1. From ‘Oomoo’ to ‘Oro’: nostalgia labels and cultural policy on the Australian trade marks register*

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I. INTRODUCTION

Trade mark law is often thought of as concerned with trade and commerce. But it is also rooted in history and culture and in some instances reflects deeply embedded cultural conflicts as between different imagined communities. In this chapter we focus on two Australian nostalgia labels that demonstrate the point in an especially poignant way. The first lay at the centre of *In the Matter of Burgoyne’s Trade Mark*,¹ a case decided at the height of the British Empire, where an English judge held that the trade mark ‘Oro’ applied to a wine imported from Thomas Hardy’s vineyard in South Australia might mean ‘choice’ to an Australian Aboriginal (in fact it was already noted in colonial records as denoting ‘good’ to the Dieri people of South Australia) but was ‘meaningless’ to the ‘ordinary Englishman’ in Britain.² So it could be entered as a trade mark on the nascent United Kingdom trade marks register. A little over a century later, a revived ‘Oomoo’ label was registered as a trade mark for Hardy’s wine in

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¹ *Burgoyne’s Trade Mark* (1889) 6 RPC 227 (Ch).

² Ibid 231–2 (Chitty J).

Australia,³ at the same time that a government-sponsored programme for recovering the endangered Dieri language was under way in the place from which the wine was sourced. The principle that a foreign-language expression without ‘ordinary signification’ in Australia can be registered as a trade mark was more recently relied on by the High Court in *Cantarella Bros Pty Ltd v Modena Trading Pty Ltd*⁴ to hold that ‘Oro’, meaning ‘gold’ in Italian and in common use by Italian coffee traders in Australia, was validly registered to Cantarella.⁵ Thus, a standard that became entrenched in Australia during the era of its White Australia policy resolves an issue as to a trade mark entitlement to a symbol widely associated with an Italian tradition of coffee in modern Australia.⁶ We argue that in these examples the legal treatment of labels applied to wine and coffee in Australia replicates the complicated histories of the products. And we question whether the ‘ordinary signification’ of language to some ‘ordinary’ English-speaker should be the measure of a trade mark in a country which prides itself on being both multicultural and respectful of the highly diverse languages and traditions of its Indigenous peoples, proposing instead that the trade mark register should do more than passively reflect the inherited cultural tensions of an earlier period. In short, the rules governing trade mark registration should be treated as part of a thoroughly modern cultural and economic trade mark law policy.

The chapter is arranged as follows. In Sections II and III we trace the roots of the Anglo-Australian inherent distinctiveness standard, arguing that it reflected a cultural policy of (predominantly) English language preservation fashioned in the hands of Victorian judges in Britain, which was then adopted wholesale by Australian judges in post-colonial Australia. In Sections IV and V we consider reforms in other parts of the Anglosphere, including the American doctrine of foreign equivalents and the equal treatment principle applied to Māori in New Zealand – and we conclude that, while introducing reforms modelled on these overseas experiments, for instance adopting a doctrine of foreign equivalents along

³ See Trade Mark 1099230, registered to Hardy’s Winery in 2006 along with the endorsement: ‘The applicant has advised that the translation of the ABORIGINAL word OOMOO appearing in the trade mark is GOOD, NICE, PLEASANT TO THE EYE’.

⁴ *Cantarella Bros Pty Ltd v Modena Trading Pty Ltd* (2014) 254 CLR 337 (HCA).

⁵ The trade mark is still registered. See Trade Mark 829098, registered to Cantarella Bros in 2000.

⁶ As to the White Australia policy, see Gwenda Tavan, *The Long, Slow Death of White Australia* (Scribe 2005). As to the historical as well as modern symbolic character of coffee as a ‘regional cultural icon’ in Australia, see Andrew Brown-May, *Espresso! Melbourne Coffee Stories* (Arcadia 2001) 75.

with special language protection for Indigenous languages, could be a desirable way to effect change in Australia, the effectiveness of the change will depend on reformist judges and other decision makers of the future creatively interpreting the current law alongside Australian social and cultural aspirations.

II. 'DISTINCTIVENESS' AND VICTORIAN CULTURAL POLICY

The economic idea of a 'trade mark' as an efficient source-signifier – '[a] kind of shortcut to get consumers to where they want to go, and in that way perform a key function in a market economy' – is a central organising principle of Australian trade mark law, which treats the fostering and ordering of efficient trade as its main policy objective,⁷ even if it is increasingly accepted that trade marks may serve 'other functions' apart from designating origin,⁸ and that the law may also have other 'public purposes' centred around broader social policy concerns.⁹ This is not only in Australia. In the large majority of countries around the world in the post-TRIPS era,¹⁰ mainstream legal and economic consensus has it that the statutory language of a 'trade mark' as a sign that distinguishes the goods or services of a trader from those of other traders in the market embodies the trade mark's principal economic function, *viz* of informing and reminding consumers of the trading source of the goods or services, with the implicit message that this can generally also be expected to be the law's main concern.¹¹ Indeed, the position that trade marks are primarily

⁷ See *JT International SA v Commonwealth of Australia* (2012) 250 CLR 1 (HCA) [139] (Gummow J) (noting the statement of Binnie J in *Mattel Inc v 3894207 Canada Inc* (2006) 1 SCR 772 (SCC) 788).

⁸ Ibid [286] (Crennan J) ('Whilst the prime concern of the Trade Marks Act is with the capacity of a trade mark to distinguish the goods of the registered owner from those of another trader, trade marks undoubtedly perform other functions'), including as an indicium of quality and through their ability to advertise the products.

⁹ Ibid [30] (French CJ) ('There are and always have been purposive elements reflecting public policy considerations which inform the statutory creation of intellectual property rights') citing Gleeson CJ et al in *Campomar Sociedad Limitada v Nike International Ltd* (2000) 202 CLR 45 (HCA) [42]–[49] and [35] ('Registered trademarks . . . give rise to, or constitute, exclusive rights . . . created by statute in order to serve public purposes . . .').

¹⁰ Agreement on Trade-Related Aspects of Intellectual Property Rights (opened for signature 15 April 1994, entered into force 1 January 1996) 1869 UNTS 299 (TRIPS).

¹¹ For instance, James Mellor, David Llewelyn, Thomas Moody-Stuart, David

economic in nature and function continues to be maintained despite a growing body of marketing, sociological, anthropological, cultural, linguistic and legal recognition that these signs may ‘represent a variety of ideas and attributes’ to the audience.¹²

That it is a long-established position no doubt helps in entrenching its status. It can be traced back to the utilitarianism of the late nineteenth century, when the British trade mark registration system was established over a period of roughly 30 years,¹³ serving also as a model for the colonies.¹⁴ It was embodied, for instance, in leading textbook-writer Kerly’s statement in 1894 that a ‘trade mark’ consists of ‘a symbol applied or attached to goods offered for sale in the market, so as to distinguish them from similar goods, and to identify them with a particular trader’,¹⁵ a statement substantially repeated in later editions throughout the twentieth century.¹⁶ And while the focus in the nineteenth century may have been more on the advantages for traders of being able to efficiently signify the source of their products in a mass-market economy and thus capture benefits from their labours in trade,¹⁷ the assumption was that the

Keeling, Iona Berkeley, Ashton Chantrielle, William Duncan, *Kerly’s Law of Trade Marks and Trade Names* (16th edn, Sweet & Maxwell 2018) 11–18 (enumerating the trade mark functions, but also identifying the source-signifying function as especially important). See also Graeme Dinwoodie and Dev Gangjee, ‘The Image of the Consumer in EU Trade Mark Law’ in Dorota Leczykiewicz and Stephen Weatherill (eds), *The Images of the Consumer in EU Law: Legislation, Free Movement and Competition Law* (Hart Publishing 2016) 339, 346 (the source-signifying function ‘remains the primary basis for trade mark protection around the world’).

