and within the Sámi people itself. ‘*Duodji* for salg har fått økt betydning, og er for enkelte familier etter hvert blitt den sikreste kilden til kontantinntekter.’⁷²³

Yet, even with an increased demand outside of the Sámi culture the foundation of *duodji* as a practical art, cultural communicator, identity marker, and traditional cultural

spun on a wool thread. These findings show that the Sami in the 1000s knew the art of making tin thread.’).

⁷¹⁸ Id., - ‘Tinn er, så vidt vi vet, det eneste metallet i elder tider som samene selv har bearbeidet, og samene er sannsynligvis også de eneste som har foredlet tinn på denne måten.’ pg 44

⁷¹⁹ *Duodji – árbediehtu* (n 207) pg 91 - ‘Tin thread embroidery is regarded as a Sami “invention”. Ulf Hård af Segerstad writes in his book about the Samis’ *duodji* that tin thread embroidery is a special handicraft skill of the Sami. ... Maja Dunfjeld writes that the Sami tin thread tradition can be traced back to the Iron Age, and that tin finds have been made at sacrificial sites in both the Iron and Middle Ages.’.

⁷²⁰ Hætta (n 82) pg 15 (‘Clothing has a special place within handwork.’).

⁷²¹ This is the North Sámi term for the Sámi traditional clothing. Other Sámi languages have their own words, such as *gáptoe* in South Sámi.

⁷²² Hætta (n 82) pg 153 (‘*Duodji* has an unbroken tradition from the oldest time up to today.’).

⁷²³ Id., pg 154 (‘*Duodji* for sale has gained importance, and for some families it has gradually become the safest source of cash income.’); ‘*Duodji* er en viktig næring. For noen kan *duodji* i en eller flere former være hovednæringen, for mange flere kan den være en binæring som gir tilleggssinntekter og fyller ut ledig tid i andre yrker som er sesongbetonte, for eksempel reindrift, fiske og sauehold.’ (‘*Duodji* is an important industry. For some, *duodji* can be the main industry in one or more forms, for many more, it may be a sidebusiness gaining additional income and filling out free time. In other professions that are seasonal, such as reindeer husbandry, fishing and sheparding.’) at 156.

expression remains strong. Indeed, although the Sámi much welcome the growth in the duodji market, including customers from outside the group, the most important aspect of duodji to the Sámi is surely still as an integral cultural and identity marker. 'Man kan også tenke på samisk brukskunst, hvordan den på den ene side er nyttig og inntektsgivende, og på den andre side er en utløser av samisk kunst- og formsans, og på den måte virker til åndelig berikelse både for brukskunstneren selv og de andre samer.'⁷²⁴

6.2.2. Tlingit handicraft

The Tlingit have, similar to the Sámi, always maintained a rich tradition of arts and handicrafts – both out of necessity of creating useful objects and also for aesthetics. As George Emmons (1852-1945) stated

The industrial life of the Tlingit was fairly shared by the two sexes, and the division of labor very clearly established. ... The man was the working in stone, bone, metal, and wood. He built the house, fashioned the canoe, chests, utensils, and all the implements and tools used in the labor of both sexes. He was the carver and painter. He made all of his weapons, the frames for skin dressing and blanket weaving, and the frames for snowshoes, as well as ornaments of ivory, bone, and shell. He made the musical instruments [drum, rattle, tapping sticks]⁷²⁵, gambling devices, and wooden hats, helmets, and headdresses used in ceremonies. ... The woman cared for the little children and trained the girls. She tanned and dressed the pelts, made the clothing, spun the goat's wool for blankets, prepared the roots, grass, and plant stems used in sewing, weaving, and making blankets, baskets, and nets. ... She worked split porcupine quill and bead embroidery.⁷²⁶

Additionally, Emmons noted the artistic nature of the objects that the Tlingit produced.

A distinctive feature of the life of the Northwest Coast was the artistic sense of the people as expressed in all of their industries. Everything they produced, from the great communal house with its wealth of carving, tooling, and painting, down to the least important article of use, was ornamented in animal design, which greatly impressed the explorers...⁷²⁷

⁷²⁴ *Sámiid Dilít* (n 83) pg 127 ('One can also think of Sami useful arts, how on the one side is useful and income-generating, and on the other side is a trigger of sami art and performance, and to that extent works for spiritual enrichment for both the artist and the other Sami.').

⁷²⁵ The annotations in Emmons work are made by Frederica de Laguna.

⁷²⁶ Emmons (n 102) pg 165.

⁷²⁷ Id., pg 165.

This is especially notable because as touched upon in section 2.6.2, the highly ornate art of the Tlingits is not merely aesthetic. Rather, it is an elaborate semiotic system that legitimizes clan membership, social relationships and obligations, as well as tangible and intangible property ownership.⁷²⁸ Indeed, what was described by Emmons as an ‘artistic sense’ was actually an expression of deep meaning to the Tlingit which included ownership, lineage, stories, and teachings in addition to the aesthetic beauty.⁷²⁹

It is impossible to attempt here a catalogue of all items of Tlingit handicraft. However, there are some notable examples that bear including. Many Tlingit cultural expressions that include a visually artistic element are figuratively composed according to what is known as ‘formline art’. This artistic style is common throughout the Northwest Coast and is characterized by its use of broad and bold solid line work and standardized shapes. The standard shapes include the ovoid, u-shape, trigon, crescent, and what is known as the Salmon-Trout head. When used in combination the standard ovoid elements depict highly stylized representations of animals, personages, and other figures from nature.⁷³⁰

Use of formline can be seen in many pieces of Tlingit cultural expression. This is particularly apparent in the Chilkat Blankets made by the Tlingit which are nearly entirely covered in formline art. Chilkat blankets, or ‘dancing blankets’,⁷³¹ are striking examples of the level of skill and artistry of the Tlingit people. They are described by Emmons as ‘the most original and pleasing ceremonial robe of the Northwest Coast tribes’⁷³² and typically follow a particular set of standards that have been maintained for hundreds of years. A Chilkat blanket is pentagonal in shape with a longer base at the

⁷²⁸ Caskey Russell, *Cultures in Collision: Cosmology, Jurisprudence, and Religion in Tlingit Territory* (Spring 2009) 33(2) *American Indian Quarterly* 230, 238-9.

⁷²⁹ It must be remembered here that these expressions form part of Tlingit *at.óow* as described above in section 2.6.2. Thus their meaning attached not only to a cultural nature but to the very concept of property and Tlingit cosmology.

⁷³⁰ see Bill Holm, *Northwest Coast Indian Art: an analysis of form* (University of Washington Press 1965); Cheryl Shearar, *Understanding Northwest Coast Art: a Guide to Crests, Beings and Symbols* (University of Washington Press 2000); *Northwest Coast Formline Design: Definitions and Student Activities* (Sealaska Heritage Institute); Cheryl Samuel, *The Chilkat Dancing Blanket* (University of Oklahoma Press 1982) pg 47.

⁷³¹ Cheryl Samuel, *The Chilkat Dancing Blanket* (University of Oklahoma Press 1982) pg 22.

⁷³² Emmons (n 102) pg 224.

top, perpendicular sides, with the two remaining bottom sides forming a point, either shallow or pronounced.

In its overall plan, the Dancing Blanket is bounded by three bands of solid color. A narrow white band, which includes the side braids, is at the extreme periphery, followed by a broad black and then a broad yellow band. Within the yellow band lies the design field. The crest animal was organised on this field by the designer depending on his preference for handling the space.⁷³³

Within the boarder of the blanket formline designs are woven into the blanket itself which typically depict clan crests or other meaningful symbols. 'The design field of the Dancing Blanket is covered with one or more crest figures.'⁷³⁴ Chilkat blankets were used for many purposes, but primary found use in ceremonial roles and as symbols of prestige and wealth. Today they are highly recognizable and known as being derived from the Tlingit and related Northwest Coast peoples.⁷³⁵



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⁷³³ Cheryl Samuel, *The Chilkat Dancing Blanket* (University of Oklahoma Press 1982) pg 39.

⁷³⁴ *Id.*, pg 39.

⁷³⁵ For a comprehensive description of the Chilkat blanket see Emmons (n 102) pg 225 *et seq.*; George Thornton Emmons, 'The Chilkat Blanket, with Notes on the Blanket Designs by Franz Boas' (1907) 3(4) *American Museum of Natural History Memoirs* 329.

⁷³⁶ Chilkat blanket attributed to Mary Ebbetts Hunt (Anisalaga), 1823-1919, Fort Rupert, Vancouver, British Columbia. Wikipedia Commons / Public Domain.

The Tlingit historically were, and today still are, highly accomplished carvers. Traditional carved products include everything from small implements to large canoes capable of exceeding forty feet in length.⁷³⁷ Formline designs usually depicting clan crests were normally carved into wooden items, including ‘bentwood’ boxes, clan house screens, clan house poles, and totem poles. Additionally, the Tlingit carved shamanistic items such as masks and dancing rattles which took the forms of creatures from Tlingit lore.⁷³⁸

Another highly distinctive Tlingit cultural expression are the daggers made and used by the Tlingit people. Tlingit daggers have a very unique and distinctive form and have been documented well in the historical records from even the earliest contacts with European explorers.⁷³⁹ The daggers can be classified into three major form categories which ‘had a standardized method[s] of construction’.⁷⁴⁰ Tlingit daggers were not only useful instruments, but played a role in ceremonial matters as well as in trade.

The last distinctive Tlingit cultural expression that is explored in this work is the Tináa, which is discussed below.

6.2.3. Selection of exemplars

6.2.3.1. *The Sámi Gákti*

As mentioned, there is little question that the production of clothing in the Sámi culture forms a central part of the duodji tradition.⁷⁴¹ As further addressed, this is especially true when it comes to the traditional clothing of the Sámi people, known as ‘gákti’ in the

⁷³⁷ Emmons (n 102) pg 88, generally pgs 84-98; though the neighboring Haida were known as master canoe carvers given their access to the desirable red cedar trees - at pg 84.

⁷³⁸ This, obviously, is not a full account of the traditional cultural expressions of the Tlingit. It is only a non-exhaustive list of examples in order to show the rich history of unique and distinctive cultural expressions.

⁷³⁹ Ashley Kristen Verplank, *Form Follows Function: The Evolution of Tlingit Daggers*, a thesis submitted in partial fulfillment of the requirements for the degree of Master of Arts (University of Washington 2008) pg 40 *et seq.* (on file with the author).

⁷⁴⁰ *Id.*, pg 50.

⁷⁴¹ Guttorm (n 88) pg 890 ‘Å skape klær var en viktig del av duodji i selvbergingsamfunnet.’ (‘Creating clothes was an important part of Duodji in the subsistence society.’); Hætta (n 82) pg 15 - ‘Klærne har en spesiell plass innenfor håndverket.’ (‘Clothing have a special place within handwork.’).

Northern Sámi language. The gákti developed from hundreds of years of use into the distinctive form that it takes today.

The gákti has certain common elements throughout Sápmi. It is clearly distinguishable from other forms of clothing either in the area or worldwide, and is typified by its tunic-like construction and the patterns and designs upon it. Primarily around the collar, neckline, hem, cuffs, and across the shoulders and back of the garment various designs and patterns are constructed. Additionally, an important element of the gákti, as a whole, is the accessories which are worn together with the base garments. These accessories include the belt, trousers, shoes and shoe bands, neck and chest covering, and hat, all of which maintain the unique Sámi aesthetic and design.⁷⁴²

The distinctive form of traditional dress used by the Sámi is recorded nearly as far back as there are references to the Sámi people themselves. 'Langobarden Paulus Diaconus, som var historieskriver og munk skriver på slutten av 700-tallet at han har sett en samedrakt. Han beskriver også reinen, som han sier ligner hjort. Av dette dyret har han sett samene lage et tunikalignende plagg.'⁷⁴³ There are many other examples of the Sámi traditional clothing being documented by historians and travelers to Sápmi.⁷⁴⁴

As to the present, there are altogether more than 30 general variations of the gákti worn throughout Sápmi.⁷⁴⁵ Irrespective of the regional difference resulting in the designs varying to a certain extent, together they nonetheless form a collective distinctiveness and are all recognised as uniquely Sámi. In other words, despite the variance in specific regional uses in Sápmi, the similarities are dominating that together they form a richness

⁷⁴² Images of the gákti in current use can be viewed on the Norwegian Sámi Parliament's photo page at <https://www.flickr.com/photos/samediggi/>; specifically <https://www.flickr.com/photos/samediggi/10323811996> (both last accessed 20 June 2024)

⁷⁴³ Guttorm (n 88) pg 890 ('Langobarden Paulus Diaconus, a historian and monk, wrote in the late 700s that he had seen a sami outfit. He also describes the reindeer, as he says looks like deer. From this animal he had seen the Sami make a tunic-like garment.').

⁷⁴⁴ Guttorm (n 88) pg 890.

⁷⁴⁵ Piia Nuorgam, 'Wider Use of Traditional Saami Dress in Finland: Discrimination against the Saami?', in Xanthaki, Valkonen et al. (eds.), *Indigenous Cultural Heritage: Rights, Debates and Challenges* (Koninklijke Brill 2017), pg 233.

of design unique to the Sámi people and are undoubtedly recognised as distinct Sámi traditional dress.⁷⁴⁶

Divisions amongst the designs in gákti generally follow language differences within the Sámi people, as well as geographic boundaries.⁷⁴⁷ And, each of the gákti designs conforms to a set of regional, local, village, and even family rules and standards that have been passed down from generation to generation. However, the variances in gákti design are not divisive of Sámi society, but rather are an important aspect of the gákti's function as a means of communication and collective identity. 'Ser man på koftas funksjon, har den tidligere hatt en klar bruksfunksjon. Samtidig hadde den også en mening – den formidlet og kommuniserte med omgivelsene. Kofte avslører også brukerens personlighet og geografiske tilhørighet.'⁷⁴⁸ Furthermore, the unified nature and common aesthetic of the gákti and its distinctiveness as Sámi dress is recognised irrespective of the State borders that now cross Sápmi.⁷⁴⁹

Thus the gákti takes on multifaceted and layered meaning. It is a distinctive indication of being a member of the Sámi people, yet it also connects that individual wearer to a specific subdivision of the Sámi while at the same time it 'tells in subtle ways a story behind the person through the cultural signs in it'.⁷⁵⁰ In this manner, it is not only a means of external communication but also as a means of creating community, shared meaning, and strengthening social bonds and local as well as cultural identity.⁷⁵¹ In short, 'i dag er kofta også blitt et viktig identitetsmerke'.⁷⁵²

Today the use of the gákti is not limited to the mere use as an article of traditional clothing. It can be seen in miniaturised versions and placed on products – such as small

⁷⁴⁶ Ibid.

⁷⁴⁷ Guttorm (n 88) pg 891 - 'Drakten følger både de språkelige og de geografiske samiske områdene. Generalt kan en si at i språkområdene og draktområdene følger hverandre. Der det snakkes sørsamisk, pitesamisk, lulesamisk, nordsamisk, enaresamisk og skoltksamisk finnes det også egne draktskikker.'

⁷⁴⁸ Guttorm (n 88) pg 914 ('With regard to the gákti's function, the former has had a clear use function. At the same time it also had a meaning – it conveyed and communicated with the surroundings. Gákti also reveals the user's personality and geographical connection.').

⁷⁴⁹ Nuorgam (n 745) pg 233.

⁷⁵⁰ Ibid.

⁷⁵¹ Id. pg 232-3; see also Guttorm (n 88) pg 917.

⁷⁵² Guttorm (n 88) pg 890 ('Today, the gákti has also become an important indicator of identity.').

dolls representing Sámi people primarily made to be sold to visitors of Sápmi, and as an image / graphic analogous to a sales logo. In certain circumstances this is legitimate use by Sámi people, and in other instances people or entities outside of the Sámi culture use it in order to elicit some connection with the Sámi culture and trade on its value. The gákti has also been used as a quasi-uniform in the performance of services – in this case it has mostly been used for tourism services both legitimately by Sámi people as well as by those attempting to attract tourists by false connection.

Given the highly distinctive nature of the gákti, pervasiveness throughout Sámi society, cultural identifying nature, and deep history, the gákti is the Sámi cultural element that shall serve as an exemplar in this work.

6.2.3.2. *The Tlingit Tináa*

The tináa is traditionally a piece of copper formed into a distinctive shape that roughly resembles a shield. It is broadest at its curved top which then tapers to a waist. From the waist the sides can extend down parallel to one another or taper slightly out again. At the waist, and extending from the middle of the waist to its bottom edge there is a worked ridge that separates the tináa into three distinct areas.

The tináa is a unique item, both in form and in use, to the Tlingit people and immediately surrounding tribes. Historically it served no purpose other than as an exhibition of wealth and prestige. In the traditional Tlingit society and economy tináa were regarded as highly valuable objects that were used throughout social life and in particular during special social gatherings.⁷⁵³

Tináa were also used in various cultural ceremonies.

[Tináa] might be bought and sold, displayed or given away at a potlatch, and its value increased each time according to the amount of property distributed at the potlatch. Or, it might be broken into pieces and given to the more honored guest, or wholly destroyed, in order to humiliate a rival or to wipe out an insult, and such an act would require an equal or greater destruction of

⁷⁵³ Grinev (n 106) pg 49.

property by the opponent. The “copper” might be placed on the grave house or mortuary column to honor the dead.⁷⁵⁴

In the historical records of contact with the Tlingit there are many references to the Tlingit use of the tináa. The earliest published description of a tináa is contained in the records of a Russian explorer, Lisiansky, who visited the Southeast Alaskan coast in 1804.⁷⁵⁵ Included in Lisiansky’s work was an illustration of the tináa.



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Lisiansky’s described the tináa as ‘a thin plate, made of virgin copper, ... It was three feet in length, and twenty-two inches in breadth at one end, and eleven inches at the other, and on one side various figures were painted.’⁷⁵⁷ Tináa, however, were not limited to the large pieces of copper seen by Lisiansky and other explorers. Indeed, there were many different sizes of tináa that ranged from a few inches to over four feet in length,⁷⁵⁸ as form and shape are the determining factors of being tináa, not size.

⁷⁵⁴ Emmons (n 102) pg 179.

⁷⁵⁵ Id., pg 180.

⁷⁵⁶ Urey (Yuri) Lisiansky, *A voyage round the world in the years 1803, 4, 5, & 6; performed, by order of His Imperial Majesty Alexander the First, Emperor of Russia, in The Ship Neva, by Urey Lisiansky, Captain in the Russian Navy and Knight of the Orders of St. George and St. Vladimir* (London 1814), Plate 1, f, pgs 150-151.

⁷⁵⁷ Urey (Yuri) Lisiansky, *A voyage round the world in the years 1803, 4, 5, & 6; performed, by order of His Imperial Majesty Alexander the First, Emperor of Russia, in The Ship Neva, by Urey Lisiansky, Captain in the Russian Navy and Knight of the Orders of St. George and St. Vladimir* (London 1814), pg 150.

⁷⁵⁸ Emmons (n 102) pg 181- ‘A note in AMNH indicates: “Coppers three or four inches were attached to *kate* [ke*t, the shaman’s skin apron], like deer hoofs or puffin beaks; longer ones five to seven inches worn on headdress of fur [of the shaman?]. The larger ones a foot or more to four feet long were

Today tináa are still in use as a distinctive product of the Tlingit and, given the unique and distinctive shape of the tináa, it is seen in many more applications than merely copper objects. The modern tináa produced by a Tlingit craftsman below evidences that the distinctive nature of the tináa has remained unchanged for at a minimum two-hundred years.



The tináa can also be seen used today in newer adaptations calling forth the distinctive shape of the tináa as a Tlingit identifier. It is not unusual to see Tináa as earrings, necklace pendants, and other jewelry as well as in use as an indicator of general Tlingit connection, such as the use below as essentially a Tlingit logo.

valued at eight to ten slaves and were shown at potlatches.’ pg 180; ‘The value varied with the size and increased on the southern journey [of the traded “copper”], and with each time that it was displayed or sold. An old Sitka native [Dick Se•tá•n] reported that one in length from the tip of the finer to the elbow was worth one male slave, one measuring from the finger to the neck two slaves, and that small ones had a current value of four moose skins. Miniature ones of traded copper were used as ornaments attached to ceremonials dress.’

⁷⁵⁹ Kindly created by Donald Gregory Heindei, Tlingit Artist, Juneau, Alaska; author’s personal collection.



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In summary, the tináa is a unique and distinctive element of Tlingit culture that has a long history of traditional use⁷⁶¹ that extends consistently into the modern era. The tináa has in continuous use by the Tlingit in its traditional copper form, as well as finding new extended uses today not only as a product but as an indication of other Tlingit products and services. Thus, it will serve well as an exemplar in our analysis below on behalf of itself as well as an analogue for other similarly important cultural properties.

6.3. Trademark protection and the Gákti and Tináa examples

In the preceding section the Tlingit and the Sámi people were introduced to this work in a substantive manner. Their respective cultures were outlined, placed within the modern and historical contexts, and their handicraft traditions were reviewed – at least as much as was possible within, and relevant for, the purposes of this work.

Additionally, two specific examples were selected, one from each indigenous people, to evaluate according to the specific national trademark protection regimes within the relevant jurisdictions of the Sámi and Tlingit people. These two exemplars – the tináa and the gákti – were selected for their strong, unbroken, and recognised connection

⁷⁶⁰ Courtesy of Sealaska Heritage Institute, www.sealaskaheritage.org (last accessed 22 April 2024).

⁷⁶¹ George Thornton Emmons (Frederica de Laguna ed), *The Tlingit Indians* (University of Washington Press, 1991), pg 175; Aurel Krause (translated by Erna Gunther), *The Tlingit Indians: Observations of an indigenous people of Southeast Alaska 1881-1882* (Epicenter Press, 1956/2013, originally published 1885 in German), pg 163; Andrei Val'Terovich Grinev (translated by Richard L Bland & Katerina G Solovjova), *The Tlingit Indians in Russian America, 1741-1867* (University of Nebraska Press, 2005), pg 31.

with their respective indigenous peoples. They are both, also, highly distinctive and representative of their cultures.

In the next few sections the substantive legal systems within which the Sámi and Tlingit peoples find themselves⁷⁶² is presented with particular focus upon the trademark protection regimes that exist in both. The gákti and tináa will then be taken through the relevant requirements in each system and tested for validity as a trademark with a view to the indigenous peoples having control of that trademark right.

While it will be seen that there are many similarities in the trademark protection regimes of both Norway and the United States, which should come as little surprise given the trademark fundamentals and historical development of trademark protection explored above, this examination is conducted specifically to test validity within those two jurisdictions and thus references, resources, and law is limited to those that are controlling and relevant.

It must be remembered, however, that this exercise is conducted not to evaluate validity of these particular items of indigenous intangible property, but rather to examine the application of trademark protections in these jurisdictions to any similar item of indigenous intangible property that would exhibit similar characteristics. Furthermore, the jurisdictions selected while necessarily following the Sámi and Tlingit, are essentially acting as exemplars of trademark protection systems elsewhere. Through examining the validity of trademark protections within Norway and the United States, as applied to the gákti and tináa, with reference to the Sámi and the Tlingit, the next few sections are in fact articulating the application of the general principles of trademark protection as seen in those jurisdictions, and trademark protections' general applicability to indigenous intangible properties.

⁷⁶² Or at least one of the jurisdictions to which the Sámi find themselves subjected – Norway – given that Sápmi has been divided between four States.

6.3.1. The US trademark system

The trademark protection system in the United States is a complex web of layered and parallel structures. This is primarily a result of how the system developed, as described in section 3.3, with the establishment of the Federal statutory protections coexisting with protection afforded at common law. As mentioned in section 3.3-4, the Federal statutory system did not extinguish the pre-existing protections of distinguishing marks under the common law at the State level – something that created a separation between Federal and State level protection that still exists in the US system today.

This system is further complicated by the fact that each US State has implemented their own trademark registration system as well, while at the same time the Federal statutory law has recognised protection available through the Lanham Act for unregistered trademarks.⁷⁶³ In short, a distinctive mark can potentially find protection as a trademark through registration at the State level and the Federal level, while also having recourse to rights as an unregistered trademark through the Lanham Act or State level common law.

In this work, it is not possible to explore each of these avenues. Instead, the focus shall be on validity of a mark under the Federal trademark system, specifically looking at provisions relating to unregistered trademarks. This is not to say that the enquiry will have no application outside of that area. Indeed, it is settled that in the US, though the route through which one finds protection may differ, the issues involved and the tests are nearly identical.⁷⁶⁴

The trademark protection system in US Federal law is currently enshrined in the Lanham Act of 1946.⁷⁶⁵ As touched upon above, protection under the provisions of the Lanham Act can be pursued in two manners, namely registration under section 2 (15 USC 1052)

⁷⁶³ Mark P McKenna, 'Trademark Law's Faux Federalism' in Shyamkrishna Balganes (ed.), *Intellectual Property and the Common Law* (Cambridge University Press 2013), pg 288.

⁷⁶⁴ 'That on the particular types of issues here involved there is no difference in the federal statutory rule, the federal common-law rule, the Massachusetts statutory rule and the Massachusetts common-law rule.' - *Coca-Cola Co v Snow Crest Beverages*, 162 F2d 280, 283 (1st Cir 1947).

