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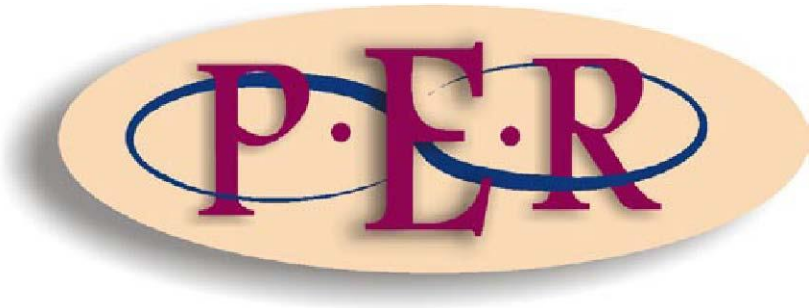

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WHAT INTELLECTUAL PROPERTY LAWYERS CAN LEARN FROM BARBRA STREISAND, SEPP BLATTER, AND THE "COCA-COLA CRY-BABY": DEALING WITH "TRADEMARK BULLYING" IN SOUTH AFRICA

AM Louw*

"Being a monopolist" is, apparently, akin to going on drugs or joining some strange religious sect. It seems to lead to complete loss of any sense of what profitable opportunities are and of how free markets function. Monopolists, apparently, can conceive of only one way of making money, and that is by bullying consumers and competitors to put up and shut up. Furthermore, it also appears to mean that past mistakes have to be repeated at a larger, and ever more ridiculous, scale.[1]

In reality, most enforcement of IP rights takes place not in court, but in the everyday practices of IP owners and their lawyers. "Cease and desist" letters, phone calls, and negotiations with alleged infringers constitute the bulk of IP enforcement efforts in trademark and copyright practice. To be sure, these efforts take place in the 'shadow' of IP law and are therefore influenced by it. But it is in these everyday practices-and not in trial or appellate courts-that most IP rights are asserted, resisted, and negotiated ... Most IP scholarship is primarily doctrinal, focusing on published appellate cases. Even the growing empirical scholarship on IP focuses largely on published or, at least, filed cases. As in every other area of civil justice, however, most IP disputes do not result in litigation, and most litigation settles well before trial.[2]

The chief attribute of intellectual property is that apart from its recognition in law it has no existence of its own ... Of course, it is this distinction ... which makes the subject challenging and fun. How richly conceptual an undertaking it is to have to recognise the existence of an interest in the very act of protecting it. And yet if one does not exercise restraint, how preposterous an undertaking it becomes as well.[3]

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1 Boldrin and Levine *Against Intellectual Monopoly* 89.

2 Gallagher 2012 *Santa Clara Computer & High Tech LJ* 456.

3 Lange 1981 *LCP* 147-148.

1 Introduction

Schoolyard bullying is a troubling social ill that has attracted growing attention in the past decade. "Queen" Oprah and "Prince" Phil, PhD, have both devoted "tear-jerker" shows to the topic, and governments across the world have taken active steps to address this increasingly worrying phenomenon. The legal profession has, for many years - sometimes undeservedly - attracted pejorative labels from members of the public, and many a schoolyard bully has probably in the past been voted most likely to someday attempt the Bar exam. Some of the criticism of lawyers is well-founded, and some facets of the profession lend themselves to derogatory labelling, if one considers how often a lawyer is not only the bearer of bad news, but also the actual author of someone's woes. What springs to mind most readily in our current economic climate is the spectre of foreclosures and home or vehicle repossessions. This article, however, addresses the recent, sometimes deplorable conduct of intellectual property (or IP) lawyers.

I still fondly remember my first encounters with IP law as an undergraduate student, and how impressed I was with a field of law which deals with the noble cause of protecting peoples' ideas and rewarding artistic and other creativity - while furthering the betterment of all mankind. An idealistic young law student can get goose-bumps by merely reading the copyright clause in the *United States Constitution*.[4] Of course, it didn't hurt that the clients of IP lawyers could be exciting pop-culture movers and shakers like rock-guitar god Eddie Van Halen[5] or the Arsenal Football Club[6] (or, come to think of it, even Barbie[7]). I remember feeling great respect for IP lawyers who deal with often very technical legal issues in order to protect the rights of their clients - and this in a constantly-changing world. Eric Schmidt, Chairman and CEO of Google, was once quoted as saying that the internet is "the first thing that humanity has built that humanity doesn't understand, the

4 Article 1, Section 8, Clause 8 of the *United States Constitution*, which gives Congress the power "to promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries".

5 *ELVH, Inc v Nike, Inc* CV09-04219 CAS (CD Cal 2009).

6 *Arsenal FC v Reed* 2003 3 All ER 865.

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

largest experiment in anarchy that we have ever had". The world-wide web and rapid technological advances in the digital age have in fact opened the floodgates for IP infringement to occur - on a previously unimagined scale. James Boyle, in his seminal work, refers to it as the "Internet Threat".[8] In the light of these and other challenges to IP rights, it was quite natural to consider IP lawyers as, generally, being the good guys, and an elite squad of knights in shining armour - white-collar experts who deal with a branch of law that is somehow elevated above the normal hum-drum of the more run-of-the-mill general legal practice.

As with so many things in life, however, a little experience will usually serve to dash the idealism of our youth, and the closer one gets to the objects of one's hero worship, the more easily one sees the chinks in the armour and the feet of clay. Today I have a slightly more jaded view of the IP-law industry and of the tactics sometimes employed by IP rights' holders and their legal advisors in order to mercilessly squash the other guy in what often amounts to David vs Goliath-like litigation or legal posturing. In this regard, this article will examine what has become known in the United States[9] and elsewhere as "trademark bullying" (or "trademark extortion") and the generally overly-aggressive rights' enforcement measures. It will also attempt to pose some warnings to IP lawyers - of the dangers of ill-considered use of the sometimes blunt instrument of the law in the real world in which we live.

I recently wrote a book about ambush marketing of sports' mega-events and the ways in which laws in various countries are abused in order to protect the commercial rights (including the IP) of event organisers and multinational corporate sponsors of such events.[10] The fight against ambush marketing[11] is one area where

8 Boyle *Public Domain* ch 4.

9 I will, in footnote references and sources referred to, rely heavily on American material on the subject - mainly because the subject has received the most extensive and detailed airing in United States case law and academic writing (and in secondary sources such as internet blogs within legal, marketing and other circles). At present there appears to be a dearth of material available on the subject in South Africa, and it is hoped that one can extrapolate useful lessons from the American jurisdiction for consumption and application in South Africa.

10 Louw *Ambush Marketing.*

11 Ambush marketing (in respect of events) can be defined, generally, as any unlawful attempt by a non-sponsor of such an event to associate its brand or product with the event without having paid for the privilege by means of a sponsorship contract. This may range from classic "association ambushes" (where the ambusher attempts to deceive the public into believing that it is an official

rights' holders have gone woefully overboard in terms of the aggressive enforcement of their rights (and even, sometimes, of imagined 'rights' that do not actually exist). Organisations such as FIFA (a serial offender) and, more recently, the London Organising Committee of the 2012 Olympic Games (a very impressive first-time offender), have gained notoriety for the often blatant lack of common sense displayed in respect of their perceived sense of their entitlement to enforce rights. These organisations are sometimes characterised as cheerfully steamrolling over the rights of others and of curbing free speech on an industrial scale - or of being "pedantic sabre-rattlers"[12] intent on spoiling the party for just about everyone when the Olympics or FIFA's World Cup are in town. Of course, the high-profile legal advisors to these organisations are rarely, if ever, actually intellectually challenged; not all such public displays of short-sightedness and lack of self-awareness are, in fact, short-sighted and unplanned. Sometimes the very public *faux pas* of apparently misplaced zeal - for example, the 'shock and awe' of rights-protection hit-squads which may, amongst many other duties, patrol a shiny new Olympic stadium armed with masking tape to cover the maker's name on toilets (yes, that actually happens) - may occur with a very definite legal strategy in mind.

Whatever the motive, overly-aggressive efforts at enforcing rights have consequences, and I hope to deal with some of these in this piece. The object will be to suggest some pause for reflection amongst IP lawyers, and for serious consideration of the words of an internationally-renowned IP law expert: "Possessing a right does not mean that it is a good idea to enforce it always, and to the hilt. Discretion may be nine parts of possession".[13] I will start, in the next section, by providing some prominent, recent examples of trademark bullying or overly-aggressive enforcement (*how* it's done). These examples are mainly from other

sponsor - possibly by misappropriation of the event organiser's or official sponsor's IP - to the modern-day "intrusion ambush" (whereby laws have been fashioned to prohibit "ambushers" from intruding on the publicity value of the event, for example through the means of event-related advertising, without having paid official sponsorship fees, even in the absence of any attempt to claim or form any kind of association with the event other than merely "intruding" on its publicity).

