

TRADE MARK OWNFRINGEMENT

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Trade mark owners have increasingly been acting similarly to those they accuse of infringement or dilution of their marks. They are acting as “ownfringers”. They have been engaging in previously unheard-of competitor collaborations, collaborations with businesses in distant spaces, and self-parody. These trends typify how trade mark owners are increasingly behaving like the third parties they pursue for infringement. How should trade mark law think about these new, prevalent behaviours by mark owners? Perhaps it is just par for the course because mark owners have the right to use their marks in commerce in ways that would constitute infringement if done by third parties. Even so, by engaging in ownfringement, trade mark owners are potentially altering the balance or calculus of a number of fundamental aspects of trade mark doctrine. I explore three important doctrinal impacts of ownfringement: on likelihood of consumer confusion, trade mark distinctiveness and self-dilution, and the parody defence.

I. INTRODUCTION

In recent years, trade mark owners have increasingly been acting very similarly to those they accuse of infringement or dilution of their marks. They are acting as what I call “ownfringers”. For example, fashion companies Gucci and Balenciaga recently engaged in a collaboration of sorts – the “Hacker Project” – in which they each spliced the others’ marks and signature aspects into their fashion items. As a result, Gucci’s double-G logo appears all over Balenciaga’s Hourglass bag, while a logo with double-B’s (for Balenciaga) that otherwise looks like Gucci’s appears with the red-and-green Gucci stripe on tote bags. Were a third party to have done this, Gucci and Balenciaga would reasonably be shouting about consumer confusion and trade mark infringement. But this is instead a once-unlikely collaboration between direct competitors. Previously unheard-of collaborations between businesses in distinct spaces are also proliferating, such as Adidas footwear with Lego brick details, between fashion brand Dolce & Gabbana and Smeg appliances, and between IKEA home goods and fashion company Off-White. Yet at the same time, mark owners like Nike are pursuing legal action for infringement against aftermarket customisers of their goods, claiming they can control this aftermarket even when

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the third-party customisation strikes consumers as an unlikely “collaboration” with the mark owner. Moreover, businesses are increasingly self-parodying their own marks, as with Gucci releasing fashion designs with its mark purposely misspelled and Nike deliberately misplacing its swoosh on its sneakers. As businesses are self-parodying, however, mark owners continue to claim that third parties’ arguable parodies constitute trade mark infringement, as Nike has done with MSCHF’s Satan Shoes and Vans has done with MSCHF’s Wavy Baby shoes. These three trends typify how trade mark owners are increasingly behaving like the third parties they pursue for infringement.

How should trade mark law think about these new, prevalent behaviours by mark owners? On the one hand, it is just par for the course because mark owners have the right to use their marks in commerce in ways that would constitute infringement if done by third parties (such as when a third party copies a protected mark identically onto competing goods). Yet this behaviour by mark owners seems distinct in important ways. For one thing, mark owners are arguably blurring the distinctiveness of their own marks by engaging in these once-unusual collaborations and self-parody. In fact, they might be undermining the strength and the protectability of their own marks and engaging in self-dilution. Moreover, by purposefully increasing the likelihood of consumer confusion as to whether a mark’s use is legitimate – even if done ironically – mark owners are altering the calculus of trade mark infringement analysis.

II. THE CONVENTIONAL STORY OF TRADE MARK OWNERSHIP AND USE

Before delving into trade mark ownfringement and the consequences for trade mark law, it is worth recounting some background on trade mark law and the conventional story of trade mark use. Words, symbols, logos, and sometimes a product’s design or packaging may be protected under trade mark law.¹ In the US, according to the Lanham Act, these are protectable under federal law so long as they are “used by a person” in commerce “to identify and distinguish his or her goods ... from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown”.² Federal law similarly protects marks that designate services.³ Distinctive marks used in commerce are protectable, either via registration and enforcement,⁴ or through a provision allowing enforcement of unregistered

¹ Lanham Act 15 USC § 1127 [Lanham Act] (defining trade marks to include certain “word[s], name[s], symbol[s], or device[s], or any combination thereof”); *Wal-Mart Stores, Inc v Samara Bros* 529 US 20 at 209–216 (2000) (holding that product design or packaging might constitute a protectable trade mark). Also potentially protectable are sounds, scents, and colors, see *Qualitex Co v Jacobson Products Co* 514 US 159 at 162, 174 (1995). Although much of what I discuss in this article might also apply to images and trade dress – a product’s design or packaging – I focus explicitly on words.

² Lanham Act, *supra* note 1 at § 1127. Likewise, they are protectable if a person has a “bona fide intention to use [them] in commerce and applies to register [them] on the principal register established by [federal law]”.

³ *Ibid.*

⁴ *Ibid* at §§ 1052, 1114.

marks.⁵ Federal law protects trade mark registrants against another's "use in commerce [of] any reproduction ... of [their] registered mark in connection with the sale, offering for sale, distribution, or advertising of any goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive".⁶ Unregistered marks are similarly protected.⁷

Trade mark law originated to protect indications of an article's source by guarding producers from competitors' illegitimate interference with their trade.⁸ The law has broadened beyond these narrower purposes to also emphasise protecting consumers from confusion to foster fair competition.⁹ The increased production capacity for goods ushered in by the industrial revolution boosted instances of advertising to the public to distinguish goods, which popularised trade marks as identifiers of the source of goods.¹⁰ As time marched on, consumers began to know less and less about the specific source of particular goods.¹¹ Nonetheless, a trade mark affixed to goods would help consumers know that those goods originated from the same source, whatever that source was.¹² Relatedly, a trade mark would help distinguish a product from others with different marks.¹³

Trade mark protection strives to bolster trade, as Frank Schechter explains, by "identify[ing] a product as satisfactory and thereby ... stimulat[ing] further purchases by the consuming public".¹⁴ Scholars theorise that producers of trade marked goods will have the incentive to invest in the goods' quality.¹⁵ They suggest that this investment will occur because consumers will use the trade mark as a

⁵ *Ibid* at § 1125(a)(1).

⁶ *Ibid* at § 1114(1)(a).

⁷ *Ibid* at § 1125(a)(1). Even though protection against infringement is provided whether or not a mark is registered, there are significant advantages to registration. If an entity succeeds in demonstrating to the US Patent and Trademark Office that a mark it uses is entitled to trade mark registration (including that an identical or sufficiently similar mark is not already in use in a way that would confuse consumers), *ibid* at § 1052(d), that entity benefits in multiple ways. Among the advantages conferred are nationwide constructive use conferring priority over most users of the same or similar marks, *ibid* at §§ 1057(c), 1072, enhanced remedies in federal court, *ibid* at § 1117(b), and the possibility of the mark becoming incontestable in many ways after five years, *ibid* at § 1065. Conversely, there are disadvantages for the owner of an unregistered mark. For that owner, an infringement action might lie only if the unregistered user has priority, typically due to an allegedly infringing use in a geographic area where the marked products or services were already being sold or advertised or where the mark's reputation has been established. See Restatement (Third) of Unfair Competition (US: American Law Institute, 1995) at § 30 cmt a.

⁸ Sidney A Diamond, "The Historical Development of Trademarks" (1975) 65 Trademark Rep 265 at 270 [Diamond]; Mark P McKenna, "The Normative Foundations of Trademark Law" (2007) 82 Notre Dame L Rev 1839 at 1841 [McKenna, "Normative Foundations"]; Beverly W Pattishall, "Two Hundred Years of American Trademark Law" (1978) 68 Trademark Rep 121 at 128; Frank I Schechter, "The Rational Basis of Trademark Protection" (1927) 40 Harv L Rev 813 at 814–819 [Schechter].

⁹ *Park 'N Fly, Inc v Dollar Park & Fly, Inc* 469 US 189 at 198 (1985); McKenna, "Normative Foundations", *supra* note 8 at 1843; Schechter, *supra* note 8 at 814–819.