⁷⁶⁵ PL 79-489, 60 Stat 427, Title 15 United States Code chapter 22 section 1051 *et seq.* (15 USC 1051 *et seq.*).

or as an unregistered trademark under section 43(a) (15 USC 1125).⁷⁶⁶ Section 43(a) of the Lanham Act (15 USC 1125) states in relevant part that

(a) Civil Action

- (1) Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which –
 - (A) is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person, or
 - (B) in commercial advertising or promotion, misrepresents the nature, characteristics, qualities, or geographic origin of his or her or another person's goods, services, or commercial activities,shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act.
...
- (3) In a civil action for trade dress infringement under this chapter for trade dress not registered on the principal register, the person who asserts trade dress protection has the burden of proving that the matter sought to be protected is not functional.

Section 43(a) of the Act has become the vehicle by which unregistered trademarks find protection on the Federal level. '[T]he [US Supreme] Court interprets this section [s43(a) 1125(a)] as having created a federal cause of action for infringement of an unregistered trademark or trade dress and conclude that such a mark or dress should receive essentially the same protection as those that are registered.'⁷⁶⁷ Indeed, it has been pointed to that '[a]ll courts have held that § 43(a) provides a federal vehicle for assertion of infringement of even *unregistered* marks and trade names.'⁷⁶⁸

Proceeding under Lanham Act section 43(a) for the protection of an unregistered trademark includes one significant difference from cases involving a registered trademark. This difference can, essentially, be found in the timepoint at which one must prove the validity of the trademark itself. During the application process for trademark

⁷⁶⁶ *Forney Industries v Daco of Missouri*, 835 F.3d 1238, 1244 (10th Cir 2016) - 'First, under § 2 of the Act, 15 U.S.C. § 1052, a party can seek protection of its trademark by registering it with the United States Patent and Trademark Office. This entitles the owner to a presumption that its mark is valid. But the failure to register a [mark] does not preclude its protection. Unregistered marks are protected from infringement under § 43(a) of the Act, 15 U.S.C. § 1125.' at 1244 (internal citations and quotations omitted).

⁷⁶⁷ *Two Pesos v Taco Cabana*, 505 US 763, 767-8 (1992).

⁷⁶⁸ McCarthy (n 225) § 27:14.

registration, a mark is evaluated according to the validity bases outlined in Lanham Act section 2.⁷⁶⁹

If a mark successfully proceeds through the application process and is granted registration it gains a presumption that it is a valid trademark. This, essentially, changes the burdens during an enforcement proceeding and distinguishes the process of proceeding upon a registered mark as compared to an unregistered mark under Lanham Act section 43(a). In the case of a registered trademark, the validity of the mark is presumed and the arguments to be taken up against that mark are limited. This is perhaps one of the most significant advantages of trademark registration. In contrast, in an action based upon an unregistered mark the 'plaintiff must prove both validity and infringement, unaided by any presumption'.⁷⁷⁰

It is necessary to be familiar with both of these avenues of protection because the general principles relevant for protection under the Lanham Act section 2 regarding registrations are for the most part applicable to the protection of unregistered marks under Lanham Act section 43(a).⁷⁷¹ However, much of what is articulated in Lanham Act section 2 is a statutory enshrinement of the general principles of trademark law that were outlined previously in this work. Essentially Lanham Act section 2 establishes prohibitions against marks that would fail to perform the necessary functions of a trademark explored above, that is they lack the distinctiveness necessary or would cause confusions. There are additional policy prohibitions, such as against disparaging marks,⁷⁷² official flags and coats of arms, and personal attributes, but the thrust of the section is nothing outside of what one would generally expect from a functioning trademark, in line with the presentation and conclusion drawn in Parts 4 and 5. Additionally, the provisions of Lanham Act section 2 are also tempered by a general acceptance of secondary meaning, and thus the public perception, being read into the

⁷⁶⁹ These restrictions are similar to those seen in §§15-16 of vml.

⁷⁷⁰ McCarthy (n 225) § 27:14.

⁷⁷¹ *Two Pesos v Taco Cabana*, 505 US 763, 776 (1992).

⁷⁷² This prohibition has been ruled unconstitutional by *Matal v Tam*, 137 S.Ct. 1744 (2017).

section, as well as the Courts consistently stating that the Lanham Act section 2 provisions apply with the qualifier ‘for the most part’⁷⁷³ in unregistered trademark cases.

The judicial system in the United States is typified by its English Common Law nature. While the term ‘common law’ can take on different meanings,⁷⁷⁴ for the purposes of this work the most relevant understanding is that of ‘a mode of legal reasoning’.

Judge-made law ordinarily follows a form of reasoning that is fairly distinctive, given its attempt to develop a forward-looking rule while at the same time focusing on the dispute at hand and relying on precedent for support. When used in this sense, scholars associate the common law with a form of practical reasoning that relies heavily on analogy, coherence, and incremental modification over time. It is in this sense that some use the phrase “the common law method.”⁷⁷⁵

In this manner, in order to accurately interpret the Lanham Act provisions it is necessary to take account of the precedent that interprets those provisions. This process can be complicated by the structure of the US Federal Courts which are divided among geographic Circuits which are subdivided by Districts. As stated above, the focus of this work is the validity of a trademark according to the Federal Lanham Act provision providing for the protection of unregistered marks - 15 USC 1125(a) - thus the relevant precedent begins with the Federal Courts. However, it is then necessary to understand the precedential value at the different levels of the Federal court system as it relates to the exemplar indigenous intangible resource that was selected from the Tlingits – the tináa.

There are three levels to the Federal court system in the US – the courts of first instance, called District courts; appeals courts, commonly called Circuit courts of which there are 13 circuits;⁷⁷⁶ and, the Supreme Court. The precedent of the Courts is instrumental in interpreting the statutory law. The Tlingit are resident in the US State of Alaska and this

⁷⁷³ *Two Pesos v Taco Cabana*, 505 US 763, 776 (1992).

⁷⁷⁴ see Shyamkrishna Balganes, ‘Introduction’ in Shyamkrishna Balganes (ed), *Intellectual Property and the Common Law* (Cambridge University Press 2013), pg 2 – describing five possible understandings of ‘common law’: Judge-made law, a mode of legal reasoning, state rather than federal law, evolving and pluralistic body of law, certain foundational subject areas.

⁷⁷⁵ Shyamkrishna Balganes, ‘Introduction’ in Shyamkrishna Balganes (ed), *Intellectual Property and the Common Law* (Cambridge University Press 2013), pg 2.

⁷⁷⁶ Circuits 1-11, the District of Columbia Circuit, and the Federal Circuit.

informs the authoritative precedent that is used when answering legal questions. Alaska has one district court and is geographically in the territory of the Ninth Circuit. Thus, controlling precedent as it relates to Federal trademark validity questions in regard to Tlingit intangible resources would consist of Supreme Court decisions being controlling, essentially being capable of stating what the law is for all Courts underneath the power of the Supreme Court. The Ninth Circuit decisions would also be controlling in our scenario. Appeal court decisions will interpret the law for their respective circuits in a controlling manner, within the bounds of Supreme Court decisions. Decisions from other circuits and district level decisions, within the same district and circuit, would be persuasive but not controlling on the applicable law.

With that in mind, it is necessary to articulate the requirements for establishing a valid protectable unregistered trademark under Lanham Act section 43(a) according to the applicable law of the Ninth Circuit.⁷⁷⁷

6.3.2. The Tináa and section 43(a)

In the case of *Southern California Darts Association v Zaffina*,⁷⁷⁸ the relevant Ninth Circuit law with respect to section 43(a) was articulated as follows:

In order to prevail on a suit under this provision section 43(a), a plaintiff must prove two basic elements: (1) it has a valid protectable trademark, and (2) the defendant's use of the mark is likely to cause confusion. The first of these basic elements is comprised of two sub-parts: the mark's protectability and the plaintiff's ownership of the mark.⁷⁷⁹

⁷⁷⁷ This scenario is simplified as the applicable law may change depending upon where a case is filed, which in turn is connected to the place, nature, and perpetrator of an infringement.

⁷⁷⁸ 762 F.3d 921 (9th Cir 2014).

⁷⁷⁹ *Southern California Darts Association v Zaffina*, 762 F.3d 921, 929 (9th Cir 2014) (internal citations and quotations omitted); *Balance Studio v Cybernet Entertainment*, 2017 WL 2473038 (ND Cal 2017) – 'To establish a trademark infringement claim under section 32 of the Lanham Act or an unfair competition claim under section 43(a) of the Lanham Act, a plaintiff must establish that a defendant is using a mark confusingly similar to a valid, protectable trademark of the plaintiff's' at *4 (internal citation and quotations omitted); *Tana v Dantanna's*, 611 F.3d 767 (11th Cir 2010) - 'To establish a prima facie case of trademark infringement under § 43(a), a plaintiff must show (1) that it had trademark rights in the mark or name at issue and (2) that the other party had adopted a mark or name that was the same, or confusingly similar to its mark, such that consumers were likely to confuse the two.' at 773; *Savant Homes v Collins*, 809 F.3d 1133 (10th Cir 2016) To obtain relief under § 43(a), a plaintiff must show: (1) The trade dress is inherently distinctive or has become distinctive through secondary meaning; (2) There is a likelihood of confusion among consumers as to the source of the competing products; and (3) The trade dress is nonfunctional.' at 1147. See also *AK Futures LLC v Boyd St Distro*, 35 F.4th 682 (9th Cir 2022), and *Gordon v Drape Creative, Inc.* 897 F.3d 1184 (9th Cir 2018).

In order to evaluate the validity of Tlingit trademark rights in the tináa under the relevant controlling law it is then necessary to establish whether 1) the tináa is protectable and 2) whether the Tlingit own it as a mark.

6.3.2.1. *Protectability*

In the 2014 case of *Southern California Darts Association v Zaffina*⁷⁸⁰ the Ninth Circuit Court of Appeals affirmed that the general trademark norm as explained in section Part 4 above, that '[w]hether a mark is protectable depends on its degree of "distinctiveness"'⁷⁸¹ applies equally as controlling law for the protection of unregistered marks in the Ninth Circuit. Moreover, when determining distinctiveness, the Ninth Circuit uses the spectrum of distinctiveness, as should be recognised from section 4.3 above. Hence the Court stated:

[t]here are five traditional categories of distinctiveness: (1) generic, (2) descriptive, (3) suggestive, (4) arbitrary, or (5) fanciful. Generic marks are not eligible for trademark protection. Descriptive marks become protectable if they acquire a "secondary meaning," by becoming distinctive as used on or in connection with the applicant's goods in commerce. Suggestive, arbitrary, and fanciful marks are automatically protectable.⁷⁸²

Where the tináa falls on the outlined spectrum of distinctiveness is highly dependent upon the manner in which the tináa design used, upon which products it appears, or how it is exhibited.⁷⁸³ When used as a distinguishing emblem or shape affixed upon a good or in connection with a service, it would seem to fall at least within the boundaries of inherently distinctive. However, the traditional form that the tináa took was as a product within itself – hearkening back to the 'coppers' that were mentioned by the early western visitors to the Southeast Alaska coast. This inseparable nature of the tináa

⁷⁸⁰ *Southern California Darts Association v Zaffina*, 762 F.3d 921, 929 (9th Cir 2014)

⁷⁸¹ *Id.* at 929 (internal citation and quotations omitted).

⁷⁸² *Ibid.*

⁷⁸³ Indeed, the usefulness of the spectrum has been called into question with regard to non-word marks, *Amazing Spaces v Metro Mini Storage*, 608 F.3d 225 (5th Cir 2010) – 'the challenge of placing the Star Symbol into *Abercrombie's* constellation of categories is a futile endeavor.' at 241, and suggesting the *Seabrook Foods* test – 'In determining whether a design is arbitrary or distinctive this court has looked at [1] whether it was a "common" basic shape or design, [2] whether it was unique or unusual in a particular field, [3] whether it was a mere refinement of a commonly-adopted and well-known form of ornamentation for a particular class of goods viewed by the public as a dress or ornamentation for the goods, or [4] whether it was capable of creating a commercial impression distinct from the accompanying words.' *Seabrook Foods v Bar-Well Foods*, 568 F.2d 1342 (CCPA 1977).

as a distinguishing mark and as a product is also seen in the marketplace today in the form of pendant, earrings, and other jewelry.

When evaluating a mark that is inseparable from the product the enquiry becomes one of trade dress or a product design in modern parlance. The controlling precedent on trade dress, applicable to the Ninth Circuit is the case of *Two Pesos v Taco Cabana*.⁷⁸⁴ In *Two Pesos* a question was raised as to whether there was a need to show secondary meaning in order for a restaurant's trade dress to be protectable. The US Supreme Court viewed this question from the standpoint of asking if the mark could be registered -

If a verbal or symbolic mark or the features of a product design may be registered under §2, it necessarily is a mark by which the goods of the applicant may be distinguished from the goods of others, and must be registered unless otherwise disqualified. Since §2 requires secondary meaning only as a condition to registering descriptive marks, there are plainly marks that are registrable without showing secondary meaning. These same marks, even if not registered, remain inherently capable of distinguishing the goods of the user of these marks. Furthermore, the copier of such a mark may be seen as falsely claiming that his products may for some reason be thought of as originating from the plaintiff.⁷⁸⁵

It must be questioned then whether the tináa would be capable of registration under §2 of the Lanham Act. There is no dispute that marks and the products that they distinguish can be physically and conceptually inseparable.⁷⁸⁶ The Court of Customs and Patent Appeals confirmed this in 1977 in the case of *In Re Penthouse International*⁷⁸⁷ where Penthouse applied for registration of a certain design for jewelry. The Court stated that

Registration was here refused because the mark was considered "functional" and therefore not capable of identifying the origin of jewelry. That view rests on Penthouse's decision to employ its mark as the design of its pendants, rather than "on" its pendants. If the pendant has a nontrademark function, the inquiry is not at an end; possession of a function and of a capability of indicating origin are not in every case mutually exclusive.⁷⁸⁸

⁷⁸⁴ 505 US 763 (1992).

⁷⁸⁵ *Two Pesos v Taco Cabana* 505 US 763, 772 (1992).

⁷⁸⁶ See section 4.5.5.

⁷⁸⁷ 565 F.2d 679 (CCPA 1977).

⁷⁸⁸ *In Re Penthouse International*, 565 F.2d 679, 681 (CCPA 1977).

The Court concluded that '[t]he stylized key design in the present case may have a function of attracting purchasers, but the shape of the jewelry, like the mark, is arbitrary and nonessential to a functioning piece of jewelry.'⁷⁸⁹

Though the Court's reasoning revolved around the question of functionality, it is clear that the design of a piece of jewelry can function as a trademark. The design can be distinctive enough, as well as arbitrary and non-functional. Indeed, this idea is even supported by the historical accounts of tináa - 'These prestige valuables were often material objects that had no functional significance. First among them were native copper plates that were used exclusively at potlatches...'.⁷⁹⁰

In short, the unique design of the tináa, whether used as a symbol on other products or as the product itself is highly likely to be ruled distinctive under the controlling trademark law.

However, the US Supreme Court returned to the question of inherent distinctiveness in product design in the case of *Wal-Mart Stores v Samara Bros*⁷⁹¹ and distinguished it from trade dress. The Supreme Court held that 'in an action for infringement of unregistered trade dress under Lanham Act section 43(a), a product's design is distinctive, and therefore protectable, only upon a showing of secondary meaning.'⁷⁹²

This blanket requirement necessitates the establishment of secondary meaning in all situations where a product is wholly composed of a trademark.⁷⁹³ 'Whether a particular

⁷⁸⁹ *In Re Penthouse International*, 565 F.2d at 681; see also *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd*, 604 F.2d 200 (2nd Cir 1979) - It is well established that, if the design of an item is nonfunctional and has acquired secondary meaning, the design may become a trademark even if the item itself is functional.' at 203.

⁷⁹⁰ Grinev (n 106) pg 49.

⁷⁹¹ 529 US 205 (2000).

⁷⁹² *Wal-Mart Stores v Samara Bros*, 529 US 205, 216 (2000).

⁷⁹³ The author questions this position taken by the Supreme Court. It seems to value the formalities of trademark protection over the substance and goals. One could wonder if a unique and distinguishing shape such as the Toblerone chocolate would be able to enter the market now and find protection for that design, or if the Supreme Court's position would leave Toblerone open to the attacks of opportunistic copycats and unable to trade enough under the design mark to engender secondary meaning.

trade dress has acquired secondary meaning is a question of fact... . A product's trade dress attains secondary meaning when the purchasing public associates the dress with a single producer or source rather than just the product itself.⁷⁹⁴

According to the US Supreme Court ruling in *Wal-Mart Stores v Samara Bros*,⁷⁹⁵ any product design trademark must show secondary meaning to qualify for protection under section 43(a) of the Lanham Act, and in the Ninth Circuit

[t]he question of secondary meaning is one of fact. To determine whether a descriptive mark has secondary meaning, a finder of fact considers: (1) whether actual purchasers of the product bearing the claimed trademark associate the trademark with the producer, (2) the degree and manner of advertising under the claimed trademark, (3) the length and manner of use of the claimed trademark, and (4) whether use of the claimed trademark has been exclusive.⁷⁹⁶

Coming to a prescriptive determination on secondary meaning under section 43(a) can be challenging as it must be remembered that section 43(a) is invoked at times of dispute. Meaning that the testing of secondary meaning in this context would be more fully informed by the contours of the dispute, as well as the evidence and testimony gathered. In the course of taking such an action to court the information available for the court to consider would be more particular and complete, given the procedures of litigation and discovery which would assist in an informed analysis of the highly fact dependent question of secondary meaning. Factors that may in particularly determine the outcome of such a dispute include the manner in which the tináa is being used, that is whether it has been used as a product, indicative image on a product, or in connection with a service.

However, certain aspects of the use of the tináa, as we known them now, provide insight into a likely secondary meaning evaluation. There has been continuous and consistent use for hundreds of years by the Tlingit of a design that is unique and distinctive.⁷⁹⁷ It

⁷⁹⁴ *First Brands Corp v Fred Meyer*, 809 F.2d 1378, 1383 (9th Cir 1987).

⁷⁹⁵ 529 US 205 (2000).

⁷⁹⁶ *Yellow Cab Co of Sacramento v Yellow Cab of Elk Grove*, 419 F.3d 925, 930 (9th Cir 2005).

⁷⁹⁷ See section 6.2.3.2.

has consistently been an indicator of Tlingit identity and connection, and is used today by Tlingit craftsmen and organisations as, among other things, a symbol of Tlingit identity. Furthermore, the tináa is today being used not only in a traditional manner similar to the ‘coppers’ that were referred to in the historical record, but also as a distinguishing symbol for other goods and services, or as the good itself.⁷⁹⁸ Given the long standing continuous use, the renown in the area, and strength of the native handicrafts market,⁷⁹⁹ it would seem that these conditions would fulfill the secondary meaning requirements – at the least it would be a good foundation from which to make a strong and reasonable argument for secondary meaning.

From the current and relevant law of the Ninth Circuit as laid out above, it is clear that secondary meaning, and in turn acquired distinctiveness, is intimately connected with the use that has been made of a trademark and ‘[d]istinctiveness measures the primary significance of the mark to the purchasing public.’⁸⁰⁰ While this is the current law as in the Ninth Circuit, it is also a clear exhibition of the general principles and norms of trademark law as were explored in Part 4, and the discussion should now be quite familiar. In order for there to be a protectable trademark there must be a necessary level of distinctiveness, indeed a trademark must be distinctive in order to distinguish and function as a trademark. This distinctiveness can arise inherently from the nature of the mark, or find acquired distinctiveness through use and reputation. Essentially the Ninth Circuit standards are a recitation of the general principles.

6.3.2.2. *Ownership*

The case of *Southern California Darts Association v Zaffina*⁸⁰¹ also recited the relevant law in the Ninth Circuit regarding ownership of a mark, as under the test for protection as an unregistered mark under Lanham Act section 43(a). The Court held that ‘[a] party’s ownership of a protectable mark is determined on the basis of priority of use in

⁷⁹⁸ See, Sealaska Heritage Institute’s Tináa Art Auction <http://www.sealaskaheritage.org/institute/art/art-programs-tinaa>. (last accessed 20 July 2022).

⁷⁹⁹ See section 7.2.

⁸⁰⁰ *Russell Road Food and Beverage v Galam*, 180 F.Supp.3d 724, 734 (D.Nevada 2016), quoting *Zobmondo Entertainment v Falls Media* 602 F.3d 1108, 1113 (9th Cir 2010).

⁸⁰¹ *Southern California Darts*, 762 F.3d at 930.

commerce. That is, the party claiming ownership must have been the first to actually use the mark in the sale of goods or services.’⁸⁰²

In the case of the Tlingit use of the tináa, one would be hard pressed to not see the clear priority of use made by the Tlingit. Not only do the first descriptions⁸⁰³ of the use of tináa by the Tlingit predate any statutory trademark protection scheme,⁸⁰⁴ but they even predate the purchase of Alaska by the United States.⁸⁰⁵ A question, however, remains as to whether the historical accounts evidence a ‘use in commerce’.

From the historical descriptions it is shown that tináa had a value and were being traded. There is also good documentation of extensive trade and commerce amongst the Tlingit and other tribes within the area, as well as ‘by the late 1850s Tlingit canoes were also going south as far as Victoria and Puget Sound for trading, seasonal work, and occasional raiding.’⁸⁰⁶ Furthermore, the United States Court of Claims recognised that ‘[f]rom their earliest history these Indians [the Tlingit and Haida] carried on extensive trade with each other, with neighboring tribes and later with the Russians and the Americans.’⁸⁰⁷

It could be asserted that such use would not equate to inter-state trade as required by the Federal trademark law, but rather only intra-state commerce.⁸⁰⁸ Though, this is more likely an unsupportable position as there was no State of Alaska at the time of this early documented trade, and thus any trade would likely fall under the authority of the Federal government.⁸⁰⁹

⁸⁰² Ibid (internal citations and quotations omitted).

⁸⁰³ Urey (Yuri) Lisiansky, *A voyage round the world in the years 1803, 4, 5, & 6; performed, by order of His Imperial Majesty Alexander the First, Emperor of Russia, in The Ship Neva, by Urey Lisiansky, Captain in the Russian Navy and Knight of the Orders of St. George and St. Vladimer* (London 1814), pg 150.

⁸⁰⁴ The first US trademark act being enacted in 1870.

⁸⁰⁵ Treaty concerning the Cessation of the Russian Possessions in North America by his Majesty the Emperor of all the Russias to the United States of America; Concluded March 30, 1867; Ratified by the United States May 28, 1867; Exchanged June 20, 1867; Proclaimed by the United States June 20, 1867.

⁸⁰⁶ de Laguna (n 99) pg 223.

⁸⁰⁷ *Tlingit and Haida Indians of Alaska v US*, 177 FSupp 452, 454 (United States Court of Claims 1959).

⁸⁰⁸ See generally *Gibbons v Ogden*, 22 US 1 (1824)

⁸⁰⁹ See generally Article 1, Section 8, Clause 3 of the US Constitution; also, 15 USC §1127

Furthermore, it is today accepted that the ‘use in commerce’ requirement is more akin to a ‘use affecting commerce’.⁸¹⁰ ‘Purely intrastate use does not provide a basis for federal registration. However, if intrastate use directly affects a type of commerce that Congress may regulate, this constitutes use in commerce within the meaning of the Act.’⁸¹¹ One of the primary means for consumers to visit Southeast Alaska today is via cruise ships which cross multiple borders to reach their destination. Indeed, the Cruise Line International Association estimated that one million fifty-five thousand people would visit Juneau, Alaska alone in the summer of 2017, and spend on average 1.233m USD a day.⁸¹² Given the large-scale tourism, and the accompanying sale of indigenous cultural items, it follows that use of tináa would be ‘use in commerce’ under the US trademark law. Similarly, historical trade in Southeast Alaska can be traced back to travelers from the contiguous 48 states and various waves of trade, such as the Klondike Gold Rush of the late 1800s. This would lend weight to Tlingit historical use of the tináa also qualifying as ‘use in commerce’ for the purposes of the Lanham Act and establishing clear priority of use.⁸¹³

Furthermore, the ‘power of the federal government to register marks comes from the commerce clause of the Constitution’⁸¹⁴ – Article 1 Section 8(3) which states ‘to regulate Commerce with foreign Nations, and among the several States, and with the Indian Tribes.’⁸¹⁵ Because the Tlingit are a recognised Indian tribe, within the meaning of the commerce clause, arguably any trade involving tináa, and possibly any other trademark protectable intangible resource of the Tlingit, would fall within the bounds of the Commerce clause restrictions to the Federal Lanham Act.

⁸¹⁰ McCarthy (n 225) §19:123.

⁸¹¹ Trademark Manual of Examining Procedure, (USPTO 2024), 901.03; available at <https://tmepp.uspto.gov/RDMS/TMEP/current>. (last accessed 19 June 2024).

