RE-CERTIFYING TRADEMARK LAW

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ABSTRACT

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This thesis provides a comprehensive treatment of certification marks as a part of trademark law. Certification marks are an infrequently discussed area of trademark law in the legal scholarship. The reality of certification marks is misaligned with the legal conception of certification marks as they are currently projected by trademark law statutes. The objective of this thesis is to interrogate the nature of certification marks, especially their core feature: what I term the *certifying function*. Therefore, I consider the nature of the certifying function, and how it is best conceptualised in the context of today's marketplace practices, consumers' expectations, and nature of meaning. I provide an analytically descriptive contribution by arguing that certification marks today exist on a spectrum, from bare to robust. Accordingly, what all marks that perform a certifying function—certification marks and other marks that I term *pseudo-certification marks*—share is the ability to signal *attestation source.* Contrary to the understanding of certification marks informed by the informational-efficiency account of trademark law, certification marks do not necessarily allow consumers to distinguish between goods or services that are certified to a particular standard by communicating information about the nature of the certification from those that are not so certified. The crux of the certifying function, and thus certification marks, is not the provision of truthful and objective information. This thesis demonstrates that the certifying function is best conceptualised as a vehicle for relational trust, and not the provision of truth. I conclude that rather than reform certification marks to better centre the certifying function as a vehicle for trust, we ought to abolish certification marks. Instead, ordinary trademarks can better perform the certifying function. This approach is more congruent with the justifications of trademark law and consistent with current marketplace meaning as informed by brands.

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TABLE OF ABBREVIATIONS

37 CFR	: 37 Code of Federal Regulations (US)
BBFC	: British Board of Film Classification
BSI	: British Standards Institution
CIPO	: Canadian Intellectual Property Office
CSR	: Corporate Social Responsibility
CJEU	: Court of Justice of the European Union
EC CTM Regulation 207/2009	: Council Regulation (EC) 207/2009 of 26 February 2009 on the community trade mark [2009] OJ L78/1
EC Regulation 2015/2424	: Council Regulation 2015/2424 of the European Parliament and the Council of 16 December 2015 amending Council Regulation (EC) No 207/2009 on the Community trade mark [etc] [2015] OJ L 341/21
EC EUTM Regulation 2017/1001	: Council Regulation (EC) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark [2017] OJ L154/1
EC	: European Commission
EUIPO	: European Union Intellectual Property Office
EU	: European Union
GMO	: Genetically modified organism
ISO	: International Organization for Standardization
INTA	: International Trademark Association
15 USC	: Lanham (Trademarks) Act, 15 USC §§ 1051 *et seq* (US)
MSC	: Marine Stewardship Council
OHIM	: Office for Harmonization in the International Market
TMA 1994	: Trade Marks Act 1994 (UK)

Trademarks Act	: Trademarks Act, RSC 1985 c T-13 (Canada)
UK	: United Kingdom
UK IPO	: United Kingdom Intellectual Property Office
UL	: UL Solutions (formerly Underwriters Laboratories)
US	: United States
USB	: Universal Serial Bus
WIPO	: World Intellectual Property Organization

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I. INTRODUCTION

This thesis examines a niche area of intellectual property law– certification mark law. Once described as 'shy beasts' in the trademark law ecosystem, certification marks are not frequently found in the spotlight of trademark law scholarship.[1] Certification marks are typically creatures of trademark statute, a special type of trademark that is envisioned as the outward facing sign of a certification regime or a certifier.[2] Certification marks are forms of private property, granted to applicants that meet the statutory requirements. Certification mark owners then, in turn, allow the use of their mark by other traders that meet their designated standards.[3] In short, this allows consumers to identify whether a product is certified to have a particular attribute or meet a given standard, as determined by the mark owner, at a glance.[4] Certification marks themselves are, therefore, a site of different social, political, and legal agendas.

Certification marks as legal objects play an important role in private governance regimes.[5] Certification marks are referred to in the private governance space as 'logos or

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[1] Dev Gangjee, 'The Business End of Collective and Certification Marks' in Ilanah Simon Fhima (ed), Trademark Law and Sharing Names: Exploring Use of the Same Mark by Multiple Undertaking (Edward Elgar Publishing Limited 2009) 79. Although it is worth noting that this observation was made in the context of the European trademark law ecosystem specifically, and prior to the introduction of a European Union certification mark.

[2] I use the term 'trademark' and not the traditional United Kingdom spelling 'trade mark' for reasons discussed below, see (n 37). I only use the disjunctive form where directly quoting from a source that does the same.

[3] Throughout this thesis, I at times use the word 'products' to collectively refer to goods or services.

[4] By 'consumers' I am referring to the end-users of products. While certification marks are also relied on as regulatory marks for specialised industries, my interest here lies in the average consumer in a retail scenario.

[5] Graeme Auld, Constructing Private Governance: The Rise and Evolution of Forest, Coffee, and Fisheries Certification (Yale University Press 2014); Hamish Van Der Ven, Beyond Greenwash: Explaining Credibility in Transnational Eco-Labeling (Oxford University Press 2019); Graeme Auld, Steven

labels that can be used on products sold to end consumers' to communicate the nature of a product and its conformity with developed standards.[6] The conventional account of certification marks, therefore, is that they can offer certainty to consumers about the characteristics of the products they are buying. This is of particular importance where the qualities or characteristics desired by consumers are difficult or impossible to discern on their own.[7] This is often the case where the characteristics desired by consumers are pertaining to process attributes or attributes of rectitude.[8]

Process and rectitude-oriented attributes are increasingly of value to consumers. Business and political science research has identified an escalating interest in, for example, products that are marketed as ethical and sustainable. *The Guardian* newspaper in 2019 published an article finding that total ethical spending had risen almost fourfold in the past two decades.[9] Similarly, a study done by NYU Stern's Centre for Sustainable Business found that 'products marketed as sustainable grew 5.6 times faster than those that were not.'[10] As a political issue, this collective interest in purchasing ethical products and

Bernstein and Benjamin Cashore, 'The New Corporate Social Responsibility' (2008) 33 Annual Review of Environment and Resources 413.

[6] Certification marks are considered one of the four 'key features' of certification programs, see: Auld (n 5) 4.

[7] Such attributes are termed by economists as 'credence attributes' discussed further in Chapter 2:

Phillip Nelson, 'Information and Consumer Behavior' (1970) 78 Journal of Political Economics 311; Michael R Darby and Edi Karni, 'Free Competition and the Optimal Amount of Fraud' (1973) 16 Journal of Law and Economics 67.

[8] Douglas A Kysar, 'Preferences for Processes: The Process/Product Distinction and the Regulation of Consumer Choice' (2004) 118 Harvard Law Review 525; Margaret Chon, 'Marks of Rectitude' (2009) 77 Fordham Law Review 101.

[9] Rebecca Smithers, 'UK Ethical Consumer Spending Hits Record High, Report Shows' The Guardian (30 December 2019).

[10] Tensie Whelan and Randi Kronthal-Sacco, 'Research: Actually, Consumers Do Buy Sustainable Products' Harvard Business Review (19 June 2019).

promoting socially responsible corporate activity matters.[11] That is, 'when it comes to socially conscious consumption, private benefits and public benefits are homologous.'[12]

Corporations, and other entities, have noted this rising consumer interest in socially responsible corporate activities and undertakings.[13] In a 2019 survey, the Brands for a Better Society Presidential Task Force, created by the International Trademark Association (INTA), found Corporate Social Responsibility (CSR) policies are frequently shared and that CSR obligations are thought of as generally beneficial social obligations, both economically and otherwise.[14] Companies who achieve an ethical practice while producing high quality products, like BEN & JERRY's ice cream and the American grocery store chain TRADER JOE'S, are rewarded with fierce consumer loyalty.[15] It is therefore not surprising that companies are seeking ways to communicate, and assure, their potential customers of their various virtues. Considering this increased interest in marketplace transparency for products with specific and desired qualities, it makes sense to turn to certification marks.[16] Certification marks can indeed be a way to communicate the characteristics of products, particularly those encompassed within ethical and sustainable standards, to consumers.

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[11] Graham Bullock and Hamish van der Ven, 'The Shadow of the Consumer: Analyzing the Importance of Consumers to the Uptake and Sophistication of Ratings, Certifications, and Eco-Labels' (2020) 33 Organization & Environment 75.

[12] Lucy Atkinson, 'Buying In to Social Change: How Private Consumption Choices Engender Concern for the Collective' (2012) 644 The Annals of the American Academy of Political and Social Science 191.

[13] Including small and medium enterprises, law firms, service firms, and non-profit organisations.

[14] 2019 Presidential Task Force, International Trademark Association, 'Brands and CSR Survey Report' (2020) INTA Research.

[15] Fran Hawthorne, Ethical Chic: The inside Story of the Companies We Think We Love (Beacon Press 2012) x.

[16] These qualities include both product and process related information, see: Kysar (n 8).

Many things have changed since the turn of the 20th century when certification marks were first introduced into the trademark law landscape in various countries.[17] One such change is the nature of products and processes. Manufacturing processes have become more complex. Global product standards have become more opaque. The myriad of qualities consumers are now interested in has grown from attributes of the products themselves, such as quality standards for safety and interoperability, to more vague and ill-defined standards on the ethical practices under which products are created.[18] While there is a social benefit for this appetite for CSR and sustainable quality goods, the average consumer is not always a rational one. The list of ethical characteristics consumers care about is ever growing, diverse, and nearly impossible to obtain concurrently:

> In this age of consumer activism, pinpoint marketing, and unlimited and immediate information, we want the impossible: products and producers that will assure us that we are fashionable, and that don't pollute, harm animals, or contain weird chemicals, that run on alternative energy, pay their workers good salaries, recycle their scraps, use natural ingredients, buy from local suppliers, donate generously to charity, donate in particular to their neighbourhoods, and don't throw their weight around by lobbying. (Or maybe they should lobby for the right causes?) Why should we pay good money for something that will make us look nerdy, or that will poison the Earth? We don't think we're being overly demanding. All we're asking for are the kinds of policies we try to follow in our own daily lives, and if we

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[17] Norma Dawson, Certification Trade Marks: Law and Practice (Intellectual Property Publishing Limited 1988); DM Phelps, 'Certification Marks under the Lanham Act' (1949) 13 Journal of Marketing 498.

This does not include the European Union, which created a community certification mark in 2017, relatively recently. Moreover, the United States, which some argue has the right to an unregistered common law certification mark, see: Michelle Smit, '(Un)Common Law Protection of Certification Marks' (2017) 93 Notre Dame Law Review 419.

[18] Michael E Conroy, Branded! How the 'Certification Revolution' Is Transforming Global Corporations (New Society Publishers 2007).

> can manage to recycle and avoid animal products, then certainly big companies, with all their clout, can do likewise.[19]

To today's consumers, the quality and desirability of a brand is not simply about the quality of their products, but also considers the integrity and morality of the production. Given consumer interest in the integrity of a product—liberally construed (eg its attributes of rectitude and the political leanings of the brand)—communicating the nature of a product is more complicated.[20]

For one, there is a question of how *much* information consumers ought to know, or think they need to know to make purchasing decisions. What does it mean to communicate environmental preferability, for example? Do you need to understand the science of ecosystems to appreciate how the manufacturing of a product impacts the environment? Do you need to know what the alternative options were to determine whether the best choices were made? How was the product exported and transported through the supply chain? What about the environmental effects of using a product, or of disposing of any remaining parts? Raising these questions for every product one wants to buy creates the Sisyphus of informed consumerism.

This is to say nothing about how well a consumer wants to *understand* this information. This alone would be a complicated enough issue, but since the turn of the 20th century the nature of meaning has also changed. Truthful information no longer has the impact it once did. In what has been termed by some as a 'post-truth era', objective facts

[19] Hawthorne (n 15) x.

[20] 'Grab Your Wallet: When Brands Go Political', Under the Influence (24 August 2017).

are less impactful or influential than appeals to belief and emotion.[21] Whether a brand touting its love for the environment acts in environmentally preferable ways may be secondary to whether consumers *feel* like they are being environmentally conscious when they purchase it. This market shift is occurring in parallel to a long-standing development in trademark law towards recognising the role of brands in the information signalled by trademarks. These developments have a bearing on the use and practice of certification marks, how they are conceptualised as legal objects, and the laws that govern them. While the world has changed, the legal conception of certification marks has not.[22]

Certification marks and the laws that govern them remain an undertreated area of trademark law scholarship. Subject to notable exceptions, few scholars have discussed them.[23] Certification marks make only but a brief appearance in most intellectual property and trademark law textbooks.[24] Given that certification marks are generally

[21] Lee McIntyre, Post-Truth (The MIT Press 2018) 5.

[22] That is not to say that new certification mark legal regimes have not been constructed. The European Union created its first certification mark, the European Union Certification Mark in 2017. See: European Union Intellectual Property Office, 'Certification and Collective Marks' (European Union Intellectual Property Office: Trade marks basics, 4 August 2017) <https://euipo.europa.eu/ohimportal/en/web/guest/search/-/journal_content/56/10162/3732528/certification-marks> accessed 2 March 2021.

[23] Jeffrey Belson, Certification and Collective Marks: Law and Practice (2nd edn, Edward Elgar Publishing Limited 2017); Margaret Chon, 'Marks and More(s): Certification in Global Value Chains' in Irene Calboli and Edward Lee (eds), Trademark Protection and Territoriality Challenges in a Global Economy (Edward Elgar Publishing Limited 2014); Dawson (n 17); Jeanne C Fromer, 'The Unregulated Certification Mark(Et)' (2017) 69 Stanford Law Review 121; Gangjee (n 1).

[24] For instance, David Vaver's text on Canadian trademark law has less than three pages dedicated to the discussion of certification marks. Similarly, the leading UK intellectual property text has less than three pages dedicated to certification and collective marks: David Vaver, Intellectual Property Law (2nd edn, Irwin Law 2011); Lionel Bently and others, Intellectual Property Law (5th edn, Oxford University Press 2018).

underdiscussed, it is of no surprise that the issues that are pressing in the trademark law scholarship have been all but entirely absent in the certification mark law literature.[25]

This may be because of the relatively 'low' number of certification marks that exist on trademark registries. As observed by Jeremy Philips, as compared to trademarks there are comparatively few certification marks registered, and those that exist 'cast almost no shadow.'[26] While this observation was made two decades ago, it remains true today. For one, few active certification marks are registered compared to their ordinary trademark counterparts:[27]

> Certification marks, in one form or another, have been registrable in the United Kingdom and other countries for more than 100 years. However, relatively few certification marks are added to the registrar each year.[28]

In the United Kingdom (UK) as of January 2020, for instance, there were only 420 total active certification marks registered in the UK.[29] This is compared to over 95,000 successful trademark registrations in the UK in 2019 alone.[30] It is therefore not surprising

[25] For instance, there is a rigorous discussion in the trademark law literature on a trademark's functions, see: Annette Kur, 'Trademarks Function, Don't They? CJEU Jurisprudence and Unfair Competition Practices' (2014) 45 International Review of Intellectual Property and Competition Law; Luis H Porangaba, 'A Contextual Account of the Trade Mark Functions Theory' (2018) 3 Intellectual Property Quarterly 230; Martin Senftleben, 'Function Theory and International Exhaustion: Why It Is Wise to Confine the Double Identity Rule in EU Trade Mark Law to Cases Affecting the Origin Function' (2014) 36 European Intellectual Property Review 518. I am unaware of any equivalent literature pertaining to the functions of certification marks.

[26] Jeremy Phillips, Trademark Law: A Practical Anatomy (Oxford University Press 2003).

[27] I use the term 'ordinary trademark' here and throughout the thesis to refer to marks that serve to distinguish the goods and services from one undertaking from that of another, sometimes referred to as individual trademarks.

[28] Jeffrey Belson, Certification and Collective Marks: Law and Practice (2nd edn, Edward Elgar Publishing Limited 2017) s 1.01.

[29] As of 30 January 2020 there were 424 certification marks registered in the UK: Email from IPO to author (30 January 2020).

[30] UK Intellectual Property Office, 'Facts and Figures: Patent, Trade Mark, Design and Hearing Data: 2019' (Intellectual Property Office: Official Statistics, 2 June 2020) <https://www.gov.uk/government/statistics/facts-and-figures-patent-trade-mark-design-and-

that there is very little litigation involving certification marks as compared to ordinary trademarks. Thus, any tensions that exist with respect to certification marks are not readily identifiable in jurisprudence, such as a line of case law with inconsistent applications of similar rules.[31]

Because certification marks have flown below the academic radar, there has not been sufficient discussion of whether certification marks are operating in practice in a manner consistent with the legal conception of certification marks as articulated by trademark law statues, such as the UK's Trade Marks Act 1994 and other comparable legislation.[32] Nor has there been sufficient consideration of whether the ways in which the protection of trademarks, as exclusionary forms of private property, can be used to properly justify the existence of certification marks.[33]

Thus, while the traditional story of certification marks is seemingly straightforward, the reality is not. Certification marks are marked by a series of incongruities. While the leading certification mark scholar, Jeffrey Belson, has called certification marks 'underutilized,' the European Union recently introduced new legislation to create EU certification marks.[34] Likewise, despite the ways in which certification marks are regulated

hearing-data-2019/facts-and-figures-patent-trade-mark-design-and-hearing-data-2019#trade-marks> accessed 2 August 2021.

[31] Although this may be beginning to change, as discussed further in Chapter 7.

[32] The jurisdictional coverage of this work is discussed further below, see (n 36). This is one of the primary focuses of Chapter 2.

[33] I explore the normative dimensions of this further in Chapter 7.

[34] Belson (n 28) s 1.02. See also Belson's comments that one of the motivation for his treatise on certification and collective marks is to address the under-utilization of these marks:

'It is hoped that this contextual approach will assist lawyers and policy-makers in considering the pros and cons of certification and collective mark law reform. Such consideration is needed, if only to remedy the under-utilization of the registered certification mark system. The certification and collective mark systems yield relatively few registrations each year. These marks are highly beneficial to as distinct from ordinary trademarks, certification marks are not the only kind of marks that act as the public facing aspect of certification regimes.[35] Perhaps the most significant incongruity of the certification mark regime is the way we conceptualise them as forms of private property yet ask them to convey the quality of a product in the public interest.

This thesis interrogates the reality of certification marks in practice and argues how this reality is misaligned with the legal conception of certification marks as they are currently projected by trademark law statutes and the conventional scholarly account of certification mark law. My central argument is that if we properly appreciate how the essential function of certification marks—the certifying function—operates, then we will see that a more apt way to understand certification marks are as signs which command trust, and not the provision of truthful information. Accordingly, I argue that the certifying function is best understood as signalling an attestation source. By identifying an attestation source, consumers may evaluate the trustworthiness of the embodied brand and decide whether they trust that a product has their desired attribute. Once the certifying function is conceptualised in this way, I suggest that the optimal way to reform certification marks is to better centre the certifying function as a vehicle for trust. Rather than reform certification

industry, regulators and the purchasing public alike, and it is time to seek ways for them to be exploited by a wider constituency of potential proprietors and users.'

To claim that a particular property regime is 'under-utilized' is, necessarily, a value laden statement as it refers to a deviation from an expected norm. I have not found any work that suggests there has been a change in the number of certification marks applied for or registered. Similarly, given the different nature of certification marks and trademarks, comparing their registration rates is not terribly insightful. There is no known optimal correlation, or rather any known basis, to draw a correlation between the number of registered trademarks to certification marks. Rather, all that can be said from an anecdotal empirical perspective is there are not 'many' certification marks registered.

[35] This will be discussed further in Chapter 5 where I observe that ordinary trademarks are used by third-party certifiers to perform a certifying function.

marks, I argue we abolish them and allow ordinary trademarks to perform the certifying function and develop trademark law to protect this central function.

Before setting out how I explicate this central argument through the next seven chapters, it is important to make a note about jurisdiction and acknowledge the limitations of this work. First, this is not a comparative legal project. While I acknowledge that the nature of certification marks varies by jurisdictions, in this work I focus on doctrinal and theoretical concepts that evade important jurisdictions. Nevertheless, this project seeks to draw on real-world examples and observations, to challenge pre-conceived ideas about the legal nature of certification marks. Given the limited certification mark case law and scholarship from the United Kingdom, a larger jurisdictional pool was required. Accordingly, throughout this thesis I draw on four jurisdictions: the United Kingdom, European Union, Canada, and the United States. As set out in Chapter 2, I define certification marks in reference to these jurisdictions in a functional sense, such that I consider the aspects of certification marks commonly shared among these jurisdictions. Where the jurisdictional variations in statute are relevant, I have sought to note them. I chose these four jurisdictions as they are all commercially important jurisdictions composed of Western countries and thus a certain degree of shared culture.[36] Furthermore, these four jurisdictions represent a mix of legal regimes with roots in both civil law and common law, as well as a mix of use-based and registration-based trademark regimes.[37]

[36] I intentionally excluded Australia from this jurisdictional pool as the involvement of the Australian Competition and Consumer Commission in the registration of certification marks is too significant a departure from the governance of certification marks of the other selected jurisdictions. I do however, at times, use Australia as a contrasting example.

[37] Given my use of a range of jurisdictions, I have decided to use the North American spelling of trademark, rather than the British and European 'trade mark' as this is the preferred spelling of the international community – exemplified by the World Intellectual Property Organization's use of the non-

Second, the primary focus of this work is not law reform. While I consider the implications of my analysis, and accordingly, reforms that flow from it, that is not the focus of this work. My proposal for reform, while capable of being enacted in the jurisdictions I have selected, would differ in its precise implementation across jurisdictions. Accordingly, my proposed legal reforms remain intentionally high-level and non-jurisdictional.

Third, while I draw on several real-world examples throughout this thesis, particularly as illustrative examples to ground observations I make, this work does not seek to provide an empirical analysis into certification marks. I draw on examples to provide context and to concretise my arguments, rather than let these examples motivate and drive my arguments. Last, this thesis squarely, and rather exclusively, considers certification marks and no other form of collective marks. While I appreciate my analysis and conclusions may have implications for other areas of trademark law, such as collective marks and geographical indications, I do not address these issues here.

My thesis proceeds as follows. In Chapter 2, I ask what is the state of affairs of certification mark law? I answer this by setting out the conventional account of certification marks. My aim in this chapter is to describe the nature of certification marks as they are currently constructed, as a starting point for my analysis. I explain how certification marks are treated by trademark statues as a special kind of trademark. Furthermore, I identify and explore the essential function of certification marks—what I term the *certifying function*. In investigating the certifying function, this chapter sets out a positivistic account of

disjunctive spelling. WIPO World Intellectual Property Organization, 'Trademarks' (*WIPO: About IP*) <https://www.wipo.int/trademarks/en/> accessed 2 May 2022.

certification marks and some of the limits of the certifying function as currently understood.

In Chapter 3, I build on the account of certification marks set out in Chapter 2 and I identify the problems with certification marks. In this chapter I ask in what ways are certification marks not performing as expected? I argue that because of a changing world, and a not-so changed legal understanding of certification marks, certification mark law is riddled with drawbacks and disadvantages. I take stock of the nature of certification marks in today's context and argue that there are three discrete but interrelated classes of problems with certification marks both as legal objects and as parts of legal and extra-legal institutions. Identifying these problems sets the groundwork for me to then consider the incongruity between the legal conception of certification marks as currently understood and how they ought to be more aptly conceived.

Before more deeply considering how the certifying function conveys meaning, in Chapter 4 I pause to consider one of the most significant drivers in how trademarks convey meaning—brands. This chapter is motivated by the deceptively simple question, what is a brand? Given the role that brands play in trademark law discourse and scholarship, analysing the role of brands is essential to considering the nature of the certifying function without acknowledging the role of brands. In this chapter, I seek to identify the ontological relationship between trademarks and brands. While it is difficult to discern a singular definition of a brand from the trademark law scholarship, I suggest that even without identifying the exact internal structure of a brand, or delineating a precise definition, we can identify certain hallmarks of a brand. These hallmarks help to delineate the outer boundaries and perimeters of brands. I argue that the ontological nature of brands vis-à-vis trademarks is such that they are distinct but related objects. I posit that a trademark is not the brand itself, but rather trademarks sustain brands. In explicating this relationship, I suggest that trademarks can both *evoke* and *embody* brands – terms I define in this chapter.

In Chapter 5 I seek to answer the question, how does the certifying function as an *institution* fit within a more general practice of marketplace meaning and within a more general practice of marks? In answering this question, I provide a greater context in which the certifying function exists in two respects. First, I consider how the meaning of a certifying function is embedded within a greater brand meaning. Second, I identify a practice by which the certifying function is performed by ordinary trademarks and not certification marks alone. In discussing this phenomenon, I introduce the term *attestation mark* to refer to any mark which performs a certifying function irrespective of how it is registered and regulated. This chapter challenges some conceptions regarding how certification marks and trademarks occupy different roles in the trademark law landscape.

In Chapter 6, I turn to critically consider the nature of the certifying function. In this chapter I ask, how is the certifying function best conceptualised? In answering this question, I draw on some philosophical and sociological theory on trust and trustworthiness and argue that what is crucial to the functioning of certification marks is trust, not the provision of objective, specific, and truthful information. I suggest that contrary to conventional accounts discussed in Chapter 2, the essential function of certification marks is a mechanism of commanding relational trust rather than communicating truthful, objective, and specific information. The corollary of this analysis is what motivates the next, and last, substantive chapter.

In Chapter 7, I ask how do we reform certification mark law in recognition of this core and critical aspect of the certifying function? Here, I suggest that the institution of certification marks is, in many respects, stale and in need of modernising. Rather than argue certification mark law regimes be reformed to make certification marks more robust, I make a more radical proposal. Building on my arguments in Chapter 6, that the certifying function is best understood as serving as a vehicle for trust, I suggest we abolish certification marks, and support ordinary trademarks in performing a certifying function and allow trademark law to protect this function. In setting out this argument, I argue that trademarks and trademark law can both accommodate the certifying function. I further explain why there is a normative case for centring trust over truth with respect to the certifying function. I explain how my proposal ameliorates some of the problems with certification marks as set out in Chapter 3. Finally, I conclude this chapter by considering the limitations and drawbacks of my proposal, particularly with respect to competition and consumer deception concerns. In Chapter 8 I briefly conclude.

Overall, this thesis interrogates the nature of certification marks and its essential function – the certifying function. At its core, I address how can we best understand the certifying function and how trademark law ought to be reformed to support this new conceptualisation, particularly within the context of brands and brand meaning.

II. The (Status Quo) Nature of Certification Marks

2.1 Introduction

Certification marks are legal objects, subject to private property rights and governed as a subset of trademarks. They are intended to signal the nature of a goods or service with respect to a specified characteristic or attribute. In this chapter, I ask what is the state of affairs with respect to the nature of certification marks and certification mark law? To answer this, I set out the conventional account of certification marks. I delineate the nature of certification marks as a special kind of trademark, and in particular, the essential function of certification marks, what I term the *certifying function*.

This chapter begins in section 2.2 by defining certification marks. I do so by identifying the core aspects of certification marks that exist across jurisdictions, using a *functional account* of certification marks.[1] That is, by identifying the aspects of a certification mark that are core to its existence. Through this discussion, I pay particular attention to the ways in which certification marks are positioned vis-à-vis ordinary trademarks. Next, in section 2.3, I turn to consider the essential function of certification marks, the *certifying function*. I explain how under the conventional account a properly

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[1] I draw on Norman Siebrasse's concept of a functional definition:

> 'I consider the defining functional characteristics of a doctrine to be those characteristics which are necessary to the doctrine's purpose.... The defining functional characteristics do not fully characterize a doctrine. Defining characteristics capture only those aspects of a doctrine that are so fundamental as to distinguish it from other doctrines. There will typically be many other ancillary characteristics that are necessary to fully describe a doctrine.'

Norman Siebrasse, 'Form and Function in the Law of Utility: A Reply to Gold & Shortt' (2015) 30 Canadian Intellectual Property Review 109.

realised certifying function allows a consumer to discern the nature of a product even where they cannot detect their desired characteristic by seeing or experiencing the product. Lastly in section 2.4, I put forward an account of how the certifying function is manifested in practice by identifying a spectrum of certification marks from bare to robust.

2.2 Defining certification marks

Certification marks are used to denote that a product bearing it has been certified with respect to a given characteristic, such as material, mode of manufacture of goods or performance of services, quality, accuracy, and in some jurisdictions, geographical origin.[2] Certification marks are generally intended to occupy a specific role in the trademark law ecosystem.[3]

Certification marks signal the attestation of a *what* or *how* of a product by conveying a characteristic such as the quality, mode of production, material, etc. That is, a certification mark tells a consumer *what* a product is, such as certified kosher or halal certified, or *how* the product was produced, such as by organic farming or fair-trade production.[4] In contrast, trademarks express the *who* of a product, the trader or what trademark law terms the 'source' with whom the product is associated. The core function

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[2] Although not, notably, in the EU. The EU has a separate *sui generis* geographical indications regime: European Commission, 'Geographical Indications and Quality Schemes Explained' (*European Commission: Agriculture and rural development*, 1 February 2022) <https://agriculture.ec.europa.eu/farming/geographical-indications-and-quality-schemes/geographical-indications-and-quality-schemes-explained_en#geographicalindications> accessed 3 May 2022.

[3] My discussion pertains to the jurisdictions of interest here, that is the UK, EU, US, and Canada, see discussion in Chapter 1.

[4] Consumer marketing research has found that consumers consider certification marks to be credible sources of information regarding a product, for example: Francisco Montoro Rios and others, 'Improving Attitudes Toward Brands with Environmental Associations: An Experimental Approach' (2006) 23 Journal of Consumer Marketing 26.

of a certification mark, therefore, is an expression of quality—that a given product has been certified for a given characteristic. As put by Belson:

> Whereas ordinary trademarks serve to distinguish the goods or services of one individual source from another, certification marks have a different significance. Certification marks are principally indicia of conformity of goods or services to particular standards, stipulated by the proprietor of the mark. Such marks are for the use of multiple sources, which may not necessarily be individual sources, provided that their goods or services meet the proprietor's required standard.[5]

A certification mark does not communicate the source of the product in the classical trademark sense.[6]

Certification marks are a niche area of intellectual property law. As I highlighted in Chapter 1, drawing from a single jurisdiction, namely the United Kingdom, raises significant challenges given the scarce amount of legal treatment on certification marks as well as the number of certification marks that have been registered.[7] As a result, I seek to consider certification marks as they exist as legal objects in a way that is common to the jurisdictions of interest here, that is, the United Kingdom, European Union, United States, and Canada. To do this, rather than focus on a single jurisdiction I draw on what I consider a *functional definition* of certification marks. This definition, while rooted in statutes, transcends the regulatory nuances that differ across the jurisdictions of relevance.[8]

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[5] Jeffrey Belson, *Certification and Collective Marks: Law and Practice* (2nd edn, Edward Elgar Publishing Limited 2017) para 3.05.

[6] In classic trademark doctrine, 'source' refers to a mark's ability to distinguish the products of one undertaking from those of another.

[7] As discussed in Chapter 1, as of 30 January 2020 there were 424 certification marks registered in the UK: Email from IPO to author (30 January 2020).

[8] Trademarks Act (Canada); EC EUTM Regulation 2017/1001 (EU); TMA 1994 (UK); 15 USC §§ 1051 *et seq* (US).

A functional approach has the following advantages. By focusing on the aspects of certification marks that are fundamental to it, this definition allows for easy comparison to other marks, such as ordinary trademarks. This is beneficial, as it will better position certification marks in the greater trademark law landscape. Further, by looking to the defining characteristics of these marks, the limitations that arise from the untethered jurisdictional nature of this project can be ameliorated. A functional definition is not rooted in the minutia of any single jurisdiction's legislation, and thus, I provide a definition that is both grounded in statute while transcending its jurisdictional limits.

Functionally, certification marks distinguish goods and services which are certified to a defined standard from those that are not.[9] Certification marks are conceived of being able to certify a range of characteristics including material, mode of manufacture, quality, and accuracy.[10] Perhaps most importantly, because certification marks are required to distinguish between certified goods and services and those that are not, it is on this basis that they must be distinctive, and not with respect to the source of goods and services.

Certification marks are indeed treated as a specific kind of trademark. They are regulated by trademark statutes and the majority of the rules that apply to trademarks likewise apply to certification marks, with some deviation.[11] The same requirements for

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[9] Trademarks Act, s 2 (Canada); EC EUTM Regulation 2017/1001, art 83 (EU); TMA 1994, s 50(1) (UK); 15 USC § 45 (US).

[10] ibid. In Canada, United States, and United Kingdom, 'origin' is a type of characteristic that can be certified by a certification mark. In the EU, however, origin is excluded as a possible characteristic, undoubtedly because of the European Union's geographical indications regime.

[11] Trademarks Act, s 2 (Canada); EC EUTM Regulation 2017/1001, art 83 (EU); TMA 1994, s 1(2) (UK); 15 USC § 45 (US). For instance, the Canadian Trademarks Opposition Board held that because the statutory definition of a trademark includes certification mark 'it seems reasonable to apply all sections that deal with trade-marks to certification marks, unless specifically contradictory to sections 23-25.' See: *Maple Leaf Foods Inc v Consorzio del Prosciutto di Parma*, 2012 TMOB 249 [30] (Trademarks Opposition Board of Canada).

ordinary trademarks apply to certification marks with respect to their requirements as a sign.[12] Accordingly, certification marks are not statutorily required to identify themselves as certification marks, nor are they required to incorporate into their sign a reference to the characteristic or standard certified.[13] Despite their treatment as a subset of trademarks, certification marks are subject to rules and regulations particular to them.[14]

Even though certification marks are regulated as a form of trademark, they are functionally distinct in the following two ways. First, there are additional requirements to register certification marks.[15] To register a certification mark, the applicant must include a document or statement setting out the 'standards' or 'regulations' defining the standard being certified.[16] Second, certification mark owners are limited in a way ordinary

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[12] 15 USC § 45 (US).

[13] In some jurisdictions there are statutory requirements certification marks are not *misleading* with respect to their nature, see for example: TMA 1994, Sch 2 para 5 (UK); EC EUTM Reg, art 85 (EU).

[14] Trademarks Act, ss 23-25 (Canada); EC EUTM Regulation 2017/1001, s 2 (EU); TMA 1994, Sch 2 (UK); 15 USC § 4, 14(5) (US).

[15] Focusing on the core features that exist across jurisdictions means that I am not delving into other requirements, that differ across these jurisdictions, such as whether a certification mark owner is 'competent to certify': TMA 1994, Sch 2 para 7(1)(b) (UK).

[16] The Canadian and American statutes require 'standards' and the British and EU statutes require 'regulations' see: Trademarks Act, s 30(2)(b) (Canada); EC EUTM Regulation 2017/1001, art 84 (EU); TMA 1994 Sch 2 para 6 (UK); 37 Code of Federal Regulations (CFR) §2.45 (US).