12 From a posting on American marketing guru Kim Skildum-Reid's weblog at Skildum-Reid 2010 powersponsorship.com.

13 From an address presented by David Vaver, Reuters Professor of Intellectual Property and Information Technology Law, Oxford University, at the Victoria University of Wellington, 30 August 2000 (Vaver 2001 kirra.austlii.edu.au).

jurisdictions, although the reader will note that South Africa is no stranger to such conduct. I will then (in section 3) examine why lawyers and rights' holders engage in such conduct (*why* it's done), and start to deal briefly with some of the legal implications. In a future article I will examine the legal aspects of trademark bullying in much more detail. I will consider its legitimacy within the context of IP law, more generally, and some other areas of law, more specifically. The future article will conclude with some suggestions for dealing with overly aggressive enforcement strategies, including the possibility of legislative intervention by the relevant authorities in order to discourage lawyers' recourse to it, and to provide remedies for the targets of unfair bullying. For now, however, let's share a chuckle about some of the ways in which some well-known IP rights holders (and others) have recently managed to very publicly shoot themselves in their collective foot - by playing hard-ball, when they should probably have just 'chilled' a little.

2 *How* do they do it?

American singer and actress Barbra Streisand is an icon of the Hollywood entertainment industry. She is, of course, best known for her singing and acting abilities (fittingly, for present purposes, she was nominated for a Golden Globe award for her role in the 1987 film *Nuts*).[14] The star has in recent years, however - as a result of her apparently fanatical obsession with the protection of her privacy - also been synonymous with something which has been coined the "Streisand effect". This term was created to describe the phenomenon where an attempt to hide or remove information from public view has the unintended consequence of only publicising the information more widely. It derived from Ms Streisand's unsuccessful attempts, in 2003, to sue photographer Kenneth Adelman for USD 50 million. She had wanted an aerial photograph of her palatial Malibu mansion removed from a collection of 12 000 California-coastline photographs available on a website (which was aimed, in the public interest, at documenting coastal soil erosion). Before Streisand filed the lawsuit, the image of her house had been viewed only six times (five of those views were apparently by Streisand, her lawyer and her neighbour). As

[14] Directed by Martin Ritt (Warner Bros).

a result of the lawsuit, however, public knowledge of the photograph increased to such an extent that about half a million persons visited the website over the following month.

The Streisand effect has not only featured in the wacky world of the often ludicrous modern-celebrity industry (where, for example, attempts by the Church of Scientology in 2008 to bury an embarrassing video of well-known convert Tom Cruise also led to the video going viral online). Some of the silly things celebrities do that get tongues wagging are undoubtedly finely orchestrated, and very deliberate; in this industry there is probably no such thing as bad publicity. If you're a Kardashian or a similar creature, you are - to mangle the lyrics of a Dean Martin song - nobody unless somebody talks about you. Beyond these quarters, however, the Streisand effect has come to assume an important role in public relations and marketing circles, whenever attempts to suppress information become bigger news than the actual information itself. It has even occurred in politics, as Bill Clinton's protracted (and painful to watch) PR wrestling act in "Monicagate" attests. Closer to home, and more recently, our president's (and the ANC's) response to *The Spear* painting comes to mind. In short, the term often aptly describes the consequences of knee-jerk reaction and a lack of forethought in respect of the potential negative public relations effects of heavy-handed responses. This is especially the case in the digital age, where Twitter and Facebook won't allow those guilty of such obtuse conduct to escape attention for long. This kind of story tends to 'trend', and is fodder for re-tweeting. While the dreaded piece of information one attempts to conceal might deliver only a few obscure results in a Google search, news of the subsequent misplaced efforts at obfuscation may lead to the creation of pages and pages of embarrassing new search results. Sometimes no amount of high-priced spin-doctoring after the fact can put Humpty Dumpty back together again. Just ask Lance Armstrong.[15]

[15] It is interesting, for present purposes, to note that Armstrong's well-known Livestrong Cancer foundation (with which he had to sever all ties following the denouncement of his doping charges in late 2012) has consistently been atop the list of the leading trademark bullies in the United States in recent years. It was reported, for example, that the foundation's legal costs (used primarily to fund trademark litigation) amounted, in 2010, to approximately USD 460 000.

The Streisand effect, however, presents not only in cases where there are attempts to hide potentially embarrassing information from the public eye. It also features in legal circles, in instances where rights holders (and IP rights holders are prominent in this regard) attempt to enforce their rights in circumstances or ways by which the enforcement efforts serve only to embarrass the rights holder. Here, the potential infringer is often left painted as an unfortunate victim of corporate or legal bullying, and someone worthy of positive public sentiment.

2.1 Examples of overly-aggressive (IP) rights enforcement

World-football governing body FIFA must surely be closely associated with the Streisand effect in the minds of South Africans. FIFA does not often tread lightly, but it does love to carry a very big stick. Few of us will forget the events of the first week of the 2010 FIFA World Cup, when a bevy of beauties in little orange dresses (some of them Dutch nationals) were not only evicted from the Soccer City stadium in a first-round match between the Netherlands and Denmark, but were also arrested by the SA Police Services, questioned for hours at nearby FIFA offices, and, allegedly, even threatened with getting shot if they tried to escape. FIFA, the author of this most disproportionate of responses, accused the young ladies of perpetrating an ambush-marketing campaign on behalf of non-World Cup sponsor Bavaria breweries, at the cost of FIFA's multi-million dollar partner Anheuser-Busch. These events led to a potential diplomatic row between the South African and Dutch governments, with Dutch Foreign Minister Maxime Verhagen characterising the arrests as 'disproportionate and not correct'. It also - not surprisingly to most right-minded persons - led to a huge public outcry on the internet and elsewhere over FIFA's aggressive anti-ambushing tactics, and boosted interest from all over the world in Bavaria beer. Some observed that the event organiser, who controlled the television broadcast of the match, could easily have ensured that cameras in the stadium did not pan over the orange-clad young ladies, which would have left the whole stunt as little more than a pleasant memory for a few hundred fans who may have noticed the presence of the boisterous young ladies in the stands. Instead, the

"Bavaria babes" made worldwide headlines, and will likely serve for some time as an object lesson in ambush-marketing lore.

What made the apparent stupidity of FIFA's conduct in this case even more mystifying was that it had just experienced the Streisand effect following its efforts - through cease-and-desist letters - to muzzle local budget airline Kulula's tongue-in-cheek ad campaign (most of us will probably remember the cheeky "Official National Carrier of the 'You-Know-What'" ad, and the follow-up "Not next year, not last year, but somewhere in between" reference to 2010). Kulula milked FIFA's self-created controversy with a Facebook campaign which offered FIFA's president, Sepp Blatter - by way of an "apology" - free flights during the World Cup. Inevitably, a shrewd bloke from Cape Town saw the gap, re-named his Boston terrier "Sepp Blatter", and managed to grab a free seat for the little mongrel. Kulula was only too happy to oblige - having scored such a phenomenal publicity bonanza at the cost of a spectacular FIFA own goal.

Of course, not everyone quite gets the point of such lessons about the perils of overly-aggressive enforcement. For example, the run-up to the 2012 London Olympic Games saw widespread unhappiness expressed in UK media reports and online chatter over the brash commercialism of the Games and the apparently thoughtless efforts of the organising committee, LOCOG, to enforce the rights of its large corporate sponsors and to protect its controversial "association right" to the event.[16] In the same week that it was announced that more than 300 "brand police" would be deployed to scour the streets of London for unsanctioned marketing - remember that this was at a time when the official security-service provider had dropped the ball and members of the defence force had to be deployed to stop the gaps just to ensure sufficient "normal" event security - Lord Sebastian Coe (the eminent chairman of LOCOG) was recorded on a talk show as saying that spectators who turned up at an Olympic event wearing a Pepsi t-shirt or Nike shoes would be shown the door (Coca-Cola and Adidas were official sponsors). Even though Lord

[16] As per s 1(2) of Schedule 4 of the *London Olympic Games and Paralympic Games Act*, 2006 (which received Royal Assent on 30 March 2006).

Coe made the compulsory claims of having been misquoted (this after Joan Rivers apparently wanted him to join her *Fashion Police* show in the States), LOCOG was subsequently - and in true Streisand tradition - confronted with a savvy marketing campaign by discount wine retailer Oddbins. This, in protest against the 'perverse' marketing rules of the Games' organisers. Oddbins installed window displays in all of its 35 stores, advertising that anyone who entered an Oddbins store during the Games "wearing Nike trainers; carrying a set of Vauxhall car keys, an RBS MasterCard, an iPhone, a bill from British Gas or a receipt for a Pepsi bought at KFC" would receive 30 percent off their purchase. These brands, of course, were all competitors to the official London Olympics' sponsors. Point well made, I'd say.

Apart from Usain Bolt's impressive performances and Michael Phelps's legendary swan song, the London Games will also be remembered for providing a number of other examples of clever and cheeky marketing campaigns - as well as high-handed sponsor and organiser conduct which served to highlight the dangers of overly-aggressive commercialism and rights' protection. Here are just a few examples:

- McDonalds - no stranger to controversy (not least in the light of the fast food it peddles and its rather ill fit, as official sponsor, with the Olympic ideals of athleticism and good health) - was taken to task by the media for enforcing an apparent "chip monopoly". No fries could be served by any of the 800 food vendors at Olympic venues unless they came from McDonalds (with a Mickey D's Happy Meal or the like), or otherwise if they were served with fish in the great British "fish and chips" tradition. This was not well received, especially after all the earlier controversy about the fact that the only credit card accepted for the purchase of tickets, or just about anything else at the Games, was Visa. Those without cash in their pockets and only a MasterCard - and who complained - were apparently just told to "get one".