⁸¹² Alex McCarthy, ‘Record number of cruise passengers expected in Juneau this summer.’ Juneau Empire, (28 April 2017) <http://juneauempire.com/local/2017-04-27/record-number-cruise-passengers-expected-juneau-summer>. (last accessed 20 June 2024).

⁸¹³ Additionally, historical trade of tináa or using the tináa mark could be seen as falling under the commerce clause of the US Constitution through its application to trade ‘with the Indian Tribes’.

⁸¹⁴ Trademark Manual of Examining Procedure, (USPTO 2024), 901.03; available at <https://tmepp.uspto.gov/RDMS/TMEP/current>.

⁸¹⁵ US Constitution Article 1, Section 8.

It is also important to note that Lanham Act section 43(a) does not necessarily require that there be use in commerce in order to plead a successful claim. Under the provision of Lanham Act section 43(a) all that is needed is that the person or entity bringing a claim is one 'who believes that he or she is or is likely to be damaged' by the acts of the defendant.⁸¹⁶ This is an important distinction between the protection provisions of the Lanham act relating to registered marks and section 43(a) on unregistered marks. Even though use in commerce is not required under Lanham Act section 43(a) to protect unregistered trademarks, it is still worth keeping in mind in regard to whether or not the Tlingit have a valid trademark whether registered or not. It would seem that they would satisfy the threshold requirements in either situation.

6.3.2.3. Source

As discussed in section 4.2, tied with the concept of ownership is the conceptualisation of a 'source' which can own the trademark. As mentioned above, in many circumstances the Courts draw analogies between a structurally ambiguous source and some form of business associations. In *Southern California Darts Association v Zaffina*,⁸¹⁷ the Ninth Circuit took the approach that that the Darts Association was an unincorporated association and thus had the capacity to own trademarks.⁸¹⁸ To be more precise the Ninth Circuit took a rather more circuitous route to come to that conclusion. It was held that the Darts Association was an unincorporated association, and because of that it has the capacity to sue and be sued. It was this capacity to sue and be sued that then qualified it as an entity that could own a trademark.⁸¹⁹

⁸¹⁶ Lanham Act section 43(a)

⁸¹⁷ 762 F.3d 921, 929 (9th Cir 2014).

⁸¹⁸ *Southern California Darts Association v Zaffina*, 762 F.3d 921, 930 (9th Cir 2014); see also the Court's articulation of the Federal Rules of Civil Procedure - 'Capacity to sue in federal court is governed by Federal Rule of Civil Procedure 17(b). Under this Rule, an individual's capacity to sue is determined by "the law of the individual's domicile"; a corporation's capacity to sue is determined by "the law under which it was organized"; and the capacity for "all other parties" to sue is determined by "the law of the state where the court is located." Fed.R.Civ.P. 17(b)(1), (2), (3). There are two exceptions to Rule 17(b)(3), however. The first of these is relevant in the current case. Rule 17(b)(3)(A) states that a "partnership or other unincorporated association" that lacks the capacity to sue under the law of the state in which the court is located "may sue or be sued in its common name to enforce a substantive right existing under the United States Constitution or laws." At 927.

⁸¹⁹ *Southern California Darts Association v Zaffina*, 762 F.3d 921, 930 (9th Cir 2014).

The Ninth Circuit's reasoning weighed heavily the determination of whether an entity was capable of filing a suit or being sued. This is primarily motivated by the definitions within the Lanham Act which state that the term 'person' for the purposes of the act also includes an 'organization capable of suing and being sued in a court of law'.⁸²⁰ While this reasoning may not conform to the general principles of trademark protection, it must be noted that in the context of the Tlingit the capacity to sue and be sued may be a rather simple qualification to fill, at least in the Alaska Native context. The Alaska Native peoples are unique amongst the native peoples in the United States in terms of their modern organisation. According to the terms of the Alaska Native Claims Settlement Act⁸²¹ of 1971 ('ANCSA') the native peoples in Alaska were organised into corporations. Through the ANCSA the Tlingit people specifically were organised into a number of village corporations and one regional corporation – Sealaska Corporation. It is outside the scope of this work to review the workings of ANCSA or even the modern organisation of the Alaska Native peoples. Suffice it to say that the Alaska Natives, and the Tlingit in particular, would easily be able to sue and be sued through the native corporation or native village structure, and thus according to the reasoning of the Ninth Circuit would also be able to own trademarks. Similar determinations would be likely for other Federally recognised Indian tribes in the US, although their legal structure and nature differ from that under the ANCSA.

However, this conclusion goes slightly counter to the idea of the protection of indigenous intangible properties as has been outlined in this work. To consider the corporation as the owner of a trademark, even though it may be indigenous owned, operated, or even organised for the sole purpose of furthering the rights of its indigenous members, might preclude the indigenous peoples, as a people and as individuals, from owning their own cultural heritage.

In this regard, it must be noted that the Tlingit have been successful in suing as a people in the courts of the United States. Though dealing with right to land and resources, and approved specifically through statute, cases of *Tlingit and Haida Indians of Alaska v US*

⁸²⁰ 15 USC 1172.

⁸²¹ 43 USC 1601 *et seq.*

(1968),⁸²² and *Tlingit and Haida Indians of Alaska v US* (1958),⁸²³ evidence that claims can be made by the Tlingit as a people without an intermediary western construct such as a corporation or association.⁸²⁴

The above demonstrates that the Tlingit would reasonably be successful in asserting ownership of any trademark right in the tináa. However, basing this ownership on the attenuated method employed in *California Darts*, does not articulate the entire relevant precedent. When examining the concept of source in Part 5, guidance was taken from various band cases in order to show the validity of collective ownership of a trademark. One of the cases presented was the Ninth Circuit case of *Robi v Reed*.⁸²⁵ In *Robi v Reed* the Ninth Circuit clearly endorsed the proposition that a trademark could be owned collectively, and that this was not necessarily dependent upon the determination of a corporate or business style entity. It was stated in that case that ‘the five members of the group owned the mark collectively...’.⁸²⁶ Moreover, *Robi v Reed* also exhibits the Ninth Circuit law’s endorsement of the role that the public perception plays in determining and defining the source. It would seem that notwithstanding the reasoning employed in *California Darts*, the Ninth Circuit is comfortable with the ownership of trademarks by collectives, without western commercial structures, and a concept of the source determined by public perception.

With the above in mind, there is no legal, conceptual, nor theoretical reason why the Tlingit as a people could not own a valid trademark, or why they could not be considered a source. In the context of the protection of indigenous intangible resources of the Tlingit this is a particularly poignant conclusion because it aligns the protection more accurately with the Tlingit property law and at.óow. Thereby not only protecting the

⁸²² 389 F.2d 778 (United States Court of Claims 1968).

⁸²³ 177 F.Supp 452 (United States Court of Claims 1958).

⁸²⁴ The statute that authorised these suits did so by reference to the Tlingit and Haida as a people. 49 State 388 (HR 2756) June 19, 1935, section 1; PL 89-130 August 19, 1965 (s 893) 79 Stat 543 – An Act To amend the Act of June 19, 1935 (49 Stat 388), as amended, relating to the Tlingit and Haida Indians of Alaska.

⁸²⁵ *Robi v Reed*, 173 F3d 734 (9th Cir 1999).

⁸²⁶ *Robi v Reed*, 173 F3d 734, 740 (9th Cir 1999); it must also be noted that the transfer of right to the corporate entity in this case was ruled invalid, and the rights reverted back to the band members collectively.

intangible resources of the Tlingit but also legitimizing within the American legal world Tlingit law, cosmology, self-determination, and identity.

In the context of a section 43(a) enquiry into the concept of source under Ninth Circuit law the above exhibits that the source is not the restrictive single source concept that was seen in early statutory trademark systems. Indeed, under Ninth Circuit law the source is a concept that finds grounding in the general principles of trademark law as seen in Part 4. Indeed the principles relating to the importance of the public in determining the source, the nature of that source, and the ownership of a trademark are found both in the current Ninth Circuit law and trademark protection norms.⁸²⁷

6.3.2.4. Intricacies of section 43(a) (15 USC 1125(a)) protection

As mentioned previously in section 6.3.1 the standing to bring a case under Lanham Act section 43(a) is not dependent upon the ownership of a mark, or even the proof of an unregistered mark. Though this does not speak to the validity of the trademark rights of the Tlingit, or other indigenous peoples, in their intangible resources, it is necessary to briefly introduce the workings of Lanham Act section 43(a) as it is the provision within the United States Federal Law through which the rights to unregistered marks are asserted.

The evaluation above concerning the tináa and protection under Lanham Act section 43(a) centered around the tináa as an unregistered trademark. However, this provision is not entirely structured as a positive protection of unregistered trademarks. Section 43(a) rather provides a mechanism to restrain the offensive use of marks. In this work a thorough examination of Lanham Act section 43(a) will not be undertaken. For the purpose of this work and completeness of understanding how an indigenous people would bring a claim to protect their trademarked intangible properties, it is only necessary to understand that it is only required that a plaintiff 'believe that he or she is

⁸²⁷ And, the author would propose, the proper lens through which to view this situation. *Adobe Systems v Christenson*, 809 F.3d 1071, 1081 (9th Cir 2015) quoting *Fortune Dynamics v Victoria's Secret Stores Brand Management*, 618 F.3d 1025, 1030 (9th Cir 2010) - 'The core element of trademark infringement is protecting against a likelihood of confusion which helps to ensure that owners of trademarks can benefit from the good will associated with the marks and that consumers can distinguish among competing products.'

or is likely to be damaged'.⁸²⁸ This necessarily means that the existence of a trademark need not be asserted. However, doing so would essentially bring a party over the necessary threshold of belief in likely damage.⁸²⁹

It should also be noted that such negative protections, that is the ability to restrain others, unattached to ownership of a mark or other item may be a means through which indigenous peoples could prevent certain forms of cultural appropriation. However, this is outside the scope of the current work.

6.3.3. Trademark regime in Norway

6.3.3.1. Introduction

While the Norwegian trademark system is unique and distinct from that of the US, there remain substantial similarities rooted in the fundamental elements of trademark protection as articulated above in Part 4-5. Indeed, in both systems one finds the general principles of trademark protection, such as the overall function of a trademark, requirements for distinctiveness, a relative measurement of that distinctiveness, prohibition against the protection of generic marks, ability to achieve secondary meaning, and the role that the public perception plays. However, the structure of the Norwegian legal system requires a different navigation to examine the question of a current trademark protections applicability to indigenous intangible resources.

The trademark protection regime in Norway is primarily enshrined in the law of 26 March 2010 nr. 8 on the protection of trademarks ('varemerkeloven').⁸³⁰ However, there are two significant differences between the Norwegian legal system and that of the United States, and indeed other common law jurisdictions, that must be taken into account when interpreting the trademark protection system in Norway. Those differences are firstly, the hierarchy of the sources of law and, secondly, the role that European Union law has in Norway.

⁸²⁸ 15 USC §1125(a)(1).

⁸²⁹ McCarthy (n 225) §32:12.

⁸³⁰ Law 26 march 2010 number 8 on the protection of trademarks.

6.3.3.2. *Norwegian legal sources and hierarchy*

There is a decent amount of case law interpreting varemerkeloven and deciding trademark disputes in Norway, but to draw exclusively from this case precedent and interpretation would be inappropriate in the Norwegian context. As with other jurisdictions rooted in the civil law system, Norwegian case precedents are subordinate to statute in a manner unfamiliar to the common law tradition. This is enshrined in the the Norwegian principles on legal sources (*rettskildelære*).⁸³¹ Specifically, the sources of law in Norway can be classed according to a hierarchy of decreasing weight. When interpreting a certain statute, the supreme source of law is the Constitution,⁸³² followed by the preparatory works of that statute, case law – with the High Court of Norway precedent being controlling, executive / government practice, private practice, legal scholarship and opinion, and equitable policies.⁸³³

Thus, in interpreting varemerkeloven it is necessary to take account of the preparatory works that led to the enactment of varemerkeloven itself. These instruments provide the primary lens through which to view the provisions, rights, obligations, and goals of the law.

Relevant to the analysis of this work,⁸³⁴ the primary preparatory works of varemerkeloven are Norges offentlige utredninger⁸³⁵ 2001:8 (NOU 2001:8, also known as ‘Varemerkeutredningen II’), Proposisjon til Stortinget number 8 (2009-2010) (‘Prp.nr.8 L (2009-2010)’), and Proposisjon til Odelstinget number 98 (2008-2009)

⁸³¹ Skoghøy (n 14) section 3.1 *et seq.*

⁸³² Grunnloven 17 mai 1814.

⁸³³ Skoghøy (n 14) section 3.2 *et seq.*; T. Eckhoff & F.E Helgesen, *Rettskildelære* (Universitetsforlaget, 5th ed 2001), pgs 23-24.

⁸³⁴ Varemerkeloven was recently amended to primarily integrate changes as the result of EU Directive 2015/2436. The amendments and reasoning for those amendments are primarily contained in Prop.43 LS (2019-2020) Endringer i varemerkeloven og tolloven mv. (gjennomføring av nytt varemerkedirektiv mv.) og samtykke til godkjenning av EØS-komiteens beslutning nr. 27/2020 av 7 februar 2020 om innlemmelse i EØS-avtalen av direktiv (EU) 2015/2436 (nytt varemerkedirektiv) og samtykke til tiltredelse til Singaporetrakteten 27. mars 2006 om varemerkerett.

⁸³⁵ ‘Norges offentlige utredninger’ can be translated as a ‘Norwegian Public Report’. It is essentially a detailed study of issues by a group of experts normally formed as a committee, panel, or commission by the government. These reports, along with public comments upon the reports, are normally the basis for legislation suggested to the parliament and a relied upon heavily in interpreting enacted legislation.

(‘Ot.prp.nr. 98 (2008-2009)’) which was integrated by reference into a later Proposisjon til Stortinget number 6 (2008-2010) (‘Prp.nr.6 L (2009-2010)).⁸³⁶ As mentioned, unlike the United States’ and other common law jurisdictions reliance on case law precedent to interpret the law, within the structure of the Norwegian legal system the point of departure in interpreting the law becomes, in practice, the statute and that particular statutes’ preparatory works. That said, the difference between these two legal traditions should not be exaggerated, especially in the context of trademark protection. As US law has come to rely more on codified law in recent times, case law, in particular that from the High Court, is also becoming an increasingly more weighted legal source in Norway.

6.3.3.3. *The relevance of EU Law*

Trademark law in Norway is also significantly affected by Norway’s membership in the European Economic Area (EEA). By virtue of the Agreement on the EEA,⁸³⁷ Norway is committed to integrate trademark related European Directives⁸³⁸ into its domestic law.⁸³⁹ Additionally, by operation of the EEA Agreement’s article 6 and 2(a),⁸⁴⁰ and Article 3(2) of the EFTA Surveillance and Court Agreement,⁸⁴¹ the EU case law that interprets trademark provisions in EU law are relevant to the application of trademark law in Norway. This means that the interpretation of EU instruments in the trademark area will have certain judicial weight in Norway when interpreting varemerkeloven.⁸⁴²

⁸³⁶ A Proposisjon til Stortinget and a Proposisjon til Odelstinget are functionally the same. They are both manners in which proposed legislation is suggested to parliament. Odelstinget was dissolved in 2009 thus all propositions now go directly to Stortinget in plenum. Ot.prp.nr. 98 (2008-2009) was not dealt with during Odelstinget’s last session, and thus was integrated into Prp.nr. 8 (2009-2010) directed to Stortinget.

⁸³⁷ Agreement on the European Economic Area (‘EEA Agreement’), 2 May 1992 (OJ L1, 03/01/1994, pg 3).

⁸³⁸ It must be noted to those unfamiliar that an EU Directive is formal legislation for the European Union. The European Union is a political and economic union comprising 28 member states. The European Economic Area is a separate and distinct arrangement relating to free movement of persons, goods, services, and capital within a single European Market. The EEA comprises the member states of the EU and Iceland, Liechtenstein, and Norway.

⁸³⁹ Decision of the EEA Joint Committee, No 146/2009 of 4 December 2009 amending Annex XVII (Intellectual property) to the EEA Agreement; see also, HR-2016-1993-A, and HR-2016-2239-A for explanation of this interaction with regard to trademark law; see generally, *Kjennetegnssrett* (n16) pgs 30-34.

⁸⁴⁰ EEA Agreement article 2(a), 6.

⁸⁴¹ Agreement between the EFTA States on the Establishment of a Surveillance Authority and a Court of Justice (Surveillance and Court Agreement).

⁸⁴² Case law prior to the signing of the EEA agreement (2 May 1992) is precedential authority – EEA Agreement Article 6; for more comprehensive the interaction between EU trademark practice and

Principal among the EU instruments that must be taken into account in the area of trademark protection are EU Directive 2015/2436,⁸⁴³ and EU Regulation 2017/1001,⁸⁴⁴ as well as the practice of the European Courts and registration authorities when interpreting the provisions of these instruments.⁸⁴⁵ However, it must be remembered that '[d]irektivet gjelder ikke alle sider ved norsk varemerkerett. Primært omfatter det regler om registreringssøknader og om registrerte varemerker. For de deler av lovgivningen som gjennomfører direktivregler, har direktivt – og rettspraksis fra EU-domstolen-vesentlig betydning for tolkningen.'⁸⁴⁶

EU trademark practice certainly has applicability to trademark cases in Norway under varemerkeloven.⁸⁴⁷ However, the applicability of this practice can be limited to where the EU case law is interpreting a provision of the Directive, or the Regulation as connected through a provision in the Directive, that has a connection with the provisions in varemerkeloven. Indeed, '[o]m betydningen av praksis fra EUIPO uttales følgende i Prop.43 LS (2019-2020) punkt 2.2.6: Praksis fra EUIPO kan være av betydning der den er uttrykk for en etablert praksis, men konkrete avgjørelser i enkeltsaker vil ikke ha særskilt vekt.'⁸⁴⁸ The general place that EU practice and interpretation has in the Norwegian

Norwegian trademark law see HR-2016-1993-A, paragraphs 42-46; HR-2016-2239-A, paragraph 31; RT-2002-391 (God Morgon) generally.

⁸⁴³ Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trade marks (recast).

⁸⁴⁴ Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark (codification).

⁸⁴⁵ In 2015 a new Trademark Directive and Regulation were enacted - Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trade marks; and, Regulation (EU) 2015/2424 of the European Parliament and of the Council of 16 December 2015 amending Council Regulation (EC) No 207/2009 on the Community trade mark and Commission Regulation (EC) No 2868/95 implementing Council Regulation (EC) No 40/94 on the Community Trade Mark, and repealing Commission Regulation (EC) No 40/94 on the fees payable to the Office for Harmonization in the Internal Market (Trade Marks and Designs). However, these have not been integrated into the EEA agreement as of the time of this work and will not be dealt with. See also HR-2016-1993-A, para 42.

⁸⁴⁶ TOSLO-2014-176078 (Oslo Tingrett 29 October 2015), pg 10 ('The directive does not apply to all aspects of Norwegian trademark law. Primarily it includes rules on registration applications and registered trademarks. For those parts of the legislation transposing directive provisions, direction and practice from the EU Court has important bearing on interpretation.').

⁸⁴⁷ See generally, LB-2023-9016; HR-2016-1993-A (Pangea) paragraph 44, 46.

⁸⁴⁸ 'on the importance of practice from the EUIPO, the following is stated in Prop.43 LS (2019-2020) point 2.2.6: Practice from EUIPO may be of importance where it is an expression of an established practice,

trademark protection system, and the way that individual EU cases are treated, is a critical distinction as the EU trademark instruments primarily deal with registration of and registered marks, not the protection of unregistered trademarks. Though there is still guidance to be found in the EU case law with regard to certain unregistered trademark questions, one must be careful to not fall into the trap of imposing upon unregistered trademarks EU law requirements or readings that are particular to registered marks. Ultimately, in the area of unregistered trademarks the guidance from EU practice is limited.

6.3.3.4. Material Norwegian trademark law

As touched upon previously, the exclusive right to a trademark can be obtained in Norway through two separate and distinct avenues. The first is through registration, derived from either a national or international application; and, the second is by establishment through use.⁸⁴⁹ The provisions relating to registration of a mark are contained in varemerkeloven chapter 2⁸⁵⁰ for national registration and chapter 10⁸⁵¹ regarding international registrations. The standards for registration of a trademark in Norway are primarily contained in sections 14, 15, and 16 which relate to general requirements and bars to registration of marks that conflict with official interests or others' rights. International applications that are designated to Norway are also subject to the requirements and restrictions in sections 14, 15, and 16.⁸⁵² In addition to the requirements specific to registered marks, all trademarks must conform to the general provisions contained in chapter one (§§ 1-11) of varemerkeloven.⁸⁵³

Similar to the evaluation conducted above regarding the Tlingit, tináa, and Lanham Act, the registration of a trademark under the Norwegian system will not be dealt with substantively. The goal of this example is to test the validity of a hypothetical trademark owned by the Sámi people (or a group within the Sámi people as the case may be) for

but specific decisions in individual cases will not have special weight.' LB-2023-9016, citing Prop.43 LS (2019-2020)

⁸⁴⁹ vml., §3.

⁸⁵⁰ vml., §§12-25.

⁸⁵¹ vml., §§66-76.

⁸⁵² vml. §70.

⁸⁵³ see vml. §14 which incorporates §2.

the gákti and, as is further elaborated upon below, according to the Norwegian trademark protection structure this does not require registration.⁸⁵⁴ Thus, focus here is upon the provisions within varemerkeloven relating to the protection of unregistered trademarks.

Rights to an unregistered trademark under varemerkeloven are obtained by operation of the third paragraph of § 3 which reads in full:

Stiftelse av varemerkerett

Varemerkerett kan oppnås for hele riket ved registrering i varemerkeregistret etter bestemmelsene i kapittel 2.

Varemerkerett kan også oppnås for hele riket ved internasjonal registrering etter bestemmelsene i kapittel 10.

Varemerkerett oppnås uten registrering når merket er innarbeidet. Et varemerke anses innarbeidet når og så lenge det i omsetningskretsen her i riket for slike varer eller tjenester det gjelder, er godt kjent som noens særlige kjennetegn. Foreligger innarbeidelse bare i en del av riket, gjelder eneretten bare for dette området.⁸⁵⁵

The third paragraph of §3 thus articulates that trademark rights may be obtained through ‘innarbeidelse’ (‘establishment’). This section must be read in the context of the other sections within Chapter 1 that set out the basic requirements of all trademarks. Of critical relevance are the general provisions relating to the definition of a trademark, specifically, vml. §§ 1 and 2.

§1 Enerett til varemerke mv.

Enhver kan oppnå enerett til å bruke et varemerke som kjennetegn for varer eller tjenester i næringsvirksomhet etter bestemmelsene i denne loven (varemerkerett).

...

§ 2 Tegn som kan være varemerke

Et varemerke kan bestå av alle slags tegn som er egnet til å skille en virksomhets varer eller tjenester fra andres, for eksempel ord og

⁸⁵⁴ And, indeed, in the Author’s opinion, viewing trademark protection through the lens of unregistered trademarks provides a clearer view of the true nature and workings of trademarks.

⁸⁵⁵ vml. §3 (‘Founding of trademark right – Trademark rights can be obtained for the entire kingdom by registration in the trademark register in accordance with the provisions of Chapter 2. Trademarks may also be obtained for the entire kingdom by international registration in accordance with the provisions of Chapter 10. Trademark rights are obtained without registration when the mark is established. A trademark is considered established when and so long as in the trade area here in the Kingdom for such goods and services it applies, is well known as someone’s particular mark. If establishment exists only in a part of the Kingdom, the exclusive rights apply only to this area.’).

ordforbindelser, herunder salgord, navn, bokstaver, tall, figurer, avbildninger, farger og lyder, eller en vares form, utstyr eller emballasje.

Det kan ikke oppnås varemerkerett til tegn som utelukkende består av en form eller en annen egenskap som følger av varens art, er nødvendig for å oppnå et teknisk resultat eller tilfører varen en betydelig verdi.⁸⁵⁶

Reading these provisions in concert provides a clear view of the requirements for obtaining a valid unregistered trademark. They speak to the broad nature of the foundational definition of a trademark, focusing on the functional ability of the mark. There are no limitations to form, though non-exhaustive examples are provided, and no limitation to the ownership – ‘enhver kan oppnå’.⁸⁵⁷ However, it is necessary for all trademarks to be able to distinguish the goods and services of one from another.

When read together, it could be said that in order to have a valid and protectable unregistered (‘innarbeidet’) trademark according to the Norwegian trademark protection system, it is necessary that there: 1) be a mark 2) suitable of distinguishing between the goods or services of one ‘virksomhet’ from another 3) that it is well known as the trademark of a particular source 5) within the relevant public and 6) that it does not fall under any foundational limitation.⁸⁵⁸

Similar to what was articulated in regard to the tináa, the Tlingit, and Ninth Circuit law, it can hence be seen how the Norwegian trademark law essentially mirrors the

⁸⁵⁶ vml. §1 (‘Entitlement to trademark. Anyone may obtain the exclusive right to use a trademark as a distinguishing mark for goods or services in the trade area after the provisions of this law (trademark rights).

vml. §2 (‘Signs that may be trademarks. A trademark may consist of any kind of sign which is suitable to distinguish one undertaking’s goods and services from others, for example words and word combinations, including sales words, names, letters, numbers, figures and images, or the shape, equipment or packaging of a product. Trademark rights cannot be obtained for signs which consist exclusively of a shape that follows the nature of the goods, is necessary to achieve a technical result or adds substantial value to the product.’)

