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TOWARDS A NEW RELATIONSHIP BETWEEN TRADE MARK LAW AND PSYCHOLOGY

Robert Burrell* and Kimberlee Weatherall**

INTRODUCTION

The temptation to entitle this article the ‘Psychological Problems of Trade Mark Lawyers’ was, in the end, capable of being resisted. This weak pun does, however, get at something important. On paper there ought to be a close relationship between law and (cognitive) psychology. Trade mark law turns on how consumers are likely to respond to signs used on or in relation to goods and services. Its ultimate concern, moreover, is with ensuring that traders do not (deliberately or otherwise) trigger particular mental states among consumers. Psychology can provide insights into how consumers are likely to respond to things they see and hear, can help us finesse what we mean by the mental states that trigger legal intervention (‘caused to wonder’, ‘confused’, ‘deceived’, ‘initially interested’) and tell us when one of these mental states is most likely to arise. In practice, however, insights from psychology have had little impact on the development of trade mark law. Understanding of the potential relationship between the disciplines has been hampered by the fact that this question has too often been viewed through the narrow prism of the probative value that should be given to survey evidence offered by a party to legal proceedings in an attempt to either prove or disprove a likelihood of confusion.¹

In this article we suggest that insights from psychology can play an important role in trade mark law. Articulating this role, however, needs to be handled with care and we need first to understand why trade mark law and psychology make uneasy bedfellows, despite their

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¹ This paper refers generally to the discipline of psychology, although some of the work cited herein comes from the academic discipline of marketing. The line between these two disciplines is not always distinct. To the extent that academic research in marketing is interested in understanding consumer behaviour (rather than how to *influence* such behaviour) it could contribute to trade mark law in the ways explored here.

apparently strong overlapping fields of interest. Our argument is broken down into three parts. We argue that one problem is that the language and modes of reasoning employed by those versed in trade mark law can obfuscate what the law is seeking to achieve.² For example, the ‘average’ or ‘ordinary’ consumer of trade mark law is a legal construct framed with a number of policy goals in mind.³ Crucially, these goals include preserving competitive markets and there are times when preserving competition may require us to tolerate a degree of confusion. Even within trade mark circles there is a strong case that we would do well to be more honest about when we are prepared to tolerate a degree of confusion in order to achieve some other desirable end.⁴ But we should certainly be unsurprised when outsiders who interact with the trade mark system are led astray into believing that the ordinary consumer is, in fact, an ordinary consumer. Still more fundamentally, it needs to be remembered that the registered trade mark system is constructed around a legal abstraction. The protected *res* of registered trade mark law is not the sign that appears on a product, but rather the sign that appears on the trade marks register. This, too, can be difficult for outsiders to grasp, and means that registered trade mark law and confusion sit in an uneasy relationship to one another.⁵ This in turn forces courts to walk a fine line between respecting the principle that the scope of trade mark rights is determined by their bureaucratic form and taking the likelihood of confusion seriously, so as to keep trade mark rights anchored to their principal justification. Working out where the insights that psychology can offer fit into this picture is surprisingly complex.

Something similar can be said about the extension of trade mark rights to protect against non-confusion based harms, harms that are usually grouped under the rubric of ‘dilution’. The existence and nature of these harms remain controversial, but all depend on consumers drawing a mental association between the sign used by the defendant and some similar sign used by the claimant. The difficulty that courts and scholars have encountered in trying to demarcate a workable concept of dilution ought to strengthen the case for drawing insights from cognitive psychology and, indeed, other disciplines. The problem, however, is

² For a discussion of this issue in the context of expert and empirical evidence in trade mark cases, see K. Weatherall, ‘The Consumer as the Empirical Measure of Trade Mark Law’ (2017) 80 MLR 57.

³ G. Dinwoodie and D. Gangjee, ‘The Image of the Consumer in European Trade Mark Law’ in D. Leczykiewicz and S. Weatherill (eds), *The Image(s) of the Consumer in EU Law* (Hart 2015).

⁴ *Ibid.* See also R. Burrell, ‘Trade Mark Bureaucracies’ in G. Dinwoodie and M. Janis (eds.), *Trademark Law and Theory: A Handbook of Contemporary Research* (Northampton, MA: Edward Elgar 2008).

⁵ Weatherall, *supra* n 2, 74-78; Dinwoodie and Gangjee, *supra* n 3.

that the harms that dilution is said to guard against may not map very well onto consumer decision-making processes at all. Courts may be reluctant to turn to external sources when faced with having to make sense of legislative provisions that may not be underpinned by any empirically defensible theory (or model) of harm. Specifically, courts may be wary of drawing on external sources that might point the law in a direction that is either unworkable (insofar as such sources demonstrate that the associative links that dilution guards against cannot be shown to cause brand owners harm) or undesirable (insofar as they demonstrate that consumers do commonly draw the associations that dilution is concerned to prevent, even if a likelihood of harm cannot be established).

In the second part of the article we turn to consider the reception of insights from psychology into trade mark law. As we have already noted, this issue has been dominated by the question of how consumer survey evidence ought to be treated in proceedings in which infringement of a registered trade mark and / or passing off has been alleged. Indeed, this question has so dictated the terms of the debate that anyone who calls for greater engagement between the disciplines is often assumed to be arguing that consumer surveys must be given greater weight by the judiciary. In contrast, we take the view that courts are right to be sceptical of survey evidence and that many of the reasons for such evidence being dismissed are compelling.⁶ But we do suggest that we ought not to shy away from confronting the understandable, but in our view ultimately misplaced, degree of mistrust that can arise when those who are legally qualified are asked to accept insights from a discipline that may appear to rest on different metaphysical foundations.

In the final substantive section of the article we make the case for greater use of insights from psychology. In particular, we argue that an important first step is to move away from the idea that insights from psychology are useful only as a means of determining whether consumers are likely to be confused in a real-world scenario that has led to litigation. We suggest that a more fruitful first step is to use psychology at a higher level of abstraction, that is, to test assumptions trade mark law makes about how consumers process information. One advantage of this approach is that it demonstrates that psychology can inform trade mark law, without disrupting the nature of the registration system – and perhaps even helping improve that system. Although we develop our argument in the first two sections primarily

⁶ This is not, however, to suggest that there are not circumstances in which carefully designed surveys or experiments might not have a useful role to play. For elaboration of this argument see K. Weatherall, *supra* n 2.

by reference to infringement of registered marks, in this third section of the article we cycle back to issues of distinctiveness and passing off.

II. EXTRAORDINARY CONSUMERS AND THE NATURE OF TRADE MARK RIGHTS

When thinking about the challenges of incorporating insights from psychology into the registered trade mark system, we might start with the way in which consumers are conceptualised within this system. Trade mark scholars have been arguing for some time that we need to pay more attention to trade mark law's image of the consumer.⁷ Trade mark systems almost invariably resort to assessing whether infringement has occurred by asking whether a hypothetical consumer would be confused. Different language is used to capture the features of this legal construct. Thus we find references to the average consumer of European trade mark law, the reasonably prudent consumer of US law and the ordinary purchaser of Australian law. Needless to say, these terms are not necessarily coterminous. Moreover, even within jurisdictions, we find that courts often employ synonyms that may bring differences of emphasis.⁸ For present purposes, however, the key thing to note is that the law's hypothetical consumer is invariably constructed with policy goals in mind. To draw on a dichotomy set up by Graeme Dinwoodie, our hypothetical consumer is invariably a normative construct and not merely an empirical construct.⁹

There is nothing objectionable about giving normative concerns a central place in trade mark law. On the contrary, insofar as trade mark law is explained in terms of the need to reduce consumer search costs or to avoid consumer confusion we are invariably concerned with normative goals. Moreover, there is no reason to prioritise these particular goals above all others. There is nothing inherently objectionable about deciding that we might want to tolerate some degree of confusion / higher consumer search costs in order to maintain healthy levels of competition, to preserve freedom of expression or to further some other goal of public policy. Indeed, one might go further and suggest that it would be strange for

⁷ See, e.g., J. Davis, 'Locating the Average Consumer: His Judicial Origins, Intellectual Influences and Current Role in European Trade Mark Law' [2005] IPQ 183; L. Heymann, 'The Reasonable Person in Trade Mark Law' (2008) 52 *St Louis University Law Journal* 78; J. Davis, 'Revisiting the Average Consumer: An Uncertain Presence in Trade Mark Law' [2015] IPQ 15; Dinwoodie and Gangjee, *supra* n 3. '

⁸ See, e.g., in the EU *Google France SARL and Google Inc. v Louis Vuitton Malletier SA* [2010] ECR I-2417, [84] (ECJ): concerned with the reaction of 'normally informed and reasonably attentive internet users'.

⁹ G. Dinwoodie, 'Trademarks and Territory: Detaching Trademark Law from the Nation-State' (2004) 41 *Houston Law Review* 885, 962; Dinwoodie and Gangjee, *supra* n 3, 345-346.

courts to focus exclusively on the response of current consumers. Trade mark law shapes what consumers see and hear. In so doing it constructs their reaction to trade signs and makes it more or less likely that they will associate particular signs with particular undertakings.¹⁰ If trade mark law inevitably shapes as well as reflects consumer responses it seems unremarkable to suggest that courts should pay attention to how they would like consumers to respond:¹¹ a decision that can only be made by reference to some extraneous normative goal.