- A serial "ambusher", the sports-betting firm Paddy Power, had come up with a clever marketing ploy to circumvent the ridiculous London Games' commercial rights legislation, which prohibited just about everyone from using terms such as

"London" and "2012" in marketing. The weeks preceding the start of the Games saw the host city plastered with advertisements declaring Paddy Power to be the "official sponsor of the largest athletics event in London this year" (the London referred to, turned out to be a small town in France, and the athletics' event was an egg-and-spoon race sponsored by Paddy Power). This was met with a highly-publicised cease-and-desist letter from LOCOG, and an embarrassing subsequent u-turn by the organising committee when the betting firm threatened a legal challenge to LOCOG's efforts at censoring its advertising;

- LOCOG's earlier cease-and-desist letter to a London restaurant, Cafe Olympic, led to the owners dropping the O from their name, and "Cafe Lympic" received a lot of press around the time of the Games; and

- The Dorset sausage maker and a florist who had created window displays in the form of the Olympic Rings constructed from sausages and tissue paper respectively both withdrew their creations following receipt of those ubiquitous cease-and-desist letters from LOCOG - but then received repeated airing in the media.

There was also the rather ironic case of Robert Ronson, the British children's author, who in 2007 wrote a science-fiction book entitled *The Donovan Twins: Olympic Mind Games* about a 13-year-old boy who knows that the world is in danger from an alien invasion in 2012. He has to hide out in the safest place in the UK - London's Olympic Village - if he is to emerge from the shadow of his super-achieving twin sister and defeat the forces committed to the world's destruction. Methinks this sounds like quite an entertaining read, but apparently it was not quite the Olympics organising committee's cup of tea. LOCOG's brand manager reportedly sent Ronson an e-mail threatening legal action for copyright infringement over the use of the Olympic reference, although it was subsequently decided that it would be 'disproportionate' to prosecute the author. There is a saying about the road to hell being paved with good intentions, and Mr Ronson must now be a great believer in this. A furore arose after the author and his publisher decided - in the light of the Olympic connotations

of the work - to donate £1 from every book sold to a local sports' charity. When the charity queried the use of the word "Olympic", the LOCOG got involved. One blogger put things in perspective, observing that: "a simple search on Amazon proves that 4 305 books have been published with Olympic in the title, 103 DVDs, 34 video games and 179 music items. It appears that the Olympic team had been a little lax in enforcing its brand".[17] True to form, in cases of Ms Streisand's effect, the matter generated some publicity, and LOCOG must have rued their actions when faced with fall-out such as the following response by David Edgar, playwright and president of the Writer's Guild:[18]

> The email to Robert Ronson was written by the Olympic organising committee's manager of brand protection, concerned to "ensure that there was no confusion" as to whether the novel was "an official licenced product", presumably in case the committee seeks to declare Ian McEwan or Martin Amis official novelist to the 2012 Olympics at some point … By declaring images, titles and now words to be ownable brands, … various organisations and individuals are contributing to an increased commodification and thus privatisation of materials previously agreed to be in the public domain. For scientists, this constrains the use of public and published knowledge, up to and including the human genome. For artists, it implies that the only thing you can do with subject matter is to sell it. As a consequence, people's view of what representation does becomes narrowly literal … Consulted by its British branch about the Olympic Mind Games case, the International Olympic Committee expressed two major concerns: that the word Olympic was used in the title of a work of fiction and that 'there is no such thing as Olympic mind games'. Clearly, the IOC hasn't grasped what the word 'fiction' means. Most expression involves reference to something real in the world. Most of our 'experience' and indeed our 'imagination' are formed from the image-making of others. Writers and other artists are rightly concerned about protecting their own copyright, but they should be equally concerned with the shrinking of the public domain. Ronson's refusal to be cowed into changing the title of his novel is a victory for the idea that there is more to free expression than the right to advertise.

Sports mega-event lore of the past two decades is replete with such often entertaining examples of heavy-handed threats and aggressive enforcement efforts (FIFA, especially, seems to nearly always get it wrong). However, this is not the only context in which this takes place. In the United States many examples of alleged trademark bullying have been reported in recent years. I will not take up too much

17 See the blog posting at RIX 2007 wondering-mind.blogspot.com.
18 Edgar 2007 www.guardian.co.uk.

space here recounting these, and the reader is encouraged to search the internet for these often-entertaining examples of overkill by trademark lawyers.

The prevalence of aggressive IP enforcement and the use of the cease-and-desist letter mean that - in the United States, at least - this sometimes pops up in the strangest of contexts. A 2010 case in Florida highlighted the proliferation of trademark disputes and the always unwelcome C & D letter. This was in the collegiate context, between colleges and universities and schools (for example, over the use of nicknames and school logos such as the 'Seminoles' - logo of Florida State University).[19] And, while on the topic of universities, there's the case of fashion-powerhouse brand Louis Vuitton - no stranger to trademark litigation - which threatened a student group at the University of Pennsylvania Law School (the Penn Intellectual Property Group) with trademark-infringement litigation on the basis of an artwork parody reminiscent of Louis Vuitton's monogram mark, which was printed on the invitation to a fashion-law symposium at the Law School. Louis Vuitton's lawyers boldly declared that this "egregious action is not only a serious wilful infringement and knowingly dilutes the LV Trademarks, but also may mislead others into thinking that this type of unlawful activity is somehow 'legal' or constitutes 'fair use' because the Penn Intellectual Property Group is sponsoring a seminar on fashion law and 'must be experts'". The university's general legal counsel responded in a letter, which included not only an invitation for Louis Vuitton's lawyers to attend the symposium, but also succinctly explained how little trademark law these lawyers, apparently, actually knew. Maybe they should rather have been invited to attend some classes.

Another case - yet another example from the wide world of sports - involved the US Olympic Committee's cease-and-desist letter which was recently sent to a knitting-based social network, Ravelry - to force them to desist from hosting a knitting "Ravelympics". The online knitting community was in an uproar, with one blogger writing that "2 million knitters with pointy sticks are angry at the US Olympic Committee". USOC persisted, claiming federal-trademark infringement, and that the

19 See Newsom 2011 *BCL Rev* 1833.

Ravelympics made a mockery of the Olympic Games and "is disrespectful of our country's finest athletes and fails to recognise or appreciate their hard work". USOC was eventually forced into a public apology, twice. The media and internet users, of course, loved this. Hey, what's not to love?

Finally, and this is my personal favourite, there is a highly-publicised case on a more positive note - which probably shows how these things *should* be done. Legendary Tennessee whiskey-maker Jack Daniel's, recently got into a minor spat with the author of a book[20] over its cover design, which was clearly based on the iconic label design of the Jack Daniel's bottle. In a surprising development - which one blogger explained by observing that "you get more flies with Tennessee whiskey than you do with adversarial attorneys" - Jack Daniel's lawyers sent the author what has come to be known as "probably the nicest cease-and-desist that anyone has ever seen". Just take a peek at some of its content:

> We are certainly flattered by your affection for the brand, but while we can appreciate the pop culture appeal of Jack Daniel's, we also have to be diligent to ensure that the Jack Daniel's trademarks are used correctly. Given the brand's popularity, it will probably come as no surprise that we come across designs like this on a regular basis. What may not be so apparent, however, is that if we allow uses like this one, we run the very real risk that our trademark will be weakened. As a fan of the brand, I'm sure that is not something you intended or would like to see happen ... In order to resolve this matter, because you are both a Louisville 'neighbour' and a fan of the brand, we simply request that you change the cover design when the book is re-printed. If you would be willing to change the design sooner than that (including on the digital version), we would be willing to contribute a reasonable amount towards the costs of doing so. By taking this step, you will help us to ensure that the Jack Daniel's brand will mean as much to future generations as it does today.

Such common sense and decency is, however, not frequently to be found when it comes to trademark enforcement. And, even worse, we unfortunately cannot just attribute the problem to those often-maligned and notoriously litigious "damn Yankees". South Africa saw a recent case in June 2012, when a veteran local marketing expert ended up calling the world's biggest soft-drink manufacturer the

[20] Wensink *Broken Piano for President*.

"Coca-Cola Cry-Baby".[21] This arose from Coca-Cola South Africa's response to a marketing ploy of a "competitor" that enjoys less than one percent of the soft-drink giant's capitalisation. Even worse in our modern PC world, it involved a cuddly, tree-hugging environmental campaign.

