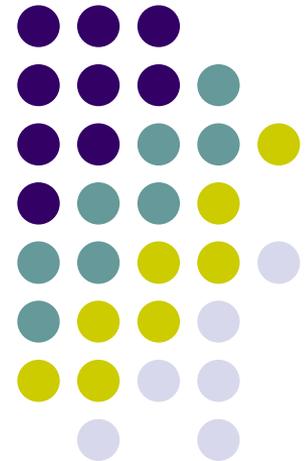
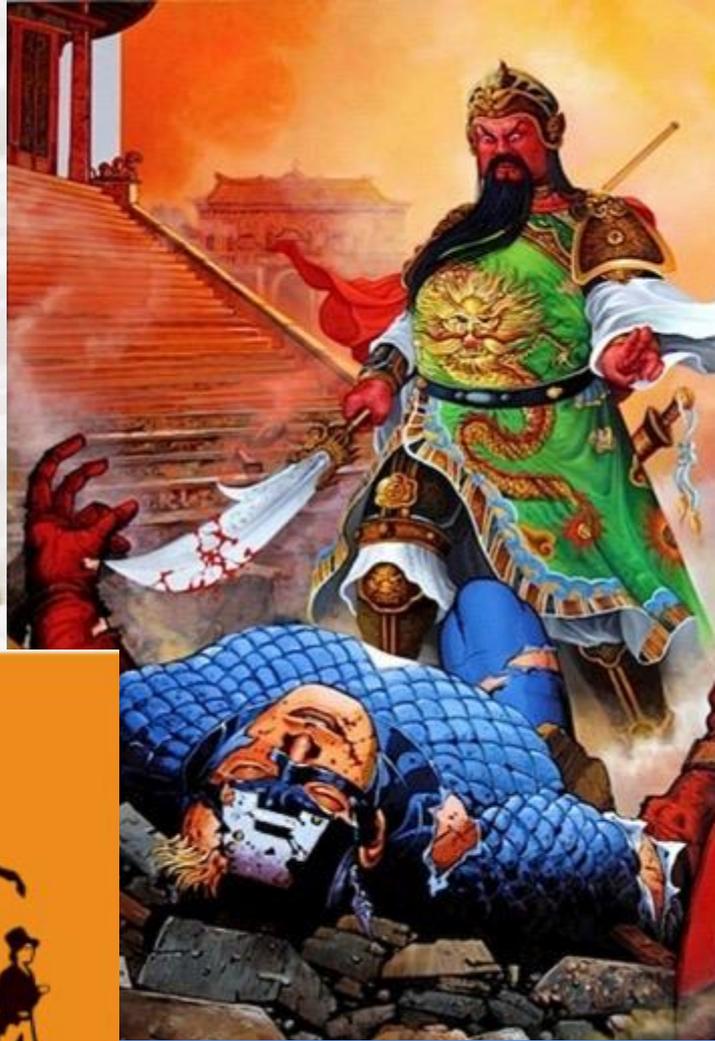


A Semiotics Perspective of Copyright Fair Dealing/Fair Use & Trademark Infringement/Dilution

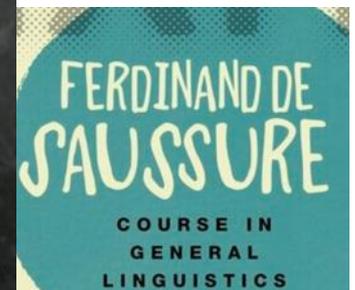
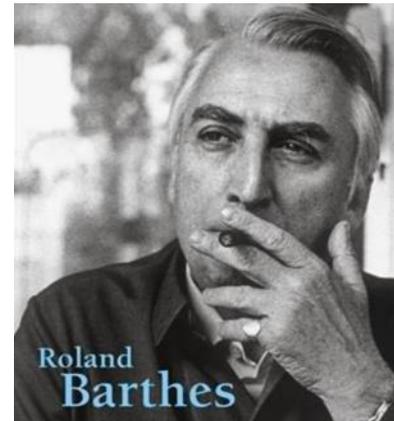
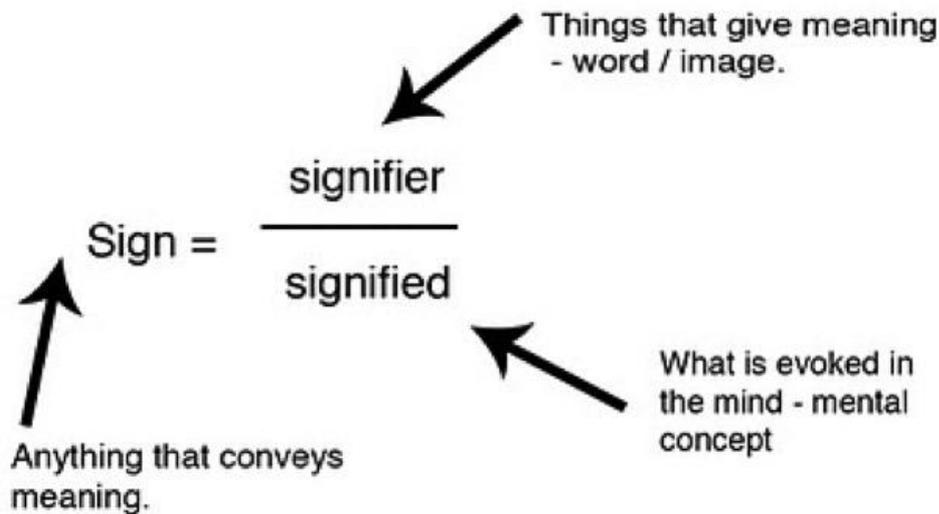
Professor David Tan
NUS Law School