Some jurisdictions require more information to be provided regarding the operation of the certification mark than others, in Canada, for instance, the Trade-Marks Opposition Board has held as follows:

'In my view, the unambiguous language of Section 30(f), as well as the scheme of the Act as a whole, requires an application for a certification mark to set out the particulars of the defined standard in a meaningful way. Firstly, the definition of a certification mark, found in Section 2 of the Act, itemizes the aspects of the wares and or services to which the defined standard may apply. Secondly, Section 41(1) permits the owner of a certification mark to update the particulars of the defined standard [for a fee of $25.] in the same way that owners of registered marks may enter a change of address. It would not be imposing too onerous a burden on an applicant to furnish a meaningful "defined standard" when the certification mark application is initially filed or to update the defined standard as the need arises. Further, easy access to the standard which a certification mark symbolizes would appear to be in the public interest. Presumably, the particulars of the defined standard need not be set out in its entirety in the trade-mark application as long as reference is made to the titles of published manuals, or the like, where the standard may be found. Of course, each case is different and must be dealt with differently to ascertain whether or not a certification mark trademark owners are not—they cannot carry on in the business of goods and services the certification mark is used for.[17] This difference is particularly significant:

> A principle fundamental to the concept of a certification mark in most but not all Anglo-American jurisdictions, and others as well, is that the owner of the certification mark is precluded from using the mark for the certified goods or services where covered. This principle derives from the notion that it would not be in the public interest for a non-independent person, that is a person carrying on a trade in the goods or services certified, to act as a certifier.[18]

By bifurcating who can own and who can use a certification mark, this separates the certification of the product from the source of the product. This becomes pertinent as we consider the different competition concerns engaged by certification marks as compared to trademarks.[19]

For example, one of the predominant competition concerns for ordinary trademarks is that granting a monopolistic right to a trademark should not correspondingly grant a monopolistic right to sell the underlying product. To this effect, there are various legislative and doctrinal mechanisms to minimise and limit this competition concern. For instance, trademark owners cannot register descriptive terms (unless they have acquired a secondary and distinctive meaning in the market), and other competitors are entitled to make fair use of trademark protected terms where doing so is necessary to describe their product.[20] The competition concerns arising from the use of certification marks are different.

application contains a meaningful standard.' *Molson Breweries, A Partnership v Labatt Brewing Co Ltd*, [1996] TMOB No 90, 69 CPR (3d) 274 [30] (Trademarks Opposition Board of Canada).

[17] Trademarks Act, s 23(1) (Canada); EC EUTM Regulation 2017/1001, art 83(2) (EU); TMA 1994, Sch 2 para 4 (UK); 15 USC § 1064(5) (US).

[18] Belson (n 5) s 3.81.

[19] As discussion in Chapter 7, section 7.5.2(b).

[20] See for example: TMA 1994, ss 3(1), 11(2) (UK).

Because certification marks are not used by their owners, they do not signal the source of a particular product. They do, however, signal that a product is attested to having some characteristic. So, while a certification mark would not be used as a mark to signal a brand of coffee, for example, a certification mark would be used to signal the brands of coffee which are produced to meet a specific environmental standard or have a given characteristic, such as made of organically farmed beans. The corollary is that certification marks can be used to attest to a standard or characteristic that carry great market force. This market power can be leveraged for certain abusive, anti-competitive, or at the very least, concerning behaviours.[21] While this explains the differences between certification marks and ordinary trademarks, particularly with respect to additional requirements and registration and limitations on use, certification marks are still capable of misuse and abuse.[22]

2.3 Certifying function as the essential function

Trademark law and trademark scholarship posits that the core purpose of a mark is the transmission of information. While several things may follow from this core purpose—such as, minimising consumer confusion, reducing search costs, protecting the investment of a mark, protecting a mark owner's goodwill—the crux of a mark is its transmission of

[21] Jeanne C Fromer, 'The Unregulated Certification Mark(Et)' (2017) 69 Stanford Law Review 121.

[22] This is particularly so as not all jurisdictions have the principle of compulsory licensing or the non-discrimination principle, which is concretized in the American legislation. For instance, 15 USC §1064(5)(d) sets out that a certification mark can be cancelled if at any time the certification mark registrant 'discriminately refuses to certify or to continue to certify the goods or services of any person who maintains the standards or conditions which such mark certifies.' While the British legislation does not mandate this, Belson holds that 'the policy of requiring "open access" to certification marks has been maintained consistently by the registry.' See: Belson (n 5) s 3.84.

information.[23] For a trademark, this central feature is a mark's ability to distinguish the goods or services of one undertaking from other undertakings, that is, the origin function of a mark.[24] Thus even when we consider the other goals or purposes of trademark law, the mark's ability to function as a mark is critical. For instance, when consumer confusion is cited as a relevant consideration for trademark law, the confusion in question is regarding source.

What then is the analogue for a certification mark? The core function of a certification mark is that it certifies. Certification marks communicate whether a product is certified or not; these marks signal certification, not source. This definition has been articulated by various boards, tribunals, and courts across the jurisdictions of interest here. As stated by what is formerly known as the Second Board of Appeal for the Office for Harmonization in the Internal Market (OHIM):

> An individual trade mark is defined by its essential function which is to distinguish the goods or services of one undertaking from those of other undertakings…In this way the trade mark guarantees the identity of the origin of the goods or services to the consumer or end user by enabling him, without any possibility of confusion, to distinguish them from others with another origin….
>
> On the other hand, a certification mark is defined by its <u>essential function</u> which is to <u>certify that the goods or services meet certain established standards and possess particular characteristics</u>….A certification mark performs a guarantee function: guaranteeing that the certified products or services possess a certain quality resulting from their compliance with the defined standards. They also perform a distinctive function: distinguishing

[23] Although what is considered the 'goodwill' of a mark is not an entirely uncontroversial matter, see: Robert G Bone, 'Hunting Goodwill: A History of the Concept of Goodwill in Trademark Law' (2006) 86 Boston University Law Review 547.

[24] See, for example: Case C-10/89 *SA-CNL SUCAL v HAG* [1990] ECR I-3752 [13]; Case C-206/01 *Arsenal Football Club PC v Reed* [2002] ECR I-10273 [48].

> such products and services from competing products not having the certified quality.[25]

This articulation by OHIM has been carried forward by the European Union Intellectual Property Office:

> <u>The specific function of an EU certification mark is to distinguish goods or services which are certified by its proprietor in respect of specific characteristics from goods and services which are not so certified</u> (Article 83(1) EUTMR). In other words, <u>the purpose of the certification mark is to distinguish a particular group of certified goods or services from another group of non-certified but otherwise identical goods or services</u>. Along with this, the certification mark points to all companies that use the sign for certified goods or services. Thus, there is a relationship of competition between companies that (also or exclusively) use the certification mark for certification purposes on the one hand and other companies that offer the same goods or services but without the certification attested by any or the same certification mark on the other hand.[26]

Similarly, in American jurisprudence certification marks have been defined as 'a special sub-category of marks which, unlike other trademarks, is intended to be used by those *other than its* owner, to indicate the quality accuracy, or other characteristics of the goods or service.'[27] Canadian case law understands the function of certification marks similarly:

[25] Case R 87/2010-2 *DVB Project v Palmerston Limited* [25]-[26] (Second Board of Appeal 2011, OHIM) (emphasis added, internal citations omitted).

[26] Case R 1410/2019-5 *Manuka Honey Appellation Society Incorporated* [25] (Fifth Board of Appeal 2021, EU IPO) (emphasis added). See also: Case R 2112/2019-5 *Qualität Gemeinschaft Biomineralwasser e.V* [11], [22] (Fifth Board of Appeal 2021, EU IPO).

[27] *Int'l Info Sys Sec Certification Consortium v Sec Univ, LLC*, 823 F.3d 153 (2d Cir. Conn. 2016)15. See also the 9th Circuit Court's discussion of how certification marks differ from trademarks, in part due to its unique purpose from an ordinary trademark to certify goods or services: *Idaho Potato Comm'n v G&T Terminal Packaging, Inc*, 425 F.3d 708 (9th Cir. Idaho 2005).

> [14] It is defined in section 2 of the Act. Basically it is the mark of persons or associations who examine and certify goods and services as being of a defined standard with respect to quality, produced under defined working conditions by a defined class of persons or in a defined area. It is tantamount to the conferment of a seal of approval and would naturally enhance the sale of a product so identified in accordance with the good repute acquired by the certification mark.
>
> [15] <u>The purpose of the certification mark is to distinguish the wares so marked from those which are not of the defined standard with respect to the matters specified in the definition in section 2</u>.[28]

Likewise, the UK Intellectual Property Office has contrasted the essential function of a certification mark ('to certify the <u>quality of third party goods/services</u>') with the essential function of an ordinary trademark ('to indicate the trade <u>origin of goods/services</u>').[29] This requirement to be distinctive with respect to the underlying standard of a mark, in contrast to the source of a product, is the defining feature within a functional definition of certification marks.[30] As articulated by the Federal Court of Canada:

> It is tantamount to the conferment of a seal of approval and would naturally enhance the sale of a product so identified in accordance with the good repute acquired by the certification mark…. The purpose of the certification mark is to distinguish the wares so marked from those which are not of the

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[28] *Wool Bureau of Canada, Ltd v Queenswear (Canada) Ltd*, [1980] FCJ No 208, 47 CPR (2d) 11 [14]-[15] (Federal Court of Canada) (emphasis added). See also, a more recent articulated by the Canadian Federal Court of Appeal:

> 'The Trade-marks Act, R.S.C. 1985, c. T-13 (the "Act") establishes a specific regime for the adoption and registration of a certification mark by a person who is not engaged in the manufacture, sale, leasing or hiring of the wares or the performance of the services in question, but who wishes to licence others to use the mark in association with wares or services. The purpose of such a certification mark for wares is to distinguish them with respect to their character or quality, the working conditions under which they have been produced, the class of persons by whom they have been produced, or the area within which they have been produced.'

Republic of Cyprus (Commerce and Industry) v International Cheese Council of Canada, 2011 FCA 201 [2] (Federal Court of Appeal of Canada).24/11/2022 20:21:00

[29] *Omega Flex Ltd v British Standards Institution*, BL O/765/18, [2019] RPC 10 [20] (Intellectual Property Office).

[30] For instance, the Canadian Federal Court has defined certification marks as must being able to 'distinguish the wares or services of a defined standard from wares and serves of others.' See: *Ontario Dental Assistants Association v Canadian Dental Association*, 2013 FC 266 [21] (Federal Court of Canada).

defined standard with respect to the matters specified in the definition in section 2.[31]

Acknowledging that a certification mark is intended to certify, however, does not necessarily provide the level of precision needed to answer the question of what a certification mark *ought* to communicate. Knowing that something is intended to certify is, on its own, an amorphous concept. What does it mean for something to be certified? How does certification fit into the prevalent view for the justification of trademarks, the informational efficiency account? These are the kinds of questions asked in trademark law scholarship. As Dev Gangjee has posited:

> While the assumption in economic theory is that these market signals convert credence or experience attributes into search ones (a specialist intermediary has certified that a product has characteristic x which saves consumers the cost of trying to verify it or simply taking it on faith), empirical research suggests that certification signals tend to dissipate in the real world. As opposed to being clear about the precise attributes being certified by such labels, consumers associate them with a swarm of fuzzy associations, may not entirely trust certification, or be overwhelmed by "certification fatigue".[32]

Similarly, Margaret Chon has said the role certification mark owners play has not yet been examined within the informational efficiency view:

> Trademark law to date has focused on what will be called here first-party certifiers, that is, the firm itself that markets a particular brand of good or service, singling source of origin directly to consumers via trademarks. The classic trademark paradigm of first-party certifiers assumes that a firm will act in its own self-interest and maximize quality assurance of its products or services. In this conventional narrative, the role of second-party certifiers (voluntary industry associations or buyer firms in a value chain) or <u>third-party certifiers (independent third-party, nongovernmental standard-setting,</u>

[31] *Wool Bureau of Canada, Ltd v Queenswear (Canada) Ltd*, [1980] FCJ No 208, 47 CPR (2d) 11 [14]-[15] (Federal Court of Canada).

[32] Dev Gangjee, 'Book Review: Jeffrey Belson, Certification and Collective Marks: Law and Practice, 2nd Edn (Edward Elgar 2017) 320 Pp.' (2018) 8 Queen Mary Law Journal.

inspection, assurance, and certification services) in providing quality assurance to consumers has also not been rigorously evaluated.[33]

These open questions form the backdrop of this thesis and are addressed in future chapters.

A review of the informational efficiency view of trademarks, also known as the search cost theory, is instructive in considering the conventional account of certification marks. This view of trademark law holds that trademarks can be used to achieve efficient marketplace communication and that the regulation and protection of trademarks can be justified on this basis.[34] A trademark produces information that helps a consumer reduce search costs, that is, find their desired product in a market with more ease and efficiency than they otherwise would, by communicating the source of the product.[35] For this to occur successfully, a few conditions must be met.[36]

First, a trademark must indicate a consistent source. The search costs theory posits that a trademark, if appropriately protected by law, can signal the kind of information a consumer needs to act efficiently in the market. This requires that a trademark can continue to signal a consistent source of a product over time. It does not matter, under this account,

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[33] Margaret Chon, 'Marks of Rectitude' (2009) 77 Fordham Law Review 101, 105.

[34] William M Landes and Richard A Posner, 'Trademark Law: An Economic Perspective' (1987) 30 The Journal of Law and Economics 265, 269.

[35] ibid 275–6. Landes and Posner also mention a second type of information that may be communicated by the trademark about the productive, and this is information about the product itself. This occurs with trademarks are descriptive in part, and as a result describes properties about a brand.

[36] While this remains the prevalent view of trademarks, it is not without its various criticisms, both scholars who disagree with various premises of this account, but also from scholars that argue this account lacks sufficient normative force to justify the protection of trademarks in any particular way. See, for example: Jonathan Aldred, 'The Economic Rationale of Trade Marks: An Economist's Critique' in Lionel Bently, Jennifer Davis and Jane C Ginsburg (eds), *Trade Marks and Brands: An Interdisciplinary Critique* (Cambridge University Press 2014); Stacey L Dogan and Mark A Lemley, 'A Search-Costs Theory of Limiting Doctrines in Trademark Law' (2007) 97 1223; Mark McKenna, 'The Normative Foundations of Trademark Law' (2007) 82 Notre Dame Law Review 1839.

whether a consumer is aware of the true source of a product. For instance, consider Cathy the consumer. When she goes to the shop to buy some chocolate, trademark law is not concerned with whether she knows that the source of DAIRY MILK is Mondelēz International, or whether it was made in a Canadian factory or a British factory, so long as the consumer does not confuse it with a GALAXY chocolate bar.[37]

Second, a brand must exhibit consistent quality. Trademarks are more helpful where the attribute the consumer is seeking is not a search attribute. That is, it is not an attribute that can merely be searched out on the market prior to purchase.[38] Rather, the consumer's desired attribute is likely an experience or credence attribute:

> The information provided by trade marks is particularly important in relation to goods that a consumer cannot judge merely through inspection (known as 'experience goods'). Where the quality and/or variety of goods is not readily apparent, trade marks enable consumers to choose the product with the desired features.[39]

For a consumer's search costs to successfully be reduced, the consistency in the use of the trademark ought to correspond with a consistency in the desired attribute of the product:

> For this strategy to be efficient, however, not only must it be cheaper to search for the right trademark than for the desired attributes of the good, but also past experience must be a good predictor of the likely outcome of

[37] Although other labelling requirements may require these other types of information be disclosed.

[38] While a premise of the informational efficiency view, one may challenge this claim today in a market where consumers care about more than just the quality of a product (narrowly construed) alone, see discussion in Chapter 1.

[39] Lionel Bently and others, *Intellectual Property Law* (5th edn, Oxford University Press 2018) 816.

> current consumption choices—that is, the brand must exhibit consistent quality.[40]

Third, if the first two premises are satisfied, the consumer can then rely on a trademark, which is communicating source, to act as an *indicator* of quality—a proxy of information. Cathy the consumer can rely on the trademarks she sees in the market to trust that purchasing a product for a second time will result in an analogous experience to her first purchase:

> In short, a trademark conveys information that allows the consumer to say to himself, 'I need not investigate the attributes of the brand I am about to purchase because the trademark is a shorthand way of telling me the attributes are the same of that of the brand I enjoyed earlier.'[41]

Assuming that the desired attribute is in indeed an experience attribute, a consumer would notionally be able to evaluate whether their desired attribute of the product remained consistent over time. This will in turn reduce consumer search costs and creates an incentive for producers to maintain the quality of their product:

> Less obviously, a firm's incentive to invest resources in developing and maintaining (as through advertising) a strong mark depends on its ability to maintain consistent product quality. In other words, trademarks have a self-enforcing feature. They are valuable because they denote consistent quality, and a firm has an incentive to develop a trademark only if it is able to maintain consistent quality.[42]

The informational efficiency model suggests that if this self-enforcing feature is not realised, and the relevant quality does not remain consistent, a trademark will be unable to lower search costs as consumers will no longer rely on these marketplace signs. If

[40] Landes and Posner (n 34) 269.

[41] ibid 269.

[42] ibid 270 (emphasis added).

consumers are unable to rely on marks, they will presumably be unwilling to pay more for a branded product.[43]

Thus, a consumer is only able to rely on a trademark to indicate their desired product if the quality of the trademarked good remains consistent over time.[44] This account, is therefore, premised on a consumer being able to identify if their desired quality attribute persists in the product they purchase and use.[45] This is a clear problem for consumers that seek out qualities that are impossible for them to discern from using the product, such as for instance, whether the product was made sustainably or to religious specifications.

Economists refer to the different qualities of a product that can be determined at various points in time as 'search', 'experience', and 'credence' attributes.[46] Search attributes are readily apparent and can be known before purchase (eg, the product's appearance). Experience attributes can only be determined after purchase by engaging with the product (eg, the product's flavour). Credence attributes cannot be evaluated in the normal use of a product. Assessing a credence attribute is often difficult to do, if not effectively impossible, as the information required to determine such an attribute is often prohibitively expensive or difficult to obtain (eg, nutritional content or the labour conditions under which the product has been produced).[47]

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[43] See also: George A Akerlof, 'The Market for "Lemons": Quality Uncertainty and the Market Mechanism' (1970) 84 The Quarterly Journal of Economics 448; Landes and Posner (n 34) 270.

[44] Landes and Posner (n 34) 269.

[45] ibid 270. This gives rise to what this account calls the 'self-enforcing feature' of trademark law. Consumers relying on trademarks as indicators of desired quality creates an incentive for the firm to both invest in developing and maintaining a strong mark, as well as consistent quality in their products.

[46] Michael R Darby and Edi Karni, 'Free Competition and the Optimal Amount of Fraud' (1973) 16 Journal of Law and Economics 67; Phillip Nelson, 'Information and Consumer Behavior' (1970) 78 Journal of Political Economics 311.

[47] Nelson (n 46).

Effective certification marks, as the conventional account goes, minimise information asymmetry with respect to credence attributes. By certifying a characteristic of a product that would otherwise be undiscernible to a consumer, certification marks lessen informational asymmetry in the market, especially with respect to attributes relating to rectitude.[48] Certification marks enhance market transparency by functioning as a 'informational surrogate'; a certification mark can transform a credence attribute into a search attribute.[49] This allows and empowers consumers to find and purchase products based on a richer and larger range of factors more efficiently than otherwise possible.[50] Again, this certifying function accords certification marks with a different role than an ordinary trademark. While trademarks allow a consumer to differentiate between different producers on a market, certification marks identify products that are certified as having a given characteristic from those that are not. Certification marks are, therefore, valuable in the trademark law ecosystem for their capacity to ameliorate a certain type of informational asymmetry for consumers.[51]

[48] Although certification marks are not the only marks which ameliorate information asymmetry with respect to credence attributes. Geographical indications, for example, can also address this type of information asymmetry: European Union Intellectual Property Office, 'Infringement of Protected Geographical Indications for Wine, Spirits, Agricultural Products and Foodstuffs in the European Union' (European Union Intellectual Property Office 2016) 13 <https://euipo.europa.eu/tunnel-web/secure/webdav/guest/document_library/observatory/documents/Geographical_indications_report/geographical_indications_report_en.pdf>.

[49] Chong Ju Choi and Jai-Boem Kim, 'Reputation, Learning and Quality Uncertainty' (1996) 13 The Journal of Consumer Marketing 47; Dev Gangjee, 'Proving Provenance? Geographical Indications Certification and Its Ambiguities' (2017) 98 World Development 12.

[50] Landes and Posner (n 34).

[51] As Katz has identified, there are several 'anti-lemon' devices intended to reduce information asymmetry for a range of attributes including repeat purchases, warranties, branding and advertising, and rivalry. These are all ways of reducing informational asymmetry at large, see: Ariel Katz, 'Pharmaceutical Lemons: Innovation and Regulation in the Drug Industry' (2007) 14 Michigan Telecommunications and Technology Law Review 1.

The conventional justification for protecting the certifying function is as follows. Consumers may be interested in a wide range of factors when making a purchase and different consumers will have different interests.[52] For instance, consider again Cathy and her friend Calvin the consumer. Both Cathy and Calvin go to the shop to purchase coffee and prioritise different features. Cathy's coffee selection is driven by the level of caffeine it contains and its taste. Calvin, on the other hand, is not a coffee aficionado and rather cares about the packaging of the coffee and its price. They are both are conscientious consumers and are interested in whether the coffee was sourced from a fair-trade farm. Some of these attributes are easier to determine than others.

The attributes Cathy desires are experience attributes. She will be able to determine them after purchasing a particular brand of coffee and drinking it.[53] The attributes Calvin is more interested in are search attributes. By looking at various brands of coffee at the store he can examine which packaging he prefers and see the offering prices. That is, several of the attributes of any product, here coffee, can be observed or experienced before and after purchase. Whereas Cathy and Calvin may be able to establish several of their desired attributes before purchase, or through repeat purchases, others may remain obscured. Of interest here is both Cathy and Calvin's interest that the coffee was sourced from a fair-trade farm. This feature is not discernible to either of them, even if they purchase and drink the coffee.

[52] Although, trademark law does not care, and ought not to care, about *all* considerations a consumer has in the market.

[53] Unless she has bought that brand before or the store is offering samples!

Whether the coffee is sourced from a fair-trade farm is one of several attributes of coffee that Cathy and Calvin may be interested in, but unable to determine alone. Such attributes include whether the coffee was made with organic beans, whether the coffee was farmed by workers paid a fair wage, or whether the package is made with environmentally sustainable materials. This class of information would generally require a consumer to conduct a prohibitively expensive or time-intensive amount of research to acquire this information. This information is therefore effectively impossible for Cathy, Calvin, or any ordinary consumer to obtain. Coffee does not taste different when the farmers are paid a fair wage or when it is sold in a more environmentally sustainable package. This information needs to be communicated; it cannot be discovered.[54]

How then does a certification mark perform its certifying function? What needs to be signalled for this conventional account of certification marks to be achieved? Must a certification mark communicate the characteristic being certified and its standard in an effort to ameliorate the information asymmetry of credence attributes, or can they merely communicate the fact of certification? In the next section I consider the various ways in which the certifying function of certification marks, as a descriptive matter, appears to be fulfilled.

2.4 Certifying function in practice—a spectrum

In this section, I delineate how the certifying function exists in practice by exploring the variability of existing certification marks.[55] The primary source of a certification mark's

[54] For greater discussion, see: Douglas A Kysar, 'Preferences for Processes: The Process/Product Distinction and the Regulation of Consumer Choice' (2004) 118 Harvard Law Review 525.

[55] This same variability exists for attestation marks performing a certifying function, see Chapter 5.

communication is derived from its ability to perform its essential function, a certifying function. The limited scholarship and jurisprudence treating certification marks appears to operate under the presupposition that certifying function is performed by all certification marks in roughly equivalent ways. This may simply be because the nature of the certifying function has not yet been explicated on. However, upon a closer examination of existing certification marks, it becomes clear this is not a wholly accurate assumption.

While all certification marks perform the same essential certifying function, the way in which this function is realised is varied. I suggest it is more instructive to think of the certifying function as existing across a spectrum from bare to robust, where these qualifiers refer to the quantity and type of information communicated by the sign that constitutes the mark. This variation corresponds to the kind of meaning the average consumer will gain from interacting with a certification mark in the market without any prior experience with the mark.[56]

This section continues by setting out an account of the spectrum of certification marks from bare to robust, and the grey zone in between. Below I define each type of mark, provide examples of these kinds of marks, and identify the features of bare and robust marks. I argue that while both bare and robust certification marks fulfil their requisite certifying function, they do so in significantly different ways. In this section, I look at a

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[56] I would argue that an average consumer of any given product is not likely to have an in-depth or extensive understanding of any given certification mark that appears on the product packaging. I would further argue even consumers seeking out specific certifications, such as kosher or gluten-free certification, will not – on average – be acquainted with all the regulations governing the use of the mark. Thus, proceeding on the basis of consumers without any experience of the mark allows me to consider the analysis from the point of view of someone who may be seeking out specific qualities in a product but not seeking out the certification of a specific certifier. I acknowledge this does, accordingly, not necessarily reflect the experience of consumers seeking out a specific certification mark.

mark's ability to communicate certification on the basis of the perceptible form of the sign that constitute certification marks. Whether a mark is bare or robust is a result of the sign that constitutes the mark itself—the signifier.[57]

This is admittedly a somewhat artificial way to parse the analysis. As explained by Barton Beebe, a trademark's meaning is a result of the entire 'triadic structure' of a mark—the signifier, signified, and referent.[58] The meaning conveyed by a mark is not derived from the signifier alone. A mark's meaning exists because the signifier of a given referent signals the signified, the source and goodwill of the mark. To consider the signifier alone is to assume that the communication of a mark comes from the signifier in isolation and not its ability to refer to the signified. This is incongruent with Beebe's insightful explanation of how trademarks communicate.

I undertake the analysis in this way, not to discount the importance of a certification mark's signified, but because the range of trends in the signifiers of certification marks that exists is valuable in and of itself. This is particularly so when considering the essential function of a certification mark in contrast to the essential function of an ordinary trademark. A trademark can perform its essential function even where a consumer has never seen it before, as long the consumer can recognise the mark as a trademark.

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[57] Barton Beebe theorises an analytical framework for understanding trademarks drawn largely from semiotic theory. Beebe sets forth an account of the internal structure of trademarks positing that trademarks are composed of three separate elements, and therefore, have a 'triadic' structure. The first element is the 'tangible symbol' also referred to as a trademark's *signifier*. The signifier is the 'perceptible form of the mark,' this is the representation of the mark that can be expressed with sufficient precision, clarity, and intelligibility. The second element is the trademark's *referent*—the goods or services that a trademark is used to refer to. The last element is a trademark's *signified*, that is, the source and goodwill of a trademark, see: Barton Beebe, 'The Semiotic Analysis of Trademark Law' (2004) 51 UCLA Law Review 621, 646.

[58] ibid.

For instance, imagine Calvin enters a shoe store and see two pairs of running shoes, one with a check mark across the side and another with three lines. If he properly identifies these signs as trademarks then he will understand they come from different commercial sources even if he has never encountered the NIKE or ADDIDAS brand before. Of course, if Calvin has encountered either brand and trademark before, then seeing these signs on a pair of running shoes will have greater meaning and likely be of more assistance to him as he searches for his desired shoe. Nevertheless, even with no prior experience of these trademarks they can perform their essential function. As long as they are identified as trademarks and are sufficiently distinctive so to distinguish between commercial sources, they can perform their essential source indicating function.

Accordingly, this section considers the analogous scenario for certification marks. Can a certification mark perform its essential function even where a consumer has no previous experience with the mark? And if so, to what extent? Considering the communicative value of a certification mark's signifier alone —which assumes a consumer has no prior knowledge or experience of the mark—is valuable because it highlights a core difference between how trademarks and certification marks function. This issue is explored further in subsequent chapters and allows us to consider the range of social value a certification mark might have.[59]

[59] Despite the difference between the essential function of an ordinary trademark and certification mark, ordinary trademarks sometimes perform a certifying function and act as pseudo-certification mark, discussed further in Chapter 5.

2.4.1 Bare certification marks

This subsection introduces what I call *bare certification marks*. This type of certification mark carries the least amount of information in its signifier. It fulfils its certifying function to a minimal degree. A bare certification mark achieves its certifying function thinly by communicating that the product with which it is associated is certified. That is, what is being communicated is the mere fact of certification. This only requires that the average consumer viewing a bare certification mark be able to identify the mark as a certification mark and distinguish it from other marks. Below, I further explain the nature of bare certification marks and provide three illustrative examples.

The way a bare certification mark realises its certifying function is solely by being identified as a mark which attests to something; by signalling to consumers that it is a mark that certifies.[60] Belson refers to this as an 'opaque' mark:

> One could perhaps use the term 'opaque' to characterize a certification mark that does not use words to identify basic features of the goods, their certified characteristic and the relevant standard.[61]

This can be contrasted to a more robust certification mark, further discussed below, which communicates that a product is certified by providing information around what is being certified and by whom. Bare certification marks can thus fulfil the act of indicating a product is certified by communicating very little *information*. Simply being capable of being identified as a mark performing a certifying function is sufficient to indicate a product associated with the mark is certified for *something*. As this is a relatively low level

[60] I refer to marks which attest to something as attestation marks. I define and discuss this concept more fulsomely in Chapter 5.

[61] Belson (n 5) s 5.27.

of information to communicate, particularly as compared to robust certification marks, it can be done in various ways. A certification mark can be composed of any kind of sign if it is capable of performing its essential function. As discussed above, the same limitations on the registration of trademarks exist for certification marks with respect to what is an acceptable sign.

Bare certification marks are distinctive marks that clearly communicate the mark is certifying, while providing virtually no other information, figures 1, 2 and 3 below are examples of this.

figure 1 HALLAL CERTIFICATION SERVICES mark

figure 2 UNION OF ORTHODOX JEWISH CONGREGATIONS OF AMERICA mark

figure 3 BRITISH BOARD OF FILM CLASSIFICATION - Universal mark

Figures 1, 2, and 3 are certification marks where the signifiers convey very little information.[62] In fact, without prior knowledge of the mark it would be virtually impossible for the average consumer to discern what is being certified by these marks.

[62] The mark in figure 1 is registered in the EU as a certification mark, filing number 018062343. The mark in figure 2 is registered as a certification mark across all jurisdictions of interest here: filing number 017476011 (EU); registration number TMA534800 (Canada); registration number 3882895 (US); trademark number UK00917476011 (UK). The mark in figure 3 is registered as a certification mark in the EU and UK: filing number 017845967 (EU); trademark number UK00917845967 (UK).

Despite the range of signs available for certification mark owners to make use of, there tends to be a certain degree of convergence in the type of signs used for certification marks. These examples make use of similar design features and are emblematic of the type of marks that constitute the signifiers of bare certification marks. For instance, all three of these figures make use of discrete shapes as their silhouette. Certification marks tend to also exclusively be wordmarks, figurative marks, or combination marks.[63] There is also an observable practice regarding the size and placement of marks performing a certifying function. These marks tend to be smaller in size than the dominant signs on a package, such as the trademark and other product markings, and found in a less central location.

These practices are often prescribed by mark owners and can be observed in branding guidelines of attestation marks. The British Board of Film Classification (BBFC), for instance, has a manual of guidelines for how to use the various rating symbols, such as the 'Universal' symbol featured in figure 3. This includes mandating an exclusion zone around a rating symbol, limitations on altering the symbols, recommended requirements regarding the size the rating symbols (30px height recommended, minimum 24px height), and their placements.[64]

Given these shared market practices around certification marks, one can infer that marks exhibiting these features are a designation of attestation and not a designation of

[63] I am unaware of any exotic or unconventional signs being used as certification marks, while the use of such a sign is not inconceivable. There was a Canadian case in the 1980s, for instance, which held that a certification mark could not be constituted by a 'guise', that is ' "a shaping of wares or their containers" or "a mode of wrapping or packaging wares".' *Brewers Association of Canada v Canada (Registrar of Trade Marks)*, 132 DLR (3d) 577 (1982) (Federal Court of Appeal of Canada).

[64] BBFC, 'VOD User Guidelines' (British Board of Film Classification 2019).

source or decoration.[65] These market practices facilitate the identification of bare certification marks as marks which do not perform a source indicating function but an attestation function. While at first this may appear a bit circular, that a bare certification mark can work as a certification mark because certification marks are used in this way, this is congruent with how trademark law understands consumers' market-literacy. For example, there is an understanding that non-traditional marks can perform their essential source indicating function because consumers can learn to interpret various product markings and features as signs.[66] The practices around bare certification marks are comparable.

A consumer identifying a mark as certifying *something*, irrespective of what is being attested to or by who, is akin to a trademark being used *as a mark*. Alexandra Roberts, in her insightful paper, discusses what it means for a trademark to be used as a mark, and thus be 'used in trademark ways.'[67] This includes features such as appearing 'where consumers expect a trademark to appear', and 'be sufficiently set off from the surrounding text and images to attract notice.'[68] As she explains:

> What does use as a mark look like in practice? Classic use displays a word mark in large, clear, prominent lettering, often using capital letters or font that differs from that used in the surrounding text. It may employ color to draw attention to the mark, or frame the mark with an oval or rectangle to offset it from the rest of the packaging. COLD-EEZE, SUAVE, and the stylized DUNKIN' DONUTS mark below are examples. On packaging or signage, the mark should be centrally located and may be followed by a TM,

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[65] Although, as discussed in Chapter 5, ordinary trademarks acting as pseudo-certification marks may also follow such conventions.

[66] See, for example: Case C-468/01P and C-427/01P *Proctor & Gamble Company v European Union Intellectual Property Office* ECLI:EU:C:2004:259;David Vaver, 'Unconventional and Well-Known Trade Marks' [2005] Singapore Journal of Legal Studies 1, 11.

[67] Alexandra J Roberts, 'Trademark Failure to Function' (2019) 104 Iowa Law Review 1977.

[68] ibid 1981.

> SM, or ® symbol. When consumers regard the coffee cup below, we can expect them to perceive the word mark DUNKIN' DONUTS, the colorful logo, and the slogan AMERICA RUNS ON DUNKIN'TM as marks.
>
> Use that does not qualify for protection typically lacks those indicia of trademark use. Instead, the matter might function primarily as a domain name, like "dunkindonuts.com," or informational or descriptive text, like "caution: this beverage is extremely hot" on the coffee cup, "Family Size!" on the shampoo bottle, or "All Natural Cherry Flavor" on the cold remedy package.[69]

This practice is like what I described above as the practices around the certifying function and use as a bare certification mark. Bare certification marks are thus capable of being identified as marks attesting to something while signalling very little information from their sign alone.

To probe this point further, consider figures 2 and 3. They are distinguishable marks. They make use of different shapes and colours. The mark in figure 2 is in black and white and makes use of a circle with a black letter 'U' in the middle. Alternatively, this could be viewed as both the letter 'O' with the letter 'U' within it (which is likely the intentional design of the mark owner, given it belongs to the Union of Orthodox Jewish Congregation of America, referred to as the Orthodox Union).[70] Although given that certification marks generally appear within a closed shape, it is probable a consumer unfamiliar with the mark would view figure 2 as a 'U' within a circle, and not the letter 'O'. The mark in figure 3, by contrast, uses a triangle, is predominately green in colour, and uses a white 'U' in the centre. If these marks are used in line with the practices

[69] ibid 1990–2 (citations omitted).