¹² See *JT International* (n 7) [286] (Crennan J) (the ‘advertising function’).

¹³ Trade Marks Registration Act 1875 (United Kingdom); Patents, Designs and Trade Marks Act 1883 (United Kingdom); Trade Marks Act 1905 (United Kingdom).

¹⁴ See Lionel Bently, ‘The Extraordinary Multiplicity of Intellectual Property Laws in the British Colonies in the Nineteenth Century’ (2011) 12 *TIL* 161; and further, as to Australia, Amanda Scardamaglia, *Colonial Australian Trade Mark Law: Narratives in Lawmaking, People, Power & Place* (Australian Scholarly Publishing 2015) (also pointing to local variations in Australian colonial laws and in some instances the adoption of advanced positions, taking up standards proposed but not yet accepted in the United Kingdom).

¹⁵ Duncan Kerly, *Law of Trade-Marks, Trade-Name, and Merchandise Marks* (Stevens and Sons 1894) 25.

¹⁶ A typical example is the eighth edition published in 1960, where the statement of Kerly is quoted verbatim: Rhys G Lloyd, *Kerly’s Law of Trade Marks and Trade Names* (8th edn, Sweet & Maxwell 1960) 16.

¹⁷ See Lionel Bently, Jennifer Davis and Jane C Ginsburg, *Trade Marks and Brands: An Interdisciplinary Critique* (Cambridge University Press 2008) 3 and further as to the colonies, Bently (n 14) and Scardamaglia (n 14).

consuming public would also benefit from their ability to identify traders' products.¹⁸ The basic understanding that the interests of traders and consumers converge in the economic benefits of a system that promotes the adoption, registration and use of trade marks to indicate a trading source thus became established when brands themselves were becoming a central feature of the vast capitalist system of trade stretching across the British world.¹⁹

Nevertheless, there was one domain in which judges in this period paid close attention to the social and cultural dimensions of trade marks from the beginning, albeit they did so in a rather restricted way. In a series of late nineteenth-century cases British judges treated the law's statutory requirements that a word should be 'fancy', 'invented', non-descriptive (as in 'a word or words having no direct reference to the character or quality of the goods') or otherwise 'distinctive', in order to be registered,²⁰ as more than simply an attempt to predict a trade mark's ability to distinguish a particular trader's goods from those of other traders through use and without the benefit of registration. That rationale came later. Most notably in *Registrar of Trade Marks v W & G Du Cros* in 1913 Lord Parker said the issue 'largely depends upon whether other traders are likely, in the ordinary course of their business and without any improper motive, to desire to use the same mark, or some mark nearly resembling it, upon or in connection with their own goods'.²¹ Rather, using strikingly different language, Victorian judges identified the distinctiveness threshold as a vehicle for protecting 'the great open common of the English language' from the appropriations of traders,²² drawing on a nineteenth-century linguistic view of the common language of a society as a repository of

¹⁸ *The Birmingham Vinegar Brewery Co Ltd v Powell* (1897) AC 710 (HL) 714 (Lord Halsbury LC).

¹⁹ See generally Gary B Magee and Andrew S Thompson, *Empire and Globalisation: Networks of People, Goods and Capital in the British World, c 1850–1914* (CUP 2010) ch 4.

²⁰ Trade Marks Registration Act 1875 (United Kingdom), s 10; Patents, Designs and Trade Marks Act 1883 (United Kingdom), s 64(1)(c), s 64(d) and (e); Trade Marks Act 1905 (United Kingdom), s 9(3)–(5).

²¹ *Registrar of Trade Marks v W & G Du Cros Ltd* (1913) AC 624 (HL) 635 (Lord Parker).

²² *Dunn's Trade Marks* (1889) 41 ChD 439, 455 (Fry LJ). See also *Eastman Photographic Materials Co Ltd v Comptroller-General of Patents, Designs and Trade-Marks* (1898) AC 571 (HL) 574 (Lord Halsbury LC), 581 (Lord Herschell), 583 (Lord Macnaghten); *Re Joseph Crosfield & Son Ltd* [1910] 1 Ch 130 (CA) 141 (Cozens-Hardy MR).

traditional culture,²³ and using the trope of ‘the ordinary Englishman’s’ knowledge of language as their standard.²⁴

Jennifer Davis has noted that ‘the ordinary Englishman’ was not an average Englishman (or woman) but reflected the judge’s ‘class assumptions’;²⁵ and his somewhat artificial character allowed considerable scope for him to function as a judicial policy instrument.²⁶ There is support for this analysis in the observation of Chitty J in *Davis v Stribolt* that ‘there are many good English words descriptive of articles which are unknown to an average Englishman, taking rather a high standard’.²⁷ Indeed the ordinary Englishman’s knowledge may well have exceeded that of even the average middle-class Englishman at times, as in that case where the ordinary Englishman’s deemed knowledge that ‘Boköl’ and ‘Bokol’ were Scandinavian words for beer meant these could not be registered as a trade mark for beer in the United Kingdom.²⁸ Indeed, there is plenty in the cases to support the idea that ‘the ordinary Englishman’ was a device that enabled Victorian judges to frame and further a policy of protecting a traditional body of English and other languages that judges wanted to treat as available to ordinary – or at least ordinary middle-class – Englishmen from appropriation.

There are other respects in which the Victorian judges’ standard relying on ‘the ordinary Englishman’ seems removed from the way that some groups understood language. That a modern language might develop new significances was still a radical idea put forward by Ferdinand de Saussure in Switzerland and Charles Sanders Peirce in America around the *fin de siècle*.²⁹ Yet ‘the arbitrariness of the sign’ would become widely accepted in the twentieth century,³⁰ and from relatively early on it provided a basis not

²³ See Megan Richardson, ‘Trade Marks and Language’ (2004) 26 Sydney L Rev 193, 207–20.

²⁴ Jennifer Davis, ‘Locating the Average Consumer: His Judicial Origins, Intellectual Influences and Current Role in European Trade Mark Law’ (2005) 2 IPQ 183, pt 2.

²⁵ Ibid 191–2.

²⁶ Cf Chris Dent, ‘The “Reasonable Man”, his Nineteenth-Century “Siblings”, and their Legacy’ (2017) 44 J Law & Soc 406.

²⁷ *Davis & Co v Stribolt & Co* (1889) 6 RPC 207 (Ch) 212.

²⁸ Ibid. See also *Philippart v William Whiteley Ltd* (1908) 25 RPC 565 (Ch) (‘Diabolo’, Italian for ‘the devil’, as the name of a popular spinning top game based on an ancient game ‘Le Diable’, or ‘Devil on Two Sticks’).