“semiotics: study of signs”





semiotics methodology

> finding meanings in objects of IP

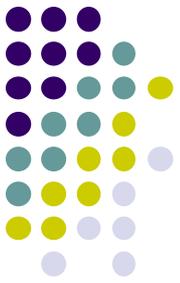




“objects of IP as signs”

common points of reference for millions of individuals who may never interact with one another, but who, by virtue of their participation in a mediated culture as the audience, have a shared experience and a collective memory.

Encoding, Decoding, Recoding



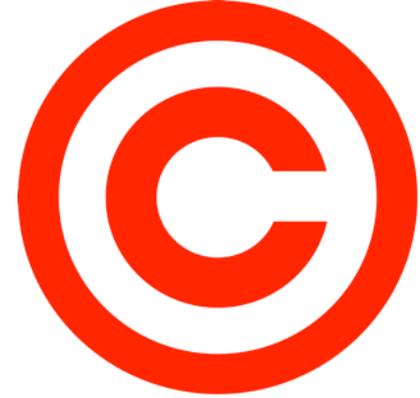
- Objects of IP are **encoded** with certain meanings or values
- These are **decoded** by consumers and audiences
- The objects may be **recoded** in different ways for different purposes

“Useful” Semiotics



- How understanding works of copyright and trademarks as signs can be useful in arguing an IP case
 - Fair dealing or fair use in copyright
 - How the original “purpose or character” of a work has been changed in fair use analysis – i.e. “transformed”
 - How to discern criticism or comment in order to qualify as fair dealing
 - Why a particular treatment of a TM does not create a likelihood of confusion, i.e. no infringement
 - Why a particular treatment of a famous TM is non-dilutive

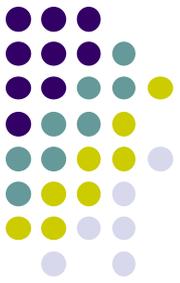
Copyright



- Literary, dramatic, musical and artistic works
- A limited-term monopoly right that allows the author to exclusively exploit the work
 - Reproduce/Make copies
 - Communicate publicly
 - License – adaptations/derivative works

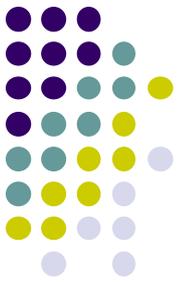


Copyright - Fair Use defence



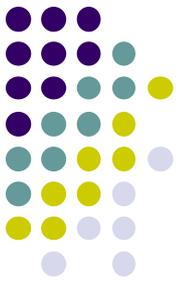
- United States: 17 USC § 107
 - (1) purpose & character of the use (transformative nature)
 - (2) nature of the copyrighted work
 - (3) amount & substantiality of the portion used
 - (4) effect of use upon potential market or the value of the copyrighted work (including derivative works)

Copyright - Fair Dealing HK



- HK: section 39(1) Copyright Ordinance
 - Fair dealing with a work **for the purpose of criticism or review**, **of that or another work** or of a performance of a work, **if it is accompanied by a sufficient acknowledgement**, does not infringe any copyright in the work ...

Copyright - Fair Dealing HK



- HK: Proposed section 39A(1) in 2014 -
 - Fair dealing with a work **for the purpose of parody, satire, caricature or pastiche** does not infringe any copyright in the work.

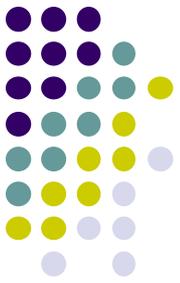


Copyright – Fair Use



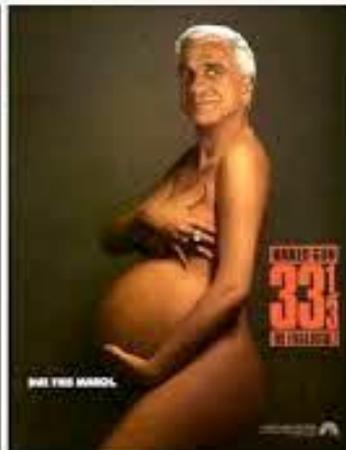
- According to the US Supreme Court in *Campbell*, **transformativeness** not only occupies the core of the fair use doctrine but also reduces the importance of all other factors
 - Does it add “**something new, with a further purpose or different character, altering the first with new expression, meaning or message**”?
 - 2nd Cir: The law “imposes **no requirement that a work comment on the original or its author in order to be considered transformative**”
 - 2nd & 9th Cir: Has the original work been used “**in the creation of new information, new aesthetics, new insights and understandings**”?