¹⁰ Diamond, *supra* note 8 at 280–281.

¹¹ Schechter, *supra* note 8 at 814–815.

¹² *Ibid* at 817.

¹³ Barton Beebe, "The Semiotic Analysis of Trademark Law" (2004) 51 UCLA L Rev 621 at 677, 682 [Beebe, "Semiotic Analysis of Trademark Law"].

¹⁴ Schechter, *supra* note 8 at 818.

¹⁵ See, eg, William M Landes & Richard A Posner, "Trademark Law: An Economic Perspective" (1987) 30 JL & Econ 265 at 269–270.

way to identify a desirable good only if their past experiences reliably forecast the good's worth.¹⁶ Protecting against trade mark infringement, from this vantage point, thus prevents others from trading on the goodwill represented by the trade mark.¹⁷ Businesses might then leverage the goodwill engendered by consumers' association of a particular mark with positive value and meaning by using the mark for an ever wider range of goods and services.

In these ways, trade marks also aim to reduce consumers' search costs – the expenditures they must make to discern important qualities of goods or services, which are frequently hard to measure.¹⁸ Therefore, trade mark protection guards against use of a too-similar mark that is likely to cause consumer confusion as to goods' or services' origin.¹⁹ In these ways, trade mark law seeks to promote fair competition and protect consumers.

Rochelle Dreyfuss observes that trade marks have begun to serve a communicative purpose, of “becom[ing] products in their own right, valued as indicators of the status, preferences, and aspirations of those who use them”.²⁰ To take one litigated instance from the US, a band sings a song entitled *Barbie Girl* to offer commentary on the values a Barbie doll represents: “I’m a blond bimbo girl, in a fantasy world/ Dress me up, make it tight, I’m your dolly.”²¹ As the ensuing Ninth Circuit decision puts it:

Some trademarks enter our public discourse and become an integral part of our vocabulary. How else do you say that something’s ‘the Rolls Royce of its class’? What else is a quick fix, but a Band-Aid? Does the average consumer know to ask for aspirin as ‘acetyl salicylic acid’? Trademarks often fill in gaps in our vocabulary and add a contemporary flavor to our expressions. Once imbued with such expressive value, the trademark becomes a word in our language and assumes a role outside the bounds of trademark law.²²

¹⁶ William M Landes & Richard A Posner, “The Economics of Trademark Law” (1988) 78 *Trademark Rep* 267 at 271 [Landes & Posner, “Economics of Trademark Law”]. There has been a good deal of debate among trade mark scholars about whether the law ought to view the consumer as a free individual making a choice to pay more for intangible values conveyed through advertising or as a person to be protected from the irrational encouragement that advertising and trade marks provide, beyond the underlying goods’ quality. See generally Ralph S Brown Jr, “Advertising and the Public Interest: Legal Protection of Trade Symbols” (1948) 57 *Yale LJ* 1165 (describing this debate).

¹⁷ Robert G Bone, “Hunting Goodwill: A History of the Concept of Goodwill in Trademark Law” (2006) 86 *BUL Rev* 547 at 549.

¹⁸ Beebe, “Semiotic Analysis of Trademark Law”, *supra* note 13 at 623.

¹⁹ Graeme B. Dinwoodie, “The Death of Ontology: A Teleological Approach to Trademark Law” (1999) 84 *Iowa L Rev* 611 at 614.

²⁰ Rochelle Cooper Dreyfuss, “Expressive Genericity: Trademarks as Language in the Pepsi Generation” (1990) 65 *Notre Dame L Rev* 397 [Dreyfuss]; accord Beebe, “Semiotic Analysis of Trademark Law”, *supra* note 13 at 624, 656; David Tan, “The Semiotics of Alpha Brands: Encoding/Decoding/Recoding/Transcoding of Louis Vuitton and Implications for Trademark Laws” (2013) 32 *Cardozo Arts & Ent LJ* 221 at 223–224.

²¹ *Mattel, Inc v MCA Records, Inc* 296 F 3d 894 at 901 (9th Cir, 2002) (quoting Aqua’s song, “Barbie Girl”) [*Mattel*].

²² *Ibid* at 900, internal citations omitted.

Because these communicative uses enrich society's conversations, scholars recommend that trade mark protection not encompass such uses.²³

Applying this canonical and conventional story of trade mark law and theory, trade mark infringement tends to involve a business – intentionally or not – using an identical or quite similar mark to that of the mark owner on competing or related goods in a way that is confusing to consumers. Examples would be a company other than Nike slapping Nike's swoosh on its sneakers, a coffee company other than Starbucks using the Starbucks name and logo, or a fast-food restaurant that is not McDonald's displaying the McDonald's golden arches. Or a coffee company might use a similar logo, color scheme, and name as Starbucks, such as Sunbucks Coffee with a dragon in the place of the Starbucks mermaid. Or Starbucks Coeff. Or Bucksstar Coffee. Or USABucks Coffee.²⁴

At the same time, in large part owing to a recognition of how central trade marks can be to speech in contemporary society, trade mark law allows for some uses of an otherwise protected trade mark, such as when they are used descriptively rather than to indicate source, when they are used nominatively, and when they are used as parody or cultural commentary.²⁵ These doctrines are thought to protect values related to free speech, yet they are plagued with ambiguity regarding when they apply and how much consumer confusion is tolerable.²⁶ For example, after Louis Vuitton brought suit against the makers of Chewy Vuitton dog chew toys, a US appeals court held that the dog chew toys do not constitute infringement of the Louis Vuitton mark because as a successful parody, they are unlikely to confuse consumers.²⁷ By contrast, a different US court held that Anheuser-Busch showed a likelihood of consumer confusion (including survey evidence that 30% of consumers were confused as to source) from the Buttwiپر squeaky dog toy in the shape of a Budweiser bottle.²⁸

Finally, rounding out the tale of conventional trade mark infringement is dilution, which has become part of trade mark law as trade mark rights have expanded over time. The doctrine of dilution provides owners of famous marks with protection against others' use of their mark, even if consumers are not confused.²⁹ As Barton Beebe, Roy Germano, Chris Sprigman, and Joel Steckel explain, dilution by blurring "is understood somehow to damage the famous brand name by diminishing the immediacy with which consumers identify the brand name with its source and

²³ Eg, Dreyfuss, *supra* note 20 at 418.

²⁴ "Rip-off Fake Starbucks Coffee anyone?", *Toby Simkin* <<https://tobysimkin.com/fake-starbucks-coffee/>> (17 July 2015).

²⁵ Stacey L Dogan & Mark A Lemley, "Parody as Brand" (2013) 47 UC Davis L Rev 473 [Dogan & Lemley]; William McGeeveran, "Rethinking Trademark Fair Use" (2009) 94 Iowa L Rev 49 [McGeeveran].

²⁶ See generally Dogan & Lemley, *supra* note 25; McGeeveran, *supra* note 25; see also *KP Permanent Make-Up, Inc v Lasting Impression I, Inc* 543 US 111 at 123–124 (2004) (holding that descriptive "fair use can occur along with some degree of confusion [which] does not foreclose the relevance of the extent of any likely consumer confusion in assessing whether a defendant's use is objectively fair").

²⁷ *Louis Vuitton Malletier SA v Haute Diggity Dogg, LLC* 507 F 3d 252 (4th Cir, 2007).

²⁸ *Anheuser-Busch v VIP Products* 666 F Supp 2d 974 (ED Mo, 2008).

²⁹ Lanham Act, *supra* note 1 at § 1125(c).

other preexisting associations”.³⁰ For this reason, Google could likely prevent third parties from selling Google milk, Google medication, Google yarn, and Google gardening tools, even though Google offers no such goods or anything similar and consumers might not be confused at all as to the source of any of these goods.