²⁹ See Ferdinand de Saussure, *Cours de linguistique générale* (Payot & Cie 1916); Charles Sanders Peirce, ‘Letter to Lady Welby’ (1904), reprinted in Arthur W Burks (ed), *Collected Papers of Charles Sanders Peirce* (vol 8, Harvard UP 1958).

³⁰ See Damián E Blasi, Søren Wichmann, Harald Hammarström, Peter

only for new thinking about language, but also for a new set of advertising and artistic practices combining language and visual effects in novel forms; for instance, with the playful 'Calligrammes' of Apollinaire,³¹ the incongruous word art of Magritte,³² the 'recurrent references to newspapers' in Picasso's collages,³³ and the expressive line-drawings of Walter Crane, noted British artist and book illustrator, who in 1900 already talked of the line as 'a language, a most vigorous and sensitive speech of many dialects, which can adapt itself to all purposes' in the hands of an artist, unleashing 'a great range of expression'.³⁴ Nevertheless, the Victorian judges' focus on 'distinctiveness' remained squarely on the traditional meaning of common words 'appropriated' and deployed by traders for their exclusive use, with the only effect the judges were prepared to imagine being that a word previously used to describe a range of things was now being used to describe a trader's products specifically.³⁵ In the process, 'the ordinary Englishman' becomes not just a middle-class person who was surprisingly knowledgeable in many languages, but also a rather conservative, literal-minded type in his reaction to the treatment of language in some already-becoming-modern advertising and artistic practices.

Indeed, as late as 1909, almost a decade after Crane wrote of language as expressive and adaptable in the hands of the artist, Cozens Hardy MR was still insisting that '[w]ealthy traders are habitually eager to enclose

F Stadler, and Morten H Christiansen, 'Sound-Meaning Association Biases Evidenced across Thousands of Languages' 113 PNAS 10818.

³¹ Guillaume Apollinaire, *Calligrammes: Poems de la Pais et de la Guerre* (Mercvre de France 1918) and Willard Bohm, *Modern Visual Poetry* (University of Delaware Press 2001) (noting the influence of new advertising practices transformed by changes in typesetting, typefaces and photo-reproduction technologies).

³² See Uwe M Schneede, *René Magritte: Life and Work* (Barron's 1982) ch 3; and Roger Rotham, 'René Magritte and "The Shop-Window Quality of Things"' (2007) 3 *The Space Between* 11 (comparing Magritte's advertising and artistic activities and arguing they were similarly inspired).

³³ See Robert Rosenblum, 'Picasso and the Typography of Cubism' in Sir Roland Penrose and John Golding (eds), *Picasso in Retrospect* (Praeger 1973) 33, 34, 36 (noting 'the stimulus of brand names, labels, advertisements, posters was constant in the Cubist milieu').

³⁴ Walter Crane, *Line and Form* (G Bell & Sons Ltd 1900) 21–2.

³⁵ Cf the common law where 'secondary meaning' was accepted as a bulwark against deceptive practices: see *Reddaway v Banham* [1896] AC 199 (HL) 210–11 (Lord Herschell) ('words forming part of the common stock of language, may become so far associated with the goods of a particular maker that it is capable of proof that the use of them by themselves without explanation or qualification by another manufacturer would deceive its purchaser into the belief that he was getting the goods of A, when he was really getting the goods of B').

Source: First author's personal collection.

Figure 1.1 Crosfield's 'Perfection' soap advertisement, Illustrated London News, May 1887

part of the great common of the English language and to exclude the general public of the present day and of the future from access to the inclosure'.³⁶ Furthermore, 'a mere laudatory epithet' such as 'Perfection', despite its use on 'millions of cakes sold' of Crosfield's soap over many years,³⁷ was not, in his opinion, 'capable of being registered [as a trade mark]' on the basis that it 'ought to be open to all the world'.³⁸ The other judges in the case referenced the word's 'ordinary' or 'common' descriptive and laudatory meaning, as denoting literally perfection,³⁹ to conclude that it should not be allowed to be withdrawn from its 'primary and proper meaning . . . to make it mean "Crosfields" instead of "perfect"'.⁴⁰

³⁶ *Joseph Crosfield* (n 22) 141–2 (Cozens Hardy MR).

³⁷ *Ibid* 143.

³⁸ *Ibid*.

³⁹ *Ibid* 148 (Fletcher Moulton LJ) 151, 153–4 (Farwell LJ).

⁴⁰ *Ibid* 153 (Farwell LJ). Note that these judges were not just concerned with protection of the English language as a general matter, but with the 'rights' of other traders to use the language (see for example Fletcher Moulton LJ at 148,

Apparently, the 'ordinary' meaning of 'Perfection' did not take into account the way the word was already being used in advertising (see Figure 1.1) to convey not a precise sense of literal perfection but a more symbolic sense of a wonderful cleanliness in association with Crosfield's soap, in the same way that Crosfield's competitors used 'Matchless Cleanser' and 'Sunlight' to convey a sense of magical cleanliness loosely connected with their soaps.⁴¹

The growing artistic and advertising reliance on symbolic meaning also helps us to understand the advertising uses of indigenous languages of the colonies in the labels applied to products sourced for British markets around the *fin de siècle*, refashioning their meaning to suit the traders' purposes of communicating their own selected symbolic meanings to their selected audiences. In the same way that leading artists from Van Gogh to Toulouse-Lautrec and Picasso were creatively adapting Oriental and later African and Oceanic symbols, with little regard to their original symbolic meanings,⁴² so apparently 'meaningless' indigenous words and imagery were being repurposed by advertisers (sometimes using the same artists) as labels, advertisements and posters in the late Victorian and early Edwardian period – ensuring that 'scenes of empire [entered] into every corner of the home, stamping images of colonial conquest on soap boxes, matchboxes, biscuit tins, whiskey bottles, tea tins and chocolate bars'; or as Anne McClintock neatly summarises it, it was a period of 'imperial kitsch as consumer spectacle'.⁴³

We might want to challenge this characterisation of kitschness, although it is a label that more generally has been applied to the art of this period and not without some justification.⁴⁴ In fact, the involvement of artists in designing labels, posters and advertisements ensured the artistic quality of advertising could be very high, as with the elegant lines and imagery of

Farwell LJ at 151); as such, the case represented a transitional moment between the nineteenth-century language protection cases and the pro-competition focus of later cases such as *Du Cros* (n 21).

⁴¹ Ibid 149 (Fletcher Moulton LJ).

⁴² Many of the most famous artistic works of this period, including Vincent van Gogh's *Irises* (1889) and Henri de Toulouse-Lautrec's *Divan Japonais* (1893) (at the same time an advertising poster), show strong oriental influences. See generally Gabriele Fahr-Becker, *Art Nouveau* (Könemann 1997) 9–11, 14–15, 103.

⁴³ Anne McClintock, 'Soft-Soaping Empire: Commodity Racism and Imperial Advertising' in Nicholas Mirzoeff (ed), *The Visual Cultural Reader* (Routledge 1998) 304–5.

⁴⁴ As Fahr-Becker (n 42) 7 points out, the Art Nouveau style of this period that many now celebrate as 'the beginning of the Modern Style' has also had its share of detractors, who have dismissed it as 'ornamental hell, kitch, and arts and crafts'.