[70] Their website is hosted on the URL <www.ou.org> and the English portion of their website title reads, 'Orthodox Union.' Orthodox Union, 'Orthodox Union' (*Orthodox Union*) <https://www.ou.org/> accessed 2 June 2020.

described above, even if a consumer has no prior experience with either mark, they will likely identify both marks as performing a certifying function. This observation has percolated into the discussion on certification marks in practice. The Fifth Board of Appeal of the European Union Intellectual Property Office, for example, noted in a recent case that:

> The public is accustomed to the fact that certification marks often (but not necessarily) have the shape of a label, logo or seal that alludes to certified characteristics or contain certain terms such as 'certified', 'tested', 'checked', 'checked', [sic] 'accepted', 'approved', etc., not seldom appear on the label or seal also the name of the proprietor (cf. Article 83(2) EUTMR), which certifies the characteristic.[71]

Yet, a consumer seeing these signifiers alone, without any prior experience or knowledge of either mark, would be unlikely to distinguish any difference in the informative content between them, as they are both composed to the same single character, a 'U'.[72] Even where these two marks are distinguishable from *each other*, there is no way to discern whether these two marks are certifying the same or similar characteristic or not. That is, it is perfectly plausible to assume that they are the marks of two different entities certifying the same characteristic.

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[71] Case R 2112/2019-5 *Qualität Gemeinschaft Biomineralwasser e.V* [23] (Fifth Board of Appeal 2021, EU IPO).

[72] There is marketing researching exploring, from a psychology and semantics perspective, the impact of brand names that are number-based, acronyms, abbreviations, alphanumeric, and sound symbolism, but I have been unable to find research exploring consumers' perceptions of a single character logo. See, for example: Sunny Arora, Arti D Kalro and Dinesh Sharma, 'A Comprehensive Framework of Brand Name Classification' (2015) 22 Journal of Brand Management 79; Richard R Klink, 'Creating Meaningful New Brand Names: A Study of Semantics and Sound Symbolism' (2001) 9 Journal of Marketing Theory and Practice 27; Teresa M Pavia and Janeen Arnold Costa, 'The Winning Number: Consumer Perceptions of Alpha-Numeric Brand Names' (1993) 57 Journal of Marketing 85. It is also worth noting that I am not speaking of brand names which are single characters, but rather marks that are parts of brands where the mark only contains a single character by which it references the brand. Nevertheless, the letter 'U' alone is not a sufficiently distinctive signifier to refer to any sort of specific semantic content without the greater context of the mark's referent or signified.

Of relevance here, however, is that these two marks would not be viewed by consumers in the abstract but rather in association with a product. The mark in figure 2 would most likely be found on food or drink products, and the mark in figure 3 would be found alongside films. This would undoubtedly help consumers in narrowing down the range of characteristics these marks can be attesting to. Yet, there is no legitimate basis to suggest why any consumer unfamiliar with these marks would conclude that figure 2 certifies kosher products and figure 3 signals that the British Board of Film has rated a film 'universal' and suitable for all audiences.[73]

Similarly, these signifiers will not, without prior knowledge of a mark, help consumers to identify who is standing behind the certification—the Union of Orthodox Jewish Congregations of American and the British Board of Film, respectively. Moreover, there is no way in which a consumer viewing these marks also would be able to determine how to find out more information about either mark.[74] This goes to demonstrate why these marks are bare certification marks—the signifier reveals nothing about what characteristic is being certified, what standard is being certified, who is doing the certifying, or where to go to find more information.

The lack of semantic content conveyed by a bare certification mark's signifier does not mean that the signifier is not still communicating. To the contrary, a bare certification

[73] There are, nevertheless, numerous characteristics for which food stuffs and films may share such as geographical origins, the identity of producers, the working conditions under which the film or food products were produced, to name a few.

[74] Although with the increasing introduction of reverse image searches online this may soon be very practicable for many consumers, see: Google, 'Find Related Images with Reverse Image Search' (10 March 2020) <https://support.google.com/websearch/answer/1325808?co=GENIE.Platform%3DAndroid&hl=en>. This is discussed further in later chapters.

mark has the *capacity* to communicate a lot but doing so requires a source of information external to the mark itself. Because certification marks communicate credence attributes, experience with the product certified by the mark alone will not help a consumer populate the signified, as is the case with ordinary trademarks. Bare certification marks, therefore, communicate almost precisely like an ordinary trademark where the consumer has no prior experience with the mark or related brand.

Bare certification marks not only have a type of 'differential distinctiveness', because they can be distinguished from other marks, but also have a type of 'source distinctiveness.'[75] Although certification marks do not have literal 'source distinctiveness', because unlike trademarks they do not signal commercial source, they do have something more akin to *certifying distinctiveness*. Certifying distinctiveness is what allows a bare certification mark to function successfully.

A mark has *certifying distinctiveness* if a consumer recognises it as a reliable indicator that some anonymous body is attesting to something about the product. Because even bare certification marks can communicate certifying distinctiveness, they communicate something of relevance. Certifying distinctiveness communicates 'attestation source' analogous to the 'source' a trademark communicates. That is, a distinctive attestation source will allow a consumer to identify that the same entity stands behind a mark attesting to something about the product when they see this mark again, irrespective of whether they can identify who or what is making the attestation. This attestation source is as thin as the nature of anonymous source required by ordinary trademarks. Resultingly,

[75] Beebe (n 57) 621. As Beebe explains, *source distinctiveness* 'describes the trademark's distinctiveness of source', and *differential distinctiveness* 'describes the trademark's distinctiveness from other trademarks.'

bare certification marks can communicate an *attestation source* even without communicating the identity of the certifier. That means an average consumer could identify the bare certification mark as belonging to the same attestation source the next time they come across the mark.

Fulfilling the certifying function in this way accords with the statutory requirements for certification marks as they are not required to indicate what characteristic a product is certified in respect to, simply that the product is indeed certified with respect to a given characteristic. This, and the ability to be distinguished from other marks such that a consumer could distinguish between certified and not-certified products, is what constitutes the certifying function for bare certification marks.

Even though the signifier of bare certification marks communicates virtually no information about the nature of the certification itself, they are able to communicate information in a very trademark like sense. A bare certification mark functions quite comparably to a trademark. It communicates by being distinguishable from other marks (differential distinctiveness) and by being able to signal a consistent attestation source (source distinctiveness).

One might suggest that a bare certification mark is sufficient because the mark is technical in nature, and the end user may be a specialised audience, such as a manufacturer.[76] Yet this is certainly not the rule and there are indeed several bare

[76] Nevertheless, some standard setting organizations that are more technical in nature still make use of non-robust certification marks. Such as UL's marks, see Appendix A UL

certification marks intended for the end-user consumer, such as UL's marks, see figures 4 and 5 below.[77]

figure 4 UL plain mark

figure 5 UL certified mark

The way a bare certification mark fulfils its certifying function, therefore, is such that it behaves like an ordinary trademark. A trademark communicates by (i) working as a mark, that is, by being something consumers identify as a trademark, and by (ii) signalling source by being sufficiently distinctive. As Roberts says, 'Use of a mark and distinctiveness are two sides of the same coin.'[78] Accordingly, the value of the semantic content of a trademark's signifier is merely that it has source and differential distinctiveness—that the signifier, when used with the referent, refers to the signified. Trademark law does not require a trademark's signifiers to contain any particular semantic content, such as terms that describe the product.

[77] The mark in figure 4 is registered as an individual trademark in the EU, filing number 017277311. However, the same mark is registered as a certification mark in the other jurisdictions of interest here: trademark number UK00002463811 (UK); trademark number TMA402149 (Canada); registration number 0782589 (US). The mark in figure 5 is registered as an ordinary trademark in the UK, trademark number UK00801103308. It is registered as a certification mark in the other jurisdictions of interest here: filing number 017284761 (EU); trademark number TMA890824 (Canada); registration number 4283961 (US).

[78] Roberts (n 67).

Similarly, a trademark's signifier is not required to contain semantic content that would identify the actual source of the product:

> In its earliest manifestation, the identity of the source of the goods was presumably actually known to the public, since the scope of distribution of a product was limited to a narrow geographical region. As commerce expanded, it was realized that such a limitation was not feasible. Accordingly, the purchaser in London no longer had to know the actual identity of the manufacturer in Manchester; the source could be anonymous. As long as the mark served to identify a single source for the goods, the triangular relationship was preserved between the mark, its owner and the goods.[79]

Trademarks reliably communicate information about a product by signalling to the same (anonymous) source so that consumers can know they are purchasing from the same source. A trademark owner can certainly include descriptive terms in their mark, and this will likely add some ease by which consumers can identify a product or the nature of the product.[80] Yet, there can be negative consequences for trademarks where the perceptible form of the mark is too descriptive.[81] To the contrary, it is easier to gain trademark protection for arbitrary and fanciful marks.

To recap, given the thin sense in which bare certification marks perform their certifying function, they behave quite analogously to ordinary trademarks. Bare certification marks fulfil their certifying function by (i) being identifiable as a mark which attests to something and (ii) communicating attestation source.[82] They do not communicate

[79] Neil J Wilkof, 'Third Party Use of Trade Marks' in Jeremy Phillips and Ilanah Simon (eds), *Trade Mark Use* (Oxford University Press 2005) para 7.07.

[80] Landes and Posner (n 34) 276.

[81] John D Ingram, 'The Genericide of Trademarks' (2004) 2 Buffalo Intellectual Property Law Journal 154.

[82] That is, by being 'certifying distinctive' while also being differential distinctive.

by virtue of any semantic content regarding the nature of the certification on the face of the mark.

Bare certification marks are not significantly helpful to the average consumer who has no prior experience with, or knowledge of, the mark. To signal the fact of certification alone, without signalling any additional information regarding the nature of the certification is, under the conventional account, not of equal utility as trademarks that do the same. Where the average consumer with no prior experience with, or knowledge of, a mark sees a bare certification mark, they will likely be able to discern that the product is certified by a body for something but will not necessarily know what characteristic is being certified and by whom. Therefore, a bare certification mark will have limited value unless a consumer has prior knowledge of, or experience with, the mark.[83]

The upside of this similarity with trademarks, however, is that a bare certification mark is capable of individuated meaning.[84] Because bare certification marks function as signs, they too can carry individuated meaning. That is, where a consumer encounters a bare certification mark, even without understanding what it means, they may import their own meaning onto it like psychological and cultural baggage, their own attitudes, experiences and feelings.[85] For instance, a bare certification mark consisting of a green

[83] It is not even useful for a consumer to look for the bare certification mark again the next time they purchase the same product because the certification mark does not speak to the quality of the overall product itself, but likely indicates a credence attribute that cannot be experienced by the average consumer.

[84] Although, as I will discuss later in the thesis, any functioning sign can carry individuated meaning, and this is not unique to bare certification marks at the exclusion of robust certification marks. There is simply more room for a bare certification mark to carry this individuated meaning (especially where the mark is not previously known to the consumer) because the signified is so vacuous.

[85] Pavia and Costa (n 72).

leaf in a circle may be interpreted as environmentally preferable, or a circle with a fist may inspire feelings of workers' rights.[86]

2.4.2 Robust certification marks

At the other end of the spectrum from bare certification marks is, what I term, the *robust certification mark.* Robust certification marks perform the certifying function in a way that communicates more than the mere fact of certification. Unlike a bare certification mark, the signifier of a robust certification mark communicates information about both the characteristic it is certifying and some measure of information about the certification itself. Even a consumer without any prior knowledge of, or experience with, the mark would be able to rely on a robust certification mark to make their purchasing decision. A robust certification mark signals information about the certification itself, namely the *characteristic being certified* and the *actual source of the certification*.

While robust certification marks perform the same certifying function as bare certification marks, they realise this function differently through the use of text and words in combination with a figurative mark, see figures 6, 7, 8.[87]

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[86] Although this possibility is part of what motivates concerns around corporate washing practices, discussed further in Chapter 6.

[87] The mark in figure 6 is registered as a certification mark in the US, registration number 3934582. The mark in figure 7 is registered as a certification mark in Canada and the US, registration numbers TMA1075793 and 3811882, respectively. The mark in figure 8 is registered as a certification mark across jurisdictions of interest here: trademark number UK00003479635 (UK); registration number 6159897 (US); filing number 018220980 (EU). In Canada, there is a pending application for the mark shown in figure 8, application number 1997669, which was listed as 'live' and 'published for opposition' by CIPO as of 22 August 2022.

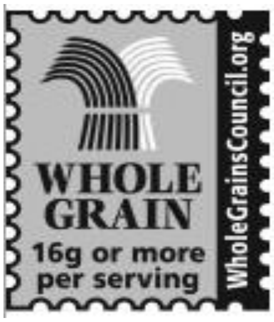

figure 6 WHOLE GRAINS COUNCIL mark

figure 7 NON GMO PROJECT mark

figure 8 CERTIFIED GLUTEN FREE mark

The average consumer who comes across the marks in figures 6, 7, and 8 even without ever encountering these marks before should grasp the following. First, a consumer should identify these signs as a mark that attests to *something* given their size, shape, and placement on a package. Robust certification marks make use of the same marketing conventions as bare certification marks. Accordingly, the way they are used alone, would likely signal to a consumer that these marks are not communicating source but the attestation of some product attribute. Second, the average consumer ought to be able to discern what the characteristic being certified is. It is obvious that the mark in figure 6 certifies whole grains, that the mark in figure 7 certifies the absence of GMOs, and that the mark in figure 8 certifies the absence of gluten. Third, the average consumer should be able to discern the 'identity' of the certifier, not just the certifying source. The identity of a certifier is different than the certifying source of a mark discussed earlier in this chapter. Unlike the certifying source of a mark, which does not require any actual knowledge of the source of the mark or the certifier, the identity of the certifier does. By being able to identify the identity of a certifier, a consumer will be able to discern either the name of the body responsible for the certification or where they need to go to find out more information about the mark, eg through a website.

This communication is not without its own limitations. There is still ambiguity in the precise way the characteristic is being certified, to what standard, and how. These more nuanced and detail-oriented questions are left unanswered by even robust certification marks. Nevertheless, by communicating the identity of the certifier, a consumer will be able to find out more information about the nature of the standard and certified characteristic. Take for example, figure 8.

A consumer encountering figure 8 for the first time may still have questions about the precise nature of the certification. Is a certified gluten free product 100% gluten free? Mostly gluten free? Yet, because of the inclusion of information regarding the actual certification source, a consumer can search out more information. For instance, visiting <gfco.org>, a web address embedded into the face of the mark, would inform a consumer what constitutes a 'gluten-free' product to the certifier.[88] Moreover, by visiting this website a consumer could learn the brand on the mark CERTIFIED GLUTEN FREE is being used by the Gluten-Free Certification Organization. She could further learn that this organisation is run by the Gluten Intolerance Group, which is a non-profit community based out of the United States.[89] She would see that while the attestation source is the CERTIFIED GLUTEN FREE brand, the identity of the certifier is the Gluten-Free Certification

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[88] For the standard underlying the mark in figure 3.i gluten free is defined as 'The presence of gluten at 10 parts per million ("ppm") or less, or whole grains, beans, seeds, pulses or legumes that contain less than 0.25 gluten-containing grains per kilogram.' Gluten-Free Certification Organization, 'GFCO Certification' (*Gluten-Free Intolerance Group*, 2020) <www.gfco.org> accessed 2 April 2020.

[89] ibid.

Organization. Further, the actual owner of the registered mark is the Gluten Free Intolerance Group.[90]

The nature of robust certification marks, in contrast to bare ones, supports the following three differences between how they are conceptualised. First, all certification marks, across the spectrum, make use of similar marketing practices to indicate they do not signal source. As emphasised above, this is generally done by making use of the similar features and characteristics that bare certification marks use – such as size, placement, shape of mark, etc. The more robust a certification mark is, however, the more likely they will make use of additional cues to indicate their certifying function. These include not only descriptive words about the characteristic they certify, but also the use of descriptive words that signal its attesting nature. See, for example, figure 7 and figure 8 that make use of the words 'verified' and 'certified' within the signifier which would further signal to a consumer this mark is not a trademark nor merely a decorative sign.

Second, the nature of both the signifier and *signified* are different in robust certification marks, as compared to bare. Because the content of the signifier in a robust certification mark, by definition, contains more descriptive information, the content of the signified is necessarily somewhat prescribed. While a robust certification mark is still capable of individuated meaning, there is a level to which the meaning of the mark will be more consistent and shared among all consumers. Although consumers may still have equally varying thoughts, attitudes, and beliefs about the mark, the meaning of a robust certification mark is more constrained. Thus, it is accurate to say that in a trademark sense,

[90] As listed on their website.

robust certification marks are somewhat inefficient, except in so far as they garner their efficiency from the objectivity and accuracy of the information they are conveying. That is because while consumers may react differently to the same robust certification mark, it would not *mean* something different. The *meaning* itself is less individuated, so the efficiencies of a robust mark are tied more to its objectivities rather than its ability to tailor to individual conceptions of its meaning.

Third, robust certification marks can signal more than a bare certification mark. As discussed above, a bare certification mark fulfils its certifying function by signalling to consumers (i) that they are attesting to something about a product and (ii) the certifying source of the mark. Robust certification marks are equally capable of being distinctive in those two ways and signalling the same features. Robust certification marks can *additionally* signal (iii) the characteristic being attested to, and (iv) the identity of the certifier. By doing this additional work, robust certification marks communicate more about the credence attributes of the product. Accordingly, robust certification marks are not merely signalling more information, they are signalling a different kind of information— information about the nature of the certification.[91]

2.4.3 Grey certification marks

As the nature of a certifying function, and thus certification mark, exists across a *spectrum*, there are inevitable marks that fall in between the bare and robust poles—grey certification marks. Figures 9, 10, and 11 are examples of certification marks that fall somewhere in the middle of the spectrum from bare to robust.

[91] The implications of this are discussed in Chapters 6.

figure 9 MARINE STEWARDSHIP COUNCIL mark

figure 10 MADE SAFE mark

figure 11 ALLERGY STANDARDS mark

The mark in figure 9 takes the form of a shape with an allusion to a seal and incorporates a checkmark figure into the design of a fish.[92] An average consumer with no prior experience with, or knowledge of, this mark would likely identify it as a certification mark if its placement and size on a package was in accordance with generally accepted practices of mark performing a certifying function. While this is all that is required to perform a certifying function in a thin sense, this mark also incorporates the identity of the certifier in the form of a URL embedded in the face of the mark. This mark is more robust than a bare mark. It does not communicate to consumers within the face of the mark itself

[92] The mark shown in figure 9 is registered as a certification mark in the EU, filing number 018032783. In Canada a very similar mark is registered as a certification mark, registration number TMA830798. This mark is only of the fish, the bottom portion of the image depicted in figure 9. In Canada there is another registered certification mark that is visually similar but not identical, under registration number TMA832052. In the United States, there are registered marks owned by the Marine Stewardship Council, including some design marks visually similar to the one shown here, but that are registered as an ordinary trademark (registration number 2718682).

the characteristic being certified so it does not rise to the level of a robust certification mark.[93] Figures 10 and 1l function similarly.[94]

2.4.4 Implications of the spectrum

The ways in which we think about the certifying function, and ought to conceive of this essential function, is the primary focus of Chapter 6. Nevertheless, observing the different ways in which certification marks fulfil their certifying function is instructive. By describing this practice, I put forward language—bare and robust—to articulate these analytically relevant distinctions for the remainder of this thesis. Furthermore, observing the variation of the certifying function brings with it some insights.

The certifying function is not performed uniformly, and this may give us pause before speaking of the certifying function like it has unitary performance of its task. By differentiating the spectrum of certification marks based on how they perform their certifying function, I can more precisely identify the limitations of *some* certification marks. Specifically, this spectrum enables me to isolate the type of certification marks that are more limited, ie bare certification marks. Across the jurisdictions of interest here, there

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[93] For instance, one would not know which ingredients the mark in figure 10 certifies without visiting the website, see: Nontoxic Certified, 'MADE SAFE' (*MADE SAFE certified products: made safe for humans & ecosystems*) <https://www.madesafe.org/> accessed 2 April 2020. The MADE SAFE mark indicates that a product has been screened for ingredients such as: 'behavioural toxins, carcinogens, developmental toxins, endocrine disruptors, fire retardants, heavy metals, neurotoxins, high risk pesticides, reproductive toxins, toxic solvents, and harmful volatile organic compounds.'

[94] The mark depicted in figure 10 is registered as a certification mark across jurisdictions of interest here: filing number 017926642 (EU); registration number 5157091 (US); trademark numbers UK00917950113 and UK00917926642 (UK); application number 1930074 (Canada), as of 22 August 2022, this mark was listed as 'live' and 'published for opposition' by CIPO.

The mark depicted in figure 11 is registered as a trademark in the EU, filing number 17938679 and the UK, trademark number UK00917938679.

is nothing inherent in bare certification marks that prevent them from passing the bar of registrability.

Although a robust certification mark may be communicating *more* about the nature of a product, it is not required. If only a bare certification mark is statutorily required, then a certifying function must merely signal the source of certification and the existence of certification. Again, a bare certification mark operates analogously to an ordinary trademark. Where a trademark signals commercial source a certification mark communicates attestation source. This also brings certification marks, as currently constituted, more within the ambit of the informational efficiency model, as a positivistic account of trademark law. Where the quality required to be signalled to reduce search costs is *the fact of certification*, then a bare certification mark fulfils this task. However, if one takes the more conventional perspective that certification marks reduce search costs by transforming credence attributes into search attributes, then a bare certification mark does not fulfil this. A consumer cannot, without information or experience from outside the triadic structure of a bare certification mark, rely on it to reduce search costs. The more robust a certification mark is, the more defensible the justification for certification marks are as against the informational efficiency account. Yet, robust certification marks, as highlighted above, are not efficient in a trademark sense. It is this tension that motivates the following chapters and is addressed more fully in Chapter 6.

2.5 Conclusion

In this chapter, I have set out a positivistic account of certification marks. I began by providing a functional account of certification marks and identifying the essential function of certification marks—the *certifying function*. I then set out what can be understood as the conventional account of certification marks: that successful certification marks help transform credence attributes into search attributes. I then sought to challenge this account by exploring the range of ways in which the certifying function exists in practice – from barely to robustly. In doing so, I demonstrated that rather than need to communicate something about the standard or characteristic being certified, the certifying function can perform merely by acting as a distinctive signal of attestation source. This underscored the idea that the certifying function exists in a range of ways such that speaking of how certification marks function in a singular fashion may be misleading. This chapter provides an important backdrop for subsequent chapters where I build on this positivistic account to identify the limitations of certification marks, both as legal objects and as part of the institution of trademark law. In the next chapter, I demonstrate that there are problems with certification marks, and the problems that exist with certification marks are, at their core, issues regarding both how our social world and markets have changed, as well as the nature of communication and meaning in our markets.

III. CERTIFICATION MARKS – A STALE INSTITUTION

3.1 Introduction

Certification marks exist within a rich context. As discussed in the introductory chapter, consumers now have a wide range of expectations for the brands they support. The existence of brands has driven a growing change in how we understand meaning in the market.[1] Certification marks have remained moderately consistent since the turn of the 20th century despite the significant changes that have occurred around them, that is, consumers' expectations, and marketplaces more broadly, have greatly evolved.[2] As a result of a changing world, and a not-so changed legal understanding of certification marks, certification mark law—to put it bluntly—has become stale.

In this chapter, I take stock of the nature of certification marks in today's context and argue that there are indeed problems with certification marks both as legal objects and as part of the legal institution of trademark law. The legal institution behind certification marks has not kept pace with the changes occurring around it and this has led to problems with certification marks as currently constituted. Certification marks, in particular, do not work well as signs which convey specific and objective information to consumers about the nature of products. This is a problem given that under the conventional account, the protection of certification marks is justified by their ability to translate credence attributes into search attributes and thereby reduce consumer search costs.

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[1] The nature of brands and brand meaning is the focus of Chapter 4.

[2] Notwithstanding the relatively recent addition of EU certification marks to the EU trademark law landscape.

In the following sections, I consider three discrete but interrelated classes of problems with certification marks both as legal objects and as a part of legal and extra-legal institutions. In section 3.2, I explain how some of the problems attributed to certification marks are in fact an upshot of issues with the certification underlying certification marks, as a form of private governance. In section 3.3, I turn to certification marks as legal objects and identify limitations with certification marks as marketplace signs as well as a constituent part of the greater legal institution of trademark law. In 3.4, I conclude that what these problems have in common is that the version of certification marks that exists, as currently constructed by trademark statutes, aligns with a 19th century consumer protection model of marks in a 21st century market.[3]

3.2 Certification as an inadequate private governance institution

Certification marks are the public facing aspect of an extra-legal institution—the institution of certification as a form of private governance. There are several features of certification marks that vary from one mark to the other. These features include, but are not limited to: (i) the characteristic being certified; (ii) the certification process; (iii) the accountability of those overseeing the certification process; (iv) the transparency of the certification process; (v) the standard being used to certify the underlying characteristic; (vi) the body responsible for creating the standard of certification; (vii) the reputation of the certifying body; (viii) the enforcement process for certification; (ix) the reputation of the mark; (x) the descriptive and figurative elements of the mark; (xi) a consumer's ability to identify

[3] This insight was developed in response to feedback I received by the participants of a research talk I gave at the Oxford Intellectual Property Research Centre's Intellectual Property Discussion Group Series on 30 November 2020 (online).

the mark and distinguish it from competing marks; and (xii) a consumer's ability to experience the characteristic being certified. All these features serve to distinguish between different types of certification marks and can be used to distinguish between a mark that is of better or worse quality or of greater or lesser social value.[4]

All these features can also, broadly speaking, be grouped into one of two overarching categories: (i) variations regarding the nature of the certification; and (ii) variations regarding the nature of the mark itself. Undoubtedly, the overall value of a certification mark is a facet of both features, the nature of the *certification* and the nature of the *mark*. The former, the nature of the certification, speaks to the quality of the certification standards, how authentic the claims are, how meaningful or verifiable the claims are, and are all inextricably linked to the characteristic being certified, the subject-matter behind the mark. The nature of certification is the focus of this section and the nature of certification *qua* mark is addressed in the following section.

3.2.1 The nature of certification

Certification plays a role both in private governance, and in overcoming information asymmetry where certifiers are recognised as 'information intermediaries':

> Because consumers cannot observe credence qualities even after consumption sellers and buyers can only partially rely on the above mentioned mechanisms to signal quality. This is when quality assurances supplied by third parties, who act as information intermediaries, may be

[4] Hamish identifies this, and a range of other features, that result in varying degrees of credibility within certification regimes, using eco-certification as a case study, see: Hamish Van Der Ven, *Beyond Greenwash: Explaining Credibility in Transnational Eco-Labeling* (Oxford University Press 2019).

> used. There are three types of information intermediation: advice, certification, and licensing.[5]

Nevertheless, there is great variation in the quality of certification schemes that underlie certification marks and these issues of private governance are the subject of great debate in political science literature.[6] As explained by Hamish Van der Ven, a political scientist who researchers the credibility of eco-labelling organizations:

> First, there is broad variation in the credibility of eco-labels. Whereas some govern in a manner analogous to neutral, credible regulatory bodies, others are biased, arbitrary, weak, or nakedly politicized. Second, <u>there is often very little to outwardly separate the credible eco-labels from the non-credible</u>.[7]

This project is more focused on Van Der Ven's latter point, an observation that exists in trademark literature as well. As Margaret Chon has noted, 'The quality guaranteed by a certifying firm may or may not be reflected in a mark per se.'[8] While the nature of the certification and the nature of a mark are undoubtedly inextricably linked, there is little literature addressing how these private governance and intellectual property issues overlap.[9] Nevertheless, it is vital to note at least some class of problems or limitations of

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[5] Ariel Katz, 'Pharmaceutical Lemons: Innovation and Regulation in the Drug Industry' (2007) 14 Michigan Telecommunications and Technology Law Review 1, 26. In this article, Katz is discussing the use of information intermediaries, and other anti-lemon devices, within the pharmaceutical industry. Accordingly, his discussion on advice (from physicians and pharmacists) and government licensing are of less relevance here as my interest is the use of certification in a range of industries.

[6] Graeme Auld, *Constructing Private Governance: The Rise and Evolution of Forest, Coffee, and Fisheries Certification* (Yale University Press 2014); Graeme Auld, Stefan Renckens and Benjamin Cashore, 'Transnational Private Governance between the Logics of Empowerment and Control' (2015) 9 Regulation & Governance 108; Van Der Ven (n 4).

[7] Van Der Ven (n 4) (emphasis added).

[8] Margaret Chon, 'Marks of Rectitude' (2009) 77 Fordham Law Review 101, 121.

[9] Chon (n 8); Margaret Chon, 'Tracermarks: A Proposed Information Intervention' (2015) 53 Houston Law Review 101; Jeanne C Fromer, 'The Unregulated Certification Mark(Et)' (2017) 69 Stanford Law Review 121.

certification marks will not be attributable to their nature as marks but rather with regards to the underlying certification.

Certification is a longstanding way to signal the quality of products and companies; certification programs are '…a form of private governance established by nongovernmental organizations (NGOs) and businesses to advance responsible production practices.'[10] Scholars can easily point back to certification practices dating back to the ancient Jewish practices of certifying food as kosher, and even what we recognise today as a fulsome certification regime was a live practice by the turn of the 20th century.[11] Notwithstanding this established history of using certification as a method of signalling quality, today certification has emerged as a form of social regulation and private governance.[12]

This is not inconsistent with the roots of certification. Rather, Jeffrey Belson has posited that the history of certification marks is 'founded on regulation and regulatory institutions.'[13] Regulation being 'the process by which governments impose requirements on enterprises, citizens, and government itself, including laws, orders and other rules.' Certification as a regulatory form sits at the intersection of regulation by information, market-based instruments, and voluntary programs.[14] Despite the variety of ways in which

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[10] Auld (n 6) 1.

[11] Shayna M Sigman, 'Kosher Without Law: The Role of Nonlegal Sanctions in Overcoming Fraud Within the Kosher Food Industry' (2004) 31 Florida State University Law Review 509.

[12] Tim Bartley, 'Certification as a Mode of Social Regulation' in David Levi-Faur (ed), *Handbook on the Politics of Regulation* (Edward Elgar Publishing 2011).

[13] Jeffrey Belson, *Certification and Collective Marks: Law and Practice* (2nd edn, Edward Elgar Publishing Limited 2017) s 2.05.

[14] Bartley (n 12) 443.

certification occurs, there are some core characteristics generally shared by all certification systems:

> [i] There is a set of standards that must be met in order to achieve the certification. [ii] There is a process for verifying that a product, a service, or a person has met those standards. [iii] There is a 'certification mark,' logo, or seal that identifies the standards and the verification that have been fulfilled. [iv] There is a system for auditing to ensure that the certification mark is being used properly and that the product or service or individual continues to meet the standards over time.[15]

The variability in these underlying standards and certification regimes will largely drive the credibility and social value of both a certification regime and its associated mark. While aspects [i], [ii], and [iv] of the above excerpt are *not* the focus of this work, it is important to recognise several of the criticisms and weaknesses of certification marks are directly linked to the nature of the underlying certification. Even though certification is an established and relied upon way to communicate the characteristic of a product in a reliable manner, it is not without its own problems.

3.2.2 Certification as an imperfect institution

Scholars exploring certification systems, generally from the fields of political science, regulation, and environmental policy, note that certification systems are not always effective or successful. Some certifiers lack credibility, sufficient stakeholder buy-in, or lack transparency.[16] Problems with certification as a way to enhance marketplace transparency, as an 'anti-lemon' device, have been described as follows:

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[15] Michael E Conroy, *Branded! How the 'Certification Revolution' Is Transforming Global Corporations* (New Society Publishers 2007) 10.

[16] Auld (n 6); Shana Starobin and Erika Weinthal, 'The Search for Credible Information in Social and Environmental Global Governance: The Kosher Label' (2010) 12 Business and Politics 1; Van Der Ven (n 4).

> While certification may alleviate some concerns about quality, it suffers from several drawbacks. First, certification itself is a credence good, hence the eternal question reminds: *quis custodiet Ipsos custodies?* [Who shall guard the guardians?] Second, if with regard to a certain attribute more than one certifying body exists, each employing different standards, the signals provided may become blurred. Third, consumers may suspect a certifying body that financially depends on its clients. Certifying bodies would therefore need effective quality assurance mechanisms as well, which may not work perfectly.[17]

The institution of certification is imperfect, as 'all human institutions are substantially imperfect.'[18]

Similarly, while there exists a legitimate range of ways in which certification occurs, such as first-party and third-party certification,[19] certification mark law is designed with a third-party certification model in mind. Often, certification is a reliable mechanism for conveying truthful information because certifiers are thought to be independent and transparent, and this is reinforced by not allowing mark owners to carry on in the same business as that which they are certifying.[20] Yet, the industry of certification itself has changed.

A third-party certifier does not necessarily have all the trappings of independence and transparency they may once have had. Today's market for certification is a competitive market in its own right. For example, there are well over 400 various eco or 'green' labels

[17] Katz (n 5) 30.

[18] Neil Komesar, *Imperfect Alternatives: Choosing Institutions in Law, Economics, and Public Policy* (University of Chicago Press 1994) 1352.

[19] See for instance: Auld (n 6); Auld, Renckens and Cashore (n 6); Jørgen Grønnegård Christensen, 'Competing Theories of Regulatory Governance: Reconsidering Public Interest Theory of Regulation', *Handbook on the Politics of Regulation* (Edward Elgar Publishing 2011).

[20] Belson (n 13) s 3.81.

on the market.[21] Even in a more niche market like kosher food labelling, there are multiple certifiers each with their own mark.[22] Where more than one certifier occupies a given market space, a certifier may have to compete with other certifiers for market share. A certifier, therefore, needs to be chosen by producers as offering more value than others. In sectors where third-party certifiers compete with one another for market share, the promulgation of one's own standards dampers the independence and impartiality one may expect of a third-party certifier. This competition, in turn, means that certifiers may be motivated to find ways to accrue value to their certification and associated mark, particularly over competing alternatives.

The need for certifiers to compete with one another is a double-edged sword. On the one hand, this competition is potentially a form of pressure, compelling certifiers to act in a way which will increase their market share. That is, certifiers may act in ways that make them a more valuable brand for consumers so that producers will opt to use their certification mark. One may hope this results in certifiers competing to create the most rigorous standards. The incentive to be the desired certification regime by producers, however, may detract from the 'impartiality' we may assume certifiers have. In the face of competition and pressure, certifiers may compromise their standards or certification process in exchange for greater uptake and popularity. Nevertheless, shielding certifiers from competition is also problematic; certifiers are not immune from anti-competitive

[21] Big Room Inc., 'Ecolabels' (*Ecolabel Index*) <http://www.ecolabelindex.com/ecolabels/> accessed 12 October 2019. The Ecolabel Index is run by a Canadian-based company, but the index includes green labels from around the world.

