

THE SEMIOTICS OF ALPHA BRANDS:
ENCODING/DECODING/RECODING/TRANSCODING
OF LOUIS VUITTON AND IMPLICATIONS FOR
TRADEMARK LAWS[•]

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Abstract

Alpha brands are the most influential global brands that possess significant configurations of meanings and can offer peculiarly powerful affirmations of belonging and recognition in the lives of their consumers. The trademark, as the visual source-designating emblem of a brand, is also a semiotic sign that resonates with the structure of myths and archetypes within a cultural environment of desire. Focusing on the world-renowned *Louis Vuitton* trademark, this Article explores how an understanding of semiotics can be useful to a legal analysis of trademarks. Two decisions involving the iconic Louis Vuitton brand—one from the United States and one from Singapore—are used as case studies to illustrate how an appreciation of its ideological codings may be relevant to courts in trademark litigation. It is contended that an understanding of the semiotic nature of a trademark can better help courts decide if these recodings are *predominantly parasitic* (and therefore infringing trademark laws) or *primarily expressive* (and thus excused from liability). The Article concludes that useful relevant insights may be gleaned from an understanding of contemporary production, circulation and consumption of the alpha brand to assist in a more nuanced but doctrinally focused understanding of trademark laws.

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INTRODUCTION

Attempting to define a brand is like trying to catch a will-o'-the-wisp; its meaning has been the subject of much debate in the world of advertising and marketing. But there is a general agreement that “[a] brand is a set of associations linked to a name, mark, or symbol associated with a product or service,”¹ and that brands “are created through a wide range of touch points; every time customers interact with a brand they form associations.”² A logo, or in legal parlance, a trademark, is one of the more obvious manifestations that may come to characterize a brand. Interbrand, a leading brand consulting firm, publishes an annual ranking of the “Best Global Brands” using a rigorous methodology that incorporates financial analysis of earnings and brand impact on consumption decision; the Louis Vuitton brand was ranked 17th in 2012 and 18th in 2011, the highest ranking for a luxury fashion brand.³ The 2011 report observed that “[f]or many, the brand depicts attainable luxury and is a highly desirable symbol of success.”⁴ Another marketing research and consulting firm also accorded Louis Vuitton its highest luxury brand ranking, noting that the

¹ Tim Calkins, *The Challenge of Branding*, in KELLOGG ON BRANDING 1, 1 (Alice M. Tybout & Tim Calkins eds., 2005).

² *Id.* at 6.

³ INTERBRAND, BEST GLOBAL BRANDS 2011 22 (2011), available at <http://www.interbrand.com/en/best-global-brands/previous-years/Best-Global-Brands-2011-report.aspx>; INTERBRAND, BEST GLOBAL BRANDS 2012: THE DEFINITIVE GUIDE TO THE 100 BEST GLOBAL BRANDS 34 (2012) [hereinafter INTERBRAND, BEST GLOBAL BRANDS 2012], available at <http://www.interbrand.com/en/best-global-brands/2012/downloads.aspx>; “Enchantment and aesthetic delight are the very essence of the luxury experience. Luxury consumers want to engage with something more profound. They want to be swept away by captivating imagery and masterful storytelling.” *Id.* at 117.

⁴ INTERBRAND, BEST GLOBAL BRANDS 2011, *supra* note 3, at 22.

brand's "bespoke attention to individuality" was impelling customers to make "emotional, expensive purchase[s]."⁵

As Rochelle Cooper Dreyfuss remarks, "Trademarks have come a long way. . . . [I]deograms that once functioned solely as signals denoting the source, origin, and quality of goods, have become products in their own right, valued as indicators of the status, preferences, and aspirations of those who use them."⁶ A trademark is as symbolic as it is functional: it does much more than designate source or origin of goods. A luxury fashion trademark is perhaps one of the best examples of the status-signifying power of the mark in contemporary society. As academic commentator Megan Richardson observes, "trade marks tell stories. Their expressiveness is the basis of commercial activity, the trader-author the conduit of meaning, and the market-audience the monitor and arbiter of taste."⁷ It has been observed that "fashion is adopted by social elites for the purpose of demarcating themselves as a group from the lower classes. The lower classes inevitably admire and emulate the upper classes."⁸ Moreover, as the most immediate visible emblematic marker of self-presentation in society, fashion—and especially the luxury fashion trademark—communicates "meanings that have individual and social significance."⁹ Reflecting the prevalent approach of the European Court of Justice ("ECJ"), Justice Lewinson of the English High Court remarked in *O2 Holdings Limited (formerly O2 Limited) v. Hutchison 3G Limited*:

Brands are big business. . . . Defining a brand is not easy. A lawyer would tend to think of goodwill, trade marks and so on. But a brand includes more elements; such as image and reputation; the values that the brand owner tries to inculcate in the buying public. A brand is what customers choose to buy. Many decisions about brands are made by customers emotionally or intuitively rather than rationally.¹⁰

⁵ See Ken Schept, *BrandZ Top 100: Most Valuable Global Brands 2011*, MILLWARD BROWN 59 (May 9, 2011), http://www.millwardbrown.com/Libraries/Optimor_BrandZ_Files/2011_BrandZ_Top100_Report.sflb.ashx (Mar. 6, 2012) (Louis Vuitton ranked twenty-sixth, which was the highest rank of any luxury fashion brand; the company's brand value was over two times more than the next highest luxury brand, Hermès, which ranked seventy-first.). See also UCHE OKONKWO, LUXURY FASHION BRANDING: TRENDS, TACTICS, TECHNIQUES 10 (2007) ("Branding is the lifeline of the luxury industry Without branding, there would be no luxury goods.").

⁶ Rochelle Cooper Dreyfuss, *Expressive Genericity: Trademarks as Language in the Pepsi Generation*, 65 NOTRE DAME L. REV. 397, 397 (1990).

⁷ Megan Richardson, *Trade Marks and Language*, 26 SYDNEY L. REV. 193, 196 (2004).

⁸ C. Scott Hemphill & Jeannie Suk, *The Law, Culture, and Economics of Fashion*, 61 STAN. L. REV. 1147, 1156 (2009).

⁹ *Id.* at 1151.

¹⁰ *O2 Holdings Ltd. v. Hutchison 3G Ltd.*, [2006] EWHC (Ch) 534, 708 (Eng.).

Thus, a well-known brand can have a significant “power of attraction”¹¹ with its “brand image [being] created in a number of ways: personal experience; word of mouth; how the brand is presented in stories in the media; packaging; point of sale display; retail staff; and, of course, advertising.”¹² Well-known brands like Louis Vuitton, Apple¹³ and Nike¹⁴ are *alpha brands* that carry significant “semiotic freight,”¹⁵ and like the most influential celebrities, they possess particular configurations of meanings and can “offer peculiarly powerful affirmations of belonging, recognition, and meaning in the midst of the lives of their [consumers].”¹⁶ These affective meanings confer upon the brand, much like the celebrity persona, an economic value such that “when consumers respond to [a brand’s] ‘attractiveness,’ they are, in fact, responding to a very particular set of meanings.”¹⁷ These transnational alpha brands have thrived on building a cachet of high emotional value with their customers through emotional branding campaigns that engender enduring loyalty. The overriding consideration in the purchasing decision is driven more by the *emotional* and *social* consumption values ascribed to these alpha brands than the functional value of the products that they offer.¹⁸

¹¹ Intel Corp. Inc. v. CPM United Kingdom Ltd., [2007] EWCA (Civ) 431, 946. Other decisions have used similar language:

[T]he use by a third party . . . of a sign identical with the trade mark in relation to goods or services identical with those for which the mark is registered substantially interferes with the proprietor’s use of its trade mark to acquire or preserve a reputation capable of attracting consumers and retaining their loyalty, the third party’s use must be regarded as adversely affecting the trade mark’s investment function.

Interflora Inc., Interflora British Unit v. Marks & Spencer Plc, Flowers Direct Online Ltd., 2011 WL 4388782 at *62. In particular, the ECJ has defined “investment function” of a mark as use “by its proprietor to acquire or preserve a reputation capable of attracting consumers and retaining their loyalty.” *Id.* at *60.

¹² *O2 Holdings Ltd.*, [2006] EWHC (Ch) at 708.

¹³ Apple was ranked the second most valuable global brand in 2012 with a brand value of \$76.568 billion. INTERBRAND, BEST GLOBAL BRANDS 2012, *supra* note 3, at 26 (commenting, “Jobs recognized that a brand is so much more than a logo He also recognized that a brand is what connects a business with the hearts and minds of consumers. Simply put, Steve Jobs understood that a brand is uniquely capable of humanizing a business”).

¹⁴ Nike was the top ranked global apparel brand in 2012 with a brand value of \$15.126 billion. *Id.* at 38 (describing the company as a “global icon that transcends its category.”).

¹⁵ Michael Madow, *Private Ownership of Public Image: Popular Culture and Publicity Rights*, 81 CALIF. L. REV. 127, 128 (1993). See also David Tan, *Affective Transfer & the Appropriation of Commercial Value: A Cultural Analysis of the Right of Publicity*, 9 VA. SPORTS & ENT. L.J. 272, 292–95 (2010).

¹⁶ CHRIS ROJEK, CELEBRITY 52 (2001). See also David Tan, *Beyond Trademark Law: What the Right of Publicity Can Learn from Cultural Studies*, 25 CARDOZO ARTS & ENT. L.J. 913, 946–48 (2008).

¹⁷ Tan, *supra* note 16, at 959 (citing Grant McCracken, *Who is the Celebrity Endorser? Cultural Foundations of the Endorsement Process*, 16 J. CONSUMER RES. 310, 312, 315 (1989)).

¹⁸ See, e.g., Jagdish N. Sheth, Bruce I. Newman & Barbara L. Gross, *Why We Buy What We Buy: A Theory of Consumption Values*, 22 J. BUS. RES. 159, 160 (1991) (describing various disciplines, including economics, sociology, psychology, that have contributed theoretical

Part I examines how an understanding of semiotics and more generally, cultural studies, can be useful to a legal analysis of trademarks. As famous marks or the alpha brands invariably connote a defined cluster of meanings that make them distinctive and highly desirable to a wide demographic of consumers, a cultural appreciation of “coding” can better assist the formulation of legal arguments that is consonant with the reality of contemporary consumption and cultural practices. Part II explains how the notion of semiotic coding in all its attendant forms—encoding, decoding, recoding and transcoding—may be used to analyze how the Louis Vuitton mark (which is a paradigmatic signification of an alpha brand) had been perceived by courts in two key cases from two different jurisdictions, and how the implications of these decisions will play out. The Conclusion determines that a more nuanced but doctrinally focused understanding of trademark laws can be achieved through examination of the useful and relevant insights gleaned from an appreciation of contemporary production, circulation, and consumption of the alpha brand.

I. SEMIOTICS, CULTURAL STUDIES, AND TRADEMARKS

How might semiotics and cultural studies be useful to law? Umberto Eco has enigmatically described semiotics as a social science discipline that studies “everything that can be *taken* as a sign.”¹⁹ A sign is simply a thing that stands for something else, and “more technically, as a spoken or written word, a drawn figure, or a material object unified in the mind with a particular cultural concept.”²⁰ Although it has its origins in the study of language, semiotic analysis is a trans-linguistic activity²¹ that can be applied to the inquiry of “[a system] of structural codes. . . . that engages with culture, consumption, and communication in the marketplace.”²² The Swiss linguist, Ferdinand de Saussure is widely credited as the most influential scholar in the field of semiotics. He emphasized the nature of the sign as the coded association of a

insights and research findings to these values). *See also* MARC GOBÉ, *EMOTIONAL BRANDING: THE NEW PARADIGM FOR CONNECTING BRANDS TO PEOPLE* (2001); JAGDISH N. SHETH, BANWARI MITTAL & BRUCE I. NEWMAN, *CUSTOMER BEHAVIOR: CONSUMER BEHAVIOR AND BEYOND* (1999); JAGDISH N. SHETH, BRUCE I. NEWMAN & BARBARA L. GROSS, *CONSUMPTION VALUES AND MARKET CHOICES: THEORY AND APPLICATIONS* (1991); SCOTT ROBINETTE & CLAIRE BRAND, *EMOTION MARKETING: THE HALLMARK WAY OF WINNING CUSTOMERS FOR LIFE* (2001).