Insofar as there is a problem with the prevailing approach, it lies in the manner in which outcomes are explained and justified. Reliance on the hypothetical consumer can obscure the weight that is being given to pro-competition concerns and other policy goals. Moreover, there is the danger that our hypothetical consumer may be disguising significant inconsistencies in outcome. The hypothetical consumer provides such a fluid standard that it is open to a tribunal to take a very personal view of the merits of the case and then attribute to the hypothetical consumer whatever reaction is necessary to produce the preferred outcome. These problems are rendered less visible by the degree of ambiguity that continues to surround the nature of the hypothetical consumer standard. In most jurisdictions, there is an imperfect consensus around the question of the extent to which the hypothetical consumer is a normative rather than an empirical construct.¹² This makes the hypothetical consumer test quite different from, say, patent law's 'person skilled in the art'. In patent law there is a clear understanding that the person skilled in the art is a legal construct, and hence that it would never be appropriate to point to the understanding of a group of technically qualified individuals as being determinative of the legal outcome. The unequivocally artificial nature of the person skilled in the art means that courts have had to spell out in some detail this hypothetical person's attributes.¹³

¹⁰ R. Burrell, H. Beverley Smith and A. Coleman, 'Three-dimensional Trade Marks: Should the Directive be Reshaped?' in N. Dawson and A. Firth (eds.), *Trade Marks Retrospective* (Vol 7, Perspectives on Intellectual Property, Sweet & Maxwell, 2000), pp. 150-151; B. Beebe, 'Search and Persuasion in Trademark Law' (2005) 103 *Michigan Law Review* 2020, 2066-7.

¹¹ Some evidence of courts taking this approach can be found in their frequent reliance on a standard defined in terms of 'reasonable' consumers: see, e.g., Case C-329/02 P *SAT-1 v OHIM*, [2005] 1 CMLR 57 [24], referring to an average consumer 'who is reasonably well informed and reasonably observant and circumspect'. This suggests a desire to require consumers to pay attention to their own interests.

¹² Dinwoodie and Gangjee *supra* n 3.

¹³ See also *Whirlpool Corp v Kenwood Ltd* [2008] EWHC 1930 (Ch) at [70] (Geoffrey Hobbs QC, Deputy Judge) for discussion of the differences between the person skilled in the art and the average consumer.

In contrast, in the trade mark field the hypothetical consumer is a less certain figure. Insofar as we have guidance as to this person's attributes, the guidance is pitched at such a general level that it leaves tribunals enormous latitude. In Europe, for example, we are told that the average consumer is 'reasonably well-informed, reasonably observant and circumspect'. What this means in practice, however, is much less certain. Take the word mark ZINC registered for nightclubs. One might reasonably take the view that there is a stronger case that XINC^(ZN) should be regarded as confusingly similar than XINC alone. In the former case the presence of the chemical symbol for zinc helps convey the same idea and points consumers to pronounce the mark as 'zinc' rather than 'ex-inc'. But this conclusion only follows if the reasonably well-informed consumer remembers a modicum of high school chemistry.¹⁴ It is at this level that there is scope for inconsistency. As a consequence, within Australian law we find a case involving fabrics sold to members of the public in which it was said that 'complete ignorance of what a Crusader was or who Caesar was may be imputed to the potential buyer'.¹⁵ However, we find other cases in which it was implicitly held that the average Australian purchaser of refrigerators could be taken to know that the Coldstream Guards is a famous regiment in the British army.¹⁶

The Crusader / Coldstream Guards example does not – as some uncharitable foreign readers might assume – reflect a set of strange priorities within the Australian education system. Rather, it demonstrates that the attributes of the average consumer can be readily manipulated to produce whatever result the tribunal considers normatively desirable. At the same time, however, tribunals genuinely care about the reaction of real consumers. This is most obviously evident in the desire of common law courts to give weight to evidence of actual confusion. But more generally, tribunals really do want to take account of how real consumers behave. Consequently, tribunals sometimes shift to treating the average consumer as something much more like an empirical construct.

There are good reasons to suggest that the mutable nature of the average consumer test undermines the consistency and predictability of outcomes, and that there are more transparent ways to build policy-based limitations into trade mark reasoning, a point that

¹⁴ See also R. Burrell and M. Handler, *Australian Trade Mark Law*, 2nd ed. (Oxford University Press, 2016), pp. 213-215.

¹⁵ *Australian Woollen Mills Ltd v FS Walton & Co Ltd* (1937) 58 CLR 641, 659.

¹⁶ *Coldstream Refrigerators Ltd v Aircrafts Pty Ltd* (1950) 20 AOJP 1491.

Dinwoodie and Gangjee have eloquently made.¹⁷ For present purposes though, the key point is that until we are clearer in our own minds as to how the decision-making of real consumers maps onto our legal tests, it is difficult to articulate what role psychology might play. Psychology may be able to tell us what real consumers think, but if we are not sure how much we care about what they think, we will struggle to know what to do with this information.

A second potential barrier to drawing on insights from psychology when dealing with registered trade marks is that the property right in such a mark is determined by its bureaucratic form. The process of registration serves to abstract away from marketplace reality, and the scope of protection will be determined by reference to what the owner has registered. If the owner has secured protection for a word mark, the mark protected by law will be that word written in any script and reproduced in any colour.¹⁸ Similarly, the goods or services will be determined by reference to the specification, and it is very likely that this will be drafted in a way that will also serve to extend the owner's monopoly beyond the goods or services that it actually produces or provides.¹⁹ Consider, for example, a trader who sells T-shirts under the mark BURRELL, with 'Burrell' invariably appearing in a purple cursive font. Absent any prior conflicting mark on the register, it would be perfectly possible to register BURRELL as a word mark with a specification for 'clothing'. This would almost certainly allow the owner of the BURRELL mark to bring a successful action against a defendant using the mark BIRRELL reproduced in a very different yellow font in relation to three-piece suits: the marks would almost certainly be regarded as similar (there only being one letter different, and differences in the get-up of the marks being ignored because BURRELL is registered as a word mark) and the goods are identical (both being 'clothing'). Yet there would seem to be very little danger of confusion in the marketplace.²⁰

The above example demonstrates that the registered trade mark system gives rights

¹⁷ *Supra* n 2.

¹⁸ *Reed Executive Plc v Reed Business Information Ltd* [2004] ETMR 56, [79]; cf *Specsavers International Healthcare Ltd v Asda Stores Ltd* (C-252/12) [2013] ETMR 46.

¹⁹ For discussion see R. Burrell and M. Handler, 'Dilution and Trade Mark Registration' (2008) 17 *Transnational Law and Contemporary Problems* 713, 716-723.

²⁰ In response it might be argued that use on T-shirts is not sufficient to preserve a registration for 'clothing' rendering the mark vulnerable to partial revocation for non-use. This may be correct, but it needs to be remembered (a) that for the first few years of the registration no such challenge can be brought; and (b) this example is intended to illustrate the point as clearly as possible, but the broader point is that the terminology used in specifications always carries with it the possibility of extending protection beyond the goods that are actually produced by the owner.

that go beyond anything that would be warranted if preventing confusion were our sole concern. The best (or rather least bad) explanation for allowing trade mark owners to carve out a broader sphere of protection than a right against confusion would warrant is that this gives trade mark owners a degree of space around their brands. This space acts as an incentive to register, and the register creates a source of public information which has public value, specifically, by reducing clearance costs for businesses that are trying to identify whether a sign remains available for use as a trade mark.²¹ If, however, the registered trade mark system is only loosely tethered to the goal of preventing confusion, it may not be immediately obvious what role psychology can play when assessing whether infringement has occurred.²²

In order to explore this point further it is necessary to analyse provisions that appear to turn on the likelihood of confusion. How can we justify our analysis in the face of tests for infringement that put confusion at the heart of the analysis? In short, our response is that provisions and legal tests that appear to turn on confusion are generally not what they seem. The confusion enquiry is not, and cannot, be at large if we are to persist with the idea that the nature of trade mark rights is determined by their bureaucratic form.²³ Matters like the ‘global appreciation’ test of European law therefore need to be approached with considerable care. This test appears to tell us that the likelihood of confusion is central to the infringement enquiry: we judge confusion in the round; we undertake a global assessment; and determinations of similarity of marks and similarity of goods go to the single question of whether there is likely to be confusion in the marketplace.²⁴ In reality, however, the global appreciation test allows us to sidestep the question of whether anyone is actually likely to be confused in the marketplace. The similarity of marks / goods enquiries are generally treated as determinative of the likelihood of confusion: *i.e.* we assume there will be confusion if the marks and goods or services are objectively similar. To reiterate, this is inevitable if we are to respect

²¹ R. Burrell, ‘Trade Mark Bureaucracies’ in G. Dinwoodie and M. Janis (eds.), *Trademark Law and Theory: A Handbook of Contemporary Research* (Northampton, MA: Edward Elgar 2008); R. Tushnet, ‘Registration in Modern American Trademark Law’ (2016) 130 *Harvard Law Review* 867.