III. THE NEW STORY OF TRADE MARK OWNFRINGEMENT

With this background, I now turn to the new – and still evolving – story of trade mark ownfringement, in which trade mark owners are increasingly acting like those they have long pursued and still pursue for trade mark infringement. In particular, I address the growing trends of competitor collaborations, collaborations between businesses in distant categories of goods and services, and self-parody.

A. Competitor Collaborations

In recent years, competing fashion companies have been collaborating to mash up their collections, incorporating signature items – that is, protectable marks – of both in a single product. As auction house Sotheby’s recently proclaimed, “unexpected partnerships are continually reshaping the fashion industry as we know it”.³¹

Notably, in 2021, luxury fashion competitors Gucci and Balenciaga engaged in a collaboration entitled “The Hacker Project”, in which they each spliced the others’ marks and signature aspects into their fashion items. It is in effect a mashup of their logos and aesthetics. As a result, for example, Gucci’s double-G logo appears all over Balenciaga’s Hourglass bag.³² Likewise, “Balenciaga” and Balenciaga’s floral print are both all over Gucci’s Marmont bag alongside Gucci’s double-G logo.³³ On the Balenciaga side, for instance, a logo with double-B’s (for Balenciaga) that otherwise looks like Gucci’s appears with the red-and-green Gucci stripe on tote bags.³⁴ And the same double-B logo appears all over a puffer jacket.³⁵ To release the collaboration, some of Gucci’s and Balenciaga’s stores, such as the Balenciaga store on New York’s Madison Avenue, were “graffitied” with the Gucci name to appear as vandalism, with artists in store to add graffiti to purchased bags that said – in a trade mark ode to Surrealist artist René Magritte – “THIS IS NOT A GUCCI BAG”.³⁶

³⁰ Barton Beebe, Roy Germano, Christopher Jon Sprigman & Joel Steckel, “Testing for Trademark Dilution in Court and the Lab” (2019) 86 U Chicago L Rev 611 at 614.

³¹ Erica Kagan, “Gucci x Balenciaga ‘Hacker Project’: Not Just Another Collaboration”, *Sotheby’s* <<https://www.sothebys.com/en/articles/gucci-x-balenciaga-hacker-project-not-just-another-collaboration>> (3 December 2021) [Kagan].

³² “The Hacker Project”, *Gucci* <<https://www.gucci.com/us/en/st/balenciaga-gucci-variation>>.

³³ *Ibid.*

³⁴ “Gucci x Balenciaga The Hacker Project Medium Tote Bag”, *StockX* <<https://stockx.com/gucci-x-balenciaga-the-hacker-project-medium-tote-bag-beige>>.

³⁵ Tara Larson, “Rihanna Does Date Night with A\$AP Rocky in Gucci x Balenciaga Puffer Vest & Snakeskin Sandals”, *Footwear News* <<https://footwearnews.com/2022/fashion/celebrity-style/rihanna-asap-rocky-gucci-balenciaga-puffer-1203228626>> (12 January 2022).

³⁶ Shane O’Neill, “Fashion Fans in Line, for a ‘Hack’”, *The New York Times* <<https://www.nytimes.com/2021/11/18/style/balenciaga-gucci-hacker.html>> (18 November 2021).

Gucci and Balenciaga are not competitors in one sense, as they are both owned by Kering.³⁷ That said, they still compete with one another as luxury fashion brands in many ways, just as independent companies would.³⁸



³⁷ “Couture and Leather Goods”, *Kering* <<https://www.kering.com/en/houses>>.

³⁸ See Phillip Areeda & Donald Turner, “Conglomerate Mergers: Extended Interdependence and Effects on Interindustry Competition as Grounds for Condemnation” (1979) 127 U Pa L Rev 1082 at 1102, n 21; Timothy M Hurley, Note, “The Urge to Merge: Contemporary Theories on the Rise of Conglomerate Mergers in the 1960s” (2006) 1 J Bus & Tech L 185 at 190–191.

Similarly, this past year, luxury fashion competitors Fendi and Versace swapped their designers and launched the appropriately named FENDACE collection. In the collection, for example, Fendi's F logo is used together with Versace's Baroque print³⁹ and the Fendi Baguette has a Versace Medusa emblazoned on it.⁴⁰ Some pieces also feature the portmanteau brand FENDACE with a combination of their signature elements.⁴¹



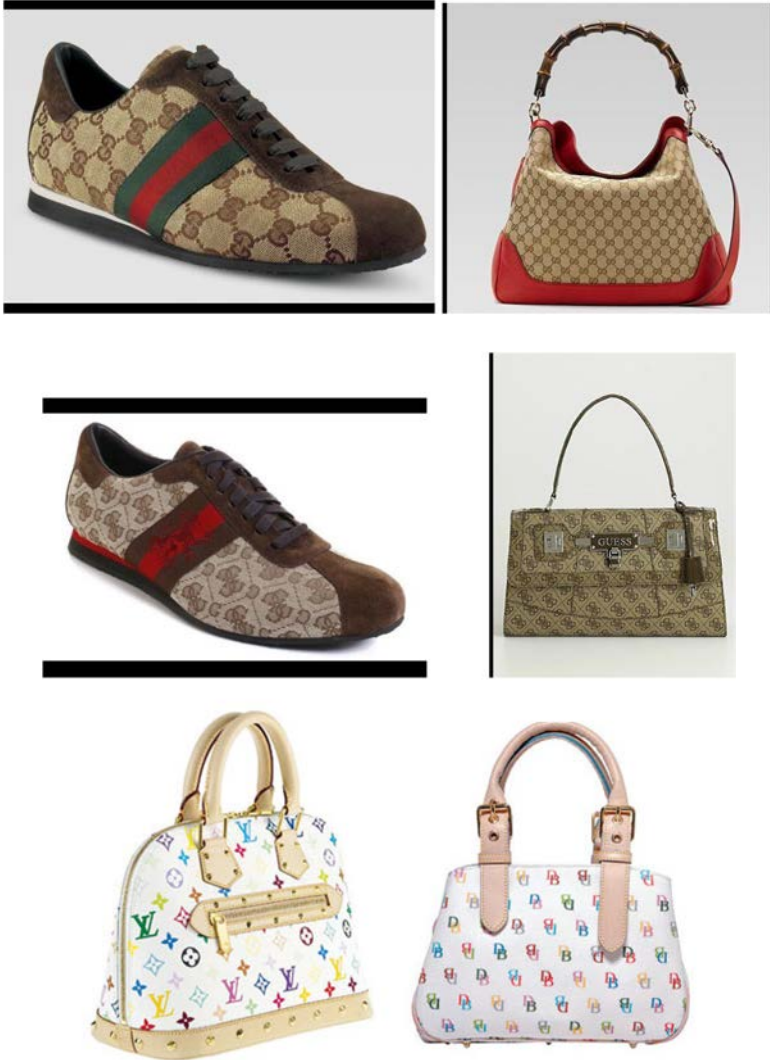
As a trade mark matter, were Gucci or Balenciaga to have unilaterally done to its products what they collaborated to do, they might each be screaming trade mark infringement at the other. The same goes for Fendi and Versace. Yet fashion companies, including Gucci, have sued others for trade mark infringement for

³⁹ "Fendace: The Fendi by Versace Collection", *Versace* <<https://www.versace.com/us/en-us/world-of-versace/stories/advertising-campaigns/fendace.html>> [Versace].

⁴⁰ "FENDACE: Fendi by Versace", *BagAddicts Anonymous* <<https://www.bagaddictsanonymous.com/bags/fendace-fendi-by-versace>> (4 October 2021).

⁴¹ Joshua Espinoza, "Fendi and Versace Drop Much-Anticipated Fendace Collection", *Complex* <<https://www.complex.com/style/fendi-versace-fendace-collection-collection>> (12 May 2022).

incorporating what they believed were their protected marks into their signature products. Examples include Gucci asserting that fashion company Guess improperly used its green and red stripe and interlocking G’s on Guess products, a case it principally won in the US in 2012.⁴² Similarly, Louis Vuitton brought an infringement suit against fashion company Dooney & Burke for using a design that it alleged was too confusingly similar to its colorful Murakami monogram, a claim it ultimately lost.⁴³ In that sense, these competitor collaborations are unconventional for condoning what trade mark owners might otherwise characterise as infringement.