⁸⁵⁷ vml. §1

⁸⁵⁸ vml. §§ 1-11. All of the sections in chapter 1 of vml. are important to an entire understanding of the workings of trademark protection within Norway. However, many will not be dealt with as they are not concerned primarily with the foundational validity of mark, yet may be important in other contexts, such as §6 on trademark exhaustion, § 8 on loss of rights through passiveness, and §§ 7 and 9 on collision of marks and co-existence. Furthermore, § 10 on the misleading use of marks will not be examined as it is a negative protection available to all that have a legal interest and does not speak to trademark validity. However, the use of §10 may be a valuable route for the protection of indigenous intangible properties and merits further study.

conclusions that were explored and articulated in Part 4 with regard to the foundational elements, general principles and norms, and reimagined definition of trademark protection in this work.

6.3.4. The Gákti and protection of unregistered marks in Norway

6.3.4.1. A mark

The form that a mark may take under the Norwegian varemerkeloven is, much as was described in section 6.3.1 regarding the US law as well as outlined in section 4.5 on general principles of trademark law, almost entirely based upon a marks ability to function as a trademark. The preparatory works to the Norwegian varemerkeloven clarifies that '[b]estemmelsen slår fast at *ethvert tegn* som er egnet til å skille en virksomhets varer eller tjenester fra andres kan være varemerke, og regner opp en rekke eksempler ... Oppregningen er ikke uttømmende.'⁸⁵⁹ In the current varemerkeloven the scope of what could qualify as a mark has broadened even further from prior versions of the trademark law. Indeed, in the first Norwegian trademark law, the scope of protectable marks was severely limited. Section 1 of the 1884 act stated,

Enhver, som her i Riget driver fabrik eller haandværksomhed, jordbrug, bergværk, handel eller anden næring, kan, ved Siden af den ham tilkommende Ret til som varemærke at benytte sit navn eller firma eller navnet paa en ham tilhørende fast eiendom, ved registrering overensstemmede med denne lovs forskrifter erhverve eneret til at benytte særlige varemærker for i den almindelige Omsætning at adskille sine varer fra andres. Denne ret skal omfatte alle slags af varer, naar den ikke ved registreringen er bleven indskrænket til viste vareslags.⁸⁶⁰

The progression of amendments and new trademark laws from the first Norwegian trademark act, and its restrictive application and understanding of trademarks, follows the general statutory expansion and return to pre-statutory protections that had been seen in other jurisdictions trademark regimes, as outlined in section 3.3 above. Indeed, substantive changes aligning the registered marks under this system more with the

⁸⁵⁹ Ot.prp.nr. 98 (2008-2009), section 14.1.1, pg 41. (emphasis added) ('The provision affirms that any sign that is suitable to distinguish an enterprise's goods or services from others can be a trademark and summarizes a number of examples...the listing is not exhaustive.').

⁸⁶⁰ Lov av 31 mai 1884 nr 16 om beskyttelse for varemærker

functional core principles of trademark protections are even seen in the most recent amendments.⁸⁶¹

The varemerkeloven of 1961, which was repealed and replaced by the current law, required that a mark be capable of graphical representation as a core attribute in §2 which applied to unregistered and registered trademarks. In the 2010 varemerkeloven this graphical representation requirement was removed as a core element of a protectable mark (§2), yet was retained as a requirement of registration in §14. In the most recent amendments to the 2010 law, the graphical representation requirement, where it remained for registration, was even further loosened so as now to only require representation in some form that is capable of reproduction on the register.⁸⁶²

Although this specific analysis is inapplicable to the treatment of unregistered marks in Norway, it is instructive of the evolution of the statutory system and evidences that it has followed the general progression that we have seen previously. Even where registered marks are concerned, restrictions as to form of a mark have substantially been abandoned in favour of focus on the function that a mark may fulfill.

The form of a mark, as far as protection of unregistered trademarks is concerned, is for the most part irrelevant – it is the ability to function properly as a trademark that is paramount.⁸⁶³ Given the broad function based conception of a mark within the Norwegian unregistered trademark protection framework, there is little question that clothing may be capable of protection, if it meets the other requirements for protectability, and as such the *Sámi gákti* could qualify as to form. It must also be considered that evaluating the *gákti* for protection and protectable elements may look past the it as a monolithic form if necessary. As was seen in section 4.5 above, protection may also be found in distinct and separate elements within a larger product

⁸⁶¹ Lov av 12 juni 2020 nr 67 om endringer i varemerkeloven og tolloven mv. (gjennomføring av nytt varemerkedirektiv mv.) LOV-2020-6-12-67

⁸⁶² vml §14, 'Et varemerke som skal registreres, må bestå av et tegn som kan beskyttes etter §2, og som kan gjengis i varemerkeregisteret på en slik måte at myndighetene og allmennheten klart og tydelig kan avgjøre gjenstanden for den beskyttelse merkehaveren gis.'

⁸⁶³ See *Kjennetegnsrett* (n 411) pg 19-20.

context. Thus, if overall form of the gákti were seen as a hurdle, though it is not considering the focus on function within the Norwegian trademark structures, separate and distinct elements of the garment may nonetheless be marks themselves.⁸⁶⁴

There is a line of reasoning within the protection of overall forms of garments which would assert that protection is more suitable through the Norwegian foretaksnavnloven ('business name law').⁸⁶⁵ Foretaksnavnloven provides the framework in Norway for the registration and protection of business names, as well as what are termed 'andre forretningskjennetegn' ('other business characteristics').⁸⁶⁶ While it is true that a manner of protection may be found in foretaksnavnloven, there is no restriction within varemerkeloven which would prevent marks of overall forms from finding protection within the trademark framework.⁸⁶⁷ Thus, under the Norwegian protection framework for unregistered marks there is no reason why the gákti would not be a form that could function as a trademark and find protection, as such.

6.3.4.2. *Suitable of distinguishing*

Any mark under the Norwegian regime must be 'egnet til å skille'⁸⁶⁸ ('suitable of distinguishing') the goods of one 'virksomhet' from another's.⁸⁶⁹ The preparatory works to the Norwegian varemerkeloven has elaborated that this requirement incorporates a necessity for a mark to have a measure of distinctiveness.⁸⁷⁰ Thus according to the preparatory works, if a mark lacks distinctiveness, whether inherent or acquired, that mark is not suitable to distinguish - 'egnet til å skille'.⁸⁷¹

⁸⁶⁴ TOSLO-2013-86552; LB-2014-95107.

⁸⁶⁵ Ot.prp.nr.98 (2008-2009), section 14.1.1, pg 40.

⁸⁶⁶ Lov av 21 Juni 1985 nr. 79 om enerett til foretaksnavn og andre forretningskjennetegn mv. (foretaksnavneloven).

⁸⁶⁷ Evaluation of the protections provided under foretaksnavnloven are outside the scope of this work.

⁸⁶⁸ vml §2

⁸⁶⁹ vml §1

⁸⁷⁰ Ot.prp.nr 98 (2008-2009) section 14.1.1, pg 41 – 'Etter bestemmelsen her [§2] stilles et abstrakt krav om særpreg'. ('According to the provision here [§2] there is an abstract need for distinctiveness.')

⁸⁷¹ Ot.prp.nr. 98 (2008-2009) section 2.1, pg 7 – 'Det grunnleggende vilkåret for enerett er at varemerket må ha særpreg (distinktivitet) som kjennetegn for de varer eller tjenester det gjelder.' ('The foundational condition for exclusive rights are that a trademark must have a distinctive character as a distinguishing mark for the goods or services to which it applies.')

Varemerkeloven section 14, on registration, is more explicit in its requirement for distinctiveness in marks – ‘Det må ha særpreg som kjennetegn for slike varer eller tjenester som det gjelder.’⁸⁷² Because of the explicit use of the term ‘særpreg’ (‘distinctiveness’) in § 14, some commentators have drawn a connection between the concepts in §§2 and 14.⁸⁷³ While in practice they are similar, and connected to an extent, the requirement for særpreg found in § 14 is distinct from the functional requirement ‘egnet til å skille’ in §2.⁸⁷⁴

This difference in distinctiveness was highlighted by Varemerkeutredningen II when discussing the Swedish draft legislation of the time –

Varemerkeutredningen II er kommet til at det kan være misvisende å bruke formuleringer som på denne måten synes å gi distinktivitets-eller særpregskravet i § 13 [enacted as vml. §14] full parallellitet med kravet om atskillende evne i varemerkedefinisjonene i § 2.⁸⁷⁵

Following this observation, Varemerkeutredningen II concluded that ‘...den formulering Varemerkeutredningen II foreslår antas å gjøre loven lettere å forstå, ved at det markers at distinktivitetskravet i §13 [now §14 of vml.] kaller på en annerledes vurdering enn kravet om atskillende evne i definisjon i § 2.’⁸⁷⁶ As mentioned above, this formulation of the two provisions were eventually included in the Act, which must then presumably be understood in a manner which Varemerkeutredningen II concluded.

⁸⁷² vml. §14 (‘it must have distinctiveness as a distinguishing mark for such goods or services to which it applies.’).

⁸⁷³ *Kjennetegnsrett* (n 411) – ‘Et varemerke er *særpreget* dersom det er <<egnet til å skille en virksomhets varer eller tjenester fra andres>>, står det i definisjonen av varemerke i vml. § 2 første led. Det er det same vilkåret som gjentas når det i § 14 første led kreves at varemerker må ha <<særpreg>> for å kunne registreres.’ (‘A trademark is distinctive if it is <<able to distinguish an entity’s goods or services from others>> it stems from the definition of trademark in vml. §2 first paragraph. It is the same condition that is repeated when it is required in section 14 first paragraph that trademarks must have <<distinguishing character>> in order to be registered.’). at pg 54.

⁸⁷⁴ Ot-prp.nr. 98 (2008-2009), highlighting the two distinct grounds of distinctiveness for innarbeidede marks and registered marks - ‘Etter bestemmelsen her stilles et abstract krav om særpreg. Spørsmål om særpreg i forhold til konkrete varer eller tjenester må vurderes etter lovforslaget § 3 tredje led for innarbeidede varemerker, og etter § 14 for varemerker som søkes registrert.’ at page 41.

⁸⁷⁵ NOU 2001:8, pg 59. (‘Varemerkeutredningen II has come to the point that it may be misleading to use formulation that in this way seem to give the distinctiveness or distinguishing requirements in §13 full parallelism with the requirements of distinctive ability in the trademark definitions in §2.’).

⁸⁷⁶ NOU 2001:8, pg 60 (‘the wording of Varemerkeutredningen II proposal is believe to make the law easier to understand by marking that the distinctiveness requirements in §13 calls for a different assessment than the requirements for differentiation ability as defined in § 2.’).

With regard to the interpretations of §§2 and 14 respectively, Lassen / Stenvik further concur that

[s]ærpregskravet i vml. § 2 første led gjelder – i motsetning til bestemmelsen i § 14 – også for innarbeidede varemerker. Noen reell betydning har det imidlertid neppe at loven stiller krav om særpreg også for de varemerker som skal få vern i kraft av innarbeidelse. Et innarbeidet varemerke må nemlig nødvendigvis være egnet til å skille en virksomhets varer eller tjenester fra andres, ellers kan det ikke være innarbeidet som særlig kjennetegn for noen.⁸⁷⁷

Though highlighting the separate concepts between §2 and §14 distinctiveness may be bordering on the strictly academic and not of great practical importance, as illustrated by Lassen / Stenvik's view, it is important to keep these concepts as distinct to ensure that requirements specific to the registration of marks do not get confused with those general requirements for the protection of distinguishing marks. It is also an important distinction because the formulation as relating to unregistered marks (§2, 3) is abstract as connected to distinctive elements. Whereas under §14 relating to registered marks the distinctive elements requirement is concrete.

It is exceedingly difficult to make a full accounting of to what extent the Sámi gákti fulfills the distinctiveness criterion for trademark purposes in Norway. That is primarily so because the gákti, as a mark, is a form of products. At least, that was the case originally. However, as previously mentioned, the gákti has more recently been used in many different ways other than as clothing, much like the Tlingit tináa. This section will concentrate on the gákti as a product within itself. When it comes to the gákti as a product, or rather the form of a product embodying a trademark, 'kommer distinktivetsspørsmålene i et spesielt lys.'⁸⁷⁸ This complication of the distinctiveness

⁸⁷⁷ *Kjennetegnsrett* (n 411) 'The distinctiveness requirement in *varemerkeloven* § 2 first paragraph is applicable – contrary to the provision in section 14— also for established trademarks. The real meaning however does not necessarily mean that the law imposes a distinctive character on those trademarks that will receive protection through establishment. An established trademark must necessarily be suitable to distinguish an undertaking's goods and services from others, otherwise it may not be established as someone's particular distinguishing mark.' - pg 54.

⁸⁷⁸ *Kjennetegnsrett* (n 411) pg 107. ('the distinctiveness question comes into a special light.')

examination of product form arises from a product form's many aspects, uses, functions, and perceptions. Many product forms are composed of a collection of elements that may or may not be protectable either on their own, or within the combination.

One manner to come to terms with product form distinctiveness is to view the form through the statutory limitations to protection, instead of attempting a positive assessment of the relative distinctiveness. Section 2 of varemekeloven states that – 'Det kan ikke oppnås varemerkerett til tegn som utelukkende består av en form som følger av varens art, er nødvendig for å oppnå et teknisk resultat eller tilfører varen en betydelig verdi.'⁸⁷⁹ In the context of an application for registration of a mark, these conditions are absolute grounds for refusal of the application. However, they are also conditions that go to the core of a functioning trademark as well – they essentially prohibit trademark rights from vesting in functional elements.

The rationale for these prohibitions not only comes from functionality having an inherent lack of distinctiveness,⁸⁸⁰ but also from the concept of '*friholdelsesbehovet*', or free competition.⁸⁸¹ When ruling in *Koninklijke Philips Electronics v Remington Consumer Products*,⁸⁸² the European Court of Justice interpreted the corresponding provision in the EU Trademark Directive as providing that

The rationale of the grounds for refusal of registration laid down in Article 3(1)(e) of the Directive is to prevent trade mark protection from granting its proprietor a monopoly on technical solutions or functional characteristics of a product which a user is likely to seek in the products of competitors.'⁸⁸³

⁸⁷⁹ vml. §2. ('Trademark rights cannot be obtained for signs which consist exclusively of a shape which follows the nature of the goods, is necessary to obtain a technical result, or gives the goods a substantial value.')

⁸⁸⁰ As well as being protected through other forms of IP protection such as patents and industrial design protections.

⁸⁸¹ See section 4.4 above.

⁸⁸² *Koninklijke Philips Electronics v Remington Consumer Products*, Judgment of the Court, 18 June 2002, Case C-299/99, ECLI:EU:C:2002:377

⁸⁸³ *Koninklijke Philips Electronics v Remington Consumer Products*, Judgment of the Court, 18 June 2002, Case C-299/99, ECLI:EU:C:2002:377, *Philips Case*, Para 78; Article 3(1)(e) is the corresponding article of the EU Trademark Directive regarding these bars to registration.

With regard to the gákti as an article of clothing, it would be difficult to say that it would fall under the prohibition against marks that exclusively consist of a form that comes from the its class of goods, or that its form is one that is necessary to achieve a technical result. However, to some there may be an argument that the mark gives substantial value to the goods upon which it is used.

This section of varemerkeloven relates directly to article 3 of the EU trademark directive,⁸⁸⁴ and therefore we can take guidance from the court practice in the EU on this issue. However, it must be remembered that Art 3 of the directive applies only as a bar to registration, it does not limit the substantive rights of a trademark holder, nor the validity of a trademark itself. Therefore the value of the EU practice as it relates specifically to varemerkeloven §2's distinctiveness requirement may be merely persuasive (perhaps highly persuasive), but not controlling.

The bar against registration, according to the EU Trademark Directive, or establishment, according to varemerkeloven, of a trademark because the shape mark adds significant value arises essentially from the protection of fair competition. It is an attempt to keep shapes that are necessary to be competitive in a certain market free for all to use.⁸⁸⁵

In the context of the gákti, though, it is necessary to look at the limitations of this provision. Specifically, it bars marks 'which consist exclusively of the shape',⁸⁸⁶

⁸⁸⁴ NOU 2001:8 – 'I utkastets §3 fjerde ledd foreslås en bestemmelse om at det ikke kan oppnås enerett til tegn som bare består av en form som følger av varens egen art, er nødvendig for å oppnå et teknisk resultat, eller tilfører varen en betydelig verdi. En tilsvarende bestemmelse står i dag i den gjeldende lovs § 13 annet ledd, som sier at slike merker *ikke kan registreres*. Bestemmelsen der er gitt for å tilfredsstille Varemerkedirektivets art 3, 1, e.' at page 62; Ot.prp.nr 98 – '*Annet ledd* (of §2) erstatter den gjeldende varemerkeloven §13 annet ledd, og svarer til § 3 fjerde ledd i Varemerkeutredningen II. Bestemmelsen gjennomfører varemerkedirektivet artikkel 3 nr. 1 bokstav e. Departementet har flyttet bestemmelsen til § 2 annet ledd fordi den gir en negativ avgrensning av hvilke tegn som kan beskyttes som varemerker, som hensiktsmessig kan plasseres sammen med den positive angivelsen av hvilke tegn som kan være varemerker i første ledd.' At page 41 (In the author's opinion this change by the department does not take into account the fact that the provision within the EU Trademark Directive to which they refer was only applicable to applications – it was a bar to registration not substantive trademark rights.)

⁸⁸⁵ Bang & Olufsen v OHIM, Case T-508/08, Judgment of the General Court 6 October 2011, ECLI:EU:T:2011:575; Hauck v Stokke, Case C-205/13, Opinion of Advocate General Szpunar, 14 May 2014, ECLI:EU:C:2014:322, para 79; Christian Louboutin v Van Haren Schoenen, Case C-163/16, Opinion of Advocate General Szpunar, 22 June 2017, ECLI:EU:C:2017:495.

⁸⁸⁶ 2008/95 Art3(1)(e).

‘utelukkende består av en form’.⁸⁸⁷ This threshold requires not only that the mark be a ‘shape’, but also that the mark exclusively be that shape and in turn entirely add the substantial value.

The gákti in shape is little more than a tunic style garment. In determining the ‘mark’ for which protection is sought, it would be difficult to argue that the ‘mark’ consisted exclusively of that shape.⁸⁸⁸ Furthermore, it would similarly be difficult to successfully argue that the tunic shape of the gákti adds value substantial enough that it is an unfair advantage relative to other items of clothing.

The gákti is more than just the shape of the garment and the value that is added to the product (in this case the gákti itself) is manifestly more than the value given it by its shape. Indeed, as was outlined in section 6.2.3.1, there is value in the meaning, the patterns, the cultural and social aspects – but in a trademark context, or rather where one would assume it would be used in a trademark manner, the value comes from the connection to the Sámi people and it is the consistent patterns, colours, forms, and constructions that indicate that connection. The value is not as a result of the garment shape.⁸⁸⁹

It must also be noted, as stated above, that the varemerkeloven §2’s distinctiveness requirement demands only that the mark be ‘egen til å skille’, ‘suitable of distinguishing’. Thus a distinctiveness evaluation under § 2 must concern itself with the threshold of suitability, not the relative strength of that suitability as gauged through distinctiveness analyses. As the gákti would not fall under any of the foundational bars to protection, it would at a minimum pass the threshold of being suitable of distinguishing. However, it must also be remembered that distinctiveness, in the Norwegian system, may also be

⁸⁸⁷ vml. §2.

⁸⁸⁸ See, *Christian Louboutin v Van Haren Schoenen*, Case C-163/16, Opinion of Advocate General Szpunar, 22 June 2017, ECLI:EU:C:2017:495.

⁸⁸⁹ Furthermore the validity of a clothing trademark has been established in Norway previously, see NOR1213527.

established through the use of a mark – similar to acquired distinctiveness or secondary meaning discussed in section 5.2.2.⁸⁹⁰

Considering the discussion that has taken place up to this point, it should come as little surprise that the Norwegian trademark protection system evaluation begins with a determination of the functional ability, specifically through distinctiveness or rather for the purposes of vml. §2 suitability to distinguish. This clearly shows underpinnings of the Norwegian trademark regime in the general principles of trademark protection as outlined in Part 4 and similarly exhibited in the US trademark protection system. Ultimately, it would appear that the gákti would meet the requirement within the Norwegian regime that it be suitable to distinguish. Furthermore, though unnecessary for the purposes of this examination, the gákti may also exhibit the necessary distinctiveness under vml. §14 as well.

6.3.4.3. A note on virksomhet

Within the confines of §2, a trademark is that which has the ability to distinguish, as was explored above, the goods and services of one ‘virksomhet’ from those of another. The use of the word ‘virksomhet’ here conforms with the nature of other provisions in chapter one of the varemerkeloven as being drafted with wide application and foundational aspects, because ‘virksomhet’ is not limited to entities of a commercial nature, nor even legal structure. Though the preparatory works provide little guidance on the meaning and context of the use of the word virksomhet in §2, yet it is possible to understand the broad nature of its operation by reference to its ordinary meaning, as well as the use of other words within varemerkeloven.

Virksomhet can be translated into English as – activity, business, work, and operation.⁸⁹¹ However, more telling are the synonyms listed for the word ‘virksomhet’ in Norwegian – aksjon, aktivitet, drift, funksjon, *kraft*, *operasjon*, *produksjon*, travelhet; arbeid, bane, bestilling, bransje, flid, geskjeft, gjerning, gjøremål, hjul (sette hjulene i gang), praksis,

⁸⁹⁰ *Kjennetegnrett* (n 411) pg 60.

⁸⁹¹ Norsk-englesk blå ordbok, (kunnskapsforlaget, 2012), pg 947.

syssel, tiltak, trade, virke, yrke.⁸⁹² Though the English translation does include the word ‘business’ which may connote a commercial nature, the overall collection of synonyms and translations gives the understanding that the term is much broader than one of a commercial nature, or strictly defined and structured entity.

This broad interpretation is also supported by §1 of varemerkeloven and the terms used in the EU Trademark Directive. Vml. § 1 uses similarly broad terms when it articulates that ‘[e]nhver kan oppnå enerett’,⁸⁹³ whereas Article 2 of the EU Trademark Directive 2008/95, and Article 3 of the EU Trademark Directive 2015/2436 both make use of the English term ‘undertaking’ in this same context.⁸⁹⁴ Suffice it to say that the entities which a mark is suitable of distinguishing between is considerably broader than those of a commercial or even strictly defined nature.⁸⁹⁵

6.3.4.4. *Well known as the mark of a particular source*

6.3.4.4.1. The law

According to §3 of varemerkeloven, for a trademark to be established, and protected as an unregistered mark, it must be ‘well known’ within the relevant public. Specifically, the term used in §3 is ‘godt kjent’.⁸⁹⁶ This may cause some confusion in translation as ‘godt kjent’ is commonly translated into English as ‘well-known’. However, when speaking of ‘godt kjent’ or ‘well-known’ marks in vml. §3 it must be noted that this is not the same concept as ‘famous marks’ as seen in the United States, or the ‘velkjent’ mark as seen in §4 second paragraph⁸⁹⁷ of varemerkeloven.

⁸⁹² Norske synonymer blå ordbok, page 354, in Fremmedord og synonymer blå ordbok (kunnskapsforlaget, 2012). (aksjon – ‘action, campaign’; aktivitet – ‘activity’; drift – ‘operation, running’; funksjon – ‘function’; kraft – ‘strength’, ‘power’, ‘force’; operasjon – ‘operation’; produksjon – ‘production’; gjerning – ‘work’, ‘deed’, ‘action’; gjøremål – ‘task’; praksis – ‘practice’; syssel – ‘govern’; amongst others).

⁸⁹³ Though later limited by the language ‘til å bruke et varemerke som kjennetegn for varer eller tjenester i næringsvirksomhet...’.

⁸⁹⁴ Directive 2008/95/EC of the European Parliament and of the Council of 22 October 2008 to approximate the laws of the Member States relating to trade marks, Article 2; Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trade marks, Article 3.

⁸⁹⁵ It should also be noted that even if a commercial nature is assumed or read into the requirements, it should be done with the understanding of commerce as outlined in section 4.2.1.

⁸⁹⁶ vml. §3 – ‘Et varemerke anses innarbeidet når og så lenge det i omsetningskretsen her i riket for slike varer eller tjenester det gjelder, er *godt kjent* some *noens særlige kjennetegn.*’ (emphasis added)

⁸⁹⁷ vml. §4 second paragraph – ‘For et varemerke som er *velkjent* her i riket, innebærer varemerkeretten at ingen uten samtykke fra merkehaveren kan bruke et tegn som er identisk med eller ligner

Section 4 of varemerkeloven is primarily the codification of what is known as the *Kodakregelen*⁸⁹⁸ which allows protection of marks outside of the goods or services area in which they are registered or established. In order to benefit from the *Kodak* protections enshrined in vml. §4 it is necessary that the mark be ‘velkjent’ which can also translate into English as ‘well known’, though it is properly translated as ‘famous’. However, when viewing these words – ‘godt kjent’ and ‘velkjent’, not only in the context of the Norwegian language but also in the context of this legislation, it is clear that they are not equal nor are both equivalent to ‘well known’.