²² It also becomes much more difficult to imagine empirical tests, as discussed further below.

²³ It is also hard to pinpoint what the contribution of trade mark law would be, above and beyond general unfair competition laws, if confusion was the only consideration in infringement. In addition, practicality is a concern. If infringement turned entirely on a factual likelihood of confusion, then so should registrability (registration reflecting what marks can and cannot be used in the marketplace) and it would become very difficult to administer the system or process the tens of thousands of trade mark applications that trade mark offices receive every year.

²⁴ *Canon Kabushiki Kaisha v Metro Goldwyn Mayer Inc (C-39/97)* [1998] ECR I-5507 at [16]; *O2 Holdings Ltd v Hutchinson 3G UK Ltd (C-533/06)* [2008] ECR I-4231.

the idea that the boundaries of protection for trade marks are determined by their bureaucratic form.

Having said this, it should be acknowledged that courts do try to find ways of bringing confusion back into the analysis. One means of so doing is by taking account of extraneous factors, that is, marketplace factors that make confusion more or less likely. If any area of trade mark law seems to suffer from a lack of conceptual clarity, it is the question of when such extraneous factors are and are not relevant to the infringement enquiry. But it should tell us something that the rules on extraneous factors lack conceptual clarity in each of Australia, Singapore and Europe.²⁵ Ultimately, this is because courts are having to walk an impossible line. On the one hand, courts are trying to keep the owner's monopoly within justifiable bounds by taking account of whether consumers will in fact be confused. On the other hand, they are trying to preserve the essential nature of the registered trade mark right as a right determined by the scope of the registration.

To elaborate on the point about how courts seek to make confusion relevant to the analysis, one might also point to the insistence in some jurisdictions that it is only certain types of 'use' of a sign that can trigger a finding of infringement. For example, under pre-harmonised British trade mark law (that is, under the Trade Marks Act 1938 and its precursors) there was a requirement that the defendant's use be 'use as a trade mark' for infringement to be established. The principal function of this test was to exclude liability in cases where the defendant's use fell *prima facie* within the scope of the trade mark owner's monopoly, but where confusion was unlikely.²⁶ This technique continues to be employed in a

²⁵ In Australia the leading authorities are *MID Sydney Pty Ltd v Australian Tourism Co Ltd* (1999) 42 IPR 561 and *CA Henschke and Co v Rosemount Estates Pty Ltd* (2000) 52 IPR 42, but many years on the application of principles established in these cases remains difficult and controversial. See Burrell and Handler, *supra* n 7, at pp. 398-401. In Singapore the leading case is *Staywell Hospitality Group Pty Ltd v Starwood Hotels & Resorts Worldwide, Inc* [2014] 1 SLR 911. For critical discussion see D. Tan and B. Foo, 'The Extraneous Factors Rule in Trademark Law: Avoiding Confusion or Simply Confusing?' [2016] *Singapore Journal of Legal Studies* 118 (arguing for a move to a system to where we pay less attention to bureaucratic form). The language of 'extraneous factors' is not used in Europe, but the same issues and uncertainties raise their head. On the one hand, one can see in the *Sky v Skype* dispute a desire to preserve the bureaucratic, paper-based nature of the registered trade mark right (See Case T 184/13 *Skype Ultd v OHIM* (5 May 2015) (General Court)). On the other hand, the Office has signalled that it will take *some* types of marketplace factors into account even when dealing with relative grounds of refusal: see *EUIPO Examination Guidelines* (1.10.2017), Part C Opposition, Section 2, ch. 2 ('comparison of goods and services'); ch. 3 ('relevant public and 'degree of attention'); ch. 6 (other factors). Much like in Australia and Singapore, the Office tries to draw a distinction between general conditions in the trade (relevant) and specific marketing strategies (irrelevant). But this distinction is fragile, not least because 'the trade' can be constructed more or less narrowly.

²⁶ See *Irving's Yeast-Vite Ltd v Horsenail* (1934) 51 RPC 110 (House of Lords holding that there had been no 'use as a mark' in a comparative advertising case). One of the present authors has defended this interpretation of

number of Commonwealth countries, including Australia.²⁷ Something similar can also be seen in the ‘functions analysis’ developed by the Court of Justice. By creating a mechanism that serves to soften the impact of the double identity provision of European law (that on its face imposes strict liability in cases where a defendant has used an identical mark on identical goods), the Court has found a way of protecting defendants whose actions are highly unlikely to cause confusion, but who may not be able to bring themselves within a nominate defence.

Again, courts are to be applauded for seeking to cabin registered trade mark rights in a way that reflects their ultimate justification. However, much as with our comment about the inevitably strained rules that determine when extraneous factors are and are not relevant to a finding of infringement, we should be unsurprised if doctrines like ‘use as a trade mark’ and ‘functions analysis’ suffer from a degree of intellectual incoherence. For present purposes, however, the key insight is that the rules by which an assessment of the likelihood of actual confusion in the marketplace are incorporated into the infringement enquiry form part of a carefully constructed, but ultimately entirely artificial, ecosystem. If one understands the role of psychology as being primarily about collecting evidence of how consumers actually respond in the marketplace to the signs and stimuli to which they are exposed – as our preoccupation with the reception of survey evidence tends to suggest – then it is easy to conclude that psychology cannot be given a place within the registered trade mark law without disrupting the artificial environment we inhabit.

There are even more formidable barriers to courts drawing on psychological evidence in cases in which dilution is alleged. The premise of legal rules that seek to prevent trade mark dilution is that even consumers who are not confused by a defendant’s use of a similar mark – who do not think there is any trade connection – will have their response to the original changed by dilutive use in ways that harm the trade mark owner. The ultimate problem for tribunals is that it is far from clear that the harms that dilution guards against are real or, to the extent such harms are real, whether they are likely to occur in the circumstances that the law imagines.

the trade mark use threshold in detail elsewhere: Burrell and Handler, *supra* n 14, at pp. 375-387. We accept, however, that it remains controversial. For a contrary view see M. Davison and F. di Giandomasso, ‘Use as a Trade Mark: Avoiding Confusion when Considering Dilution’ [2009] EIPR 443.

²⁷ See *Trade Marks Act 1995 (Cth)*, s. 120 and, e.g., *Shell Co Australia Ltd v Esso Standard Oil (Aust) Ltd* (1963) 109 CLR 407; *Irrewarra Estate Pty Limited (t/as Irrewarra Sourdough)* [2012] FCA 592 (2012) 292 ALR 101; *Coca-Cola Company v PepsiCo Inc (No 2)* [2014] FCA 1287 (2014) 322 ALR 505.

Consider, for example, what we know about the tarnishment of brands, bearing in mind that this is normally regarded as the more intuitively appealing and hence least controversial subset of dilution.²⁸ Work by marketing researchers on authorised brand extensions suggests that even in cases where consumers are disappointed by the new product, their negative evaluation of the extension will not feedback to impact on their view of the original.²⁹ As Michael Handler has noted, this must call into question whether consumers would ever think less of a brand where they understand that the product or service in question is being used by an unrelated entity. If they do not think less of a brand when it has been ‘tarnished’ by the trade mark owner, there is no reason to conclude that they would think less of a brand when the use is clearly unauthorised.³⁰ Still more dramatically, we have the results of Christo Boshoff’s attempts to measure tarnishment effects.³¹ Boshoff conducted a study in which he exposed consumers to advertisements for well-known brands and to advertisements for tarnished versions of these brands. Importantly, when the participants were exposed to the tarnished versions first their subsequent reactions to the original brands were actually more positive than in cases where they were exposed to the original brands first.³²

Attempts to draw on psychology in cases where blurring is alleged would be equally fraught. Insofar as there are studies that attempt to show that consumer recognition of a mark can be adversely affected by use of a similar sign on dissimilar goods, they do not begin to show that traders would suffer any financial harm from a delayed reaction time that has to be measured in milliseconds.³³ Moreover, even within the most famous study of this type, we find examples where use of a mark on dissimilar goods actually served to *increase* recognition of the original brand.³⁴ Then there is the problem that in most jurisdictions protection

²⁸ S. Rierson, ‘The Myth and Reality of Dilution’ (2012) 11 *Duke Law and Technology Review* 212, 246; M. Handler, ‘What Can Harm the Reputation of a Trademark? A Critical Re-Evaluation of Dilution by Tarnishment’ (2016) 106 *Trademark Reporter* 639, 640.

²⁹ H. Sjödin and F. Törn, ‘When Communication Challenges Brand Associations: A Framework for Understanding Consumer Responses to Brand Image Incongruity (2006) 5 *Journal of Consumer Behaviour* 32, in particular, at 38 (and the work cited therein).

³⁰ Handler, *supra* n 28, at 680.

³¹ C. Boshoff, ‘The Lady Doth Protest Too Much: A Neurophysiological Perspective on Brand Tarnishment’ (2016) 25 *Journal of Product and Brand Management* 196.

³² As determined by using electroencephalography or ‘EEG’ to measure brain activity and electromyography or ‘EMG’ to measure changes in facial muscles.