⁴² *Gucci Am, Inc v Guess?, Inc* 868 F Supp 2d 207 (SDNY, 2012).
⁴³ *Louis Vuitton Malletier v Dooney & Bourke, Inc* 454 F 3d 108 (2nd Cir, 2006); Evan Clark, “Dooney & Burke Wins Ruling in Bag Battle with Louis Vuitton”, *WWD* <<https://wwd.com/business-news/legal/dooney-bourke-wins-ruling-in-bag-battle-with-louis-vuitton-1555059>> (4 June 2008).

The competitor companies that have done these once-unlikely collaborations have sought to explain their goals. Gucci described its Hacker Project with Balenciaga as such: “Exploring ideas of authenticity and appropriation, Gucci and Balenciaga motifs merge to create new interpretations of signature pieces.”⁴⁴ Versace proffered the Fendace collection as “an exchange of roles and brand codes rather than a collaboration, with designers Kim Jones and Silvia Venturini Fendi bringing their perspective to Versace, and Donatella Versace recasting Fendi through her vision, creating in turn two collections: Fendi by Versace and Versace by Fendi”.⁴⁵

Critics have found these collaborations to be intriguing and unusual. *HighSnobiety* viewed the Gucci-Balenciaga collaboration as “a nod to counterfeit culture, as well as branding and logomania”.⁴⁶ Sotheby’s described this collaboration as “a shining example of the innovation that can emerge when two luxury fashion houses unite in a modern day love affair”.⁴⁷ It continued: “This hybrid universe is seemingly simple but actually complex, forcing consumers to confront their expectations of branding, collaboration, and design ownership, all at once.”⁴⁸ Relatedly, *HighSnobiety* noted of the Gucci-Balenciaga collaboration that “[l]ooking at the collection almost feels wrong. We’re so used to associating a signature silhouette with a recognizable monogram, so when the two get mixed up, so do our brains.”⁴⁹ Similarly, *Vogue* described the Fendace collection as “a dazzling amalgamation of some of fashion’s most iconic brand codes, reimagining classic silhouettes from both houses”.⁵⁰ *The New York Times* noted the unusual nature of a collaboration like Fendace: “It’s when two brands in the same fashion bracket decide that, rather than competing with each other, they’re going to start playing with each other. On purpose and with permission.”⁵¹ It also observed that this collaboration was “mutual appreciation and marketing”, even though such collaborations have the potential to “[create] a chimera so new it could potentially become myth”.⁵² *HighSnobiety* was less generous, calling these collaborations “the cheap trick of luxury collaborating with itself”.⁵³

British Vogue fashion critic Anders Christian Madsen expressed his expectation that the Gucci-Balenciaga collaboration would be the “most bullet-proof merchandise of the social media-driven fashion era”.⁵⁴ Indeed, the collection

⁴⁴ Kagan, *supra* note 31.

⁴⁵ Versace, *supra* note 39.

⁴⁶ Tora Northman, “Gucci & Balenciaga’s Hacker Project Is Here”, *HighSnobiety* <<https://www.highsnobiety.com/p/gucci-balenciaga-hacker-project-bags>> (12 November 2021) [Northman].

⁴⁷ Kagan, *supra* note 31.

⁴⁸ *Ibid.*

⁴⁹ Northman, *supra* note 46.

⁵⁰ Henrik Lischke, “Fendace Is Here: Get a First Glimpse of 2022’s Most Anticipated Designer Drop”, *Vogue* <<https://www.vogue.com/article/fendace>> (12 May 2022).

⁵¹ Vanessa Friedman, “A First in the History of Fashion”, *The New York Times* <<https://www.nytimes.com/2021/09/27/style/milan-fashion-week-fendi-versace-fendace.html>> (27 September 2021).

⁵² *Ibid.*

⁵³ Christopher Morency, “The Cheap Trick of Luxury Collaborating with Itself”, *HighSnobiety* <<https://www.highsnobiety.com/p/fendace-fendi-versace-cheap-trick-luxury-collaborations>> (27 September 2021).

⁵⁴ Alice Cary, “Gucci’s ‘Hacking’ of Balenciaga Is a Fashion Power Move—and Finally Available To Shop”, *Vogue* <<https://www.vogue.com/article/balenciaga-gucci-collaboration>>.

sold out quickly,⁵⁵ emphasising the consumer demand for this mashup. The Fendace collaboration has been reported to be similarly successful.⁵⁶

These collaborations between Gucci and Balenciaga and between Fendi and Versace are prominent examples of the new trend of once off-the-limits, unheard-of collaborations between direct competitors in ways that splice together each other's marks.

B. *The Reality of Unlikely Category Collaborations*

In addition to collaborations between competitors, businesses in distant spaces are increasingly collaborating to create new offerings that merge each of their signature elements.

Recent examples abound. In 2021, Adidas and Lego collaborated to offer up numerous products, including a sneaker customisable with Lego bricks.⁵⁷ Luxury fashion brand Dolce & Gabbana teamed up with appliance maker Smeg to – according to the two businesses – “tell the story of Sicily, a story essential to the aesthetic and soul of Dolce & Gabbana ... [and] also tell the story of Sicilian cuisine, and, by extension, the cuisine of Italy itself, as interpreted by SMEG through its long experience in appliances and kitchen design”.⁵⁸ The collaboration resulted in Dolce & Gabbana's signature colourful prints on Smeg appliances.⁵⁹ Home goods company IKEA collaborated with fashion company Off-White to “add an artful quality to anonymous objects”, as explained by Off-White designer Virgil Abloh.⁶⁰ This collection includes a rug with the characteristically Off-White whimsical print of an IKEA receipt and a reimaged IKEA bag marked as “SCULPTURE”.⁶¹ Gucci and Xbox also collaborated to release a game console covered in the Gucci monogram and modified controllers bearing a Gucci-like series of stripes.⁶²

⁵⁵ Stella Hughes, “Gucciaga Dropped, Sold Out & Landed on eBay in Hours”, *Culted* <<https://culted.com/gucciaga-dropped-sold-out-landed-on-ebay-in-hours>> (16 November 2021); See also Kagan, *supra* note 31.

⁵⁶ “Fendace Reaches the Second Chapter of the Versace by Fendi – Fendi by Versace Collection”, *The Blonde Salad* <<https://theblondesalad.com/en/fashion/fendace-reaches-the-second-chapter-of-the-versace-by-fendi-fendi-by-versace-collection/>> (28 April 2022).

⁵⁷ Jovani Hernandez, “You Can Now Customize Your Adidas UltraBOOST with LEGO Bricks”, *Sneaker News* <<https://sneakernews.com/2021/04/01/lego-adidas-ultraboost-white-shock-blue-fy7690/>> (1 April 2021).

⁵⁸ “Smeg and Dolce&Gabbana”, *Smeg* <<https://www.smeg.com/us/special-products/sicily-is-my-love>>.

⁵⁹ *Ibid.*

⁶⁰ “MARKERAD Limited Collection”, *IKEA* <<https://www.ikea.com/es/en/new/markerad-limited-collection-pub039b6a31>>.

⁶¹ *Ibid.*

⁶² Maria Bobila, “Xbox's Series X Console Just Got Guccified”, *Nylon* <<https://www.nylon.com/fashion/how-to-buy-gucci-xbox-series-x-console-bundle>> (12 November 2021).