Toulouse-Lautrec's advertising posters,⁴⁵ and the colourful posters, labels and other advertising material produced by commercial lithographer Charles Troedel's company in Melbourne, Australia, which, in the words of Amanda Scardamaglia, demonstrated 'great artistic merit and honoured the style of the French *Belle Époque* in the 1890s'.⁴⁶ Nevertheless, the aims and effects of the colonial advertising practices often seemed quite different from the practices of other artist/advertisers whose broader purpose was to create a genuinely 'modern style'.⁴⁷ While the latter were at the vanguard of the transition to twentieth-century modernism, colonial advertising practices seemed designed to give consumers the impression that they could enjoy the luxurious experience of living at the centre of a vast colonising enterprise dedicated to providing them with exotic products without having to think too hard about the methods that had been employed in making this possible. Thus we see the beginning of nostalgia labels used to promote and reinforce the idea of the product as 'an unalloyedly blissful substance, except that we wrongfully forget that it is also the product of an expropriation'.⁴⁸

How did the courts treat these practices in the trade mark cases involving indigenous language and imagery that came before them in the last decades of the nineteenth century and the very beginning of the next one? We have already noted how, on the one hand, Victorian and later Edwardian judges treated European languages as within the ordinary Englishman's knowledge, so descriptive words in these languages were precluded from trade mark registration in the same way as English ones.⁴⁹ On the other hand, 'the ordinary Englishman's' deemed lack of knowledge of 'barbarous language[s]',⁵⁰ meant that traders were left free by the law to pursue their practices of drawing on the languages and imagery of the indigenous peoples of the colonies in their advertising practices. In the case that established the position, *Burgoyne's Trade Mark*,⁵¹ Chitty J held

⁴⁵ See, for instance, National Gallery of Victoria, *Japonisme: Japan and the Birth of Modern Art* (National Gallery of Victoria 2018) 56–7, describing Toulouse-Lautrec's *Divan Japonais* as innovatively employing formal qualities of Japanese art in an example of the French Art Nouveau style that many regard as a precursor to modernism.

⁴⁶ Amanda Scardamaglia, 'A Legal History of Lithography' (2017) 26 GLR 1, 18.

⁴⁷ Fahr-Becker (n 42) 8.

⁴⁸ Roland Barthes, 'Wine and Milk' in *Mythologies* (The Noonday Press 1972) 58, 61.

⁴⁹ See discussion at n 28.

⁵⁰ See Kerly (n 15) 146.

⁵¹ *Burgoyne* (n 1).

Source: Troedel Archive, State Library of Victoria, Image H2000.180/194.

Figure 1.2 Hardy's 'Oomoo' Advertisement, circa 1881

that the word 'Oomoo', applied to an Australian wine made by Thomas Hardy of Adelaide exhibited at the Colonial and Indian Exhibition in London in 1886,⁵² which in the label designed by Troedel & Co (see Figure 1.2) was woven into a rural scene featuring Australian flora and fauna to create an impression of unalloyed bucolic enjoyment (notably absent from which were any examples of Indigenous Australians occupying the land), was a 'fancy' word that could be registered as a trade mark by wine importer Peter Burgoyne.

Of course, it was not the Dieri people themselves who objected to the trade mark. Rather the objection that 'Oomoo' meant 'choice' in the 'aboriginal language of Australia' came from a competing wine importer, owner of the 'Emu' trade mark.⁵³ But Chitty J said that the word,

⁵² 'Oomoo Red' was Hardy's high-end wine, described as 'light vintage', and selling in bulk at 6s per gallon: see Henry Trueman Wood (ed), *Reports of the Colonial Sections of the Exhibition* (William Clowes & Sons Ltd 1887) 215.

⁵³ Burgoyne (n 1) 228. For this as the Dieri language, see George Taplin (ed), *The Folklore, Manners, Customs and Languages of the South Australian Aborigines*,

‘manufactured out of four “o’s” and one “m”’, was ‘meaningless’ to ‘an ordinary Englishman, or a sufficient number of Englishman in this country’, as evidenced by the fact that ‘nobody that I know has ever asked for “a glass of Oomoo”’.⁵⁴ In this brief passing comment, ‘the ordinary Englishman’ takes on a further dimension of representing a particular type of English wine-drinking gentleman to be a proper exemplar of public opinion as to what languages should count and which could be dismissed as ‘meaningless’, with no need to consider apparently the way that the bucolic message of Australian enjoyment has been carefully constructed through the use of Indigenous language combined with Australian imagery. Indeed, the language of ‘meaninglessness’ adopted in this context, a term evoking an idea of *terra nullius*, serves as another reminder of the difficulty ‘indigenous groups faced in negotiating for themselves a place in the British world’.⁵⁵

The reasoning of Chitty J in *Burgoyne* can be contrasted with that of Kay J in *Jackson Co’s Trade Mark*,⁵⁶ decided earlier in the same year. In this case the onomatopoeic American Indian word ‘Kokoko’, meaning ‘owl’ in the language of the Chippewa, was treated as equivalent to the English word ‘owl’ in signifying the figure of an owl, which, being common in the cotton trade, was accepted to be precluded from registration under the statute.⁵⁷ An unusual feature of the case was a clever demonstration of a new technology, a phonograph on which a wax cylinder made by Thomas Edison containing an ethnographic recording of the sound of a Chippewa Indian war-cry imitating the owl’s screech was played in court,⁵⁸ to the tremendous excitement of those present – and showing, as one newspaper said, ‘how valuable and important may be the part which Mr Edison’s remarkable discovery may yet play in social and commercial life’.⁵⁹ Thus it was already evident to this audience that ‘Kokoko’ was not just a word in Chippewa language denoting an ‘owl’, but was also accorded a particular symbolic function in Chippewa culture that could

Gathered from Inquiries made by Authority of South Australian Government (E Spiller 1879) 83 (‘oomoo’ translated there as ‘good’, and ‘oomoomurla’ as ‘better’).

⁵⁴ *Burgoyne* (n 1) 231.

⁵⁵ See Magee and Thompson (n 19) 37.

⁵⁶ *Jackson Co’s Trade Mark* (1889) 6 RPC 80 (Ch).

⁵⁷ It was accepted that ‘owl’ in English, French, Italian or Russian could not be registered: *ibid* 82.

⁵⁸ See, for an account of the demonstration, Patrick Feaster, ‘The Origins of the Ethnographic Sound Recording, 1878–1892’ (2001) 20 (1/2) *Resound: A Quarterly of the Archives of Traditional Music* 2, 3.