SodaStream - the Israeli company that sells home-carbonation equipment and the ingredients for consumers to make their own soda drinks (and which employs the funky catchphrase "Get busy with the fizzy!") - has for some time now been running an eco-campaign aimed at informing consumers about waste management. The company has used displays at airports and other venues across the world, using "The Cage" - a display made up of glass cages filled with thousands of discarded soda cans and bottles, and indicating the amount of waste of this kind generated by an average family over several years. These displays had, apparently, caused barely a ripple elsewhere (they have been employed in more than thirty countries) - and had not invoked the ire of the big boys in the soda world - until SodaStream brought its display to the O R Tambo airport in Johannesburg. Some pedant connected to Coca-Cola noticed that - in amongst the other junk - a number of discarded Coke, Sprite and Fanta cans and bottles were on display. Lo and behold, it was not long before Coca-Cola's South African IP law team (quite a prominent firm on the local scene) sent a cease-and-desist letter[22] to SodaStream, claiming infringement of Coke's trademarks and that Coca-Cola was being subjected to disparaging advertising. The matter garnered significant media exposure, with some pundits questioning the fact that Coca-Cola had expressed no concerns about these displays elsewhere (including in Chicago and New York), and that it seemed as if the company was trying to bully SodaStream in the 'quiet backwater' of South Africa. As one report noted: "The idea of claiming the trademark integrity of trash - regardless of its legal merits - just won't play well with ordinary consumers already predisposed to root for the underdog".[23] Others remarked on the irony of the situation - in the light of Coca-Cola's long-reported reticence to get involved in steps to deal with all

21 See Moerdyk 2012 www.bizcommunity.com.

22 Incidentally, the original letter was subsequently posted online by someone and is (at the time of writing) available to be viewed at Adams & Adams 2012 imgur.com.

23 Vinjamuri 2012 www.forbes.com.

the waste its bottles and cans creates. Daniel Birnbaum, CEO of SodaStream, put it well when he remarked, as follows:

> We think it is absolutely ridiculous. If they claim to have rights to their garbage then they should truly own their garbage and clean it up. Instead of getting a thank you for cleaning up, we get a lawyer's letter.

SodaStream, of course (much like Kulula and Bavaria back in 2010), could not buy the type and level of publicity that Coke's actions had created, and the company subsequently promised to erect one of its cage displays in Atlanta, Georgia - outside Coca-Cola's world headquarters.

There are countless more examples of the Streisand effect at work in the context of aggressive rights enforcement, and of trademark bullying by IP rights holders from around the world. While there are many facets to this issue which deserve closer attention, one important feature is the ability of the perpetrators of trademark bullying to ply their trade outside the courts - and as one American commentator has framed it - within "the shadows of IP law". Bullying occurs through the means of extra-judicial power plays, of threats of liability, and of the potential incurring of often prohibitive legal costs. In the context of anti-ambush marketing laws - especially the strong *sui generis* legislation which in recent years has created "association rights" to events in the UK, Canada, New Zealand, South Africa and Brazil) - a frequent problem is the broad powers and authority placed in the hands of private (and commercially-driven) entities and the local organising committees of events to determine whether or not 'infringements' have occurred. Rarely, if ever, do claims of alleged infringement reach a forum where a knowledgeable (and impartial) judge can pronounce on the merits of the case. It is in this extra-judicial setting that the Streisand effect may serve as a deterrent for aggressive enforcers - namely a means by which such enforcers may be shamed in the court of public opinion.[24]

[24] In the United States, trademark bullying has reached such prominence in public discourse that entities have been established to record instances and to publicly name and shame those responsible. An example is Chilling Effects Clearinghouse (Chilling Effects Clearinghouse Date Unknown www.chillingeffects.org), a joint project of the Electronic Frontier Foundation and Harvard, Stanford, Berkeley, University of San Francisco, University of Maine, George

However, the cease-and-desist letter can also have a very definite and significant chilling effect, and often blatant cases of rights holder over-reach never even reach the court of public opinion.[25]

2.2 How the law is used to bully would-be 'infringers'

So, in order to evaluate the implications of aggressive rights-enforcement practices, let us examine how legal processes are used for this purpose. Irina Manta succinctly explains what is meant by the term "trademark bullying", in the American context:[26]

> Simply stated, a trademark bully is usually a large company that seeks to put an end to behavior by individuals and small businesses that it perceives as a danger to its own intellectual property even though its legal claims against these other parties are spurious or non-existent. The bully puts its opponents under pressure through cease and desist (C & D) letters in which it demands that the opponent stop using a certain trademark that it believes resembles its own and threatens legal sanctions if the C & D demands are not met. These letters frequently do not contain detailed explanations of the alleged infringement but instead are intended to intimidate recipients into submission through the use of vague claims masked in legalese and are sent by lawyers who pressure recipients into providing a fast response. Individuals and small businesses often capitulate rather than face a harrowing legal battle that could bring them to the brink of financial destruction.

Of course, it is not only through the means of the ubiquitous cease-and-desist letter that such bullying may occur. Kenneth Port, in a provocative 2008 article which examined thousands of trademark-infringement cases in the United States,[27] explains that IP rights' holders often also go further than the letter of demand, and may use a combination of measures. These - which the author calls "trademark extortion" - may be used at the cease-and-desist stage, at the litigation stage (which

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Washington School of Law, and Santa Clara University School of Law clinics. This site actively compiles a database of cease-and-desist letters alleging trademark rights violations.

25 McGeveran - in the context of trademark infringement claims as a muzzle on free speech -states: "We need not devote too much energy to improving the courts' ability to reach the correct substantive outcomes in the final judgment at the end of a lawsuit. They already do. Rather, the priority should be restructuring the relevant doctrines to reduce the pre-litigation chilling effect." (McGeveran 2008 *Fordham Intell Prop Media & Ent LJ* 1207).

26 Manta 2012 *Fordham Intell Prop Media & Ent LJ* 854-855.

27 Port 2008 *Wash & Lee L Rev*.

conduct includes the use of "strike suits"), and at the registration stage (ie through objections to the registration of trademarks, in order to achieve the same results):[28]

> [Strike suits] are law suits and, in the trademark context, cease and desist letters that have a different objective than to merely stop the use or conduct of the would-be defendant. Their objective is to raise the cost of market entrance or continuation for the competitor. One result of this conduct is that a small fraction of all law suits filed actually reach trial ... This strike suit conduct is also prevalent in the registration stage of the trademark before the Patent and Trademark Office (PTO). In this case, a trademark holder objects to the registration of a mark. The objection is based on the idea that the trademark holder has to plow a wide path through commerce in the United States. The wider this path is, the better it is for the existing trademark holder - better in the sense that the more third parties acquiesce to its use, the stronger the mark becomes. As the trademark holder plows this wide swath through American commerce … the trademark holder's mark becomes that much more distinctive and strong. As this conduct occurs, gradually, but assuredly, the actual scope of protection of the trademark broadens. As the trademark scope broadens, the mark becomes more distinctive. As it becomes more distinctive, it becomes more likely that a skilled litigant will be able to argue that it has become famous. Once famous, it becomes subject to protection from dilution. Once a mark is protected from dilution, it has reached the zenith of its power to exclude others, regardless of whether the goods in connection with which the marks are used are in competition. That is, once the mark becomes famous and eligible for dilution protection, competition no longer is relevant. This is the holder's intended life cycle of trademarks.

The problem has reached such a level of prominence in the United States that in March 2010 President Obama signed the *Trademark Technical and Conforming Amendment Act* of 2010 into law as Public Law 111-146. The new law tasked the Department of Commerce, in consultation with the Intellectual Property Enforcement Coordinator (IPEC), to study the extent to which small businesses may be harmed by abusive trademark-enforcement tactics.[29] The statute defined the target of the proposed investigation in a manner that includes a definition of trademark bullying, namely "the extent to which small businesses may be harmed by *litigation tactics the purpose of which is to enforce trademark rights beyond a reasonable interpretation of the scope of the rights granted to the trademark owner*" [my emphasis].[30] The Congressional study commissioned in terms of the Act defines trademark bullying as

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28 Port 2008 *Wash & Lee L Rev* 589-591.

29 The eventual Department of Commerce report has, however, been heavily criticised for its alleged one-sided and superficial study of the problems of trademark bullying. See, for example, Goldman 2011 blog.ericgoldman.org. See also Masnick 2011 www.techdirt.com.

30 Section 4(a)(1) of the *Trademark Technical and Conforming Amendment Act*, 2010.

"a trademark owner that uses its trademark rights to harass and intimidate another business beyond what the law might be reasonably interpreted to allow".[31] Accordingly, in Minnesota the state legislature tabled a Bill for the enactment of the *Minnesota Small Business Trademark Protection Act* in 2011.[32] The Bill contains a definition of trademark bullying that is identical to that found in the above-mentioned *Trademark Technical and Conforming Amendment Act* of 2010.[33]

Bullying may take a variety of forms. For example, Michael Meurer distinguishes between anti-competitive lawsuits (which are filed "to impair the defendant's performance in their shared market or even to exclude the defendant from the market completely") and opportunistic lawsuits ("seeking a settlement payment")[34] - which distinction is based on the plaintiff's motive and the relationship within a market between plaintiff and defendant. The gist of determining from the above definitions whether threats or law suits amount to bullying seems to revolve around a reasonable interpretation of trademark holders' rights - a sticky question in practice, I'm sure.[35] Grinvald (who discusses trademark bullying in the specific context of cases involving large corporations versus small businesses) suggests that "an unreasonable interpretation of trademark rights occurs when large corporations do one or more of the following: (1) do not conduct a complete and objective assessment of the third party's trademark and/or use of the trademark, (2) exaggerate the strength of their trademark, or (3) exaggerate the extent to which confusion is likely".[36] Some guidance may also be found in the advice Walters offers to trademark holders in considering whether to pursue legal action, which focuses on the issue of potential consumer confusion.[37]

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31 Walters 2012 *Intellectual Property Magazine* 46.