Some of these collaborations are truly bizarre, indicating that any two brands in the most distant categories imaginable might truly collaborate. Processed cheese company Velveeta has collaborated with beauty brand Nails.INC to make a cheese-scented nail polish.⁶³ Meat company Oscar Mayer has partnered with skincare company Seoul Mamas to make bologna-inspired face masks.⁶⁴



Unlikely category collaborations are also flourishing between businesses belonging to the same broader industry, but which occupy distinct subcategories. This is particularly apparent in fashion. For example, luxury fashion company Fendi partnered with Kim Kardashian’s shapewear company Skims to produce Fendi-branded

⁶³ Jelisa Castrodale, “Velveeta Just Dropped a Cheese-Scented Nail Polish”, *Food & Wine* <<https://www.foodandwine.com/news/velveeta-nail-polish-cheese-scented-nails-inc>> (7 June 2022).

⁶⁴ Amy McCarthy, “My Bologna Has a Face Mask”, *Eater* <<https://www.eater.com/2022/1/26/22901509/oscar-mayer-bologna-face-mask-review>> (26 January 2022).

shapewear and related clothing items.⁶⁵ Luxury fashion company Gucci collaborated with outdoor apparel company North Face to produce a luxury outdoor fashion collection.⁶⁶ Luxury fashion company Louis Vuitton teamed up with streetwear fashion company Supreme to produce clothing and handbags with both of their signature elements.⁶⁷



While some have scratched their heads upon seeing some of these unlikely category collaborations, others are struck by their potential. For instance, *Style Democracy* analyses such collaborations as “generat[ing] hype, offer[ing] access to a new customer, and often inject[ing] a dose of creativity and uniqueness into the expected. Sometimes the best and most buzzed-about collaborations are the ones that are the most unusual or seemingly unrelated.”⁶⁸ For example, it saw the Dolce & Gabbana-Smeg partnership as “a unique collection of small appliances that pretty much double as art”.⁶⁹ These collaborations can be very profitable. The Fendi-Skims

⁶⁵ Tora Northman, “Fendi + Skims = True”, *HighSnobiety* <<https://www.highsnobiety.com/p/fendi-skims>> (25 October 2021).

⁶⁶ “The North Face x Gucci”, *North Face* <<https://www.thenorthface.com/en-us/featured/gucci>>.

⁶⁷ Jonathan Sawyer, “Here’s Every Piece from the Supreme x Louis Vuitton Collection”, *HighSnobiety* <<https://www.highsnobiety.com/p/supreme-louis-vuitton-every-piece>> (29 June 2017).

⁶⁸ Erin Davis, “15 Unusual Brand Collabs That Somehow Worked”, *Style Democracy* <<https://www.style-democracy.com/unusual-brand-collabs-that-somehow-worked>> (9 December 2020).

⁶⁹ *Ibid.*

collaboration earned US\$1m within a minute of its launch.⁷⁰ With multiple collaborations, a business (like Nike, which seems to engage in an endless series of collaborations with other businesses) also has a way to reach multiple subcultures with which it might not otherwise connect.⁷¹

These increasing numbers of unusual category collaborations are an odd fit within the conventional story of trade mark law. In particular, as Mark Lemley and Sari Mazzurco describe, third parties have long customised branded products that they have lawfully purchased.⁷² Trade mark law's first sale doctrine (permitting resale of branded items in many circumstances) and the law's requirement of trade mark use (that marks be used as marks for there to be trade mark infringement) might insulate at least some of these instances of customisation from infringement liability.⁷³ Even so, many trade mark owners pursue such customisations as infringement. Many of them seem like close cousins of the unlikely category collaborations just discussed. For example, Sony recently stopped McDonald's from giving away PlayStation 5 controllers the fast-food company had customised with its branding.⁷⁴ Similarly, Nike is currently pursuing trade mark infringement claims against aftermarket customisers of its sneakers, including for putting branding from snack company Cheetos, fashion company Burberry, and internet commerce megabusiness Amazon on its swoosh and elsewhere on its sneaker.⁷⁵



⁷⁰ Emma Levin, "Ten Unexpected Brand Collaborations That Made Us Say 'What? Yes!'", *Luupe* <<https://theluupe.com/blog/ten-unexpected-brand-collaborations-that-made-us-say-what-yes>> (25 October 2022).

⁷¹ *Ibid.*

⁷² Mark A Lemley & Sari Mazzurco, "The Exclusive Right to Customize?" 103 *BUL Rev* (forthcoming, 2023) [Lemley & Mazzurco].

⁷³ *Ibid.*

⁷⁴ Luke Plunkett, "Sony Stops McDonalds from Giving Away PS5 Controllers", *Kotaku* <<https://kotaku.com/sony-stops-mcdonalds-from-releasing-ps5-controllers-1847410890>> (2 August 2021).

⁷⁵ *Nike, Inc v Customs by Ilene, Inc* 5:21-cv-01201 (CD Cal); *Nike, Inc v Jeffrey Waskowiak & Kickrich, LLC* 3:21-cv-01068 (D Or).



As typified by the foregoing examples, the second growing trend of trade mark ownfringement has businesses in distant product spaces – including almost unimaginable combinations – collaborating with one another.

C. Self-Parody

A third way in which trade mark owners are increasingly deviating from conventional trade mark ownership and use and acting more like infringers is by engaging in self-parody.

For example, in 2017, Gucci opted to release a collection with its name misspelled as “Gucci”. The misspelling appeared emblazoned on sweatshirts that cost over US\$1,000, in pearls on Gucci outfits, and elsewhere in that line.⁷⁶

⁷⁶ J’net Nguyen, “Fake Gucci to Real Gucci: Fashion’s Identity Crisis or Alter Ego?”, *Right Brain Studio* <<https://www.therightbrainstudio.com/fake-gucci-real-gucci-fashions-identity-crisis-alter-ego>> (8 February 2018); Liana Satenstein, “Would You Buy Fake Designer Clothes? How Some Labels Are Changing the Bootleg Stigma”, *Vogue* <<https://www.vogue.com/article/rise-of-bootleg-fashion-at-gucci-and-vetements>> (6 June 2017).

One commentator explained the spelling choice as “an ironic jab at the momentous presence of knock-offs that are sold in droves – both from physical retailers and online – around the world. This particular spelling of the name was incredibly popular with counterfeit retailers in the 1980s (along with ‘Channel’ and ‘Dolce & Gabbaba’).”⁷⁷ Indeed, it perhaps most directly pokes fun at *shanzai* (山寨), which emerged in the past few decades in China, starting with cell phones like “Samsing” phones instead of Samsung phones but growing to cover goods like Ferrari-branded athletic shoes, other fashion items, and even hotels.⁷⁸ Indeed, many of the potential infringements of Starbucks’ trade marks mentioned above are arguably *shanzai*.⁷⁹ *Shanzai* has been understood as a class-based movement as much as anything else, representing a grassroots challenge to the elite.⁸⁰



A few months later after Gucci’s self-parody, tongue placed firmly in cheek, clothing company Diesel similarly opened an “official knockoff” pop-up store in New York City on Canal Street, a location notorious for selling fashion knockoffs.⁸¹ There, for a short time, Diesel sold merchandise misspelled as “Deisel”.⁸² Diesel’s founder commented, “We were intrigued by the logo-mania trend and the world of counterfeit culture. So we engaged in this in our way: playful and ironic at the same time.”⁸³

⁷⁷ Emma Portelli Bonnici, “Putting the ‘Y’ in Gucci”, *Times of Malta* <<https://timesofmalta.com/articles/view/putting-the-y-in-gucci.695003>> (24 November 2018).

⁷⁸ See generally Barton Beebe, “Shanzai, Sumptuary Law, and Intellectual Property Law in Contemporary China” (2014) 47 UC Davis L Rev 849 [Beebe, “Shanzai”].

⁷⁹ See text accompanying note 24.

⁸⁰ Beebe, “Shanzai”, *supra* note 78.