⁵⁹ ‘The Phonograph is Forcing its Way to the Front’, *Evening Telegraph and Star and Sheffield Daily Times* (December 1888) 2. The incident was widely reported in the local and London newspapers.

be preserved and recorded by virtue of the phonograph. Further, responding to the company's argument that 'Kokoko' was a word unknown in the cotton trade in Britain, Kay J held that the possibility of cotton trade with the Chippewa developing in the future could not be ruled out and, for that potential audience at least, the prospect of 'Kokoko' being understood as a descriptive word could not be ruled out.⁶⁰ For his part, Chitty J in *Burgoyne* was quick to dismiss such an argument on the basis that 'as to there growing up a trade in "Oomoo" with the Aborigines of the Australian Continent, I think that is far-fetched, and a great deal too fanciful a notion for me, sitting here as a Judge, to proceed upon'.⁶¹

We have not been able to find any record of the 'Oomoo' label being registered to Burgoyne in the United Kingdom register (although that may have more to do with the hole in the archive than with any actual decision not to register the trade mark, despite his having gone to court to proclaim his entitlement to do so)⁶² – and nor was it registered in the name of Hardy in South Australia around the same period, although it seems likely that the 'Oomoo' label in question in the *Burgoyne* case, designed and printed by the Chas Troedel lithographic company for Thomas Hardy's winery, was intended for use also in Australia.⁶³ But the reasoning of Chitty J that obscure languages from Aboriginal Australia, or 'say, from the centre of Africa',⁶⁴ were meaningless to the 'ordinary Englishman' and thus could be freely entered on the register, set the tone for later cases. Six years later, in *Densham and Sons' Trade Mark*,⁶⁵ the Court of Appeal upheld the decision of Romer J that 'Mazawattee', a word composed from 'Mazadhar', meaning 'luscious' in Hindi, and 'Wattee', meaning 'garden' in Sinhalese, was a validly registered trade mark for tea imported from Ceylon.⁶⁶ One

⁶⁰ *Jackson* (n 56) 83–4.

⁶¹ *Burgoyne* (n 1) 232.

⁶² On the other hand, it is possible that Burgoyne decided not to register the trade mark, which already had achieved the desired goal of making use of Australiana to designate Australian wines imported into Britain, including in the showing at the Colonial and Indian Exhibition. For the use of 'Australian' imagery as a marketing tool see David Dunstan, 'A Sobering Experience: From "Australian Burgundy" to "Kanga Rouge": Australian Wine Battles on the London Market, 1900–1981' (2002) 17 *J Aus Studies* 179.

⁶³ The 'Oomoo' label along with the 'Emu' label form part of the Troedel archive at the State Library of Victoria.

⁶⁴ *Burgoyne* (n 1) 231.

⁶⁵ *Densham and Sons' Trade Mark* (1895) 12 RPC 75 (Ch).

⁶⁶ The authority of *Jackson* was raised in this case but Romer J said that he was rather inclined to think that 'the Chippeway Indians might have been left to take care of themselves'; *ibid* 82.

might think that the firm's advertisements of its tea as coming from 'the sweet-scented island of Ceylon, which produces the most luscious tea in the world'⁶⁷ might have made the symbolic meaning of luscious colonial cultivation obvious to at least some of the consuming public in Britain, even aside from those who through education or experience might have known the Hindi and/or Sinhalese languages. Nevertheless, Romer J, who as Romer QC had argued for registration of 'Oomoo' before Chitty J in *Burgoyne*, held that 'Mazawattee' was a 'meaningless' invented word; and his decision was upheld without any apparent difficulty on appeal.⁶⁸ By the time the House of Lords came to determine the distinctiveness of the Eastman company's trade mark 'Solio' for photographic paper,⁶⁹ Lord Herschell could confidently state that the English language was 'common property' and 'no one ought to be prevent the other members of the community from using [it] for purposes of description';⁷⁰ although he thought the same might be extended to foreign words – and more generally questioned whether 'meaninglessness' was necessarily the proper standard here.⁷¹ He made an exception for 'words from languages so little known in this country that it would suggest no meaning except to a few scholars'.⁷²

III. VICTORIAN CULTURAL POLICY IN MODERN AUSTRALIA

The Victorian distinctiveness standard, culminating in Lord Herschell's judgment in *Eastman Photographic*, found support in Australian cases of the 1940s, 1950s and 1960s, where the notion of distinctiveness protecting 'the common right of the public' to 'the common heritage' is treated as the

⁶⁷ Ibid 76 (quoting the advertisement).

⁶⁸ (1895) 12 RPC 271 (CA). Perhaps Kay J came around to the same view as Romer J; like Kay LJ he agreed with Lindley and Lopes LJ in the Court of Appeal. The decision's positive reception in the press also suggests that it accorded with views of British traders: see, for instance, 'Letter of Cheesbrough & Royston, Fellows, Chartered Institute of Patent Attorneys' to the Liverpool Mercury (June 1895) (the decision 'shows that [earlier] trade mark cases have now, in the eyes of the law, reached the summit of absurdity').

⁶⁹ *Eastman Photographic* (n 22).

⁷⁰ Ibid 580.

⁷¹ Ibid (at least for invented words). Thus the 'newly coined' word 'Solio', despite its derivation from the Latin word 'sol' for sun and hint at the process of development involving the use of sunlight, could be registered.

⁷² Ibid 581. Cf Lord Macnaghten at 583 ('no objection that [an invented word] may be traced to a foreign source').

principal standard in Australia, supplemented by the economic standard propounded in *Du Cros*.⁷³ These cases, all decided in a time of the White Australia Policy, are still regarded as authoritative. They provide the backdrop of the 'inherent distinctiveness' standard in section 41 of the Trade Marks Act 1955 (Cth), a standard relied on to allow registration of a trade mark without the benefit of actual or potential use and thus substantially less onerous for a potential registrant than the other standards of 'distinctiveness' permitted under the Act (which require evidence of actual or intended use).⁷⁴ In an ironic return to Victorian decision-making, in 2006 'Oomoo' was registered as an inherently distinctive trade mark for a revived brand of Hardy's wine after a lengthy period of disuse.⁷⁵ Again registration was not opposed. And presumably it was allowed on the basis that the language, and thus 'Oomoo's' meaning, was little known in Australia – despite a resurgence of interest in the Dieri (or Dayari) language among the Dieri population in South Australia, sponsored by various government programmes,⁷⁶ and Australia's support for the United Nations Declaration on the Rights of Indigenous Peoples, including

⁷³ Most notably, *Howard Auto Cultivators Ltd v Webb Industries Pty Ltd* (1946) 72 CLR 175 (HCA) 181 (Dixon J) (citing Lord Macnaghten in *Eastman Photographic* (n 22)); *Mark Foy's Ltd v Coop & Co Ltd* (1956) 95 CLR 190 (HCA) 195 (Dixon J) (referring to 'the probability of ordinary persons understanding the words') 199, 201 (Williams J) (citing Lord Herschell in *Eastman Photographic* (n 22) and adding that 'to say that articles of clothing are "tub happy" [in this case] is in the ordinary use of English meaningless'). The *Du Cros* standard (n 21) (with its emphasis on limiting the prospects of undesirable monopolies) is more the focus in *FH Faulding & Co Ltd v Imperial Chemical Industries Ltd* (1956) 112 CLR 537 (HCA) 555 (per Kitto J, regarding 'barrier' as commonly used in trade). See also *Clark Equipment Co v Registrar of Trade Marks* (1964) 111 CLR 511 (HCA) 513–14 (per Kitto J on the status of 'Michigan' for trucks under s 25 Trade Marks Act 1955 (Cth), permitting registration on the basis of a minimum threshold of inherent distinctiveness combined with actual or potential use, referencing 'the common right of the public to make honest use of words forming part of the common heritage, for the sake of the signification which they ordinarily possess' but also citing *Du Cros* (n 21)).

⁷⁴ For s 41 of the Trade Marks Act 1955 (Cth) and the current tripartite 'distinctiveness' standard, see Michael Handler, 'All that Glitters Is Not Gold: A Critical Assessment of Trade Mark Distinctiveness under Australian Law, Part I' (2015) 101 IP Forum 14.