32 For the amendment of Minnesota Statutes 2010, section 333.18.

33 It should be noted that the Minnesota Bill has since undergone a radical redrafting in respect of its suggested remedies or means of combating trademark bullying, and it is unclear whether or in what form the Bill will eventually be passed into law.

34 Meurer 2003 *BCL Rev* 512.

35 In the soon to be completed follow-up article to this piece, I will suggest a test for the identification of illegitimate bullying, along with a number of factors to be considered in determining whether such bullying is present in any given case. I will attempt to add a more nuanced consideration of issues beyond a "reasonable interpretation" of the trademark owner's rights.

36 Grinvald 2011 *Wis L Rev* 643.

37 Walters 2012 *Intellectual Property Magazine* 47 declares the following to be a useful test: "Since trademark infringement is based on likelihood of confusion, if there is no way that consumers

Some even clearer advice (this nugget comes with a picture) comes from some other recent commentators. They suggest the following to be considered by would-be trademark enforcers, in order to ensure proportionality in their response and to avoid the moniker of "bully":[38]

> The policing response ought to be proportional to the actual threat to the brand. It may be helpful to think of trade mark rights as a collection of concentric circles, like a bull's eye. The innermost circle represents the exact trade mark and its associated goods and services - the absolute exclusive zone. Any third party trying to occupy that space poses the greatest risk, and the enforcement strategy should be tailored accordingly. Direct and apparently wilful infringement that inflicts damage to a brand may call for aggressive enforcement actions. However, the further away an alleged infringer is from the centre (for example, the mark or the goods and services are less similar), the lower the risk may be and the lighter the touch required to avoid the trade-mark bully label.

This seems to be good advice, although, of course, the expansion of trademark law to cover dilution means that many trademark owners who may (also mistakenly) view their marks as famous or well-known will baulk at drawing the line only at the likelihood of consumer confusion. The development of trademark dilution doctrine in the various jurisdictions has in fact been a key factor in the ever-increasing proliferation of illegitimate bullying tactics.[39] The expansion of the scope of trademark protection seems to provide fertile soil for rights holders to perceive a concomitant expansion of the potential scope of infringement.[40]

It should also be noted that spotting a bully may not be restricted to requiring consideration of the objective substantive merits of the alleged claim or the purported right(s) allegedly infringed; some suggest that even meritorious claims to

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could be confused about two products or services, or the source of two products or services, then the corporation risks stepping into trademark bullying territory."

38 Boudett, Kluft and Rufo 2012 *Managing Intellectual Property* 48-51.

39 In discussing dilution as one of the reasons for the proliferation of bullying, Grinvald refers to "the Fame Monster", and explains how the trademark owner's "duty to police" may be implicated: "This ability to claim fame in pre-litigation settings, such as in cease-and-desist letters, has provided trademark owners with hefty ammunition. In addition, these benefits that accrue to strong or famous trademarks, and the ability to lose such rights, have incentivized trademark owners aspiring to such status and expanded protection to increase their policing efforts." (Grinvald 2011 *Wis L Rev* 639-640).

40 Which I will examine in more detail in a follow-up article.

legal remedies may cross the line when pursued through the means of overly-aggressive litigation strategies or tactics. American IP lawyer Eric Pelton suggests that both the merits of a potential claim of infringement as well as the enforcement tactics should be considered in such cases:[41]

> I look at two factors to assess whether a 'bullying' label is appropriate: whether the claim is over-reaching and whether the tactics are heavy handed. Over-reaching occurs when the alleged infringer [of a trademark] is really making no commercial impact on the enforcer. For example, when the alleged infringer's use is trivial; their industry or market or products or services are quite different; or there are already tons of third party uses of similar marks and the claim has no merit. Bullying tactics include unreasonably demanding letters, such as: 'respond that you are in compliance with all of our demands within 48 hours.' Or seeking discovery that is overly burdensome and irrelevant just to run up costs for the other party. Or failing to seek a compromise that accomplishes the goal of avoiding confusion or dilution before litigating.

Pelton suggests a formula to identify illegitimate bullying. Thus, to determine whether a company is a trademark bully one applies the following function: "[strength/weakness of claim's merits] x [harshness of legal tactics used]".[42] All of these attempted definitions of bullying have merit and bear consideration as a test to be used by courts in determining whether a plaintiff is over-reaching. It may, however, be very difficult to compile a meaningful and universal test or benchmark for this determination, although the following broad considerations could be used (in the case of actual lawsuits):[43]

> A lawsuit is weak if the objective probability of successfully proving infringement is low at the time of filing. The probability of success is evaluated using the knowledge of a hypothetical plaintiff who files after conducting a reasonable investigation. The probability of success may be low because the right asserted likely does not cover the defendant's behavior or because the right is unlikely to be valid. A weak lawsuit is anti-competitive if the defendant's alleged infringing behavior occurs in a market the plaintiff participates in or intends to enter; otherwise, a weak lawsuit is opportunistic.

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41 From a posting (dated 20 September 2012) on Pelton's IP law blog at Pelton 2012 www.erikpelton.com.

42 Pelton suggests that even the arguably prudent and well-mannered Jack Daniel's response to the alleged infringement by means of a book cover of their bottle label design (in the example referred to earlier in the text) may have crossed the line, because they asked the author with extreme courtesy and made no "demands" - "but arguably they were still bullying because the law gives them no actual right to force [the book's author] to change the cover".

43 Meurer 2003 *BCL Rev* 512.

There seems currently to be (in the United States, at least) a measure of uncertainty as to an acceptable definition for illegitimate trademark bullying. The above definition, which is contained in the federal statute of 2010, and that contained in the Minnesota Bill (namely "litigation tactics the purpose of which is to enforce trademark rights beyond a reasonable interpretation of the scope of the rights granted to the trademark owner") have been criticised because of their use of a reasonableness standard rather than a higher standard of culpability, which would justify the pejorative label of "bully".[44] I will revisit later the question of identifying the presence of illegitimate trademark bullying in the light of the relevant characteristics.

One important factor, however, which I do believe should be considered in respect of harsh or unreasonable threats or litigation tactics is the issue of the alleged infringer's access to legal assistance. In the South African context, this may be especially relevant when considering the plight of small businesses or individuals - especially those from previously-disadvantaged communities, who may for various reasons not have access to a ready source of meaningful (and affordable) legal assistance, or, even more worryingly, may not have the wherewithal to even consider any active steps to counter threats made by wealthy and powerful corporate clients through legalese deriving from large IP or other law firms. In such scenarios, a harsh cease-and-desist letter may have a significant, chilling effect on free speech and freedom of trade. Leah Grinvald has identified the potential impact of bullying on small businesses in the American context, and I would suggest that her concerns are as apt in respect of the potential harm to small businesses in South Africa (and especially small businesses operated by often unsophisticated, previously-disadvantaged entrepreneurs):[45]

> One of the harms produced by bullying is that economic competition is impaired. In particular, small businesses and individuals are more adversely affected, as these victims do not have the wherewithal to fight legal battles. While changing or ceasing to use the trademark at stake without a battle may seem to be the least expensive option, altering a trademark (especially if it is also the business's name)

44 See Baird 2013 www.minnpost.com.
45 Grinvald 2011 *Wis L Rev* 630-631.

> can be an expensive proposition. In addition, it is not merely a change in trademark that the bully demands, but also a cessation of sales of goods bearing the trademark, along with any marketing materials, and, further, the delivery of the remaining products bearing the trademark to the bully (presumably for destruction), along with an accounting of past profits. For a small business, the destruction of inventory and the payment of a licensing fee may push the business into bankruptcy, which reduces the potential for competition for the bully. Even for individuals with no commercial interest at stake, complying with a cease-and-desist letter can still be expensive, as some letters demand payment of attorney's fees even if the recipient agrees to cease in its use of the trademark.

I will revisit later both the potential implications for free speech as well as the issue of the inequalities that are often so prevalent in bullying cases. This will be with specific reference to the South African constitutional dispensation and its relevance in this regard.