⁸¹ Emilia Petrarca, “Diesel Is Opening Its Own Knockoff Pop-Up on Canal Street”, *Cut* <<https://www.thecut.com/2018/02/diesel-knockoff-collection-canal-street.html>> (8 February 2018).

⁸² *Ibid.*

⁸³ *Ibid.*



In another example, Nike has released sneakers with a misplaced swoosh.⁸⁴ Consumers noted the resemblance to John Geiger’s successful “Misplaced Checks” shoes, wherein he customised Nike sneakers as a commentary and pun on his ideas being dismissed by big companies like Nike.⁸⁵



Like competitor collaboration and unlikely category collaborations, these self-parodies do not fit comfortably within the conventional story of trade mark use. Trade mark owners do not generally – or at least purposely – misspell their own marks or misplace their logos.⁸⁶ Indeed, they are more likely to pursue third parties by claiming that their arguable parodies constitute trade mark infringement. Nike recently sued art collective MSCHF for customising Nike sneakers as Satan shoes, which purportedly had employees’ blood injected into the air bubble of the sneakers and featured satanic references.⁸⁷ Nike settled with MSCHF after MSCHF claimed

⁸⁴ Eric Brain, “Nike’s Air Force 1 ‘Misplaced Swoosh’ Isn’t for Perfectionists”, *Hypebeast* <<https://hypebeast.com/2020/10/nike-air-force-one-low-lv8-misplaced-swoosh-white-premium-leather-ck7214-100>> (28 October 2020).

⁸⁵ See, *eg*, *ibid*.

⁸⁶ Cf Mark A Lemley & Mark P McKenna, “Trademark Spaces and Trademark Law’s Secret Step Zero” (2023) 75 *Stan L Rev* 1 (describing how trade mark owners expand or change the spaces in which they place their marks).

⁸⁷ Neil Vigdor, “Company Will Offer Refunds to Buyers of ‘Satan Shoes’ to Settle Lawsuit by Nike”, *The New York Times* <<https://www.nytimes.com/2021/04/08/style/satan-shoe-settlement-nike.html>> (8 April 2021).

parody, which MSCHF’s lawyer David Bernstein explained: “With these Satan Shoes—which sold out in less than a minute—MSCHF intended to comment on the absurdity of the collaboration culture practiced by some brands, and about the perniciousness of intolerance.”⁸⁸ Similarly, shoe company Vans has sued MSCHF for trade mark infringement of its Old Skool sneakers with MSCHF’s cartoonish Wavy Baby shoes.⁸⁹ Here too, Bernstein has claimed that the Wavy Baby sneakers are a parody of consumerism and sneaker culture, whereas Vans has maintained by contrast that consumers would be confused and MSCHF’s shoes constitute trade mark infringement.⁹⁰ Moreover, Gucci has gone after a Japan-based artist who released shirts bearing the word “CUGGL” – which ordinarily looks nothing like “GUCCI” – but with the bottom half of the name covered in pink paint, so that the shirt might appear to depict “GUCCI”.⁹¹



⁸⁸ *Ibid.*
⁸⁹ Blake Brittain, “Vans, MSCHF Counsel Spar in Wavy Baby Trademark Case”, *Reuters* <<https://www.reuters.com/legal/litigation/vans-mschf-counsel-spar-wavy-baby-trademark-case-2022-09-28>> (29 September 2022).
⁹⁰ *Ibid.*
⁹¹ Elizabeth Segran, “Is That Shirt a Gucci ... or a Cuggl?”, *Fast Company* <<https://www.fastcompany.com/90781660/is-that-shirt-a-gucci-or-a-cuggl>> (24 August 2022).

These three trends of competitor collaborations, distant category collaborations, and self-parody typify the rise of trade mark ownfringement – of trade mark owners acting like conventional infringers. I now turn to consider what ownfringement might mean for trade mark law.

IV. CONSEQUENCES FOR TRADE MARK LAW

One reaction to these new uses, reuses, and combinations of marks by trade mark owners is that this is merely par for the course for them as rightsholders. Perhaps by definition, trade mark holders can freely and without consequence act like first-party infringers. That is, they can feel free to engage in the same behaviour that would provoke them to pursue a colourable claim against a third party for infringement. This is so because a trade mark owner holds the right to use its mark in commerce to signify the source of its goods and services. And because an owner's right is exclusive, the owner can invoke the law to prevent a third party from doing so instead. From this perspective, the notion of trade mark ownfringement, about which I have been going on and on, is meaningless. One can own trade mark rights or infringe them, but not both simultaneously.

Yet even if the foregoing analysis is correct, trade mark ownfringement in the ways I have been conveying is worthy of further analysis. Why? Because trade mark owners are potentially altering the balance or calculus of a number of fundamental aspects of trade mark doctrine by behaving as ownfringers. I explore three potentially important doctrinal impacts of ownfringement: on likelihood of consumer confusion, on trade mark distinctiveness and self-dilution, and on the parody defence.

A. *Likelihood of Consumer Confusion*

Consider likelihood of consumer confusion. US courts have developed a doctrine that states that the likelihood of confusion with a plaintiff's trade mark – the lynchpin of whether a defendant's use of a mark infringes the plaintiff's rights⁹² – turns on a series of factors. Different circuits vary somewhat in assessing the likelihood of confusion, yet the Second Circuit's test is characteristic. Its multifactor test looks to "(1) the strength of the mark; (2) the degree of similarity between the two marks; (3) the proximity of the products; (4) the likelihood that the prior owner will 'bridge the gap' ... ; (5) actual confusion; (6) the defendant's good faith in adopting its mark; (7) the quality of the defendant's product; and (8) the sophistication of the buyers."⁹³

A number of these subfactors are relevant to the phenomenon of ownfringement, but perhaps most obviously germane are actual confusion and buyer sophistication. Scholars have consistently noted the circularity at the base of consumer confusion.

⁹² *Savin Corp v Savin Group* 391 F 3d 439 at 456 (2nd Cir, 2004).

⁹³ *Time, Inc v Petersen Publishing Co LLC* 173 F 3d 113 at 117 (2nd Cir, 1999) (quoting *Arrow Fastener Co v Stanley Works* 59 F 3d 384 at 391 (2nd Cir, 1995)).

For example, as Stacey Dogan and Mark Lemley observe, “Whether a particular use confuses consumers depends, in part, on the legal baselines that trademark law sets.”⁹⁴ Taking the extreme example of placing generic colas side by side in the supermarket with Coca-Cola, they say that many would permit that because it does not provoke consumer confusion.⁹⁵ But that very well might be only because the law allows it. By contrast, were trade mark law to forbid this side-by-side placement as infringement, any subsequent placement of generic cola side by side with Coca-Cola would be more likely to cause consumer confusion. Dogan and Lemley explain: “This [prohibition] would mean that consumers would not be used to seeing all the colas grouped together and would make it harder for anyone else to make such a use because, over time, the placement of generic cola beside Coke would be more surprising to consumers. And if no one else is putting generic colas next to Coke, it is an easy mental step to conclude that a grocer that does so is free riding on Coke’s interest in being insulated from nearby competitors, particularly if the grocer is making money directly or indirectly from the placement or sales of generic colas.”⁹⁶

Applying this insight about how trade mark law’s conclusions as to confusion affects actual consumer confusion and how actual consumer confusion affects the law’s conclusions as to confusion – ad infinitum – to ownfringement, it is straightforward to see that if owners can engage in the newer sorts of behaviour previously discussed and also successfully prevent third parties from engaging in similar behaviour, consumers are more likely to become confused as to source whenever a third party engages in such behaviour. On the flip side, if owners and third parties can both engage in this sort of behaviour, consumers are less likely to become confused as to source whenever a third party engages in this behaviour. Rather, consumers might become more sophisticated at discerning source in such a scenario.