[22] Timothy D Lytton, *Kosher: Private Regulation in the Age of Industrial Food* (Harvard University Press 2013); Starobin and Weinthal (n 16). See also: Arlene Mathes-Scharf, 'Kashrus Agencies: UK' (*Kashrut.com The Premier Kosher Information Source on the Internet*, 2022) <https://www.kashrut.com/agencies/#__UK> accessed 3 January 2020.

behaviour themselves. As Jeanne Fromer has explained, certification mark owners are capable of anti-competitive and monopolistic behaviour:

> Because the law allows certification standards to be vague, high-level, and underdeveloped, a certifier can choose to exclude certain businesses inconsistently or arbitrarily, even when these businesses' goods or services would seem to qualify for the certification mark (particularly to consumers). Moreover, certifiers can wield their marks anticompetitively, even when a certification standard is clear and complete.[23]

One way to attract consumers, and producers alike, is to have strong market differentiation, something that can be cultivated through brand development.[24] Certifiers are not simply operating as siloed actors in the market. They too must compete and thus may find themselves having to straddle the balance between proving themselves accessible and valuable to producers, while also being recognised and perceived as reliable by consumers. This is a sharp contrast to UL (formerly Underwriters' Laboratories) when they were first on the scene, and the only source of certification for safety certification of electric appliances.[25]

Certifiers today are not only in a market competing against other certifiers. They are also competing against commercial actors that have created purportedly ethical brands and first-party certifiers. For instance, one empirical study considered the impact of the self-declaration of a brand with respect to sustainability practices as compared to the declaration independent certifier. That is, this study considered the impact of NESPRESSO's (a well-regarded coffee brand) statements of sustainability compared to

[23] Fromer (n 9) 123.

[24] Discussed further in Chapter 5.

[25] Conroy (n 15).

FAIR TRADE MAX HAVELAAR (an independent fair-trade certifier).[26] Despite the prominence of third-party certification in the institution of certification marks, researchers here found that the self-declaration influenced consumer preference positively and in 'virtually the same way as independent certification.'[27] Accordingly, 'This result suggests that a company's self-declaration can be as effective as a certification organised by an independent third party.'[28]

Similarly, commercial actors have expanded their identity and brand beyond the quality of products they offered to also encompass the processes behind the production of their products.[29]

> [M]any consumers are now searching for quality that goes well beyond the efficiency, durability, stylishness of the product, and the pleasantness of the purchase and delivery process. For hundreds of millions of consumers in the United States and around the world, <u>quality now means that the social and environmental characteristics of the production process meet high standards</u>. As global sales become increasingly concentrated in retail chains that order a huge diversity of products, <u>the reputation of that chain (and the value of its brand) depends on the social and environmental characteristics of the production processes throughout the whole supply chain</u>.[30]

Where firms have a strong brand that consumers trust they may have good reason to move their 'certifying' practices in-house.[31]

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[26] Sihem Dekhili and Mohamed Akli Achabou, 'Eco-Labelling Brand Strategy: Independent Certification versus Self-Declaration' (2014) 26 European Business Review 305.

[27] ibid 317.

[28] ibid.

[29] Douglas A Kysar, 'Preferences for Processes: The Process/Product Distinction and the Regulation of Consumer Choice' (2004) 118 Harvard Law Review 525.

[30] Conroy (n 15) 14.

[31] Some research suggests that a self-declaration regarding ethical practices can positively influence consumer preference to an equivalent degree of an independent certification. An empirical study was done in France, surveying the response 134 coffee consumers to explore the impact on consumers' preference of a self-declaration responsible label as opposed to an independent certification label. The researchers presented consumers with Nespresso AAA Sustainable Quality

Ultimately, the credibility, quality, and social utility of a certification mark, and certification marks as a legal institution, may at times hinge on the underlying certification and the nature of certification as a private governance institution. Yet, as demonstrated in the sections below, there are some issues with certification marks that fit squarely within the purview of trademark law and the nature of marks as marketplace signs. These are the issues explored in the subsequent sections of this chapter and lie at the heart of this thesis.

3.3 Problems with certification marks

In this section I canvass two problems with certification marks as legal objects. The first considers certification marks as marketplace signs, and the second how certification marks fit in to the larger trademark law landscape.

3.3.1 Certification marks as a marketplace sign

Irrespective of the quality of certification underlying a certification mark, there is a second class of problems associated with certification marks as an institution. Certification marks are not particularly successful at communicating information about the quality being certified. As explored in Chapter 2, there are times where certification marks function more robustly and do provide some measure of information about the quality or characteristic they are certifying. Even where we have a robust certification mark, however, frequently the information needed to fully evaluate the quality of the certification underlying the mark

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logo, which was launched in 2003 in partnership with Rainforest Alliance, versus the FairTrade MaxHavelaar label. The analysis found that while consumers the respondents preferred an eco-labelled coffee, and that a 'responsible label, regardless of its type, ha[d] a favourable influence on consumer preference.'

Dekhili and Achabou (n 26) 316.

is not made available. In better case scenarios we may observe best reference made to the actual source of the certification, that will allow consumers to know where to get more information about the certification, such as a website URL. This is all in contrast to bare certification marks where, as set out in Chapter 2, virtually nothing other than an attestation source is communicated.

Furthermore, even if we accepted a model of bare certification marks and expected consumers to read the regulations underlying them, we are not necessarily in a better position as far as trademark law is concerned. Even in jurisdictions that require certification mark owners to send the underlying regulations to the registry or make them publicly available, consumers finding this information is not as straightforward as we would expect. As Dev Gangjee has noted:

> More generally, in an internet-enabled environment, the detailed regulations governing certification and collective marks seem to be inaccessible from most web-based platforms commonly used to access trade mark data.[32] This is an issue worth emphasising.[33]

Resultingly, we can imagine at least a non-trivial number of instances where a consumer interacting with a certification mark will understand very little about what the mark is purporting to signal other than it is certifying *something*. This lack of meaning in a certification mark's signifier is potentially supplemented by the brand meaning associated with the mark, discussed further in Chapter 5. Nevertheless, it is troubling that as far as trademark law is concerned, certification marks are not generally required to communicate

[32] The regulations are not available from the UK IPO's Trade Mark Search or the EUIPO eSearch Plus, for instance.

[33] Dev Gangjee, 'Book Review: Jeffrey Belson, Certification and Collective Marks: Law and Practice, 2nd Edn (Edward Elgar 2017) 320 Pp.' (2018) 8 Queen Mary Law Journal.

anything in particular about the characteristic or standard they are certifying. This is particularly troubling given the dominant justification of the protection of trademarks, the search costs account.

3.3.2 Certification marks as part of trademark law

As will be explored later in this thesis, certification marks are not the only mechanism by which mark owners obtain marks that perform a certifying function. At times, ordinary trademarks perform a certifying function, as is discussed further in Chapter 5. Consumers encountering a mark performing a certifying function may not perceive it as a certification mark.[34] This raises questions regarding the amount of redundancy in the trademark law landscape, and the potential for confusion where both ordinary trademarks and certification marks are seemingly taking up the same role.[35] This, and the relevance of this inability to distinguish between certification marks and trademarks, is discussed in further chapters.[36]

3.4 Conclusion

In this Chapter, I highlighted some of the issues with certification marks as marketplace signs and as a legal institution. I explained that given the current market for certification marks, and the way they work, they no longer exist as the legal instrument envisioned by trademark statutes. In light of this, I argue that we should revisit our conception of

[34] And it is reasonable to assume most consumers are entirely unaware of the legal nature of the signs they encounter in the market, but rather interpret and interact with these signs on a social level.

[35] Discussed at further length in Chapter 7, section 7.5.

[36] Particularly in Chapter 5, sections 5.3 and 5.4.

certification marks and ultimately reform how certification marks are treated under trademark law.

IV. EXPLORING THE NATURE OF BRANDS

4.1 Introduction

In the previous chapter, I identified some problems with certification marks as currently constituted, and the issues that arise both in the use of certification marks and certification mark law. Neither of these topics has been the subject of significant engagement in the intellectual property literature. This is consistent with the limited amount of literature treating certification marks more generally. Accordingly, one of the most dynamic discussions in trademark law—the relationship between trademarks and brands—has also not been discussed in the context of certification marks. Nevertheless, any discussion of the nature of certification marks, their essential function, and how certification marks convey meaning, would be remiss to not acknowledge the role of brands. The primary purpose of this chapter is to put forward an account of brands to draw on in subsequent chapters.

The subject of brands plays a central role in the trademark law scholarship. There has been a rich dialogue on the relationship between trademarks and brands, a topic which is at its core a conversation about the continuing expanding scope of trademark law:

> The long-run history of the law of trade marks—indeed, the history of all intellectual property law—has been one of expanding subject-matter and

> scope of protection: what is protected, how deep protection should run, and where and against whom it should run.[1]

At the heart of this exploration is the what the ontological relationship between trademarks and brands is, and whether trademarks and brands can analytically remain as distinct and separate concepts and objects. This has led to a vibrant area of scholarship asking what a brand is, who properly owns the proprietary nature of brands and controls brand value, and how the brand dimensions within trademarks figure into what appropriate scope of protection offered by trademark law ought to be.[2]

Trademark law has indeed expanded the scope of protection to marks in service of protecting brand value and the brand-like qualities within trademarks.[3] Many disagree about how this expansion should play out doctrinally, whether it can be theoretically justified, and whether it is desirable as a matter of policy. Nevertheless, it is descriptively true that trademark doctrine has expanded the scope of protection for trademarks in light of the prominence of brands.[4] Thus, being able to recognise what a brand is, and determine

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[1] David Vaver, 'Unconventional and Well-Known Trade Marks' [2005] Singapore Journal of Legal Studies 1, 2. See also: Mark A Lemley, 'The Modern Lanham Act and the Death of Common Sense' (1999) 108 The Yale Law Journal 1687.

[2] For example: Lionel Bently, Jennifer Davis and Jane C Ginsburg (eds), *Trade Marks and Brands: An Interdisciplinary Critique* (Cambridge University Press 2008); Deven R Desai, 'From Trademarks to Brands' (2012) 64 Florida Law Review 981; Dev Gangjee, 'Property in Brands: The Commodification of Conversation' in Helena R Howe and Jonathan Griffiths (eds), *Concepts of property in intellectual property law* (Cambridge University Press 2013).

[3] For instance, trademarks are protected from blurring, tarnishment, and unfair advantage, see for instance the following statutory provisions: Trademarks Act, s 22(1) (Canada); EC EUTM Regulation 2017/1001, art 9(2)(c) (EU); TMA 1994, s 10(3) (UK); 15 USC § 1125 (US).

This expansion has been described and discussed by numerous scholars in various contexts. See for example: Gangjee (n 2); Lemley (n 1); Mark McKenna, 'The Normative Foundations of Trademark Law' (2007) 82 Notre Dame Law Review 1839.

[4] As Jennifer Davis noted, 'there has been pressure on the courts to expand the protection afforded by registration to encompass what are seen as brand values.' Jennifer Davis, 'Between a Sign and a Brand: Mapping in the Boundaries of a Registered Trade Mark in European Union Trade Mark Law' in Lionel Bently, Jennifer Davis and Jane C Ginsburg (eds), *Trade Marks and Brands : An Interdisciplinary Critique* (Cambridge University Press 2008) 67. Similarly, Ilanah Fhima has said,

if certification marks are related to brands as trademarks are, is important to consider in a discussion of how certification marks are regulated, and how the law that governs them is reformed. This chapter addresses both the nature of brands and the relationship between brands and trademarks, with an eye to how this informs a deeper analysis on the nature of certification marks. This provides an important backdrop for the chapter that follows, Chapter 5, where I build on this analysis and examine how brand meaning forms the backdrop of the nature of the certifying function and the meaning signalled by certification marks.

Integral to this discussion is the deceptively simple question: what is a 'brand'? There are many, non-mutually exclusive, answers to this question. In this chapter, I argue that brands are composed of several elements, including trademarks, and that a trademark is a constituent element of a brand and is a vehicle for brand communication. I further argue that a trademark can evoke an entire brand, and that a trademark may be said to embody a brand, as it is a visible form of a brand. A trademark is not the brand itself; *trademarks sustain brands.*

This chapter considers the relationship between trademarks and brands. I begin by introducing the concept of a brand and positioning it within the greater trademark literature. Yet, positioning the concept of brands within the trademark literature is not a

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'These suggest that trade mark law is moving towards protecting aspects of image and branding in a way that recognises how consumers respond to trade marks and the brands that they are a part of, while at the same time acknowledging what trade mark owners need in order to preserve the relationship between their brands and consumers.'

Ilanah Fhima, 'Trade Mark Law Meets Branding?' in Deven R Desai, Ioannis Lianos and Spencer Weber Waller (eds), *Brands, Competition Law and IP* (Cambridge University Press 2015).

straightforward task. I argue that despite the prevalence of the discussion of brands in the trademark law scholarship, there is not a singular definition of a brand, nor a governing account of its relationship to trademarks. Nevertheless, I seek to set out how the trademark law scholarship conceives of brands. I do so by identifying in section 4.3 two different conceptualisations in the literature, differentiating between those that view brands and trademarks entirely distinct objects, and those that consider them as interrelated objects. To understand and help reconcile this divergence, I introduce the idea of *evocation* and *embodiment* to explain why brands and trademarks are distinct objects that can also be interrelated in section 4.4.

I conclude by arguing that we can proceed with a discussion on the nature of certification marks and the certifying function by appreciating two features of brands. Firstly, the relationship of evocation and embodiment between brands and their related signs. Secondly, by recognising what I identify as the *hallmarks* of brands, namely that brands have a brand impression, touchstone objects, and mediate relations as set out in section 4.5.

4.2 The search to define 'brand'

Brands are often discussed in the trademark literature. Yet for such a widely treated topic, the concept of brand has been notoriously difficult for the trademark law community to define: 'The term 'brand' is familiar in marketing and related disciplines but does not have a recognised legal definition.'[5] In fact, there is not yet a convergence from the trademark community on the definition of a brand:

[5] Fhima (n 4).

> Despite its ubiquity in contemporary discourse, there is no agreed definition of 'a brand.' This is true even if one looks only at literature concerned with branding.[6]

There is a straightforward, if not unsatisfactory, answer to why the legal scholarship has not disclosed a definition of a brand; brands are not legal objects.

Unlike a trademark which is defined by legislation, a brand is not a legal object and evades statutory definition. While the constituent part of a trademark, a sign exists without legal recognition, a 'trademark' has an established legal definition:

> A trade mark is a legally constituted sign, whose defining feature is that it is "capable of distinguishing the goods or services of one undertaking from those of other undertakings." By contrast, a brand is notoriously difficult to define, since the attributes emphasised vary depending upon the perspective adopted.[7]

This is not to say that brands are not affected by law. Quite to the contrary, brands are considered valuable assets and are protected, and in some ways, regulated by law, even outside of trademark law.[8]

As simple as this explanation is, it is wholly unsatisfactory. Even without a statutory or judicial definition, it is entirely possible for there to be a consensus regarding a definition, or even a contentious definition, in the scholarship. This lack of a definition

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[6] Davis (n 4) 80. Davis goes on to note that 'Generally, however, a brand is understood to have a value which transcends the product with which it is associated.' (p 81)

[7] Gangjee (n 2) 34. See also, Margaret Chon, 'Trademark Goodwill and Green Global Value Networks' in Matthew Rimmer (ed), *Intellectual Property and Clean Energy: The Paris Agreement and Climate Justice* (Springer Singapore 2018).'While a trademark is a legal term of art, a brand is something much more amorphous.'

[8] Certain aspects of a brand, such as brand images and products may be protected by other forms of intellectual property, such as patents, copyright, and design rights. Similarly, the tort of passing off can be used to protect a brand's image and goodwill, as embodied in a given product. Other parts of a brand's image, such as the behaviour of affiliates and key employees, can be regulated through contract law.

begs the following questions. Why has there not yet been an emergence of a clear definition for 'brands' in the trademark law scholarship? But also, and perhaps more curious, how is it possible to not have a working definition of a brand in the trademark scholarship and yet have such a rich body of both legal and non-legal scholarship discussing brands?

Before delving into what understandings the trademark law community of practice *can* provide on the nature of brands, it is instructive to note that brands are not the purview of trademark law alone. There are other disciplines and fields of practice where brands play an integral role in their work that legal scholars can look to for answers, and sometimes have. Yet even this undertaking is not as fruitful as one may expect, as the range of communities of practice that engage with brands do not share a unitary definition of a brand either.[9] Communities of practice can be understood as 'a group of people joined by conventions, language, practices and technologies.'[10] Several communities of practice outside the trademark law community engage with brands as a concept and object, namely

[9] I agree with Celia Lury's work that brands are a form of *boundary object*, and this explains why various communities of practice can engage with brands, and cooperate with one another, without a shared convergence on the nature of brands, see: Celia Lury, 'Brands: Boundary Method Objects and Media Space' in Andy Pike (ed), *Brands and Branding Geographies* (Edward Elgar Publishing 2011) 52.

Boundary objects is a term first identified by Leigh Star: 'Boundary objects are those objects that both inhabit several communities of practice and satisfy the informational requirements of each of them. Boundary objects are thus both plastic enough to adapt to local needs and constraints of several parties employing them, yet robust enough to maintain a common identity across sites. They are weakly structured in common use and become strongly structured in individual site-use. These objects may be abstract or concrete.' Geoffrey Bowker and Susan Leigh Star, *Sorting Things Out: Classification and Its Consequences* (The MIT Press 1999) 297.

[10] Susan Leigh Star, Geoffrey Bowker and Laura J Neumann, 'Transparency beyond the Individual Level of Scale: Convergence between Information Artifacts and Communities of Practice' in Ann Peterson Bishop, Nancy A Van House and Barbara P Buttenfield (eds), *Digital Library Use: Social Practice in Design and Evaluation* (The MIT Press 2003).This definition is taken from the work of Lave and Wenger, see: Jean Lave and Etienne Wenger, *Situated Learning: Legitimate Peripheral Participation* (Cambridge University Press 1991).

marketing practitioners and scholars, sociological and cultural studies scholars, and consumers.

In the marketing community, by which I include both the practice of marketing and marketing research, brands have a long history. In this community, brands are understood as quantifiable assets that provide a communication role to identify a source of a product, or service, or seller(s). Brands are believed to be able to elicit expectations, attitudes, beliefs, and preferences in the minds of consumers, and thus are seen as a competitive advantage.[11] In this community of practice, the discussion around the nature of brands is oriented around its value as an intangible asset: 'The mainstream marketing literature depicts it as an intangible asset and source of sustained competitive advantage.'[12] The focus is, therefore, on managing brands with an eye to the ability to develop brand image, brand reputation, and correspondingly, brand value. This community is concerned with how brands can be treated such that they can function as valuable assets, that is, they can be valuated, protected, and sold. To some degree this requires identifying the parameters of a brand such that it could be alienated from one entity to another.

[11] The American Marketing Association defines brands as '[A] brand is a name, term, sign, symbol or a combination of them, intended to identify the goods and services of one seller or a group of sellers and to differentiate them from their competitors.' Likewise, the International Organization for Standardization defines brand as a 'marketing-related intangible asset including, but not limited to, names, terms, signs, symbols, logos and designs, or a combination of these, intended to identify goods, services or entities, or a combination of these, creating distinctive images and associations in the minds of stakeholders, thereby generating economic benefits/values.'

American Marketing Association, 'Branding' (2022) <https://www.ama.org/topics/branding/> accessed 4 June 2021; International Organization for Standardization, 'ISO 10668:2010(En) Brand Valuation — Requirements for Monetary Brand Valuation' <https://www.iso.org/obp/ui/#iso:std:iso:10668:ed-1:v1:en> accessed 4 March 2020.

[12] Dev Gangjee, 'Property in Brands: The Commodification of Conversation' in Helena R Howe and Jonathan Griffiths (eds), *Concepts of property in intellectual property law* (Cambridge University Press 2013) 34.

In the sociological and cultural studies community, by contrast, brands are viewed as social objects and institutions.[13] As social objects, brands are identified as, 'the organisation of a set of multi-dimensional relations between products or services.'[14] The focus is on brands as a tool or platform for meaning and mediating various relations, as well as being an embodiment of the cultural logic of our capitalist society.[15] Brands are understood to refer to 'the intersecting relationship between marketing, a product, and consumers.'[16] While this community of practice understands the use of brands in an economic and commercial context, their understanding of brands transcends this role:

> The practice of branding is typically understood as a complex economic tool, a method of attaching social or cultural meaning to a commodity as a means to make the commodity more personally resonant with an individual consumer. But it is my argument that in the contemporary era, brands are about culture as much as they are about economics. As marketers have continually relayed to me, brands are meant to invoke the experience associated with a company or product; far from the cynical view of academics, or beleaguered parents, brands are actually a story told to the consumer. When that story is successful, it surpasses simple identification with just a tangible product it becomes a story that is familiar, intimate, personal, a story with a unique history. Brands become the setting around which individuals weave their own stories, where individuals position themselves as the central character in the narrative of the brand: 'I'm a Mac user,' many of us say smugly, or, 'I drink Coke, not Pepsi.' While brands are visible and often audible, through symbols and logos, through jingles and mottoes, through all means of visual and auditory design—and occasionally, even through a smell!—the definition of a brand exceeds its materiality. More than just the object itself, a brand is the perception—the series of images, themes, morals, values, feelings, and sense of authenticity

[13] Adam Arvidsson, *Brands: Meaning and Value in Media Culture* (Routledge, Taylor & Francis Group 2006); Celia Lury, *Brands, The Logos of the Global Economy* (Routledge, Taylor & Francis Group 2004).

[14] Lury, *Brands, The Logos of the Global Economy* (n 13) 27.

[15] Arvidsson (n 13).

[16] Sarah Banet-Weiser, *AuthenticTM: The Politics of Ambivalence in a Brand Culture* (New York University Press 2012) 4.

> conjured by the product itself. The brand is the essence of what will be experienced; the brand is a promise as much as a practicality.[17]

In addition to brands being a 'form of immaterial capital,' they have become a form of 'virtual real estate' and have come to 'work as a kind of ubiquitous managerial devices by means of which everyday life is managed, or perhaps better, programmed' all in the service of attracting attention that generates brand value.[18] Within the sociological community, brands are a type of information intermediary,[19] a kind of tool or 'mobile platform' where meanings converge.[20] Under this view, 'brands do not so much stand for products, as much as they provide a part of the context in which products are used.'[21]

Another community of practice that meaningfully engages with brands is the community of consumers, albeit a less formal one.[22] Brands play an important role in helping consumers find their desired product in their market and shaping their market preferences. Brands also play a role in the lives of consumers beyond shaping their consumption practices. Within consumer communities, brands are objects of self-expression and a scaffold for identity building. There is also a significant body of marketing and business literature considering how brands interact with consumers, both with respect to consumer identities, as well as notions of brand community:

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[17] ibid.

[18] Arvidsson (n 13) 7.

[19] '[B]rands are information intermediaries, and resemble what has been described in other contexts as a 'two-sided platform.' Chon (n 7) 282.

[20] Arvidsson (n 13) 7–8; Chon (n 7) 282.

[21] Arvidsson (n 13) 8.

[22] By less formal I mean they do not share a practice of work, as per Star's definition of a 'community of practice' but do share understandings, language, etc. which shape the members' identity.

> Researchers have focused on how the personality of a brand enables a consumer to express his or her own self, an ideal self, or specific dimensions of the self through the use of a brand.[23]

Brands play a significant role in shaping consumers' identities, as well as creating communities. This is because brands are a way to signal 'beliefs, attitude, and social identities' to ourselves and others,[24] a critical aspect of forming community. And brand communities do indeed exist:

> A brand community is a specialized, non-geographically bound community, based on a structured set of social relationships among admirers of a brand. It is specialized because at its center is a branded good or service. Like other communities, it is marked by shared consciousness, rituals and traditions, and a sense of moral responsibility. Each of these qualities is, however, situated within a commercial and mass-mediated ethos, and has its own particular expression. Brand communities are participants in a brand's larger social construction and play a vital role in the brand's ultimate legacy.[25]

Accordingly, some scholars have begun to explore how consumer activities in relation to brands are so significant that the meaning of brands is co-created between their owners and consumers (a consideration for those discussing whether trademark law ought to protect trademarks in light of the need to protect brand image and meaning).[26]

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[23] JL Aaker, 'Dimension of Brand Personality' (1997) 34 Journal of Marketing Research 347, 347 (references omitted).

[24] Dan Ariely and Michael I Norton, 'Conceptual Consumption' (2009) 60 Annual Review of Psychology 475.

[25] Albert M Muñiz and Thomas C O'Guinn, 'Brand Community' (2001) 27 Journal of Consumer Research 412, 412. See also Hope Jensen Schau, Albert M Muñiz and Eric J Arnould, 'How Brand Community Practices Create Value' (2009) 73 Journal of Marketing 30.

[26] It is the way in which brands inhabit consumer communities that underscore claims that the meaning behind brands is co-created, see: Pierrre Berthon, Leyland Pitt and Colin Campbell, 'Does Brand Meaning Exist in Similarity or Singularity?' (2009) 62 Journal of Business Research 356; Desai (n 2); Gangjee (n 2); Muñiz and O'Guinn (n 25).

Thus, it makes sense that the trademark scholar community has not, even looking outside themselves, been able to pinpoint with consensus a definition of a brand from an adjacent discipline or field of practice to draw on. The different vantage points that these various communities of practice have into understanding brands results in a multitude of ways to conceptualise and define brands. Yet, these different perspectives are not mutually exclusive. To the contrary, all these communities refer to the same type of object and therefore we can draw from these various understandings in constructing a set of indicia which all brands share.[27]

The trademark law community, however, is composed of actors within the same community of practice. Nevertheless, the present state of the conversation is that the concept of brand, even within the trademark legal community, is that brands sit as a 'blackboard' that '"sit[s] in the middle" of a group of actors with divergent viewpoints.'[28] Why is this so? This next section considers what lies at the heart of this divergence.

4.3 The trademark law community's conception of a brand

The relationship between a trademark and brand is a topic relevant to a far greater normative and more pragmatic issue, the scope of protection trademark law affords. In this section, I suggest that this dissensus around the normative relationship between trademarks and brands is an obstacle to the trademark community converging on a shared understanding of a brand. Accordingly, I locate two general conceptions of brands that

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[27] See Section 4.5.

[28] Susan Leigh Star, 'Chapter 12: The Structure of Ill-Structured Solutions: Boundary Objects and Heterogeneous Distributed Problem Solving' in Geoffrey Bowker and others (eds), *Boundary Objects and Beyond* (The MIT Press 2015) 251.

appear within the trademark law scholarship—one that holds trademarks and brands as *entirely distinct objects*, and another that holds that trademarks and brands are *interrelated objects*.[29] Perhaps a reason for the lack of consensus regarding how brands relate to trademarks is because of the context in which this scholarship generally arises.

The task of explicating the boundaries between trademarks and brands is, therefore, painted by this looming question: if trademarks and brands are ontologically related, such that they are necessarily related objects, must trademark law protect brands too? It is difficult from this body of literature to parse out and isolate what the legal community considers as the internal structure of a brand.[30] Because of the normative desirability of protecting and regulating brands via trademark law is indeed the subject of great debate in the trademark law scholarship that treats brands, it can be difficult to discern, in some instances, whether a scholar is merely describing an existing relationship between trademarks and brands or normatively endorsing a given relationship. Nevertheless, of interest here is the nature of brands themselves, rather than the desirability of allowing trademark law to protect brand image or value.[31]

Despite there not being a legal definition for brands, various definitions have been posited; 'There is a plethora of definitions of "brand" (not a statutory term)'.[32] As Chon

[29] I am mindful that I am seeking to establish an ontological relationship from discussions on the *legal* relationship between trademarks and brands.

[30] Although I argue in section 3.5, even without this we can identify hallmarks of brands that give us a sufficient idea of how brands operate to have discussions about their relationships with trademarks.

[31] As Ilanah Fhima explains, there is a difference between the 'lively debate as to whether it is desirable for trade mark law to protect brand image' and drawing attention to how courts are indeed protecting brand image through trademark protections. Fhima (n 4) 218.

[32] Neil J Wilkof, '"Strong" Trade Marks, "Strong" Brands: What Do We Mean?' (2018) 13 Intellectual Property Law & Practice 341, 341.

explains, 'While a trademark is a legal term of art, a brand is something much more amorphous.'[33]Andrew Griffiths suggests that brands are "a distinctive and exclusive <u>identity</u> that a firm can confer on its products to facilitate their marketing to consumers and to provide a focus for consumer demand and loyalty.'[34] Similarly, brands are considered to be ontological objects that are sufficiently 'closed and transferrable' such that they are capable of being appropriated.[35] While I could point to several more instances where trademark scholars have defined brands for the purposes of their own work, it would be of limited utility because it would, at best, be a piecemeal effort revealing a fragmented view of brands throughout the literature.

No singular understanding of what a brand is emerges from the present trademark law literature. However, the discussion on the nature of the relationship between trademarks and brands implicitly reveals something about the ontological nature of brand vis-à-vis trademarks. In the literature, two ways of conceptualising the relationship between trademarks and brands have emerged. These can be described as, on the one hand, asserting that trademarks and brands are entirely distinct objects, or, on the other hand, asserting trademarks and brands are somewhat equivalent in nature:

> [A] trade mark, legally defined, is viewed <u>as either a feature of or as equivalent to a brand</u>. In the latter case, the message carried by the trade

[33] Chon (n 7) 281.

[34] Andrew Griffiths, 'Brands and Corporate Power' (2018) 18 Journal of Corporate Law Studies 75, 78 (emphasis added).

[35] Gangjee (n 2) 46.

> mark is assumed to be one that goes beyond its role as an indicator of origin, to embody some of the wide meanings that a brand is assumed to carry.[36]

My analysis below is not intended to constitute a comprehensive account of all the views in the trademark literature between trademarks and brands. Nor do I necessarily seek to put a respective scholar's work into a particular camp. Rather, I seek to account for what I have identified as two dominant and reoccurring themes in the literature that are frequently positioned as being at odds with one another. As I will discuss further below, these divergent approaches, despite at times being quite pronounced and seemingly divisive in the literature, are not necessarily as divisive as they may first appear. I argue that trademarks and brands are both distinct and still related objects. Also, it is relevant to note that this below discussion pertains to the relationship between trademarks, as marketplace signs, and brands—not trademark law and brands. Thus, there is an extent to which this discussion is necessarily descriptive. I have focused my analysis on how trademarks and brands relate, and not how trademark law should respond to the relationship between them, as it is this ontological relationship which is instructive for my future discussion on the relationship between brands and certification marks.

4.3.1 Trademarks and brands as entirely distinct objects

One view that permeates the literature is that trademarks, while undoubtedly relevant to brands, are wholly distinct objects. In this conceptualisation, while trademarks remain entirely distinct and separate objects from brands, performing a specific and distinct goal.

[36] Jennifer Davis, 'The Value of Trade Marks: Economic Assets and Cultural Icons' in Y Gendreau (ed), *Intellectual Property: Bridging Aesthetics and Economics* (Themis, University of Montreal 2006) 100 (emphasis added). This quote is said about trademarks specifically within the context of trademark valuation, a context where the differences between trademarks and brands are of vital and practical importance.

Trademarks are a narrower object than a brand; whereas a brand subsumes trademarks, the inverse is not true. A helpful articulation of this view is encapsulated by Jessica Kiser who suggests:

> Brands are categorically distinct; unlike trademarks, they cannot be sensibly understood simply as the development of a consistent identification of source. A trademark is a narrower concept than a brand. A brand is likely to include a trademark (or multiple trademarks) among the creative content that a company releases to the public to differentiate its product's uniqueness and personality from that of another. To illustrate the difference between the role of a trademark and that of a brand, consider that a trademark can be said to answer the question, 'Who made this product?' A brand answers the more existential questions of 'Who is this product?' or 'Who am I if I buy this product?' A trademark answers the first question by indicating the source of the good or service. To answer the brand-related questions requires more than a reference to a trademark or a source.[37]

Within this view, brands are conceived as objects with qualities and values different from those of a trademark. Brands are described as having 'extra qualities, such as transferability and an emotional link to consumers, which are not necessarily shared by trade marks,'[38] therefore, 'brands are regarded as constituting something more than a trade mark as it is legally defined.'[39] Others explain the difference by examining roles of trademarks as opposed brands in the market, for example, Deven Desai argues that trademarks are 'simple symbols identifying product' whereas brands are 'rich symbols that feed business strategies.'[40]

[37] Jessica M Kiser, 'Brandright' (2017) 70 Arkansas Law Review 489, 495-496 (internal citations omitted).

[38] Davis (n 36).

[39] Davis (n 4) 81.

[40] Desai (n 2) 981.

Similarly, the World Intellectual Property Organization (WIPO) in their publications treating brands and trademarks identify that these are two different types of objects, where trademarks are a narrower entity and a legal tool that allows brands to exist:

> In relation to terminology, it is important to point out that this Report employs the term 'trademark' when referring to the specific instrument of intellectual property (IP) protection; the term 'brand' is employed for more general discussions on the use of product and business identifiers in the marketplace. While there are no unique definitions of these terms, this approach appears to be in line with their ordinary meaning.[41]

WIPO's report on brands delineates a bright line distinction between trademarks and brands. Yet their language belies the distinction between trademarks and brands, as the report goes on to attribute the reduction of search costs for consumers in the market to *both* trademarks and brands. This begs the question of how clear the difference between these objects is when they are both attributed a core function of trademarks:

> Consumers, in turn, cannot always discern these characteristics at the moment of purchase; they spend time and money researching different offerings before deciding which products to buy. <u>Brand reputation helps consumers to reduce these search costs.</u> It enables them to draw on their past experience and other information and products – such as advertisements and third party consumer reviews. However, the reputation mechanism only works if consumers are confident that they will purchase what they intend to purchase. The trademark system provides the legal framework underpinning this confidence. It does so by granting exclusive rights to names, signs and other identifiers in commerce….By lowering

[41] WIPO, 'World Intellectual Property Report 2013: Brand - Reputation and Image in the Global Marketplace' (2013) 21 <https://www.wipo.int/edocs/pubdocs/en/intproperty/944/wipo_pub_944_2013.pdf> (emphasis added).

> search costs, trademarks create incentives for companies to invest in higher quality goods and services….[42]

This general point of view is best encapsulated by the idea that while trademarks and brands are necessarily related, there are better understood and treated as distinct objects.

4.3.2 Trademarks and brands as interconnected objects

The other view prevalent in the trademark literature posits that brands and trademarks are *interconnected objects*. While trademarks and brands are distinct *concepts*, they are interrelated *objects*; a trademark envelops brand meaning within its triadic structure, and thus by a trademark embodying the brand itself it becomes brand-like—disintegrating any clear division between a trademark and brand as entirely distinct objects.