¹⁹ UMBERTO ECO, *A THEORY OF SEMIOTICS* 7 (1979).

²⁰ ARTHUR ASA BERGER, *THE OBJECTS OF AFFECTION: SEMIOTICS AND CONSUMER CULTURE* 3 (2010).

²¹ ROLAND BARTHES, *ELEMENTS OF SEMIOLOGY* 11 (Annette Lavers & Colin Smith trans., Hill and Wang 1973) (1964).

²² LAURA R. OSWALD, *MARKETING SEMIOTICS: SIGNS, STRATEGIES, AND BRAND VALUE* 47 (2012).

material *signifier*, such as the sound of a word, with a *signified* or preconceived meaning.²³ For example, our minds attach the word “cat,” and the drawn figure of a “cat,” as a signifier to the idea of a “cat”—that is, a domesticated feline species possessing particular behavioral characteristics. In his oft-cited work on the semiotic analyses of consumer cultures, *Mythologies*, Roland Barthes explains that “any semiology postulates a relation between two terms, a signifier and a signified”²⁴ and that a sign “is the associative total of the first two terms.”²⁵ A “myth” is thereby created when meaning within a semiological system is transformed into form as represented by a sign;²⁶ each sign becomes naturally associated with a set of meanings or “historical intention”²⁷ which is ultimately consumed.

In her application of semiotics to the study of brands, Laura Oswald highlights that these associations are not subject to the whims of individuals, but are regulated by cultural conventions.²⁸ Thus the trademark, or brand logo, on goods and services does much more than simply designate the origin of the producer; it also functions as a visual *signifier* of a set of *signified* meanings. It is precisely this symbolic nature of the Saussurean sign which “embeds structural semiotics in the culture of consumers”²⁹ that will drive consumption behavior in modern society. Oswald contends that semiotics

does not stop with a structural analysis, but identifies ways brand meanings are embedded in the broad cultural myths, social organization, and beliefs of the target market. The brand system resembles *la langue*, the term that Saussure gives to the system of linguistic codes that defines the range of possibilities for producing discourses[.]³⁰

Referring to the “triadic structure” of the trademark, Barton Beebe offers a similar explanation that expands on the binary nature of the Saussurean sign:

[T]rademark commentary has traditionally conceived of the trademark as a three-legged stool, consisting of a signifier (the perceptible form of the mark), a signified (the semantic content of

²³ See generally FERDINAND DE SAUSSURE, COURSE IN GENERAL LINGUISTICS (Roy Harris trans. 1983) (1972).

²⁴ ROLAND BARTHES, MYTHOLOGIES 111 (Annette Lavers trans. 1972) (1957).

²⁵ *Id.*

²⁶ *Id.* at 131.

²⁷ *Id.* at 142.

²⁸ OSWALD, *supra* note 22, at 48.

²⁹ *Id.*

³⁰ *Id.* at 50 (citation omitted).

the mark, such as the goodwill or effect to which the signifier refers), and a referent (the product or service to which the mark refers).³¹

Thus the legal term “trademark” really means the “signifier” when we talk about a word, image, sound, smell or thing that is capable of being registered as a mark. However, when we refer to trademark infringement or trademark dilution actions, what we really mean is the exclusive right to use the signifier in connection with a particular signified goodwill and referenced good or service.³² For well-known trademarks, the brand signifier/signified relationship has become universally codified for the consuming public; these consumers will automatically and consistently think of the coded brand meanings and values (the signified) when they are exposed to the signifiers such as the logos. In other words, the brand logo or trademark becomes a sign for a predetermined set of cultural codes and consumer experiences associated with the brand. In their recent study of luxury brands, Michel Chevalier and Gérald Mazzalovo commented that logos “are to modern communication and consumption activities what numbers are to mathematics or words to language[;] . . . logos are the new alphabet of an overcommunicating society, the symbols of our times.”³³

So, a handbag is not just a handbag. Chevalier and Mazzalovo observed that consumers in Paris and Tokyo are very happy with their Louis Vuitton purchases and these consumers feel that by carrying the bag in public, they are affirming the values they seek.³⁴ Fashion in general, in the postmodern condition, is not simply about covering up the naked body, and an alpha brand like Louis Vuitton transcends clothing, bags, and accessories to take on political, pedagogical, and cultural meanings, much in the same way that McDonald’s transcends ground beef and potatoes.³⁵ Similarly, Disney is not just about cartoons and family entertainment, but has become “synonymous with the notion of childhood innocence” and a semiotic sign for “a pristine never-never land in which children’s fantasies come true, happiness reigns, and innocence is kept safe through the magic of pixie dust.”³⁶ Arthur Berger illustrates this idea—the difference between literal description

³¹ Barton Beebe, *The Semiotic Account of Trademark Doctrine and Trademark Culture*, in *TRADEMARK LAW AND THEORY: A HANDBOOK OF CONTEMPORARY RESEARCH* 42, 45 (Graeme B. Dinwoodie & Mark D. Janis eds. 2008).

³² *Id.* at 47.

³³ See MICHEL CHEVALIER & GÉRALD MAZZALOVO, *LUXURY BRAND MANAGEMENT: A WORLD OF PRIVILEGE* 105 (2d ed. 2012).

³⁴ *Id.* at 109.

³⁵ See JOEL L. KINCHELOE, *THE SIGN OF THE BURGER: MCDONALD’S AND THE CULTURE OF POWER* 119 (2002) (discussing the McDonald’s brand as cultural pedagogy).

³⁶ HENRY A. GIROUX & GRACE POLLOCK, *THE MOUSE THAT ROARED: DISNEY AND THE END OF INNOCENCE* 17 (2010).

(denotation) and the cultural meanings and myths connected to words and things (connotation)—with an example:

From a denotation perspective, a Barbie doll is 11.5 inches tall, and has the following measurements: 5.25 inches by 3 inches by 4 inches. It was invented in 1959. This material is all factual and is denotation. The connotations of Barbie dolls are more complicated, for here we are dealing with what these dolls reflect about American culture and society and their symbolic and mythic significance.³⁷

The semiotic signification of Barbie—both the doll and the trademark—has been discussed by the Ninth Circuit Court of Appeals on a number of occasions. In *Mattel, Inc. v. MCA Records, Inc.*, the court observed that Mattel has established Barbie as “the ideal American woman” and a “symbol of American girlhood” for many.³⁸ In *Mattel Inc. v. Walking Mountain Productions*, the court found that “Barbie, and all the associations she has acquired through Mattel’s impressive marketing success, conveys these messages in a particular way that is ripe for social comment.”³⁹

Stuart Hall’s *Encoding/Decoding* essay,⁴⁰ which has achieved “canonic status”⁴¹ in the field of audience study, suggests that

we must recognize that the discursive form of the message has a privileged position in the communicative exchange . . . and that the moments of “encoding” and “decoding”, though only “relatively autonomous” in relation to the communication process as a whole, are *determinate* moments.⁴²

Referring to Barthes’ work on modern myths,⁴³ as well as to Antonio Gramsci⁴⁴ and Claude Lévi-Strauss,⁴⁵ Hall later discusses the

³⁷ BERGER, *supra* note 20, at 16.

³⁸ *Mattel, Inc. v. MCA Records*, 296 F.3d 894, 898 (9th Cir. 2002), *cert. denied*, 537 U.S. 1171 (2003).

³⁹ *Mattel Inc. v. Walking Mountain Prods.*, 353 F.3d 792, 802 (9th Cir. 2003).

⁴⁰ Stuart Hall, *Encoding/Decoding*, in *CULTURE, MEDIA, LANGUAGE* 128 (Stuart Hall, Dorothy Hobson, Andrew Lowe & Paul Willis eds., 1980) [hereinafter Hall, *Encoding/Decoding*]. For Hall’s comments on Dyer’s works, see Stuart Hall, *The Spectacle of the “Other,”* in *REPRESENTATION: CULTURAL REPRESENTATIONS AND SIGNIFYING PRACTICES* 225, 254 (Stuart Hall ed., 1997) [hereinafter Hall, *The Spectacle of the “Other”*].

⁴¹ Michael Gurevitch & Paddy Scannell, *Canonization Achieved? Stuart Hall’s “Encoding/Decoding,”* in *CANONIC TEXTS IN MEDIA RESEARCH: ARE THERE ANY? SHOULD THERE BE? HOW ABOUT THESE?* 231, 246 (Katz et al. eds. 2003). See also GRAEME TURNER, *BRITISH CULTURAL STUDIES: AN INTRODUCTION* 72–73 (3rd ed. 2003) (discussing how Hall has installed “a new vocabulary of analysis and a new theory of cultural production . . .”).

⁴² Hall, *Encoding/Decoding*, *supra* note 40 at 129.

⁴³ BARTHES, *supra* note 24.

⁴⁴ ANTONIO GRAMSCI, *SELECTIONS FROM THE PRISON NOTEBOOKS* (Quintin Hoare & Geoffrey Nowell Smith trans., ElecBook 1999) (1971).

politics of signification⁴⁶ and how ideological discourses of a particular society are classified and framed through semiotic signs within a “pragmatic circle of knowledge.”⁴⁷ In Barthesian terms, the alpha brand can be seen as a “cultural narrative” or signifier that is synonymous with the dominant culture.⁴⁸ In his critique of consumption, Jean Baudrillard contends that the consumer “no longer relates to a particular object in its specific utility, but to a set of objects in its total signification.”⁴⁹ Like Barthesian myths, the Louis Vuitton brand “contain[s] subject positions and models for identification that are heavily coded ideologically.”⁵⁰ Thus, increasingly, when consumers buy Louis Vuitton products, they are not making consumption decisions based on the functional or utilitarian nature of these products but they are buying into the significations of these commodities in the construction of their self-identities.⁵¹ As commentators Scott Hemphill and Jeannie Suk observed, “[t]hrough fashion, people communicate and express themselves. . . . Fashion goods provide a vocabulary.”⁵² The reality is cultural producers like Louis Vuitton engage target audiences via “textual signification”—for example, through advertisements containing particular value propositions—and audiences “connect with advertisements through interpretive and affective processes of semiotic engagement”⁵³

Semiotics is also located within a broader analytical framework of cultural studies that blends different theoretical disciplines like critical theory, literary theory, cultural anthropology, film/video studies, art history/criticism, women’s studies, sociology and consumer studies in its appreciation of the phenomena of popular culture. One of the most powerful and relevant insights of cultural studies for the law is that culture is transacted between the consumer and the producer via the distributors. Cultural studies recognises that consumers (or more generically known as “audience”) inevitably participate in the constitution of cultural meanings. There is no single “cultural studies”;

⁴⁵ Claude Lévi-Strauss, *The Scope of Anthropology*, 7 *Current Anthropology* 112 (1966); CLAUDE LÉVI-STRAUSS, RODNEY NEEDHAM, *THE ELEMENTARY STRUCTURES OF KINSHIP* (Rodney Needham ed., James Harle Bell & John Richard von Sturmer trans., 1969).

⁴⁶ Stuart Hall, *The Rediscovery of “Ideology”: Return of the Repressed in Media Studies*, in *CULTURE, SOCIETY AND THE MEDIA* 56, 70–74 (Gurevitch et al. eds., 1982).

⁴⁷ *Id.* at 74.

⁴⁸ PATRICK FUERY & KELLI FUERY, *VISUAL CULTURES AND CRITICAL THEORY* 93, 101 (2003).