Synonyms for ‘velkjent’ in Norwegian include ‘berømt’, ‘kjent’, and ‘notorisk’⁸⁹⁹ (‘famous’,⁹⁰⁰ ‘well-known’,⁹⁰¹ and ‘notorious’⁹⁰²) indicating a significantly higher threshold compared with ‘godt kjent’ (renown). Other provisions within varemerkeloven, as well as the Act’s history, confirm this higher threshold of fame relating to ‘velkjent’. In the prior varemerkeloven, qualification for §4 protection (then §6) required that the mark be ‘særlige sterkt innarbeidet’.⁹⁰³ It is also well articulated by Lassen/Stenvik that the term ‘velkjent’ as used in vml. §4 is a higher threshold than

varemerket for varer eller tjenester av samme eller annet slag, hvis bruken ville medføre en urimelig utnyttelse av eller skade på det *velkjente* varemerkes særpreg eller anseelse (goodwill).’ (emphasis added)

⁸⁹⁸ The Kodakregelen is integrated into vml. §4 second paragraph, and arises from the English case of *The Eastman Photographic Materials Company Ltd., and Another v. The John Griffiths Cycle Corporation, Ltd., and The Kodak Cycle Company, Ltd., and In the Matter of The Trade Mark No. 207,006 (Kodak)*. 15(5) Reports of Patent, Design, and Trade Mark Cases 105 (March 23, 1898) which concerned the John Griffiths Company establishing a company under the Kodak name and selling bicycles under the Kodak mark. An injunction was issued to restrain such use and cancel John Griffith Company’s trademark registration based, essentially, on the renown of the Kodak mark and its connection with the bicycle market even though Kodak had never entered or competed in that market.

⁸⁹⁹ Norske synonymer blå ordbok, page 348, in Fremmedord og synonymer blå ordbok (kunnskapsforlaget, 2012).

⁹⁰⁰ Norsk-englesk blå ordbok, (kunnskapsforlaget, 2012), pg 61.

⁹⁰¹ Norsk-englesk blå ordbok, (kunnskapsforlaget, 2012), pg 419; also ‘(som mange kjenner) well-known, famous, notorious’.

⁹⁰² Norsk-englesk blå ordbok, (kunnskapsforlaget, 2012), pg 566.

⁹⁰³ (‘especially strongly established’); see Instilling til lov om varemerker (Bergen 1958) pg 332-33; Innst. O. VIII (1960-61) - ‘kjennetegn som er særlig sterkt innarbeidet, når det er kjent i vide kretser her i riket, og det ville bety en utilbørlig utnyttning eller forringing av den anseelse (<<goodwill>>) kjennetegnet hadde oppnådd, om lignende kjennetegn i det foreliggende tilfelle ble brukt av en annen.’ (‘Distinguishing marks that are especially strongly established, when known in the circles here in the Kingdom, and that would mean and improper exploitation or impairment of the reputation <<goodwill>> that the distinguishing mark had obtained, if similar marks in the present case are used by another.’) at pg 4.

‘godt kjent’ for establishing rights to an unregistered mark.⁹⁰⁴ ‘For at et merke skal anses velkjent, må det være kjent av en betydelig del av den relevante omsetningskretsen.’⁹⁰⁵ For the purposes of the protection of an unregistered trademark the qualifying term is the vml. §3 lower threshold of ‘godt kjent’ within the relevant public and it is important that these two concepts are not confused or conflated.

Establishing that an unregistered mark is well known, in the vml. §3 sense, as the mark of a particular source within the relevant public is a complex and highly fact dependent endeavour. The determination of whether a mark is well-known is connected directly to the identification of the relevant public within which the mark’s esteem is tested. But, it is also relative to many factors regarding the mark itself and the use of that mark. A mark that exhibits a high degree of distinctiveness may require less effort for reaching the threshold of well-known. A mark which, on the other hand, is highly descriptive may require extensive efforts. The ultimate goal, and indeed question, is whether the use of the mark has been in such a manner that it has created the association in the minds of the relevant public with a specific source.⁹⁰⁶ Furthermore, there is no concrete answer on what proportion or amount of that relevant public must have that association of the mark with source.⁹⁰⁷

As indicated, the question of being well known thus essentially becomes one of evidence and facts. ‘Den holder ikke ut fra hverandre spørsmålet om *hva som kreves* og spørsmålet om *hva som må til for å bevise at kravene er oppfylt*.’⁹⁰⁸ Evidence that can be offered to support a finding of well known status include market research, amount of sales, expenditure on advertising, nature of the mark, examples of use, intensity of use and advertising, and duration of use; all of which are set within the backdrop of the relevant public.

⁹⁰⁴ *Kjennetegnsrett* (n 411) pgs 364-371.

⁹⁰⁵ Ot.prp.nr. 98 (2008-2009), pg 43. (‘for a mark to be considered well known [velkjent], it must be known by a significant part of the relevant sales circles.’).

⁹⁰⁶ *Kjennetegnsrett* (n16) pg 250-252; Chevy case C-375/95.

⁹⁰⁷ Chevy case, C-375/95.

⁹⁰⁸ *Kjennetegnsrett* (n 411) pg 249. (‘The question what is required and the question what it takes to prove that the requirements are met are not separate.’)

Lassen/Stenvik state that

Beviset for at et varemerke er blitt godt kjent som særlig kjennetegn føres best gjennom dokumentasjon av <<harde fakta>>. Hvor mange enheter er blitt solgt over hvor lang tid, har de alle vært solgt med varemerket på fremtredende plass, og hvor stor markedsandel har varene hatt? Hvor stort har merkebrukerens reklamebudsjett vært, hvordan har annonsene sett ut – i hvilken grad har de fokusert selve varemerket, i den utforming som hevdes å være innarbeidet—og hvor ofte har de stått i hvilke publikasjoner som har hvor store opplag og hvilken spredning til hvilke lesergrupper? Hvilke messer o.l. har varen med varemerket vært presentert på og hvordan har den vært presentert der? Hvilke brosjyrer mv. har vært fremstilt, hvordan har de fremhevet varemerket, og hvordan er de blitt spredd, til hvem i hvor store opplag? Alt dette vil normalt være fakta som *kan* dokumenteres, og det vil gjerne være fakta som når de summers opp kan gi et godt grunnlag for å vurdere sannsynligheten for at varemerket er blitt <<godt kjent>> i omsetningskretsen her i riket som <<særlig kjennetegn for noens varer>>.⁹⁰⁹

While it is true that hard facts provide some of the best means for establishing that a mark is well known within a relevant public, it must be highlighted that they are merely evidence of actions taken to convince the public of an association. It is for the court to determine whether those actions had the effect that the mark user sought, which was ultimately creating an association in the mind of the relevant public. The critical question remains whether the public associates the trademark with a specific source. Importantly, the relevant public need not be entirely familiar with or even able to identify that source - it remains a source for trademark purposes all the same. This feature of Norwegian law is well illustrated by the Biltilsynet case.

⁹⁰⁹ *Kjennetegnsrett* (n 411) pg 254. ('The proof that a trademark has become well known as a distinctive distinguishing mark is best conducted through documentation of <<hard facts>>. How many units have been sold, over how long, have they all be sold with the brand in the prominent place, and how much market share did the goods have? How big has the brand's advertising budget been, how have the ads looks – to what extent have they focused upon the trademark itself, in the form that is claimed to be established – and how often have they been in which publications that have how big a publication and what size of a readership? Which fairs and the like has the trademark been presented and how has it been presented? Which brochures et cetera have been produced, how have they highlighted the trademark and how have they been distributed to who and in what size? All of this will normally be facts that can be documented and it would be a matter of fact that when they sum up can provide a good basis for assessing the likelihood that the brand has become well known in the sales circles here in the Kingdom as a particular distinguishing mark for someone's goods.')

The facts of the Biltilsynet were set out in section 5.3.1 previously.⁹¹⁰ However, by way or reminder, in this case a number of years after Statens Vegvesen had ceased the use of the term 'Biltilsynet' for various motor vehicle services, A Kalveland established a business and registered a domain name of that term. He carried on business for a number of years and throughout this time complaints were registered regarding Kalveland's use of the term. The Court of Appeals determined that there was still an association in the mind of the public between the term 'Biltilsynet' and Statens Vegvesen. The Court of Appeal restrained Kalveland's use primarily on this basis.⁹¹¹ Of interest for the purposes of this section, however, are the facts that Statens Vegvesen had done no advertising, nor spent any money on attempting to ingrain the mark in the minds of the public for over ten years by the time the case had come to court. In fact, during that time Kalveland was actively promoting and advertising his business under the term Biltilsynet. Yet, at court it was decided, and rightly so, that the association in the mind of the relevant public still remained with Statens Vegvesen.

Thus, hard evidence, though helpful and persuasive, must be seen in the context of the public's perception, as it is that perception that ultimately determines whether a mark has become well known. No amount of hard evidence, including the extent of advertising, or money spent in promoting, would have assisted Kalveland in overcoming the overwhelming association that the public had between the term 'biltilsynet' and the government authority.

6.3.4.4.2. Particular application to the Sámi gákti

In turning specifically to the Sámi gákti there is presumably a lack of evidence regarding many of the hard facts that are normally looked at in order to support a finding of well known status within a relevant market. For example, market research, sales figures, expenditure on advertising, nature of the mark, examples of use, intensity of use, and duration of use. This is unsurprising given that the protection of unregistered trademarks is proven during disputes – at which time evidence would arise.

⁹¹⁰ THAUG-2010-68241 (Biltilsynet-dommen), pg 3-4.

⁹¹¹ For a more thorough explanation see section 5.3.1.

Additionally, the various issues regarding collecting hard facts when it comes to the use of indigenous intangible properties that were outlined in the US Government Accountability Office report – Indian Arts and Crafts: Size of market and extent of misrepresentation are unknown⁹¹²- are equally applicable to the Sámi people (and communities) and the market for Sámi products as they are for the Native Americans in the United States. While facts with regard to the nature of the mark, as well as with regard to examples, intensity, and duration of use can be gathered to a not insignificant degree, the other elements most commonly present in trademark cases through ‘hard facts’ may prove more problematic. This, however, is not a problem unique to the Sámi and a similar discussion was undertaken relating to tináa.

Ultimately, a measure of uncertainty lingers as to whether evidence of hard facts can prove that the gákti is well known in the relevant public, although it can be far from ruled out given the strength of use, duration of use by the Sámi people, and not least by the extremely high level of distinctiveness.

If questions remain with regard to hard facts, the same is surely not true with the perception of the public. The gákti is indicative of the Sámi people. It has been documented that the Sámi people have consistently used the gákti for hundreds of years and in all likelihood far longer, has an unbroken chain of use in Norway, and a lively industry of production.⁹¹³ It has also had constant exposure in the relevant medias of the day in connection with the Sámi people, as well as in commercial brochures for instance in the Norwegian tourist industry. The gákti is also the standard dress of the Sámi for official meetings (including international inter-governmental and national governmental functions), and celebrations including high-visibility Norwegian celebrations such as that of the Norwegian National Day (17 May). Some, if not many, Sámi also make use of the gákti as everyday dress, including all that such daily life involves – business meetings, shopping, meals, family outings, et cetera. In short, within the border of Norway it is doubtful that the gákti is not well known as a symbol of the

⁹¹² GAO Report (n 199); see also section 2.6-8.

⁹¹³ See section 6.2.3.1.

Sámi and the association in the minds of the public in general between the gákti and the Sámi would be strong.

In conclusion, given the status of the Sámi people in Norway, the connection of the gákti with the Sámi, the exposure that the gákti has had throughout the Kingdom, and not least the long and continuous use of the gákti by the Sámi for hundreds of years as an identifying and communication signal,⁹¹⁴ it would be difficult to imagine that the gákti is not well known in Norway as associated with the Sámi people.

It must also be remembered that the concept of source in the protection of unregistered trademark in Norway hearkens back to the anonymous source as seen in the US trademark practice. ‘Det kreves ikke at det er kjent i omsetningskretsen *hvem* som har varemerket, jfr. Lovens uttrykk <<*noens...kjennetegns*>>. Men merket må være godt kjent *som kjennetegn* for varer eller tjenester.’⁹¹⁵ Thus, it is not critical that the relevant public be able to specifically identify the source with which they associate the trademark, only that they associate it with a source even if that source is un- or even vaguely known.⁹¹⁶ It can be safely assumed that the majority of the public in Norway are not only aware of the gákti, can identify it, and associate it with the Sámi people even if the understanding of who exactly the Sámi are is not a perfect knowledge. This reasoning similarly applies to the specific variations of the gákti and their associations with internal divisions within the Sámi people. It is not necessary, for the purposes of unregistered trademark protection in Norway, that the relevant public be educated on all of gákti variations nor the internal ownerships within the Sámi people. The threshold requisite is that the relevant public can identify their conception of a ‘gákti’ and associate it with their conception of the Sámi as a source.

This necessarily, also, means that it is not necessary that relevant public know the exact or specific membership of the Sámi people. The internal norms, regulations, and

⁹¹⁴ Id.

⁹¹⁵ *Kjennetegnsrett* (n 411) pg 244; also pg 40 – ‘Det kreves ikke at de som kjenner market også skal ha forestillinger om hvem merkehaveren er.’ (‘It is not required that those who know the mark should also have ideas about who the mark owner is.’).

⁹¹⁶ See sections 4.2 and 5.3.

standards regarding membership of an indigenous group are a complex concept, and will not be fully addressed in this work. However, it is also, for the most part, an irrelevant query here. The primary and controlling factor is whether an association has been created in the mind of the relevant public with a source, not whether the relevant public is familiar with the internal composition of that source.⁹¹⁷

6.3.4.5. *Within the relevant public*

The question of the relevant public, much like the other elements of this enquiry, is somewhat ethereal without a specific dispute from which to draw the relevant facts. Like all situations where the rights arise from use, the exact contours and boundaries of the trademark rights are not tested until a dispute arises, which leads to rather circular attempt at articulating the various aspects of unregistered trademark protection. This is no different for the relevant public. As mentioned above

omsetningskretsen er helt enkelt den krets slike varer eller tjenester som det gjelder falbys til eller avtas av – de forbrukere, brukere eller mellomhandlere som er (aktuelle eller potensielle) avtagere eller formidlere av slike varer eller tjenester. For vise dyre spesialvarer – eller for svært spesielle varer i det hele – kan det være en ganske liten gruppe, for margarin og tannpasta kan det være hele eller iallfall en stor del av landets befolkning.⁹¹⁸

For the present purposes, however, although the contours of the relevant public will change significantly with each dispute, there are general attributes of the relevant public that must be kept in mind. The relevant public is not limited to end users, but can also include the retailers and other manufacturers.⁹¹⁹ Further the relevant public not only includes the customers at any given moment in time, but also potential customers.

⁹¹⁷ Issues relating to the internal composition of an indigenous group with regard to source and trademark ownership are returned to in Part 7.

⁹¹⁸ *Kjennetegnsrett* (n 411) pg 244 ('The trade area is simply the circles in which such goods or services are offered for sale to or taken up by consumers, users, or retailers which are actual or potential collectors or communicators of such goods and services. With a view to expensive goods-or very specialized goods at all – it can be a very small group, for margarine and toothpaste it can be the whole, or in any case a large part, of the country's people. '); see also *Kjennetegnsrett* (n 411) pg 318-319 regarding the relevant public in the risk of confusion analysis.

⁹¹⁹ A good example of a manufacturer being part of the relevant public, along with the end consumer, is that of computer components. It was not until the 'Intel Inside' campaign that the processor chips of computers began to be a visual, logo, and trademarks marketing tool, yet Intel was supplied only internal components to computer manufacturers for integration into products; see also, NOU 2001:8, pg 62

The relevant public additionally has a geographic dimension concerning unregistered trademarks. Varemerkeloven §3 states that if it 'foreligger innarbeidelse bare i en del av riket, gjelder eneretten bare for dette område'.⁹²⁰ However, a small by population or specialised relevant public does not necessarily mean that it is also geographically small. In the *Gorgoroth Case*⁹²¹ the rights to the trademark of a black metal band were at issue. Oslo tingretten stated that

Den aktuelle omsetningskrets utgjøres her av det spesialiserte og forholdsvis <<smale>> marked for black metal musikk i form av plater, koserter og <<fan>>-artikler, men omfatter for dette marked hele den vertikale omsetningskjede bestående av blant annet artister, produsenter, distributører, arrangører og slutt kunder. ... Tingretten trenger ikke ta stilling til eventuell innarbeidelse utenfor riket, men bemerker at black metal er en forholdsvis snever musikk sjanger, hvor merkebevisstheten er høy og markedet i det alt vesentlig internasjonalt.⁹²²

To determine the relevant public for the use of the gákti, one is as indicated encumbered by circular definitions without a specific dispute that provides context. This makes a concrete determination difficult beyond what has been written above. In order to adequately identify the relevant public for the purposes of the Sámi ownership of an unregistered trademark for the gákti it would be necessary to articulate the exact use of the gákti for which protection is being sought, in what manner it was used, and the customers and potential customers to which that use is directed. However, one clearly relevant and important segment of the public would be the tourist and visitor to Sápmi, and the potential tourists and visitors, and by implication, the service providers and retailers to those visitors and tourists.⁹²³ The significance of the gákti as an identifier of the Sámi people to this particular relevant public is evidenced by the use made of the

⁹²⁰ vml. §3, third paragraph. ('if the establishment is present only in a part of the Kingdom the exclusive right is valid only for that area.')

⁹²¹ TOSLO-2008-140784

⁹²² TOSLO-2008-140784, page 8, ('The relevant trade area is shown here are the specialized and relatively <<narrow>> market for black metal music in the form of records, concerts and <<fan>> articles, but for this market the entire vertical sales chain includes artists, manufacturers, distributors, organisers, and end customers. ... The district court does not need to consider possible inclusion outside the Kingdom, but notes that black metal is a relatively narrow music genre, where the brand awareness is high and the market is largely international.')

⁹²³ See section 7.2.

Sámi culture and images of the Sámi in state sponsored tourism marketed – directly connect to the tourism strategies.

The relevant public in vml. §3 attaches to relevance to the particular mark for which protection is sought and the market conditions surrounding the use of that mark. That said, however, it should be understood that esteem and knowledge of the mark on a broader scale are also relevant to determining the conditions within that relevant public. It is conceivable that the knowledge of a mark is so widespread throughout Norway and associated with a particular source that the conditions within the relevant public must take that overall knowledge into account.⁹²⁴ This might very well be the situation with regard to the Sámi gákti.

There are many relevant publics within which the validity of the Sámi people's trademark rights to the gákti could be tested. Including, as noted above, the tourism trade, but also by way of example the internal Sámi individuals who commission a gákti as part of their identity and membership within the group; external non-Sámi individuals who seek to purchase a unique Sámi cultural expression; the purchasers of souvenirs; people seeking out Sámi services such as nature tourism experiences or consulting and many other relevant areas. As indicated, with each different relevant public the necessary requirements for a protectable mark would be slightly different – that is to say that the distinctiveness required to create that association within a specific relevant public may vary.

In order to highlight this scenario one can consider the market for two different relevant publics – i) the internal Sámi individuals who would commission a gákti for their own use, and ii) non-Sámi individuals who would purchase a gákti for whatever use they desired. As was outlined in section 6.2.3.1 the gákti exhibits deep, intricate, and complex meaning to Sámi individuals. It displays not only an identity connection to the Sámi people at large, but also specific aspects of the individual wearer. Slight differences in pattern, cut, and design can tell other Sámi, and others who are capable of reading

⁹²⁴ Indeed, this can be seen in the operation of the Kodakregeln principles and vml. §4.

those elements, a great deal of information, all within the overall concept and aesthetic of a gákti. With that in mind, the distinctiveness required by any of those elements may indeed be a very high threshold within the relevant public of Sámi people in order to attract the protection of trademark law. In other words, if the relevant public is the Sámi themselves the level of knowledge and familiarity with the gákti may necessitate a significant departure from the norm in order to exhibit the required level of distinctiveness.

If, on the other hand, viewing the same article of clothing through the eyes of a non-Sámi relevant public the ability to see the intricate differences that can be read by Sámi people will surely not be present. Indeed, the level of distinctiveness required in order for the non-Sámi relevant public to associate a given mark, or collection of marks or indications, with the Sámi as a source is a much lower threshold as the distinction then is between Sámi and non-Sámi products not between Sámi products within a Sámi context. In other words, if the relevant public are tourists with unspecialized knowledge of the Sámi culture, their association and perception will attach to the overall form and aesthetic of the gákti.⁹²⁵

In short, what could qualify as 'godt kjent' in one relevant public will not be the same for another relevant public even for the same good or service.⁹²⁶ Critically, this could lead to a situation where the relevant public being evaluated has low substantive knowledge of the source, or mark, but a high association between those marks and the source.

In such a situation the relevant public could become vulnerable even to simple imitations that trade on the overall distinctive aesthetic. It is precisely in these types of

⁹²⁵ Though outside of the scope of this work, these differences in understanding and perception are of critical importance when conducting infringement analyses. Even from this short explanation it can be seen how the varying public perception can also create an environment where tourists are taken advantage of, the indigenous cultures are exploited, by unscrupulous imitators.

⁹²⁶ This is a particularly important point given the areas in which most indigenous intangible resources are misappropriated by non-indigenous entities – namely in the area of tourism (souvenirs and mock cultural services / experiences) where the level of distinctiveness required to form the association – within the minds of the tourists and the indigenous culture – would be a very low threshold.

situations where the protections provided by trademarks are vital, and it necessitates a sound understanding of the foundational nature of a trademark and the general principles of trademark protection to adequately evaluate their application.

6.3.4.6. *Interactions among the provisions*

The above sections concluded that the essential elements of a valid unregistered trademark are: a mark that is suitable of distinguishing the goods and services of one 'virksomhet' from another's, and is well known as the trademark of a particular source within the relevant public. However, in order to gain a full understanding of what this validity means it is necessary to examine how the various sections of varemerkeloven interact and what is gained from each particular section.

At the outset any trademark, in Norway, must conform to the basic principles of what can be a trademark in vml. §2.⁹²⁷ It is then necessary that the rights to the trademark be obtained by virtue of vml. §3, and once obtained then does one gain the exclusive right to use that mark in commerce by operation of vml. §1.

Of particular note in this process is what each section provides, and especially the creation of rights through vml. §3. The use of the phrase 'godt kjent som noens særlige kjennetegn' in vml. §3 not only places the knowledge of the mark within the workings of the relevant public ('godt kjent'), but also the composition of the source itself.⁹²⁸ Essentially, obtaining rights to an unregistered trademark is dependent upon that association by the relevant public. This, in turn, means that it is not required that the source associated with that trademark necessarily has made any use of the mark itself – 'At varemerket skal være *brukt* i Norge, kreves imidlertid ikke'⁹²⁹ - it is the public perception that is critical here.

Indeed, the Norwegian trademark precedent makes it clear that an unregistered trademark can be protected not only in situations where use of a trademark has

⁹²⁷ See section 6.3.3.4.

⁹²⁸ See section 5.3.

⁹²⁹ *Kjennetegnsrett* (n 411) pg 244 ('However, it is not required that a trademark be used here in Norway.').

ceased,⁹³⁰ but also where it has never occurred (at least within the borders of Norway).⁹³¹ It also confirms the role that the public perception plays in defining the nature of an unregistered trademark.⁹³² Notably, these basic features of Norwegian trademark law implies that it essentially mirrors the nature of a trademark generally, as concluded in Part 4, and in particular section 4.2.2. Or conversely, once again it is seen how the general principles of trademark protection, articulated in Part 4, form the basic understandings used in national level systems and in this case Norway.

The above goes to the interaction of the sections of the Norwegian varemerkeloven because, though they can be, and normally are, read together, they also operate separately. Through operation of §3 one obtains the trademark rights, and through §1 those rights are defined. With these sections operating separately there are situations that conceivably arise where protection would be routed through one and not the other, such as one triggering the operation of §1 (the exclusive right of use in commerce) based on registrations instead of §3 establishment; or more interestingly, a trademark finding protection through operation of §3 where a source is not engaged in business at all, but has sufficient association within the relevant public.

Though these hypotheticals may seem fanciful they are not outside of the realm of possibility, and indeed would not be denied protection under the Norwegian trademark system. They may also seem extreme in their concept of protection, however, given the fundamental goals and functions of a trademark as outlined in this work, if there is the requisite association in the mind of the public combined with a properly composed trademark, protection will follow.

This aspect of the protection of unregistered trademarks in the Norwegian regime is important to understand when evaluation these protections within the indigenous, and Sámi, context. When these two sections are read together, many may input a

⁹³⁰ Biltilsynet case LG-2011-23049 – RG-2012-578, THAUG-2010-68241.

⁹³¹ TOSLO-2003-9203A – RG-2004-1542; HR-1995-167-B – RT-1995-1908; PS-2007-7628.