I have not conducted an intensive historical study of IP litigation trends in South Africa. I do not know the exact number of IP cases (including, for present purposes, particularly trademark and copyright matters) that habitually take up the attention of lawyers in South Africa. Usually not many such cases reach our courts - at least relative to the numbers of cases in other mainstream legal disciplines. This seems to be par for the course when compared to the United States, where only approximately 1.5 percent of all trademark cases filed ever reach trial, and the majority are disposed of before the cases reach the pre-trial phase.[46] However, I believe it would be fairly accurate to say that South African IP lawyers, *per capita*, probably do not engage in significantly less "demand letter lawyering"[47] than their counterparts in other jurisdictions. Also, it should be noted that one of the most prominent recent IP law cases in South Africa - which eventually proceeded all the

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46 See *Report to Congress: Trademark Litigation Tactics and Federal Government Services to Protect Trademarks and Prevent Counterfeiting*, April 2011 (report by the Secretary of Commerce in terms of s. 2968, Trademark Technical and Conforming Amendment Act, 2010 (Public Law 111-146)) 15.

47 This *modus operandi* was recently described as follows in an article which presents the results of a qualitative study on IP-enforcement tactics undertaken amongst IP lawyers in California: "The first step in enforcing most trademark and copyright claims is to contact the target, assert those claims, and make a demand. All of the interviewed lawyers identified "cease and desist" letters as an important tool in their enforcement practices. These letters were described as the "opening salvo" that both begins the disputing process and sets the tone for the anticipated ensuing negotiations in almost all cases. This process is typically conducted primarily by letter and telephone, and most of the lawyers expect that almost all of these disputes will result in a negotiated settlement." Gallagher 2012 *Santa Clara Computer & High Tech LJ* 482.

way to the Constitutional Court - involved a scenario strongly reminiscent of trademark bullying, and also of the potential application of the Streisand effect to its facts.[48] In fact, this was expressly recognised by Sachs J in this case:[49]

> [O]ne must recognise that litigation could be a risky enterprise for a meritorious trademark owner as well as the prankster. Applicants seeking to interdict the abusive use of their trademarks stand to be involved in lengthy litigation in which every manner of accusation could be made against them by persons from whom no costs could ultimately be recovered. Furthermore, any businesses seen as trying to block free speech could hardly be surprised if the media tended to champion their opponent's cause. Indeed, the very act of invoking the heavy machinery of the law might be regarded as being in conflict with the image of freedom, liveliness and good cheer associated with their product brand. Thus, in the present matter simply bringing the proceedings … risked being more tarnishing of [the beer brand's] association with bonhomie and cheerfulness than the sale of 200 T-shirts could ever have done. The principle of litigator beware, however, faces any person contemplating legal action.

It is therefore apt to consider more closely the phenomenon of trademark bullying in the hopes that some lessons may be posed for consideration by South African IP lawyers and the legislature at a time when a significant (although, to date, controversial) overhaul of the country's IP law statutes is on the cards. Before I consider the possible ways to deal with the problem, however, let us first consider the reasons why IP rights holders (and their legal advisors) engage in such conduct.

3 *Why* do they do it?

There does not seem to be an obvious answer to the above question, and the reasons for rights holders and their legal advisors engaging in bullying tactics would appear to be myriad. In my rather cursory consideration of the issues I have arrived at two relatively legitimate (or shall I say understandable) reasons for trademark bullying, and ten reasons that are much more open to debate - as to their legitimacy and legality. First, let us briefly consider the 'legitimate' reasons.

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48 *Laugh It Off Promotions CC v South African Breweries International (Finance) BV t/a Sabmark International* 2006 1 SA 144 (CC).

49 *Laugh It Off Promotions CC v South African Breweries International (Finance) BV t/a Sabmark International* 2006 1 SA 144 (CC) para 104.

Some have observed that the very nature of IP allows for such over-zealous enforcement practices and strategies, and may serve as encouragement for rights holders on occasion to misbehave in order to selfishly pursue their self-interest:[50]

> Intellectual property (IP) law effectively stimulates the creation and distribution of information and information-rich products that are vital to economic growth and well-being. Unfortunately, it also promotes harmful rent-seeking by owners of IP rights who undertake opportunistic and anti-competitive lawsuits. Some IP owners value their property rights chiefly as 'tickets' into court that give them a credible threat to sue vulnerable IP users. Socially harmful IP litigation is common because the rights are easy to get and potentially apply quite broadly, and the problem is growing worse because of the expansion of the scope and strength of IP law.

The second reason - potentially more legitimate and less depressing to consider - why rights holders may choose to pursue overly-aggressive litigation or other rights enforcement tactics is, of course, that protecting a trademark and policing potentially infringing use or conduct by others is a natural function of trademark laws and trademark rights. In fact, a pattern of failure to take action against potential infringers will in most jurisdictions constitute grounds for striking out a registered mark on the basis of non-use, or may lead to dilution, tarnishment or blurring of such a mark. As it was succinctly put in a recent report to the US Congress on trademark litigation (compiled in terms of the above-mentioned *Trademark Technical and Conforming Amendment Act* of 2010), by the US Secretary of Commerce:[51]

> Trademark owners have a legal right and an affirmative obligation to protect their trademark assets from misuse. If the owner does not proactively police the relevant market and enforce its rights against violators, the strength of the mark, the owner's ability to exclude others from using the same or similar marks in the marketplace, and the value of the asset all will diminish. Failure to take action may result in consumers being confused or deceived as to the source or sponsorship of goods or services, harm to the owner's reputation, and lost sales. A trademark owner is not required to object to all unauthorized uses that might conflict, for not every third-party use poses the same risk of eroding distinctiveness in the

50 Meurer 2003 *BCL Rev* 509-510. It should be noted, however, that one should be careful not to generalise in this regard, as some forms of IP as recognised by law specifically encompass protection against unfounded threats by IP holders.

51 Report to Congress: Trademark Litigation Tactics and Federal Government Services to Protect Trademarks and Prevent Counterfeiting, April 2011 (report by the Secretary of Commerce in terms of s. 2968, Trademark Technical and Conforming Amendment Act, 2010 (Public Law 111-146)) 7.

> marketplace. However, widespread unauthorized uses may cause the mark to lose its trademark significance altogether and fall into the public domain. Thus, diligent enforcement of trademark rights is necessary to help prevent others from unfairly trading off the mark owner's goodwill and reputation and to protect the public from mistakenly believing that the mark owner authorizes, endorses, sponsors, or is somehow affiliated with another business.

Similar rationales apply also in respect of trademark licensing, and may sway the licensor to bully perceived infringers (or licensees) in order to avoid "naked licensing". This is where a mark could be deemed to have been abandoned upon evidence of a failure to exert control over the quality of the goods with which a licensee is associating the licensor's goodwill.[52] One is reminded of the sentiments expressed more than thirty years ago by an American commentator:[53]

> [T]rademark proprietors and their lawyers are sometimes forced into unwelcome police actions on behalf of their marks by the realistic concern that inaction can lead to a weakened mark or even to its loss. The truth is, I am afraid, that overreaching claims are virtually synonymous with sound trademark management.

It should be noted, however, that the above-mentioned report to Congress by the US Department of Commerce on trademark bullying has been heavily criticised. One specific aspect that has attracted criticism is that the report did not sufficiently interrogate the trademark holder's "duty to police", and that the importance of this "duty" may often be overstated:[54]

> [The "duty to police"] is an issue that is regularly raised whenever we talk about trademarks, where people claim that you *have* to enforce your trademark or you can lose it ... [T]hat's a bastardization of what the law and case law seem to actually say. It's only true that you need to enforce it in situations where there's an actual likelihood of confusion and/or it's being used in direct competition. The tangential or totally unrelated uses don't require you to enforce. Furthermore, there are alternative actions rather than threatening or suing -- such as offering up free or cheap licenses.

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52 See, for example, in the American context, *Gorenstein Enters, Inc v Quality Care-USA, Inc* 874 F 2d 431, 435 (7th Cir 1989): "The owner of a trademark has a duty to ensure the consistency of the trademarked good or service. If he does not fulfill this duty, he forfeits the trademark ... The purpose of a trademark, after all, is to identify a good or service to the consumer, and identity implies consistency and a correlative duty to make sure that the good or service really is of consistent quality, i.e., really is the same good or service."

53 Lange 1981 *LCP* 167.

54 Masnick 2011 www.techdirt.com.

To this assertion, Goldman has added the following:[55]

> [I]f the "duty to police" might be driving trademark owners to be (over)zealous in their enforcement efforts, maybe we should fix the duty to police. After all, this "duty" isn't in the statute at all; it's barely in the case law; and it could be easily remedied with a statutory clarification that might very well be welcomed by both trademark owners and secondary trademark users because it might eliminate ambiguity plaguing both communities ... From my perspective, the 'duty to police' is like the proverbial monster under a child's bed. It's not actually there, but boy, it sure seems scary.

Others believe that the proposed anti-trademark bullying provisions - as mooted in the Trademark Technical and Conforming Amendment Act of 2010 - are unfounded, and should be abandoned. This is because they are claimed to be inconsistent with this "duty to police", and would place trademark owners in an untenable situation:[56]

> [T]he 'Trademark Bullies' provision is counterintuitive to trademark law, the very essence of which is to protect the exclusive use and uniqueness of a mark's ability to serve as a source identifier. The provision undermines this by playing the blame game and pointing fingers at mark owners who are merely doing what they must, according to trademark law, to protect the strength of their mark and their rights in those marks ... The trademark owner may be the biggest kid on the playground, but the bullies are the mob of smaller kids who take every chance they get to chip away at the goodwill that the mark owner has worked hard to build in the minds of consumers.