⁴⁹ JEAN BAUDRILLARD, *THE CONSUMER SOCIETY: MYTHS AND STRUCTURES* 27 (Chris Turner trans., 1998) (1970).

⁵⁰ DOUGLAS KELLNER, *MEDIA CULTURE: CULTURAL STUDIES, IDENTITY AND POLITICS BETWEEN THE MODERN AND THE POSTMODERN* 248 (1995).

⁵¹ See ZYGMUNT BAUMAN, *POSTMODERNITY AND ITS DISCONTENTS* (1997). See also ZYGMUNT BAUMAN, *CONSUMING LIFE* (2007).

⁵² Hemphill & Suk, *supra* note 8, at 1164.

⁵³ IAIN MACRURY, *ADVERTISING* 190 (2009).

rather, it comprises different approaches with varying emphasis on the extent to which consumers interact with producers and distributors, and help determine cultural meanings and messages.

Cultural studies is often equated with the theory and politics of ideology, identity and difference;⁵⁴ but as Lawrence Grossberg points out, new discursive opportunities present themselves when cultural studies move “towards a model of articulation as ‘transformative practice’”⁵⁵ In its “study of the quotidian world,”⁵⁶ much of cultural studies research concentrates on how a particular phenomenon relates to matters of ideology, race, social class and gender; it departs from the *text* (which can be seen as the law’s main concern) to undertake a discursive analysis of the *context* to consider how power in society is distributed and contested through processes of production, circulation and consumption.⁵⁷

The origins of cultural studies may be traced back to the Frankfurt School, whose most ardent proponents, Max Horkheimer and Theodor Adorno, postulated a neo-Marxian passive and resigned audience in a society where certain cultural products and practices in the culture industry reproduce ideological domination.⁵⁸ Despite some stark differences in their focus, the Frankfurt School and much of contemporary cultural studies share “at least a family resemblance as practices that attempt to understand . . . commodity culture”⁵⁹ Frankfurt School theorists generally view mass-mediated popular culture as a field in which autocratic and dominant meanings are systematically reproduced and reinforced by the culture industries.⁶⁰

⁵⁴ See CHRIS ROJEK, CULTURAL STUDIES 27–28 (2007) (Rojek also observes that cultural studies are characterized by the three D’s of deconstruction, demythologization and demystification.).

⁵⁵ Lawrence Grossberg, *Identity and Cultural Studies: Is That All There Is?*, in QUESTIONS OF CULTURAL IDENTITY 87, 88 (Stuart Hall and Paul Du Gay eds., 1996).

⁵⁶ Austin Sarat & Jonathan Simon, *Cultural Analysis, Cultural Studies, and the Situation of Legal Scholarship*, in CULTURAL ANALYSIS, CULTURAL STUDIES, AND THE LAW: MOVING BEYOND LEGAL REALISM 1, 12 (Austin Sarat & Jonathan Simon eds., 2003).

⁵⁷ See, e.g., Douglas Kellner, *The Frankfurt School and British Cultural Studies: The Missed Articulation*, in RETHINKING THE FRANKFURT SCHOOL: ALTERNATIVE LEGACIES OF CULTURAL CRITIQUE 31, 43 (Jeffrey T. Nealon & Caren Irr eds., 2002) (Kellner points out that cultural study “operates with a transdisciplinary conception” in understanding how texts are “articulating discourses in a given sociohistorical conjuncture” and that one “should move from text to context, to the culture and society that constitutes the text and in which it should be read and interpreted.”).

⁵⁸ See generally MAX HORKHEIMER & THEODOR W. ADORNO, DIALECTIC OF ENLIGHTENMENT (John Cumming trans., 1972); Theodor W. Adorno, *Culture Industry Reconsidered*, in THE CULTURE INDUSTRY: SELECTED ESSAYS ON MASS CULTURE 98, 101 (J.M. Bernstein ed., Routledge Classics 2005) (1991) (“[I]ndividuality itself serves to reinforce ideology . . . its ideology above all makes use of the star system.”).

⁵⁹ Imre Szeman, *The Limits of Culture: The Frankfurt School and/or Cultural Studies*, in RETHINKING THE FRANKFURT SCHOOL: ALTERNATIVE LEGACIES OF CULTURAL CRITIQUE 59, 61 (Jeffrey T. Nealon & Caren Irr eds., 2002).

⁶⁰ The term “Frankfurt School” was first used in the 1960s to refer to the key works of

Extending this Frankfurt view to the contemporary famous or well-known trademarks, it appears that the cultural producers are creating and perpetuating a product—the brand—that induces the consumer to live in “a world of hypnotic definitions and automatic ideological equations.”⁶¹ In contrast to the Frankfurt School, the highly influential Birmingham Centre for Contemporary Cultural Studies (“Birmingham School”), established in 1964 by Richard Hoggart, and later headed by Stuart Hall, tends to see popular culture as a contested terrain in which individuals make and establish their own cultural meanings and, in the process, resist and even subvert the preferred meanings that are generated and circulated by the culture industries.⁶² The Birmingham School’s approach assigns a less important role to cultural producers, and is focused on how culture is made and practiced by different groups and classes in society struggling for cultural domination.⁶³ In demonstrating “how culture came to constitute distinct forms of identity and group membership,” these writings focused on “how subcultural groups resist dominant forms of culture and identity . . . and thus create oppositional identities, defining themselves against standard models.”⁶⁴

Although many of Hall’s works relate to televisual media, his key thesis may be extended to an understanding of the alpha brand as a “naturalistic illusion,” constituted by “the combination of verbal and visual discourse . . . [requiring] the most skillful and elaborate procedures of coding.”⁶⁵ The Birmingham School view on encoding and decoding in culture suggests a distinction between cultural texts and subtexts: culture conveys meanings and values explicitly through the

Horkheimer and Adorno. Later theoreticians used the label “Critical Theory” to describe their writings in this area. ROLF WIGGERSHAUS, *THE FRANKFURT SCHOOL: ITS HISTORY, THEORIES, AND POLITICAL SIGNIFICANCE* 1–8 (Michael Robertson trans., 1994). See also Tony Bennett, *Theories of the Media, Theories of Society*, in *CULTURE, SOCIETY AND THE MEDIA* 30, 41–47 (Gurevitch et al. eds., 1982); JÜRGEN HABERMAS, *THE PHILOSOPHICAL DISCOURSE OF MODERNITY* (Frederick Lawrence trans., 1990); STUART EWEN, *ALL CONSUMING IMAGES: THE POLITICS OF STYLE IN CONTEMPORARY CULTURE* (1988). Generally, the Frankfurt School has its roots in the dialectical materialism of Marxism. For early Marxist references to culture, see LUCIEN GOLDMANN, *CULTURAL CREATION* (1976). See also GEORG LUKÁCS, *HISTORY AND CLASS CONSCIOUSNESS: STUDIES IN MARXIST DIALECTS* (1971).

⁶¹ See Bennett, *supra* note 60, at 44.

⁶² See, e.g., Hall, *Encoding/Decoding*, *supra* note 40, at 128; IAIN CHAMBERS, *POPULAR CULTURE: THE METROPOLITAN EXPERIENCE* (1986); JOHN FISKE, *READING THE POPULAR* (1989).

⁶³ For Hall, popular culture is one of the sites where the “struggle for and against a culture of the powerful is engaged It is the arena of consent and resistance.” Stuart Hall, *Notes on Deconstructing the “Popular,”* in *PEOPLE’S HISTORY AND SOCIALIST THEORY* 227, 239 (Raphael Samuel ed., 1981). See also Janet Woollacott, *Messages and Meanings*, in *CULTURE, SOCIETY AND THE MEDIA* 91 (Gurevitch et al. eds., 1982).

⁶⁴ Kellner, *supra* note 57, at 35.

⁶⁵ Hall, *supra* note 46, at 76.

text, and it also conveys them implicitly via the subtext, in which obscured messages and values are encoded in cultural gestures, and then decoded by the audience-consumer to yield specific meanings. For example, Louis Vuitton explicitly encodes meaning through its ad campaigns, but also implicitly encodes meaning through impeccable customer service in the rarified atmosphere of its boutiques and throughout the entire LV “brand experience.”

Contemporary cultural studies in the last couple of decades are more concerned with the practices of popular culture, the relationships between audiences and producers, the formation of identity, and the nature of consumption. Scholars often adopt a multiperspectival approach that blends together ideas from earlier cultural studies scholarship discussed above, as well as from discourses and theories such as semiotics, gender and race studies, psychoanalysis, and postmodernism. Scholars like Austin Sarat and Jonathan Simon have been prominently involved in the “cultural analysis” of law, focusing on the cultural lives of law and how the law is “part of the cultural processes that actively contribute in the composition of social relations.”⁶⁶ Cultural perspectives on law are a growing part of contemporary legal scholarship, paralleling the emergence of cultural studies as an academic discipline. As Beebe has so persuasively demonstrated that “semiotic concepts can be applied to clarify and ameliorate fundamental areas of trademark doctrine and policy,”⁶⁷ this Article builds on his analysis of “sign value” as a “Saussurean structural value” that involves a “conspicuous display of distinctions, of ‘marginal differences.’”⁶⁸ In the field of semiotics and brand management, Oswald has written about how “brands grow in value to the extent that they resonate with the structure of myths, archetypes, and rhetorical operations at work in the cultural environment.”⁶⁹ Marketing semiotics, in particular, is “a field of investigation that is based on the proposition that goods often transcend their functional purpose and have symbolic value for consumers.”⁷⁰ It can be seen as essentially an extension of the critical theories of consumption advanced by Jean Baudrillard⁷¹ to modern day consumerism behavior.

⁶⁶ Sarat & Simon, *supra* note 56, at 19; *see also* LAW IN EVERYDAY LIFE (Austin Sarat & Thomas R. Kearns eds., 1993); Susan S. Silbey, *Making a Place for a Cultural Analysis of Law*, 17 LAW AND SOC. INQUIRY 39 (1992).

⁶⁷ Beebe, *supra* note 31, at 42. Justice Frankfurter called this a trademark’s “commercial magnetism.” *Mishawaka Rubber & Woolen Mfg. Co. v. S. S. Kresge Co.*, 316 U.S. 203, 205 (1942).

⁶⁸ Beebe, *supra* note 31, at 62. *See also* Barton Beebe, *The Semiotic Analysis of Trademark Law*, 51 UCLA L. REV. 621 (2004).

⁶⁹ OSWALD, *supra* note 22, at 8.

⁷⁰ *Id.* at 17.

⁷¹ *See, e.g.*, BAUDRILLARD, *supra* note 49.

While Beebe makes a clear distinction between, on the one hand, the “esteem” in which consumers hold a trademark and, on the other hand, the “differentiation” that characterizes strong brands and sets them apart from others,⁷² this distinction is perhaps less pronounced in the luxury fashion goods market. In the same manner that celebrities can “represent typical ways of behaving, feeling and thinking in contemporary society, ways that have been socially, culturally, historically constructed,”⁷³ alpha brands—especially luxury fashion brands—wield significant cultural power and play a prominent role in social identity formation.⁷⁴ Like celebrities who have become “common points of reference for millions of individuals who may never interact with one another, but who share, by virtue of their participation in a mediated culture [as the audience], a common experience and a collective memory,”⁷⁵ alpha brands have significant cultural cachet. Luxury fashion brands already function as Barthesian mythical significations of luxury and prestige, compared with other conventional fashion brands. Uche Okonkwo observes that such luxury brands are “associated with denotative words like opulence, superiority, exclusivity and wealth”⁷⁶ and they generally “share certain brand personality traits such as glamour, reliance, originality and sophistication.”⁷⁷ However, different luxury brands each connote a unique set of meanings, and each has focused on producing selective differentiated commodities—known as “narrow level positioning”⁷⁸—like the Hermès Birkin bag, the Chanel 2.55 handbag, the Gucci bamboo-top handle bag and the Louis Vuitton Speedy bag in the brand’s signature monogram. According to statistics from Seeking Alpha, a stock market analysis company, Louis Vuitton has a broader customer base than any other luxury brand among women in their twenties in Tokyo; ninety-four percent of such women own a Louis Vuitton product.⁷⁹

Ultimately, “[s]igns function . . . not through their intrinsic value but through their relative position.”⁸⁰ The status-signaling function of

⁷² Beebe, *supra* note 31, at 63.