So far, so straightforward. Mostly. Yet the newer part of the story here is trade mark owners’ contribution to likelihood of confusion. Conventionally, trade mark owners try to diminish consumer confusion, or at the very least, not provoke it. Yet with ownfringement, trade mark owners are themselves contributing to consumer confusion by commingling legal marks with competitors’ marks or in other unlikely contexts and by engaging in self-parody. What is a consumer to think when they see Gucci’s G-logo or red-and-green stripe on a bag it thinks to be from Balenciaga? Or Gucci’s logo on an Xbox game console? Or “Gucci” misspelled as “Guccy”? It becomes much harder to know now which is the genuine source of a particular mark and whether there in fact is one.

What then to make of a consumer’s likelihood of confusion in these contexts? Are consumers more likely to be confused than ever before given these increasing instances of ownfringement? Or less likely to be confused as they become acculturated to trade mark owners’ behaviour? Or given that trade mark owners

⁹⁴ Stacey L Dogan & Mark A Lemley, “Grounding Trademark Law Through Trademark Use” (2007) 92 Iowa L Rev 1669 at 1693 [Dogan & Lemley]; accord James Gibson, “Risk Aversion and Rights Accretion in Intellectual Property Law” (2007) 116 Yale LJ 882 at 907–927; Mark A Lemley & Mark P McKenna, “Irrelevant Confusion” (2010) 62 Stan L Rev 413 at 451 n 150.

⁹⁵ Dogan & Lemley, *supra* note 94 at 1694–1695.

⁹⁶ *Ibid* at 1695.

themselves are contributing to confusion as to mark source, perhaps they should have a harder path than previously to proving likelihood of confusion? Given the circularity endemic to likelihood-of-confusion analysis, trade mark law's answers to these questions will in turn affect actual consumer confusion and consumer sophistication in distinguishing source. Courts and the law will have to be sensitive when assessing likelihood of confusion in these instances, as ownfringement is on the rise precisely because of the runaway circular effect on subsequent likelihood of confusion engendered by legal determinations. The multifactor likelihood-of-confusion test in the US may be flexible enough to address these new scenarios, but in Singapore, the application of a more rigid approach to trade mark infringement may cause significant difficulties in properly and fairly analysing the unusual factual circumstances.⁹⁷

Recognising these features of likelihood-of-confusion analysis might explain why businesses are arguably policing further beyond the bounds than ever before, such as Nike's pursuit of after-market customisers, as Mark Lemley and Sari Mazzurco explore in their work analysing whether trade mark owners have an exclusive right to customisation.⁹⁸ Successful claims in this context would provide trade mark owners with broader scope to their rights and greater leeway to pursue third parties (such as *shanzai*) successfully. Successful claims also would further increase the proper-tisation of trade marks that has been underway for some time now.⁹⁹ Trade mark claims being made in this context further underscore how trade mark law might be well-served to deploy a normative stance and deem some trade mark owners' activities irrelevant to a finding of trade mark infringement even if consumers are indeed confused, as a way to disallow trade mark owners from expanding their scope of protection merely by venturing into unlikely spaces.¹⁰⁰

Furthermore, the phenomenon of ownfringement might indicate that trade mark owners' interests in deploying their marks might no longer principally focus on diminishing consumer search costs, as the conventional tale of trade mark law assumes. That is, trade mark owners might instead think they benefit by increasing consumer search costs through competitor collaborations, unlikely category collaborations, and self-parody.

The rise of trade mark ownfringement therefore permeates how likelihood of consumer confusion is and ought to be analysed.

B. *Distinctiveness and Self-Dilution*

Ownfringement additionally might have important consequences for how trade mark law should think about distinctiveness and dilution.

⁹⁷ David Tan & Benjamin Foo, "The Extraneous Factors Rule in Trademark Infringement: Avoiding Confusion or Simply Confusing?" (2016) Sing JLS 118 (comparing the US multifactor test with Singapore's approach).

⁹⁸ Lemley & Mazzurco, *supra* note 72.

⁹⁹ See, *eg*, Peter J Karol, "The Constitutional Limitation on Trademark Propertization" (2015) 17 U Pa J Const L 1065.

¹⁰⁰ See Graeme B Dinwoodie, "Trademark Law as a Normative Project" (2023) Sing JLS 314.

Consider first distinctiveness. Trade mark law's distinctiveness requirement is situated in the Lanham Act's rule that a mark "identify and distinguish [a business's] goods ... from those manufactured or sold by others and ... indicate the source of the goods".¹⁰¹ As Barton Beebe explains, "a trademark is distinctive of source if it is recognized by consumers as a designation of the source of the product to which it is affixed rather than as, say, a decoration on or a description of that product".¹⁰² A mark can be inherently distinctive if it is arbitrary, fanciful, or suggestive of – that is, not too conceptually associated to – the category of goods or services with which it is associated.¹⁰³ Or it can acquire distinctiveness if it is descriptive of its associated goods or services and consumers sufficiently associate the mark with a single source of goods or services.¹⁰⁴ Moreover, a mark that is generic as to its category of goods or services is not at all protectable.¹⁰⁵ Protectability turns on distinctiveness for a cluster of connected reasons. First, consumers would never be likely to be confused as to source – trade mark's central inquiry for infringement – unless they recognise a particular designation as source-indicating in the first place.¹⁰⁶ Relatedly, consumers can reduce their search costs of associating goods or services with a particular source only if they know that the term or symbol associated with them is a source designator.¹⁰⁷ Moreover, from a business's perspective, if consumers know to associate a term or symbol with the business as the source of goods or services, it will be encouraged to invest in the quality of its goods or services, an important goal of trade mark law.¹⁰⁸ In addition to the benefits of establishing distinctiveness, there is a cost to granting trade mark rights for marks that are not distinctive. The principal worry is that conferring trade mark rights in such a situation would inefficiently or unfairly prevent other businesses from using terms or symbols as they compete that fail to distinguish source.¹⁰⁹

Trade mark law already appreciates that distinctiveness is not static in a variety of ways. Perhaps most prominently, marks that do not start out generic can become generic over time based on language evolution and changing consumer understanding,

¹⁰¹ Lanham Act, *supra* note 1 at § 1127.

¹⁰² Barton Beebe, "Search and Persuasion in Trademark Law" (2005) 103(8) Mich L Rev 2020 at 2028–2029 [Beebe, "Search and Persuasion"]; accord Mark P McKenna, "Teaching Trademark Theory Through the Lens of Distinctiveness" (2008) 52 Saint Louis ULJ 843 at 847 [McKenna, "Teaching Trademark Theory"] ("Distinctiveness ... refers to the extent to which a claimed designation conveys to consumers information about the source of products or services as opposed to merely conveying product-related information."). There are yet more refined understandings of distinctiveness than trade mark law incorporates. See Beebe, "Search and Persuasion", *supra* note 102 at 2028 (distinguishing "source distinctiveness, which a trademark must possess to fall within the subject matter of trademark protection", and "differential distinctiveness, the extent of which prescribes the scope of trademark protection when protection is given").

¹⁰³ See Jeanne C Fromer, "Against Secondary Meaning" (2022) 98 Notre Dame L Rev 211 (describing and critiquing these rules) [Fromer].

¹⁰⁴ See *ibid* (describing and critiquing these rules).

¹⁰⁵ *Ibid*.

¹⁰⁶ Graeme B Dinwoodie, "Reconceptualizing the Inherent Distinctiveness of Product Design Trade Dress" (1997) 75(2) NCL Rev at 483.

¹⁰⁷ McKenna, "Teaching Trademark Theory", *supra* note 102 at 850.

¹⁰⁸ *Ibid* at 851.