Historically, those that endorsed this kind of view articulated a more extreme version of it by asserting that brands and trademarks were considered equivalents. For instance, in their seminal paper on trademark law, William Landes and Richard Posner refer to trademarks and brands as being essentially analogous: 'To perform its economizing function a <u>trademark or brand name (these are rough synonyms</u>) must not be duplicated'.[43] This view, while no longer dominant in trademark literature remains dominant in the mainstream culture. That is, dictionaries tend to define brand predominantly by reference to a trademark.[44] Nevertheless, in the trademark scholarship, scholars that think that trademarks and brands are interconnected objects advance a more nuanced approach.

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[42] ibid 12.

[43] William M Landes and Richard A Posner, 'Trademark Law: An Economic Perspective' (1987) 30 The Journal of Law and Economics 265, 269 (emphasis added).

[44] Tom Blackett, 'Chapter 1: What Is a Brand?' in Rita Clifton and John Simmons (eds), *Brands and Branding* (Profile Books Ltd 2003); Oxford English Dictionary, 'Brand, n.'

Contemporary scholars who describe trademarks and brands are inextricably related as entities conceptualise this relationship differently than merely claiming trademarks and brands are functionally tautologous. Their view is better understood as arguing that the more that trademarks themselves become valuable assets, either because trademarks function like brands, or contain a brand-dimension within them, the more they overlap as objects.[45]

The former view, that trademarks have become so valuable in and of themselves they essentially now can function like brands and have become brand-like, has roots in Frank I. Schechter's work, most notably his seminal article, 'The Rational Basis of Trademark Protection.' He argues that 'the preservation of the uniqueness of a trademark should constitute the only rational basis for its protection.'[46] Schechter's view was premised on observations that trademarks were not merely symbols communicating the goodwill between a product and a sign. Trademarks transcended being symbols that were a proxy for meaning, and that they in and of themselves, had agency to create and perpetuate meaning:

> …[B]ut today the trademark is not merely the symbol of good will but often the most effective agent for the creation of good will, imprinting upon the public mind an anonymous and impersonal guaranty of satisfaction, creating a desire for further satisfactions. The mark actually sells the goods.

[45] Some examples of these views are provided below.

[46] Frank I Schechter, 'The Rational Basis of Trademark Protection' (1927) 40 Harvard Law Review 813, 831.

> And, self-evidently, the more distinctive the mark, the more effective is its selling power.[47]

Schechter goes on to examine how trademarks have come to be used and protected and argues that the following principles regarding the value, use, and protection of trademarks has emerged:

> From the necessities of modern trademark protection mentioned above, on the one hand, and from the decisions emphasizing the greater degree of protection to be given to coined rather than to commonplace marks, the following principles necessarily emerge: (1) that the value of the modern trademark lies in its selling power; (2) that this selling power depends for its psychological hold upon the public, not merely upon the merit of the goods upon which it is used, but equally upon its own uniqueness and singularity; (3) that such uniqueness or singularity is vitiated or impaired by its use upon either related or non-related goods; and (4) that the degree of its protection depends in turn upon the extent to which through the efforts or ingenuity of its owner, it is actually unique and different from other marks.[48]

Again, we see trademarks discussed as something that are valuable in their own right. While Schechter makes virtually no mention of the concept of brands,[49] the way he discusses trademarks as more than 'signs' maps onto how trademark scholars today discuss brands. Schechter's conception of trademarks tracks far closer to what Desai would call a brand.[50]

A similar view is illustrated by some of Jessica Litman's observations in her influential article, 'Breakfast with Batman: The Public Interest in the Advertising Age.'[51]

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[47] ibid 819.

[48] ibid 830–1.

[49] The word appears once in the entire article, in a footnote.

[50] This is in line with Desai's argument that our current system has moved away from trademarks and towards brands, drawing on the work of Schechter.

[51] Jessica Litman, 'Breakfast with Batman: The Public Interest in the Advertising Age' (1999) 108 Yale Law Journal 1717.

Litman argues that while it may have been true at some time that trade symbols have no inherit value, this is no longer the case:

> [T]he descriptive proposition that trade symbols have no intrinsic value has come to seem demonstrably inaccurate….The worth of such [batman] trade symbols lies less in their designation of product source than in their power to imbue a product line with desirable atmospherics….Indeed, in the new orthodoxy, marketing *is* value. American industry seems to proceed on the assumption that we can make the consumer richer simply by revising a product's packaging, without having to make any changes in the product itself.[52]

The value of trademarks, as Litman identifies it, is precisely what others would attribute to brand value, the 'power to imbue' with 'desirable atmospherics.' This is remarkably similar to what Davis called the 'emotional link' of a brand and what Kiser identifies as the existential nature of a product, discussed above.

Another articulation of this view has a more judicious framing; trademarks can do more than indicate source, and the other functions trademarks have the capacity for are brand-like.[53] Dev Gangjee, for instance, suggests the ways in which trademarks are seen to incorporate brand-like functions, a view endorsed and perpetuated by the Court of Justice of the European Union (CJEU):

> Contemporary EU trade mark law goes further [than protecting a mark's ability to signal commercial source] and protects the more expansive brand dimension associated with a successful trade mark. The Court of Justice of the European Union (CJEU) has enabled this by recognising not only the

[52] ibid 1726.

[53] See footnote 4: Fhima (n 4).

> origin indication function of marks, but also their advertising, investment and communication functions as well.[54]

While these additional functions are premised on the origin function, they are now recognised in law as sufficiently distinct such that the origin function can be affected, and infringement of a mark can be found, even where the origin function is unaffected.[55] Under this view, trademarks performing these additional brand like functions give trademarks a brand-like dimension.[56] By trademarks embodying these aspects of brands, they become not only a part of a brand, but also the brand itself. Yet, as Gangjee explains, trademarks behaving in brand-like ways does not change the fundamental constitution of a trademark, rather 'It is the signified [of the mark] that is commodious enough to incorporate the brand dimension.'[57] Thus, trademarks have a brand-dimension within them, expressed through their capacity to perform brand-like functions;[58] this idea appears to have growing acceptance among European trademark scholars.[59]

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[54] Gangjee (n 2) 29.

[55] Case C-487/07 L'Oréal v Bellure [2009] ECR I-5185; Max Planck Institute and for Intellectual Property and Competition Law in Munich, 'Study on the Overall Functioning of the European Trade Mark System' (2011) para 2.719 <https://op.europa.eu/en/publication-detail/-/publication/5f878564-9b8d-4624-ba68-72531215967e/language-en>.

[56] See for example Chronopoulos' discussion on how the advertising function helps bolster and protect a brand image: Apostolos Chronopoulos, 'Legal and Economic Arguments for the Protection of Advertising Value through Trade Mark Law' (2014) 4 Queen Mary Law Journal of Intellectual Property 256, 257.

[57] Gangjee (n 2) 31.

[58] These 'brand-like' functions include the functions, in addition to the origin function, the CJEU recognized, such as a trademark's communication, investment, and advertising function. See also: Martin Senftleben, 'Function Theory and International Exhaustion: Why It Is Wise to Confine the Double Identity Rule in EU Trade Mark Law to Cases Affecting the Origin Function' (2014) 36 European Intellectual Property Review 518, 518.

[59] See for instance Bailey discussing how the communication function, related to the investment and advertising function, seems to 'relate to the ability of a mark to communicate a brand image or psychological image in the broader sense.' Andrew Bailey, 'Trade Mark Functions and Protection for Marks with a Reputation' (2013) 8 Journal of Intellectual Property Law and Practice 868, 871. See also Porangaba questioning to what extent 'consumers really assimilate the brand-like message

4.4 Addressing the divergence - evocation and embodiment

The divergence expressed in the trademark literature with respect to the relationship between trademarks and brands is descriptive. That is, the scholars identifying the relationship between how trademarks and brands exist do so as a precursor to a larger conversation. The problem, therefore, is that although the above two themes in the literature speak to the nature of trademarks and brands, it is inevitably related to the ways in which trademarks are protected by law.

Take, for example, Martin Senftlben's position on the relationship between trademarks and brands. He posits that the CJEU has 'broadened the scope and reach of EU trademark protection, in particular in the area of brand protection' thus providing more 'generous and readily available brand protection'.[60] This is a descriptive position, and one that he is critical of, warning of the 'unjustified' temptation towards brand exploitation rights.[61] He argues that by the CJEU broadening the range of protection of trademarks to protect functions other than the origin function, the ability to invest in brand image is now a (protectable) function of a trademark.[62] While we *could* parse out the part of this analysis that pertains to the relationship between trademark and brands, to do so is somewhat artificial. Discussions on trademarks and brands are necessarily viewed through the lens of

that other trade mark functions purport to protect.' Luis H Porangaba, 'A Contextual Account of the Trade Mark Functions Theory' (2018) 3 Intellectual Property Quarterly 230, 252.

[60] Martin RF Senftleben, 'Keyword Advertising in Europe - How the Internet Challengers Recent Expansions of EU Trademark Protection' (2011) 27 Connecticut Journal of International Law 39, 73.

[61] Martin RF Senftleben, 'Keyword Advertising in Europe - How the Internet Challengers Recent Expansions of EU Trademark Protection' (2011) 27 Connecticut Journal of International Law 39.

[62] Martin Senftleben, 'Overprotection and Protection Overlaps in Intellectual Property Law - the Need for Horizontal Fair Use Defences' in Annette Kur and Vytautas Mizaras (eds), *The structure of intellectual property law: can one size fit all?* (Edward Elgar 2011).

trademark law and one's normative views on it. Luis Porangaba has likewise argued there are cases where European courts have expanded the scope of protection afforded to trademarks 'to conform to market realities, revealing a more comprehensive understanding of brands.'[63]

Yet, these two ways to conceptualise the relationship between trademarks and brands are not mutually exclusive. First, there is a consensus between scholars that trademarks and brands are related, yet distinct, *concepts*. A 'trademark' and a 'brand' are not properly synonymous terms, yet trademarks inescapably feature in a brand's existence. Brands are neither reducible to just a trademark, or group of trademarks alone. Nor can brands simply be reduced to their external characteristics such as brand names, symbols, trademarks, or designs.[64] There are few scholars today that would presume to use these words entirely interchangeably, even if the ordinary person would. Nevertheless, the scholars that hold the view that trademarks and brands are entirely distinct entities would object to the view that trademarks have become brands in and of themselves or have developed a brand-dimension within the structure of a trademark. I suggest, however, that when we consider the relationship between trademarks and brands with respect to a trademark's ability to evoke or embody a brand, the distinction between these two conceptions collapse and we can see that trademarks and brands are both distinct, yet at times, related objects.

[63] Luis H Porangaba, 'Putting Functions in Context: Reconceptualising the Scope of Trade Mark Infringement' (DPhil Thesis, University of Oxford 2019) 230. See, for example: *Hearst Holdings Inc v AVELA Inc* [2014] EWHC 439 (Ch).

[64] 'Brands, then, are emergent products that are not reducible to any simple combination of product properties.' Wolfgang Grassl, 'The Reality of Brands: Towards an Ontology of Marketing' (1999) 58 The American Journal of Economics and Sociology 313, 323.

In this section, I argue that the different views of the relationship between trademarks and brands as set out in section 4.3 are not as divisive as they might seem. Because both views are filtered through the lens of the implications of this relationship on the scope of trademark law and the legal protection of brands, they do not suitably consider the ontological nature of trademarks and brands. Accordingly, even though I set out the divergence while focusing only on the descriptive relationship between trademarks and brands, it is still be coloured by an underlying normative disagreement regarding the scope of trademark law. That is, the disagreement may appear descriptive but necessarily and inextricably driven by some normative discord. Against this backdrop, I situate an ontological relationship between brands and trademarks abstracted from the issue of trademark law's protective ambit. I suggest that the nature of trademarks is such that this can evoke and embody brands. Nevertheless, recognising this relationship does not commit us to any particular view on the ambit of trademark law's protection for trademarks nor brands.

4.4.1 Trademarks evoke brands

Where a consumer is familiar with a brand, an associated trademark has the capacity to evoke its brand. Where Cathy sees a coffee cup with the STARBUCKS Siren, or a pair of running shoes with the NIKE swoosh, if she is familiar with these brands, it is almost inevitable that she will not see these signs as narrow symbols of source but as an indicator of the brand itself. This is often true even where merely the signifier is seen, divorced from any referent.[65] Conversely, where a consumer is not familiar with a brand, a trademark will be perceived as *just* a trademark. Trademarks may stimulate a brand, by bringing a brand to mind. Thus, while trademarks may evoke a brand, a trademark is a distinct object and does not constitute the entirety of the brand itself.

Brands, as objects, are not reducible to a single, or even group, of its trademarks. Consider, for instance, the McDONALD'S brand. McDONALD'S has a very strong and popular trademark that acts as its dominant logo—the golden arches. Even this iconic trademark is not tantamount to the brand. That is, a trademark that serves as the dominant logo is likely a primary or major vehicle for the brand and serves as its most efficient retrieval cue. While the golden arches are a strong and distinctive trademark, the fact that I can also identify the McDONALD'S brand by the trademark 'i'm lovin' it' or the 'McDonald's' wordmark means that the brand is not reducible to the golden arches alone. Nor are the golden arches necessary to identify the brand or call it to mind although they may be sufficient. Even something more abstract than a dominant logo, such as seeing a green awning may bring to mind the STARBUCKS brand.[66] All the component parts of a brand thus serve as a network, where the retrieval of one brand element can 'act as a retrieval cue for the other.'[67]

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[65] There is no better evidence of this than the myriad of brand identifying online quizzes, for e.g., JetPunk, 'Brand Logos Quiz #1' (21 May 2019) <https://www.jetpunk.com/user-quizzes/139806/brand-logos-quiz-1> accessed 16 February 2020.

[66] Specifically, Panton #3425 Green, or a green similar to it.

[67] Grassl (n 64) 323. Grassl explains this more fully with reference to Gestalt theory: 'In the language of Gestalt theory, brands are *founded* on products and require special intellectual acts in order to be grasped by consciousness. They have, in Christian von Ehrenfels' sense, a higher degree of "organic unity." Brands, then, might be viewed as Gestalten that exist in reality. Brands have a value greater than the sum of their tangible assets, which explains the phenomenon of brand equity. It is the "closure" of brand elements, their degree of unity and integration, which facilitates brand awareness, since each piece of information can act as a retrieval cue for the other. This makes us understand

Brands can thus be envisaged as a central node of an associated network constituted by a consumer's learned connections between a brand and a variety of cues, attitudes, and symbolic meaning—a cognitive schema.[68] When conceived as a cognitive schema, it becomes clear how a trademark can evoke a brand; any trademark that is a part of this network can act as a retrieval cue for the brand.[69]

Therefore, where a trademark is part of a brand that someone is familiar with, simply seeing the trademark will bring the brand to mind. Even those scholars who maintain that trademarks and brands are distinct objects would almost certainly accept the proposition that a trademark can evoke a brand. It appears to be common ground in the trademark law community that brands and trademarks are related concepts, and the ability of a trademark to evoke a brand is a cornerstone of this relation.

4.4.2 Trademarks embody brands

The issue which is more contentious between trademark scholars is whether trademarks and brands are *interrelated* objects. As explored in section 4.3 above, some argue that trademarks and brands are related objects because trademarks act like brands or have brand-like dimensions. That is, where a trademark evokes a brand for a consumer, the signified the trademark carries has the capacity to engage the brand's impression. One no longer buys just a computer from Apple or a coffee at Starbucks, they buy an APPLE

the extraordinary persistence of "deep" brands (or "strong" Gestalten, *i.e.* wholes made up of parts other than natural parts). They are more integrated wholes than weaker brands.'

[68] Gangjee (n 2) 35, footnote 21.

[69] For a further discussion on how the cognitive science research relates to how trademarks are perceived by consumers, see: Rebecca Tushnet, 'Gone in Sixty Milliseconds: Trademark Law and Cognitive Science' (2008) 86 Texas Law Review 507.

computer or STARBUCKS coffee. The signified of the mark encompasses a consumer's thoughts and attitudes towards the entire brand. Let us consider the case of consumer Cathy.

Cathy has general positive feelings about NIKE as a brand. When she thinks of NIKE she thinks of strong female athletes, discipline, motivation, and achievements. She has been enjoying NIKE running shoes for several years and finds them to be of good quality. She gets a little extra joy when she goes for a run in her NIKE running shoes in public. Let us say Cathy is a fan of the NIKE brand. That is, with one small exception, she does not like their leggings. When Cathy sees the NIKE 'swoosh' logo on her running shoes, the trademark in question is not just the swoosh; the swoosh is just the signifier. The mark, in its entirety, is made up of the signifier, the signified, and, crucially here, the referent. So, when Cathy sees the 'swoosh' signifier on a pair of running shoes, the goodwill contained in the signified of this mark, is first and foremost in relation to the running shoes. Yet, where a consumer is familiar with an associated brand, such that the trademark *evokes* the brand the story can get more complicated.

Given that Cathy knows of the NIKE brand, when she encounters this pair of NIKE running shoes her thoughts, beliefs, and attitudes about these shoes cannot be divorced from her view on the brand itself. Similarly, her experience with these shoes will feed into her thoughts and opinions about the brand. Not only does Cathy's view of NIKE's brand potentially shape her impression that NIKE shoes have elicited from her, her thoughts and experiences with NIKE running shoes will help to inform her view of the brand. After a good experience with the durability and quality of NIKE running shoes, Cathy may also think of NIKE as a brand with high quality standards. In this scenario, we can say that the

NIKE trademark not only evokes the brand but also embodies it. Cathy's experience with a trademark on a specific product accrues back to the brand.

This is not to say that trademarks do not have their own meaning contained in the signified that may vary from product to product. Consider, for instance, Cathy's dissimilar experience with NIKE running shoes and NIKE leggings. Cathy has had great experience with NIKE running shoes, and the signified of this mark is positive. For Cathy, her views on NIKE running shoes will be nearly identical to her thoughts and attitudes about the entire brand as her running shoes make her feel extra athletic, disciplined, and motivated. When she wears her NIKE running shoes, her feet never get sore, the laces never loosen, and she achieves her running goals with ease. She might also see NIKE as a brand that empowers her, is for athletes, and has high performance quality gear. That being said, when Cathy sees the exact same NIKE 'swoosh' logo on a pair of leggings the goodwill within *this* signified may differ. Although the signifier may be identical, the trademark is not. The referent here are leggings, and the signified in this case is the reputation and meaning Cathy attributes to the signifier on a pair of leggings. Since Cathy has had a negative experience with NIKE leggings, the signified of this trademark contains a different meaning. In this instance while the signifier still evokes the NIKE brand, the signified is something like 'poor quality' or 'unflattering fit' or 'I overheat, and these leggings slow me down'. None of these thoughts are consistent with Cathy's views on NIKE as a brand, although this may in turn, modify her view of the brand. Cathy may also rationalise this negative experience as a one-off experience and may explain away experiences with the leggings as an incongruency. So, while a trademark can embody a brand, it always does so as a sub-component of the brand, and as its own distinct object.

Therefore, the arguments that a trademark embodies a brand are justifiable, but to a point. The signified of a trademark certainly can, and often does, embody a brand. Nevertheless, the reputation of a trademark is not the same as the view of an entire brand, if for no other reason that a reputation of a trademark is, and ought to be understood as, rooted in the connection between the signifier and referent in question. A brand's reputation is not similarly constrained to a given product, as will be discussed in section 4.5 below, nor is a brand's reputation constructed only from information resulting from the use of a given product. For instance, a news article about NIKE's abhorrent labour practices, which do not affect the quality of any product but rather its moral standing, can modify Cathy's impression of NIKE as a brand.[70]

If when Cathy sees the NIKE 'swoosh' on a new product, such as an energy granola bar for runners, one can see again how trademarks undoubtedly evoke and embody a brand. With no previous experience with the product itself, the signified for this referent can only be occupied by Cathy's expectations, feelings, and attitudes towards NIKE as a brand, modified by her perception of other secondary information regarding the product, such as any advertising campaign she has experienced, reviews, or certification marks the product carries. That is, the non-trademark information from the brand can be channelled into her understanding of the brand and consequently the signified of a new trademark, similar to her experience with previously products bearing NIKE's trademark.

[70] Michael E Conroy, *Branded! How the 'Certification Revolution' Is Transforming Global Corporations* (New Society Publishers 2007) 11–13; Vicky Xiuzhong Xu, 'Uyghurs for Sale: "Re-Education", Forced Labour and Surveillance beyond Xinjiang' (Australian Strategic Policy Institute 2020) Policy Brief 26/2020 <https://www.aspi.org.au/report/uyghurs-sale>.

In conclusion, where a consumer is familiar with a brand, a trademark, even viewed in the abstract, has the capacity to evoke it. Conversely, where a consumer is not familiar with a brand, a trademark will be perceived as *just* a trademark. Trademarks may stimulate a brand, by bringing a brand to mind. Thus, while trademarks may evoke a brand, a trademark is a distinct object and does not constitute the entirety of the brand itself. In this way, trademarks sustain brands.

4.5 Hallmarks of a brand

Brands are more amorphous entities than trademarks. Because they are not legally created, there are no required constituent parts of a brand, and the contours of brands as objects are not legally defined. Yet, despite divergence on the meaning and nature of a brand, trademark scholars, lawyers, and policy makers cooperate in the service of thinking critically about our legal system, reforming and shaping the rules that affect brands, and implement these rules. Nonetheless, the outer boundaries of a brand are known, and there are some aspects essential to all brands: brands have an impression, a touchstone object, and mediate relations. In the following subsections, I will explore each component in turn, focusing where possible on the ways trademarks feature into these aspects of brands.

4.5.1 Brand Impression

All brands make an impression. A brand impression, held by the recipient or viewer engaging with the brand, can be understood as referring to the mental associations or ideas, thoughts, and feelings a consumer has about a brand. This can be thought of like the goodwill or repute of any trademark. While the marketing literature sometimes refers to this aspect of brands as a 'brand image', I refer to it as an impression, which I think is a more apt term. I use the term brand image, more narrowly, to refer to the visual aspects of a brand, which include but are not limited to, a brand's associated trademarks.[71]

A brand's impression, that is the ideas and feelings one holds about a brand, will be shaped, and influenced by many aspects of a brand, such as the visual aspects or identity of a brand.[72] Trademarks are thus a major component of a brand's impression, as trademarks are necessary to create and maintain a brand's image, a critical component of their impression.[73] Given the way trademarks are frequently used, they are likely to be the strongest and most recognised identifiers of a brand. A brand impression, nevertheless, is not the result of just its trademarks. When considering the visual marketing material of a brand, a trademark is only one component of a greater brand image and brand impression. A brand's visual identity involves several things in addition to trademarks such as, for example, colour palettes, font selections, store front designs, and store displays. This is evident by looking at any branding guide.

While trademarks play a key role in these documents, there are several other elements at play. Consider, for instance, STARBUCK's branding guidelines. These guidelines specify the correct way to use their main trademark, variations of this mark, specific fonts to use, complementary fonts, and complimentary colours. For instance, the STARBUCKS Creative guide specifies the main corporate imaging strategy and sets out

[71] Although like most aspects of brands the precise definition of a brand image is also the source of long-standing debate, see for example: Dawn Dobni and George M Zinkhan, 'In Search of Brand Image: A Foundation Analysis' (1990) 17 110.

[72] As well as other sensory aspects, such as the sounds, smells or tastes a brand makes use of.

[73] As discussed further below, given that a brand mediates relations and refers to a touchstone object, a brand requires some sort of perceptible form, albeit visual or not. A brand image, which includes visual and non-visual aspects, is precisely this – the perceptible form of the brand.

guidelines for not only the use of their trademarks (referred to as logos) but also allowable colours, typography, voice, illustrations, and photography.[74] These branding guides frequently dictate aspects of advertising, marketing, and packaging that are outside the ambit of trademark practice and management. A brand's identity may extend beyond these visual elements and include things like the product designs themselves, social-media presence, store-layouts, and even scents.[75]

A brand's impression is also made up of non-visual aspects such as a consumer's experiences with the product, the reputation of the product or the producer of the product, and other brands with which the brand has a relationship.[76] While several aspects of a brand impression are controlled by the brand owner, not all elements are. Product reviews, the other brands with which a brand associates with, the reputation of potential sponsors, and a consumer's own opinion of a brand's products are all things that can significantly shape a consumer's impression of a brand. While brands may play a role in the actions and features that compose their impression, they cannot control them entirely. A brand's impression is held by the recipient of the brand so the resulting brand impression is indisputably affected by its audience. As much as a brand owner may control several aspects of their brand, the resulting impression is always at least somewhat outside their

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[74] Starbucks, 'Theory | Starbucks Creative Expression' (2021) <https://creative.starbucks.com/theory/> accessed 11 August 2020.

[75] Scents are used in the retail sector to create immersive brand experiences: Michael Keenan, 'How Scent Marketing Works for Retailers' (*Shopify Retail Blog*, 1 November 2021) <https://www.shopify.ca/retail/scent-marketing>.

[76] These co-branding relationships are also considered by brand owners. Starbucks, for instance, has a branding guidelines for those using a 'We proudly serve Starbucks' logo to set out their co-branding requirements: Starbucks (n 74).

control.[77] The corollary of this is that brand meaning has the capacity to be individuated.[78] The brand impression is the result of the recipient's ultimate interpretation of the constituent parts of a brand. Thus, while there may be some consistency among recipients, especially those with shared cultural backgrounds, how a brand is viewed will differ from person to person.

One may object that in my framing of a brand's impression I have insufficiently appreciated the role of trademarks in creating and cultivating a brand. One might reply that while a trademark is only an aspect of a brand's impression, and a necessary component of a brand. I agree a trademark *is* a critical component of a brand's impression. Although a brand can exist without an associated registered trademark, it would be difficult to imagine a brand today functioning without any sign or symbol that acts as its perceptible face. A brand's image is key to its impression. I also agree that a trademark can shape and impact the brand impression. Nevertheless, any given trademark can be replaced without the brand coming to an end, as is often the case when a brand owner decides to re-brand or refresh their branding.

In the process of re-branding a brand owner decides to change its image, or identity, with the goal of creating a new or modified brand impression.[79] Often, re-branding involves changing the visual elements of a brand's identity, such as the trade name, trademarks, and

[77] The co-creation literature speaks about this heavily: Gangjee (n 2).

[78] Barton Beebe, 'The Semiotic Analysis of Trademark Law' (2004) 51 UCLA Law Review 621; Graeme B Dinwoodie, 'The Death of Ontology: A Teleological Approach to Trademark Law' (1999) 84 Iowa Law Review 611.

[79] Mark McKenna has considered related issues that arise in the context of 'brand extension and brand alliance' see: Mark McKenna, 'Testing Modern Trademark Law's Theory of Harm' (2009) 95 Iowa Law Review 63.

advertising themes. Re-branding successfully occurs in a range of products, from candy bars—for example, what is now known as the TWIX chocolate bar was once known as RAIDER[80]— to luxury brands, such as BURBERRY.[81] There are also, inevitably, re-brand failures. These failures appear to be related to a failure on the part of the brand owner to consider how the brand is changing, rather than any underlying product change itself.[82]

The ability of a firm to re-brand is emblematic of the idea that a brand is greater than its trademarks and image. If a brand was reducible to its trademarks, then it would be difficult to conceive of how a product or company could go through a re-brand without simply ending and becoming a new brand, ie a new object altogether. When a product is re-branded although the brand may re-position itself in the market or attempt to create market differentiation, several associations of the prior brand carry through; there is continuity. In fact, the more continuity there is, such as the more brand trust that carries over in the re-branding process, the more successfully a re-brand will be.[83] If a brand were merely a trademark, it would be impossible to re-brand where a dominant trademark is abandoned or changed. Thus, while changing the elements of a brand's impression, such as a trademark, does not end a brand's existence, it changes it.

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[80] ibid; Véronique Pauwels-Delassus and Raluca Mogos Descotes, 'Brand Name Change: Can Trust and Loyalty Be Transferred?' (2013) 20 Journal of Brand Management 656.

[81] Angela Ahrendts, 'Burberry's CEO on Turning an Aging British Icon into a Global Luxury Brand' [2013] *Harvard Business Review* <https://hbr.org/2013/01/burberrys-ceo-on-turning-an-aging-british-icon-into-a-global-luxury-brand> accessed 11 August 2020; Christopher Moore and Grete Birtwistle, 'The Burberry Business Model: Creating an International Luxury Fashion Brand' (2004) 32 International Journal of Retail & Distribution Management 412.

[82] See Chapter 9: Matt Haig, *Brand Failures: The Truth about the 100 Biggest Branding Mistakes of All Time* (Kogan Page Publishers 2011).

[83] Pauwels-Delassus and Mogos Descotes (n 80).

While trademarks play a key role in brand creation and management through being a critical element of a brand's image, a brand's impression is not restricted to nor synonymous with its trademarks. Rather, a brand's ability to protect and control their trademarks will assist in creating and sustaining their brand's image, and ultimately impression.

4.5.2 Touchstone object

A brand's touchstone object, unlike a brand's impression, does not intimately involve the use of a trademark. Rather it explains the nature of brands vis-à-vis trademarks. A critical difference between a trademark and a brand, in many ways appears, therefore, to be the role of a referent. Mainly, that while every proper trademark is composed of the triadic structure Barton Beebe identified, a brand is not. A brand has no specific referent. Unlike trademarks which become a 'floating signifier' without a referent, brands are more akin to what Rosemary Coombe calls the 'quintessential self-referential sign.'[84] Thus, while a trademark needs to have a referent to properly function as a trademark, a brand does not. The implication of this is not that a brand is merely a collection of signifiers and signified meaning; a brand is not an object that exists in reference to only abstract ideas. Rather, a brand requires what I call a *touchstone object*.

A touchstone object is something the brand is anchored to, including a broader group of referents. Although I have been using the term 'brand' in this chapter as a noun, here I switch gears and consider brands in action. Thinking about a touchstone object

[84] See: Beebe (n 78) 626; Rosemary J Coombe, *The Cultural Life of Intellectual Properties* (Duke University Press 1998).

requires us to think about branding as a verb. A brand is not created in the abstract, a brand arises from branding *something*; it is this 'something' that I call a touchstone object.

The easiest types of touchstone objects to consider are those which are based around a clear set of referents, such as NIKE where the touchstone object is, broadly construed, athleticwears and accessories. While trademarks are a badge of origin for a specific product, a brand is a transferable 'origin' identifier between products. The relationship between a brand and touchstone object is not the same as a trademark to its referent. While the same signifier may be used on several different products, properly speaking these are not the same *trademark* when used on different products – as a trademark considers the entire triadic structure. Even for a brand like STARBUCKS that originated as a coffee roastery and chain of coffeehouses, it is well accepted their touchstone objects extend beyond coffeehouses that serve food. The STARBUCKS brand now also encompasses a range of products from breath mints, to breakfast sandwiches, playlists on SPOTIFY sharing the music playing in their locations, to their own line of drinkware and coffee machine merchandise. Rather than be constrained by a product, a brand has an identity that can be transferred between products:

> A brand asset's unique identity is secured through legal recognition which firstly, protects the seller from competitors who may attempt to provide similar goods and or services and secondly, enables it to exist as an entity in its own right and therefore be capable of being transferred independently of the goods/or services to which it was originally linked.[85]

A brand's relationship to associated products is part of what requires us to distinguish between a referent and a touchstone object. A referent, in the trademark sense, is too narrow

[85] Davis (n 36).

a concept. Referents must, necessarily, be listed in the classes of goods and services for which trademarks are registered. Accordingly, the class of goods and services, while extraordinarily broad is not infinite and lists *commercial* goods and services. This would exclude other entities that are not commercial in nature, such as political parties, that still have brands.[86]

While touchstone objects, therefore, includes commercial products or producers, this term captures a broad range of entities. As the use of brands expands, so too does the type of touchstone objects they attach to. For instance, a musical group can be a touchstone object for a brand, as can a university, or even a political party. The use of brands on a wide range of touchstone objects is emblematic of how our capitalist society has commodified a variety of human relationships and institutions beyond that of commerce:

> The term 'brand' has now permeated just about every aspect of society, and can be as easily applied to utilities, charities, football teams and even government initiatives as it has been in the past to packaged goods. Yet there still seems to be a residual and stubborn belief that brands are relevant only to consumer goods and commerce. Clearly, this is nonsense when every organisation has 'consumers' of some kind; furthermore, some of the world's most valuable brands are business to business, but that does not make them any less 'consumers'. However, rather than get deeply embroiled in the broader meanings of consumption, it is probably more helpful to talk about audiences for brands today. These can be consuming audiences, influencing audiences or internal audiences. All of these

[86] Despite the commercial nature of the classes of goods and services trademarks are registered in association with, and the non-commercial nature of political parties, some political parties still make use of registered trademarks. For instance, the UK Labour Party holds registered trademarks in the UK: UK trademark numbers UK00001491993 & UK00002146503.

> audiences need to be engaged by the brand—whether it is a product, service, corporate or not-for-profit brand—for it to fulfil its potential.[87]

The notion that 'every organization has "consumers"' is aligned with Adam Arvidsson's view that brands ought to be understood as 'a paradigmatic embodiment of the logic of information capitalism.'[88]

What then is the relationship then between a brand and its touchstone object? A brand 'supervenes' on an object, that is, the brand is dependent on the touchstone object for its existence.[89] In this way, a brand is not only anchored to its touchstone object, but requires a touchstone object to shape its existence:

> It may well be that 'a brand gives products their meaning and direction.' But it can do so only within the <u>limits defined by the affordances of the product</u> …. 'Though we can accept that the brand starts with a product, it is not the product: <u>the brand is the sense, the meaning of the product.' In other words, the brand supervenes on the product, or is founded on it</u>.[90]

The implication of this relationship is that not all brand concepts will work for any given touchstone object; this is of particular interest in the marketing literature where there is a lot of consideration of how to cultivate the most effective branding. Consider, for example, where the touchstone object for a brand is a product line of writing implements. One cannot, for example, successfully brand pens as being the 'healthy' option, although they may be branded as 'professional,' 'stylish,' or 'sustainably made.' Trying to incorporate

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[87] Rita Clifton, 'Introduction' in Rita Clifton and John Simmons (eds), *Brands and Branding* (Profile Books Ltd 2003) 6.

[88] Arvidsson (n 13) 13.

[89] Supervene in the philosophical sense, as defined by the Oxford English Dictionary: 'Of a quality or property: to be dependent on (or upon) a further underlying quality or property for its existence; to be present by virtue of the presence of other specified attributes.' See also: Grassl (n 64).

[90] ibid 331 citing Jean-Noël Kapferer, Strategic Brand Management (Free Press, New York 1992) (in text citations omitted, emphasis added).