⁷³ RICHARD DYER, HEAVENLY BODIES: FILM STARS AND SOCIETY 15–16 (2d ed. 2004). *See also* RICHARD DYER, STARS 3 (1979) (discussing how Hollywood, through its representation of movie stars, can reproduce the “dominant ideology” of Western society).

⁷⁴ *See, e.g.*, Hemphill & Suk, *supra* note 8, at 1149.

⁷⁵ JOHN B. THOMPSON, IDEOLOGY AND MODERN CULTURE: CRITICAL SOCIAL THEORY IN THE ERA OF MASS COMMUNICATION 163 (1990). *See also* *ETW v. Jireh Publ'g, Inc.*, 332 F.3d 915, 933 (6th Cir. 2003) (quoting *Cardtoons, L.C. v. Major League Baseball Players Ass'n*, 95 F.3d 959, 972 (10th Cir. 1996) (quoting THOMPSON, *supra*, at 163)).

⁷⁶ OKONKWO, *supra* note 5, at 111.

⁷⁷ *Id.* at 111–12.

⁷⁸ *Id.* at 116–17.

⁷⁹ *Id.* at 73.

⁸⁰ Beebe, *supra* note 31, at 53 (citing SAUSSURE, *supra* note 23, at 16).

the Louis Vuitton trademark is reinforced by the consistent encoding of specific values through a harmonised brand management strategy. This strategy extends from the print advertising campaigns, which emphasise a respect for tradition and quality to the meticulously orchestrated shopping experience inside and outside its stores. The brand increased prices during a recession, invested in innovation, heightened its focus on quality and collaborated with influential contemporary artists such as Richard Prince and Takashi Murakami. It is one of the most recognisable cultural symbols that connotes status, prestige and desirability, which also makes it one of the most vulnerable signs for recoding. In terms of recoding, scholars like John Fiske and Iain Chambers have emphasised the potential of audience reconstruction of dominant symbols of a culture. Fiske coined the term “semiotic democracy” to describe a world where empowered audiences freely and widely engage in the use of cultural symbols to express meanings that are different from the ones intended by their creators.⁸¹ Like Chambers, Fiske examines the construction of meanings by the audience, which creates parodies of and actively subverts the dominant encoding of the sign.⁸² Similarly, Jane Gaines, in her incisive cultural analysis of law, concludes that “the sign is disputed territory.”⁸³ Indeed, there is a significant emphasis in contemporary cultural studies on the notion of audience participation—be it complicit or resistant—in the hegemony of cultural texts propagated by the media and other producers.⁸⁴ This cultural perspective on recoding has come to the attention of the courts, as evident in recent cases like *Louis Vuitton Malletier S.A. v. Haute Diggity Dog*⁸⁵ and *ETW Corp. v. Jireh Publishing*.⁸⁶

Rosemary Coombe⁸⁷ and Michael Warner⁸⁸ writing about the constitution and politics of social and individual identity, have

⁸¹ JOHN FISKE, TELEVISION CULTURE 239 (1987). See also Sonia K. Katyal, *Semiotic Disobedience*, 84 WASH. U. L. REV. 489, 489–90 (2006); Michael Madow, *Private Ownership of Public Image: Popular Culture and Publicity Rights*, 81 CALIF. L. REV. 127, 146 (1993).

⁸² FISKE, *supra* note 62; CHAMBERS, *supra* note 62.

⁸³ JANE M. GAINES, CONTESTED CULTURE: THE IMAGE, THE VOICE, AND THE LAW 230 (1991).

⁸⁴ See, e.g., JOHN FISKE, MEDIA MATTERS: EVERYDAY CULTURE AND POLITICAL CHANGE (1994); DAVID MORLEY, THE NATIONWIDE AUDIENCE: STRUCTURE AND DECODING (1980); NICHOLAS ABERCROMBIE & BRIAN LONGHURST, AUDIENCES: A SOCIOLOGICAL THEORY OF PERFORMANCE AND IMAGINATION (1998); MAÏRE MESSENGER DAVIES ET AL., AUDIENCES AND PUBLICS: WHEN CULTURAL ENGAGEMENT MATTERS FOR THE PUBLIC SPHERE (Sonia Livingstone ed., 2005); JONATHAN BIGNELL, BIG BROTHER: REALITY TV IN THE TWENTY-FIRST CENTURY (2005); JONATHAN GRAY, WATCHING WITH THE SIMPSONS: TELEVISION, PARODY, AND INTERTEXTUALITY (2006).

⁸⁵ *Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC*, 507 F.3d 252, 261 (4th Cir. 2007).

⁸⁶ *ETW Corp. v. Jireh Publ'g*, 332 F.3d 915, 933 (6th Cir. 2003).

⁸⁷ ROSEMARY J. COOMBE, THE CULTURAL LIFE OF INTELLECTUAL PROPERTIES: AUTHORSHIP, APPROPRIATION, AND THE LAW (1998).

⁸⁸ MICHAEL WARNER, PUBLICS AND COUNTERPUBLICS (2002).

suggested that identity is predicated on a power struggle between dominant and subordinate groups. The term “subaltern” or “subculture” is frequently used in cultural studies to denote the subordination of particular identities by a dominant ideological hegemony; the “subaltern’s place [in society] is subsumed within . . . an experience of oppression which privileges particular exemplars as the ‘proper’ figures of identity.”⁸⁹ Building on Jürgen Habermas’ work on the public sphere,⁹⁰ Warner’s analysis of the struggles that bring individuals together as a public postulates that “subaltern counterpublics” usually articulate alternative power relations with the dominant public defined by race, gender, sexual orientation and other subordinated status.⁹¹ In an influential article, Nancy Fraser similarly contends that

[m]embers of subordinated social groups—women, workers, peoples of color, and gays and lesbians—have repeatedly found it advantageous to constitute alternative publics . . . [where they] invent and circulate counterdiscourses to formulate oppositional interpretations of their identities, interests, and needs.⁹²

Thus counterpublics are “counter” to the extent that they supply different ways of imagining participation within a political or social hierarchy by which their members’ identities are formed and transformed.⁹³ According to Warner, a counterpublic maintains “an awareness of its subordinate status. . . . [with respect] not just to ideas or policy questions but to the speech genres and mode of address that constitute the public”⁹⁴ Increasingly, there is judicial recognition of these groups asserting their alternative views in the political sphere.⁹⁵

Hall has also defined the taking of an existing meaning and reappropriating it for new meanings as “trans-coding”⁹⁶ and explained

⁸⁹ *Id.* at 92.

⁹⁰ *See, e.g.*, JÜRGEN HABERMAS, THE STRUCTURAL TRANSFORMATION OF THE PUBLIC SPHERE: AN INQUIRY INTO A CATEGORY OF BOURGEOIS SOCIETY (Thomas Burger & Frederick Lawrence trans., 1991); KEITH MICHAEL BAKER ET AL., HABERMAS AND THE PUBLIC SPHERE (Craig Calhoun ed., 1992).

⁹¹ WARNER, *supra* note 88, at 44–63, 117–20.

⁹² Nancy Fraser, *Rethinking the Public Sphere: A Contribution to the Critique of Actually Existing Democracy*, in KEITH MICHAEL BAKER ET AL., HABERMAS AND THE PUBLIC SPHERE 109, 123 (Craig Calhoun ed., 1992).

⁹³ WARNER, *supra* note 88, at 121–22.

⁹⁴ *Id.* at 119.

⁹⁵ *See, e.g.*, *Hurley v. Irish-Am. Gay, Lesbian and Bisexual Grp. of Boston*, 515 U.S. 557 (1995) (where the plaintiffs professed to express their group members’ pride as openly gay, lesbian, and bisexual individuals and support their march in the New York St. Patrick’s Day parade); *Raymen v. United Senior Ass’n, Inc.*, 409 F. Supp. 2d 15 (D.D.C. 2006) (where the defendants were protected by the First Amendment in the use of the plaintiff’s images in an advertising campaign that challenged various public policy positions taken by the American Association of Retired Persons).

⁹⁶ Hall, *The Spectacle of the “Other,” supra* note 40, at 270. The term “transfunctionalize” has

that repressed groups may use trans-coding strategies to reverse stereotypes, substitute “negative” portrayals with “positive” ones, or contest subordinate representations from within.⁹⁷ For example, if the Jacqueline Onassis sign is widely accepted as a “historic archetype” possessing “qualities of charisma, sophistication, elegance, trend-setting and uniqueness,”⁹⁸ then one may challenge this ideological signification by using Onassis’ identity in an oppositional mode. The commercial use of Onassis’ likeness by Christian Dior in an advertisement in *Onassis v. Christian Dior-New York, Inc.* reinforces the hegemony of the Onassis sign with the primary purpose of appropriating its associative value. However, other recoding uses of the Jacqueline Onassis sign, depending on the content, form and context of the message, *may* be seen to be political speech that challenges the dominant ideologies of class, race or gender.⁹⁹ While trans-coding is of immediate relevance to right of publicity jurisprudence,¹⁰⁰ it is also applicable to the transformation doctrine in the fair use defence of copyright law. In copyright fair use, the pertinent inquiry is whether the secondary work “adds something new, with a further purpose or different character, altering the first with new expression, meaning, or message”;¹⁰¹ by this definition of fair use doctrine, many trans-coding practices, especially in appropriation art, can be said to be “transformative.”¹⁰² It has been astutely observed that “once a court has found the use to be ‘transformative’ and to promote speech and/or learning, . . . that court is unlikely to find the same activity to violate the copyright holder’s trademark.”¹⁰³ In the context of trademarks, it may be argued that parodic and satirical uses of a mark in offering social commentary are transcoding practices that attempt to subvert the original meanings of the marks; such practices invariably

also been used to describe how subcultures assign new and often contradictory meanings to signs as understood by mainstream society. PAUL NATHANSON, *OVER THE RAINBOW: THE WIZARD OF OZ AS A SECULAR MYTH OF AMERICA* 241 (1991) (citing M. Gottdiener, *Hegemony and Mass Culture: A Semiotic Approach*, 90 AM. J. SOC. 979 (1985)).

⁹⁷ Hall, *The Spectacle of the “Other,” supra* note 40, at 270–75. *See also* Sonia K. Katyal, *Performance, Property, and the Slashing of Gender in Fan Fiction*, 14 AM. U. J. GENDER SOC. POL’Y & L. 461, 489 (2006).

⁹⁸ *Onassis v. Christian Dior-New York, Inc.*, 472 N.Y.S. 2d 254, 261 (Sup. Ct. 1984).

⁹⁹ *See* David Tan, *Political Recoding of the Contemporary Celebrity and the First Amendment*, 2 HARV. J. SPORTS & ENT. L. 1, 39–40 (2011).

¹⁰⁰ *Id.* at 37–50.

¹⁰¹ *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 579 (1994).

¹⁰² *See generally* David Tan, *What Do Judges Know About Contemporary Art?: Richard Prince and Reimagining the Fair Use Test in Copyright Law*, 16 MEDIA & ARTS L. REV. 381 (2011); William M. Landes & Richard A. Posner, *The Legal Protection of Postmodern Art*, in THE ECONOMIC STRUCTURE OF INTELLECTUAL PROPERTY LAW 254, 269 (2003).