Copyright – Fair Use

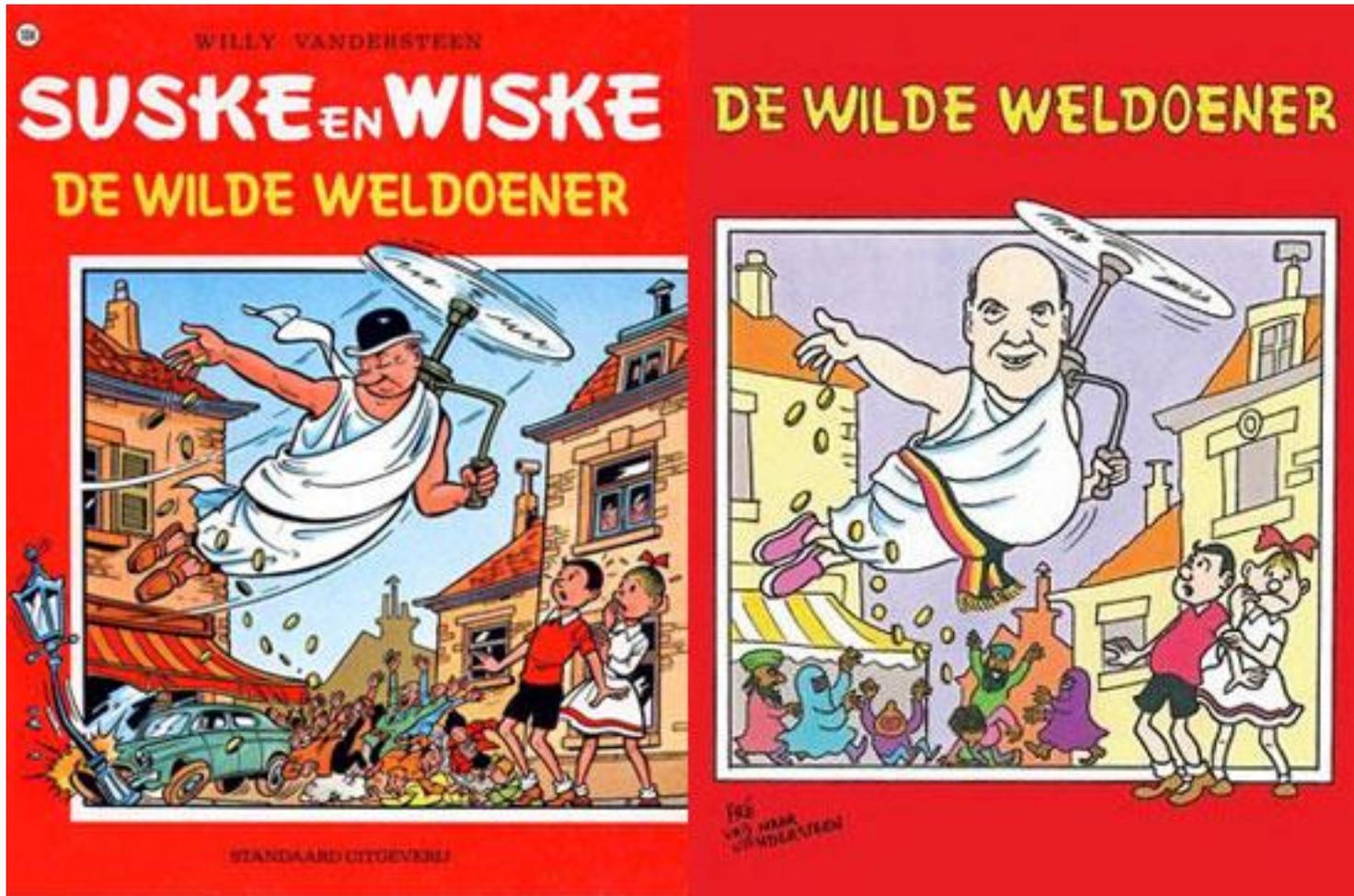
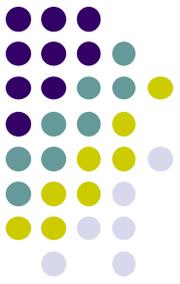


- **Types of transformative uses:**
 - **directly commenting on or criticising the original work**, or targeting the original work for ridicule
 - **using the original work to comment on something else**, but the secondary work nonetheless contains some underlying **critical relevance** to the original work
 - **recontextualising** the original work **with minor modifications** (e.g. appropriation art)
 - **changing the purpose** of the original work, and sometimes with **significant social benefit** (e.g. format-shifting and time-shifting, Google Books)

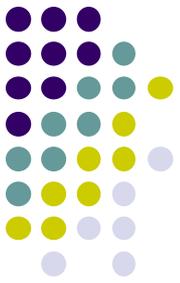
Semiotics Analysis implicit in US Fair Use decisions