‘health’ into this brand’s impression is bordering on absurd; pens cannot be healthy or nutritious (but could be unhealthy if made with toxic materials). Accordingly, a brand is restricted and limited to the nature of their touchstone object, here their product category, to some extent.[91] This also explains the limits of brand extensions (‘the practice of introducing new products under existing brands’),[92] and brand alliances (‘partnership[s] between two entities in which efforts are combined for a common interest or to achieve a particular aim’).[93] A touchstone object can, therefore, restrict how a brand is developed and received. As explained by marketing literature, ‘There are non-arbitrary, constraining conditions for successful branding.’[94] This provides a partial explanation for why some branding efforts succeed and others fail.

A misalignment between brand and touchstone object is analogous to what Matt Haig terms, ‘extension failures’, where a company already has a successful brand and seeks to add a new product or new product category to an already established line.[95] Examples of such failures include the motorcycle brand HARLEY DAVIDSON’s failed attempt into perfume, the baby food manufacturer GERBER’s failed attempt into the adult food market, and BIC, the producer of disposable pens, razors, and lighters, failed attempt into the women’s lingerie with a line of disposable pantyhose.[96]

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[91] Brands are accordingly more successful when they help to differentiate their touchstone objects in the market, ‘That is because brands have value only where consumers have choice, which rarely exists in public services’ Blackett (n 44) 9.

[92] McKenna (n 79) 94.

[93] Nicole L Votola and H Rao Unnava, ‘Spillover of Negative Information on Brand Alliances’ (2006) 16 Journal of Consumer Psychology 196, 196.

[94] Grassl (n 64) 322–3.

[95] Haig (n 82).

[96] ibid 4.

An abstract or intangible object can still constitute a proper touchstone object. While I do not attempt here to delineate the precise limits between a touchstone object and its brand, I think it is useful to note the variation in this relationship that must exist. The variability of a tenable touchstone object becomes clear when considering a brand like VIRGIN. Haig himself notes that VIRGIN's ability to successfully extend their brand is an example of a (rare) success story that 'encourage(s) other brands to follow suit.'[97] The VIRGIN brand claims to not have a product category. If accepted this would pose a strong challenge to my argument that brands have touchstone objects. Nevertheless, I reject the idea that VIRGIN has no touchstone object merely because it has no obvious thematic or logical product categories. Rather, the VIRGIN brand provides an illustration of a brand that engages a touchstone object, where the nature of its touchstone object is certainly a case on the margins.

VIRGIN is a notoriously 'flexible' brand. [98] As Richard Branson, the founder of the Virgin Group has said, 'we've never been constrained by the "what business are we in?" question'.[99] The VIRGIN brand is not being built around a set of products:

> The idea, Branson says, is to 'build brands not around products but around reputation….I call these "attribute brands": They do not relate directly to one product – such as Mars bar or a Coca-Cola – but instead to a set of values.' While the wholesale adoption of the Virgin model is rare, it is associated with a more widespread transformation in the organization of production among producer markets. This involves a shift in the locus of control such that firms that might once have understood themselves as manufacturing firms come to see themselves as marketing firms, or rather,

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[97] ibid 58.

[98] Celia Lury, 'Trade Mark Style as a Way of Fixing Things' in Lionel Bently, Jennifer Davis and Jane C Ginsburg (eds), *Trade Marks and Brands, An Interdisciplinary Critique* (Cambridge University Press 2010) 220.

[99] ibid.

> as companies in which skills in market signalling involving the use of information about consumers becomes the defining attribute.[100]

While the VIRGIN brand may indeed not be built around a set of products, and therefore does not have a group of products that act as a touchstone object, there are other possibilities. The Virgin Group and the Branson family themselves could be a touchstone object, so could VIRGIN's ability to market to a particular demographic of consumers.

While this may have been a more outlandish concept historically, today the average consumer is likely quite accepting of the idea that corporations themselves can become brands and the brand almost appears to become its own product. In fact, even in the late 1990s this was becoming an accepted reality. For instance, Litman argued it is possible to build a brand that becomes 'its own product.'[101]

4.5.3 Mediate relations

Brands are objects that mediate relations, and in doing so, take on a social dimensions as social objects.[102] These relations can include a variety of stakeholders such as the brand owner, consumers, sponsors of the brand, other brands, etc.[103] As Margaret Chon has argued 'brands can serve as information platforms around which various stakeholders

[100] ibid citing Naomi Klein, No Logo: Taking Aim at the Brand Bullies (Vintage Canada 2000) 24.

[101] This statement arises in the greater context of Litman identifying that the value around a BUGS BUNNY brand, for instance, reflects not only Warner Brothers' participation, but her own, and that of millions of other consumers. She, therefore, argues 'There is no particularly good reason to adopt a rule permitting the producers of the brands to arrogate all of that collaboratively created value to themselves. The icons that embody the persuasive force of those brands, I suggest, should be properly be viewed as collectively owned.' Litman (n 51) 1734.

[102] This idea finds its foothold in the sociological literature treating brands, such as the work of Adam Arvidsson and Sarah Banet-Weiser.

[103] Lury, 'Brands: Boundary Method Objects and Media Space' (n 9).

participate to create value.'[104] Mediating these relations is not just a feature of a brand, it is essential to a brand's existence; brands must be used or be in action to exist. Brands do not exist in the abstract, they require a context to exist within, 'To be a brand, then, ultimately means to be perceived or known to be a brand or to have been forged into a brand.'[105]

Brands cannot exist without connections between the originator of a brand's impression, a touchstone object, and those that perceive the brand. Trademarks, in contrast, can exist without relations, and as legal objects can (and in some jurisdictions do) come into existence without ever being used.[106] Even when being used, a trademark need not mediate relations. Rather, it successfully works and does its job with just one body—the consumer. While the signified of a trademark, and repute embodied within, may be the result on various sources of information in the mind of the consumer, the formation of a trademark is particularly one-way between the source of the mark and the consumer viewing it. Brand formation, in contrast, is more complex. It is this complexity that has led trademark scholars to posit how much of a brand's value should be properly accrued to the brand owner. Especially when not only a brand's meaning, but it's impression (ie its creation) is formed by stakeholders outside the brand.[107]

Not only do consumers play a significant role in the development of a brand, but brands mediate relations with stakeholders beyond consumers. For instance, the positions

[104] Chon (n 7) 284.

[105] Grassl (n 64) 317.

[106] Such as in jurisdictions where an applicant does not need to demonstrate actual use to successful register a mark.

[107] See, for example: Gangjee (n 2); Kiser (n 37); Litman (n 51).

and attitudes expressed by the media, NGOs, activists, and governments have towards a brand are critical in forming a brand's impression and thus existence.[108] Unlike the more straightforward creation of a trademark, a brands creation involves others:

> It is only when the brand image is collectively shared that it becomes accepted as an everyday truth, which requires that the public must invest the brand with meaning before it gains in cultural salience….brand formation is dialogic and iterative, as opposed to being the result of a one-way broadcast. Since brands are generated in the minds of consumers, they are negotiated, context-sensitive and constantly reproduced by a range of actors.[109]

Brands not only mediate relations around thoughts and expectations of a brand, but brands have developed such that they are even used to mediate relations internal to the company they are associated with. For instance, some corporations now use brands as a central organising principle.[110]

The ability of brands to mediate relationships not only accounts for the social aspect of brands that allow them to be recognised as social objects, but also equips them with the capacity to be pro-social. That is, that brands mediate relations, and that various stakeholders interact with brands *relationally*, gives brands the capacity to act in furtherance of social goods, and to benefit actors beyond the brand and its underlying touchstone object or corporate entity. One way in which brands can take on this pro-social dimension is to reputationally bear accountability in ways that underlying corporate structures may evade.[111]

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[108] Blackett (n 44).

[109] Gangjee (n 2) 52–8.

[110] Blackett (n 44) 20.

[111] And this reputational accountability becomes particularly pertinent when one considers how consumers may relate to brands through trust, as discussed in chapters 6 and 7,

One of example of this is the repercussions for brands following the Rana Plaza disaster in Bangladesh. On 24 April 2013, the Rana Plaza building, housing several garment factories, collapsed killing over 1,100 people, most of whom were factory workers.[112] The five garment firms with factories in this building, including Ether Tex Ltd, New Wave Bottoms Ltd, Phantom Apparels Ltd, were likely unrecognizable to most consumers. Yet the brands that marketed and sold the apparel made by this firms, such as Primark, Joe Fresh, Mango, and Walmart, to name a few, are well known brands. Yet, because of disaggregated nature of global production chains, these brands were not legally responsible. The same, however, was not true socially:

> The publicity tended to portray the brands as culpable even though they had no legal responsibility for the safety and wellbeing of those working there. This attribution of blame reflected awareness of the strategic power that brand owners enjoy as lead firms in the garment (or apparel) industry, of the pressure that lead firms can put on other firms in their supply chains and of the impact that this pressure can have on working conditions, the environment and other matters related to production.[113]

Our legal systems and structures have evolved such that corporations can now outsource manufacturing and production and thus insulate themselves from significant legal risks and responsibilities associated with the production of the products they sell. Griffiths compellingly identifies trademark law as a driver in facilitating 'the disaggregation of production into global value chains' which 'strengthened the strategic power of brand owners within these chains and encouraged the adoption of business models

[112] Jason Burke, 'Rana Plaza: one year from the Bangladesh factory disaster' *The Guardian* (19 April 2014) <https://www.theguardian.com/world/2014/apr/19/rana-plaza-bangladesh-one-year-on> accessed 5 November 2022.

[113] Andrew Griffiths, 'Brands, "weightless" firms and global value chains: the organisational impact of trade mark law' (2019) Legal Studies 284, 245-5 (emphasis added).

such as fast fashion'[114] He also, however, identifies a way in which the nature of brands, and in particular their ability to, as I term here, mediate relations, can act as a counterbalance to this state of affairs such that brands offer a valuable social role.

That is, as it is the brands that are known by consumers, and the social object to which consumers relate, brands are 'vulnerable' to negative publicity in a way that may function as an 'Achilles' heel.[115] In this way, a brand's value, particularly as related to the goodwill embodied in its trademarks, can take on a role in accounting for corporate socially responsible or irresponsible acts.[116] Not only are brands, as a descriptive matter, social objects that multiple stakeholders interact with and relate to in various capacities, but given this social dimension they may be welcomed as a desirable entities in the social fabric of our capitalist society.[117]

4.6 Conclusion

This chapter addressed both the nature of brands and the relationship between brands and trademarks. Brands, despite being a source of great discussion and debate in the trademark literature, are not clearly defined. Nevertheless, trademark scholars (as well as scholars and practitioners in other communities) can collaboratively discuss, and work in relation to,

[114] ibid 286.

[115] ibid 287. As response to a corporate governance problem this solution is not without its own significant drawbacks and limitations. I offer it here, rather, merely to illustrate that accountability to *brands* rather than corporate actors may transcend more established lines of legal fault and offer a positive contribution of brands into our social fabric – particularly if trademark law were to consider this aspect of brands as they relate to trademarks, discussed further in Chapter 7.

[116] Margaret Chon, 'Trademark Goodwill as a Public Good: Brands and Innovations in Corporate Social Responsibility' (2017) Lewis & Clark Law review 277.

[117] Particularly so if we begin to govern trademarks considering this relationship with brands, and in acknowledgment of the social role brands play and have the capacity to play.

brands. Even without a concretised definition in the trademark literature, I argued that an ontological relationship between trademarks and brands—that trademarks can both evoke and embody brands—exists. Furthermore, I argued that even without identifying the exact internal structure of a brand, or delineating a precise definition, we can identify certain hallmarks of a brand. That is, brands have an impression, are supervened on touchstone objects, and mediate relations. These hallmarks help to delineate the outer boundaries and perimeters of brands.

Therefore, even without a precise definition of a brand, I can proceed with a discussion on the nature of certification marks and the certifying function. It is against this backdrop that in future chapters I go onto explore how brands impacts the meaning of the certifying function. While in this chapter, my discussion has been limited to trademarks, I build on the concepts I have set out in this chapter to demonstrate in future chapters how certification marks relate to brands similarly to ordinary trademarks. This thesis, therefore, proceeds on the basis that brands are social objects that exist beyond the triadic structure, while being both evoked by a trademark and embodied in a trademark's signified. Brands act as information platforms that mediate relationships, including relationships with consumers. This in turn has resulted in consumers constructing their identity around brands and brand communities.

V. Positioning the Certifying Function in Context

5.1 Introduction

Certification marks are positioned in the trademark law landscape as being a different kind of mark than an ordinary trademark. And in many ways, they are. The most critical difference between an ordinary trademark and a certification mark is that they do not share a core purpose in trademark law. While ordinary trademarks serve to distinguish the source of a product, certification marks distinguish between products that are certified and those that are not. It is this core purpose that is achieved by the certifying function, as I introduced in Chapter 2. It is the nature of the certifying function that is the focus of this and the subsequent two chapters.

Before delving into a deeper analysis of the nature of the certifying function in the chapters that follow, I begin here with an observation: the nature of the certifying function itself is not inherently bounded by trademark law. Just as are two interwoven histories for trademarks—'one is a history of the social practices and understandings attached to the activity of applying marks to goods; the other, a positivist history of trade mark law'—there are two *stories* of certification marks.[1] One is a positivist account of how trademark law binds and shapes the certifying function, and another account examines the social practices of applying marks to goods and services to communicate they are assured to have a particular quality as distinguished from other goods and services. Considering these

[1] Lionel Bently and others, *Intellectual Property Law* (5th edn, Oxford University Press 2018) 847. There are also, admittedly, two histories of certification marks, but I do not provide a historical account here.

accounts is the focus of this chapter. How does the certifying function as an *institution* fit within general practices of communicating meaning in the marketplace and within a more general practice of marks? Those are the questions which motivate this chapter, the answers to which provide insight into the nature of certification marks and the ways in which the trademark ecosystem is developing more generally.

This chapter proceeds as follows. In section 5.2, I consider the ways in which some certification mark owners situate their mark's certifying function within a broader brand. I put forward a few illustrative examples of how certification mark owners seek to develop their brand impression and brand meaning. I consider the way in which brand meaning embeds a certifying function. These examples also demonstrate the ways in which a certification mark has the capacity to command more functions than its essential function alone—the certifying function—similarly to a trademark. Rather my focus in this chapter is on understanding the greater context surrounding how the certifying function exists in practice not on the other functions of a certification mark. This brief discussion begins to address a gap in the trademark law scholarship that houses a vigorous debate on the intersection of trademarks and brands but is virtually silent on the intersection of certification marks and brands.[2] These observations are instructive for my arguments in in the following chapter regarding how we ought to conceptualise the certifying function.

In section 5.3, I consider the variety of *marks* that perform a certifying function in practice. That is, I demonstrate that at least on an anecdotal level, the certifying function is not performed by certification marks alone, but also ordinary trademarks. I introduce the

[2] Although this silence is understandable, given the lack of literature on certification marks more generally. I think the silence on brands and certification marks is par for the course and says more about the limited scholarship on certification marks than on brands and certification marks.

term *attestation mark* to refer to any mark which performs a certifying function, agnostic of how the mark is registered and regulated.[3] I identify a typology of attestation marks that perform a certifying function, which include: (i) pure certification marks, (ii) quasi-certification marks, (iii) in-house certification marks, and (iv) specious certification marks. These empirical observations are not intended to provide any sort of quantitative diagnoses of the state of attestation marks. Rather, these observations merely recognise the existing practice of embedding the certifying function in a range of attestation marks as a matter of descriptive fact. I build on these observations in Chapter 7, when I situate my own reforms for certification mark law within existing practices.

Last, in section 5.4, I consider what situating the certifying function within a brand and the use of pseudo-certification marks tells us about the nature of the certifying function. I suggest that these practices tell us something important about how consumers in today's market imbue marks with meaning, and how the distinction between trademarks and certification marks breaks down. By identifying a typology of attestation marks, I differentiate between various ways ordinary trademarks can subsume a certifying function. This allows for a more nuanced discussion on the use of attestation marks. These differences between attestation marks are critical in examining the implications of an ordinary trademark performing a certifying function, as discussed at the end of this chapter, and in Chapter 7.

[3] A term introduced in a paper I published with the European Intellectual Property Review, see: A Mogyoros, 'Attestation Marks and Pseudo-certification Marks: A Divergence of Roles in Trademark Law' (2021) 43(4) EIPR 219.

5.2 Certification marks and their brands

Certification marks are being used in the furtherance of developing brand impressions and brand value. A consequence of this use is that the certifying function exist within a greater context of a brand.[4] In this section, I put forward an account of how certifiers are cultivating brands and how this practice affects a consumer's experience with a certification mark. That is, a consumer interacting with a certification mark may imbue the meaning of a mark with a brand's impression, in addition to (or even at the exclusion of) their understanding of what the mark purports to certify. To illustrate this practice, I present three examples considering the certification marks owned by the Gluten Intolerance Group (figure 8), the Marine Stewardship Council (figure 9), and Orthodox Union Kosher (figure 2).

figure 2: UNION OF ORTHODOX JEWISH CONGREGATIONS OF AMERICA mark

figure 8: CERTIFIED GLUTEN FREE mark

figure 9: MARINE STEWARDSHIP COUNCIL mark

I have selected these three certification marks, which are all consumer facing marks, because they span the range of characteristics that certification marks can signal. The Gluten Intolerance Group's mark signals a standard regarding a physical quality of a product; the Marine Stewardship Council's mark signals a standard regarding a process characteristic, sustainability standards; and the Orthodox Union Kosher's mark signals

[4] Within the meaning of brand I developed in Chapter 4.

standards that relate to religious faith and practice. Furthermore, each of these marks achieve their certifying function to a different capacity. That is, each mark sits at a different place of the bare-robust spectrum as set out in Chapter 2. Collectively, these three examples represent a robust certification mark (the Gluten Intolerance Group's mark), a grey certification mark (the Marine Stewardship Council's mark), and a bare certification mark (the Orthodox Union Kosher's mark).

In exploring these examples, we can see how certifying bodies seek to establish an identity and value above and beyond the credibility of their certification regime and the quality of their standard. I demonstrate how these certifiers use their certification marks in marketing and community-building activities to create a brand impression that extends beyond their standards, and derives meaning from their values, politics, and relations.[5]

The Gluten Intolerance Group, a non-profit organisation, owns the CERTIFIED GLUTEN FREE mark which certifies food products as being gluten free. Much of their online presence and marketing materials seeks to explain how they certify gluten-free products and the strength and quality of their certification regime. For instance, on their website they portray themselves as different from other certifies by explaining their process:

> Unlike other certifications which only audit record-keeping, GFCO reviews the manufacturer's products and ingredients, and individually tailors testing requirements based on risk. But your support goes beyond food safety—

[5] Recall, while a brand may try to create a particular impression, this is ultimately the purview of the recipient of the brand, as discussed in Chapter 4, subsection 4.5.1.

> 100% of revenue from our food safety programs is invested into GIG's programs that support and educate the gluten-free community.[6]

Many of their activities extend beyond the act of certification but nevertheless are focused on their core mission of gluten free certification and thus are activities that benefit members of their community. As explained in their website, they also engage in educational outreach and advocacy work regarding gluten intolerance. These activities do align with what is typically understood as a certifier's mission to explain and promulgate the benefits of their standards. By educating relevant groups on the importance of gluten free certification, the certifying function of their mark can perform in a more informed market.

Additional to these efforts, interestingly, is behaviour that is more consistent with traditional brand development. For instance, the Gluten Intolerance Group began a campaign in the spring of 2020, 'Giving Back to Our Gluten-Free Heroes,' to engage in the social issues raised by the coronavirus COVID-19 global pandemic. This campaign used their website and social media profiles to create awareness about their product, gluten-free certification, namely, by engaging in a social political issue. Their Instagram profile, for instance, detailed the success of this campaign with heartfelt stories of change.[7]

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[6] Gluten-Free Certification Organization, 'GFCO Certification' (*Gluten-Free Intolerance Group*, 2020) <www.gfco.org> accessed 2 April 2020.

[7] Gluten Intolerance Group, 'Giving Back to Our Gluten-Free Heroes' (*Gluten Intolerance Group*) <https://gluten.org/hero/>.

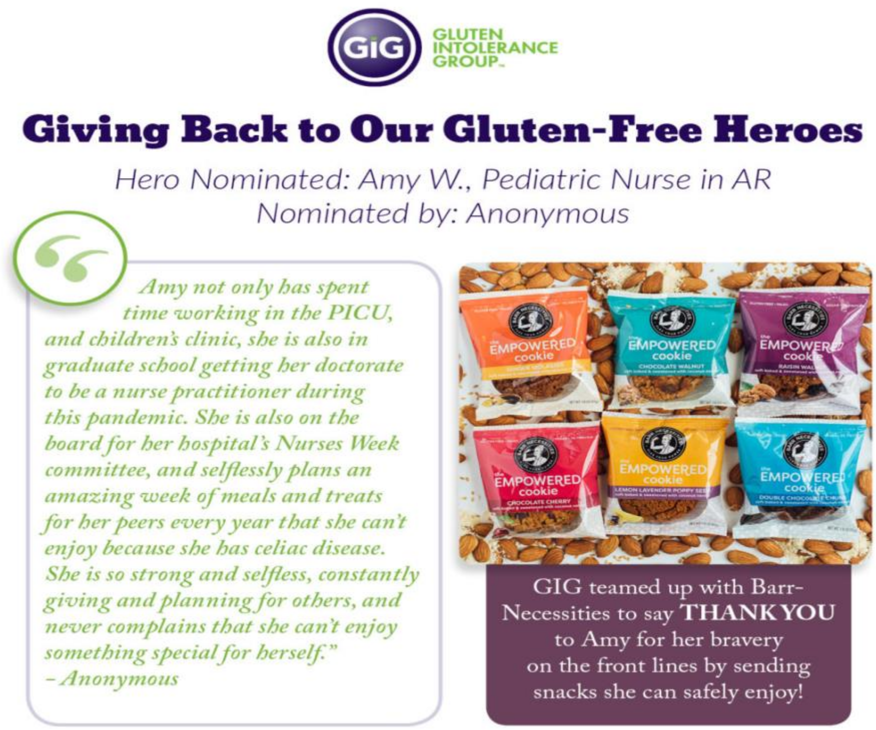

figure 12 Gluten Intolerance Group 'Hereos' Instagram post

This campaign was a branding strategy that positioned the Gluten Intolerance Group as a pro-social brand in a few ways. First, this campaign created awareness, and thus potential demand, for the brand's product, gluten free certification. Second, this campaign, along with their use of their social media accounts, allowed the Gluten Intolerance Group to inform the public and potential consumers about their standards.[8] Third, this campaign positioned the Gluten Intolerance Group as a brand with certain values, and engaged in social political issues, here the need to support front-line workers during a global health crisis. Alongside other brand-like behaviour, such as the creation of branding guidelines for their marks, demonstrates how this certifying function exists against this backdrop of

[8] See for example their Instagram, Facebook, and Twitter accounts: Gluten Intolerance Group, 'Facebook Account' <https://www.facebook.com/GlutenIntoleranceGroup/>; Gluten Intolerance Group, 'Instagram Account' <https://www.instagram.com/glutendotorg/>; Gluten Intolerance Group, 'Twitter Account' <https://twitter.com/GlutenDotorg>.

deeper brand meaning. A consumer familiar with the CERTIFIED GLUTEN FREE mark may import into the signified more than the nature of the standards alone, but also their impression of the brand behind it. We can see similar practices in the marketplace behaviour of Marine Stewardship Council and Orthodox Union Kosher for example.

The Marine Stewardship Council is an international non-profit organisation that oversees a sustainable fishery certification program and owns a corresponding ecolabel which certifies companies that sustainably source seafood.[9] Like the Gluten Intolerance Group, a large portion of their online presence and materials seek to explain the importance of sustainable fishing as an environmental and social issue as well as explain their standards and certification. This body of communication is very much aligned with educating potential consumers about what their mark signifies. Similarly, they promote their active engagement in education, research, and advocacy related to sustainable fishing practices.

That being said, the Marine Stewardship Council also engages in several marketing tactics which seemingly seeks to develop and build a brand impression apart from these standards. For instance, they run an Ocean Ambassadors program, where chefs (as well as photographers and explorers) are profiled with their views on sustainable seafood, and recipes.[10] Similarly, their social media profiles, such as Instagram, are replete with photographs of stunning seafood meals and dishes—cultivating a brand around food culture which is not directly tied to sustainable fishing or their standards.[11] Some of their

[9] Marine Stewardship Council, ‘Marine Stewardship Council’ (*Marine Stewardship Council*, 11 March 2019) <https://www.msc.org/>.

[10] Marine Stewardship Council, ‘Ocean Ambassadors’ (*Marine Stewardship Council*) <https://www.msc.org/ocean-ambassadors> accessed 16 April 2020.

[11] Marine Stewardship Council, ‘Instagram Account’ <https://www.instagram.com/mscecolabel/>.

marketing campaigns say very little about what they certify or what the nature of their standards are. For instance, their Big Blue Future campaign alludes to environmental preferability, as seen in figures 13 and 14, but says little about what is being certified.[12]

figure 13 MSC 'Big Blue Future' (i)

figure 14 MSC 'Big Blue Future' (ii)

Similarly, their Feel-Good Seafood campaign alludes to seafood that is 'good', and presumably environmental preferable, yet says little about what they certify or what their

[12] Marine Stewardship Council, 'Campaigns for Change' (*Marine Stewardship Council*) <https://www.msc.org/en-us/campaigns-for-change> accessed 4 November 2021.

standards are. The visual images in this campaign are photographs of gorgeous food and happy gourmands, as depicted below in figure 15, and not for instance infographics explaining their standard.[13]

figure 15 MSC 'Feel-Good Seafood'

While not *necessarily* at odds with their activities as a third-party certifier, these campaigns certainly do not strengthen the certifying function by advertising what they certify or how. Rather these campaigns create a greater brand context for the certifying function to perform within.

This strategy, however, has received some critical notice. Scholars have found that Marine Stewardship Council's 'Small is Beautiful' campaign, along with representations of pastoral fisheries in their promotional materials is at odds with the reality of their certification:

> The Marine Stewardship Council (MSC) sets a standard by which sustainable fisheries can be assessed and eco-certified. It is one of the oldest and most well-known fisheries certifications, and an estimated 15% of global fish catch is MSC-certified. While the MSC is increasingly recognized by decision-makers as an indicator for fishery success, it is also

[13] ibid.

> criticized for weak standards and overly-lenient third-party certifiers. This gap between the standard's reputation and its actual implementation could be a result of how the MSC markets and promotes its brand…. The MSC disproportionately features photographs of small-scale fisheries although the catch it certifies is overwhelmingly from industrial fisheries. [14]

This suggests that with an effective marketing strategy, a certifier's reputation can be grown and shaped more in accordance with their brand image than with their standards.

The last example, Orthodox Union Kosher, also provides an interesting look into how a certifier positions themselves and the meaning behind their certification. Orthodox Union Kosher is a branch of Orthodox Union, a religious organisation, and the owners of the OU Kosher certification mark.[15] Like the Gluten Intolerance Group and Marine Stewardship Council, this certification mark is part of an organisation and positioned within a greater range of education and advocacy activities, in addition to certification. Orthodox Union Kosher, and Orthodox Union, maintain social media profiles.[16] Orthodox Union Kosher's social media presence is largely about promoting the brands they certify and an overall epicurean culture rather than explaining the nature of their certification. Similarly, Orthodox Union Kosher's positioning within the greater Orthodox Union organisation allows it to borrow meaning from Orthodox Union's brand, which they develop and maintain through a variety of mechanisms aligned with their mission

[14] Frédéric Le Manach and others, 'Small Is Beautiful, but Large Is Certified: A Comparison between Fisheries the Marine Stewardship Council (MSC) Features in Its Promotional Materials and MSC-Certified Fisheries' (2020) 15 PLOS ONE 8 <https://journals.plos.org/plosone/article?id=10.1371/journal.pone.0231073> accessed 19 August 2020.

[15] Orthodox Union, 'Orthodox Union' (*Orthodox Union*) <https://www.ou.org/> accessed 2 June 2020.

[16] For example: Orthodox Union, 'Instagram Account' <https://www.instagram.com/oukosher/>.

statement, such as publishing an Orthodox Union magazine, 'Jewish Action.'[17] While Orthodox Union Kosher offers a religious certification, their focus appears to be promoting their community and religious values, and positioning their certification within this framework, rather than focusing exclusively on how and what they certify.

These three examples are illustrative of how a certifier can imbue their certification mark with meaning greater than the nature of their certification. While third-party certifiers engage in activities harmonious with role as certifiers, their certification marks and marketplace presence are not singularly constructed around these standards. Rather these third-party certifiers, like many others, are developing brands and positioning their marks within their brand meaning.[18] Resultingly, consumers familiar with a certification mark, upon interacting with it, may draw on their interactions with promotional materials and the brand impression of the certifier. In fact, a consumer's understanding of the signified of a certification mark may be populated by their impression of the brand without being sure of what exact standards are being certified.

The context of these commercial practices can also be considered against the greater backdrop of the changing nature of certification, as discussed in Chapter 2. In a market where independent certifiers are losing market share to self-declarations by producers and first party owned certification schemes, one can see why certifying bodies

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[17] Orthodox Union, 'Jewish Action: About Us' (*Jewish Action: The Magazine of The Orthodox Union*) <https://jewishaction.com/about-us/> accessed 2 June 2020.

[18] See for instance: Non-GMO Project, 'Non-GMO Project' (*Non-GMO Project*) <https://www.nongmoproject.org/> accessed 2 February 2021; Rainforest Alliance, 'What Does "Rainforest Alliance Certified" Mean?' (*Rainforest Alliance*, 28 October 2020) <https://www.rainforest-alliance.org/insights/what-does-rainforest-alliance-certified-mean/?_ga=2.106296515.1794487534.1660342592-2074428353.1660342592> accessed 2 February 2021.

may find themselves in a position of needing to add value to their certification services and labelling.[19] Creating a strong brand is one way to do this. As certification marks today are frequently used to certify characteristics and standards related to rectitude, these certification regimes are privately regulating products either above and beyond government created standards, or characteristics generally outside the purview of a secular government, such as religious standards. Some of the characteristics and standards being certified may not generally be known or understood by the general consuming public. Where this is the case, brand developing activities, like the use of a spokesperson, advertisements, or an online social media campaign, can be useful in explaining the social problem associated with the standard being certified. This can add value to certification services, and their certification marks by creating an understanding for the importance of the certification in question and create demand for their standards.

5.3 The range of attestation marks: introducing pseudo-certification marks

This section introduces and explores a typology of attestation marks. In doing so I consider how the certifying function fits into a general practice of marketplace signs. I use the term *attestation mark* to denote any mark that is primarily performing a certifying function independent of its legal categorisation. Attestation mark, therefore, is a descriptive term agnostic to whether the mark in question is registered and governed as a certification mark or another form of trademark. While one may think legal norms dictate that all attestation

[19] Samanth Subramanian, 'Is Fair Trade Finished?' *The Guardian* (23 July 2019) <https://www.theguardian.com/business/2019/jul/23/fairtrade-ethical-certification-supermarkets-sainsburys> accessed 23 July 2019.

marks are also certification marks, this is not so. Ordinary trademarks can also be observed performing a certifying function and thus acting as attestation marks.[20]

Few scholars to date have identified that ordinary trademarks are also being used in a way which fulfils the purview of certification marks, and none have analysed or conceptualised the varied ways in which this can occur. Jeffrey Belson has observed that both trademarks and certification marks are used as ecolabels.[21] He does not, however, attribute any significance to this practice. Jessica Lai identifies a single case of what she considered a mis-registered trademark that she argues ought to have been registered as a certification mark.[22] While she argues that this practice 'hijacks' the legitimacy of the certification mark institution, her basis for this claim is a singular example and she does not identify this misuse as part of a more widespread practice. C. Bradford Biddle and his colleagues have undertaken the most systematic exploration of this topic to date, having undertaken an empirical project exploring 'the trademark registration practices of 40 standards setting organizations.'[23] In this work, they identify a practice of these organisations predominately applying for ordinary trademarks rather than certification marks. The observations underlying these works collectively, and in particular Biddle's piece, accords with my own anecdotal observations that the certifying function is at times

[20] This is true across jurisdictions of interest here, that is, Canada, the EU, the UK, and the US.

[21] Jeffrey Belson, *Certification and Collective Marks: Law and Practice* (2nd edn, Edward Elgar Publishing Limited 2017) ch 7.

[22] Jessica C Lai, 'Hijacking Consumer Trust Systems: Of Self-Declared Watchdogs and Certification Trade Marks' (2021) 52 International Review of Intellectual Property and Competition Law 34.

[23] C Bradford Biddle and others, 'Standards Setting Organizations and Trademark Registration: An Empirical Analysis' [2019] (Working Draft: Available on SSRN) 1.

performed by an ordinary trademark, and at times, at the exclusion of the traditional essential function of a trademark, the source function.

My observations here are anecdotal. I did not undertake a quantitative research project, nor do I seek to assert any empirical claims about the use of pseudo-certification marks other than the following: the practice of pseudo-certification marks exists and this practice is nontrivial. To illustrate this, 'Appendix A' lists several examples of pseudo-certification marks from the UK. While I have not identified the amount of pseudo-certification marks that exist, I can say that proportionate to the amount of registered certification marks their existence is nontrivial. For instance, I have (without undertaking a systemic review of all registered trademarks) preliminarily identified at least 30 pseudo-certification marks in the UK, as compared to approximately 420 total active registered certification marks in the UK as of January 2020.[24]

Giving a more detailed empirical account is both unnecessary and unfeasible for the nature of this project. While the number of registered of pure certification marks in any given jurisdiction is possible to identify, identifying the amount of pseudo-certification marks would require examining every registered trademark in a jurisdiction. There are no unifying features that can be used to search out the registry to identify all pseudo-certification marks. Not all pseudo-certification marks make use of the words 'certified', 'vouch', 'seal', or 'approved' in their sign, although some do. Nor are pseudo-certification marks all registered in the same class of services.[25] This makes this enterprise extremely

[24] As of 30 January 2020 there were 424 certification marks registered in the UK: Email from IPO to author (30 January 2020). See 'Appendix A'.

[25] Although there are some classes of goods and services that, anecdotally, appear to have re-occurring use in pseudo-certification marks registrations such as classes 16, 41, 42 of the Nice Classification system.

cumbersome. Furthermore, undertaking it is not necessary. The aim of this section is to demonstrate that the certifying function is not the exclusive purview of certification marks alone, and that trademarks can at times perform a certain kind certifying function in accordance with trademark law. This helps deepen our understanding of the context of the certifying function, particularly before considering how we ought to conceptualise nature of the certifying function more deeply in Chapter 6 and does not require an empirical undertaking.

My typology of attestation marks, seen in diagram 1 below, includes four categories of marks: pure certification marks, quasi-certification marks, in-house certification marks, and specious certification marks.

Attestation marks			
	Pseudo-certification marks		
Pure certification mark	Quasi-certification mark	In-house certification mark	Specious certification mark

diagram 1 Typology of attestation marks

The latter three are pseudo-certification marks. In the subsections that follow, I explain the differences between each category and provide examples of each type of attestation mark for illustrative purposes. As such, the examples in this section reveal that attestation marks are varied. Nevertheless, their commonality is their ability to perform a certifying function. Any of these marks will be perceived by the average consumer to be an attestation mark. A consumer is unlikely to know whether the attestation mark they are encountering is a certification mark or ordinary trademark but will gather that the mark communicates a quality about the product that bears it.