¹⁰⁹ Landes & Posner, "Economics of Trademark Law", *supra* note 16 at 288.

as with “ESCALATOR”, “ZIPPER”, “GRANOLA”, and “TRAMPOLINE”.¹¹⁰ These marks were once distinctive but have lost that distinctiveness and thus also their trade mark protection through genericide.¹¹¹ In addition, trade mark infringement – with the multifactor likelihood-of-confusion test – depends in part on mark strength, which turns on the mark’s distinctiveness and strength of secondary meaning at the time of suit, rather than merely at the time it is first protected.¹¹²

The trade mark ownfringement discussed here shows another way that distinctiveness might not be static, as businesses might be diminishing their marks’ distinctiveness over time through their mashups and self-parody. It might therefore be important for trade mark law to recognise that marks can lose protection or have it diminished through trade mark ownfringement, just as with genericide. In many ways, ownfringement is a somewhat paler variation of naked licensing in trade mark law. Naked licensing occurs when a trade mark owner “grant[s] permission to use its mark without attendant provisions to protect the quality of the goods or services provided under the licensed mark”.¹¹³ When a trade mark owner engages in naked licensing of its mark, the owner is found to have abandoned its rights in the mark, as such rights are not in gross.¹¹⁴ Even if ownfringement is more thought through – as to which collaborations and self-parody make sense and enhance the business and perhaps even the brand – significant ownfringement might similarly diminish, even if it does not extinguish, an owner’s rights in its mark.

Indeed, marketing experts note that some instances of ownfringement – particularly competitor collaborations – can self-dilute a brand’s distinctiveness. For example, one report notes that “brands can have a collision of styles and may lose their identities”.¹¹⁵ An expert further observes, “It is important to choose the right partner and modality to prevent diluting your brand image.”¹¹⁶ In this regard, experts see cross-category collaborations as more sustainable than those between competitors.¹¹⁷

As such, trade mark law must also be sensitive to how ownfringement affects the dilution doctrine. There may be salient effects here, as the businesses that tend to engage in ownfringement tend to have particularly famous marks. To the extent that they are self-diluting their marks through extensive and unusual collaborations and self-parody, it might be sensible to estop or otherwise bar them from making successful claims to trade mark dilution.

Indeed, the phenomenon of ownfringement exposes an until-now unexplored ambiguity in the theory underpinning harms from trade mark dilution. One view might be that dilution is the dilution of the uniqueness – the singularity – of the

¹¹⁰ Jorge L Contreras, “Sui-Genericide” (2021) 106 Iowa L Rev 1041; Laura A Heymann, “Trademarks in Conversation: Assessing Genericism After Booking.com” (2021) 39 Cardozo Arts & Ent LJ 955; John Dwight Ingram, “The Genericide of Trademarks” (2004) 2 Buff Intell Pro LJ 154.

¹¹¹ Fromer, *supra* note 103.

¹¹² *Ibid.*

¹¹³ *Exxon Corp v Oxford Clothes, Inc* 109 F 3d 1070 at 1075 (5th Cir, 1997).

¹¹⁴ *Ibid.*

¹¹⁵ Lisa Nan, “Will Chinese Gen Z Buy Gucciaga & Fendace?”, *Jing Daily* <<https://jingdaily.com/gucciaga-fendace-collaborations-china-gen-z/>> (24 October 2021).

¹¹⁶ *Ibid.*

¹¹⁷ *Ibid.*

mark as against the noise of the marketplace.¹¹⁸ From that vantage point, there ought to be little legal consequence to any self-dilution done through trade mark ownfringement. On the other hand, dilution might be better (or additionally) viewed as blurring the link between a famous mark and its source. Seen through that lens, even though an owner of a famous mark can in theory place its mark on every single imaginable good or service, it typically does not, even if Virgin comes close with its Virgin-branded airline, gyms, hot-air balloons, hotels, media channels, sports, banking, and more.¹¹⁹ In that sense, the dilution cause of action seems to be more about preserving a mark as a so-called “limited edition” than as truly providing positive rights to the mark in all classes of goods and services to a famous mark holder. From this vantage point, self-dilution by occupying too many classes of goods or services or combining one’s mark with too many other sources of goods and services seems to undermine the thrust of any dilution claim a mark owner might bring. That is, trade mark ownfringement would undermine the viability of a dilution claim.

In these ways, ownfringement can have important consequences for trade mark distinctiveness and dilution.

C. Parody Defence

Finally, trade mark ownfringement might affect the viability of a third party’s parody defence to trade mark infringement or dilution. Recall that US courts struggle with both how successful a parody must be and how much consumer confusion is tolerable for a parody defence to succeed.¹²⁰ As the US Supreme Court has taken up *Jack Daniel’s Properties, Inc v VIP Products LLC*¹²¹ – a case in which whiskey maker Jack Daniel’s sued the maker of the Bad Spaniels Silly Squeaker dog toy for trade mark infringement – the law needs to confront these thorny issues. Until now, many courts have used a test that is more protective of artistic uses or parodies than the multifactor likelihood-of-confusion test would be. Prominently, the Second Circuit has held that trade mark infringement will not be found “unless the [use] has no artistic relevance to the underlying work whatsoever, or if it has some artistic relevance, unless [the use] explicitly misleads as to the source or content of the work”.¹²² In *Jack Daniel’s*, the Supreme Court considered whether the proper infringement standard for parodies is akin to the more speech-protective approach of the Second Circuit, popularly known as the *Rogers* artistic relevance test, or the usual multifactor test for likelihood of confusion. In this regard, it is further worth ruminating on the degree to which self-parody affects the viability of defendants’ parody defences.

¹¹⁸ See Schechter, *supra* note 8.

¹¹⁹ “Virgin Group”, *Wikipedia* <https://en.wikipedia.org/wiki/Virgin_Group> (21 April 2003).

¹²⁰ See text accompanying notes 25–28.

¹²¹ 143 S Ct 1578 (2023) [*Jack Daniel’s*].

¹²² *Rogers v Grimaldi* 875 F 2d 994 at 999 (2nd Cir, 1989).



Specifically worth considering is how trade marks are so much a part of our cultural discourse, as Rochelle Dreyfuss cogently observed decades ago. For quite a while now, society and third-party businesses cannot do without using marks as commentary in many contexts. But now trade mark owners cannot resist making commentary using their own marks too. As such, perhaps they ought to be estopped into accepting third-party parody more readily. This might be particularly true if mark owners themselves are engendering greater consumer confusion, as just explored.¹²³ More broadly, the calculus of tolerable confusion and successful parody no longer seems stable if mark owners are confusing consumers and engaging in self-parody through trade mark ownfringement. As to trade mark infringement, then, a test that recognises the crucial importance to speech of using trade marks in our conversations – like the Second Circuit’s – is likely better suited to a world with self-parody than the standard likelihood-of-confusion test, with its empirical circularities which can use self-parody to diminish the ability of others to engage in parody.¹²⁴ As to trade mark dilution, a mark owner’s engagement in self-parody conceptually undermines its ability to maintain that others are blurring the distinctiveness of its mark, when it might indeed be doing so on its own. Moreover, the Ninth Circuit is astute in understanding an exception to a dilution claim for “noncommercial use of a mark”¹²⁵ to be placing a speech-protective thumb on the scale for any speech that is not purely commercial (as per US First Amendment law).¹²⁶

While there might be further consequences to trade mark theory and doctrine from trade mark ownfringement, many of its central doctrines – likelihood of consumer confusion, distinctiveness, dilution, and the parody defence – are potentially materially affected by ownfringement.

¹²³ See Part III.A above.

¹²⁴ See Part III.A above.

¹²⁵ Copyright Act 17 USC § 1125(e)(3)(C).

¹²⁶ *Mattel*, *supra* note 21 at 905–907.

V. CONCLUSION

Perhaps the trade mark ownfringement on display here indicates nothing more than businesses running out of new things to say, leaving them to cannibalise one other through recombinations. Perhaps trade mark ownfringement is generating new pathways of creativity, both expressively and economically. Perhaps it is a passing trend, or perhaps it is a harbinger of mark remixing and destruction. Whatever one's vantage point, it asks us to confront and rethink central questions of trade mark doctrine and theory.