CJEU in Deckmyn (2014)



CJEU in Deckmyn (2014)



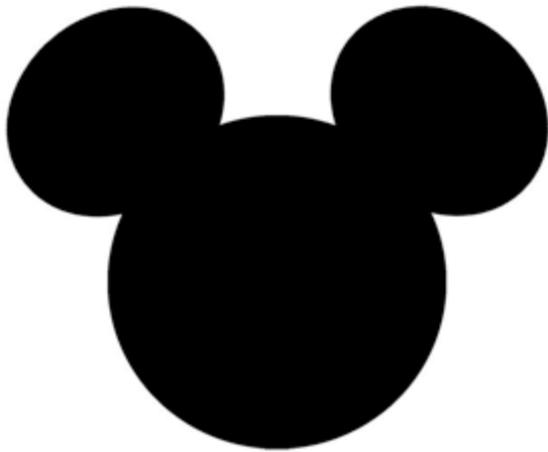
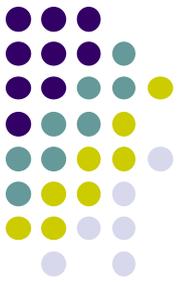
- Parody should be given a broad interpretation, and that the “essential characteristics of parody, are, first, to evoke an existing work, while being noticeably different from it, and secondly, to constitute an expression of humour or mockery.
- Parody is not subject to the following conditions:
 - (i) the parody should display an original character of its own, other than that of displaying noticeable differences with respect to the original parodied work;
 - (ii) it could reasonably be attributed to a person other than the author of the original work itself;
 - (iii) it should relate to the original work itself or mention the source of the parodied work

US Fair Use today



- In terms of constructing a legal argument, it is helpful to understand how such fan works fit into the parlance of “**parody**” or the broader test of “**transformed in the creation of new information, new aesthetics, new insights and understandings**” as expressed by the Second and Ninth Circuits.
- A well-known literary or artistic work does much more than simply educate, inform or entertain, but it also functions as **a *signifier of a set of signified meanings***.

Copyright Signs



=



Copyright Signs



=



Copyright Signs



- Mickey Mouse, Barbie, Captain America and Superman are just some of the iconic characters from the last century that are universally recognised today and are each emblematic of a unique set of character values and semiotic significance.

- They 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.”**

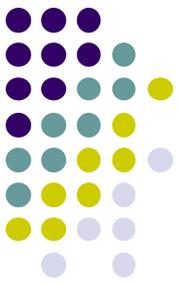


Copyright Signs



- Like Barthesian myths, cartoon characters such as Mickey Mouse and Snow White, well-known superhero characters such as Superman, Captain America and Wonder Woman, as well as fictional characters from popular television series like Star Trek, **contain subject positions and models for identification that are heavily coded ideologically.**
- These iconic copyrighted works can have an **ideological function of not only reiterating dominant values, but also concealing prevalent contradictions or social problems.**

“Playing” with Copyright Signs



interactive
relationship between
nostalgia and
novelty



“Playing” with Copyright Signs (Factor 1)



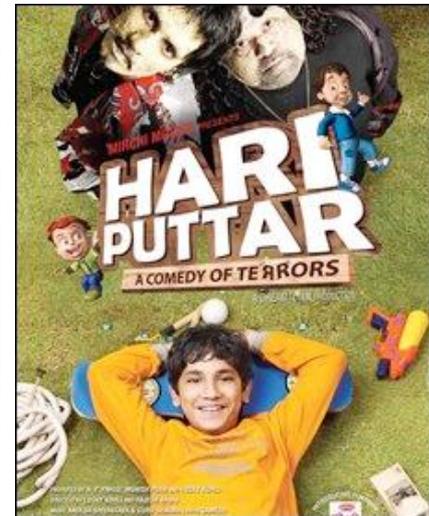
- Transformative play does not necessarily involve opposing the original texts, they can also be seen to be **a form of pastiche that simultaneously mirror and subvert the original narrative through a nostalgic interaction with the texts** – a form of “transformative purpose”



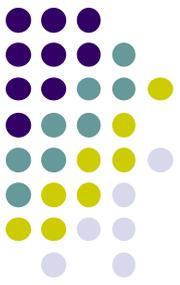
Recoding Copyright Signs can Increase Demand for the Original Works (Factor 4)



- Rather than displacing sales of the original, fanworks that recode the original encourage and sustain a vibrant fan community that helps authorized versions thrive



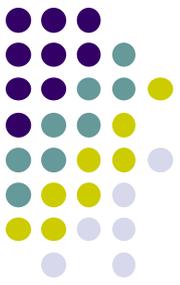
Semiotics and Fair Use/Fair Dealing – Transformative and Critical Commentary



Dismaland was a temporary art project in 2015 organised by street artist Banksy, constructed in a seaside resort town in Somerset, England.