⁹³² TOSLO-2008-140784; Biltilsynet case LG-2011-23049 – RG-2012-578, THAUG-2010-68241; HR-1995-167-B – RT-1995-1908 pg 8; PS-2005-7344.

commercial nature from one to the other – that being from §1 to §3. However, as has been explored above, there is no commercial nature requirement to obtain the §1 exclusive right through §3 paragraph 3 on ‘innarbeidelse’. Thus an evaluation of protectable indigenous resources through a commercial lens, as a threshold to protection, would be inappropriate when discussing unregistered trademark protection in Norway.

6.4. Conclusion - the Gákti, Tináa, and unregistered trademark protections

In this Part of the work the application of trademark protection principles outlined in Part 4 were applied through specific jurisdictional systems to two specific items of indigenous intangible resource of two specific indigenous peoples. This began with an introduction and outline of those indigenous peoples – the Sámi people of Northern Europe and the Tlingit people of Southeast Alaska. Section 6.2 initially reviewed the history of the Sámi and Tlingit and their respective handicraft traditions in order to place the protection of their intangible resources into the proper social context. Section 6.2.3 continued by selecting a particular item of indigenous intangible resource from the handicraft traditions of the Sámi and Tlingit through which the possibility to achieve protections for those two peoples’ respective intangible resources generally through unregistered trademark could be tested. These particular items, the gákti and tináa, were then given a brief history of their use and placement within their respective indigenous people’s society. Both items have been used from time immemorial and both maintain a central role within the spiritual, social, and cultural lives of their respective indigenous people.

Section 6.3 then proceeded to view the gákti and tináa through the lens of the unregistered trademark protections offered by the trademark systems in the United States (in particular as applicable in the Federal Ninth Circuit) and Norway. Though the trademark protection regimes of Norway and the United States are different, and the legal systems in which they operate are built upon different principles, theories, and justifications, there are many commonalities when it comes to practical protection of trademarks and trademark validity. Norway and the United States both allow the validity of marks through use and establishment. The public perception of a mark is a

controlling factor as to whether a mark is indeed a valid trademark, to what extent it is protectable, and to what source and owner it attaches. Norway and the United States both view the required attributes of a valid trademark in a similar manner – a trademark must be suitable of distinguishing, it must have distinctiveness, and it must create within the mind of the relevant public an association between the mark and a source. In short, when properly understood, the general principles of trademark protection as described in Part 4 are present in both trademark protection regimes, the reimagined definition of a trademark in section 4.2.2 is exhibited in both jurisdictions, and the analysis of the application of trademark protection in both scenarios was clarified by a foundation approach.

Perhaps most central to the discussion of the protectability of indigenous intangible resources generally through marks established by use, and indeed to this Part's evaluation of a valid unregistered trademark in the *gákti* and *tináa*, is the treatment in Norway and the United States of the concept and construction of source and ownership. Here the Part notably discovered that both legal systems accept a similarly broad view of source and ownership as long as it is supported by the public perception and expectation.

Ultimately, when a fundamental trademark approach is taken there is no impediment to the protection of the *gákti* in Norway or *tináa* in the United States as unregistered trademarks for their respective peoples within the trademark protection systems in the respective countries. The *gákti* and *tináa* both exhibit at least the minimum distinctiveness required for a valid unregistered trademark, either inherently or through the long, consistent, and continuous use by the Sámi and Tlingit people. They are both indications that are well known within their own area - but most probably this renown extends much further and most certainly to the relevant public of those that seek to visit Sápmi and Southeast Alaska in order to experience the indigenous culture.

Lastly, both the *gákti* and *tináa* have and do create an association between whatever they are placed upon, or whatever service they are used within, and the Sámi and Tlingit peoples. The extent to which this association can be articulated and attracts protection

would be illuminated by a specific dispute and the relevant public at issue in that dispute.

Having established the general principles of trademark protection in Part 4 and applied that knowledge through the operation of specific systems in this Part there is no legal, theoretical, or practical reason why the gákti and tináa are not at this moment protectable unregistered trademarks of their respective indigenous peoples – the Sámi and Tlingit. And, indeed, through this analysis and these examples it can be seen that the protections provided by existing trademark law can be and is useful and effective to meet certain needs of indigenous peoples. It has also been illuminated that prior analyses of the application of trademark law within the area of indigenous resource protection have been lacking a foundational approach when they have determined that substantive trademark protections are of limited or no effectual value.

It must be highlighted that, though it is outside the scope of this work to catalogue and test all possible iterations, these conclusions may be equally applicable to other items of indigenous intangible resource, including those of the Sámi and Tlingit, as well as instructive for other indigenous peoples in other jurisdictions, as these examples scenarios were employed only as an articulated of the foundational, protection first, trademark approach.

7. Public policy interests in appropriate trademark protections

7.1. Introduction

The implication and effect of properly analysing and applying trademark protection, with the assistance of a fundamental understanding of that protection, to the intangible resource of indigenous peoples in a protection first manner cannot be under-emphasised. As previously mentioned, there has been prior work and scholarship within this area, though with minimal practical progress and effect. It is articulated in this work that this lack of effect arises primarily from an infirm foundation of the understanding of trademark protections employed previously, which has led to improper application and ineffective analysis. Yet, while these efforts have proceeded the cultural, social, and economic pressures upon indigenous groups have only increased and the deleterious effects have compounded for indigenous groups, the general public, and states. This calls up certain public policy concerns and interests in applying trademark protection in a fully informed manner.

The pressures upon indigenous groups and an easing of those pressures through trademark protection can be acutely seen in the areas of tourism and ‘handicrafts’, where economic, cultural, and social perils can be seen. The public interest in proper trademark protection in this area can also be seen as a manner to strengthen the survivability of indigenous peoples, recognition of indigenous legal systems, and not least consumer protection. Each of these aspects are explored in this Part to outline the meaningful impact of the fundamental understanding and approach to trademark protections.

7.2. Handicrafts and tourism markets

7.2.1. Tourism

The market for indigenous products must be seen in the context of the increase in tourism, which also has its own impacts upon the indigenous environment, land rights, and services. Although it is outside the scope of this work to dwell substantially upon the area of tourism, it is instructive to outline tourism's interaction with indigenous peoples, their products, and the pressure that they face, especially where tourism development is oftentimes a national interest concern and raises public policy issues.

Tourism has always revolved around seeking out the new, unique, and different from one's own place within the world, geographically, culturally, or environmentally. 'Tourism is a service industry whose primary resource is environments and cultures which differ from those where tourists usually live.'⁹³³ This has oftentimes coalesced into standardised patterns and routes, such as the classical Grand Tour⁹³⁴, or stages in life such as gap year travel.⁹³⁵ Furthermore, tourism focused on experiences and cultural explorations has increased significantly and is expected to continue to do so,⁹³⁶ especially in the post-pandemic world.⁹³⁷ This has led to a tourism environment in which the cultures of indigenous peoples play a larger role.⁹³⁸ National governments have been frank about the fact that indigenous peoples within their borders provide a valuable draw for the tourism industry.⁹³⁹ This comes as no surprise given the deep connections indigenous peoples have to the lands and natural resources which they have traditionally occupied, their cultures and traditions that reach back to time immemorial, and societies that are wholly unique. The unique cultural aspects of indigenous peoples are a motivation for many tourists to visit certain areas.⁹⁴⁰ It is not

⁹³³ Kristal Markowitz, Cultural Tourism: Exploration or Exploitation of American Indians? (2001-2002) 26 *American Indian Law Review* 233, 234, quoting Martin F. Price (ed), *People and Tourism in Fragile Environments* (1996).

⁹³⁴ See, John Towner, 'The Grand Tour – A Key Phrase in the History of Tourism', (1985) 12(3) *Annals of Tourism Research* 297

⁹³⁵ The European market potential for gap year tourism, Centre for the Promotion of Imports – Netherlands Ministry of Foreign Affairs (30 January 2024) available at <https://www.cbi.eu/market-information/tourism/gap-year-tourism/market-potential> (last accessed 13 May 2024)

⁹³⁶ 'Gap year travellers are more and more interested in experiences that allow them to connect with local culture, nature and communities. ... Other immersive experiences include festivals and local events that showcase traditional cultures and heritage.' *Ibid.*

⁹³⁷ See, Outlook for 2024: the rise and rise of experiential travel, RLA Global, Feb 2024, (available at <https://rlaglobal.com/en/insights/outlook-for-2024-the-rise-and-rise-of-experiential-travel>); Is experiential travel the next big trend?, Sean Newsom, National Geographic 19 Dec 2023 (<https://rlaglobal.com/en/insights/outlook-for-2024-the-rise-and-rise-of-experiential-travel>);

⁹³⁸ See, As Travelers Search For Meaning, Indigenous Tourism Is Taking Off, Christopher Elliott, Forbes, 20 Jan 2024 (<https://www.forbes.com/sites/christopherelliott/2024/01/20/as-travelers-search-for-meaning-indigenous-tourism-is-taking-off/?sh=6fe2d8c924b8>); <https://destinationsinternational.org/blog/embracing-indigenous-tourism-empowered-experiences>.

⁹³⁹ <https://www.austrade.gov.au/en/news-and-analysis/news/training-gives-indigenous-people-a-pathway-into-tourism>; https://www.bia.gov/sites/default/files/dup/inline-files/native_act_report_fy22_final.pdf; *Id.*

⁹⁴⁰ Palethorpe and Stefaan (n 66) pg 23.

new that indigenous peoples and cultures have been a draw to the traveller,⁹⁴¹ but the scale, scope, and pressure upon indigenous peoples have increased to new heights.

Tourism, in general, is a large part of the modern global society and adds substantially to state and local economies. For the thirty-five members of the Organisation for Economic Co-operation and Development⁹⁴² tourism contributes on average 4.4% of GDP, 6.9% of employment and 20.5% of service exports to their economies prior to the COVID-19 pandemic.⁹⁴³ Though these numbers were significantly impacted by the pandemic, the tourism sector has rebounded strongly with many expecting a full recovery in 2022.⁹⁴⁴

Specifically when looking at Scandinavia and the US, in 2019 Norway's tourism industry employed almost 182 800 people,⁹⁴⁵ tourism represented 3.6% of total GDP⁹⁴⁶ and contributed 127.4 billion NOK.⁹⁴⁷ In Sweden tourism accounted for 2.6% of the GDP prior to the pandemic and SEK 249 billion turnover in 2021.⁹⁴⁸ The tourism market in Finland was relatively smaller yet still accounted for 2.7% of the GDP in 2020 and more than 11.2 billion EUR in generated income in 2021 after significant pandemic related decline.⁹⁴⁹ In the United States tourism accounted for 2.9% of pre-pandemic GDP⁹⁵⁰ and an estimated economic output in 2018 of 941 billion USD of direct tourism output.⁹⁵¹

⁹⁴¹ Carl von Linné, *Lachesis lapponica: or, A tour in Lapland now first published from the original manuscript journal of the celebrated Linnæus* (White and Cochrane, 1811); Emilie Demant Hatt (Barbara Sjöholm trans and ed), *With the Lapps in the High Mountains: A Woman among the Sami 1907-1908* (University of Wisconsin Press, 2013).

⁹⁴² Australia, Austria, Belgium, Canada, Chile, Columbia, Costa Rica, Czechia, Denmark, Estonia, Finland, France, Germany, Greece, Hungary, Iceland, Ireland, Israel, Italy, Japan, Korea, Latvia, Lithuania, Luxembourg, Mexico, Netherlands, New Zealand, Norway, Poland, Portugal, Slovak Republic, Slovenia, Spain, Sweden, Switzerland, Türkiye, United Kingdom, and United States. (<https://www.oecd.org/about/members-and-partners/>)

⁹⁴³ *OECD Tourism Trends and Policies 2020* (OECD Publishing, 2020), pg 18; *OECD Tourism Trends and Policies 2022* (OECD Publishing, 2022), pg 16.

⁹⁴⁴ *OECD Tourism Trends and Policies 2022* (OECD Publishing, 2022), pg 20 *et seq.*

⁹⁴⁵ *OECD Tourism Trends and Policies 2022* (OECD Publishing, 2022), pg 246.

⁹⁴⁶ *Ibid.*

⁹⁴⁷ *Ibid.*

⁹⁴⁸ *Id.* at pg 276.

⁹⁴⁹ *Id.* at pg 161.

⁹⁵⁰ *Id.* at pg 296.

⁹⁵¹ *OECD Tourism Trends and Policies 2020* (OECD Publishing, 2020), pg 304.

The tourism sector is significant for nearly any country however, the impact that tourism can have on indigenous groups is especially acute. As noted by the Australia Council in a 1996 report, nearly one-third of visitors to Australia included some element of indigenous culture into their visit, whether that be an indigenous art gallery, cultural experience, or purchasing of cultural products. Additionally, '[i]n 1993, purchases of Aboriginal art and souvenirs by international visitors were estimated at \$46 million [AUS] and rose to \$67 million [AUS] in 1996.'⁹⁵²

Cultural tourism, in whichever manner one wishes to tackle the question of defining culture,⁹⁵³ has become a significant part of the overall tourism industry and accounted for nearly thirty-seven percent of all international tourism in a 1999 report.⁹⁵⁴ This cultural tourism is combined with a 'search for novelty',⁹⁵⁵ that unsurprisingly finds indigenous peoples with their singular traditions of livelihood, history, art, technology, knowledge, and expressions.

States with indigenous groups within their borders have also seen the touristic value of the indigenous cultural heritage. 'Cultures have become important economic resources as many nations capitalize on aspects of their cultures that make them unique and market these to tourists.'⁹⁵⁶ This is highly apparent in the marketing campaigns of various countries, as well as their tourism strategy documents. In 2014 'Future North' report issued by the Norwegian Ministries of Trade, Industry and Fisheries; Local Government and Modernisation; and, Climate and Environment, the Sámi people featured heavily in the value creation strategy for the three northernmost counties in Norway. 'Northern Norway's local communities and culture also play an important role as mainstays of the tourism industry. Arctic, coastal and, not least, Sámi culture provide

⁹⁵² Palethorpe and Stefaan (n 66) pg 23.

⁹⁵³ See, Markowitz (n 933) at 235; and, Greg Richards, 'European Cultural Tourism: patterns and prospects', in D Dodd and A-M van Hemel (eds) *Planning cultural tourism in Europe. A presentation of theories and cases* (Boekman Foundation: Amsterdam 1999) pg 2; and, Culture and Sustainable Development: A Framework for Action, The World Bank, (1999), pg 13.

⁹⁵⁴ Richards (n 953) pg 1.

⁹⁵⁵ Id., pg 10.

⁹⁵⁶ Deborah Rapuano and Jessica R Fernandez, 'Remembering and Living Irishness: tourism, place and memory', (2010) 36(1) *International Review of Modern Sociology* 1.

a framework for the nature experience, making it more unique and complete.⁹⁵⁷ Indeed, in the opinion of the Norwegian government, the 'Sámi culture helps to differentiate Northern Norway's Arctic offerings from competitors such as Iceland and Greenland, which do not have Sámi culture'.⁹⁵⁸

In Norway's 2012 government tourism strategy document, *Destination Norway*, the Sámi culture was similarly held out as a significant factor for tourism in the north of Norway. 'There is a growing demand for experience-based products linked to the Sámi way of life, which includes sale of food and duodji handicrafts.'⁹⁵⁹ Similar statements can be found in other Norwegian government strategy documents.⁹⁶⁰

While, in the new *National Tourism Strategy 2030*,⁹⁶¹ the Norwegian government has walked back the state-based focus on exploiting the Sámi people, by articulating a more evolved and appropriate stance on the Sámi people controlling their own tourism resources.⁹⁶² Prior to this recent change, their resources seemed to be understood as a state interest and for state benefit.

The use of indigenous cultures to attract tourist is not confined to government documents but can also be seen in official marketing campaigns. For example, the Northern Norway Tourist Board dedicated a section of their website to Sámi cultural

⁹⁵⁷ Future North: Final report from 'Knowledge Gathering – Value Creation in the North', Nærings- og fiskeridepartementet, kommunal- og moderniseringsdepartementet, klima- og miljødepartementet, pg 8-9; further 'The opportunity to experience Sámi culture and cultural history is unique to Northern Norway. The Sámi, Norway's indigenous people, live all over the country, but Sámi traditions are most evident in Finnmark, especially in Karasjok and Kautokeino. ... the opportunities for tourism lie in increasing demand for emotional and knowledge-related elements in the tourist experience, and the report therefore concentrates on experience enterprises based on Sámi culture, including museums, cultural institutions and events, as being important for future-oriented prioritization of tourism.' at pg 50.

⁹⁵⁸ Id., pg 50.

⁹⁵⁹ The government's tourism strategy – *Destination Norway*: National strategy for the tourism industry, Norwegian Ministry of Trade and Industry (2012), pg 56.

⁹⁶⁰ See, *Innovation Norway, Tourism Strategy 2014-2020*; European Commission Tourism industry sub-sectors Country Report – Norway, March 2014; *Destination Norway*, above n 190; *New Building Blocks in the North: The next step in the Government's High North Strategy*, Norwegian Ministry of Foreign Affairs (2009).

⁹⁶¹ *National Tourism Strategy 2030*, (Innovation Norge, 2021)

⁹⁶² 'The Sami tourist industry offers potential for growth, but it is important for it to be allowed to develop and mature on its own terms.' *National Tourism Strategy 2030*, (Innovation Norge, 2021), pg 34

history and attractions,⁹⁶³ and releases tourist information pamphlets devoted to Sámi related tourism.⁹⁶⁴ And, in Finland, a tourism marketing video entitled ‘100 Days of Polar Night Magic’ was released by the government funded tourism organisation Visit Finland to attract tourist to that country which prominently integrated Sámi characters.⁹⁶⁵

From the basic outline above, it is clear that tourism is of significant interest to States, increasingly centered on the cultural tourism area, and highly and ever more increasingly affected by, and affecting, indigenous peoples and cultures.⁹⁶⁶ Indeed, ‘[I]t is possible to say that tourism is highly affected by folklore, as well as folklore by tourism’.⁹⁶⁷ Though the availability of metrics and analyses specifically tailored to the effect that tourism has on indigenous peoples may be lacking, from this broad view of tourism generally the impact of tourism upon indigenous peoples and cultures is seen. With this increased exposure comes the increased possibility of inappropriate exploitation and proliferation of various entities wishing to take advantage of indigenous heritage. This vulnerability can be more clearly illuminated when looking specifically at the handicrafts market and imitations within that market.

7.2.2. Handicrafts market

While the linguistic problems with the use of English terms such as ‘handicraft’ has been noted above, it is necessary to employ ‘handicrafts’ here in order to set a frame of reference for the discussion. Indigenous products are a highly visible, and economically

⁹⁶³ Northern Norway Tourist Board, <http://nordnorge.com/en/sapmi>.

⁹⁶⁴ Sami Tourism in Northern Norway, Northern Norway Tourist Board, http://issuu.com/northern_norway/docs/49678981?mode=embed&layout=http%3A%2F%2Fskin.issuu.com%2Fv%2Fflight%2Flayout.xml&showFlipBtn=true; Sápmi Activities, Northern Norway Tourist Board, http://issuu.com/northern_norway/docs/292465960?mode=embed&layout=http%3A%2F%2Fskin.issuu.com%2Fv%2Fflight%2Flayout.xml&showFlipBtn=true.

⁹⁶⁵ in this case Visit Finland was criticized for depicting the Sámi as embodiments of harmful and discriminatory stereotypes and the scene was subsequently removed – see, “Likaiset lappalaiset, sekö myy maailmalla?” – Visit Finlandin mainosvideo suututtaa, Yle Uutiset, 17 September 2015 / 10 May 2016, available at <https://yle.fi/uutiset/3-8312073> (last accessed 20 June 2024).

⁹⁶⁶ Alysa Landry, ‘Millions in Fake Native Art and Shark-Infested Waters’, Indian Country Today, 13 July 2017 available at <https://indiancountrymedianetwork.com/news/politics/millions-fake-native-art-shark-infested-waters/> (last accessed 19 June 2024); Jonas Karlsbakk, ‘Sami Protests in Rovaniemi’, Barents Observer (31 October 2008), <http://barentsobserver.com/en/node/20977> (last accessed 20 June 2024); Piia Nuorgam, ‘Wider Use of Traditional Saami Dress in Finland: Discrimination against the Saami?’ in Alexandra Xanthaki, Sanna Valkonen, Leena Heinämäki, and Piia Nuorgam (eds), *Indigenous Cultural Heritage: Rights, Debates and Challenges* (Koninklijke Brill 2017).

⁹⁶⁷ Palethorpe and Stefaan (n 66) pg 23.

important, segment of the general 'handicrafts' market though it is somewhat challenging to tease out figures, statistics, and trends specific to indigenous products. This challenge arises from overlapping market terms, definitions, and conceptual divisions within research and statistics collection.

In attempting to quantify the 'handicraft' market, either locally or globally, challenges arise as '[h]andicraft products are not identified separately in the main international system for trade statistics...therefore, reliable trade data at the international level do not exist'.⁹⁶⁸ The complexities of evaluating the handicrafts market can be distilled down to, essentially, a 'quagmire'⁹⁶⁹ of definitions and categorisations.

Useful figures, however, can still be employed if not to merely illuminate the outside bounds of this area. USAID estimates the global market value of home accessory products 'to be at least \$100 billion',⁹⁷⁰ which it is using 'as a proxy for handicrafts'.⁹⁷¹ Vietnam exported 300 million USD worth of handicrafts to the United States in 2004, and India exported 1.9 billion USD of the same in 2003.⁹⁷² Ghana increased its handicraft exports to 14.9 million USD in 2001, and Peru exported 40 million USD worth of handicrafts in 2005.⁹⁷³

While these figures give us an idea of the handicraft market generally, or in some cases product markets within which handicrafts could exist,⁹⁷⁴ translating that into relevance for indigenous peoples requires further direction. One lens that provides a certain clarity to the scale of indigenous products market is that used by the International Trade

⁹⁶⁸ *Id.*, July 2006, pg 2.

⁹⁶⁹ Maureen Liebl and Tirthankar Roy, 'Handmade in Indian: Preliminary Analysis of Crafts Producers and Crafts Production' 38(51/52) *Economic and Political Weekly* 5366-5376, pg 5367.

⁹⁷⁰ Global Market Assessment for Handicrafts, Vol 1, Final Draft, United States Agency for International Development (USAID), July 2006, pg 3. Available at http://pdf.usaid.gov/pdf_docs/Pnadm210.pdf (last accessed 20 June 2024)

⁹⁷¹ *Id.* at pg 17.

⁹⁷² *Id.* at pg 19.

⁹⁷³ *Id.* at pg 20.

⁹⁷⁴ Generally, Handicrafts Market Opportunity Assessment, Embassy of India (Seoul Korea), 2012. Available at <http://www.epch.in/projects/Handicrafts-Market%20Survey%20Report-SouthKorea.pdf> (last accessed 20 June 2024).

Center where it focuses on ‘poor people’,⁹⁷⁵ and styles development in the handicraft area as ‘pro-poor tourism (PPT)’.⁹⁷⁶ The International Trade Center recognises the impact that PPT and handicrafts could have on subdivisions of ‘poor people’ – ‘[a] large part of handicraft producers and sellers, if not the majority, are women and many are from deprived ethnic minorities’.⁹⁷⁷ Even through this rather imperfect lens, the International Trade Center estimates that ‘[i]n 2007, Ethiopia ... the average tourist spent about US\$50 on handicrafts during his stay ... of which US\$25 were pro-poor income’.⁹⁷⁸ In 2006 the estimate for Mozambique was 20 USD per tourist, and 79 USD per tourist in Kenya.⁹⁷⁹

Furthermore, ‘[a]n assessment of the pro-poor-impact of tourism in the Lao People’s Democratic Republic former capital and main tourist destination Luang Prabang estimates that a total of US\$ 4.4 million of curios and craft articles are sold to tourists annually. Forty percent of this amount, US\$ 1.8 million, provides income for semi-skilled and unskilled people, who are considered to belong to the poorer parts of the population’.⁹⁸⁰ The impact that handicraft production, sale, and distribution has on handicraft producers, and underprivileged populations in particulate is unmistakable.

Perhaps more instructive for this work are studies specifically or primarily aimed at indigenous products. Though they are commonly more pinpoint in their analysis, limited to certain geographic areas or indigenous groups, they provide limited figures that highlight the impact of products upon those specific areas or groups. In this vein, and specific to the indigenous groups in this work, note must be taken of the focused study conducted by the Southeast Conference in Southeast Alaska.⁹⁸¹ In their publication *The Arts Economy of Southeast Alaska* they set out to ‘consider the role of arts in the

⁹⁷⁵ *Inclusive Tourism* (n 148) pg 1.

⁹⁷⁶ *Id.* at pg 3.

⁹⁷⁷ *Ibid.*

⁹⁷⁸ *Ibid.*

⁹⁷⁹ *Ibid.*

⁹⁸⁰ *Ibid.*

⁹⁸¹ Southeast Conference, ‘The Arts Economy of Southeast Alaska’ September 2014. Available at http://www.seconference.org/sites/default/files/Arts%20and%20the%20Southeast%20Economy%20FINAL_0.pdf (last accessed 10 June 2024).