⁷⁵ A pictorial label containing the word 'Oomoo' was registered in 2003 and the word 'Oomoo' was registered in 2006 (with an endorsement): Trade Marks 953036, 1099230. See further n 3.

⁷⁶ See Peter K Austin, 'And Still They Speak Diyari: The Life History of an Endangered Language' (2014) *Ethnorêma* 1, for a historical survey and account of the language's revitalisation.

its provision for protection of indigenous ‘cultural heritage, traditional knowledge and traditional cultural expressions’.⁷⁷

Likewise, in 2014 in *Cantarella*,⁷⁸ the High Court held that ‘Oro’, meaning ‘gold’ in Italian, and a common sight on coffee packets circulated by Italian coffee traders in Australia,⁷⁹ was validly registered as an inherently distinctive trade mark for Cantarella Bros’ Vittoria coffee in 2000,⁸⁰ on the basis of the word’s ‘ordinary [lack of] signification’ to the public in Australia – notwithstanding a post-war Italian diaspora which has been active in the coffee industry with the result that coffee is now widely viewed as ‘a regional cultural icon’,⁸¹ the popularity of Italian language programmes, including in schools and universities, and a long-standing official government policy of non-discrimination on grounds of race extending to ‘economic, social and cultural rights’.⁸² In assessing knowledge of Italian in Australia, the Court relied on a finding of Emmett J at first instance that only ‘a very small minority’ understood the meaning of ‘Oro’ on the evidence available – most notably Census data from 2006 suggesting that those speaking Italian at home in Australia were less than 2 per cent of the Australian population.⁸³ This demographic fragment was scarcely enough if the purpose was to assess whether ‘particular words that are intended to constitute the trade mark are sufficiently well understood in Australia’, as Emmett J posited.⁸⁴ Indeed, our research conducted after the case suggests the number of those who understand may be nearer 10 per cent of the broader population, around 20 per cent for some quite sizable minority groups *viz* those familiar with Italian language and coffee

⁷⁷ UN General Assembly, ‘United Nations Declaration on the Rights of Indigenous Peoples’ (adopted 13 September 2007) A/RES/61/295, art 31. See Kristin Carpenter and Angela Riley, ‘Indigenous Peoples and the Jurisgenerative Moment in Human Rights’ (2014) 102 Cal L Rev 173 (arguing that the Declaration is part of a new invigoration of indigenous rights).

⁷⁸ *Cantarella* (n 4).

⁷⁹ *Ibid* [75] (The High Court disputed whether the evidence of the other trade uses of ‘Oro’ on coffee packets was sufficient to prove that ‘the word “Oro”, standing alone, is understood in Australia by persons concerned with coffee products to be to be directly descriptive of the character or quality of the goods’).

⁸⁰ Trade mark 829098; see further n 5.

⁸¹ See Brown-May (n 6).

⁸² International Convention on the Elimination of All Forms of Racial Discrimination (opened for signature 21 December 1965, entered into force 4 January 1969) 660 UNTS 195, art 5(e); Racial Discrimination Act 1975 (Cth) (implementing the Convention).

⁸³ *Cantarella* (n 4) [61] (French CJ et al, citing Emmett J in *Cantarella Bros Pty Ltd v Modena Trading Pty Ltd* (2013) 99 IPR 492 [117]).

⁸⁴ *Cantarella* (n 4) [113] (Emmett J).

Table 1.1 Significations of 'Oro' – survey results

'Oro' signifies 'gold'		'Oro' signifies 'Italian', 'authentic', 'fancy', 'pure' etc
All respondents	11%	20%
Italian background	56%	33%
Understand Italian	18%	28%
Coffee aficionados	19%	33%

'aficionados' (that is, those serious about coffee as measured by their preference for coffee made from beans/grounds), and more than 50 per cent of the relatively small number of those of Italian background.⁸⁵ But, as there was no evidence specifically directed to the latter point put forward in the case itself, the Census data on Italian-speaking became the barometer of public knowledge of Oro's 'meaning' in Australia. The results of the survey are presented in Table 1.1.

At the same time, the Court appeared anxious to distance itself from any suggestion that it was using a standard of an ordinary English language speaker, preferring the neutral-sounding 'ordinary signification' to those 'concerned with' coffee in Australia, 'a familiar beverage consumed by many'.⁸⁶ Yet it preferred 'the many' in Australia over other imagined communities – unlike Gageler J, in dissent, who noted that in Australia coffee is 'commonly associated with Italy, often enough imported from Italy and often enough sold to Italian speakers', and supported the 'multicultural' approach of the full Federal Court in taking into account the language of coffee traders as explaining their legitimate choices to use 'Oro' on their packages.⁸⁷ At the same time, the Court also made clear that 'allusive or metaphysical meaning' can be disregarded in assessing

⁸⁵ In this research, conducted in September 2015 with the Pureprofile online survey company, we surveyed 250 adult people across Australia, asking questions *inter alia* about their consumption of coffee (around 80% of respondents); whether they bought coffee as beans or grounds (as a measure of coffee aficionado status) or in convenience forms, or did not buy coffee; what they thought the word 'Oro' meant on the package; why they thought 'Oro' was on the package (in other words, the symbolic value they attributed to the word 'Oro'); whether they had an Italian background and whether they understood the Italian language from 'a little' to 'perfectly'.

⁸⁶ *Cantarella* (n 4) [73], [117] (French CJ et al).

⁸⁷ Ibid [101]–[113] (Gageler J, discussing the Full Federal Court decision in *Modena Trading Pty Ltd v Cantarella Bros Pty Ltd* (2013) 102 IPR 382).

‘ordinary signification’.⁸⁸ And so the allusive symbolic meaning that ‘Oro’ may have for some audiences, which may help to explain its common use to denote pure or authentic Italian quality by Italian coffee traders in Australia,⁸⁹ was left out of account on this highly literal analysis.⁹⁰ As such, the Court’s coded language of ‘ordinary signification’ fits the observation of Graeme Dinwoodie and Dev Gangjee that ‘most efforts by courts [these days] to identify or construct consumers and the marketplace they inhabit are blended exercises that are part-empirical and part-normative’.⁹¹

IV. TOWARDS A MODERN AUSTRALIAN CULTURAL POLICY

One of the difficulties with the part-normative standard adopted in the *Cantarella* case is that its starting point is a Victorian distinctiveness standard adopted when it was socially acceptable for a British judge to treat ‘the ordinary Englishman’ as the arbiter of meaning, endorsed without question in Australia during the era of the White Australia policy, and made the measure of the inherent distinctiveness of the ‘Oro’ coffee label in modern multicultural Australia. As Michael Handler points out, ‘expressed at such a high level of generality, and by seeming to treat “anyone concerned with the goods” as an undifferentiated mass, the majority’s interpretation of “signification” is not especially helpful in addressing a range of other, more complex situations’.⁹² In this chapter we have argued that it was not especially helpful either in addressing the signification to be attributed to a common Italian word, commonly used and applied with respect to coffee products in Australia, to a range of publics. Nor was it especially helpful in addressing the registration of Hardy’s ‘Oomoo’ wine label a few years earlier, relying on the by-then set-

⁸⁸ *Cantarella* (n 4) [73] (French CJ et al).