Semiotics and Fair Use/Fair Dealing – Transformative and Critical Commentary

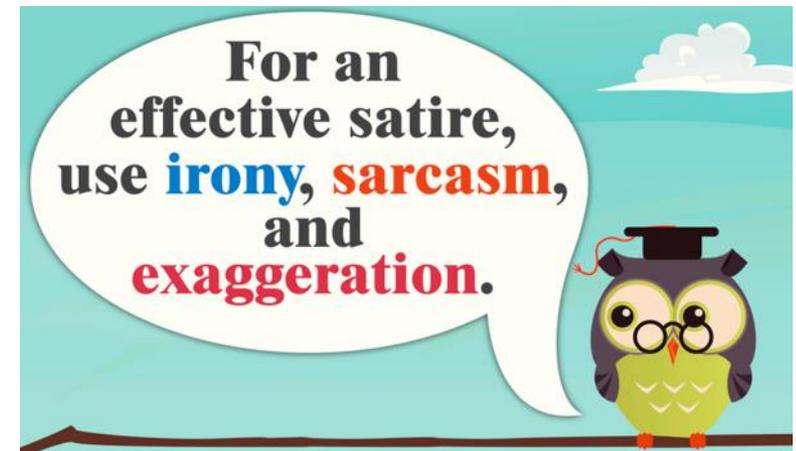


Hero, Leader, God
by Alexander Kosalopov

Summary - Fair Dealing HK



- HK: section 39(1) Copyright Ordinance
 - Fair dealing with a work **for the purpose of criticism** or review, **of** that or **another work** or of a performance of a work, if it is accompanied by a sufficient acknowledgement, does not infringe any copyright in the work ...



“Brand” – Coding of Signs



- Logos are “encoded” with a set of meanings which is “decoded” by audiences/consumers
- Encoding occurs through repeated representations of specific themes; these are usually decoded in a similar manner by consumers



Bosland (2005)

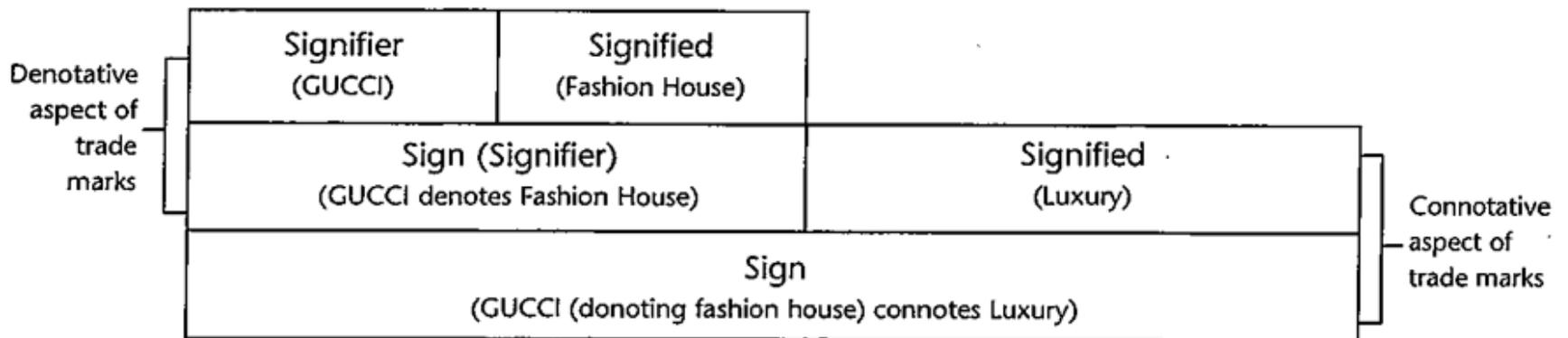
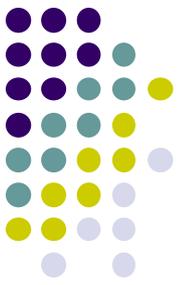
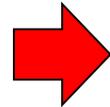


Diagram adapted from Roland Barthes, *Mythologies*.

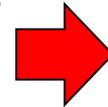
Trademark as a Semiotic Sign or the “Brand Experience”



The well-known TM is perceived to embody particular positive values or ideals
Eg. glamour, prestige, beauty, sexual desirability



These attributes or ideals are transferred to products sold under the TM



The consumer imbibes these attributes or ideals when these products (and in effect, the TM) are consumed



Semiotics and TMs



- Not just an aid to consumers searching for desirable goods and services, **TMs also constitute a rich form of cultural expression**
- It is precisely *because* trade marks are owned that they are valued as such powerful expressive devices ... **By investing a trade mark with meaning and using it as a cultural tool, the public can express, for example, approval or criticism at the ideological stance of a trade mark owner**
- As observed by Rosemary Coombe, trade marks 'provide symbolic resources for the construction of identity and community, subaltern appropriations, parodic inventions, and counterhegemonic narratives.'