¹⁰³ Jane C. Ginsburg, *Of Mutant Copyrights, Mangled Trademarks, and Barbie’s Beneficence: The Influence of Copyright on Trademark Law*, in TRADEMARK LAW AND THEORY: A HANDBOOK OF CONTEMPORARY RESEARCH 481, 493 (Graeme B. Dinwoodie & Mark D. Janis eds., 2008).

portray the marks in a manner that the original brand owner would disapprove of, but courts are increasingly more likely to find instances of irreverent transcoding not to be infringing¹⁰⁴ or dilutive in nature.¹⁰⁵

In summary, from a cultural studies perspective, the political agenda of counterpublics or subaltern groups may be best communicated to mainstream society through the use of widely recognised trademarks—as semiotic signs—to which the public have ascribed particular representative values or characteristics. Judge Kozinski in *Mattel Inc. v. MCA Records, Inc.*, opined that

[t]rademarks often fill in gaps in our vocabulary and add a contemporary flavor to our expressions. Once imbued with such expressive value, the trademark becomes a word in our language and assumes a role outside the bounds of trademark law.

. . . .

. . . Were we to ignore the expressive value that some marks assume, trademark rights would grow to encroach upon the zone protected by the First Amendment. Simply put, the trademark owner does not have the right to control public discourse whenever the public imbues his mark with a meaning beyond its source-identifying function.¹⁰⁶

As explained earlier, the well-known trademarks or alpha brands that are constitutive of our cultural heritage have transcended their source designation function, and are symbolic of the ideological hegemonies of social identities in contemporary society. Their recoding by counterpublics may be viewed as “[p]ractices of articulating social difference [that] are central to democratic politics.”¹⁰⁷ For example, when Nadia Plesner designed a not-for-profit T-shirt featuring an emaciated Darfur victim holding a Louis Vuitton handbag and a dog bearing a striking resemblance to Paris Hilton’s beloved Tinkerbell, she was clearly using the Louis Vuitton mark to express a counter-

¹⁰⁴ See, e.g., *Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC*, 507 F.3d 252 (4th Cir. 2007) (holding that there was no likelihood of confusion in respect of “Chewy Vuiton” dog toy); but see *Ate My Heart Inc. v. Mind Candy Ltd.*, 2011 WL 4706936 (holding that the “Lady Goo Goo” animated character did infringe the Lady Gaga trademark). For an argument that the English *Ate My Heart* decision was incorrectly decided, see David Tan, *Goo Goo Gaga: The Chilling Effect of the Trade Mark Monster* 17 MEDIA & ARTS LAW REVIEW 82 (2012).

¹⁰⁵ Compare the decision involving a humorous depiction of a Muppet character in *Hormel Foods Corp. v. Jim Henson Prods., Inc.*, 73 F.3d 497 (2d Cir. 1996) (holding there was no dilution by tarnishment), with that involving a declaration of a love for illegal drugs like cocaine in *Coca-Cola Co v. Gemini Rising, Inc.*, 346 F. Supp. 1183 (E.D.N.Y. 1972) (holding that there was a tendency to impugn the product and injure Coca-Cola’s business reputation).

¹⁰⁶ *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 900 (9th Cir. 2002) (citation omitted).

¹⁰⁷ COOMBE, *supra* note 87, at 295. See also WARNER, *supra* note 88, at 210.

majoritarian view about conspicuous consumption.¹⁰⁸

II. ENCODING/DECODING/RECODING/TRANSCODING OF LOUIS VUITTON

The Louis Vuitton brand, founded in 1854, is today worth more than Tiffany, Fendi, Cartier, Rolex and Chanel combined.¹⁰⁹ The famous Monogram mark, which appears on its leather goods, clothing, and fashion accessories—comprising the LV and the flower quatrefoil marks arranged in a distinctive repeated pattern—identifies much more than the origin of manufacture of the products. Louis Vuitton products are the systematized significations of capitalist consumption and heightened social status, and are rarely, if ever, consumed or desired for their utilitarian functions. Recognising the essential function of a trademark as a designation of source or origin, however, does not preclude an acknowledgment that a trademark *may* have other functions.¹¹⁰ In an implicit recognition of the semiotic nature of a mark, the European Court of Justice noted that the “trade mark acquires a life of its own, making a statement . . . about quality, reputation and even, in certain cases, a way of seeing life.”¹¹¹

Jason Bosland makes a compelling argument regarding trademarks and culture:

From a cultural perspective trade marks are vitally important. Not just an aid to consumers searching for desirable goods and service, trade marks also constitute a rich form of cultural expression—a language that cuts across social and political divides to provide a wealth of material with which to identify, negotiate and augment cultural meanings and subjectivities.¹¹²

¹⁰⁸ See Sheila Marikar, *Louis Vuitton on Artist's Darfur Project: Bag It*, ABC NEWS (May 14, 2008), <http://abcnews.go.com/Entertainment/BeautySecrets/story?id=4839919&page=1#.T3Z3w464BPY>. All profits from the t-shirt and poster are donated to Divest for Darfur, a national campaign to encourage firms to withdraw investments from companies that help fund genocide in Darfur. Louis Vuitton sent Plesner a cease-and-desist letter and threatened litigation. She eventually succumbed and stopped the production of her countercultural merchandise.

¹⁰⁹ Mark Ritson, *Louis Vuitton: The World's Strongest Luxury Brand*, LUXURY SOCIETY (Mar. 25, 2011), <http://luxurysociety.com/articles/2011/03/louis-vuitton-the-worlds-strongest-luxury-brand>.

¹¹⁰ E.g., Rochelle Cooper Dreyfuss, *Expressive Genericity: Trademarks as Language in the Pepsi Generation*, 65 NOTRE DAME L. REV. 397 (1990); Alex Kozinski, *Trademarks Unplugged*, 68 N.Y.U. L. REV. 960 (1993); Megan Richardson, *Trade Marks and Language*, 26 SYDNEY L. REV. 193 (2004).

¹¹¹ Case C-206/01, *Arsenal Football Club Plc v. Reed*, 2002 E.C.R. I-10273, at I-10286. Contrast this with the view of the U.S. Supreme Court in *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23 (2003).

¹¹² Jason Bosland, *The Culture of Trade Marks: An Alternative Cultural Theory Perspective*, 10 MEDIA & ARTS L. REV. 99, 99 (2005). See also Megan Richardson, *Trade Marks and Language*, 26 SYDNEY L. REV. 193, 213 (2004).

A trademark is often identified by distinctive visual elements; it embodies a bundle of affective values for the consumer, and its meaning is shaped by producers and consumers. Commentator Jennifer Davis argues that brand values attached to certain marks have been “nurtured by the proprietor and, as such, the question is not whether they belong in the public domain, but to what extent they may be protected through trade mark registration from use by third parties.”¹¹³ The protection for well-known trademarks is increasingly extending beyond their meaning as a badge of origin. In the United States, despite the availability of trademark dilution actions,¹¹⁴ free speech considerations often trump the proprietary interests of trademark owners,¹¹⁵ as evident in the repeated failure of Mattel to protect the Barbie mark¹¹⁶ from unauthorized parody or satirical uses, and cases like *Louis Vuitton Malletier S.A. v. Haute Digitty Dog*¹¹⁷ and *Hormel Foods Corp. v. Jim Henson Productions*.¹¹⁸ However, the ECJ appears willing to provide

¹¹³ Jennifer Davis, *Between a Sign and a Brand: Mapping the Boundaries of a Registered Trade Mark in European Union Trade Mark Law*, in TRADE MARKS AND BRANDS: AN INTERDISCIPLINARY CRITIQUE 65, 82 (Lionel Bently, Jennifer Davis & Jane C. Ginsburg eds., 2008). *Contra* Rosemary J. Coombe, *Objects of Property and Subjects of Politics: Intellectual Property Laws and Democratic Dialogue*, 69 TEX. L. REV. 1853, 1876 (1991) (arguing that trademark owners have “the ability to restrict and control meaning” because they “own” the sign).

¹¹⁴ See Trademark Dilution Revision Act of 2006, Pub. L. 109-312, § 2, 120 Stat. 1730, 1730–32 (2006) (amending 15 U.S.C. § 1125(2)(c)(1) (1946)) [hereinafter TDRA] (“Subject to the principles of equity, the owner of a famous mark that is distinctive . . . shall be entitled to an injunction against another person who . . . commences use of a mark or trade name in commerce that is likely to cause dilution by blurring or dilution by tarnishment of the famous mark, regardless of the presence or absence of actual or likely confusion, of competition, or of actual economic injury.”). Historically courts have treated substantial similarity—a judicially created standard—as a threshold showing in dilution by blurring claims. This has posed a significant limitation on such claims and has made it easier for third parties to avoid liability by using marks that are similar, but not “identical or nearly identical” or “substantially similar,” to the famous mark. However, both the Second Circuit and Ninth Circuit have removed the “identical or nearly identical” standard from its dilution analysis, with each holding that the standard did not survive Congress’ adoption of the TDRA in 2006. See *Starbucks Corp. v. Wolfe’s Borough Coffee, Inc.*, 588 F.3d 97 (2d Cir. 2009); *Levi Straus & Co. v. Abercrombie & Fitch Trading Co.*, 633 F.3d 1158 (9th Cir. 2011). These decisions represent a significant change in federal dilution law (at least in the Second and Ninth Circuits, and likely in other courts in the future), and should provide trademark owners greater protection for their famous trademarks. Nonetheless, the Act incorporates robust First Amendment protections that render non-actionable, *inter alia*, uses that parody, criticize, or comment on the famous mark owner. Lanham Act, 15 U.S.C. 1125(c)(3)(A)(ii) (2006).

¹¹⁵ See Richardson, *supra* note 112, at 219 (“[T]he results are perverse if all expressive uses no matter how meagre [sic] their contribution to social discourse, how destructive they may be to a trade mark’s integrity or imagery, and how commercial their flavour now find exemption.”).

¹¹⁶ E.g., *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894 (9th Cir. 2002); *Mattel, Inc. v. Pitt*, 229 F. Supp. 2d 315 (S.D.N.Y. 2002); *Mattel Inc. v. Walking Mountain Prods.*, 353 F.3d 792 (9th Cir. 2003).

¹¹⁷ *Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC*, 507 F.3d 252 (4th Cir. 2007).

¹¹⁸ *Hormel Foods Corp. v. Jim Henson Prods., Inc.*, 73 F.3d 497 (2d Cir. 1996).

protection to the brand values that might be embodied in a trademark beyond its source designation function, as demonstrated in the Court's decision in *Arsenal Football Club v. Reed*.¹¹⁹ The "communication functions" of a mark, especially for well-known trade marks with reputations, are becoming increasingly important in Strasbourg jurisprudence.¹²⁰ Such developments were welcomed by a number of academic commentators,¹²¹ but at the same time have garnered a fair share of criticisms.¹²² More recently, the ECJ in *L'Oréal S.A. v. Bellure NV* held that "the taking of unfair advantage of the distinctive character or the repute of a mark . . . does not require that there be a likelihood of confusion or a likelihood of detriment to the distinctive character or the repute of the mark or, more generally, to its proprietor."¹²³ The court noted that "[a]s regards the concept of 'taking unfair advantage of the distinctive character or the repute of the trade mark', also referred to as 'parasitism' or 'free-riding', that concept relates not to the detriment caused to the mark but to the advantage taken by the third party as a result of the use of the identical or similar sign."¹²⁴

In interpreting Article 5(2) of the European Council Directive 89/104/EEC, the ECJ was of the view that an infringing use of a well-known mark may occur by any one of the following: blurring, tarnishment, or parasitism (i.e., taking unfair advantage or free-riding).¹²⁵ With regard to parasitism, the ECJ exhibited a strong reliance on an unjust enrichment rationale: "[A]n advantage [is] taken unfairly by that third party of the distinctive character or the repute of that mark where that party seeks by that use to ride on the coat-tails of the mark . . . in order to benefit from the power of attraction, the reputation and the prestige of that mark"¹²⁶ The Office of Harmonization for the Internal Market ("OHIM") Board of Appeal was of the following view:

¹¹⁹ See Case C-206/01, *Arsenal Football Club Plc v. Reed*, 2002 E.C.R. I-10273. See also Jennifer Davis, *To Protect or Serve? European Trade Mark Law and the Decline of the Public Interest*, 25 EUR. INTEL. PROP. REV. 180 (2003).