³³ R. Tushnet, ‘Gone in 60 Milliseconds: Trademark Law and Cognitive Science’ (2008) 86 *Texas Law Review* 507.

³⁴ M. Morrin and J. Jacoby, ‘Trademark Dilution: Empirical Measures for an Elusive Concept’ (2000) 19 *Journal of Public Policy and Marketing* 265 (the authors of this study this study seek to demonstrate via laboratory studies that blurring tends to increase information processing times with the result that it takes consumers longer to

against blurring is only conferred on marks that meet a certain threshold of public recognition.³⁵ In the language of the European trade mark regime, it is only ‘marks with a reputation’ that enjoy protection against blurring. However, when one interrogates the harm that protection against blurring is intended to prevent, it is said to be about preserving the commercial identity of the mark; it prevents uses that would be ‘detrimental to the distinctive character of the mark’. The underlying concern is that use of a similar mark on dissimilar goods and services can inhibit the ability of the original trade mark to ‘reach out’ to consumers. There appears to be a growing consensus that it is counter-intuitive to suggest that this type of harm should only be a cause for concern in cases where the mark enjoys a reputation.³⁶ Such marks are, by definition, already firmly fixed in the public mind and the risk that third party uses will diminish consumers’ ability to recall the mark and its associations must be relatively limited.

It must, however, be remembered that courts have to take the antidilution provisions as they find them. It is of no assistance to judges to tell them that there is a discipline that may help demonstrate that dilution harms do not occur or, at most, that dilutive uses will sometimes impair brand recognition, but will sometimes enhance it in ways that are apparently impossible to predict. Admittedly, psychologists might be able to demonstrate that consumers will indeed draw links between unconnected products. They might well be able to demonstrate, say, that customers of a Nike café have the sportswear company brought to mind. But if this makes dilution easier to establish – despite the fact that no harm to Nike’s interests can be shown – this would hardly be desirable.³⁷ The concern that the reputation threshold makes the action for blurring entirely incoherent adds a further level of uncertainty.

recall the original brand. However, although this was generally found to be the case they reported that advertisements for ‘Hyatt legal services’ actually improved participants’ recall of Hyatt as a brand of hotel).

³⁵ To gain protection under the Lanham Act in the US, a mark must be ‘famous’: 15 U.S.C. § 1125(c) (2006). In the European Union only marks that ‘have a reputation’ are protected against dilution: European Parliament and Council Directive 2008/95/EC of 22 October 2009 to approximate the laws of the Member States relating to trade marks, 1989 O.J. (L 40) 1 (EC), art. 5(2); Council Regulation Council Regulation (EC) No 207/2009 on the Community trade mark, as amended by Council Regulation (EU) 2015/2424 of the European Parliament and of the Council of 16 December 2015, art. 9(1)(c), 1994 O.J. (L 11) 1 (EC).

³⁶ See R. Burrell and M. Handler, ‘Reputation in European Trade Mark Law: A Re-examination’ (2016) 17 *ERA Forum* 85.

³⁷ This is arguably one of the problems with the way in which survey evidence has been employed in some US dilution cases, with the evidence going solely to the question of whether consumers would be likely to link the two products. Our thanks go to Dev Gangjee for this observation. See also *British Sky Broadcasting Group Plc v Microsoft Corporation* [2013] EWHC 1826 (Ch) where a survey was accepted to establish that the defendant’s mark ‘called to mind’ the registered mark.

In particular, there must be a concern that the evidence will suggest that the associations that consumers draw between a mark and particular goods / services is most likely to be disrupted (blurred) in cases where the senior mark is still struggling for a foothold in the market (i.e. the harm that blurring is intended to prevent will only arise in cases where the statutory threshold for antidilution protection has not been met). Courts cannot rely on such information to write legislative provisions out of the Act.

Consequently, the temptation for courts is to do their best to impose liability in cases of the type that the legislature must be presumed to have had in mind, without drawing on insights from psychology. A discipline that suggests that antidilution protection should be rethought in its entirety may be interesting to academics and ought to be interesting to policy-makers, but is unlikely to command much attention from judges, at least when they are acting in their judicial capacity.

III. PSYCHOLOGY IN COURT

If psychology is to have a greater bearing on trade mark law, we need to recognise that many of the questions with which trade mark law is concerned do not lend themselves to an empirical or scientific answer. Trade mark law is not only concerned with whether consumers are likely to be confused: it also quite rightly takes account of a range of other policy goals. For better or worse the registration system confers a set of abstract rights and the nature of these rights needs to be respected; courts have to take the legislative framework as they find it, proving that the framework is deeply flawed is of little assistance. As trade mark lawyers we might do well to be more open and explicit about these matters, but they do pose very real constraints on how we engage with psychologists and psychological evidence.

Moreover, before charting any new relationship between the disciplines, we also need to take seriously the constraints imposed on judges by the need to ensure the efficient administration of justice. Not only do courts have to take extraneous policy concerns into account, such as the impact of their decisions on competition, they also need to pay attention to how litigation can and should be run. Most obviously, they need to think about the costs of litigation. This consideration is placed front and centre of the UK's Civil Procedure Rules, which set out an 'overriding objective of enabling the court to deal with cases justly and at

proportionate cost'.³⁸ The potential for litigation costs to balloon is an obvious concern about trying to draw on psychological evidence,³⁹ particularly when this question is being viewed almost entirely through the lens of whether courts should make greater use of survey evidence in infringement proceedings.⁴⁰ Surveys add significantly to the costs of the litigation, both in direct costs in arranging for surveys to be conducted, but also because they cause delay and take up significant court time because of the evidentiary tussles that seem inevitably to follow in their wake. Courts are therefore right to approach survey evidence with a good deal of care.⁴¹

The cost of litigation is not the only matter to which courts need to turn their attention. Practitioners from disciplines outside law are sometimes unaware of a range of considerations internal to court processes that are unrelated to (and even counter to) the pursuit of objective truth. Courts also need the freedom to take account of how the parties have conducted themselves during the course of the litigation, whether the case has been properly pleaded and so forth. Here it must be remembered that such considerations are not removed from the demands of justice. If parties do not conduct themselves appropriately the administration of justice rapidly becomes impossible. Holding parties to their pleadings is an important part of ensuring that each side can prepare its case properly with adequate knowledge of what the other side is claiming and without an undue element of surprise. Above all defendants must be given 'a fair idea of the possible consequences and risks' should the claimant prevail.⁴² Still more generally, we ought to respect the craft involved in judicial decision-making. We ought not expect judges to put aside more intuitive considerations ('common sense') when deciding cases, and nor would we want them to do so.⁴³

One of the problems with surveys in particular is that they are often presented in trade mark litigation as though they provide the definitive answer to the question that is to be

³⁸ Civil Procedure Rules 1998 (UK) Rule 1.1. The court has a general power to exclude, admissible evidence in pursuit of this overriding objective: Civil Procedure Rules 1998 (UK) Rule 32.1.

³⁹ See, e.g., *Interflora Inc v Marks & Spencer Plc* [2013] 2 All ER 663; *Neutrogena Corp v Golden Ltd* [1996] RPC 473, 485–486; *Sterling Pharmaceuticals Pty Ltd v Johnson & Johnson Australia Pty Ltd* (1990) 96 ALR 277; *Cadbury Schweppes Pty Ltd v Darrell Lea Chocolate Shops Pty Ltd* (2006) 228 ALR 719, 726.

⁴⁰ Empirical evidence that might be provided from the disciplines of psychology or marketing vary considerably: from broad representative surveys of existing consumers, to small experiments which seek to test very specific (and isolated) questions, as illustrated in the next Part.

⁴¹ For a detailed exegesis of these points see Weatherall, *supra* n 2.

⁴² *Kirin-Amgen Inc v Transkaryotic Therapies Inc. (No. 2)* [2002] RPC 3, [34].

⁴³ A point made convincingly by Posner: R. Posner, *How Judges Think* (Harvard University Press 2010), in particular, at pp. 116-117.

determined: they either prove or disprove the likelihood of confusion and hence are dispositive of the outcome. Trade mark law has left itself open to this problem because, as we have seen, there has been a tendency to submerge other policy considerations within the confusion enquiry. Equally, however, there can be no question that courts have often been presented with poorly designed surveys and overblown claims from the authors of these surveys.⁴⁴ Indeed, one of these things that we have been most struck by from the psychologists with whom we have collaborated is their scepticism as to whether it would ever be possible to design a robust test for whether confusion has occurred or is likely to occur. The problems, it seems, are manifold but include:

(1) How to separate legally irrelevant background confusion (some consumers will just mix up Visa and Mastercard, or Duracell and Eveready) from confusion caused by the use of similar signs.