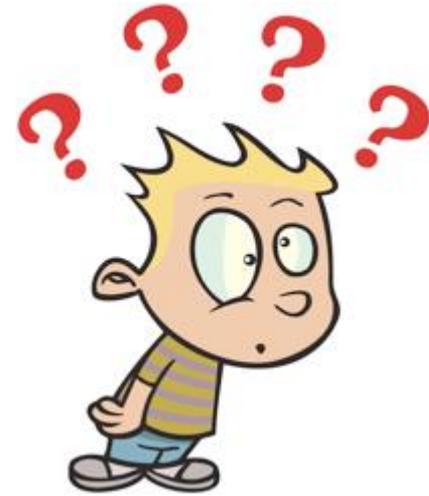


Veblen Brands – Sheff (2012)

- **Thorstein Veblen:**
 - the “quality” of status goods is fundamentally different from the “quality” of goods with which trademark law has traditionally concerned itself
- **“Conspicuous Consumption”**



TM Law



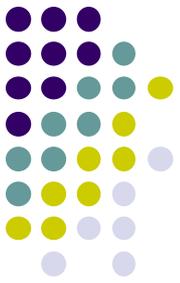
- Trademark Infringement
 - Need to prove **likelihood of confusion**
 - Note different statutory text and judicial tests in US, EU, AU and HK but consumer confusion is the common link

TM Infringement - HK



- Trademark Ordinance section 18(3)
 - A person infringes a registered trade mark if—
 - (a) he uses in the course of trade or business a sign which is similar to the trade mark in relation to goods or services which are identical or similar to those for which it is registered; and
 - (b) the use of the sign in relation to those goods or services is **likely to cause confusion** on the part of the public.

TM Dilution - HK



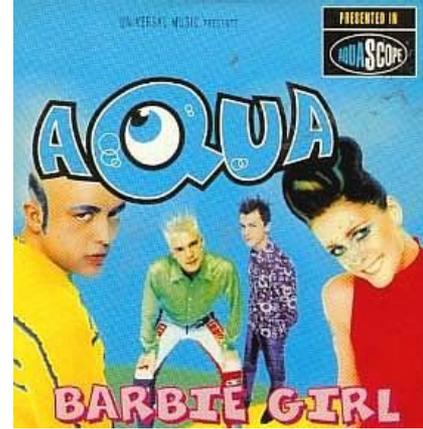
- Trademark Ordinance section 18(4)
 - A person infringes a registered trade mark if—
 - (a) he uses in the course of trade or business a sign which is identical or similar to the trade mark in relation to goods or services which are not identical or similar to those for which the trade mark is registered;
 - (b) the trade mark is ... a well-known trade mark; and
 - (c) the use of the sign, **being without due cause**, takes unfair advantage of, or is detrimental to, the distinctive character or repute of the trade mark.

Semiotics and Infringement



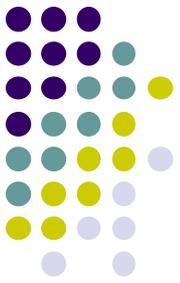
- “Parody” – under US TM law, it includes satire
 - **Generally taken into account in the inquiry on “likelihood of confusion”**
 - Parody – “juxtaposing the irreverent representation of the TM with the idealized image created by the owner” (*broad definition*)
 - US Courts run through the factors after establishing the defendant’s use was a parody

Aqua's "Barbie Girl" (2002)



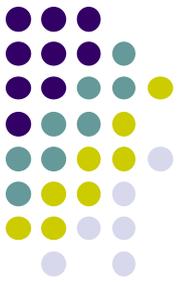
- The Semiotic Meaning of "Barbie"
 - **No TM infringement**
 - Barbie has entered public discourse and have become an integral part of our vocabulary – mark has “expressive value” beyond source-identification function
 - The song targets Barbie and the values that she represents – a communicative message that implicates First Amendment

Overview of TM Dilution (US)



- Trademark Dilution (US)
 - No need to prove likelihood of confusion
 - Threshold: Must be “well-known” or “famous” mark
 - **Blurring** > D’s mark needs to “impair distinctiveness” of famous mark and has to be substantially similar
 - **Tarnishment** > D’s mark need to “harm the reputation” of primary mark
 - **“Non-commercial use” exception (15 USC § 1125(c)(3)(C))** protects parodic + satirical uses (very broadly defined – First Amdt given effect)
 - **2006 “fair use” exception (15 USC § 1125(c)(3)(A)(ii)):**
 - A reviewing court is to ask (1) whether the alleged dilutive activity is a “parody” or it “comments/criticizes” the mark owner or products. If the answer is yes, then the court is to ask (2) whether the “parody” is being used as a source identifier. If the answer is no, then the inquiry is over and a dilution action cannot be sustained.

Overview of TM Dilution (US)



- Trademark Dilution (US)

- If parody was **NOT** a source identifier – i.e. the secondary TM is a parody of the primary mark but does not indicate source of origin of goods – then **2006 “fair use” exception – 15 USC § 1125(c)(3)(A)(ii)** – applies

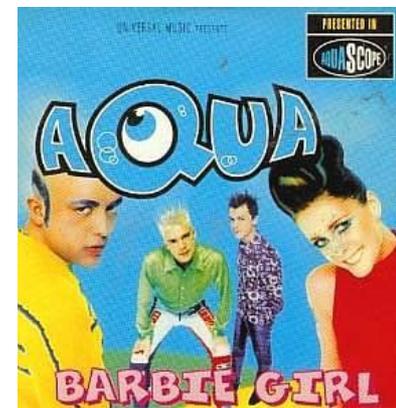
Haute Diggity Dog™
bark, play, love, everyday!