⁸⁹ Despite a concerted television advertising campaign launched by Cantarella in 2010, featuring Italian-American actor Al Pacino in a series of vignettes designed to associate himself specifically with a traditional idea of good Italian-style coffee enjoyed by Italian diasporas (an idea reinforced by the old-fashioned sepia-tinged coffee label). The campaign is noted by Emmett J in *Cantarella Bros v Modena Trading* (n 4) [57].

⁹⁰ For instance, in our survey (n 85), some 20% of respondents, and nearer 30% of the identified minority groups of involved coffee consumers, indicated in response to our question about why ‘Oro’ was on the Vittoria package that it was used to signify ‘Italian’, ‘authentic’, ‘fancy’, ‘pure’ etc.

⁹¹ Dinwoodie and Gangjee (n 11) 339.

⁹² Handler (n 74) 22.

tled standard of inherent distinctiveness that privileges the understandings of ordinary English-speaking Australians over minority and Indigenous groups. This standard, construed this way, may represent a more 'correct' reading of a nineteenth-century standard that now appears to be entrenched in Australian law than the 'multicultural' standard espoused by the full Federal Court and by Gageler J in his dissenting judgment. But in terms of modern cultural policy as well as economic policy of limiting monopoly, per Lord Parker in *Du Cros*,⁹³ theirs seems far superior. And, even then, whether their approach focusing on perceptions of Italian coffee traders without also considering the understandings of consuming and other existing and emerging publics in a rapidly changing modern Australia goes sufficiently far – or indeed whether a focus on an existing coterie of Italian coffee traders who now use 'Oro' leaves out potential other traders of the future who equally may have legitimate interests in using the word to describe their competing products.⁹⁴

So is the answer law reform and, if so, in what direction? Many of those we have consulted in this study have suggested that the American doctrine of foreign equivalents, which is now followed to an extent in current British practice,⁹⁵ could provide a solution. This doctrine emerged towards the beginning of the twentieth century in response to the use of Italian, French, Spanish and other languages in vibrant and expanding American trading communities.⁹⁶ It allows translation of foreign words into English

⁹³ Recall Lord Parker's language of the legitimate desire of other traders to use the same or a similar mark as the standard of distinctiveness, framed in terms of restricting barriers to entry; *Du Cros* (n 21).

⁹⁴ Bearing in mind that if the focus of the economic standard is whether other traders are 'likely, in the ordinary course of their business and without any improper motive, to desire to use the same mark, or some mark nearly resembling it, upon or in connection with their own goods' (*Du Cros* (n 21) 635 (Lord Parker)), this kind of 'barriers to entry' standard should include not just other traders who now exist, but potential traders in the future.

⁹⁵ See Ellen Gredley, 'Foreign-language Words as Trade Marks' in Norma Dawson and Alison Firth (eds), *Trade Marks Retrospective* (Sweet & Maxwell 2000) 85 (cited in *Cantarella* (n 5) [97] (Gageler J), although without considering the argument's validity); and further Handler (n 74) 24.

⁹⁶ For instance, *Roncoroni v Gross* (1904) 92 AD 221 ('Conserva Di Tomate'); *Charles R De Bevoise Co v H & W Co* (1905) 69 NJ Eq 114 ('Brassiere'); *Italian Swiss Colony v Italian Vineyard Co* (1910) 158 Cal 252 ('Tipo Chianti'); *Thermogene Co v Thermozine Co* (1916) 234 F 69 (Fed Circ) ('Thermogene'); *McKesson & Robbin Inc v Charles H Phillips Chemical Co* (1931) 53 F2d 342 (Fed Circ) ('Leche-de-Magnesia'); and authorities noted in *Re Northern Paper Mills* (1933) 64 F 2d 998 (Fed Circ) (a case that itself concerned the Spanish word 'Gazza', meaning gauze, for toilet paper).

for purposes *inter alia* of assessing inherent distinctiveness.⁹⁷ It may be feasible to introduce this doctrine into Australian law, whether by legislative amendment or by a more subtle change in judicial approach. Nevertheless, a great deal depends on how it is treated in practice by judges and other decision makers. For instance, some US judges have treated the doctrine as asking simply whether the ‘ordinary American purchaser’ would ‘stop and translate’,⁹⁸ an approach which seems little different from the current Australian standard of ‘ordinary signification’.⁹⁹ And even on a more liberal interpretation, ‘obscure’ languages are generally not accorded protection. In one early case *Selchow v Chaffee*,¹⁰⁰ it was held with respect to ‘Parcheesi’, a popular game based on an ancient Indian game with a ‘very similar’ name, that ‘[b]ecause the foreign name is known here to but a few to-day does not signify it will not be known to hundreds tomorrow and thousands next week and tens of thousands next month’, using language reminiscent of the British *Jackson* case.¹⁰¹ But since then the focus has been more on giving equivalent protection to already common (primarily European) languages. Native American Algonquin have not been accorded the protection.¹⁰² Nor has Arabic, knowledge of which

⁹⁷ The doctrine is also used to determine genericism and similarity of connotation in infringement cases: see *Palm Bay Imports Inc v Veuve Clicquot Ponsardin Maison Fondee* (2005) 396 F 3d 1369 (Fed Circ) 1377.

⁹⁸ See *Palm Bay Imports*, *ibid* 1377 (Rader Circ J) (‘it is improbable that the average American purchaser would stop and translate “VEUVE” into “Widow”’, and thus the doctrine does not apply in this case where ‘Veuve Royale’ and ‘the Widow’ were being compared for similarity of connotation in an infringement case).

⁹⁹ In a later attempt to soften its approach, the US Court of Appeals said the requirement of ‘the ordinary American’ translating meant ‘all American purchasers, including those proficient in a non-English language who would ordinarily be expected to translate words into English’: *Re Spirits International NV* (2009) 563 F 3d 1347 (Fed Circ) 1351–2, and note generally Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* (5th edn, Thomson Reuters 2017) s 11(34).

¹⁰⁰ *Selchow v Chaffee & Selchow Mfg Co* (1904) 132 F 996 (Fed Circ).

¹⁰¹ *Ibid* 999 (Ray DJ). The trade mark was eventually registered in 1918 after ten years’ use. Cf *Re Bradford Dyeing Association* (1917) 46 App DC 512, 513 (Van Orsdel J) regarding the relatively obscure French word ‘E’clatant’ adopted for the applicant’s cotton piece goods (‘Not only would the meaning soon become known to the public, but the user of the mark would appreciate the advantage of disseminating such information by advertisement or otherwise. Indeed, there would be nothing to prevent the printing of a translation of the word or phrase in direct connection with the use of the mark’); *Otokoyama Co Ltd v Wine of Japan Import Inc* (2001) 175 F 3d 266 (Fed Circ) 270 (Leval Cir J) (‘there are (or someday will be) customers in the United States who speak that foreign language’).