(2) How to interrogate consumer responses to signs when – however gently and indirectly this is done – this is likely to cause participants to engage with what a sign conveys in ways that may not map onto real shopping scenarios. This is because surveys ask people explicitly to think about marks and signs, whereas for everyday purchases we will often shop on ‘autopilot’, relying on unconscious information processing, while we are busy talking on the phone or distracting children from the call of the confectionary aisle or preparing a lecture in our heads.⁴⁵

(3) How to press participants on the nature of their response to ensure that they are engaged with thought processes relevant to the legal enquiry, and doing so without asking leading questions. Take, for example, a participant who on seeing the junior mark states that this ‘reminds’ her of the senior mark. Does she mean (a) that she has been left wondering whether the marks come from the same trade source (confusion); or (b) that the junior mark ‘calls to mind’ the senior mark but is ‘obviously’ from a different trade source (legally irrelevant, at least outside of the dilution context) or (c) that she takes it as a signal from an unrelated trade source that this is intended to be a competing product (legally irrelevant and likely to be beneficial for competition)? Any attempt to press the participant on what she

⁴⁴ See eg *CA Henschke & Co v Rosemount Estates Pty Ltd* (1999) 47 IPR 63 (small/unbalanced sample); *Re Castlemaine Perkins Ltd v Power Brewing Company Limited* [1992] FCA 638 (methodology not explained); *South Australian Brewing Co Pty Ltd v Carlton & United Breweries Ltd* (2001) 185 ALR 719 (questions did not sufficiently distinguish between use of the word Showdown as a mark, and use of the word to refer to certain AFL games).

⁴⁵ See Weatherall, *supra* n 2 and the sources cited therein for detailed discussion of these issues.

means is likely to be condemned as leading, and quite rightly so: when the participant said she was 'reminded', she is likely to have meant she was reminded. If she is pressed to elaborate any additional explanation she provides may well be generated entirely *ex post*.⁴⁶

Moving away from surveys, we need to be alive to the problems of expert evidence more generally. These problems have been rehearsed in the pages of law reviews for 150 years or more.⁴⁷ Among the more prominent are selection bias (parties are able to call experts whose views fall outside the scientific mainstream and present these views as if they were on an equal footing with orthodox opinion); loss of objectivity (experts, no matter how professional, will align themselves with the instructing party) and mission creep (the danger of experts being pulled into giving opinion on matters outside their core area of expertise). To this need to be added problems of cost and the rather more amorphous concern that the 'battle of experts' undermines the integrity of the judicial process.⁴⁸ Courts are, of course, alive to these concerns and there have been a series of innovations, ranging from greater use of 'hot tubbing' to removal of the immunity from suit that expert witnesses previously enjoyed in relation to their participation in legal proceedings.⁴⁹ But the need for such innovations and the fact that discomfort about the role of experts in court can be traced back to when recognisably modern scientific professions emerged⁵⁰ should perhaps alert us to the fact that expert evidence is never going to be free from difficulty. We should therefore hardly be surprised if those responsible for administering the system are less than enthused by calls from academics for greater use of experts in trade mark proceedings when, ultimately, we have been muddling along quite nicely without their input.

⁴⁶ This is not, of course, invariably the case – sometimes we misspeak or are careless in our choice of language. In these cases a follow up question may allow us to get closer to what the participant meant by the original response, but there is no way to separate out these cases from those in which the follow up question prompts a deeper level of thought or engagement. Our thanks go to Lionel Bently for pushing us to clarify this point.

⁴⁷ For early critical discussion of the problems attached to expert testimony see, e.g., E. Washburn, 'Testimony of Experts, (1866) 1 *American Law Review* 45; L. Hand, 'Historical and Practical Considerations Regarding Expert Testimony' (1901) 15 *Harvard Law Review* 40.

⁴⁸ A point made forcefully by Goldstein: R. Goldstein, 'High Noon in the Court Room: An Overview of the Psychiatric Expert as Hired Gun' in R. Simon (ed.), *Review of Clinical Psychiatry and the Law* (American Psychiatric Publishing, 1992).

⁴⁹ In the UK this was a consequence of the decision of the Supreme Court in *Jones v Kaney* [2011] UKSC 13.

⁵⁰ Concerns about perceived partisanship of expert witnesses, and the consequent impact on the scientific credibility of their evidence, were voiced regularly from the 1780s onwards. For discussion of these concerns in the context of the rise of the adversarial trial see T. Golan, 'Revisiting the History of Scientific Expert Testimony' (2008) 73 *Brooklyn Law Review* 879; C. Jones, 'Expert Witnesses: Science, Medicine and the Practice of Law' (Oxford: Clarendon Press, 1994). For a recent survey of the literature see K. Couzens, "'Upon my word, I do not see the use of medical evidence here": Persuasion, Authority and Medical Expertise in the Edinburgh High Court of Justiciary' (2018) 103 *History* (forthcoming).

It is also important to confront a still more fundamental suspicion than can arise between law and psychology, one grounded in mistrust of the other's metaphysical underpinnings. Neither law nor psychology requires a commitment to drawing a conclusion about the ultimate nature of human decision-making, but the disciplines do tend to pull us towards different poles of the age-old freedom/determinism debate. If determinism is correct, then we would seem not to be morally responsible for our actions and the law's assignment of fault and system of sanctions become difficult to justify. Some philosophers have developed sophisticated responses to this concern, including by attacking the idea that there is a link between moral responsibility and the freedom to choose an alternate course of action.⁵¹ For the most part, however, lawyers and legal academics go about their business with a sort of loose commitment to libertarianism.⁵² If pressed on the nature of human decision-making, the legally trained may well be non-committal or even express some sympathy for the determinist view, but day-to-day we approach the operation of the legal system as if the libertarian position were correct.

Conversely, psychologists are not invariably determinists. There are psychologists who defend free will⁵³ and even among the psychologists who would normally be classified as determinists we find attempts to carve out space for genuine decision-making.⁵⁴ Psychologists working on less abstract questions do not in general need to worry about such matters. Like lawyers they can focus on more quotidian concerns. But in their work they tend to look for causal explanations for our behaviour: for consumer psychologists this means asking how we respond to adverts or to the positioning of goods in a supermarket or to incongruent brand messages. This does not require consumer psychologists to conclude that

⁵¹ See, most famously, H. Frankfurt, 'Alternate Possibilities and Moral Responsibility' (1969) 66 *The Journal of Philosophy* 829. For those with a legal background who do end up engaging with the freedom-determinism debate, Strawson's compatibilism often holds an instinctive attraction. For Strawson our desire to punish is tied to our 'reactive attitudes' towards witnessing the infliction of harm on others, which is inseparable from our nature as social beings. See P.F. Strawson, 'Freedom and Resentment' (1962) 48 *Proceedings of the British Academy* 187.

⁵² Used here in the sense this term is employed in metaphysics, i.e., as involving a commitment to a belief in free will and not in the sense this term is used in political philosophy, the latter being much more commonly encountered in legal scholarship.

⁵³ This is true, in particular, of humanist psychologists such as Carl Rogers.

⁵⁴ For example, on some accounts of Freud's work the goal of psychoanalysis is to provide subjects with some ability to control their actions.

we are ‘Pavlovian stooge[s] of the advertising industry’,⁵⁵ but in their day-to-day work they look at psychological processes through a lens of soft determinism.

Lawyers and psychologists thus tend to look at the world and its inhabitants from different perspectives, at least in their day-to-day dealings. This can make lawyers wary of accommodating insights from psychology. This is particularly true in cases where psychological evidence may cast doubt on human agency,⁵⁶ as some consumer psychology might seem to tend towards. The law has far less difficulty in accommodating insights from psychologists in other types of case, for example, in family court proceedings where psychological evidence will go more to matters of environment, as where the question is whether a child would be more likely to flourish in one domestic situation rather than another.⁵⁷ This is not to suggest that there would be an insurmountable obstacle to making greater use of psychological evidence on the types of matters that arise in trade mark cases.⁵⁸ But the metaphysical mistrust that can arise between the disciplines means that there is an even heavier burden on proponents of greater engagement between the disciplines than might be suggested by the other consideration canvassed in this section alone (cost, the need to preserve judicial discretion, the problem of testing for likelihood of confusion in a robust fashion, and the problems with expert evidence generally).

IV. TOWARDS A NEW RELATIONSHIP

The analysis presented thus far demonstrates that psychology and trade mark law make much less comfortable bedfellows than might at first be imagined. It is clear that any attempt to build a more fruitful relationship between the two disciplines needs to take account of a range of potential obstacles. It also seems that the most productive way forward is likely to be to find areas when consensus might be achieved relatively easily, rather than, say, trying to

⁵⁵ B. Beebe, ‘Search and Persuasion in Trademark Law’ (2005) 103 *Michigan Law Review* 2020, 2023.

⁵⁶ For a discussion of the hostility of English courts to psychological evidence in the criminal context see A. Colman and R. MacKay, ‘Psychological Evidence in Court: Legal Developments in England and the United States’ (1995) 1 *Psychology, Crime and Law* 261 (noting ‘In England, the growth of psychology after the Second World War was accompanied by an increasingly sceptical and cautious attitude on the part of the judiciary towards the admissibility of psychological evidence’ (at 261)).

⁵⁷ Although here, too, there is debate: see J. Cashmore and P. Parkinson ‘The Use and Abuse of Social Science Research Evidence in Children's Cases’ (2014) 20 *Psychology, Public Policy, and Law* 239.