Even assuming, for present purposes, that the rationales for the activity of policing trademarks in the contexts mentioned above are not problematic *per se*,[57] going full-tilt at those potential infringers in circumstances of often dubious legal merits is more worrying. Why do rights holders so often seem to lose the plot? It would be too simplistic to merely ascribe the actions of IP owners who succumb to overly-zealous enforcement to their being guilty of arrogance. There may, of course, be some arrogance involved, but the often inexplicable conduct of such parties may also be due to a number of other reasons. Just one such reason may be the over-expansion of IP laws' protection for rights holders, along with a resultant inflated

55 Goldman 2011 blog.ericgoldman.org.
56 See Huynh 2011 works.bepress.com.
57 I will revisit the trademark owner's "duty to police" in South African trademark law in the soon to be completed follow-up article on trademark bullying.

ego, as one critical observer commented in the context of publicity rights in the United States:[58]

> Granting property rights in fame is a dangerous proposition in no small part because celebrities tend to be control freaks … As their egos expand, so do their publicity rights. They conceive of their rights as granting them permission to ban any cultural expressions that tread on their alleged identity.

If we discount arrogance and ego, however, there must be other reasons why trademark bullies would expose themselves to public ridicule or vitriol, and even consumer boycotts. If we bear in mind that these trademark holders generally represent commercial brands and have commercial profit-making objectives, why would a brand conduct itself in a way that seems at first glance to be counter-productive and even idiotic? Compare the case of a threat of a lawsuit by Smirnoff which resulted in the demise of a website dedicated to a drinking game involving Smirnoff Ice-flavoured malt beverages (i.e. the promotion and use of its own product, by obviously fanatical supporters of that very product!).[59] There must be more to this than meets the eye, which is why I have briefly to refer to what seem to me to be the less legitimate reasons for trademark bullying. A prime reason for the proliferation of bullying tactics is that it makes a lot of *practical* sense for rights' holders (or, at least, for their legal advisors), and the following reasons seemingly all resort under the umbrella of pragmatism.

The practical reasons can be identified in respect of a number of aspects. Randall Newsom explains (in the context of trademark disputes between colleges and schools in the United States, as referred to earlier) how the (1) *disparity in bargaining power*[60] between the rights holder and the recipient of the cease-and-desist letter functions to the benefit of the former:

58 Bollier *Brand Name Bullies* 135.

59 See Spalding 2010 www.newmediarights.org.

60 For further consideration of the implications of this aspect of bullying for the legality of such conduct, see discussion in my soon to be completed follow-up article on the legal implications of trademark bullying.

Upon receiving a C & D letter, a high school is often forced to decide between termination [of the use of an allegedly infringing mark] or litigation. On the one hand, termination, although not inexpensive, provides cost-certainty and the assurance of finality. On the other hand, the uncertainty in cost, duration, and finality of litigation often forces a high school to abandon any claims to the trademark at question. Furthermore, a collegiate institution has very little to lose in asserting trademark rights against a high school, and the high school has little to gain in a lawsuit other than continuing to use that mark. In these disputes, a university can gain acknowledgement and demonstrated control of trademark rights, whereas the best case for a high school is to maintain the *status quo* - using the logos, nicknames, and other identifying insignias at no cost.[61]

Newsom explains that the practical consequence of this unequal bargaining power between collegiate institutions and high schools is one that - I would assume - also applies in other contexts of aggressive enforcement by means of the ubiquitous C & D letter - namely that both parties presume that the collegiate institutions (or other rights' holders) are correct in asserting their trademark rights, and that the high schools (or other targets of threats of litigation) are infringing on those rights.[62] So, (2) *risk aversion on the part of the alleged infringer* may play a key role in encouraging the use of the C & D letter (with the targets of such bullying opting to be responsible gamblers who most definitely know when to quit). Coleman explains how a trademark owner may establish a virtual no go-zone around its mark by creating an environment fraught with danger for anyone who comes close to the mark - thereby pre-emptively encouraging risk aversion. He uses the example of the National Football League in the United States and its SUPER BOWL mark:

> Like all IP owners holding premium "brand equity", the NFL has in place an "enforcement programme" designed not only to protect its legitimate rights, but to establish a buffer zone of illegitimate, intimidation-based quasi-rights that have a very real effect because it is never economically rational to test them in court. Such a buffer zone establishes a zone of litigation-based (not legal-based, litigation-based) early warning triggers around the real rights, such that any purported infringer of the trademark - even a party making a protected fair use of the SUPER

61 Newsom 2011 *BCL Rev* 1834-1835.
62 Newsom 2011 *BCL Rev* 1834-1835.

> BOWL® mark - would have to traverse the hopelessly expensive no-man's land of illegitimate litigation threats to establish his defence.[63]

Apart from such risk aversion, bullying tactics may also hold benefits from a financial perspective. It makes sense for a trademark lawyer to advise the use of an aggressive cease-and-desist letter with a view to discouraging a potential defendant from opposing the client's claims - if one considers the significant (3) *costs of trademark litigation*. In the United States, a 2009 survey by the American Intellectual Property Law Association found that trademark-infringement litigation costs total on average USD384 000 when less than USD 1 million is at issue; USD857 000 when USD1-USD25 million is at issue, and USD1 746 000 when over USD25 million is at issue.[64] Bearing in mind the substantial potential costs of actual trademark litigation, one can understand the mentality of the "bully" or his legal advisor who may (in the words of an English judge writing about the "groundless threats" provisions in early patent statutes)[65] be '"willing to wound but afraid to strike' ... holding the sword of Damocles above another's head".[66]

Apart from the fact that bullying may make financial sense for rights holders, Meurer mentions two other practical issues which may explain the attractiveness of such conduct for serial litigators or the authors of cease-and-desist letters. The first is that of uncertainty of outcome (in the favour of the accuser) - namely that (4) *the scope of IP rights is often highly variable*, and that even reasonable judges often disagree on the interpretation of a patent claim, the standard for trademark infringement (the likelihood of consumer confusion, which is 'inherently noisy'), and the fact that copyright law requires a difficult subjective decision on whether or not the defendant unlawfully appropriated the plaintiff's expressive work.[67] The second issue is what I will call (5) *the "poker-face aspect*"- namely that "a weak lawsuit may present a

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63 Coleman 2011 *Intellectual Property Magazine* 11.

64 From the *Report to Congress: Trademark Litigation Tactics and Federal Government Services to Protect Trademarks and Prevent Counterfeiting*, April 2011 (report by the Secretary of Commerce in terms of s. 2968, Trademark Technical and Conforming Amendment Act, 2010 (Public Law 111-146)) 18 n 52.

65 In respect of protection against such groundless threats, see the discussion in s 5.2 (in part 2 of this article).

66 Simon Brown LJ (in *Unilever PLC v Procter & Gamble Co* 2001 1 All ER 783), as quoted by Lightman J in *L'Oreal (UK) Limited v Johnson & Johnson* 2000 FSR 686 para 12.

67 Meurer 2003 *BCL Rev* 513.

credible threat to a defendant who has trouble distinguishing weak lawsuits from strong ones", as a plaintiff with a weak lawsuit can successfully bluff a defendant, because in the early stages of IP litigation the plaintiff is likely to have better information about the scope and validity of the claimed IP rights.[68] Furthermore, this might be even more poignant considering the strategic advantages that a serial "bully" might have over their occasional targets. Gallagher notes "how powerful IP rights owners, as sophisticated 'repeat players' in IP enforcement efforts against often 'one-shot' participants in the legal system, have strategic advantages that allow them to enforce IP rights beyond their proper scope".[69]

In the ambush-marketing context referred to earlier, these aggressive enforcement measures by event organisers sometimes display some rationality *vis-a-vis* the existing contractual obligations owed to the event's sponsors. When hundreds of millions of dollars are paid - for example - for Olympics sponsorship rights, it is a no-brainer that (6) *the perception of aggressive protection of those rights by the rights' grantor promotes a feeling amongst sponsors that they are receiving the requisite value for that investment*. Of course, those sponsorship contracts also generally impose positive obligations on event organisers to actively (and proactively) combat ambushing by means of aggressive enforcement measures. These range from blanket ("carpet-bombing") trademark registrations and public education campaigns to naming and shaming perceived ambushers, as well as sometimes to aggressive litigation aimed at small-fry "infringers" (rather than the big boys of ambushing such as Nike and Pepsi). Apart from contractual obligations, however, it is possible that the same rationale of displaying a no-nonsense and zero-tolerance attitude to perceived infringements might apply when a client pays generously for the expectation of real and aggressive protection to an unscrupulous or uncaring IP lawyer.