¹²⁰ E.g., Trimmer, *infra* note 176; Christopher Morcom, *L'Oréal v Bellure—Who Has Won?*, 31 EUR. INTEL. PROP. REV. 627 (2009).

¹²¹ E.g., Helen Norman, *Time to Blow the Whistle on Trade Mark Use?*, 1 INTEL. PROP. Q. 1 (2004); Robert Sumroy & Carina Badger, *Infringing 'Use in the Course of Trade', Trade Mark Use and the Essential Function of the Trade Mark*, in TRADE MARK USE, 164 (Jeremy Phillips & Ilanah Simon eds., 2005).

¹²² E.g., Ng-Loy Wee Loon, *Time to Re-think the Ever Expanding Concept of Trade Marks? Re-calibrating Singapore's Trade Mark Law After the Controversial US-Singapore FTA*, 304 EUR. INTEL. PROP. REV. 151 (2008).

¹²³ Case C-487/07, *L'Oréal S.A. v. Bellure NV*, 2009 E.C.R. I-05185 ¶ 50.

¹²⁴ *Id.* at ¶ 21.

¹²⁵ *Id.* at ¶¶ 5, 39–41.

¹²⁶ *Id.* at ¶ 50.

As to unfair advantage . . . that is taken when another undertaking exploits the . . . repute of the earlier mark to the benefit of its own marketing efforts. In that situation that undertaking effectively uses the renowned mark as a vehicle for generating consumer interest in its own products.¹²⁷

It appears that recent European development in trademark laws has embraced the idea that encoded meanings can confer on a trademark a set of brand values, which are worthy of protection.¹²⁸ A consumer does not buy a product; he or she buys a brand that promises an expectation. Scholars have also contended that from the consumer perspective, the brand overwhelms the trademark. Jonathan Schroeder, whose research focuses on the production and consumption of images, remarks that “[c]ontemporary branding’s reliance on visual images implies rethinking legal perspectives on trade marks.”¹²⁹ Similarly, Trimmer has also urged that courts should “modernise their perception of where the real value in trade marks lie and become just a little more image conscious.”¹³⁰

What do all these developments mean for an alpha brand like Louis Vuitton that has dedicated significant investments to promoting its encoded brand values, but has at the same time become a cultural icon imbued with important social meanings that make it a target for myriad recoding opportunities? Some of the writings on the Disney brand—a comparable alpha brand—may be instructive.¹³¹ For example, it has been said that

Disney uses its trademark techniques . . . and forms . . . to tell stories with popular yet enduring themes vital to the contemporary capitalist culture of the United States Indeed, Disney narratives are unsurpassed in their narrative fidelity to dominant ideology and

¹²⁷ Case R 308/2003-1, *Mango Sport System S.R.L. Socio Unico Mangone Antonio Vincenzo v. Diknah S.L.*, 2005 ETMR 5, 32.

¹²⁸ *E.g.*, Case C-487/07, *L’Oréal*; Case C-206/01, *Arsenal Football Club Plc v. Reed*, 2002 E.C.R. I-10273. *Contra* O2 Holdings Ltd. v. Hutchinson 3G Ltd., 2006 EWHC 534 (Ch). For a more recent discussion in the English Court of Appeal, see also *Whirlpool Corp. v. Kenwood Ltd.*, 2009 EWCA Civ. 753 at 136–38.

¹²⁹ Jonathan E. Schroeder, *Brand Culture: Trade Marks, Marketing and Consumption*, in *TRADE MARKS AND BRANDS: AN INTERDISCIPLINARY CRITIQUE* 161, 162 (Lionel Bently, Jennifer Davis & Jane C. Ginsburg eds., 2008).

¹³⁰ Bonita Trimmer, *The Power of Attraction: Do Trade Marks Have an “Image” Problem in the English Courts?*, 31 EUR. INTEL. PROP. REV. 195, 201 (2009).

¹³¹ *See, e.g.*, *RETHINKING DISNEY: PRIVATE CONTROL, PUBLIC DIMENSION* (Mike Budd & Max H. Kirsch eds., 2005); Eleanor Byrne & Martin McQuillan, *DECONSTRUCTING DISNEY* (1999); GIROUX & POLLOCK, *supra* note 36.

cultural values, consistently asking audiences to enter believable fantasy worlds.¹³²

Luxury brands have the same effect of inviting consumers to imbibe semiotic meanings. In using celebrities like Madonna, Jennifer Lopez, Uma Thurman, Scarlett Johansson, and Michelle Williams at the height of their popularity in its advertising campaigns, as well as associating with cultural icons like Zinedine Zidane, Andre Agassi, Steffi Graf, and Muhammad Ali in its brand values positioning,¹³³ Louis Vuitton has successfully capitalized on the affective relationship between the celebrity and the audience to ensure that whatever cultural meanings attached to the celebrity can shift along unimpeded paths from the celebrity to its brand and products.¹³⁴ By aligning itself with these celebrities, the Louis Vuitton brand narrative has infused its semiotic sign with a specific hegemonic signification that naturalizes elite individualism. The contestations of these ideological premises have the potential to destabilize the myths that Louis Vuitton has painstakingly constructed over the decades, and it is unsurprising that the company has been almost as aggressive as Disney in issuing cease-and-desist letters to protect its trademarks. However, the challenges to Louis Vuitton's cultural hegemony in the form of parodies and satires, especially in the context of subaltern counterpublic discourses, are highly expressive activities deserving of protection under the freedom of expression constitutional guarantees. An understanding of the semiotic nature of a trademark can better help courts decide if these recordings are predominantly parasitic (and therefore infringing trademark laws) or primarily expressive (and thus excused from liability). The following two cases illustrate this.

A. *Louis Vuitton Malletier S.A. v. Haute Diggity Dog LLC*

The decision of the United States Fourth Circuit Court of Appeals in *Louis Vuitton Malletier S.A. v. Haute Diggity Dog LLC* (“*Chewy Vuiton*”) sheds some light on how a parody could be considered in the likelihood of confusion analysis.¹³⁵ In that case, the defendant Haute Diggity Dog manufactured, among other things, plush chew toys for dogs, which, it claims, parody famous trademarks on luxury products,

¹³² Lee Artz, *Monarchs, Monsters, and Multiculturalism: Disney's Menu for Global Hierarchy*, in *RETHINKING DISNEY: PRIVATE CONTROL, PUBLIC DIMENSION* 75, 79 (Mike Budd & Max H. Kirsch eds., 2005).

¹³³ Alethia Tiang, *LV Chooses Ali for Global Campaign*, *MARKETING-INTERACTIVE.COM* (June 12, 2012), <http://www.marketing-interactive.com/news/33351>.

¹³⁴ David Tan, *Affective Transfer and the Appropriation of Commercial Value: A Cultural Analysis of the Right of Publicity*, 9 VA. SPORTS & ENT. L. J. 272, 298–99 (2010).

¹³⁵ 507 F.3d 252 (4th Cir. 2007).

including those of Louis Vuitton Malletier. The particular Haute Diggity Dog chew toys in question were small imitations of handbags labeled “Chewy Vuitton” that mimic Louis Vuitton Malletier’s distinctive monogram handbags,¹³⁶ “undisputedly evok[ing] LVM handbags of similar shape, design, and color.”¹³⁷

The Fourth Circuit held that for trademark purposes, “[a] ‘parody’ is defined as a simple form of entertainment conveyed by juxtaposing the irreverent representation of the trademark with the idealized image created by the mark’s owner.”¹³⁸ In addition, the court explained:

“A parody must convey two simultaneous—and contradictory—messages: that it is the original, but also that it is *not* the original and is instead a parody.” . . . This second message must not only differentiate the alleged parody from the original but must also communicate some articulable element of satire, ridicule, joking, or amusement. Thus, “[a] parody relies upon a difference from the original mark, presumably a humorous difference, in order to produce its desired effect.”¹³⁹

On the facts of the case, the court concluded that the Chewy Vuitton dog toys were successful parodies of the Louis Vuitton handbags. The court found that “the pet chew toy is obviously an irreverent, and indeed intentional, representation of an LVM handbag,” and it “undoubtedly and deliberately conjures up the famous LVM marks and trade dress, but at the same time, it communicates that it is not the LVM product.”¹⁴⁰ The court then proceeded to consider the *Pizzeria Uno* factors¹⁴¹ and held that there was on balance no likelihood of confusion. In particular, the court observed that “[d]espite Haute Diggity Dog’s obvious intent to profit from its use of parodies, this action does not amount to a bad faith intent to create consumer confusion. To the contrary, the intent is to do just the opposite—to

¹³⁶ In addition to Chewy Vuitton (a parody of Louis Vuitton), the company also produced Chewnel No. 5 (Chanel No. 5), Furcedes (Mercedes), Jimmy Chew (Jimmy Choo), Dog Perignonn (Dom Perignon), Sniffany & Co. (Tiffany & Co.), and Dogior (Dior). The chew toys and pet beds are plush, made of polyester, and have a shape and design that loosely imitate the signature product of the targeted brand. They are mostly distributed and sold through pet stores, although one or two Macy’s stores in the United States carries Haute Diggity Dog’s products. The products are also sold online. The dog toys are generally sold for less than twenty U.S. dollars, although larger versions of the plush dog beds sell for more than one hundred U.S. dollars. *Id.* at 258.

¹³⁷ *Id.*

¹³⁸ *Id.* at 260 (citing *People for the Ethical Treatment of Animals v. Doughney*, 263 F.3d 359, 366 (4th Cir. 2001)) [hereinafter *PETA*].

¹³⁹ *Id.* (citing *PETA*, 263 F.3d at 366); *Jordache Enters., Inc. v. Hogg Wyld, Ltd.*, 828 F.2d 1482, 1486 (10th Cir. 1987).

¹⁴⁰ *Id.*

¹⁴¹ *Pizzeria Uno Corp. v. Temple*, 747 F.2d 1522 (4th Cir. 1984) (using a seven-factor test).

evoke a humorous, satirical association that *distinguishes* the products.”¹⁴² This transcoding use of the Louis Vuitton mark is exactly the kind of subversive recoding alluded to by scholars like Fiske, Hughes and Warner.

The bar for tarnishment is a high one in U.S. law, particularly when First Amendment free speech concerns are triggered by a parody. The courts there have found that a trademark may be tarnished when it is “‘linked to products of shoddy quality, or is portrayed in an unwholesome or unsavory context,’ with the result that ‘the public will associate the lack of quality or lack of prestige in the defendant’s goods with the plaintiff’s unrelated goods.’”¹⁴³ In *V Secret Catalogue v. Moseley*, the Sixth Circuit observed that there have been “at least eight federal cases in six jurisdictions that conclude that a famous mark is tarnished when its mark is semantically associated with a new mark that is used to sell *sex-related products*.”¹⁴⁴ In the United States, there appears to be “a clearly emerging consensus in the case law” that “a semantic ‘association’ is equivalent to a liability-creating mental ‘association’ of a junior mark . . . with a famous mark . . . that constitutes dilution by tarnishment when the junior mark is used to sell sexual toys, videos and similar soft-core pornographic products.”¹⁴⁵ However, outside of this sex-related context, parodies, even where a semantic association is present, are accorded a different treatment. The *Haute Diggity Dog* case is paradigmatic. Similarly, in *Hormel Foods*, despite the obvious semantic association, the Second Circuit Court of Appeals rejected the argument that the image of the Muppet character Spa’am, as a grotesque, untidy wild boar will “‘inspire negative and unsavory associations with SPAM® luncheon meat.’”¹⁴⁶ The court held that the “sine qua non of tarnishment is a finding that plaintiff’s mark will suffer negative associations through defendant’s use,” and the fact that the defendants’ merchandise would not be in direct competition with that of Hormel was “an important, even if not determinative,

¹⁴² *Chewy Vuiton*, 507 F.3d at 263.