⁵⁸ As illustrated by the fact that the criminal justice system has come to accommodate insights from psychologists, for example, in risk assessments made as part of parole decisions, although even in this case it might be noted that in both legal circles and press coverage there is a tendency to treat such insights as going to the question of whether the prisoner is likely to *choose* to reoffend.

reach immediate agreement on how to incorporate survey evidence into the likelihood of confusion enquiry. It seemed to us that a useful first step might be to see whether we might try to think about the relationship between the two disciplines at a higher level of abstraction. Rather than thinking about how psychology might influence the outcome in a particular dispute, we might want to think about whether we can learn anything from psychology at a more general level.

Consider, for example, old British rules on comparison of marks, rules that continue to be influential in a number of Commonwealth countries. These tell us, for example, that words are more likely to be deemed similar if they share the same beginning rather than the same ending.⁵⁹ Conversely, word marks are less likely to be deemed similar if they contain a different number of syllables.⁶⁰ At the danger of stating the obvious, these rules are not intended to act as a closed set of legal rules. Courts are not making an assessment of whether the signs are similar solely by reference to an established body of case law. Rather they are seeking to establish whether the marks share enough features in common that they would be likely to leave consumers with the same overall impression. It is for this reason that when making assessments of similarity we pay attention to the conditions under which goods and services are offered to the public. If we are talking about marks for beer, for example, we need to take account of the fact that beer is sold in noisy bars where there is a significant danger of mishearing.⁶¹

Rules on comparison of marks are thus at their heart rules on how consumers respond to things they see and hear, what they are likely to retain and what sort of connections they are likely to draw. But looked at in this way it soon becomes clear that the rules rest on a series of untested assumptions. They are, in essence, the product of early twentieth century judicial guesswork. If that seems likely an unduly harsh assessment, we should acknowledge that the present authors have not been above guesswork of their own. For instance, we became concerned that Australian courts had underplayed the potential importance of ideational similarity. This is because they had held that a finding of deceptive similarity could not be made on the basis of ideational similarity alone.⁶² This meant, for example, that a mark

⁵⁹ *London Lubricants (1920) Ltd's Application* (1925) 42 RPC 264 (CA) is usually cited as the foundational case.

⁶⁰ See, e.g., *RJ Reynolds Tobacco Co v Butland Tobacco Ltd* [1974] NZIPOTM 1; *'Lancer' Trade Mark* [1987] RPC 303 (Ch); *Gardenia Overseas Pte Ltd v The Garden Co Ltd* (1994) 29 IPR 485 (FCA).

⁶¹ *New Zealand Breweries Ltd v Heineken's Bier Browerij Maatschappij NV* [1964] NZLR 115, 136 (NZCA).

⁶² *Sports Cafe Ltd v Registrar of Trade Marks* (1998) 42 IPR 552, 557 (FFCA).

featuring the image of a star could not be regarded as deceptively similar to a mark featuring the word 'star'. It seemed to us that this failed to recognise that consumers might be left with the idea or impression of a star and hence mistake the two. One of the present authors pointed out that Australian courts had failed to consider late nineteenth and early twentieth century UK cases that had reached the opposite conclusion⁶³ and, of course, was delighted when the Full Federal Court signalled a shift in its position.⁶⁴ But if we are being honest, the argument rested on a guess that the guess made by UK courts was better than the guess made by Australian courts a century later.

If our rules on comparison of marks are a product of guesswork, there must surely be scope for psychology to add something important, if only in terms of us getting a better understanding of how consumers process information. Think about what we know about the rearrangement of internal word order. Several years ago, the so-called 'Cambridge email' was widely circulated. This was intended to demonstrate that 'it doesn't matter in what order the letters in a word are, the only important thing is that the first and last letter be at the right place'. Subsequent research has confirmed that where a word is reproduced with its internal letters mixed up we can often still match that word against its normal orthographic representation stored in our memory.⁶⁵ Operationalising this knowledge within the trade mark system would almost certainly make very little difference to the outcome in most cases. Courts would tend towards a finding of similarity in jumbled word cases applying current rules. Moreover, we need, as always, to be clear about the limits of scientific knowledge: we are still not entirely clear why most of us find it harder to read 'Big council tax increases' as 'big council tax increases' than we do to read 'A vehicle exploded at a police checkpoint' as 'A vehicle exploded at a police checkpoint'.⁶⁶

Nevertheless, a better understanding of how consumers access and process information would allow us to be more confident about outcomes, particularly in cases that are genuinely difficult or borderline. For example, a better understanding of the lessons that

⁶³ Specifically, *La Société Anonyme des Verreries de l'Etoile's Trade Mark* (1894) 11 RPC 142 (CA); *Pomril Ltd's Application* (1901) 18 RPC 181 (Ch). See R. Burrell and M. Handler, *Australian Trade Mark Law* (Oxford University Press, 2010), pp. 182-184

⁶⁴ In *Telstra Corporation Limited v Phone Directories Company Pty Ltd* [2015] FCAFC 156.

⁶⁵ K. Rayner, S.J. White, R.L. Johnson and S.P. Liversedge, 'Reading Words with Jumbled Letters: There is a cost' (2006) 17 *Psychological Science* 192 and S.J. Lupker, M. Perea and C.J. Davis, 'Transposed-letter Effects: Consonants, vowels and letter frequency' (2008) 23 *Language and Cognitive Processes* 93.

⁶⁶ These examples are adapted from the webpages of the Cognition and Brain Sciences Unit at the University of Cambridge: mrc-cbu.cam.ac.uk/people/matt.davis/cmabridge.

psychology has to offer might allow us to be more confident about whether the VOLVO / LOVOL dispute was rightly decided.⁶⁷ Embedding insights from psychology into some of our legal tests would also ensure that tribunals could deal more confidently with attempts by parties to rely on arguments grounded in psychological studies. It would remove the sense that tribunals are uncomfortable or perhaps even unduly defensive when addressing such arguments.⁶⁸

Building the sort of relationship we have in mind is obviously a slow process. It requires us to think carefully about when and how psychology might have something to offer. It also requires thinking about the mechanism(s) or route(s) by which insights might be embedded: one thing we do not address in this paper is when work in psychology could make its way into legal tests via adoption by courts, by a more indirect route through, say, discussion in academic treatises, or via other trade mark institutions such as the trade mark office. These are hard questions, as the earlier discussion of expert evidence illustrates. But before we can even think about such paths to change, it also requires psychologists to design studies that produce results that are meaningful, bearing in mind that the findings need to be capable of taking root in the artificial trade mark ecosystem we have constructed. The team of psychologists with whom the present authors have been working have made a start on the latter process, conducting three studies that help shed light on some of the most important issues in trade mark law. These are discussed immediately below.⁶⁹

(a) Getting started

In our view one important place to start was with the basic rules for comparing word marks. As mentioned earlier, one of the rules that is still widely applied in Commonwealth countries is that the beginning of words is more important than the end and, in particular, that attention

⁶⁷ T-525/11 - *Volvo Trademark v OHMI - Hebei Aulion Heavy Industries* (12 November 2014) (General Court of the European Union, rejecting Volvo's appeal against OHIM's decision to allow LOVOL to be registered); *Volvo Trademark Holding AB v Hebei Aulion Heavy Industries Co Ltd* [2009] ATMO 46 (Australian registry, rejecting Volvo's opposition).

⁶⁸ See, in particular, *Volvo v OHMI*, *ibid*, [49]. Volvo argued that research from cognitive neuroscience suggested that consumers would associate the marks such that they ought to be regarded as similar. The General Court dismissed this argument without engaging with the science or the relevant policy considerations on the ground that Volvo's argument 'was not based on any principle established by case-law'. See also *Lion-Beer, Spirits & Wine Pty Ltd v Harvey* [2013] ATMO 6 (Australian registry dealing with some of the evidence on 'jumbled words' outlined above).

⁶⁹ Inevitably, it is not possible to provide a detailed account of the methodology or experimental design of these studies. For these the reader should refer to the original studies.

should be given to the first syllable.⁷⁰ Although this rule has been with us for nearly a century, it is not underpinned by any empirical evidence. Moreover, when this rule is explored in further detail the internal rationale for this rule becomes somewhat unclear. Originally this approach was justified because of ‘the tendency of persons using the English language to slur the termination of words’. But this suggests that the rule is about aural comparison: it is a concern that goes to the danger of mishearing as might occur when a product is ordered over the telephone or by talking to a shop assistant. However, this rule has been equally applied in cases where aural comparison is of relatively little importance because the goods in question will only ever be selected by the consumer from a rack or a shelf or from an online store. Indeed, tribunals in Australia have been clear that for many products aural similarity is retreating in importance as shopping habits change, and yet they continue to apply *London Lubricants*.⁷¹

This suggests that there must be another justification for the rule, namely, that it is the start of a word that will leave the greatest impression with consumers.⁷² If this is correct, then there may well be a greater danger of confusion (because of imperfect recollection) if a later market entrant chooses a mark with a similar beginning than there is if the later entrant chooses a mark whose similarities lie in some other component.