5.3.1 Pure Certification Marks

Pure certification marks are the only type of attestation marks that are indeed proper certification marks. These marks are used, registered, and regulated as certification marks. Accordingly, they signal that those products which bear them are certified by the mark owner as having some characteristic relating to the quality, material, mode of production, or—in some jurisdictions—origin. As they are not used by their owners, they act as a sign of a third-party certifier. Additionally, because they are registered as a certification mark, the characteristic being attested to has been publicly defined and is available.[26]

Fair Trade USA's mark, FAIR TRADE CERTIFIED is an example of a pure certification mark in the United States, see figure 16.[27]

figure 16 FAIR TRADE CERTIFIED mark

[26] See, for example: Trademarks Act, s 30(2)(b) (Canada); Trade Marks Act 1994, sch 2 para 6 (UK).

[27] This mark is registered in the US as a certification mark, see registration numbers 4819101 & 4322276 & 4773175. mark is registered in the United States as a certification mark. This mark is registered in the EU as an individual trademark, see filing numbers 010298867 & 013247234. This mark was previously registered in Canada, although it is currently listed (as of 22 August 2022) by the CIPO as abandoned, as a certification mark (application number 1601044). There are also two registrations for this in the UK, as ordinary trademarks, see trademark numbers UK00910298867 and UK00913247234.

The FAIR TRADE CERTIFIED mark is a word and design mark, depicting ‘the image of a black human figure holding a black and white basket with the image of a green and white circular design appearing in the background’ along with the words ‘FAIR TRADE CERTIFIED’ underneath the image.[28] The mark is intended to be smaller in size from the dominant logo on a package, and placed on the side of the front of a package, or on the back of a package, alongside similarly sized marks.[29] The FAIR TRADE CERTIFIED mark can be found on a variety of products and brands; this mark has no brand affiliation and is not constrained to the use of any particular brand. It does not communicate the source of a product. A consumer would likely infer that a product bearing this mark has met a fair-trade production standard in some aspect of its production.

The FAIR TRADE CERTIFIED mark is owned by Transfair USA, doing business under Fair Trade USA; FAIR TRADE CERTIFIED is their global brand.[30] This non-profit organisation uses this attestation mark as a third-party mark. This mark can be used on products where the producers are certified against their standards, or under Fairtrade International standards.[31] Fair Trade USA makes their standards available on their website and allows companies to make use of their marks, but does not certify the businesses themselves.

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[28] US registration numbers: 4819101 & 4322276 & 4773175, all are registered as certification marks.

[29] The branding guidelines for the FAIR TRADE CERTIFIED mark requires that the mark be used a certain distance away from any other mark, and ‘proportional to other certification seals on the package.’ See: Fair Trade USA, ‘Fair Trade Certified Seal & Language Use Guide’ (2020) Version 1.5.0 3 <https://www.fairtradecertified.org/sites/default/files/standards/documents/FTUSA_STD_SLUG_EN_1.5.0.pdf>.

[30] Fair Trade USA, ‘Frequently Asked Questions’ (*Fair Trade Certified*, 2021) <https://www.fairtradecertified.org/frequently-asked-questions#are-fair-trade-usa-and-fair-trade-certified-the-same> accessed 3 November 2019.

[31] While their names are quite similar, Fairtrade International and Fairtrade America are different organisations, see discussion on Fairtrade International below.

Another example of a pure certification mark is the American INDEPENDENT CRAFT BREWERS SEAL, owned by The Brewers Association, see figure 17.[32]

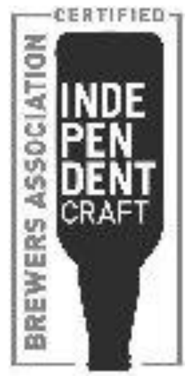

figure 17 INDEPENDENT CRAFT BREWERS SEAL mark

It is used by craft beer brewers who meet the standard definition for craft brewer set forward by The Brewers Association.[33] This mark is registered as a certification mark and the standard for using the mark is set forward by the owner of the mark and is publicly available. As a pure certification mark it is used by craft beer brands that meet the requirement – not the mark owner.

Another example from the UK is the RED TRACTOR mark owned by Assured Food Standards, figure 18.[34]

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[32] Registered in the US as a certification mark, registration number 5602434.

[33] Brewers Association, 'Craft Brewer Definition' (*Brewers Association: For Small & Independent Craft Brewers*, 2021) <https://www.brewersassociation.org/statistics-and-data/craft-brewer-definition/> accessed 12 October 2019.

[34] This mark is registered in the UK as a certification mark, trademark number UK00003510656. It is also listed as a certification mark on the Canadian registry. As of 22 August 2022, this mark was listed as 'live' and 'awaiting examination' by the CIPO, filed on 4 November 2021. The mark registered with the CIPO is nearly identical as it is in black and white only.

figure 18 RED TRACTOR mark

This figurative mark of a red tractor is used by Assured Food Standards on grocery items to signal that food bearing it has been farmed and produced to their standards. As explained on their website:

> The Red Tractor logo is a simple way for people to recognise food and drink that has been produced to high quality standards across the whole length of the food chain – from farm to pack. We make sure that food is traceable, safe and farmed with care – so everyone can feel confident and good about their choices when shopping and eating out.
>
> The Red Tractor is only found on food and drinks that are sourced from UK farms and have been checked from farm to basket.
>
> By looking for the Red Tractor, you are choosing food you can trust, as well as helping provide support and security for British farmers and food producers.[35]

The existence of pure certification marks, such as those described above, is not contentious. These marks are congruent with the legal norms governing marks. They, nonetheless, provide a useful point of comparison for my discussion of pseudo-certification marks below.

[35] Red Tractor Assurance, 'Assured Food Standards' (*Red Tractor Assurance, Assured Food Standards*, 2021) <https://www.redtractor.org.uk/> accessed 12 October 2019.

5.3.2 Pseudo-Certification Marks

The category of pseudo-certification marks subsumes three types of attestation marks, all of which are registered as ordinary trademarks—quasi-certification marks, in-house certification marks, and specious certification marks. In the discussion below I have separated them out because they do not perform their certifying function in the same ways. There are nuances between how the certifying function is performed between these categories of marks and these differences have legal significance.[36]

5.3.2.a Quasi-certification marks

Quasi-certification marks are the first of the three types of pseudo-certification marks and the most akin to a pure certification mark. To a consumer, this mark will likely be indistinguishable from a pure certification mark. These, like pure certification marks, are owned by third-party certifiers and its public facing aspects are essentially identical. Quasi-certification marks do not perform a source indicating function in the traditional sense; they appear on a variety of brands and alongside source indicating marks. Their size and placement resemble that of a pure certification mark, being smaller in size and off to the side of the dominant labels on the package. Additionally, like a pure certification mark, there is a defined standard or characteristic associated with the use of the mark set by the owner. Yet, these marks are registered, enforced, and protected like ordinary trademarks. Thus, there is incongruency between the public facing aspects of quasi-certification marks and their regulation as ordinary trademarks. That is not to say a quasi-certification mark

[36] These distinctions are mentioned in Chapter 7 where I consider how trademarks and trademark law have already begun to absorb the certifying function.

owner could not choose to govern themselves by the same rules and limitations as a pure certification mark, merely that they are not required to.[37]

The B CORP CERTIFIED mark is an example of a quasi-certification mark, see figures 19 and 20.[38]

figure 19 B CORP CERTIFIED mark

figure 20 B CORP CERTIFIED plain mark

[37] Although some aspects, like requiring registry oversight, several jurisdictions are not available for a quasi-certification mark owner. Pure certification marks are legislatively subject to registrar oversight, see discussion in Chapter 2.

[38] This mark in figure 19 is registered in Canada as an ordinary trademark, registration number TMA906232. This mark was previously registered in the EU as an individual trademark, filing number 1169124. This mark was registered on 19 July 2013 and as of 22 August 2022 was removed from the register. The same owner still had a substantially similar mark registered in the EU as an individual trademark (filing number: 0953751) that expired in 2017. The mark in figure 20 is registered as an ordinary trademark in the US, registration number 5538256 and as an ordinary trademark in the UK under trademark numbers UK00801269577 and UK00811358762.

This mark certifies that a company has become a Certified B Corporation; the B CORP CERTIFIED mark indicates a product bearing it was made by a corporation conducting itself to a certain standard of corporate social responsibility. What is unique about B CORP CERTIFICATION, and in some ways distinguishes it from other attestation marks, is that it does not certify or identify a goods or service that has a specific quality:

> Certifying as a B Corporation goes beyond product- or service-level certification. B Corp Certification is the only certification that measures a company's entire social and environmental performance.[39]

As their website explains, B CORP CERTIFIED is evaluating the company that stands behind a product or service, 'And increasingly that's what people care most about.'[40] Certified B Corporations 'are for-profit companies that use the power of business to build a more inclusive and sustainable economy. They meet the highest verified standards of social and environmental performance, transparency, and accountability.'[41] This mark is owned by B Lab, a non-profit organisation that administers the B Corp certification program. Once certified, a company becomes a 'Certified B Corporation,' or 'B Corps' for short, and may make use of the B CORP CERTIFIED brand and affiliated mark. Like FAIRTRADE, not only is B CORP CERTIFIED a third-party certification that is used by multiple brands, such as BEN AND JERRY'S, DR. BRONNER'S, and PATAGONIA, it

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[39] B Lab, 'Certification' (*Certified B Corporation*, 2021) <https://bcorporation.net/certification> accessed 12 October 2019.

[40] B Lab, 'About B Corps' (*Certified B Corporation*, 2021) <https://bcorporation.net/about-b-corps> accessed 12 October 2019.

[41] B Lab, 'Certified B Corporation Brand Communication and Identity Guidelines' (2018) Branding Guidelines version 2.4 9.

is a third-party mark which speaks to the nature of the company or brand, rather than a specific product.[42]

Another quasi-certification mark is FAIRTRADE INTERNATIONAL's mark, figure 21.[43] This mark consists of 'a stylized representation of a human with an upraised arm in black appearing inside a circle' where the circle is a yin-yang-esque design using the colours light green and blue for either side of the circle, with the words FAIRTRADE appearing underneath.

figure 21 FAIRTRADE INTERNATIONAL mark

Fairtrade International is an international non-profit organisation that serves as the umbrella organisation for several national branches, such as Fairtrade America, Fairtrade Canada and the Fairtrade Foundation in the UK. Fairtrade International sets the standards that are required for their marks to be used. It also owns and licenses their marks to firms

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[42] Ben & Jerry's, 'Ben & Jerry's Joins the B Corp Movement!' (*Ben & Jerry's*) <https://www.benandjerrys.ca/en/about-us/b-corp> accessed 1 May 2022; Patagonia, 'B Lab' (*Patagonia*) <https://www.patagonia.ca/b-lab.html> accessed 1 May 2022; Dr. Bronner's, 'Independent Third-Party Certification Ensures Our Products Meet the Highest Standards for Ecological and Social Sustainability' (*Dr. Bronner's*) <https://www.drbronner.com/blogs/our-customers/product-certifications?_pos=2&_sid=64a769236&_ss=r> accessed 1 May 2022.

[43] It is registered in Canada as an ordinary trademark, trademark number TMA872494, and the US as a trademark service mark, registration number 4762338.

that meet the requisite standards.[44] Fairtrade International has registered this mark in all four jurisdictions of interest here. While it is dominantly registered as an ordinary trademark, in the EU and UK it is both registered as an ordinary trademark and certification mark.[45] This mark also appears on a variety of products belonging to a range of brands and is thus also as a third-party attestation mark.

While the first two examples may be considered to have fuzzier standards as marks of rectitude,[46] even more 'technical' attestation marks are sometimes quasi-certification marks. For instance, The British Standards Institution (BSI) Kitemark which certifies quality standards regarding safety is registered as an ordinary trademark and thus a quasi-certification mark.[47] Similarly, several of USB's marks are used by manufacturers to signal USB computability and are registered as ordinary trademarks.[48]

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[44] Fairtrade International, 'The Fairtrade Marks' (*Fairtrade*, 20 December 2019) <https://www.fairtrade.net/about/fairtrade-marks> accessed 20 December 2019.

Fairtrade International has a range of standards, such as for hired labour, small-scale producers, contract production, climate and textile. These standards are made by the Fairtrade International Standards Committee in accordance with the ISEAL Code of Good Practice on Standard Setting, which includes a consultation practice.

[45] This mark is registered in the EU as a certification mark, filing number 017959045, as well as an individual trademark, 009426172 & 018039409. Similarly, in the UK it is registered as a certification mark, trademark number UK00003702894, as well as an ordinary trademark, trademark numbers UK00909426172 and UK00918039409.

[46] Margaret Chon, 'Marks of Rectitude' (2009) 77 Fordham Law Review 101.

[47] This mark is registered as an ordinary trademark in the UK, trademark number UK00917899012, as well as Canada, registration number TMA759473. It is also registered as an individual trademark in the EU, filing number 017899012. As discussed further in Chapter 7, this mark was originally a registered certification mark and was subsequently registered as a trade mark and is thus now advertised and marketed as a 'conformity certification trade mark.' See: The British Standards Institution, 'Kitemark™' (*bsi.*, 2022) <https://www.bsigroup.com/en-IL/Our-services/Product-certification/Kitemark/> accessed 1 May 2022.

[48] See, for example in the EU individual trademark filing number 008187304, and other marks owned by the USB Implementers Forum, Inc in 'Appendix A'.

Quasi-certification marks are owned and controlled by third-party certifiers. Accordingly, there is nothing in the identity of the owner, or use of the mark, that presumptively would have prohibited these marks from being registered as certification marks, presuming they fulfilled the registration criteria as they appear from outside scrutiny to be capable of doing. Further to this point, some marks which are pure certification marks in some jurisdictions are quasi-certification marks in others.[49]

There may be many reasons motivating the practice of registering an attestation mark as a quasi-certification mark. For instance, one may wonder to what extent this practice is a result of refused certification marks rather than an intentional registration strategy. While I do not seek here to make any empirically supported claims for this practice, I have observed it is at least anecdotally an intentional practice by some. It is therefore likely that at least *some* mark owners are intentionally selecting to register their marks as a trademark rather than as a certification mark, as in the case of at least BSI and their Kitemark,[50] as well as several of USB's marks.[51]

Another potential motivation may be a practical reason for this decision, namely as a real or perceived lack of an alternative options to protect one's mark. Historically, the EU did not allow for the registration of certification marks. This effectively compelled mark owners to register their certification marks as ordinary trademarks to garner

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[49] See as discussed above (n 45).

[50] *Omega Flex Ltd v British Standards Institution*, BL O/765/18, [2019] RPC 10 (Intellectual Property Office).

[51] Interview with Jeff Ravencraft and Traci Donnell, 'Interview with Representatives of USB Implementers Forum' (3 March 2022).

protection of their intellectual property.[52] In that period, OHIM's Guidelines before to the introduction of the EU certification mark instructed:

> Certification marks in the sense that one individual entity unilaterally sets standards with which the goods shall comply if they may carry the mark cannot be Community Collective Marks but must be filed as Community individual marks.[53]

This reason, however, is not particularly compelling to explain all the quasi-certification marks, as we find this practice existing in jurisdictions where marks were registered as an ordinary trademark when the certification mark option was also available.

If at least some mark owners are opting to register their attestation marks as trademarks and not registered marks, we might consider what is motivating this registration strategy. After surveying the literature, and speaking to mark owners and trademark lawyers, the most compelling reason to register an attestation mark as an ordinary trademark is the certainty of control that trademark owners have as compared to certification mark owners. Of course, this sense of certainty and control must be weighed against a risk of invalidation.[54]

As discussed in section 5.2, there are compelling reasons why an attestation mark owner would want to build a brand around their mark. Quasi-certification mark owners are more optimally positioned to do this compared to their pure certification mark owner counterparts. There may be values associated with an attestation mark that are not strictly

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[52] EC Regulation 2015/2424 (EU).

[53] Office for Harmonization in the Internal Market (OHIM), 'Guidelines Concerning Proceedings Before the Office for Harmonization in the Internal Market (Trade Marks and Designs) Part B, Examination' (2008) Guidelines 58.

[54] For instance the UK and EU, see: Axel Ringelhann, 'CJEU Clarifies That EU Individual Marks Cannot Be Used Exclusively as Labels of Quality' (2017) 12 Journal of Intellectual Property Law & Practice 724.

part of the certified characteristic or standard, but that affect the perception of an attestation mark and its brand's impression. One can appreciate how an attestation mark owner may want to consider the perception of their mark by not allowing their mark to be used by users whose business contradict or are not in accordance with the brand values of the attestation mark.

Consider, for instance, a kosher certifier who owns an attestation mark that attests to food meeting appropriate kosher rules.[55] One can imagine a food producer, or restaurant, that meets the requirements of the mark, but outside their handling of food, engages in activities contrary to the values of the mark and associated brand. While allowing this user to make use of the mark may not dilute the reputation of the standard underlying the mark, it may very well undermine the attestation mark's brand, driving producers and consumers to use a different kosher certifier going forward. This example is not academic. Jeanne Fromer presents such a scenario in her case study on a kosher restaurant—Jezebel.

Jezebel, was a new restaurant that opened in 2012 in the Manhattan SoHo neighbourhood. As Fromer describes:

> [Jezebel sought] to offer a cutting-edge downtown dining experience with food that happens to be kosher. Its décor and ambience strove to be different

[55] 'Kosher' foods are foods which conform to Jewish dietary regulations known as *kashrut*. For an in-depth and critical discussion of kosher certification see: Timothy D Lytton, *Kosher: Private Regulation in the Age of Industrial Food* (Harvard University Press 2013).

> from one's typical idea of a kosher restaurant…. [and] referenced Judaism in its packaging in a fun and somewhat subversive way.[56]

When the time came to try to become certified by one of the major kosher certifiers, The Orthodox Union refused to certify Jezebel, not because the food did not meet the appropriate standards, but because of the restaurant's name.[57] Fromer uses this case study to illustrate the potential for anti-competitive effects that can emerge where a certifier, and owner of an attestation mark, wields their power.

This example demonstrates the harms that can follow from an attestation mark owner determining who can use their mark because of something other than the characteristic they are attesting to. This example also, however, prompts another question about justifying this behaviour. If an attestation mark is successful in the market in part because of their reputation, and thus their brand, why should the mark owner not be able to have greater control on who can make use of their mark? On the one hand, allowing an attestation mark owner to discriminate against who can use their mark can result in anti-competitive behaviour, which can ultimately harm producers, consumers, and the market. On the other hand, attestation mark owners being able to cultivate a robust brand could be of benefit to producers and consumers as well, as discussed further in later chapters.

5.3.2.b In-house certification marks

In-house certification marks, another type of pseudo-certification mark, do not meet the requirements of a certification mark. This type of attestation mark is used exclusively by

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[56] Jeanne C Fromer, 'The Unregulated Certification Mark(Et)' (2017) 69 Stanford Law Review 121, 136–7. The name, Jezebel, was 'a reference to a biblical princess said to have encouraged idol worship at the expense of Jewish practice and ordered the deaths of many Jewish prophets.' (p 137)

[57] ibid 133–40.

their owners; they are not required to allow their use by anyone who meets the given characteristic or standard the mark communicates. Furthermore, the specific characteristic the mark conveys is not necessarily made available nor precisely articulated. In-house certification marks are owned by an existing brand, and this ownership is communicated by the mark itself. These marks are often used for wholly proprietary first-party certification schemes, such as NESTLÉ'S COCOA PLAN, see figures 22 and 23.[58]

figure 22 COCOA PLAN mark

figure 23 NESTLÉ THE COCOA PLAN mark

Nestlé has opted to use an in-house certification mark instead of a third-party attestation mark, such as FAIRTRADE.[59] As a corollary of creating their own standard for this attestation mark, Nestlé is not required to ensure this standard is publicly articulated. While their website outlines achievements and goals related to cocoa farming, the quality of cocoa

[58] The mark in figure 22 is registered as an ordinary trademark in Canada, registration number TMA927551, an individual trademark in the EU filing number 1110175 and in the UK as an ordinary trademark, trademark number UK00801110175. The mark in figure 23 is registered in the US as an ordinary trademark, registration number 4614060.

[59] Subramanian (n 19).

and the lives of the cocoa farming community, there are no articulated standards of what qualifies a product to bear the NESTLÉ'S COCOA PLAN mark.[60]

NESTLÉ'S COCOA PLAN makes use of a couple of attestation marks that are used only in association with NESTLÉ branded products. This mark is registered two different ways across jurisdictions, as seen in figures 22 and 23 above. In some registrations is a brown rectangle with words COCOA PLAN written largely inside the rectangle with two horizontal lines over the mark, with the second 'o' in COCOA the shape of a cocoa bean. In others, it is the former mark with the Nestlé's distorted red, heart shaped logo with NESTLÉ in white writing inside, sits above COCOA PLAN within the brown rectangle.

Despite using 'NESTLÉ' in the mark's signifier, the role of this mark does not communicate the source of the product. This mark does not appear centrally on packaging, or in larger font. Likewise, NESTLÉ, although an umbrella commercial source, markets their products with a more product-level source indication, which is signalled by other marks. Rather, this in-house certification marks corresponds to a regime created by NESTLÉ and speaks to the nature of the cocoa used in marked products: 'The Nestlé Cocoa Plan aims to improve the lives of cocoa farmers and the quality of their products.'[61]

[60] There has been pushback on the quality of this mark of rectitude, see for example: Beth Hoffman, 'Love Chocolate? 4 Reasons Why Nestlé's Cocoa Plan Is Not Enough' *Forbes* (22 May 2013) <https://www.forbes.com/sites/bethhoffman/2013/05/22/4-reasons-why-nestles-cocoa-plan-is-not-enough/#4b2ce6d77582> accessed 12 October 2019; 'Nestle Cocoa Plan: Not Quite Enough' (*Chocolate Class*, 3 May 2018) <https://chocolateclass.wordpress.com/2018/05/03/nestle-cocoa-plan-not-quite-enough/> accessed 12 October 2019; Peter Whoriskey and Rachel Siegel, 'Cocoa's Child Laborers' *The Washington Post* (5 June 2019) <https://www.washingtonpost.com/graphics/2019/business/hershey-nestle-mars-chocolate-child-labor-west-africa/> accessed 12 October 2019.

[61] Nestlé, 'Nestlé Cocoa Plan' (*Nestlé Cocoa Plan*) <http://www.nestlecocoaplan.com/> accessed 12 October 2019.

This type of pseudo-certification mark is unique in being clearly branded with an existing producer brand. NESTLÉ is a well-known brand that produces the products certified; it is the source of the products carrying the attestation mark. Consumers see upfront that the quality being certified is interwoven with the brand responsible for the product being produced. This flies in the face of bifurcating the source and certification as certification marks are intended to do. As an in-house certification mark, there is no arm's length relationship to help foster objective standard setting and independent monitoring.

An in-house certification mark may be tailored to a standard and thus entirely fit for purpose. On the one hand, this can be beneficial as no administrative and bureaucratic energies are wasted meeting unnecessary or irrelevant standards. On the other hand, however, this can result in a producer determining the easiest, most diluted way to sufficiently meet a standard to leverage the self-declaration for a benefit in the market.[62] In this latter scenario, an in-house certification mark may mean very little, as the party creating and using the mark has only their own interests in mind. Yet a savvy in-house certification mark owner will find a way to have a mark that is not deceptive. Similarly, because this mark is branded and only used on brand owned products, it can always be argued that it *is* performing a source indicating function such that it is not a deceptive trademark.

5.3.2.c Specious certification marks

Specious certification marks are also registered as ordinary trademarks. Unlike an in-house certification mark, this type of mark is not transparently branded. Again, this kind of mark

[62] This is like the practice of 'corporate washing' discussed in Chapter 6, where corporations make insincere claims of responsibility.

would not meet the requirements of a registered certification mark in jurisdictions of interest here. It is exclusively used by its mark owner and thus is another first-party certifying attestation mark. Accordingly, there is no requirement for publicly announcing the characteristics or standards associated with its use.

The COCOA LIFE mark is an example of this kind of pseudo-certification mark, figure 24.[63]

figure 24 COCOA LIFE mark

This mark is a combination word and design mark. It is composed of two concentric circles, where the other circle is a solid green colour and has the words 'COCOA LIFE' written in it. In the inner circle is the outline of a flower, that is composed of different colours. From the words on the mark, and the use of a flower, one would likely infer that this mark indicates something regarding the quality of cocoa and nature. The word 'life' in this context is vague. There is nothing about the mark itself which communicates a discrete characteristic or standard. This mark, in fact, signals the Cocoa Life global cocoa sustainability program. The mark is found on various cocoa products, namely chocolate bars, that come from a range of sources, such as CADBURY, FREIA, CÔTE D'OR and

[63] This mark is registered as an ordinary trademark in Canada, (international) registration number 1664269, as well as the UK, trademark number WO0000001664269. In the EU it is registered as an individual trademark, filing number 1664269. In the US it is registered as a trademark service mark, (international) registration number 1664269.

MILKA. To the average consumer, this mark has no apparent brand affiliation. Yet, the Cocoa Life program is controlled and owned and by Mondelēz International.

Mondelēz International is a large multi-national snack producing corporation: '[Our] *purpose* is to empower people to snack right. We will lead the future of snacking around the world by offering the right snack, for the right moment, made the right way.'[64] To this end, they own a large range of beverages, biscuits, chocolates, gum and candy brands in their portfolio. This includes an array of powerful brands such as CADBURY, MILKA, TOBLERONE, TRIDENT, RITZ and OREO, to name a few. The COCOA LIFE mark only appears on some Mondelēz International products, such as CADBURY, FREIA, CÔTE D'OR and MILKA. As the COCOA LIFE mark is used on a variety of brands, an average consumer is unlikely to know they are all owned by Mondelēz International. Based only on marketplace experience, a consumer seeing COCOA LIFE mark on a variety of chocolate products could assume it is some sort of third-party mark as it has no explicit affiliation with the product's brand.

The characteristic behind the COCOA LIFE mark appears to be some vague notion of cocoa sustainability. Little clarity emerges even looking beyond the mark to the COCOA LIFE's online materials. COCOA LIFE'S website outlines three areas of intervention they are guided by. Yet these principles do not correspond to a specific *standard* or characteristic, rather their materials detail various ways in which these interventions are supported. This, however, is not the same as articulating and maintaining a clear standard. Moreover, despite the distancing of COCOA LIFE's advertising and branding from

[64] Mondelēz International, 'About Us' (*Mondelēz International*, 2021) <https://www.mondelezinternational.com/about-us> accessed 12 October 2019 (emphasis in original).

Mondelēz, this is a first-party attestation mark, which again, eliminates the presumption of objectivity, transparency, and independence one expects from a third-party certifier.[65] Notwithstanding being a program operated by Mondelēz International, their website seeks to legitimise them and centre their program in a network of independent organisations by listing their partners, initiatives they are members of, and external advisors. For instance, COCOA LIFE works with various partners, such partners have included Save the Children, FAIRTRADE International, World Vision, and is a member of the International Cocoa Initiative and the World Cocoa Foundation.[66] Several of these organisations are well-known and are reputable advocacy and non-profit organisations. While COCOA LIFE is not at arm's length from the products it is used on, through its numerous partners, memberships, and external advisors, it appears to be trying to garner the goodwill a third-party could give it, while still operating entirely in line with Mondelēz International's interests.

A mark owner would likely opt for a specious certification for similar reasons as one would opt for an in-house certification mark; the essential difference between these types of marks is the decision to not disclose the ownership of the attestation mark within the signifier. While there is no literature on why a mark owner might opt for this, it may be to give the appearance of an arm's length relationship between the specious certification mark and the product that bears it. However, a specious mark owner may argue, to the contrary, that because the mark is used only on their own products it performs a source

[65] Michael E Conroy, *Branded! How the 'Certification Revolution' Is Transforming Global Corporations* (New Society Publishers 2007).

[66] Mondelēz International and Cocoa Life, 'COCOA LIFE'S PARTNERS' (*Cocoa Life*, 2021) <https://www.cocoalife.org/the-program/partners> accessed 1 May 2022.

indicating function. On the one hand, this latter argument may be tougher to make convincingly in instances, such as COCOA Life where the mark is advertised as performing a certifying function. On the other hand, however, an owner may argue that a specious certification mark is seeking to perform an informative function, describing something about the quality of their product.

5.4 Insights derived from considering the certifying function in practice

In the previous two sections, I considered how the certifying function operates in the market in two respects. First, I considered how brand meaning forms a backdrop to the certifying function such that a consumer familiar with a certification mark may import their impression of the brand into a certification mark's signified. Second, I considered how in contrast to what one might assume about the purview of the certifying function, it is not the domain of certification marks alone. In this section, I consider what examining the certifying function in practice may tell us about the story of the certifying function and attestation marks. To borrow the words of Lionel Bently and his colleagues, what are the 'social practices and understandings attached to the activity of applying marks to goods' where the goal of the mark is to communicate that a product is assured to have a given characteristic;[67] to describe and vouch for the nature of a product as distinguishable from other similar products on the market. And further, what insights can we glean from these practices that will provide a critical context for my discussion on certification marks and certifying functions in the chapters that follow.

[67] Bently and others (n 1) 847.

First, the ways in which at least some third-party certifiers and certification mark owners behave may tell us something about how brands and how brand meaning pervades the marketplace. Namely, that the utility (and desirability) of brands in cultivating marketplace meaning does not stop at ordinary trademarks but proceeds into the world of certification marks. As discussed in the previous chapter, the role of brands in shaping trademark meaning and justifying the protection of trademarks has been the subject of a rich body of trademark law scholarship. Yet, the intersection of certification marks and brands has not been considered in the literature in any significant way. What does come into focus when we do look at how certification marks and brands intersect, however, is that brand meaning can be embodied by marks that primarily perform a certifying function as well, not just those marks that have the source function as their essential function.

The co-existence of brands and certification marks is interesting when one considers the ways in which certification marks are often conceptualised—as marks which are intended to convey a specific standard and thus some measure of objective meaning about the quality of a product. While trademarks already, and inherently, are used as a proxy to signal a product's qualities, the qualities we expect trademarks to signal are generally individuated and acceptably 'fuzzy.'[68] While we may accept, or even embrace, that trademarks are vehicles of individuated meaning, some may find this less tolerable for certification marks.

Trademarks embodying and evoking a brand's impression can be seen as aligned with at least some goals of trademark law. The same may not be true, at first blush, with

[68] Dev Gangjee, 'Book Review: Jeffrey Belson, Certification and Collective Marks: Law and Practice, 2nd Edn (Edward Elgar 2017) 320 Pp.' (2018) 8 Queen Mary Law Journal.

certification marks. Thus, as a matter of observation, it is interesting the brands are developed around certification marks as well. Again, this is not to say that the owners of certification marks, these third-party certifiers, do not use their promotional material and positionality in the market to promulgate, explain, and defend their standards—they do. My point is that they *additionally* appear to be also involved in the enterprise of forming a brand in conjunction with these standards.[69] As such, the certifying function is not merely conveying the nature of standards alone, which one would consider an objective and finite set of information.[70] Rather, certification mark owners are also communicating through this fuzzier brand meaning mechanism.

Second, this chapter begins to break down the clean distinction between ordinary trademarks and certification marks as projected by legal norms. Although certification marks are conventionally conceptualised to play a unique role in the trademark law landscape, the reality is that the certifying function is not the purview of certification marks alone.[71] Rather, ordinary trademarks also act as attestation marks, albeit in a range of ways. Consumers are unlikely to know whether a mark they encounter is a pure certification mark or pseudo-certification mark. I will return to this in Chapter 7, but here I merely note that the distinction between ordinary trademarks and certification marks as institutions is not as clean as we may otherwise think.

Third, it is of interest to consider whether for specious certification marks and in-house certification marks their certifying function is an upshot of a source indicating

[69] These standards or their existence as a certifier can act as a touchstone object, as discussed in Chapter 4.

[70] What I refer in Chapter 6 as 'truth.'

[71] As I set out in Chapter 2.

function.[72] A proper analysis on this question would inevitably be bounded by the specific set of a facts of a given mark, how it is used, and the precise requirements of that jurisdiction to use the trademark as a mark. Nevertheless, we can see the *plausibility* for the argument that a trademark owner that uses a pseudo-certification mark to perform a certifying function, but exclusively on their own products, may say their mark is performing the quality function of a trademark.

Last, we may wonder what these insights about the certifying function in practice may tell us about how mark owners view certification marks in terms of desirability of certification marks as a legal object. Why does the practice of pseudo-certification marks, particularly quasi-certification marks, exist? There are few things to consider in contemplating the practice of pseudo-certification marks and attestation marks more generally.

An attestation mark owner may opt to register their mark as a trademark because it is a more desirable form of intellectual property. A primary motivation for the use of pseudo-certification marks may be that some attributes of certification marks are more limiting than ordinary trademarks. Despite differences between the regulations of

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[72] Particularly where the certifying function is more akin to, for example, the what the Court of Justice of the European Union has termed a quality function. Case C-10/89 *SA-CNL SUCAL v HAG* [1990] ECR I-3752 [13]. As the Court of Justice noted:

> '[A]n undertaking must be in a position to keep its customers by virtue of the quality of its products or services, something which is possible only if there are distinctive marks which enable customers to identify products and services. For the trade mark to be able to fulfil [its] role, it must offer a guarantee that all goods bearing it have been produced under the control of a single undertaking which is accountable for their quality.'

Likewise, the dominant account of trademarks (the search costs account) accepts that the role of a trademark is to act as a proxy of unobservable attributes, ie quality. See: William M Landes and Richard A Posner, 'Trademark Law: An Economic Perspective' (1987) 30 The Journal of Law and Economics 265.

certification marks in different jurisdictions, on the whole certification marks come with more registry oversight and constraints than ordinary trademarks.[73] These additional regulatory burdens exist notwithstanding that a certification mark owner is still responsible for the investment and maintenance of their mark.[74] Accordingly, it makes sense that an attestation mark owner may want to opt for the mark that comes with more freedom or control. This may be particularly true where certification mark owners are trying to build and develop a brand around their certification.

This was the tentative conclusion reached by Biddle and his colleagues when considering why a majority of standard setting organisations (SSOs) opted to register for trademarks and not certification marks:[75]

> This outcome may be less surprising when considering the restrictions and complexities of certification marks, and considering the investments that the SSO makes in its 'house mark.' We suspect that many SSOs prefer to use their house mark in connection with testing and 'certification' instead of registering a certification mark because (a) the SSO will have invested in establishing the house mark, and the mark will be known to its constituent communities, and (b) the SSOs are able to accomplish their desired

[73] As previously discussed in Chapter 2. One such example is that certification mark owners are legislative prohibited from carrying on in the business of goods and services the certification mark is used for, see: Trademarks Act, s 23(1) (Canada); EC EUTM Regulation 2017/1001, art 83(2) (EU); TMA 1994, sch 2 para 4 (UK); 15 USC § 1064(5) (US).