¹⁴³ *Hormel Foods Corp. v. Jim Henson Prods.*, 73 F.3d 497, 507 (2d Cir. 1996) (quoting *Deere & Co. v. MTD Prods., Inc.*, 41 F.3d 39, 43 (2d Cir. 1994)).

¹⁴⁴ *V Secret Catalogue, Inc. v. Moseley*, 605 F.3d 382, 388 (6th Cir. 2010) (emphasis added). *See also* *Pfizer Inc. v. Sachs*, 652 F.Supp 2d 512, 525 (S.D.N.Y. 2009) (defendants’ display at an adult entertainment exhibition of two models riding a VIAGRA-branded missile and distributing condoms would likely harm the reputation of Pfizer’s trademark); *Mattel, Inc. v. Internet Dimensions Inc.*, 55 U.S.P.Q.2d 1620, 1627 (S.D.N.Y. 2000) (linking BARBIE with pornography will adversely colour the public’s impressions of BARBIE); *Polo Ralph Lauren L.P. v. Schuman*, 46 U.S.P.Q.2d 1046, 1048 (S.D. Tex. 1998) (defendants’ use of “The Polo Club” or “Polo Executive Retreat” as an adult entertainment club tarnished POLO trademark).

¹⁴⁵ *V Secret*, 605 F.3d at 387.

¹⁴⁶ *Hormel Foods*, 73 F.3d at 507.

factor.”¹⁴⁷ More importantly, the court explained:

Here, Henson does not seek to ridicule SPAM in order to sell more of its competitive products; rather, the parody is part of the product itself. Without Spa’am, the joke is lost.¹⁴⁸

In *Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC*, the Fourth Circuit justified its consideration of a parody element in conducting the blurring analysis:

While a parody intentionally creates an association with the famous mark in order to be a parody, it also intentionally communicates, if it is successful, that it is *not* the famous mark, but rather a satire of the famous mark. That the defendant is using its mark as a parody is therefore relevant in the consideration of these statutory factors.

. . . Indeed, by making the famous mark an object of the parody, a successful parody might actually enhance the famous mark’s distinctiveness by making it an icon. The brunt of the joke becomes yet more famous.¹⁴⁹

One of the few generalizations about the U.S. cases is that the defendant’s use of parody or satire is not in itself a defence against trademark infringement or dilution. However, “even when some commercial motive is present, [the] defendant is not liable merely because its satire or parody leads the public to think of the claimant’s famous mark.”¹⁵⁰ In the United States, “courts go to great lengths in weighing the interests of the public, the mark holder, and the parodist in determining whether to grant an injunction against a parody in the absence of confusion.”¹⁵¹ As the Tenth Circuit observed, “where a party chooses a mark as a parody of an existing mark, the intent is not necessarily to confuse the public but rather to amuse.”¹⁵² With respect to the unfair advantage provision of Article 9(1)(c) of the Community Trade Mark regulation, again the observations of the Tenth Circuit are pertinent:

¹⁴⁷ *Id.*

¹⁴⁸ *Id.* at 508.

¹⁴⁹ *Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC*, 507 F.3d 252, 267 (4th Cir. 2007) (citation omitted). *See also* *Starbucks Corp. v. Wolfe’s Borough Coffee, Inc.*, 588 F.3d 97, 112–13 (2d Cir. 2009).

¹⁵⁰ *See* LOUIS ALTMAN & MALLA POLLACK, *CALLMANN ON UNFAIR COMPETITION, TRADEMARKS AND MONOPOLIES* § 22:61 (4th ed. 2003).

¹⁵¹ Justin J. Gunnell, *Evaluation of the Dilution-Parody Paradox in the Wake of the Trademark Dilution Revision Act of 2006*, 26 *CARDOZO ARTS & ENT. L.J.* 441, 462 (2008).

¹⁵² *Jordache Enters., Inc. v. Hogg Wyld, Ltd.*, 828 F.2d 1482, 1486 (10th Cir. 1987).

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In one sense, a parody is an attempt “to derive benefit from the reputation” of the owner of the mark, . . . if only because no parody could be made without the initial mark. *The benefit to the one making the parody, however, arises from the humorous association* A parody relies upon a difference from the original mark, presumably a humorous difference, in order to produce its desired effect.¹⁵³

It should also be noted that not all parodies are unequivocally protected. The Second Circuit has warned:

We have accorded considerable leeway to parodists whose expressive works aim their parodic commentary at a trademark or a trademarked product, . . . but have not hesitated to prevent a manufacturer from using an alleged parody of a competitor’s mark to sell a competing product¹⁵⁴

If one views the Louis Vuitton trademark as a semiotic sign—or a Barthesian myth—that is the paradigmatic connotation of luxury, glamour, and prestige in a consumerist society, then a parody has the capacity to function as a semiotic disruption or a demythologizing tool. In Barthesian terms, the encoded alpha brand of Louis Vuitton has succeeded in “giving an [sic] historical intention a natural justification”¹⁵⁵ in contemporary society, and has in fact “depoliticized speech.”¹⁵⁶ The parodic commentary, or indeed any critique of the Louis Vuitton sign, is a form of transcoding that has the potential to contest cultural representations and challenge ideology.¹⁵⁷ In First Amendment rhetoric, the transcoding use of a well-known trademark may be construed as an act of *repoliticizing* speech—a *primarily expressive* activity that merits constitutional protection. The notion of transcoding has also been implicitly recognized by the Ninth Circuit in *Mattel Inc. v. Walking Mountain Productions*, where the court commented that “[b]y developing and transforming associations with Mattel’s Barbie doll, Forsythe has created the sort of social criticism and parodic speech protected by the First Amendment and promoted by the Copyright Act.”¹⁵⁸

With Louis Vuitton being consistently ranked as the most valuable luxury brand in the world, it is not surprising that the company

¹⁵³ *Id.* (emphasis added).

¹⁵⁴ *Harley-Davidson, Inc. v. Grottanelli*, 164 F.3d 806, 812 (2d Cir. 1999).

¹⁵⁵ BARTHES, *supra* note 24, at 142.

¹⁵⁶ *Id.* at 143.

¹⁵⁷ See, e.g., Hall, *The Spectacle of the “Other,” supra* note 40, at 270–75.

¹⁵⁸ *Mattel Inc. v. Walking Mountain Prods.*, 353 F.3d 792, 803 (9th Cir. 2003).

aggressively seeks to enforce its intellectual property rights.¹⁵⁹ But parodies are often harmless. They neither compete directly with nor impair the distinctiveness of the primary trademark; moreover, consumers are unlikely to be confused as to their source. Perhaps the only harm the primary marks suffer is others having a laugh at their expense. The best course of action is aptly stated by Judge Kozinski of the Ninth Circuit Court of Appeals in *Mattel Inc. v. MCA Records Inc.*, where the manufacturers of the Barbie doll failed in their trademark infringement and dilution claims against the record company for the chart-topping parody music single “Barbie Girl,” concluding that “[t]he parties are advised to chill.”¹⁶⁰

B. *City Chain Stores (S) Pte Ltd. v. Louis Vuitton Malletier*

A more invidious attempt to cash in on the semiotic values of Louis Vuitton was successful in *City Chain Stores (S) Pte Ltd. v. Louis Vuitton Malletier*,¹⁶¹ where the Court of Appeal of Singapore overturned a lower court’s decision,¹⁶² finding that the defendant’s use of a quatrefoil flower mark on a watch neither diluted nor infringed on Louis Vuitton’s trademark. The decision is important for two reasons: first, the decision offers a sound rejection of a broader European approach that protects the brand values behind a trademark, and second, it contains a narrow interpretation of the meaning of a “well-known” mark in the context of a dilution claim.

At the heart of the dispute is the Flower Quatrefoil mark. This mark is one of four constituent elements that make up the Louis Vuitton Monogram Canvas design (“the Monogram”) which has been applied to the Louis Vuitton’s goods since 1896. The Monogram was first registered as a trademark in France in 1905, and is registered as a trade

¹⁵⁹ *E.g.*, *Louis Vuitton Malletier, S.A. v. Akanoc Solutions, Inc.*, 591 F. Supp. 2d 1098 (N.D. Cal. 2008); *Louis Vuitton Malletier v. Dooney & Bourke, Inc.*, 454 F.3d 108 (2d Cir. 2006); *Louis Vuitton Malletier, S.A. v. eBay Inc.*, Tribunal de Commerce [T.C.] [commercial court] Paris, June 30, 2008, First Section B, No. 2006077799, CL-1; *Louis Vuitton Malletier S.A. v. Bags O’Fun Inc.*, 2002 FCT 78, 2 F.C. D-34; *Louis Vuitton Malletier S.A. v. Toea Pty Ltd.*, (2006) FCA 1443; *Louis Vuitton Malletier S.A. v. Burlington Coat Factory Warehouse Corp.*, 426 F.3d 532 (2d Cir. 2005). *See also* Complaint, *Louis Vuitton Malletier S.A. v. Hyundai Motor Am.*, 10 Civ. 1611 (S.D.N.Y. filed Feb. 26, 2010), available at <http://www.scribd.com/doc/27694336/Complaint-LV-Hyundai>; Jim Edwards, *Louis Vuitton’s Suit Against Hyundai Super Bowl Ad Is So Ridiculous It May Just Win*, CBSNEWS (Mar. 2, 2010, 5:06 PM), <http://industry.bnet.com/advertising/10005854/louis-vuittons-suit-against-hyundai-super-bowl-ad-is-so-ridiculous-it-may-just-win/>.

¹⁶⁰ *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 908 (9th Cir. 2002). In 2007, *Rolling Stone* magazine named “Barbie Girl” as one of the twenty most annoying songs. *See* <http://www.rollingstone.com/music/blogs/staff-blog/the-20-most-annoying-songs-20070702> (last visited Mar. 2012).

¹⁶¹ *City Chain Stores (S) Pte Ltd. v. Louis Vuitton Malletier*, (2010) S.L.R. 382.

¹⁶² *Id.*

mark in Singapore in respect of a number of classes.¹⁶³

The Louis Vuitton watch, bearing the Flower Quatrefoil mark as a randomly repeated pattern on the dial, was sold in Singapore from 2004; however, it was only sold at three Louis Vuitton boutique stores. The appellant, City Chain, operates 360 stores and counters in Hong Kong, Macau, China, Thailand, Malaysia, and Singapore. There are over thirty City Chain outlets in Singapore. In November 2006, City Chain launched a series of watches in Singapore bearing its own SOLVIL trademark, as well as decorative flower patterns on its dial and strap. These Solvil watches were later sold in the other City Chain outlets in Asia. The Solvil Flower resembles, but is not identical to, Louis Vuitton's Flower Quatrefoil. Moreover, these flowers are arranged in a randomly repeated fashion and are varied in size. The trial judge was of the view that the Solvil watch could easily be mistaken for the Louis Vuitton watch at a glance when worn on the wrist, as people did not generally scrutinise another person's watch at close range.¹⁶⁴

The Court of Appeal considered a number of decisions from different jurisdictions, in particular U.K.¹⁶⁵ and ECJ cases,¹⁶⁶ before deciding to adopt a narrow view that trademark use is required for trademark infringement. The court observed that in the "broader Community approach" taken by the ECJ,

[W]here a sign is used other than as an indication of origin (and, perhaps, is descriptive) . . . the court may nonetheless conclude that, taking all relevant matters into account, the use will have an adverse impact on the functions of the mark including its essential function.¹⁶⁷

The court also acknowledged that this broader approach "has the advantage of greater flexibility in allowing the courts to achieve justice in individual cases."¹⁶⁸ However, the unanimous opinion thought that "the broader Community approach could lead to uncertainty in determining when the third party's use would affect or was likely to

¹⁶³ *Id.* at 387.