Southeast Alaska economy'.⁹⁸² The Southeast Conference found 2340 full and part time artists in Southeast Alaska with total art related earnings by artists of 29.9 million USD.⁹⁸³ Southeast Alaska is the home to three indigenous groups, the Tlingit, Haida, and Tsimshian people, all of which maintain a thriving art heritage. It was because of this high concentration of indigenous artists that Southeast Conference included in its study specific measures for artists that identified as Alaska Native.⁹⁸⁴ It was found that '[r]egionally, approximately one-quarter (23%) of all artists identify themselves as Alaska Native artists. In ten Southeast Alaska communities Alaska Native art is the dominant art form, with 75% to 100% of survey respondents identifying themselves as Alaska Native artists'.⁹⁸⁵ If only from these figures alone, it can be seen that art and products plays a significant role in the lives of indigenous people in the Southeast Alaska region.

Southeast Conference provides further economic details, including that 'Alaska Native Artists secured nearly a third (30%) of their annual earnings through their art last year [2013]', and that 'net profit of Alaska Native artist is 64% higher than the average net profit of all Southeast Alaska independent artists'.⁹⁸⁶ These numbers, however, must be tempered by the fact that they articulate only the impact of 'art' and where relevant to Alaskan Natives is applicable to those who self-identify as such. Thus, while providing a more nuanced view of indigenous 'handicrafts' within an indigenous community, ambiguities remain.

Similarly, in a report drafted for the European Commission, metrics from Australia were used. Though, '[t]he world-wide impact of folklore on arts and crafts is hard to tabulate. ... [F]igures from Australia are a good example of the importance of folkloric art to art and crafts in general. [The Aboriginal and Torres Strait Islander Commission]'s National Aboriginal and Torres Strait Islander Cultural Industry Strategy estimated the indigenous arts and crafts market to be worth almost \$200 million per year'.⁹⁸⁷

⁹⁸² Id. at pg 1.

⁹⁸³ Id. at pg 3

⁹⁸⁴ Id., pgs 8-9.

⁹⁸⁵ Id., at pg 8.

⁹⁸⁶ Ibid.

⁹⁸⁷ Palethorpe and Stefaan (n 66) pg 22.

In the United States, a 1935 Congressional study of the 'indian' handicrafts market stated "[t]here are several Indian tribes which even now rely on the sale of their handicraft output for a major portion of their total income. Among the Navajos, the output of the looms and of the silversmiths produces a gross revenue in excess of a half million dollars a year [8.5 million inflation adjusted to 2016]'.⁹⁸⁸ It was also presented to the United States Congress in 1990 that '[t]his industry's [that of Native American handicrafts] value has been estimated at \$400-\$800 million annually'.⁹⁸⁹

While these US studies provide a more nuanced view of the handicraft market specifically in the area of indigenous peoples, particularly those native groups of the United States, they are not without their own inherent issues. These issues were best articulated in a Government Accountability Office ('GAO') Report to the Committee on Natural Resources of the United States House of Representatives in 2011 which stated that:

The actual size of the Indian arts and crafts market, and extent of misrepresentation that is occurring, are unknown, because existing estimates are outdated, limited in scope, or anecdotal and no national sources contain the data necessary to make reliable estimates. Conducting a comprehensive study to estimate the size of the market and level of misrepresentation would be complex and costly and may not provide reliable results.⁹⁹⁰

The authors of that report went further and questioned the reliability of any such studies for reasons including:

- Artists may not maintain detailed income records and may not be able to reliably estimate, or may not want to provide, their annual income from the sale of their art.
- A store selling Indian-style and other goods may not be able to accurately estimate what proportion of total sales comes from Indian-style goods.

⁹⁸⁸ Report of the Committee on Indian Arts and Crafts to the Honorable Harold L. Ickes, Secretary of the Interior, September 1934, SR 74-900 ('SR 74-900'), pg 3.

⁹⁸⁹ House Report on the Indian Arts and Crafts Act of 1990, HR Rept 101-400 ('HR 101-400'), pg 5; see also the *Final Report (First Part) submitted by the Special Rapporteur, Mr. José R Martínez Cobo* ('Cobo Report'), Study of the Problem of Discrimination Against Indigenous Populations, UNESCO Commission on Human Rights Sub-Commission on Prevention of Discrimination and Protection of Minorities, (34th session 30 July 1981) Report E/CN.4/Sub.2/1982/2/Add.3, pg 32 *et seq.* for estimates in other countries.

⁹⁹⁰ GAO Report (n 199) pg 9.

- A comprehensive list of Indian artists and establishments that sell Indian and Indian-style arts and crafts does not exist. The meaning of key terms, such as “Indian-style,” are not universally agreed upon, and a survey to identify all of the goods that make up the term “Indian-style,” one respondent may think that they must include all jewelry with turquoise stones, while another respondent may consider only turquoise jewelry with recognizable tribal patterns or markings as being “Indian-style.”
- A study on the extent of misrepresentation in the market would be difficult because it would rely largely on self-reporting of illegal activity by violators of the Indian Arts and Crafts Act.⁹⁹¹

The authors were speaking with a view to issues within the United States and the legal and legislative environment there that specifically deals in protection of indigenous products. However, the principles that were stated can highlight the difficulty of estimating, not only the market for indigenous products, but even the market landscape. As can be seen from this, and the above discussion, the area is rife with definitional issues, identity issues, lack of reporting and tracking, and general amorphous boundaries.

Though the figures and metrics provided by the studies above do not directly illuminate the market for indigenous products to a satisfying granularity they are instructive in ascertaining the general scope of handcraft markets of indigenous products and the tourism market in which those products find themselves. It is exhibited from these basic figures that the tourism market and market for handicrafts is economically and impactfully substantial both to the people affect and the State as a whole.

7.3. Imitations in tourism and handcraft and their effect on indigenous peoples

As tourists and other visitors to areas of indigenous occupation increase, and the value of indigenous resources becomes realised, this inevitably is followed by an increase of products attempting to emulate the indigenous expressions of the area. The International Trade Centre have stated that while local production of handicrafts for the

⁹⁹¹ GAO Report (n 199) pg 13.

tourism market provides opportunities, there are serious problems with imitation and imported products.⁹⁹²

In the United States in 1990 it was estimated that with a value of 400-800 million USD around 10-20 percent of the native handicrafts market was affected by imitations. 'This means that imitation of Native American handicrafts is siphoning an estimated \$40-\$80 million from the genuine manufacturers markets.'⁹⁹³ Of course this attempt to quantify the handicrafts market and corresponding imitation market falls victim to the issues of collecting solid data which was explored above, it is still beneficial to take note of those estimates.

The problem of imitation indigenous handicrafts has long been a topic of concern. It was brought to the attention of the US Congress when efforts were made at passing the Indian Arts and Crafts Act – an attempt to eradicate or severely hinder imitation 'Indian-style' products. In the 1935 Congressional report relating to that law, it was stated that '[t]here is a definite demand on the part of the public for Indian arts and crafts products. This demand has led to the manufacture of imitations by machinery and the market is being flooded with low-cost spurious articles to such an extent that the sale of the genuine handicraft is seriously affected.'⁹⁹⁴ This theme was further taken up in a United States Senate report which noted that a 'deluge' of imitations was flooding the market.⁹⁹⁵

The problems relating to imitation cultural products are most often seen in an economic light. Once indigenous craftspeople are competing with 'low-cost spurious articles' it creates a market within which they, most often, cannot compete. This concern was voiced by the Chairman of the Committee on Indian Affairs (US) –

The present market is also in need of protection against imitation products. The problem is serious with regard to silver work and jewelry. Machine- and factory-made products of this type can and do undersell the individual hand-craftsman's wares, partially by deception. The uninformed purchaser

⁹⁹² *Inclusive Tourism* (n 148) pg 4.

⁹⁹³ *HR 101-400* (n 989) pg 5.

⁹⁹⁴ *SR 74-900* (n 988) pg 2.

⁹⁹⁵ *Id.* pg 3, Statement by Hon. Elmer Thomas, Chairman Committee on Indian Affairs.

cannot distinguish between them, and even the expert cannot always do so.⁹⁹⁶

Though the above statement was made in 1934, the concern is still valid today, as evidence in a report to the European Commission on the protection of expression of folklore in 2000 - 'By allowing imitations of expression of folklore to compete in the marketplace a reliable source of income for traditional communities may be endangered.'⁹⁹⁷

However, the impact upon the indigenous community is not limited to the economic realm, and perhaps is more insidious within the cultural context itself. In 1934, in the opinion of the Committee on Indian Arts and Crafts, the economic aspects of the arts and crafts market was one of only three 'problems' that arose from the competition of imitation products.

1. These products as a part of Indian culture as a whole; inextricably related to Indian religion, ways of life, and self expression.
2. These products as art, and as part of the art heritage of the American people as well as of the Indian
3. These products as a present and potential source of income to the Indian and to various trade factors; therefore as an element in the economy of the tribes and of other population groups.⁹⁹⁸

Perhaps more relevantly, that Committee went on to write that, '[a]s mediums of self-expression [the arts and crafts] are intimately related to the Indian's inner life, and have been shown by experience to have a direct bearing on tribal solidarity and self-respect.'⁹⁹⁹

It was apparent even nearly ninety years ago that the arts and crafts traditions of indigenous groups were not only an economic resource, but that they were vital to the wellbeing and survivability of the indigenous groups. These sentiments have been echoed many times, not least by a 2000 report to the European Commission –

⁹⁹⁶ Id. pg 10.

⁹⁹⁷ Palethorpe and Stefaan (n 66) pg 14.

⁹⁹⁸ SR 74-900 (n998) pg 5.

⁹⁹⁹ Id. pg 6.

‘Folklore creators’ cultural interest lies in the preservation and continued evolution of their cultural heritage. For many traditional communities folklore plays an important role in their cultural life. If expressions of folklore are gradually incorporated into the cultures of others and distorted from their original form this has potentially detrimental effects on the creators’ culture and may disrupt its continued evolution. Furthermore, expressions of folklore may be a viable means of promoting a sense of national cohesion and identity. Folklorists stress the importance of folklore validation and protection for individual and community dignity and respect.’¹⁰⁰⁰

The uncontrolled inappropriate exploitation of these items not only causes significant economic hardship, but it also destroys the very fabric of the indigenous community and identity. This destruction of an indigenous groups ‘solidarity and self-respect’ can be seen not only in the assault upon their culture from imitations of questionable quality, authenticity, and sensitivity, but also in the effects that such unsustainable competition has on the production of indigenous products.

This concept is described by the US Government Accountability Office’s 2011 report -

‘Misrepresentation by sale of unauthentic products created by non-Indians, including imports from foreign countries, is a matter of great concern to Indian artisans, who may have to reduce their prices or lose sales because of competition from lower-priced imitations products. This could have a potentially significant negative economic effect on the Indian arts and crafts market and, consequently, on the individuals and tribes who rely on this market for income.

Furthermore, Indian artisans have voiced concerns that the traditional knowledge of how to create these goods—often passed down from generation to generation within the tribes—will not be carried forward by younger generations if they cannot make a living producing these goods.’¹⁰⁰¹

While the GAO helpfully summarises many of the issues surrounding the imitation indigenous arts and crafts market in the above passage, most troubling may possibly be that which is emphasized - without the ability to compete in an imitation flooded market, indigenous craftspeople may find that the younger generation is not interested in continuing a tradition that has ‘a direct bearing on tribal solidarity and self-respect’.

¹⁰⁰⁰ Palethorpe and Stefaan (n 66) pg 15.

¹⁰⁰¹ GAO Report (n 199) pg 1 (emphasis added).

The younger generation cannot make a living from their own heritage, and thus find no value in continuing it. In short, by not ensuring the market for authentic, genuine, indigenous handicrafts it not only creates economic hardships and attacks the very fabric of an indigenous community, but it also threatens the very survival of the traditional knowledge surrounding those items.¹⁰⁰²

Another troubling aspect of this situation, which has been unaddressed and persistent into today, is that those seeking to purchase indigenous products are seeking the genuineness that is becoming increasingly difficult to find. It was expressed in 1935 that '[t]he public desires to buy only the genuine Indian handicraft product, but under present conditions it frequently requires the trained eye of an expert to determine what is genuine and what is spurious imitation'¹⁰⁰³ and this desire has not waned. Relating this back to tourism it has been said that '[a]ccording to tour operators, limited exposure of local indigenous culture such as crafts diminishes the uniqueness and attractiveness of the tourism experience.'¹⁰⁰⁴

This desire of the purchasers, and indigenous groups, has also been evidence in recent court cases¹⁰⁰⁵ and perhaps most visibly in the vibrant discussion surrounding 'cultural appropriation' that has intensified in recent years.¹⁰⁰⁶ The GAO report succinctly

¹⁰⁰² This erosion of the culture of indigenous peoples also has significant negative social impacts. It creates an environment which devalues and demeans indigenous peoples and individuals which can impact on the individuals self-identity. This disproportionately affects those most vulnerable including youth and children. See Nuorgam (n749) pg 236-7.

¹⁰⁰³ SR 74-900 (n 988) pg 3.

¹⁰⁰⁴ *Inclusive Tourism* (n 148) pg 4. (quoting the IFC, 2006).

¹⁰⁰⁵ *US v Kowalis*, 5:21-cr-00145-XR (WD Tx 2021); *Navajo v Urban Outfitters*, Dist of NM (1:12-cv-195), *US v Sippy*, 01:16-cr-00007 (D Ak 2016); *US v Gengler*, 01:16-cr-00006 (D Ak 2016); *US v Karim*, 01:16-cr-00005 (D Ak 2016); *US v Caradang*, 01:16-cr-00004 (D Ak 2016); *US v Rodrigo, et al.* 1:23-cr-00003-TMB-MMS (D Ak 2023); *US v Nael Ali*, 1:15-cr-03762-JCH (D NM 2015); *Sealaska Heritage Institute, et al. v. Neiman Marcus Group LTD, et al.*, 1:20-cv-00002-SLG (D. Ak. 2020).

¹⁰⁰⁶ Jonas Karlsbakk, 'Sami Protests in Rovaniemi', *Barents Observer* (31 October 2008), <http://barentsobserver.com/en/node/20977>; (last accessed 30 July 2023); Danny J Pellicer, 'Raser mot Kiwis koftestunt', *Nordlys*, (11 September 2010), <https://www.nordlys.no/nyheter/raser-mot-kiwis-koftestunt/s/1-79-5306233>; (last accessed 12 June 2024); Sissel Wessel-Hansen, et al., 'Denne kreasjonen skapte storm i Sapmi', *Nordlys*, (2 December 2013), <https://www.nordlys.no/nyheter/denne-kreasjonen-skapte-storm-i-sapmi/s/1-79-7018945>; (last accessed 20 June 2024); 'Storm i en samekofte', *iTromsø*, (14 September 2010), <http://www.itromso.no/meninger/leder/article389222.ece>; (last accessed 10 June 2024); Jessica Chia, 'Brown skin is not a costume': Disney accused of cultural appropriation after 'Moana' outfit based on a Polynesian demigod goes on sale', *DailyMail*, 20 September 2016,

describes the effects that the sale of imitation indigenous handicrafts has on the perception of the public when it stated –

‘Likewise, consumers may suffer from misrepresentation if they are fraudulently led to believe that imitation products they purchase are authentic and, upon discovery, may cause them to question the authenticity of genuine goods, further damaging the Indian arts and crafts market at large. These concerns also extend beyond tangible arts and crafts to include other types of traditional knowledge and cultural expression, such as song, dance, and writings, which can be misappropriated by outsiders and used for profit.’¹⁰⁰⁷

Thus, in the situation in the current environment is one that benefits neither the indigenous group from which the cultural heritage and resources arise, nor the consumer that wishes to purchase genuine indigenous products. These conditions

<http://www.dailymail.co.uk/news/article-3798362/Brown-skin-not-costume-Outrage-Disney-sells-Moana-Halloween-costume.html>; (last accessed 10 June 2024); Mark Olsen, ‘Disney pulls ‘Moana’ costumes for children amid cultural appropriation uproar’, *LA Times*, 22 September 2016, <http://www.latimes.com/entertainment/movies/la-et-mn-disney-moana-costume-controversy-20160922-snap-htmlstory.html>; (last accessed 20 December 2023); Jessica Chia, ‘“Brown skin is not a costume”: Disney accused of cultural appropriation after ‘Moana’ outfit based on a Polynesian demigod goes on sale’, *DailyMail*, 20 September 2016, <http://www.dailymail.co.uk/news/article-3798362/Brown-skin-not-costume-Outrage-Disney-sells-Moana-Halloween-costume.html>; (last accessed 20 June 2024); Elizabeth Roberts, ‘Chanel’s \$1,325 boomerang condemned as ‘cultural appropriation’, *CNN Style*, 16 May 2017, <http://edition.cnn.com/2017/05/16/europe/chanel-boomerang/index.html>; (last accessed 10 June 2024); Evan Ross Katz, ‘Chanel is under fire for cultural appropriation for selling a \$1,325 boomerang’, *Business Insider*, 17 May 2017, <http://www.businessinsider.com/chanel-boomerang-is-under-fire-for-cultural-appropriation-2017-5?r=US&IR=T&IR=T>; (last accessed 10 June 2024); Heidi Stevens, ‘Explaining that lousy Maui costumer—and cultural appropriation—to a kid’, *Chicago Tribune*, 4 October 2016, <http://www.chicagotribune.com/lifestyles/stevens/ct-disney-moana-costume-controversy-balancing-1004-20161004-column.html>; (last accessed 12 June 2024); Jessica Misener, ‘Karlie Kloss wears Native American headdress at Victoria’s Secret fashion show’, *Huffington Post*, 8 November 2012, http://www.huffingtonpost.com/2012/11/08/karlie-kloss-victorias-secret-headdress-fashion-show_n_2091958.html; (last accessed 20 Dec 2024); ICMN Staff, ‘Here we go again: Victoria’s Secret Angel Karlie Kloss dons headdress’, *Indian Country Today*, 9 November 2012, <https://indiancountrymedianetwork.com/news/here-we-go-again-victorias-secret-angel-karlie-kloss-dons-headdress/>; (last accessed 20 June 2024); Katie J.M. Baker, ‘A Much-Needed Primer on Cultural Appropriation’, *Jezebel*, 13 November 2012, <http://jezebel.com/5959698/a-much-needed-primer-on-cultural-appropriation> (last accessed 20 June 2024); Johan Sandberg McGuinne ‘Authentically Saami’: Lisa Vipola’s Art in Context, Indigeneity, Language and Authenticity’, *WordPress*, 20 March 2013, <https://johansandbergmcguinne.wordpress.com/2013/03/20/authentically-saami-lisa-vipolas-art/>; Krystalline Krause, ‘Activist Communique: Our culture is not a Halloween costume,’ *Rabble.ca*, 15 March 2012, <http://rabble.ca/blogs/bloggers/krystalline-kraus/2012/03/activist-communiqu%C3%A9-our-culture-not-halloween-costume%E2%80%8E>; (last accessed 30 July 2023); Hilary Bird, ‘Cultural appropriation: Make it illegal worldwide, Indigenous advocates say’, *CBC News*, 13 June 2017 available at <http://www.cbc.ca/news/canada/north/cultural-appropriation-make-it-illegal-worldwide-indigenous-advocates-say-1.4157943> (last accessed 30 July 2023); WIPO/GRTKF/IC/34/PRESENTATION/2MEAD.

¹⁰⁰⁷ GAO Report (n 199) pg 1.

negatively impact both groups, and have a long-term lasting and possibly irreversible effect.

7.4. Public policy interests in appropriate trademark protection application

The above sections reveal that tourism and its accompanying product market is a substantial economic and cultural interest to the state and public. These combined markets also significantly impact upon the indigenous peoples within tourism concerned States, as the indigenous peoples and the unique experiences and products they provide are a significant and increasing draw within the tourism market.

It was also articulated above that the negative impacts upon indigenous peoples, through inappropriate, inauthentic, or unauthorised products are manifest and strike to the very core of those peoples. This is not only in the form of economic vulnerability but also cultural erosion, attacks upon their integrity, possible elimination of entire peoples or at least segments of their cultural heritage. In short, this becomes a question of their survivability.

A recognition of fundamental trademark protection application to these indigenous intangible resources provides a means by which the distinctive cultural properties of these indigenous groups are secured to those indigenous peoples and the unauthorised uses could be combated. The follow-on effects of this approach result in solutions to serious public policy concern. It would provide a secure and protected manner to ensure the economic foundation of affected indigenous groups, which oftentimes goes to the development of rural and village economies. This also ensures the integrity of the tourism and tourism products market. It has been previously stated that the cultural and experiential tourism market is based upon seeking out the genuine, yet without securing that 'genuine' the foundation of that market would be undermined. This is a concern not only for the affected people or local area, but for the State itself.

Furthermore, there is a clear aspect of consumer protection in the protection of genuine indigenous products, services, and intangible resource. Combined with the desires of cultural and experiential tourism is also the expectation and demand for genuine.

Indeed, '[t]here is a definite demand on the part of the public for [genuine] Indian arts and crafts products.'¹⁰⁰⁸ The diversion of that demand to inauthentic products or services is an aspect that trademark law is clearly designed to prevent. 'The uninformed purchaser cannot distinguish between them, and even the expert cannot always do so. Both the buying public and the Indian craftsman in this field need the protection of established standards and a distinguishing mark of identification.'¹⁰⁰⁹ Legislation specifically addressing the needs of indigenous products and the indigenous products market such as the Indian Arts and Crafts Act have even been couched specifically in consumer protection terms.¹⁰¹⁰

Thus there are strong public policy concerns to ensure that the intangible resources of indigenous groups are properly protected, for the economic foundation of the indigenous peoples, the development of rural industries, the continuing value of tourism, and the economic aspects of tourism upon the State. It is through the proper application of fundamental trademark rights, as they now exist and are equally accessible by indigenous groups, where one may find effective protection.

These interest must also be seen in the context of States obligations to ensure the survivability of indigenous cultures.

7.5. Indigenous Survivability and State Obligations

While it is outside the scope of this work to evaluate the international regime for protection of indigenous peoples, it bears noting that ensuring that indigenous peoples are able to make use of the trademark protections available in a given jurisdiction may also fulfill certain international legal obligations. As outlined in sections 2.3-4 many international instruments include various provisions for the protection of indigenous peoples, communities, and other groups, and individuals, including their cultures, as well as handicrafts and industry. Norway for example was

¹⁰⁰⁸ SR 74-900 (n 988).

¹⁰⁰⁹ Id., pg 10.

¹⁰¹⁰ IACA is a 'truth-in-advertising statute aimed at ensuring that products marketed and sold as "Indian" are actually Indian.' *Native American Arts, Inc. v. Contract Specialties, Inc.*, 754 F.Supp.2d 386, 388 (Dist. R.I. 2010)

the first country to ratify the ILO Indigenous and Tribal Peoples Convention, 1989 (No. 169), [and having endorsed] the United Nations Declaration on the Rights of Indigenous Peoples. Norway has [ratified and] incorporated the International Covenant on Civil and Political Rights, the International Covenant on Economic, Social and Cultural Rights and the International Convention on the Elimination of All Forms of Racial Discrimination into its domestic law

...

Following an amendment adopted in 1988, the Norwegian Constitution establishes an obligation on the authorities to protect the Sami, their culture and traditional livelihoods.¹⁰¹¹

Similarly, the United States has ratified the International Convention on the Elimination of All Forms of Racial Discrimination, the International Covenant on Civil and Political Rights, as well as being a signatory to the International Covenant on Economic, Social and Cultural Rights, and having endorsed the United Nations Declaration on the Rights of Indigenous Peoples.¹⁰¹²

Each of these international instruments contain provisions that relate to the protection of indigenous peoples in one manner or another, including their cultures and expressions. As indicated, this work is not the place to conduct an analysis of these provisions of the international indigenous rights instruments. Suffice it to say that of particular interest for the present purposes are Article 27 of the International Covenant on Civil and Political Rights,¹⁰¹³ Article 23(1) of ILO 169,¹⁰¹⁴ Article 5(d)(v) of the International Convention on the Elimination of all Forms of Racial Discrimination,¹⁰¹⁵ and

¹⁰¹¹ Report of the Special Rapporteur on the rights of indigenous peoples on the human rights situation of the Sami people in the Sápmi region of Norway, Sweden and Finland, 9 August 2016, A/HRC/33/42/Add.3, page 7

¹⁰¹² Report of the Special Rapporteur on the rights of indigenous peoples: The situation of indigenous peoples in the United States of America, 30 August 2012, Human Rights Council, A/HRC/21/47/Add.1, pg 19.

¹⁰¹³ 'In those States in which ethnic, religious or linguistic minorities exist, persons belonging to such minorities shall not be denied the right, in community with the other members of their group, to enjoy their own culture, to profess and practice their own religion, or to use their own language.'

¹⁰¹⁴ 'Handicrafts, rural and community-based industries, and subsistence economy and traditional activities of the peoples concerned, such as hunting, fishing, trapping and gathering, shall be recognised as important factors in the maintenance of their cultures and in their economic self-reliance and development. Governments shall, with the participation of these people and whenever appropriate, ensure that these activities are strengthened and promoted.'