- If parody was a source identifier – i.e. the secondary TM indicates source of origin of goods then the **non-commercial use exception – 15 USC § 1125(c)(3)(C)** – applies



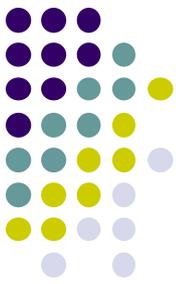
Aqua's "Barbie Girl" (2002)



- **Not Dilutive because it is Expressive**

- Although the boundary between commercial and non-commercial speech has yet to be clearly delineated, the 'core notion of commercial speech' is that it 'does no more than propose a commercial transaction.'
- MCA used Barbie's name to sell copies of the song. However, as we've already observed, **the song also lampoons the Barbie image and comments humorously on the cultural values Aqua claims she represents.**
- **>> Should all parodic recordings automatically qualify for protection from dilution claims as a "non-commercial" exemption even if they might be commercially successful?**

Semiotics of Luxury Brands in Popular Culture



Recoding Louis Vuitton



- LV v Haute Diggity Dog (4th Cir. 2007)

- The dog toy 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.
- The LV handbag is provided for the most elegant and well-to-do celebrity, to proudly display to the public and the press, whereas the imitation “Chewy Vuiton” “handbag” is designed to mock the celebrity and be used by a dog.
- **The dog toy irreverently presents haute couture as an object for casual canine destruction. The satire is unmistakable ... a comment on the rich and famous, on the LOUIS VUITTON name and related marks, and on conspicuous consumption in general.**

Recoding Louis Vuitton

- LV v My Other Bag (2nd Cir. 2016)



- At the same time that they mimic LV's designs and handbags in a way that is recognizable, they do so as a drawing on a product that is such a conscious departure from LV's image of luxury – in combination with the slogan “My Other Bag” – as to convey that MOB's tote bags are **not** LV handbags.
- The fact that the joke on LV's luxury image is **gentle**, and possibly even **complimentary to LV**, **does not preclude it from being a parody**.

Semiotics, Free Speech and TM



- Louis Vuitton v Plesner (May 2011, Netherlands)
 - **Importance of freedom of expression in a functioning democracy** (Art 10, ECHR) – Plesner aims to increase public attention regarding Darfur situation
 - World of glamour gets too much attention
- **Art may shock, offend or disturb – “Simple Living” message is critical of society** and outweighs LV’s right to peaceful enjoyment of its exclusive property rights.

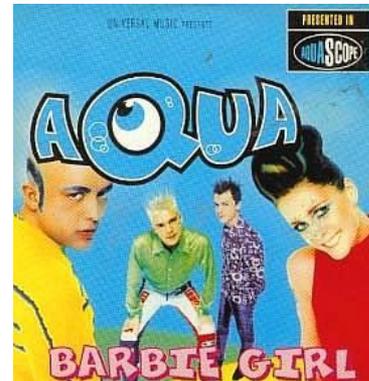
Do the sale of these products rely on the consumers' familiarity with the TM semiotic signs?