¹⁶⁴ *Id.* at 408.

¹⁶⁵ *E.g.*, Arsenal Football Club Plc v. Reed, [2003] EWCA (Civ.) 696, [2003] R.P.C. 39; R v. Johnstone, [2003] UKHL 28; RxWorks Ltd. v. Dr. Paul Hunter, [2007] EWHC (Ch) 3061, [2008] R.P.C. 13; Whirlpool Corp. v. Kenwood Ltd., [2009] EWCA (Civ) 753, [2010] R.P.C. 2; L'Oréal S.A. v. eBay Int'l AG, [2009] EWHC (Ch) 1094.

¹⁶⁶ *E.g.*, Case C-206/01, Arsenal Football Club Plc v. Reed, 2002 E.C.R. I-10273; Case C-245/02, Anheuser-Busch Inc. v. Budjovicky Budvar, Národní Podnik, 2004 E.C.R. I-10989; Case C-48/05, Adam Opel AG v. Autec AG, 2007 E.C.R. I-01017; Case C-17.06, Céline SARL v. Céline S.A., 2007 E.C.R. I-07041; L'Oréal S.A. v. Bellure NV, [2007] EWCA (Civ) 968.

¹⁶⁷ City Chain Stores (S) Pte. Ltd. v. Louis Vuitton Malletier, [2010] 1 S.L.R. 382, 394 (citing Rxworks Ltd. v. Dr. Paul Hunter, [2008] R.P.C. 13 at 53).

¹⁶⁸ *Id.*

affect the functions of the trade mark.”¹⁶⁹ On the facts, the court found that “the predominant use of the Solvil Flower [on the watches] is for decorative purposes. . . . Thus, [it] is not trade mark use.”¹⁷⁰ Hence, on the narrow approach, there is no trademark infringement. Even on the broader Community approach, it was held that although the Solvil Flower was similar to the Louis Vuitton Flower Quatrefoil mark, there was no likelihood of confusion capable of sustaining the plaintiff’s trademark infringement claim. In determining whether there was a likelihood of confusion on the part of the public, the court construed the “average consumer” as the “general public,”¹⁷¹ but also referred to the “target consumers” of both Solvil and Louis Vuitton watches.¹⁷²

With respect to the trademark dilution claim, the Flower Quatrefoil mark did not meet the stringent threshold requirement of a “well known” mark under § 55(3)(b)(i) and 55(4)(b)(i) of the *Trade Marks Act*.¹⁷³ When determining whether a trade mark is “well known to the public at large in Singapore,” the courts must adhere to § 2(7) of the Act, which enumerates a number of factors to be considered, including the degree to which the trade mark is known to or recognised by any relevant sector of the public in Singapore, and the duration, extent, and geographical area of any use of the trade mark. Remarking that the Singapore approach “would be in line with the U.S. approach in determining famous marks,”¹⁷⁴ the Court held:

[T]here is no evidence of the degree to which the Flower Quatrefoil mark on its own is known to, or recognised by, any relevant sector of the public in Singapore; there is no evidence that the Flower Quatrefoil mark has been used on its own as a trade mark; there was limited promotion of the Flower Quatrefoil mark on watches; and there is no evidence of any value associated with the Flower Quatrefoil mark.¹⁷⁵

Ultimately what was fatal to Louis Vuitton’s claims was the fact that “the Flower Quatrefoil mark has always been used and linked to the Monogram or *Louis Vuitton* marks and there is no evidence that the Flower Quatrefoil mark was ever used on its own.”¹⁷⁶ The Flower Quatrefoil mark has rarely been used in isolation from the *LV* mark, the *Louis Vuitton* mark, or the Monogram mark.

¹⁶⁹ *Id.* at 395.

¹⁷⁰ *Id.* at 399.

¹⁷¹ *Id.* at 403.

¹⁷² *Id.* at 404.

¹⁷³ Trade Marks Act (SS Cap 332, 2005 Rev Ed) (Sing.).

¹⁷⁴ *City Chain Stores*, [2010] 1 S.L.R. at 414.

¹⁷⁵ *Id.*

¹⁷⁶ *Id.* at 414–15.

Nonetheless, the makers of the Solvil watch are arguably leveraging on the semiotic freight of the Louis Vuitton brand here—a *predominantly parasitic* activity—and the literal approach that the court has taken has ignored the fact that the defendant has not attempted to engage in any transcoding of the Louis Vuitton icon. Fashion aficionados know at a glance that the visual similarity between the Solvil watch and the Louis Vuitton watch is more than mere coincidence; the use of the four-point Solvil Flower in a random pattern on the dial is a studied imitation of the use of the Flower Quatrefoil mark on the dial of the Louis Vuitton watch. In dismissing Louis Vuitton’s claims, City Chain has been given a free ride to trade on the star aura of Louis Vuitton. One may argue that City Chain has been accorded an unfair commercial advantage: rather than having to go through the effort and expense of developing and creating their own unique designs, it can save significant expense and simply tweak the designs of an alpha brand whose marks are instantly recognizable to the public at large. Commentator Bonita Trimmer points out that “if another business can take advantage of a mark’s positive image, rubbing some of its ‘power of attraction’ onto itself, without having to make the investment the trade mark owner has made to create it, it may well, again, be tempted to do so.”¹⁷⁷ Unlike the defendants in *Haute Digitty Dog* who created the “Chewy Vuiton” toy, the defendant here clearly is not engaging in a semiotic disruption of the Louis Vuitton sign or repoliticizing speech that has become naturalized in the creation of the Louis Vuitton myth. The use of Flower Quatrefoil mark reinforces the Louis Vuitton myth and amplifies the aspirational desire to own a Louis Vuitton.

CONCLUSION

Megan Richardson has pointed out that “[t]here are cases already that show trade mark owners unready to allow uses of their trade marks that they believe could reflect badly on them, or are controversial, or lie too far outside the scope of their activities, no matter their overall social value (and including in cases where those who wish to use will pay).”¹⁷⁸ Perhaps our postmodern condition is our reality. Manfredi Ricca, in a commentary on brand valuation, wrote:

Global luxury brands have embraced, and are now at the forefront of a shift in their paradigm. They have transitioned from focusing on their own spirit and history to reaching deep into people’s—not

¹⁷⁷ Bonita Trimmer, *The Power of Attraction: Do Trade Marks have an “Image” Problem in the English Courts?*, 31 EUR. INTELL. PROP. REV. 195, 197 (2009).

¹⁷⁸ Richardson, *supra* note 7, at 216.

necessarily customers'—lives and zeitgeist. They have become fully immersed in the way people think, live, and behave Today, those brands that are generating extraordinary value are dynamic, energetic icons able to achieve what Zygmunt Bauman has called “liquid modernity.”¹⁷⁹

Indeed, the Louis Vuitton brand is the Barthesian myth with a universal ideological coding that is recognised globally. The consumers of Louis Vuitton products proudly display the “LV” symbol and the iconic Monogram as an emblem of their social identity and as a status symbol. The intrinsic strength and stability of the *LV* semiotic sign is quintessential to the success of the Louis Vuitton brand, but at the same time, it renders the brand far more susceptible to counterpublic recodings and uses in parodic and satirical contexts that lampoon conspicuous consumption and an ostentatious lifestyle. In 2011, the Hague Court dismissed Louis Vuitton’s claim against artist Nadia Plesner, whose painting *Darfurnica* (a reference to Pablo Picasso’s *La Guernica*) comprised an image of a black boy with a Chihuahua and a Louis Vuitton handbag.¹⁸⁰ In particular, the Court considered Plesner’s illustrations to be imbued with symbolic and iconic values, and commented:

The circumstance that Louis Vuitton is a very well-known company, the products of which enjoy a considerable reputation, which it also stimulates through advertising famous people, moreover implies that Louis Vuitton must accept critical use as the present one to a stronger degree than other rightholders¹⁸¹

The pragmatic contributions of semiotics and cultural studies to trademark law, through their understandings of contemporary consumption and identity politics, can assist judges in their articulation of legal rules that better reflect cultural practices. For instance, trademark dilution has been described as “one of the most elusive concepts in all of intellectual property law,” and it has been further stated that “[t]he concept is elusive because it is an essentially semiotic [one]”¹⁸² Each trademark does more than denote the origin of goods. It connotes a bundle of social and emotional values that drive

¹⁷⁹ Manfredi Ricca, *Luxury: Dynamic Icons for Liquid Modernity*, in INTERBRAND, BEST GLOBAL BRANDS 2011, 51.

¹⁸⁰ Joensen v. Louis Vuitton Malletier S.A., KG ZA 11-294 § 4.4 (Court of the Hague, May 4, 2011), available at <http://www.mediareport.nl/wp-content/uploads/2011/05/english-translation-plesner-vs-louis-vuitton-judgement-4-may-2011.pdf>.

¹⁸¹ *Id.* at § 4.8.

¹⁸² Barton Beebe, *Intellectual Property Law and the Sumptuary Code*, 123 HARV. L. REV. 809, 845 (2011).

consumption. But the cursory judicial nod given to observations in cultural studies, such as by the Sixth Circuit majority in the right of publicity case *ETW Corp v. Jireh Publishing*,¹⁸³ can be a dangerous thing when courts do not engage in a thorough examination of cultural practices and consumption behavior, but instead rely on platitudes that appear merely to support the outcomes they desire. A methodical consideration of the content, form, and context of each expressive use is essential to resolving intellectual property disputes. For example, one may read the Supreme Court's reasoning of the use of parody in *Campbell v. Acuff-Rose* as extending to the audience an "invitation to contrast."¹⁸⁴ Furthermore, the way "transformativeness [today] figures as a kind of metaconsideration arching over fair use analysis"¹⁸⁵ and the increasing willingness of the courts to take into account the insights of reader-response criticism in copyright law¹⁸⁶ suggest that future judicial decisions may offer further guidance for a more nuanced understanding of the relevance of transcoding in trademark doctrine.

A final word of caution. In using semiotics and cultural studies to assist in legal analysis, courts should be wary of overprotecting trademarks by finding every opportunistic capitalization of the semiotic values of marks to be an infringement and underprotecting trademarks by deeming every recoding to be a permissible expressive use. Trademark laws operate in "a semiosphere combining social, market and cultural significations seamlessly"¹⁸⁷ There is no doubt that the extra-legal perspectives of cultural studies on the meaning, production, and consumption of the trade mark as a semiotic sign can provide a vital resource for the formulation of better legal solutions in contemporary times.

¹⁸³ *ETW Corp. v. Jireh Publ'g, Inc.*, 332 F.3d 915, 933 (6th Cir. 2003) ("Through their pervasive presence in the media, sports and entertainment celebrities come to symbolize certain ideas and values Celebrities, then, are an important element of the shared communicative resources of our cultural domain.").

¹⁸⁴ Rochelle Cooper Dreyfuss, *We Are Symbols and Inhabit Symbols, So Should We Be Paying Rent? Deconstructing the Lanham Act and Rights of Publicity*, 20 COLUM. J.L. & ARTS 123, 152 (1996).

¹⁸⁵ Peter Jaszi, *Is There Such a Thing as Postmodern Copyright?*, in MAKING AND UNMAKING INTELLECTUAL PROPERTY 413, 420 (Mario Biagioli, Peter Jaszi & Martha Woodmansee eds., 2011).

¹⁸⁶ E.g., Laura A. Heymann, *Everything is Transformative: Fair Use and Reader Response*, 31 COLUM. J.L. & ARTS 445, 460–62 (2008); David Tan, *What Do Judges Know About Contemporary Art?: Richard Prince and Reimagining the Fair Use Test in Copyright Law*, 16 MEDIA & ARTS LAW REVIEW 381, 383–89, 392–96 (2011); *Blanch v. Koons*, 467 F.3d 244, 251–53 (2d Cir. 2006).

¹⁸⁷ MACRURY, *supra* note 53, at 274.