¹⁰² See *Mohegan Tribe of Indians of Conn v Mohegan Tribe & Nation Inc* (1999)

was deemed 'negligible . . . according to Census data',¹⁰³ although Swahili on a range of evidence was treated as within the doctrine.¹⁰⁴ Similarly mixed results can be found in the United Kingdom – with, for instance, the Spanish expression 'El Canal de Las Estrellas' treated as equivalent to the English phrase 'The Channel of the Stars' in one decision,¹⁰⁵ but the Japanese word 'Kiku' (denoting 'Chrysanthemum') and a symbol of a globe, said to be 'a common sight' in Saudi Arabia, in other decisions deemed too obscure to be counted on the evidence available when it comes to assessing inherent distinctiveness.¹⁰⁶

Thus, although the doctrine of foreign equivalents would be a step beyond the current Australian approach (and the approach in some European jurisdictions),¹⁰⁷ it might still end up being a rather modest step, depending on how it is construed. Certainly, as far as 'Oro' in Australia is concerned, a court following the current American or British approach and basing itself on Census data suggesting that less than 2 per cent of the population speaks Italian, might still conclude that Italian is an obscure

255 Conn 358, 371–2 (doctrine of foreign equivalents not applicable in assessing genericism of the disputed term 'Mohegan' on the basis that 'no sizable segment of the relevant public is likely to speak the Algonquin languages', and the word was generic as it had 'become synonymous in the English language with the unique Indian people commonly known by that name'). See also *Re Spirits of New Merced LLC* (2007) 85 USPQ2d 1614 (TTAB 2007) (as to 'Yosemite' meaning 'the killers' in the Miwok language and no evidence that the general American public would be familiar with that meaning).

¹⁰³ *Taza Systems LLC v Taza 21 Co LLC* (US Dist WD Pa, LEXIS 130974, No 2:11-cv-073, 13 September 2013).

¹⁰⁴ *S Squared Ventures LLC* (TTAB 86813357, 16 August 2017) (Swahili a 'common modern language' evidenced by university language programmes, clubs, religious and cultural organisations, and broadcasting media).

¹⁰⁵ *El Canal de las Estrellas Trade Mark* (2000) RPC 291, 299 (noting also that 'stars' would be understood in the laudatory sense of 'star performers in entertainment' rather than 'celestial stars'). See also Handler (n 74).

¹⁰⁶ *Kiku Trade Mark* (1978) FSR 246; Opposition to a trade mark application of Ajlan Bin Arbullah Al-Ajlan & Bros Co, Geoffrey Hobbs QC, 11 February 2000 (device of globe).

¹⁰⁷ *Matratzen Concord AG v Hukla Germany SA* (2006) ECR 2303 [24] – not following the Opinion of Advocate-General Jacobs, favouring a more liberal approach, as in Britain, Germany, the Netherlands and Belgium (at [52]). See Dinwoodie and Gangjee (n 11), suggesting that in the European Court of Justice empirical considerations of Spanish consumers trumped normative European free trade considerations (although this presupposes that Spanish consumers would not know the meaning of a German word for mattresses that was similar in Dutch, French, Italian and English, and we might also posit an alternative normative nationalist cultural policy here).

rather than a common European language. As to the fate of ‘Oomoo’, even on the best evidence about language dissemination of Dieri this is not a ‘common’ language. Indeed, for Indigenous languages something closer to a full equal treatment principle may offer a better guarantee that the language will be protected from appropriation as trade marks.¹⁰⁸ This is the position adopted in New Zealand with respect to Māori, based on the official status of the language under Māori Language Acts, although even then it was decisions of the Assistant Commissioner of Trade Marks that ensured that trade mark law would treat Māori the same way as English in assessing inherent distinctiveness – with the result that ‘Kikorangi’ and ‘Kura’, meaning ‘blue’ and ‘red’ in Māori, were held not inherently distinctive of blue cheese and yoghurt products (although the first was found distinctive on evidence of 11 years uninterrupted use by the well-known Kapiti Cheeses company).¹⁰⁹ In short, the effectiveness of modelling reform on American and New Zealand language equivalence approaches will depend on how high the threshold of language knowledge is treated by Australian decision makers, how ready they are to accept there may be multiple meanings, and how receptive they are to evidence

¹⁰⁸ See Terri Janke and Maiko Sentina, ‘Indigenous Knowledge: Issues for Protection and Management’ (2018) IP Australia 61 raising the introduction of language protection legislation as one option for reform (the authors note the introduction of the New South Wales Aboriginal Language Act 2017, but state that ideally such legislation could go further in ‘empower[ing] Indigenous people to make decisions about [languages] maintenance and use’). This discussion paper also suggests the establishment of protocols in the Trade Marks Examiners’ Manual for examiners to exercise powers of rejection under s 41 of the Trade Marks Act 1995 (Cth) where ‘indigenous words and images . . . [are] descriptive’ (at 59); and that ‘[i]t would be an appropriate recognition of cultural protocol for non-Indigenous persons to obtain . . . with the traditional custodians of the language and seek permission to use an Indigenous word or name commercially’ and suggesting that the absence of consent could be made an absolute ground of rejection (at 56, 59–60) (with an Indigenous Advisory Committee in IP Australia having an educative role here).

¹⁰⁹ See *Kapiti Cheeses Ltd* [2003] NZIPOTM 21, J Walden Assistant Commissioner of Trade Marks (treating Māori as equal to English in assessing inherent distinctiveness, based on its official status under the Māori Language Act 1987, s 3); *White Cloud Dairy Innovation Ltd* [2017] NZIPOTM 3, Victoria Casey QC Assistant Commissioner of Trade Marks (reaching the same conclusion as to the equal status of Māori under Te Ture mō Te Reo Māori 2016/Māori Language Act 2016, s 5). In the latter decision, the Assistant Commissioner noted also that ‘the Māori advisory committee advised . . . that the mark is unlikely to offend’ under s 178 of the Trade Marks Act (at [3]), making clear that inherent distinctiveness was a separate issue from cultural offensiveness.

of language knowledge in cases and disputes before them.¹¹⁰ All we are saying here is that, as the history of the inherent distinctiveness standard has demonstrated, the scope and operation of any future legal standard will be a product not just of design and intention, but of the way that its language is ultimately construed – and construction will almost inevitably be at least partly a function of the policy choices of decision makers.

V. CONCLUSION

In this chapter we have argued that there are a number of reasons, economic and cultural, to question whether a standard about the ordinary signification of language in Australia, a standard whose roots can be traced back to the language of the 'ordinary Englishman' of nineteenth-century colonial Britain, is the best way to determine what should be entered on the trade mark register in modern Australia. We have suggested that Australian law makers, legislators and judges, and other decision makers alike, should now consider how the standard could be updated for a twenty-first-century modern Australia. As to efficiency, an approach that espouses the possibility that a few traders today may become more tomorrow and all should be taken into account in considering the prospect that a variety of traders will have legitimate interests in using certain language expressions for their competing products is surely preferable to one that privileges existing traders. As to culture, a standard that protects the common language of English-speaking people while allowing appropriation of the languages of Indigenous and minority groups fails to give account to the multiple imagined communities in which many people now live in Australia, and the aspirational norms of inclusion that this country espouses. On several counts, then, now is the time to move away from the nineteenth-century idea that a word's 'ordinary signification' should dictate the quality of a sign's trade mark-ness for multiple publics across multiple boundaries.

¹¹⁰ And see for instance, our survey results (n 85). The point is also made more generally by Kimberlee Weatherall, 'The Consumer as the Empirical Measure of Trade Marks' (2017) 80 Mod Law Rev 57.