Summary – TM Infringement & Dilution – HK

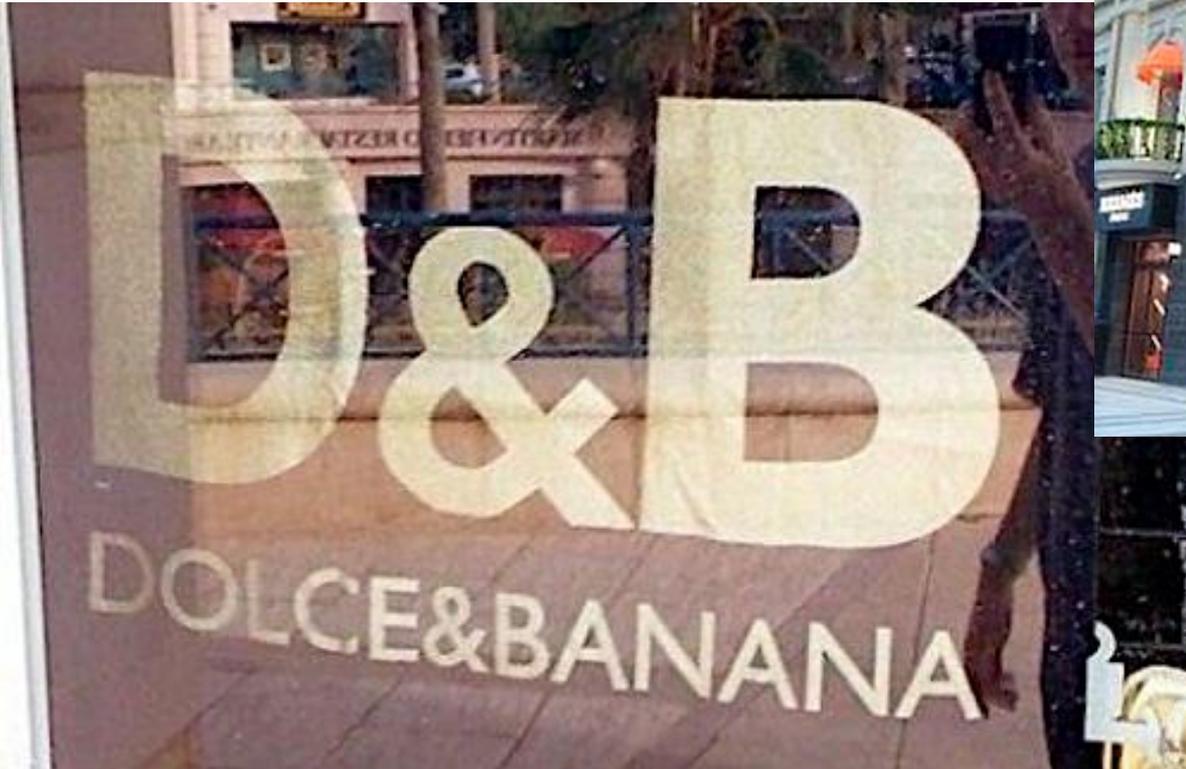


- Trademark Ordinance ss 18(3) + 18(4)
 - “Likely to cause confusion”
 - “the use of the sign, **being without due cause**, takes unfair advantage of, or is detrimental to, the distinctive character or repute of the trade mark”



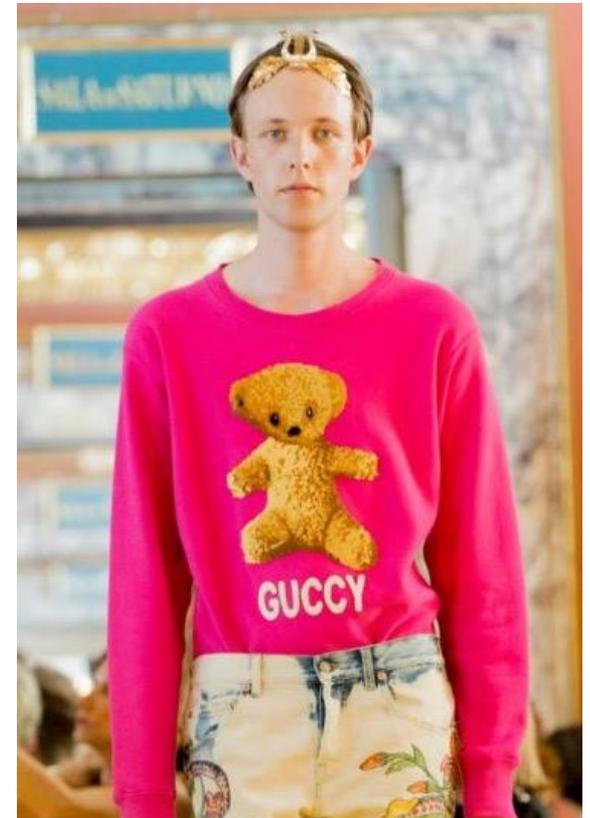
Shanzhai practices – Semiotic Recodings?

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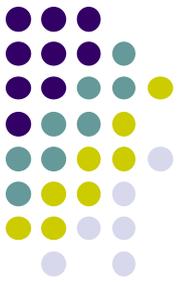


Shanzhai practices – Semiotic Recodings?

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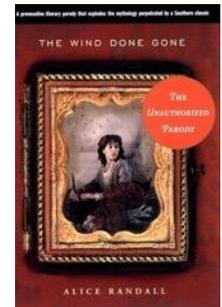
Semiotics in IP Law



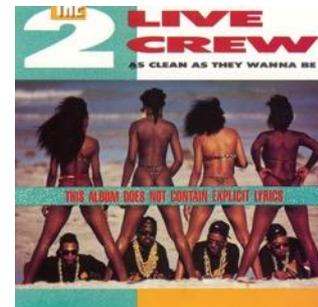
- The mimicking is a “a conscious departure from LV’s image of luxury” ... “a parody of LV’s luxury image is the very point of MOB’s plebian product”: LV v My Other Bag (2nd Cir. 2016)



- “*The Wind Done Gone*’s criticism of *Gone With the Wind*’s substance is plain ... Like a political, thematic, and stylistic negative, *The Wind Done Gone* inverts *Gone With the Wind*’s portrait of race relations of the place and era”: Suntrust Bank v Houghton Mifflin (11th Cir. 2001)



- 2 Live Crew’s words “can be taken as a comment on the naiveté of the original of an earlier day, as a rejection of its sentiment that ignores the ugliness of street life and the debasement that it signifies”: Campbell (Sup Ct 1994)



A Semiotics Perspective of Copyright Fair Dealing/Fair Use & Trademark Infringement/Dilution

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NUS Law School