Designing a test to seek to establish whether consumers really are more likely to be confused by similar word beginnings is, however, difficult. Replicating shopping scenarios is hard and is not necessarily helpful if one is talking about comparing marks for the purposes of the abstract test used in the registered trade mark system which requires us to consider the mark as registered not as used – and in some cases even before there is any use. Nevertheless, one might reasonably expect that if consumers do pay more attention to the beginning of words this would be something they would be aware of subjectively. In other words, if the legal test accurately reflects consumer response one would expect that if you ask members of the public to rate the similarity of words they would tend to focus on the

⁷⁰ *In re London Lubricants* [1925] 42 RPC 264.

⁷¹ See, e.g., *Taiwan Yamani Inc v Giorgio Armani SpA* (1989) 17 IPR 92(ATMO). To much the same effect, see Intellectual Property Office of Singapore, *Trade Mark Work Manual*, p. 18 (Version 5, June 2017), available at: https://www.ipos.gov.sg/docs/default-source/resources-library/trade-marks/infopacks/tm_work-manual_7-relative-grounds_jun2017.pdf. It is, of course, possible that the advent of ‘intelligent personal assistants’ such as Siri will cause a resurgence in the importance of aural similarity.

⁷² Perhaps, for example, because we are accustomed to reading left to right. Our thanks go to Richard Arnold for emphasising this point.

beginnings as being the most important feature. A critic might respond that the additional propensity for confusion occurs by means of a purely subconscious process. But if we were to approach the matter *de novo* we would require the critic to prove this subconscious effect. As a practical matter, of course, we cannot approach this question as if we were starting with a blank sheet of paper – any shift from the current rule would create considerable uncertainty and thus could only be justified by cogent evidence. However, for the purpose of working out how the disciplines might learn to speak to one another, we should try to approach questions like ‘should we weigh word beginnings more heavily?’ with an open mind.

The psychologists in the research team therefore conducted a laboratory study where they asked participants to rate the similarity of words, being a mixture of words from the dictionary and brand names taken from the Australian trade marks register.⁷³ The participants were asked to rate on a short numerical scale the similarity of the words presented to them visually. They were instructed that they should consider whether the words might be confused when reading, but were given few other instructions and no information about pronunciation or the like. The idea was that this experiment would give us an indication of whether there was anything in the subjective response of participants to support the idea that we should give additional weight to the beginnings of words even when we are concerned solely with visual (as opposed to aural) presentation. The results were striking: participants gave a much higher similarity score to words that shared the same beginning than they did to words that shared the same ending.⁷⁴

This first experiment does not, of course, demonstrate that the current legal test is correct. The test tells us nothing about memory effects and hence the likelihood of confusion. But it does tell us something about how we process words, it does suggest that we do respond much more strongly to the beginnings of words than to their endings or other elements. As such it lends some weight to the view that the current rule is appropriate.

Beyond this though the study may offer a further important lesson for trade mark law. The results of the study were extremely consistent. It seems that as soon as you have a moderately sized group of 20 or (somewhat mischievously) we might suggest 12, then you

⁷³ See Jennifer S. Burt, K. McFarlane, S. Kelly, M. Humphreys, K. Weatherall and R. Burrell, ‘Brand Name Confusion: Subjective and Objective Measures of Orthographic Similarity’ (2017) 23 *Journal of Experimental Psychology: Applied* 320.

⁷⁴ The results are not easily summarised since they varied across various sub-experiments that tested for the impact of different length letter strings, the importance of vowel match, etc.

can be fairly certain that assessments of similarity across the group will map onto the reaction of a much larger group. However, when looking at the response of any given individual we do often find some idiosyncratic assessments. This might cause us to reflect on whether we are confident that the training, experience and shared understandings of trade mark examiners, hearing officers and judges is sufficient to counteract any personal tendency towards unusual views of similarity. More controversially, we might want to ask whether we want to pay more attention to public ratings of similarity, and if so, how might this be done. Assuming that no one really wants to revert to having jury trials in trade mark cases,⁷⁵ does this perhaps mean that experimental data of the type our study produced might be admitted, or does it mean that we might use a more statistical measure of similarity? Our study suggests, for example, that it would be possible to design a metric based on existing metrics used in psychology or other disciplines that would provide a reliable indicator of whether the public would be likely to regard two words as similar.⁷⁶ Such a measure may or may not be useful, and we would certainly never suggest that it could be definitive, because as we have already noted we need to leave room for judicial discretion including to take account of conditions in particular trades, competition concerns (such as concerns to keep certain kinds of words available for all to use) and the like. But we do think that it is an idea that is at least worth considering.

(b) Limping towards confusion

The second study was designed to think about issues of distinctiveness, but in a somewhat different way than one might normally expect this issue to be tackled. The problem with studies that ask consumers whether they respond to this sign or that sign as a badge of origin is that they readily lapse into asking what looks like leading questions. The concern is that if you ask participants a question like ‘who do you think makes this shoe’ based on a picture of a shoe with a series of stripes on the side, you are signalling to the respondent that they have enough information to answer the question, you are encouraging them to speculate. Drawing

⁷⁵ For a discussion (and bipartisan rejection) of this possibility, see *Verocchi v Direct Chemist Outlet* (2015) 228 FCR 189 at [316]–[326].

⁷⁶ Burt et al *supra* n 2. We are conscious of Dinwoodie and Gangjee’s concern that ‘consumer reaction might be deduced using heuristic devices designed to short-circuit the factually intensive and messy enquiry into how real world consumers actually perceive signs’: *supra* n 3, 365. As noted, we would not argue that any such heuristic or metric should be determinative of the questions in trade mark law. The point here, too, is that by drawing on experiments like that reported here, we can ensure the heuristic is rooted in empirical evidence, rather than judicial (or other) guesswork.

on the general principles of good survey design you could perhaps administer a written questionnaire with an 'I don't know' box as one of the alternatives, but even on this model you have still asked them to speculate as to trade origin when this idea might simply not have entered their mind at all. Semi-structured interview questions, where there is scope for the researcher to ask for clarification on certain points might be an alternative, but there is still the danger of leading respondents towards certain answers. Consequently, there are good reasons for approaching 'distinctiveness surveys' with caution.⁷⁷

We therefore thought that an alternative approach might be to work backwards from what we can deduce about the signs that consumers rely on when they are searching for products. In order to test this, we presented participants in our second study with a group of brands and accompanying brand claims or slogans.⁷⁸ The brands used were all existing Australian brands that enjoy a significant market share and in the preliminary phase we ensured that participants were familiar with the brands in question. These brands were then matched with a slogan generated by the research team. Participants were instructed to try to remember the brand and the slogan, and were told that they would be tested on the recurrence of the brand with the slogan. During the memory phase of the test participants were shown a number of pairs, some were pairs they had studied, some consisted of slogans they had studied linked to a new brand in the same product category and some consisted of slogans they had studied linked to a new brand in a different product category. So, for example, participants might have been asked to study 'Always reliable with... Eveready'. Some would then be shown 'Always reliable with...Eveready', some would be shown 'Always reliable with...Duracell' and some would be shown 'Always reliable with...Huggies'. The results found a statistically significant increase in the 'false alarm rate' when a studied slogan was used in conjunction with a brand in the same product category, compared to when it was used in relation to a brand in a different product category. In other words, there was something about the slogans that meant they became attached in the minds of the participants to a particular type of product.

⁷⁷ This is notable because surveys regarding distinctiveness are often treated as less problematic than surveys targeted at testing for consumer confusion: Dinwoodie and Gangjee *supra* n 3; Weatherall *supra* n 2.

⁷⁸ M. Humphreys, K. McFarlane, J. Burt, S. Kelly, K. Weatherall and R. Burrell, 'Recognition in Context: Implications for trade mark law' (2017) 24 *Psychonomic Bulletin & Review* 1665.

What does this tell us? A sceptic is likely to respond ‘nothing’. One obvious criticism is that our study is far removed from a high-fidelity shopping scenario. However, if we try and step back from what we do at the moment and reflect on what we know about the impact of slogans on consumers, then we might see our study as providing some limited evidence that consumers do rapidly associate slogans with particular types of product. Might this not suggest that if we allow competitors within the same product category to copy slogans this is likely to lead to confusion? Does this in turn raise questions about the registrability of slogans: in particular, is it right to treat slogans less favourably because they are ‘limping marks’? On this view, although consumers may associate slogans with particular traders, they do not rely on them to find the products they want: they may associate ‘Have a Break’ with Nestle, but no one ever went into a shop and said ‘please may I have a Have a Break’: rather, they ask for a Kit Kat. However, looked at from an infringement perspective, this approach to distinctiveness looks somewhat suspect. In Australia at least, when thinking about infringement we focus on matters of first impression. We focus on a consumer who has had limited exposure to the senior mark, so that their recollection of it may be imperfect, and who encounters the junior mark for the first time. Now let us change our focus slightly and think about the real-world scenario of a consumer who encounters a product for the first time. If we accept that slogans can become readily attached to a product then consumers may to some degree rely on slogans to help them make purchases – at least until the primary brand name is firmly fixed in their minds. Viewed in this way it is much less clear that slogans should be dismissed as mere limping marks, unless of course we were prepared to abandon our concern with matters of first impression generally.

If our second study suggests that consumers might rely on slogans when making purchasing decisions then we also need to ask questions about other secondary indicators of source, above all trade dress. This formed the focus of our final study.