I have a personal belief that much of the rights holder bluster of the "Streisand effect" type may also be attributable to (7) *a misguided long-term goal of pre-emptive self-victimisation*: If I make a huge noise about alleged infringement of my

68 Meurer 2003 *BCL Rev* 514.
69 Gallagher 2012 *Santa Clara Computer & High Tech LJ* 459.

"rights" (and do so often enough), courts or law-makers will in future be willing to provide me with more and more significant protection - simply because I have so frequently in the past been a victim of "infringement". Or could it be that bullying that achieves (8) *a goal of informally lobbying and obtaining greater legal protection for rights holders* (in the way just referred to) makes sense because it actually adds commercial value to the rights claimed? Cohen has identified a measure of circularity of reasoning in much of trademark law (and, more generally, property law), whereby the law "purports to base legal protection upon economic value, when, as a matter of actual fact, the economic value of a sales device depends upon the extent to which it will be legally protected".[70] At the very least, the bully may find that (9) *building a reputation for prosecuting weak claims through to the end, actually has value in itself in terms of deterrence* aimed at smaller market entrants: "a plaintiff with a predatory reputation rationally views losing a weak lawsuit as a profitable investment in that reputation"[71] (and such litigation may get cheaper and cheaper the more it is engaged in).[72]

In a similar vein - although more oblique and more concerned with the *zeitgeist* than the courtroom - an aggressive threat of litigation may be used indirectly as (10) *a tool to obtain greater respect (even though possibly misplaced) for an IP rights holder's property in the public psyche,* despite the recognition of the means used to achieve this end. McGeveran recognises this in the context of the implications of trademark enforcement in the United States for freedom of speech, and observes the following regarding the sending of cease-and-desist letters as a routine response to virtually any unauthorised use of a trademark:[73]

> In addition to deterring the individual recipients, these legal threats also serve a broader signalling function by warning against all unauthorized uses of a mark. Over time, broad claims have begun to redefine public understanding of the nature of trademark ownership, which ultimately shapes those rights through the 'feedback effect' of consumer perception.

70 Cohen 1935 *Colum L Rev* 815, as quoted in Beebe 2004 *UCLA Law Review* 679.
71 Meurer 2003 *BCL Rev* 515.
72 Meurer 2003 *BCL Rev* 516 notes that in predatory litigation "the cost to the predator declines after the first lawsuit - the plaintiff can use the work product from the first litigation in subsequent litigation".
73 McGeveran 2010 *BUL Rev* 2273.

Of course, this means of manipulation of public perception of the scope of trademark rights is problematic from the perspective of freedom of expression. In the light of the significantly-commercialised nature of the modern "bling generation" and the "growing ubiquity of branding", third-party use of trademarks may be more essential to open discourse than ever before, as "[n]o representation of the modern world would be accurate unless it were saturated with marketing symbols".[74] Brands have become so ubiquitous that they now often permeate our use of language in social discourse. The use of bullying to threaten such use of language may in fact serve to illegitimately limit free speech and to attempt to remove what have become well-entrenched cultural symbols from the public domain and avenues of social expression. The threat to the public domain posed by trademark owners' efforts to expand the protection for their marks by manipulating the public's consciousness of a legal claim to protection has been evident for some time:[75]

> When the proprietor of a mark presumes to intrude into the relationship which the subject of the mark may have contracted with the public in some setting essentially beyond the proprietor's own undertakings ... the proprietor goes well beyond any purpose legitimate in the law of trademarks and begins, indeed, to engage in an appropriation of its own ... [P]roprietors of trademarks and related impedimenta are subject to natural pressures to expand the boundaries of their interests, even at the risk of appearing silly or rapacious and not infrequently at the cost of expropriatory incursions into the public domain. The pressures are acute; a trademark exists only insofar as the proprietor can persuade the public to recognise it from time to time. Proprietors cannot be expected to restrain themselves. It is all the more essential then that courts respond firmly and clearly to threats to the public domain in these cases.

The implications for free expression and the public domain of trademark bullying suggest why such conduct must be addressed by the legal system. I will continue to examine some of the other implications in a future paper on the subject, where I will also provide some suggestions for ways to deal with bullying.

4 Conclusion

[74] McGeveran 2010 *BUL Rev* 2274.
[75] Lange 1981 *LCP* 167-168.

In the foregoing discussion I have attempted to introduce those readers who may be less familiar with the concept of trademark bullying to this interesting phenomenon by means of examples of such conduct as well as some rather broad evaluation of the reasons why IP lawyers and their clients may engage in this practice. This piece has been mostly descriptive of the forms of bullying encountered to date. I have hardly scratched the surface regarding the legal implications of this modern-day form of IP litigation or rights' enforcement strategy, and I believe that the subject merits further in-depth investigation.

In a second article on the subject, I intend to examine the legitimacy of overly-aggressive enforcement tactics against the backdrop of the philosophical justifications for the protection of intellectual property. While this introductory article has dealt mostly with procedural issues relating for example to IP litigation strategies as experienced in practice, examination of the applicable law and legal principles in this context is required. One central issue that remains to be considered is whether uncurbed acquiescence by the legal system in such enforcement practices may serve to illegitimately expand the actual substantive scope of IP rights beyond their accepted limits. Other issues that need to be considered are the trademark owner's "duty to police" its rights (as justification for aggressive enforcement); the implications for freedom of speech of such conduct (including the potential role for a defence of parody in some cases that often attracts bullying behaviour from rights holders);[76] and ethical considerations for IP lawyers who advise their clients to engage in such enforcement tactics. Special consideration should also be given to relevant issues concerning the South African developmental state and its transformative constitutional dispensation, as I believe that the phenomenon of illegitimate trademark bullying is something that directly offends a number of the foundational values which underpin our Constitution, and is an example of the

[76] See, for example, the South African *Laugh It Off* case referred to earlier, and the matter between Louis Vuitton and artist Nadia Plesner, which was heard by the District Court of the Hague (*Nadia Plesner Joensen v Louis Vuitton Malletier SA The Hague District Court*, case number 389526/KG ZA 11-294 (4 May 2011)). This last case will be discussed in more detail in my forthcoming follow-up article on trademark bullying (in respect of the potential free speech implications)

"abuse of private power"[77] which so harshly implicates our society's professed adherence to the principle(s) of *ubuntu*.[78] I intend firstly to attempt to formulate a useable definition and a test for determining the presence of illegitimate trademark bullying, and secondly to provide some suggestions for practical mechanisms to deal with trademark bullying in South Africa. Drawing from recent experience in other jurisdictions, I will propose legal reform in the interests of the public and of the public domain in order to ensure the continued legitimacy of the South African IP law regime when faced with the abuse of rights**.**

77 See, for example, the views of Davis J (expressed in the context of contract law) in *Advtech Resourcing (Pty) Ltd t/a Communicate Personnel Group v Kuhn* 2008 2 SA 375 (C) and *Mozart Ice Cream Franchises (Pty) Ltd v Davidoff* 2009 3 SA 78 (C).

78 The importance of which was recently confirmed, again, by judges of the Constitutional Court in *Everfresh Market Virginia (Pty) Ltd v Shoprite Checkers (Pty) Ltd* Case CCT 105/10 2011 ZACC 30.

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List of abbreviations

BCL Rev	Boston College Law Review
BUL Rev	Boston University Law Review
C & D	Cease-and-desist letter
Colum L Rev	Columbia Law Review
FIFA	Federation Internationale de Football Associations
Fordham Intell Prop Media & Ent LJ	Fordham Intellectual Property, Media and Entertainment Law Journal
IP	Intellectual property

LCP	Law and Contemporary Problems
LOCOG	London Organising Committee for the Olympic Games
Santa Clara Computer & High Tech LJ	Santa Clara Computer and High Technology Law Journal
USOC	United States Olympic Committee
Wash & Lee L Rev	Washington & Lee Law Review
Wis L Rev	Wisconsin Law Review

WHAT INTELLECTUAL PROPERTY LAWYERS CAN LEARN FROM BARBRA STREISAND, SEPP BLATTER, AND THE "COCA-COLA CRY-BABY": DEALING WITH "TRADEMARK BULLYING" IN SOUTH AFRICA

AM Louw*

SUMMARY

This article suggests some pause for reflection amongst intellectual property lawyers, and for serious consideration of the words of an internationally-renowned IP law expert: "Possessing a right does not mean that it is a good idea to enforce it always, and to the hilt. Discretion may be nine parts of possession". It provides some prominent, recent examples of trademark bullying or overly-aggressive enforcement in the IP law context. These examples are mainly from other jurisdictions but they are directly relevant to some of the IP law challenges present in South Africa at the moment. The article further examines why lawyers and rights' holders engage in trademark bullying (*why* it's done), and start to deal briefly with some of the legal implications. A future article is to examine the legal aspects of trademark bullying in much more detail and considers its legitimacy within the context of IP law, more generally, and some other areas of law, more specifically.

KEYWORDS: Trademarks; Trademark infringement; Intellectual property; IP rights; Overly-aggressive enforcement; Rights holder over-reach; Litigation strategy; Cease-and-desist letters; Strike suits; 'Trademark extortion'; 'Duty to police'; Streisand effect; Ambush marketing.

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