¹⁰¹⁵ 'In compliance with the fundamental obligations laid down in article 2 of this Convention, States Parties undertake to prohibit and to eliminate racial discrimination in all its forms and to guarantee the right of everyone, without distinction as to race, colour, national or ethnic origin, to equality before

UNDRIP Articles 11, 20, 22 and in particular 31.¹⁰¹⁶ The protection of indigenous intangible resources and their expressions is an essential aspect of the goals of the international instruments concerning indigenous peoples.¹⁰¹⁷

This view to protection also ensures indigenous individuals' ability to freely participate in their culture. While the concept of culture is complex and constantly at the center of lively debate,¹⁰¹⁸ it is used as a key term in many instruments directed at the protection of indigenous peoples, not least section 108 of the Norwegian Constitution.¹⁰¹⁹ There is an important aspect of culture that is valuable to highlight in the context of this work - that being culture as the ability to participate.

[C]ulture is better understood by considering three central features: *participation, livelihood, and shared meaning.*¹⁰²⁰

...

Culture is not just a set of "inputs" necessary for further innovation. Culture is the sphere in which individuals participate, create, share ideas, and enjoy life with others.¹⁰²¹

the law, notably in the enjoyment of the following rights: ... (d) Other civil right, in particular: ... (v) the right to own property alone as well as in association with others... .'

¹⁰¹⁶ Article 11 – 'Indigenous peoples have the right to practice and revitalize their cultural traditions and customs. This includes the right to maintain, protect and develop the past, present and future manifestations of their cultures, such as archaeological and historical sites, artefacts, designs, ceremonies, technologies and visual and performing arts and literature.

States shall provide redress through effective mechanisms, which may include restitution, developed in conjunction with indigenous peoples, with respect to their cultural, intellectual, religious and spiritual property taken without their free, prior and informed consent or in violation of their laws, traditions and customs.'

Article 20 – 'Indigenous peoples have the right to maintain and develop their political, economic and social systems or institutions, to be secure in the enjoyment of their own means of subsistence and development, and to engage freely in all their traditional and other economic activities.

Indigenous peoples deprived of their means of subsistence and development are entitled to just and fair redress.'

Article 22 – 'Particular attention shall be paid to the right and special needs of indigenous elders, women, youth, children and persons with disabilities in the implementation of this Declaration.

States shall take measures, in conjunction with indigenous peoples, to ensure that indigenous women and children enjoy the full protection and guarantees against all forms of violence and discrimination.'

¹⁰¹⁷ Åhrén, *the Saami Traditional Dress* (n 74) pg 151 *et seq.*

¹⁰¹⁸ Michael F Brown, *Who Owns Native Culture?* (Harvard University Press, 2003) pg 4; Jane E Anderson, *Law, Knowledge, Culture: The Production of Indigenous Knowledge in Intellectual Property Law* (Edward Elgar, 2009) pg 191; *Glossary of key terms* (n 179) pg 6.

¹⁰¹⁹ 'Det påligger statens myndigheter å legge forholdene til rette for at det samiske folk, som urfolk, kan sikre og utvikle sitt spark, sin kultur og sitt samfunnsliv.' Grunnloven, §108 ('The authorities of the state shall create conditions enabling the Sami people, as an indigenous people, to preserve and develop its language, culture and way of life.')

¹⁰²⁰ Madhavi Sunder, *From Goods to a Good Life: Intellectual Property and Global Justice* (Yale University Press 2012) pg 8.

¹⁰²¹ *Id.* pg 32.

Taking that viewpoint, the ability to participate in the one's community is an essential element of culture. This participation not only flows to personal interactions, but also to the expressions of the culture – the ability to create, comment, and utilise in concert with other members of the group of their cultural community. As stated at the 1953 Sámi conference – 'Kulturen er ikke bare en *livsform*, men i første rekke en *samlivsform*; den må bygges på et organisert samfunn.'¹⁰²²

Key to this ability to participate are the intangible cultural resources that are used within a culture because the protection of those indigenous intangible resources is critical to ensure the cohesiveness of the community, and in turn the culture, in which one participates. Use of indigenous cultural resources outside of the community in an unauthorised manner can have a direct, negative, impact on the identity of indigenous individuals. This unfortunately disproportionately affects the most vulnerable among the indigenous peoples including children and youth.¹⁰²³ This is because, as mentioned above, the handicraft traditions of indigenous peoples are directly connected to the individual's identity, culture, and place within society.

With relation to the examples in this work, in the case of the *gákti* the meaning written into the object itself extends to all aspects of the individual wearer's place within the Sámi society.¹⁰²⁴ The *gákti* is a valuable connection for an individual to the community itself and expression of identity. To allow the unrestrained counterfeiting of these elements, or the *gákti* itself, dilutes the nature of this item, degrades the meaning within the garment itself, and attacks the very fabric of Sámi society. It has been noted that '[m]any outside the Sami community use symbols that have been tied to the [Sámi] pre-Christian religion and other symbols as well. Often, these symbols are used to lure tourists for the purpose of sale'.¹⁰²⁵ And in Finland, 'they have particularly struggled to get Finns to stop using *kofta* in a "wrong" way. In this case, "wrong" means when a Finn

¹⁰²² *Sámiid Dilít* (n 83) pg 123 ('Culture is not just a form of life, but primarily a form of social arrangement; it must be built on an organized community.').

¹⁰²³ *Nuorgam* (n 745) pg 236-7.

¹⁰²⁴ See section 6.2.3.1.

¹⁰²⁵ *Duodji – árbediehtu* (n 207) pg 85.

pretends that he/she is Sami in interaction with tourists, that is, for a commercial purpose, and portrays the Sami as something dirty and “primitive”.¹⁰²⁶

In regard to the tináa and other forms of art amongst the Tlingit, Caskey Russell explains that

the highly ornate art of the Tlingits is not merely aesthetic; it is an elaborate semiotic system that legitimizes claims of clan hereditary and both tangible and intangible property ownership. Tlingit art is part of an extant totemic law that comprises unique, culturally specific designs carved, painted, woven, or otherwise represented on virtually every article of Tlingit life; the role and international of this art with oral tradition and tribal ritual produce and reinforce a shared identity within the tribe. Nor are the various forms of artistic expression (carving, weaving, painting, etc.) mutually exclusive. The various forms of art are cultural expressions that, along with the oral tradition, define clan identity and legitimate a clan’s claim to property ownership. In a sense, totem poles, screens, and other designs are the physical manifestations of an ornate totemic law that has been handed down within the clan to explain what properties a clan owns and why.¹⁰²⁷

These resources are not just mere items of aesthetic, but are integral parts of the culture, society, people, and individual. Yet there are often seen by non-indigenous people and entities as simple aesthetic resources or as means by which to conjure an association with the exotic.¹⁰²⁸ This unprotected, unauthorised, and inappropriate, use not only has the negative impacts that have been described in previous sections, but hinder the indigenous individual’s ability to participate in their own culture.

Though the method of protecting these indigenous properties outlined in this work, that being the proper application of fundamental trademark protections, is private in nature and does not derive from any State action – indeed, this work has gone to lengths to highlight that protection of indigenous intangible resources is available in the current

¹⁰²⁶ *Id.* pg 88.

¹⁰²⁷ Russell (n 106) pg 238-9.

¹⁰²⁸ Alysa Landry, ‘Millions in Fake Native Art and Shark-Infested Waters’, Indian Country Today, 13 July 2017 available at <https://indiancountrymedianetwork.com/news/politics/millions-fake-native-art-shark-infested-waters/> (last accessed 21 June 2024); Jonas Karlsbakk, ‘Sami Protests in Rovaniemi’, Barents Observer (31 October 2008), <http://barentsobserver.com/en/node/20977> (last accessed 21 June 2024); Nuorgam (n 745); Riley Woodford, ‘The art of tricking tourists’, Juneau Empire, 18 September 2000 available at http://juneauempire.com/stories/091800/Ins_Trick.html#.WYFiaf-GOAY (last accessed 21 June 2024).

trademark systems – it is clear that it is in the State and public interest, and possibly among the State obligations, to support the trademark protection efforts of indigenous cultural resources.

7.6. Trademark protection as a recognition of indigenous law

In addition to the public policy interests surrounding the economics of the protection of indigenous cultural resources, the consumer protection aspects, and the general tourism market impacts, the recognition of fundamental trademark protections also embodies the self-determination and cultural self-governance of indigenous groups. This arises not only through proper control of their own cultural resources, but also through a method of recognition of indigenous law

While it is oftentimes espoused that indigenous groups lacked, or currently lack, a form of recognizable ‘law’ in the manner of modern understanding, this is not supported by the evidence in a historical or modern context.¹⁰²⁹ Indeed, ‘[c]ustomary laws are central to the very identity of indigenous peoples and local communities, defining rights, obligations and responsibilities of members relating to important aspects of their lives, cultures and world views.’¹⁰³⁰

Indigenous law was, and is, even clearly developed for most indigenous groups in the area of their intangible resources and their use. The role that indigenous law plays in the intangible realm can be seen in nearly every aspect of indigenous cultural life. In any given indigenous group, one may encounter law relating to the telling of stories, the exhibition of certain signs, marks, or images, the dancing of certain dances, the wearing of certain clothing, the creation or use of certain items of craft, or any number of other

¹⁰²⁹ See generally, Bronislaw Malinowski, *Crime and Custom in Savage Society* (Harcourt, Brace & Company, 1926); E. Adamson Hoebel, *The law of primitive man: a study in comparative legal dynamics* (Harvard University Press, 1967)

¹⁰³⁰ Customary Law and Traditional Knowledge, Background Brief No.7, (WIPO 2016) available at http://www.wipo.int/edocs/pubdocs/en/wipo_pub_tk_7.pdf (last accessed 21 June 2024); see also, Customary Law, Traditional Knowledge and Intellectual Property: An Outline of the Issues, (WIPO 2013) available at http://www.wipo.int/export/sites/www/tk/en/resources/pdf/overview_customary_law.pdf (last accessed 21 June 2024)

aspects of life, as well as who within the group may access certain resources and make decisions for those resources.

With regard to the Sámi gákti, there are clear rules relating to its use, wear, and construction. As Piia Nuorgam states '[t]he Saami have clear legal conceptions regarding who can wear Saami dress and how; these vary in different areas, just as the conceptions of land use do.'¹⁰³¹ The fact that these Sámi legal rights to the use of gákti are similar to land use is not surprising as the variations of the gákti itself generally follows the geographical divisions within Sápmi.¹⁰³² In any case, '[r]esearch on Saami law has shown that Saami customs can constitute customary law and can act as one of the sources of law alongside national and international law.'¹⁰³³ These legal rules are not only seen in relation to the gákti, but in many other areas of intangible Sámi resources, including the traditional form of song (the 'joik').¹⁰³⁴

Similarly, the Tlingit have a highly developed system of law relating to the use of their intangible resources. Most notably such laws relate to the ownership and use of clan crests and names.¹⁰³⁵ The rules relating to crests and other forms of intangible resource within the Tlingit people necessitates a discussion of the social structure, family relationships, traditional stories, and property rights within the Tlingit society. This is much too complex an issue to adequately articulate here and is also outside the scope of this work. Yet, as much can be said that the interaction between the law relating to use of the clan crest is not only about bare use but also relates to the crests, and other items of Tlingit at.óow, being integral to the Tlingit identity. 'The crest is the distinctive feature of the life of the Northwest Coast of America. It is the basic principle of the well-

¹⁰³¹ Nuorgam (n 745) pg 234.

¹⁰³² As well as along the linguistic and familial divisions. Gunvor Guttorm, 'Den Samiske Drakten i Historiens Løp' in *Norsk Bunadleksikon: Alle bunader og samiske folkedrakter* (Cappelen Damm 2013) – 'Drakten følger både de språkelige og de geografiske samiske områdene. Generalt kan en si at i språkområdene og draktområdene følger hverandre. Der det snakkes sørsamisk, pitesamisk, lulesamisk, nordsamisk, enaresamisk og skoltesamisk finnes det også egne draktskikker.' at pg 891.; see also section 6.2.3.1 on the gákti.

¹⁰³³ Nuorgam (n 745) pg 235.

¹⁰³⁴ see generally, Birger Stuevold Lassen, 'On Copyright in Saami Joiks' in Peter Wahlgren (ed), *Legal issues of the late 1990s* (Stockholm 1999).

¹⁰³⁵ See section 2.6.2.

established code of laws that governs the relations of people with one another and regulated their social functions.’¹⁰³⁶

The Sámi and Tlingit, much like other indigenous peoples, had a highly developed system of law prior to the introduction of western legal systems by their respective majority populations.¹⁰³⁷ These respective legal systems extended to the intangible resources and in most cases are still relevant and applicable today.¹⁰³⁸ When considering the role that indigenous law plays relative to trademark protections, there is no reason that the indigenous law already in place should not be given full recognition and enforceability at least as it relates to the internal intangible resource management and decision making. The place that customary law or norms based protections has in intellectual property disputes is already comfortably sound in a modern context, at least in discrete areas.¹⁰³⁹

Furthermore, the use of customary law, of a sort, is commonly used to assist courts in deciding cases internal to certain entities. An example of this can be seen in the Norwegian *Gorgoroth* case. Though the *Gorgoroth* case revolved around the rights to the GORGOROTH trademark itself, one issue that had to be dealt with by the court was the internal decision making rules within the band. Two former members of the band claimed to the court that they had removed the third member by majority vote. However, the court noted that

¹⁰³⁶ Emmons (n 102) pg 32.

¹⁰³⁷ Emmons (n 102) pgs 46-53; Krause (n 106) pg 147, and ‘The Indian cannot stand a peaceful, quite existence. His great sensitivity and his strong sense of property rights are constant cause of resentment.’ at pg 209; Worl (n 214) pg 198; Åhrén, *Indigenous Peoples’ Culture* (n 79); Øyvind Ravna, ‘Sami Legal Culture – and its Place in Norwegian Law’ in *Rendezvous of European Legal Cultures*, Jørn Øyrehagen Sunde and Knut Einar Skodvin (eds) (Fagbokforlaget 2010).

¹⁰³⁸ Worl (n 214) pg 198 - ‘...the fundamental tenets of Tlingit property law remain intact insofar as they apply to claims of ownership of traditional, ceremonial objects, intangible property (i.e. crests, stories, and songs), and clan houses. ...clan crests used on ceremonial garment ...continue to be governed by traditional Tlingit legal principles.’; Nuorgam (n 745) pg 234; Gunvor Guttorm, ‘Den Samiske Drakten i Historiens Løp’, in *Norsk Bunadleksikon: Alle bunader og samiske folkedrakter* (Cappelen Damm 2013), pg 889 *et seq.*; Grinev (n 106) pgs 40-45; Krause (n 106); Åhrén, *Indigenous Peoples’ Culture* (n 79); Øyvind Ravna, ‘Sami Legal Culture – and its Place in Norwegian Law’ in *Rendezvous of European Legal Cultures*, Jørn Øyrehagen Sunde and Knut Einar Skodvin (eds), Fagbokforlaget 2010), pg 149 *et seq.*

¹⁰³⁹ Emmanuelle Fauchart and Eric von Hippel, ‘Norms-based intellectual property systems: the case of French chefs’ MIT Sloan School of Management Working Paper 4576-06, January 2006. Available at <https://evhippel.files.wordpress.com/2013/08/vonhippelfauchart2006.pdf> (last accessed 21 June 2024).

På grunnlag av Gorgoroths sannsynliggjorte muntlige stiftelsesgrunnlag sett i sammenheng med praksis ved tideliger skifter av faste bandmedlemmer har tingretten videre kommet til at Tiegs ikke kunne ekskluderes fra Gorgoroth ved flertallsvedtak.¹⁰⁴⁰

The foundation that the court referenced was Gorgoroth's 'erklærte satanistiske normgrunnlag'.¹⁰⁴¹ The court continued that

Gorgoroth er imidlertid et satanistisk band. Spørsmålet om Tiegs vesentlig har krenket Gorgoroths verdigrunnlag eller stiftelsesgrunnlag må klarligvis vurderes opp mot verdigrunnlagets satanistiske innhold. Til tross for at alle sakens parter har erklært at de slutter seg til satanistiske verdier og/eller livssyn, er det i liten grad konkretisert hva dette innebærer. Det er ikke forklart hvordan <<use and abuse>> atskiller seg fra en mer egosentrisk satanisme. Domstolene kan ikke forventes å verken dele eller være fortrolig med innholdet i slike verdigrunnlag fra før.

Tingretten finner det tilstrekkelig å konstatere at satanisme synes å ha et heterogent innhold, der verdier som kompromissløs selvhevdelse, vilje til makt, individualism, egosenstrisitet og knallhard forhandlingsstrategi synes høyt og positivt vurdert. Det synes også å ha positive satanistisk egenverdi å utfordre eller bryte tradisjonelle borgerlige dyder eller verdier.¹⁰⁴²

The court thus used the Satanic values of the band as the standard from which to view the band members' internal behaviour and ultimately ruled that the removal of the third band member was not justified according to the satanic value system. Though this may have been done in the context of corporation law, the fact remains that the case nonetheless demonstrates that Norwegian courts are no strangers to accepting that internal norms should be allowed to govern internal decision making relating to intangibles.

¹⁰⁴⁰ TOSLO-2008-140784, pg 6 ('On the basis of Gorgoroth's alleged oral incorporation foundation in connection with practice from earlier changes of permanent band members the District Court further concludes that Tiegs could not be excluded from Gorgoroth by majority decision.').

¹⁰⁴¹ TOSLO-2008-140784, pg 6 ('declared satanic foundational norms').

¹⁰⁴² TOSLO-2008-140784, pg 12('Gorgoroth, however, is a satanic band. The question whether Tiegs has substantially violated Gorgoroth's value base or incorporation foundation must be clearly assessed against the satanic content of the value base. Despite the fact that all parties to the dispute have declared that they adhere to satanic values and / beliefs, there is little concrete about what this implies. It is not explained how <<use and abuse>> differs from a more self-centered Satanism. The courts cannot be expected to share or be familiar with the content of such values.

The district court finds it sufficient to note that Satanism seems to have a heterogeneous content, where values such as uncompromising self-determination, willingness to power, individualism, egocentrism, and fierce negotiation strategies are highly and positively evaluated. It also seems to have positive satanic self-worth to challenge or break traditional civic virtues or values.')

There have also long been calls for the recognition of indigenous law in the broader application or integration into national and international legal systems.¹⁰⁴³ However, many of commentators place the applicability of indigenous law within the area of traditional knowledge and the external, to the indigenous community, recognition of internal norms and law.¹⁰⁴⁴ The use of indigenous law in the realm of the ownership of trademark rights does not play so large a role in the external, to the indigenous people, application but focuses more on the internal decision making processes within the people and authorised uses. This is not unlike the internal rules and regulations, and decision making processes, seen in modern western trademark owner.

In this aspect, the application of fundamental protections relating to trademarks and the recognition of those marks as being owned by the respective indigenous groups, with all of the accompanying rights recognised under the current law would lead to a recognition and strengthening of the traditional law of those indigenous groups. This would, in turn, strengthen the survivability of indigenous peoples and further their integrity, cohesiveness, self-determination, and unique cultural lives and structures.

¹⁰⁴³ Anthony Taubman and Matthias Leistner, 'Analysis of Different Areas of Indigenous Resources' in Silke von Lewinski (ed), *Indigenous Heritage and Intellectual Property; Genetic Resources, Traditional Knowledge and Folklore* (2nd Edition, Wolters Kluwer, 2008), pg 89, 134-136; Åhrén, 'Indigenous Peoples' Culture (n 79); Ravna (n 1038).

¹⁰⁴⁴ Anthony Taubman and Matthias Leistner, 'Analysis of Different Areas of Indigenous Resources' in Silke von Lewinski, *Indigenous Heritage and Intellectual Property: genetic resources, traditional knowledge and folklore* (Wolters Kluwer, 2nd ed, 2008) pg 89; *Samerett* (n 160) pg 65 *et seq.*

8. Conclusion

This work has selected a small, but significant, element of the discourse surrounding the rights of indigenous peoples to analyse anew - that being the applicability of trademark protections, as seen in modern systems, to indigenous intangibles resources.

The world is on the search for the new, unique, and different in both experience and products, and indigenous peoples are squarely in the crosshairs. Within the culture of any given indigenous people there is a wealth of unique, distinguishing, and distinctive intangible resources and properties that have been utilized, managed, maintained, and stewarded from time immemorial. The importance of these properties to the development, sustainably, and survival of indigenous cultures cannot be understated, yet they are under consistent and increasing pressure from outside actors.

Trademark protection is uniquely suited to staving off, at least to a significant extent, threats faced by indigenous peoples relating to their intangible properties, and securing to those peoples not only the value of those properties but also the support they provide the respective cultures. However, while the discussion surrounding the rights of indigenous peoples has progressed immensely, securing to indigenous peoples their own intangible resources within the frameworks of dominant western legal systems has been lagging.

Taking account of the prevailing literature in the indigenous rights and intellectual property areas, this work evidenced that the discussion surrounding intellectual property's, and in particular trademarks', applicability to indigenous intangible resources had become confused. As seen in section 1.3, a troubling habit of conflating all of the areas of intellectual property (primarily copyrights, patents, and trademarks) together, and a heavy focus upon copyright and patent protection systems, stunted a valuable and effective examination of trademarks. This work further explained that on the occasions where trademarks had been substantively taken into account, they were commonly disregarded as an available means of protecting indigenous intangible resources. Due to misconceptions traced to a misunderstanding or misapplication of the fundamental principles of trademark law and the protection of distinguishing marks,

trademarks were quickly seen as unhelpful to indigenous peoples due to constructed notions of their individualistic nature, commercial identity, and impracticality for various other reasons.¹⁰⁴⁵

It was also shown that the existing trademark analysis were not helped by the prevailing tendency to force segmentation of indigenous cultures into categories – primarily TK, TCEs, and GRs. Though ostensibly this is in an effort to make indigenous issues audible, it is divorced from the realities of indigenous cultures, properties, and peoples, creates significant gaps in the interface between these categories and the legal mechanisms, and establishing a filtering set of hurdles before recognition of indigenous ownership and control can be fulfilled.¹⁰⁴⁶

This work repositioned the discussion surrounding the applicability of trademark protection within the indigenous rights arena by employing a dogmatic analysis of the existing trademark law, built upon the foundations of trademark protections, and viewing indigenous intangible properties through the sole lens of those trademark systems. This occurred primarily in Part 3 and 4 of the work through articulating and analysing the historical foundations and development of distinctive mark protection and their interactions with the creation of the modern statutory understanding of a trademark. This process clarified the currently applicable trademark protections with a distilled and refined view of the foundations and a new definition of a trademark, while applying it to indigenous resources without the burden of overlaying extraneous categorical discussions – essentially employing a bottom up approach.

It was through this process and approach that a number of commonly employed trademark misconceptions in the area were laid bare, and it was articulated in Part 4 that common principles of trademark law, seen essentially throughout the history of the protection of distinguishing marks are no less applicable today especially through the mechanisms of unregistered trademark protection.

¹⁰⁴⁵ See section 1.3

¹⁰⁴⁶ See section 2.4.1

This renewed understanding of trademark protection was then tested and proved though its use in the example scenarios of Part 6 with specific exemplars to articulate that the foundation trademark protections are not only extant in the modern trademark systems, but that they can also be employed to great effect in the service of indigenous rights. These targeted scenarios occurred specifically relating to the Sámi and Tlingit people within their respective jurisdiction, yet the results articulate that foundation trademark principles, and the protection of unregistered trademarks, can be activated to securing indigenous intangible properties. Or rather, indigenous peoples already own these trademarks, established through simple use and recognition, the unregistered trademark provisions within national laws are merely the means by which to prove, already existing, ownership.

In short the answer to this work's question – *'To what extent are unregistered trademark protections in modern systems applicable to the protection of indigenous intangible resources?'* – is that unregistered trademark protections have substantial and significant applicability to the protection of indigenous intangible resources, even in the modern trademark systems. There is no theoretical, practical, or legal reason why indigenous groups could not find protection for many of their intangible resources through the mechanisms of unregistered trademark protection, as just such protection is at the foundational level of trademark law.

The impacts of this conclusion were explored in Part 7, as it can be seen that such recognition of protection could lead to economic security and development, cultural survival, fulfillment of legal obligations, and other serious public policy concerns. But, perhaps more importantly, implementation of a foundation trademark understanding within the indigenous rights discourse allows the recognition of rights, for indigenous individuals and collectives, which have largely been denied up to this time. Critically, as this work has established, this denial of rights is not supported by the law or fundamental principles of trademarks.

Contrary to the prior general treatment of trademarks in the context of indigenous rights, this work has been established that as long as a specific item of indigenous

intangible property meets the fundamental requirements of a trademark, as articulated within these pages, it can and should be protected as a trademark owned by that indigenous group. In doing so indigenous peoples would find support, indigenous properties would find recognition, the law of trademarks would find internal harmony and equitable applicability, and the interests of the public at large would be fulfilled.

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