(c) Looking like confusion

The third topic we wanted to examine was lookalike products. This was an obvious area to explore because lookalike goods have been controversial for many years and brand owners periodically insist that more needs to be done to protect them from copycat products. It was also one that seemed potentially fruitful, since the question of how we think about product get up is important both in terms of what we let onto the register and in terms of passing off

litigation. At the same time, it is an issue that needs to be approached with care, because protection for product get up, much more than protection for some other secondary indicators of source, raises very real competition concerns.

In Commonwealth countries brand owners have generally struggled to prevent the sale of lookalike products. The assumption is that consumers pay more attention to brand names than they do to product appearance when making their purchasing decisions. In fact, the law has not really moved on since the 1903 decision in *Schweppes Ltd v Gibbens*,⁷⁹ where Lord Halsbury said, ‘if a person is so careless that he does not look, and does not... “treat the label fairly”, but takes the bottle without sufficient consideration and without reading what is written very plainly indeed upon the face of the label on which the trader has placed his own name, then you certainly cannot say he is deceived’.⁸⁰

We set out to test whether consumers really do treat the relationship between brand names and labels / packaging in the way Lord Halsbury suggests: is it really only exceptionally careless consumers who can be led into error by similarities in packaging? The psychologists in the research team therefore designed another memory experiment in which participants were asked to remember pictures of a number of items all of a type that could be found in a supermarket.⁸¹ During the recall part of the experiment the products were manipulated so that one group of subjects was presented with identical packaging and a similar brand name (e.g. Heinz and Heanz) and another group of subjects was presented with identical packaging and a dissimilar brand name (e.g. Heinz and Bertie’s). If our natural propensity as consumers really is to focus on brand names then one would expect very different false alarm rates between the two groups: we would expect a much higher false alarm rate from the identical packaging, similar brand group than from the identical packaging, dissimilar brand group. In fact, however, the false alarm rates between the two groups were almost identical.

There are lots of things that this study does not tell us. It does not, for example, tell us how fame will impact on the relative weight that we place on brand names. The experiment tested whether participants had seen a product before *during the study*. In contrast, a consumer may be seeking to find a product that they may have encountered on many

⁷⁹ (1905) 22 RPC 601. The quote is at pp. 606-7.

⁸⁰ For the ongoing influence of *Schweppes Ltd v Gibbens* see, e.g, *George East Housewares Ltd v Fackelmann GmbH & Co KG* [2016] EWHC 2476 (IPEC).

⁸¹ M. Humphreys, K. McFarlane, J. Burt, S. Kelly, K. Weatherall and R. Burrell, ‘How Important is the Name in Predicting False Recognition for Lookalike Brands? (2017) 23 *Psychology, Public Policy, and Law* 381.

previous occasions. Perhaps as brand names become very firmly fixed in our mind we become less susceptible to the impact of similar packaging. Perhaps the participants in our study began to doubt their recollection of the name and began to focus unduly on trying to remember the details of the packaging they had seen in a way that would not map onto a real shopping scenario. Perhaps the fact that the experiment turned on our judgment calls as to whether the marks were similar or dissimilar brings our results into question. These and similar arguments might all form avenues by which to protect the status quo.

If, however, one steps back from the current legal position would it really be all that surprising if our study provided some evidence to suggest that confusion might be occurring? Might the prevalence of copycat strategies not indicate that traders are quietly hoping that some degree of confusion will occur,⁸² even if they might also have other reasons for adopting such a strategy? Moreover, we would push back against the idea that our experiment has no bearing on real shopping scenarios. On the contrary, we would suggest that it provides a reasonable proxy for the type of scenario alluded to at the end of the preceding subsection, namely, that of a consumer who has had some prior exposure to a brand, but where that exposure is sufficiently limited that her memory is imperfect. Take, for instance, someone who has tried a new brand of ice cream at a friend's house. This person decides that she will buy a carton for herself when she sees it for sale and so she tries to commit the product to memory. Once she is out shopping our study suggests similarity of get up may be enough to cause her to buy the wrong brand, even if the brand names are entirely different. If the confusion had arisen because of similarity in the brand names this would be treated as a straightforward case. We therefore need to think harder about whether, and if so why, the result should be different if the error is caused by similarity of packaging.

Consequently, although our study unquestionably has its limits, it does call into question our restrictive attitude to allowing similarity of trade dress to form the basis of a successful passing off claim and to allowing elements of product design to be registered as a

⁸² This would include cases (possibly the majority) where the later market entrant is hoping not so much for an increase in sales through ongoing confusion involving repeated transactions with the same consumer, but more that the consumer will be confused at the point of sale the first time they encounter the copycat product. The copyist may well be expecting (indeed hoping) that the consumer will realise his or her error at or before the point of consumption, but if they are nevertheless satisfied with the product they may come to accept it as a substitute and actively seek it out again. For trade mark lawyers this sort of strategy is traditionally regarded as illegitimate, even though it might be defended as competition enhancing. This speaks to the need of trade mark lawyers to speak to other disciplines beyond psychology, a point to which we return below.

trade mark. Our tentative findings do not, however, necessarily mean that the law has to change, or even that such a decision is merely waiting on further data to confirm our results. If packaging is more important in consumer decision-making than we have generally been comfortable in admitting, it is likely because we are worried about the impact of greater protection on competitors. Such concerns are not without foundation. The supply of commercially viable shapes and colours is limited, and perhaps it is more efficient to err on the side of allowing some degree of confusion to occur.⁸³ Perhaps we need to give more weight to the argument – which receives some support from the marketing literature – that lookalike packaging can be a helpful way of signalling functional equivalence. Perhaps it is better that any error cost should fall on consumers who – on the assumption they eventually realise their error – will be motivated to be more careful next time. Perhaps we need to expect a higher degree of attention from customers generally, irrespective of whether we are talking about confusion caused by similarity of names or packaging.

Demanding that consumers be more attentive and worrying less about what the ‘moron in a hurry’ might do might, moreover, have other advantages. It would, for example, allow for greater co-existence between marks generally, an outcome that would by no means be unattractive if, as Beebe and Fromer suggest, we may be entering a world in which we are ‘running out of marks’: tightening our rules on similarity would increase the stock of available marks considerably.⁸⁴ But considering whether such a development would be desirable is precisely why, on the one hand, it is important that as trade mark lawyers we engage with other disciplines, whilst, on the other hand, bearing in mind the limits of what other disciplines can teach us. Psychologists should hopefully be able to help us predict the likely impact of any tightening of our rules on similarity, but they cannot tell us normatively whether the consequences of any such tightening would be desirable. This is not to say that the latter question is one for trade mark lawyers alone – economists should have at least as much to offer. This brings us to a general point. We are not suggesting for a moment that psychology is the only other discipline that has something to offer trade mark law or that its insights

⁸³ See Burrell and Handler, *supra* n 7, pp. 68-69 (where we seek to demonstrate that the supply of bottle shapes in Class 32 (alcoholic beverages) is limited. For a contrary view see J. McCutcheon, ‘Monopolised Product Shapes and Factual Distinctiveness under s 41(6) of the *Trade Marks Act 1995 (Cth)* (2004) 15 *Australian Intellectual Property Journal* 18, 27-29 (doubting the ‘limited supply’ argument).

⁸⁴ B. Beebe and J. Fromer, ‘Are We Running Out of Trademarks? An Empirical Study of Trademark Depletion and Congestion’ (2018) 131 *Harvard Law Review* 945.

should carry special weight. But we do think that given how much psychology might have to teach us it has been woefully neglected thus far, something that cannot be said of economics.

V. CONCLUSION

To conclude, we would like to return to the question of where trade mark law and psychology can meet productively. Where we are running into difficulty at present is in seeing this question in terms of whether psychology can help us determine how a particular case should be decided. How should this dispute, between these parties, be resolved? Cognitive psychology is not well-suited to answering that sort of question. As a discipline it does not set out to draw conclusions at that level of specificity. Scientific papers do not try to draw conclusions for the single case. They are probabilistic in their approach and insofar as they advance our understanding of the real world, they do so by performing experiments in closed environments that can only, at best, approximate to real world conditions. Making decisions about the individual case in all its complicated, real world messiness is what judges are trained to do. It is what legal decision-making is quintessentially designed to do. This is not to suggest that there is no place for psychological studies to be admitted in evidence, but we should not pretend that using such evidence in trade mark cases is ever going to be easy, or comfortable.

The point we are seeking to make, however, is that the difficulties of accommodating psychological evidence in infringement cases is not an excuse for us failing to ask whether there is something that trade mark law can learn from psychology at a higher level of abstraction. Trade mark law turns in large part on how consumers process information and it is surely important that we at least explore whether our models of consumer processing could be made more accurate. With this in mind we have been part of a research team that has tried to do some proof of concept work – work that shows that psychology can help us question in a productive fashion whether our current assumptions about consumers are well-founded. At the same time, our work adds to growing calls for trade mark law to be clearer about when other policy goals may cause us to discount some degree of confusion. If trade mark law had a better-grounded model of consumer reaction and a more clearly articulated set of policy goals, we might be able to remedy at least some of what is wrong with current trade mark systems.