

MAKING A MARK

Dr. Irene Calboli tries to bring legal clarity to trademark advertising.

If you see Dr. Irene Calboli poking around in a supermarket, scanning the clothing racks at TJ Maxx or even watching commercials, she may not be doing what you think she is.

“I’m working,” she says.

Calboli, an associate professor of law at Marquette, specializes in intellectual property law. What she’s actually up to in the store and in front of the TV is studying the use of corporate trademarks and logos. “In consumer society,” she says, “we’re surrounded by trademarks everywhere.”

Despite the ubiquity of marks and logos, the law that governs them is unclear, which makes it an intriguing research subject. Intellectual property law encompasses much more than trademarks and logos, of course. As the name implies, anything that’s a product of someone’s intellect — inventions, literary and artistic works, symbols, names, images and designs — falls under its rubric. “It can really apply to nearly everything in our lives, at any time,” Calboli says.

Calboli’s recent work focuses on the legal and policy issues arising from international commerce in trademarks and particularly trademark advertising. That’s important because more and more entities, from companies to schools and even hospitals, are using their logos on merchandise. And “fake” products from China and Southeast Asia continue to flood the market and raise trademark infringement issues.



TM

By Jay Sanders

Although the licensing of famous marks such as Green Bay Packers or Coca-Cola for use on products is commonplace in the business world, there's no straightforward legal protection of the practice. "Instead," Calboli has written, "courts have elaborated different tests and views, thus leaving trademark owners, competitors and the market with much confusion as to what can or cannot be protected."

That's one of the reasons Calboli relishes the topic.

"Intellectual property law is very challenging, very technical," she says. "I enjoy the

technicalities." Technicalities like this one: Trademarks themselves generally aren't protected, but their use is. It's up to the company that owns the mark to define exactly how it can be used and to go after anyone who uses it incorrectly. "If you don't pursue your rights, you've abandoned them" in the eyes of the court, Calboli says.

For famous marks, damages from misuse can amount to "dilution by blurring or tarnishment," a loss of the distinctiveness or damage to the reputation of what the mark represents to its owner. "If you use a mark on everything, eventually the mark means nothing," Calboli says. It can all get a little confusing, especially when the body of rulings on trademark merchandising itself lacks focus. Calboli attempts to bring "light and clarity" to the issue through her research, some of

which she highlighted in a paper she's submitting this spring for law review publication later in 2010.

Calboli's article makes the case for a "fair and balanced" protection of trademark merchandising. She shares evidence that the Federal Trademark Act supports the recognition of merchandising rights — rights that could benefit the market by protecting against unfair competition and consumer confusion. That's the fair part. The balanced part is an argument

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for specific limits on those protections. "I believe trademarks should be treated as property. Property rights are never absolute," Calboli says. "Property rights should allocate resources but also be limited by public needs."

Needs like the protection of freedom of speech. Many people have tried to trademark words. And at least one court has gone further, ruling that Louisiana State University could legally protect its school colors. For Calboli, that goes beyond the realm of commercial usage.

"Words are a limited resource," she says, "and color even a more limited resource." Much as groups might want to claim them for their own purposes, it wouldn't be healthy for our own freedom of expression to allow that, she says.

"We have to reconcile trademarks with reality," Calboli says.

Is it OK to call sparkling wine produced in California champagne,

which is named for a specific region of France? Can you market Wisconsin

blue cheese as

Gorgonzola, the

eponymous blue

cheese produced in

a small Italian city since

879? Can an Idaho Potato

come from Montana? In another of

her recent research papers Calboli

says no. Instead, she argues for

protecting geographic indications of origin, or GIs.

"There's a market reason," she says, namely preventing unfair competition from "masquerade" products. "But there's also an anthropological reason. The world is coming closer and closer together. It's important to protect some cultural identity."

If you want to produce sparkling wine and claim that it's better than French champagne, Calboli has no problem with that. Just don't call it champagne. You might even create a new market as a result. Calboli cites the example of Australia's wine industry, which devoted itself to producing knock-offs of French wines until it was banned from doing so. Forced to come up with new names, it created worldwide demand for national distinct Australian varieties.

"Protecting GIs ultimately guarantees the quality of the foods and their uniqueness," Calboli says.