[74] This is in line with the advice some lawyers give their clients about whether to register a trademark or certification mark, see for example a blog post where solicitors explain that in the United States 'One advantage of trademarks is the complete control the owner can exercise over its trademarks. Owners can license a trademark to whomever they wish. And, although trademarks are subject to certain forms of attack, they cannot be attacked for discriminating against particular licensees. This results in broad and complete control over a mark's use. Another advantage is that trademarks are far more common than certification marks and are thus more familiar. The trademark application process includes fewer requirements than the certification mark process. Additionally, trademarks are recognized in nearly all countries around the world, while certification marks are not.'

Heather Angelina Dunn and Blake William Jackson, 'Trademark or Certification Mark? The Standards Body's Dilemma | Insights | DLA Piper Global Law Firm' (*DLA Piper*, 10 December 2012) <https://www.dlapiper.com/en/us/insights/publications/2012/12/trademark-or-certification-mark-the-standards-bo__/> accessed 6 July 2016.

[75] Their research found that of 40 standard setting organizations only 8 applied for certification marks, and of the 327 applications examined only 47 were for certification marks.

> outcomes contractually, without having to navigate the complexities of the certification mark process. These SSOs typically adopt a strong trademark usage policy or license agreement for its members which permits the SSO member to use the SSO's trademark, but subject to the terms of the trademark policy and, if applicable, any certification program established by the SSO. Thus, if the SSO member breaches the trademark usage policy, or falls out of compliance with any certification program, the SSO has greater control pursuant to contract law to stop the non-complying member's use of the SSO's mark.[76]

There is limited insight into why an organisation takes the trademark strategy it does,[77] but my observations are in line with Biddle's findings.[78]

Likewise, in the case of *Omega Flex Ltd v British Standards Institution* the owners of the British Standards Institution (BSI) Kitemark sought to let their registration of their certification mark lapse and registered it as an ordinary trademark instead.[79] In the hearing contesting this registration, BSI put forward evidence that they were seeking to register their mark as a trademark to be able to further develop their legitimate business interests and develop their brand:

> The reason for doing so [registering the Kitemark as an ordinary trademark] was driven by legitimate commercial objectives and a general drive to re-focus the business of the proprietor's certification arm. These objectives included: international growth, aligning the branding of the Kitemark to realise the full value of its goodwill, and to align with the proprietor's protection of the Kitemark in other jurisdictions where it is registered as an ordinary mark; In 2012, Mr. Fenton became aware that there were a number of commercial restrictions placed upon the proprietor due to the fact that the

[76] Biddle and others (n 23) 8–9.

[77] Interestingly, the Canadian Trade-Marks Opposition Board once observed that in an instance where an Applicant had the choice to file an application to register a mark as either an ordinary trademark or certification mark was 'not relevant to speculate' why they decided to not file an application for a certification mark. See: *Chartered Professional Accountants of Ontario v Association of International Certified Professional Accountants, a District of Columbia non-profit corporation*, 2019 TMOB 120 [155] (Trademarks Opposition Board of Canada).

[78] And further supported by conversations had with representatives of the USB Implementers Forum: Interview with Ravencraft and Donnell (n 51).

[79] Discussed further in Chapter 7.

> Kitemark was protected by certification mark registrations which impacted upon the business in ways that did not apply to an ordinary mark.[80]

A certification mark owner's work and investment into the maintenance and reputation of their mark is in many ways parallel to the work a trademark owner does to build and generate value in their brand. Yet, given the restricted uses of a pure certification mark, the investment and maintenance costs come without the corresponding freedoms and full range of benefits. While pure certification mark owners undoubtedly benefit from the uptake of their mark and the proliferation and market acceptance of their corresponding standard, this may be an insufficient motivation. Where the owner is a standard setting organisation, such as Assured Food Standards, or non-profit organisations, such as the Brewers Association, who are not primarily profit driven, this benefit may be sufficient. Particularly where their mandate lies in advocacy or in education.

A pure certification mark owner, that successfully generates awareness and the proliferation of their attestation mark, can also develop their reputation. This reputation can become key. In many cases, a consumer may not understand the specific requirements underlying the standard for the given characteristic being attested to. Rather, the consumer is familiar with, and trusts, the certifier.[81] This is likely to become amplified as the standards and characteristics underlying attestation marks and are likely to become more complex. Where this is the case, consumers will become more reliant on the identity of the entity attesting to the characteristic of the mark, rather than familiar with the details of the characteristics or standards themselves. This, in turn, results in pure certification marks

[80] *Omega Flex Ltd v British Standards Institution*, BL O/765/18, [2019] RPC 10 [13] (Intellectual Property Office).

[81] Discussed further in Chapter 6.

becoming a brand in their own right. Becoming brand-like may not only assist pure certification marks in generating greater awareness (as they mediate relations and act like informational intermediaries) but can also help pure certification mark owners differentiate themselves in a marketplace flooded with attestation marks.[82]

As discussed, there are compelling reasons why an attestation mark owner would want to build a brand around their mark. There may be values associated with an attestation mark that are not strictly part of the characteristic or standard certified, but that affects the perception of an attestation mark. Consider an attestation mark that indicates a characteristic or standard related to rectitude—such as an environmental or religious standard. It is conceivable that a producer would meet the requirements of the mark but would behave in a way that is incongruent with the attestation mark's brand.[83] Allowing this potential user of the mark to associate their products with the attestation mark may compromise the attestation mark owner's brand. One can appreciate how an attestation mark owner may want to cultivate and protect the perception of their mark by prohibiting use by users whose actions are in tension with the mark's brand.[84]

In today's market, it is not only the attestation mark owners who benefit from their mark evoking and embodying a brand. Supervening a brand to an attestation mark, or certification regime or certifier, helps facilitate trust between a consumer and certifier,

[82] Margaret Chon, 'Trademark Goodwill and Green Global Value Networks' in Matthew Rimmer (ed), *Intellectual Property and Clean Energy: The Paris Agreement and Climate Justice* (Springer Singapore 2018).

[83] As in the example of the Jezebel restaurant, see (n 56-57).

[84] Dunn and Jackson (n 74). 'Certification marks afford the appearance of detached altruism. A certification mark licensor cannot attach the mark to its own manufactured goods. Thus, it is perceived as operating above the fray of commercial self-promotion. However, obtaining a certification mark is more arduous.'

which is key for attestation marks dealing in credence characteristics. Attestation marks are also increasingly in competition with one another. In a market where consumers are often interested in complex rectitude characteristics, it is not only the product that have credence attributes, but the standards themselves are a credence attribute. These factors militate in favour of attestation mark owners having the control required to make use of their mark in service of brand management. Seen in this light, it is less surprising and problematic that some attestation mark owners are registering their marks as trademarks; owners such as B Lab, Fairtrade International, and the Rainforest Alliance rely on their brand in part to generate value around their certifications.

Pure certification mark owners have already begun to use roll-out awareness campaigns as part of their investment and maintenance strategy, as discussed in section 5.2 above. These campaigns are akin to trademark owners' advertising campaigns to build their brand. Despite the apparent value to a pure certification mark owner to be able to build a brand around their mark, their ability to do so effectively may be curtailed by the regulatory limitations on who can make use of their mark.[85] This may, in part, explain why attestation mark owners are registering their marks as ordinary trademarks.

Another potential motivation behind registering pseudo-certification marks is producers looking for ways to communicate quality to consumers that align with consumer interests in more ethical and sustainable consumer practices. Consumers have become

[85] This is particularly so in jurisdictions that have the principle of compulsory licensing or the non-discrimination principle, which is concretised in the American legislation. For instance, 15 USC §1064(5)(d) sets out that a certification mark can be cancelled if at any time the certification mark registrant 'discriminately refuses to certify or to continue to certify the goods or services of any person who maintains the standards or conditions which such mark certifies.' While the British legislation does not mandate this, Belson holds that 'the policy of requiring "open access" to certification marks has been maintained consistently by the registry.' See: Belson (n 21) s 3.84.

accustomed to interpreting information about the quality of products in certain ways. This task can also be performed by symbols or designs that are not signs nor registered marks. Consider, for example the brand SWEETS FROM THE EARTH. This is a Canadian family-run company that produces a line of ethical and inclusive baked goods. They describe their line of baked products as follows:

> Our proudly family-run company makes a full line of original recipe, egg free, dairy free, vegan baked goods, which are made using only the best all natural, kosher, 100% plant-based, GMO-free ingredients. We are pleased to offer both a nut free line and a gluten free line.[86]

With this many product attributes, it's not surprising that a SWEETS FROM THE EARTH package is covered in information, as seen in figure 25.[87] Several of the marks on the package are indeed certification marks – such as the COR kosher mark and top left Gluten Free Celiac Association mark. Other designs, which appear as marks, however, are not. For instance, the GMO sign on the bottom left of the label, also featured in figure 25 is not a registered trademark.[88]

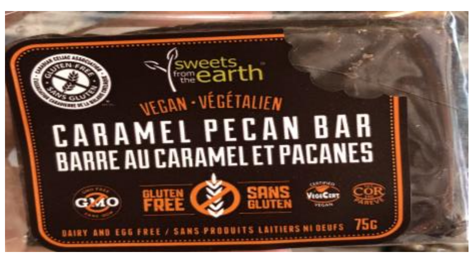

figure 25 SWEETS FROM THE EARTH caramel pecan bar

[86] Sweets from the Earth, 'Our Story' (*Sweets from the Earth*, 2016) <https://sweetsfromtheearth.com/about-us/our-story/> accessed 18 November 2021.

[87] Photograph taken by author.

[88] Sweets from the Earth, 'Homepage' (*Sweets from the Earth*, 2016) <https://sweetsfromtheearth.com/> accessed 18 November 2021.

figure 26 SWEETS FROM THE EARTH GMO free label

Nevertheless, it appears as an attestation mark, both for the way it is used, ie its size and placement on the package, and with respect to what it is communicating, the absence of GMOs.[89] While this mark is not registered as a trademark, it is similar to a specious certification mark as it is unbranded and appears to be attesting that the product has a certain quality, that it is GMO free.

A brand owner may opt to use a specious certification mark or a symbol that looks like an attestation mark, as in the case of SWEETS FROM THE EARTH, simply to communicate information about their product quickly and conveniently to consumers. If certifying marks do indeed work to communicate characteristics about a product because of how consumers interpret these marks, then we can see how brand owners may use unregistered marks and symbols to convey qualities using similar marketplace conventions, and not the fact of certification.

It is also possible that applicants are unable to secure the type of trademark registration they are interested in. Some pseudo-certification mark owners may have

[89] Which is not a problem if the product is indeed GMO free, because it is descriptively true even if it is not clear to the consumer who or what entity is standing behind this declaration.

preferred a pure certification mark but been unable to register one. This could explain some of the pseudo-certification marks in existence, but not all.[90]

5.5 Conclusion

In this Chapter, I set out a description of the greater context in which the certifying function exists, particularly with respect to brand meaning, building on my discussion of brands from Chapter 4. I argued that certification marks are already acting as parts of brands, which allows the certifying function to exist embedded within the context of a brand's impression. Certification marks, like ordinary trademarks, can evoke and embody brands. I illustrated this practice with real world examples. By certification mark owners developing the non-standard related aspects of their brand, their brand impression includes both the nature of their standards as well as other ideas and identities that extend beyond that of their certification and standards. This highlights the practice of certifiers to both act as brands and seek to situate their certification marks with meaning beyond their standards alone. I further demonstrated that this practice of embedding the certifying function within a greater brand meaning may be driving some attestation mark owners to register their

[90] This project has not undertaken a systematic qualitative review of the marks that have initially sought to be registered as pure certification marks and rejected. Based on a Freedom of Information Request (on file with the author) there has been approximately 350 rejected certification mark applications in the last decade at the UK IPO office. Similarly, an initial search has suggested there have been less than 30 rejected certification mark applications at the European Union Intellectual Property Office since the introduction of the EU Certification Mark in 2017. There are, at least, examples of a few reasons why certification mark applications have been rejected, including: (i) a finding the mark was descriptive and non-distinctive (Examination – W01461294 EU IPO Decision on the inherent distinctiveness of an International registration designating the European Union trade mark); (ii) a finding the mark was intending to distinguish goods on the basis of geographical origin and thus fell outside the ambit of Article 85 of the EUTMR (Examination – 018529593 Refusal of application for a European Union trade mark); (iii) a finding the applicant had an economic interest by carrying out activity related to the provision of services of the certified type (Examination – 018527189 Refusal of application for a European Union trade mark).

marks as ordinary trademarks and thus use their marks as pseudo-certification marks. I suggest the practice of pseudo-certification marks also highlights ways in which marketplace meaning, vis-à-vis brands has developed for attestation marks. While my anecdotal observations cannot point to a definitive trend in why this practice is occurring, there appear to be a few possible drivers at play. Irrespective of the impetus for this practice, its existence nonetheless invites us to consider more deeply the relationship, and divide, between ordinary trademarks and certification marks.

VI. Reconceiving the Certifying Function: A Vehicle for Trust (Not Truth)

6.1 Introduction

How is the certifying function best conceptualised? What reforms would best support its optimal operation? These are the questions that motivate this chapter. Building on the preceding chapters, I argue that what is crucial to the functioning of certification marks is trust, not the provision of objective, specific, and truthful information. Throughout this chapter I refer to *truth* and *truthfulness* as a shorthand for this type of information—information that is objective, specific, and accurate. In this chapter, I challenge the conventional idea that the basis of an adequate certifying function is the provision of truthful information. I suggest that the ability to command trust, in a more relational sense, is the proper cornerstone of the certifying function.

I begin this chapter by describing the role *truth* and *trust* are understood to have in animating certification marks with respect to the conventional account of certification marks. I argue that this traditional approach to certification marks envisions them as a more truthful kind of trademark and are often seen as a mark which can provide consumers, at a glance, information about the nature of a product. I go on to argue that while the concept of trust is already embedded in how we understand certification marks, as a form of trademark, that the role of trust is much deeper and richer than appreciated. I argue, rather, the key to how certification marks function is their ability to command a relational sense of trust between consumers and the brands embodied by these marks. Last, I explain why seeking to enhance the truthfulness of certification marks is misguided. Attempting to substantively regulate the standards underlying certification marks to enhance how truthful a mark is produces consequences that are in direct tension with other goals of trademark law. Such an attempt would also insufficiently recognise the role of trust in driving consumers' reliance on certification marks.

6.2 Motivating the certifying function: the role of trust and truth

Contrary to the conventional account, the essential function of certification marks is a mechanism of commanding trust rather than communicating truth. That is, the certifying function is better understood as a vehicle for trust rather than as providing truthful information about the characteristic that is being certified, the standard it is being certified to, or the identity of the certifier.[1] Recognising the central role of trust in certification marks, at a minimum, offers a more apt account of how certification marks work in practice. *Truth* and *trust* are not mutually exclusive components of certification marks, which are both relevant features. Nevertheless, while truth is more predominantly featured in the conventional accounts of certification marks, trust plays a more central role, and the ability to command trust ought to be advantaged as such.

6.2.1 Truth and the conventional account of certification marks

As discussed in previous chapters, there is little case law or scholarship considering the essential function of certification marks—what I have called the *certifying function*.

[1] The type of information I described as being necessary components of robust certification marks in Chapter 2. That is, robust certification marks are not only identifiable as distinctive attestation marks but also signal information about the certification itself, namely the *characteristic being certified* and the *actual source of the certification*.

Conventionally, the goal of certification marks is to ameliorate the uncertainty associated with the quality of a product, particularly qualities that are credence attributes.

In the rare treatment of certification marks by adjudicative bodies, they generally refer to statutory definitions of a certification mark when they hold that the essential function for a certification mark is to distinguish the goods or services which are certified from those that are not, as set out in Chapter 2. For example, the former Second Board of Appeal for the Office for Harmonization in the Internal Market (OHIM) articulates the essential function of a certification mark as a 'guarantee function':

> [A]n individual trade mark is defined by its essential function which is to distinguish the goods or services of one undertaking from those of other undertakings…In this way the trade mark guarantees the identity of the origin of the goods or services to the consumer or end user by enabling him, without any possibility of confusion, to distinguish them from others with another origin….
>
> On the other hand, a certification mark is defined by its essential function which is to certify that the goods or services meet certain established standards and possess particular characteristics….<u>A certification mark performs a guarantee function: guaranteeing that the certified products or services possess a certain quality resulting from their compliance with the defined standards. They also perform a distinctive function: distinguishing such products and services from competing products not having the certified quality</u>.[2]

Similarly, the UK Intellectual Property Office, in a rare case addressing the distinction between trademarks and certification marks, explained the function of a certification mark as that 'which is to certify the *quality of third party goods/services*' in contrast to the essential function of an ordinary trademark, which indicates the 'trade *origin*

[2] Case R 87/2010-2 *DVB Project v Palmerston Limited* [25]-[26] (Second Board of Appeal 2011, OHIM (emphasis added).

of goods/services.'[3] Furthermore, Canadian and American case law have similarly defined the purpose of certification marks as to distinguish between a characteristic of the goods or services, and to distinguish between wares certified with respect to a particular standard from those that are not.[4]

Fittingly, the conventional account of certification marks can be outlined as follows: by indicating that goods or services are certified for a given quality—and being able to distinguish these from those products which are not—consumers can rely on certification marks as indicators of unobservable attributes, chiefly credence attributes.[5] Accordingly, the performance of this essential function allows certification marks to transform what would otherwise be an unobservable attribute into a search attribute.[6] Thus, the certification mark's presence assures the consumer of a given quality of the product; it

[3] Omega Flex Ltd v British Standards Institution, BL O/765/18, [2019] RPC 10 [20] (Intellectual Property Office).

[4] *Int'l Info Sys Sec Certification Consortium v Sec Univ, LLC*, 823 F.3d 153, 15 (2d Cir. Conn. 2016); *Republic of Cyprus (Commerce and Industry) v International Cheese Council of Canada*, 2011 FCA 201 (Federal Court of Appeal of Canada).

[5] Unobservable attributes include experience attributes and credence attributes, as discussed in Chapter 2. See: Michael R Darby and Edi Karni, 'Free Competition and the Optimal Amount of Fraud' (1973) 16 Journal of Law and Economics 67; Phillip Nelson, 'Information and Consumer Behavior' (1970) 78 Journal of Political Economics 311.

[6] Namely credence attributes, although some certification marks do certify what can be considered an experience attribute. For instance, certification marks which intend to communicate the absence of an allergen or foodstuff. While the presence of such an ingredient may be, in many ways and for many consumers, a credence attribute, for those who are allergic to the product it may be an experience attribute. These minority cases have little bearing on my argument, however. Even for the consumer, for instance, who is utterly intolerant of gluten and eats a certified gluten free cookie and feels discomfort, it will be difficult to definitively know why. The consumer is not likely to be able to discern if source of the discomfort was because the gluten-free certification mark was used inaccurately, or the standard being certified was not rigorous enough for this consumer, if the producer of the cookie used another ingredient that caused discomfort, or another reason altogether.

provides a non-legally binding 'guarantee' pertaining to some specific and objective quality.[7]

Based on my descriptive analysis in Chapter 2, fulfilling the certifying function appears, at a minimum, to require that a consumer identify the mark as communicating an aspect of quality (divorced from source) and that the mark is sufficiently distinctive from other trademarks and certification marks as to be able to distinguish marks that are certified from those that are not.

It is helpful to further consider the conventional account of the certifying function, and thus certification marks, within the greater trademark law landscape. The role of certification marks—like *all* trademarks—is to reduce uncertainty, thus minimising risk and increasing efficiency in our marketplace interactions.[8] A primary way to minimise risk is to reduce uncertainty, particularly the uncertainty associated with the imperfect nature of information asymmetry.[9] Namely, by ameliorating the information asymmetry in the market, we can reduce the amount of uncertainty, and correspondingly, the risk. Trademarks help us do this efficiently.

This is not a contentious proposition. The prevailing, yet imperfect, view of trademarks, remains the law and economics account that the protection of trademarks

[7] Jeffrey Belson, *Certification and Collective Marks: Law and Practice* (2nd edn, Edward Elgar Publishing Limited 2017) para 5.09.

[8] William M Landes and Richard A Posner, 'Trademark Law: An Economic Perspective' (1987) 30 The Journal of Law and Economics 265.

[9] In nearly all marketplace transactions consumers are operating with less than optimal information. In a healthy functioning market this is generally not a problem; consumers do not need perfect and complete information to make every purchasing decision. Left unmanaged, however, marketplace information asymmetry can be a problem, as discussed in Chapter 2, see: George A Akerlof, 'The Market for "Lemons": Quality Uncertainty and the Market Mechanism' (1970) 84 The Quarterly Journal of Economics 448.

reduces 'search costs' in the market.[10] Trademarks do this by acting as reliable indicators that products bearing a given mark are all under the control of the same mark owner, and thus can be relied on to maintain a consistent quality from purchase to purchase. Trademarks offer a sense of certainty in the market about what we are searching for. The same can be said of certification marks.[11]

The difference between the nature of uncertainty being reduced between trademarks and certification marks is a more complicated issue. As indicators of trade origins, trademarks stand as a proxy for a whole range of information by signalling one clear piece of information—the commercial source of a product. Thus, trademarks are said to have individuated meaning.[12] Not only can the same trademark have different relevance to different consumers, but the nature of the meaning of a trademark itself, or as Beebe calls it the signified of a trademark, is individually cultivated.[13]

The nature of uncertainty reduced by a trademark will vary consumer to consumer and is shaped by an individual's prior experience (if any) with a trademark, or the brand associated with it, and the consumer's preferences. Accordingly, an individual trademark can reduce uncertainty for consumers as to the unobservable attributes of a product,

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[10] This view, while remaining dominant, is not without its numerous criticisms. See, for example: Jonathan Aldred, 'The Economic Rationale of Trade Marks: An Economist's Critique' in Lionel Bently, Jennifer Davis and Jane C Ginsburg (eds), *Trade Marks and Brands: An Interdisciplinary Critique* (Cambridge University Press 2014).

[11] Certification is recognised as one way to reduce uncertainty in the marketplace, and accordingly, the potential for what economists refer to as the 'lemonization of the markets.' There are other ways to reduce this informational asymmetry, see: Ariel Katz, 'Pharmaceutical Lemons: Innovation and Regulation in the Drug Industry' (2007) 14 Michigan Telecommunications and Technology Law Review 1.

[12] See: Graeme B Dinwoodie, 'The Death of Ontology: A Teleological Approach to Trademark Law' (1999) 84 Iowa Law Review 611.

[13] Barton Beebe, 'The Semiotic Analysis of Trademark Law' (2004) 51 UCLA Law Review 621.

particularly experience attributes.[14] It is an axiom of trademark law that a trademark owner is consequently incentivised to maintain the quality of their product such that if a consumer purchases a product bearing the same trademark, it will have the same desired quality as their prior purchase.[15]

Conveying quality is the purview of ordinary trademarks. For example, imagine consumers Cathy and Calvin are in a shop and see a pair of running shoes with the NIKE swoosh logo on them. Both Cathy and Calvin properly identify these shoes as being NIKE shoes and can both call on their previous experience with their last pair of NIKE running shoes. Cathy is a stickler for support and comfort. She is a long distancer runner, and her last pair of running shoes were NIKE. She was very pleased with how they fit and how comfortable her feet felt even after a long run. When Cathy comes across this new pair of NIKE running shoes at the store, she will rely on her previous experience with NIKE running shoes and assume these new shoes will also keep her feet comfortable after a long run. This feature of running shoes is an experience attribute and cannot be determined in a store before purchase; Cathy trusts that the quality of NIKE shoes will remain consistent purchase to purchase.

Calvin has also worn NIKE shoes before but has not had the same experience as Cathy. Sometimes after a long run they make his feet feel a bit sore, but he does not mind as he is not a frequent runner. Rather, Calvin is looking for running shoes for his long walking commutes. His last pair of NIKE shoes lasted two seasons before showing any

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[14] The 'trust function' of trademarks is their capacity to 'denote unobservable experience and credence attributes, thus allowing consumers to trust specific sellers or products.' Ariel Katz, 'Beyond Search Costs: The Linguistic and Trust Functions of Trademarks' (2010) 2010 Brigham Young University Law Review 1555, 1563.

[15] Landes and Posner (n 8).

signs of deterioration. So, when Calvin looks at a new pair of running shoes and recognises they are NIKE shoes they also signal a consistent quality. But Calvin interprets NIKE to signal a different quality than Cathy. The same NIKE swoosh sign is signalling different unobservable attributes for Cathy and Calvin. This is a value of ordinary trademarks. Cathy and Calvin had different uncertainties about the quality of the pair of shoes, yet both uncertainties were overcome by the same information – the NIKE trademark – which lead them both to the presumption that these new NIKE shoes will also have their desired quality.

Certification marks reduce a different kind of uncertainty. Certification marks are intended to reduce uncertainty with respect to the quality of a good or service as well, but in a more consistent and objective way:

> Both certification and ordinary trademarks are bound up with quality perceptions, but in different ways. Where quality is concerned, a certification mark has a statutorily defined function – to indicate certification of goods to approved quality standards.[16]

The differences lie in the fact that the uncertainty reduced by certification marks is predominately with respect to the quality of a product's credence attributes rather than *both* credence and experience attributes. Thus, the quality that is the subject of the uncertainty is more definite and objective in contrast to a more subjective experience-based attribute.

While the quality or nature of a product that trademarks signal is both broad ranging and *individuated*, the uncertainty of characteristics that a certification mark is intended to ameliorate are precisely *not* individuated. The characteristics that certification marks are a proxy for are intended to be specific, demarcated, and finite. So, while Cathy and Calvin

[16] Belson (n 7) para 5.31.

may look to the NIKE logo on shoes as indicators of entirely different qualities, when they both see a FAIRTRADE logo, the conventional account holds, they are both relying on it to reduce the *same uncertainty*. That is, shoes with a FAIRTRADE mark were made sustainably.

This does not preclude the possibility that Cathy and Calvin's thoughts, feelings, attitudes, and behaviours in response to this FAIRTRADE logo may differ. Nor does it necessarily matter that they may both have different understandings of what the sustainable practice being signalled consists of. What is relevant, however, is that the quality signalled by the FAIRTRADE logo is intended to be the same quality irrespective of the consumer viewing it. This underscores something important about the certification mark regime vis-à-vis the ordinary trademark regime. There is a sense in which certification marks are intended to be more truthful than ordinary trademarks.

6.2.1.a Certification marks are more truthful trademarks

Certification marks, as a form of trademarks, are still regulated both as signs in the marketplace and as a proxy for information. Trademark law is more focused on regulating the maintenance of clear and consistent marketplace signals than regulating the information being signalled. There is an exception to this, however. Trademark statutes modify the ways in which certification marks are regulated separately and apart from ordinary trademarks.[17] As Belson explains:

> The [certification] mark signifies that its proprietor vouches for the conformity of the goods or services to approved and often quantitative standards. To the extent that the standard goes to quality, the certification

[17] As discussed in Chapter 2, see: Trademarks Act, s 2 (Canada); EC EUTM 2017/1001, art 83 (EU); TMA 1994, s 1(2) (UK); 15 USC § 1127 (US).

> mark attests to attainment of an *absolute* level of quality. By contrast, an ordinary trademark's quality is considered to be an assurance to the consumer of a *consistent* level of quality in the product as a whole.[18]

As certification marks signal is this 'absolute' level of quality; they provide of a more truthful information than trademarks.

While the certification mark regime is not intended to regulate information per se, when we look to the ways certification marks are created and governed by trademark statutes, we can see that certification marks are intended to be a more truthful kind of mark than ordinary trademarks.[19] This is done in a few ways, but the overall difference is what Belson calls more 'stringent' requirements for the registrations of certification marks, as compared to ordinary trademarks.[20]

For example, unlike trademarks that can be licensed to others without sharing the nature of the licensing agreement with the trademark registrar, certification mark owners must share with the registrar the rules that govern the use of the mark. The UK statute, for example, sets out:

[18] Belson (n 7) para 3.08. While I accept Belson's proposition, he does not provide support for this, and I have not seen any empirical work on this.

[19] I make this claim drawing on a functional account of certification mark, as explained in Chapter 2. That is, I look to the core defining features of certification marks apart from the nuances of regulation that pertain to a particular jurisdiction. I draw on Norman Siebrasse's concept of a functional definition: 'I consider the defining functional characteristics of a doctrine to be those characteristics which are necessary to the doctrine's purpose.... The defining functional characteristics do not fully characterize a doctrine. Defining characteristics capture only those aspects of a doctrine that are so fundamental as to distinguish it from other doctrines. There will typically be many other ancillary characteristics that are necessary to fully describe a doctrine.' Norman Siebrasse, 'Form and Function in the Law of Utility: A Reply to Gold & Shortt' (2015) 30 Canadian Intellectual Property Review 109.

[20] Belson (n 7) para 5.46.

> 6(1) An applicant for registration of a certification mark must file with the registrar regulations governing the use of the mark.
>
> (2) The regulations must indicate who is authorised to use the mark, the characteristics to be certified by the mark, how the certifying body is to test those characteristics and to supervise the use of the mark, the fees (if any) to be paid in connection with the operation of the mark and the procedures for resolving disputes.
>
> Further requirements with which the regulations have to comply may be imposed by rules.[21]

This is also true in Canada, the EU, and the US.[22] Similarly, the registrar must be satisfied that a certification mark owner is 'competent to certify' the goods or services for which the mark is registered.[23] These regulations are to be published and open to public inspection,[24] and the regulations may not be properly amended unless they are filed and accepted by the registrar.[25] Registrar oversight and consent is also needed to assign a certification mark.[26] Further, a certification mark may be revoked on the basis, *inter alia*, they are deemed no

[21] TMA 1994, sch 2, para 6.

[22] Trademarks Act, s 23, para 30(2)(b) (Canada); EC EUTM Regulation 2017/1001, arts 83-4 (EU); 15 USC §1054 (US); 37 CFR §2.45 (US).

[23] TMA 1994, sch 2, para 7(b). In Canada, an applicant is capable of being a certification mark owner if they are 'not engaged in the manufacture, sale, leasing or hiring of goods or the performance of services such as those in association with which the certification mark is used or proposed to be used.' See: Government of Canada, 'Trademarks Examination Manual' (Canadian Intellectual Property Office 2019) s 2.5 <https://www.ic.gc.ca/eic/site/cipointernet-internetopic.nsf/eng/wr01614.html?Open&wt_src=cipo-tm-main>. Similar rules exist in the EU and the US, see: EC EUTM Regulation 2017/1001, art 84 (EU); 15 USC §1127 (US). Also see: United Stated Patent and Trademark Office (USPTO), 'Trademark Manual of Examining Procedure' (2022) s 1306 <https://tmep.uspto.gov/RDMS/TMEP/current#/current/TMEP-1300d1e585.html>.

[24] Trademarks Act, s 30(2)(b) (Canada); EC EUTM Regulation 2017/1001, art 111 (EU)TMA 1994, sch 2, paras 9-10 (UK); 37 CFR §2.200 (US). See also, Government of Canada (n 23) s 2.5.

[25] Trademarks Act, s 41(1)(d) (Canada); EC EUTM Regulation 2017/1001, art 88 (EU) TMA 1994, sch 2, para 11 (UK); 37 CFR §2.76 (US).

[26] TMA 1994, sch 2, para 12 (UK). See also: EC EUTM Regulation 2017/1001, art 89 (EU).

longer competent to certify or 'that the proprietor has failed to observe, or to secure the observance of, the regulations governing the use of the mark.'[27]

Taken together, these types of statutory provisions result in certification marks being uniquely regulated apart from ordinary trademarks and are an attempt to statutorily ensure a continuity in the quality a certification mark signals. Yet, as discussed in Chapters 2 and 3, these statutory provisions are not without their limits and the landscape of attestation marks today is different than one would expect based on these provisions. For the purposes of this discussion, however, we can see how these provisions attempt to make the quality that certification marks signal public and known; there is an attempt to make this quality signal consistent.[28] Collectively, these types of provisions work to make certification marks a more truthful kind of mark than ordinary trademarks. The underlying quality a certification marks signals is supposed to be demarcated, transparent, and consistent. Ordinary trademarks have no equivalent requirements.

It is not much of a leap to go from viewing a certification mark as a signal of absolute and consistent quality to a signal of truthful content. We can see this in the way the few trademark scholars that have considered certification marks tend to emphasis this difference between trademarks and certification marks:

> One finds a consensus in commentaries on the certification mark system that guarantee usage is appropriate to certification marks. Ladas observes

[27] EC EUTM Regulation 2017/1001, art 91 (EU); TMA 1994 sch 2 para 15 (UK); 15 USC §1064(5) (US). In Canada this would arguably fall within grounds of invalidation for reasons of misrepresentation or non-disclosure, see: David Vaver, *Intellectual Property Law* (2nd edn, Irwin Law 2011) 541–2.

[28] Of course, these regulations do not ensure consistency of quality, as the regulations or standards underlying the mark are liable to change. These rules merely ensure that these changes are overseen by the registrar. Consumers may not care about consistency of quality over all else, in fact, empirical research on the credibility of eco-labels cites the ability to adapt and grow standards as important, see: Hamish Van Der Ven, *Beyond Greenwash: Explaining Credibility in Transnational Eco-Labeling* (Oxford University Press 2019).

> that a certification mark 'has principally a guarantee function. It certifies regional origin or material, mode of manufacture, quality or other characteristic of the goods. The guarantee is generally emphasized and the buyer relies on this.' Implying that some more measure of guarantee is associated with any form trademark, Callman says that 'the guarantee function of a certification mark is much more evident than it is with respect to an ordinary trademark, service mark, or collective mark'. Callman also points out that 'a certification mark guarantees a specific standard of quality, place of origin, material, or mode of manufacture.' Rozas and Johnston invert this last proposition, saying that a mark that 'guarantees the functional quality and safety of a product regarding the components of the product is certifying that the product has the standard level established by the rules of certification'. Alexandra George views a certification mark as 'a guarantee of standards, thus bridging a gap between "intellectual property" and consumer protection law.' Dawson asserts that 'trade mark law permits an entire industry to protect itself by the registration of a *Certification Trade Mark* to act as a warranty that goods bearing the mark meet a certain standard or possess a particular characteristics.' ….[29]

Similarly, Bently, Sherman, Gangjee, and Johnson explain:

> With the increasing privatization of regulatory functions and the adoption of private governance models in market sectors, trade mark law has the potential to empower consumers by providing reliable, objective information facilitating their choices about where products come from, how they are made, and the values to which a manufacturer is willing to commit. Certification and collective marks are increasingly relevant in this context.[30]

While the language these scholars use varies, the idea that underlies their comments is that certification marks can do something *more* than trademarks; certification marks provide a more truthful signal. Conceptualising certification marks as *truth marks* gives a wholly incomplete picture of how this type of mark works. As more truthful as certification marks may be regulated to be, they are still a form of trademark and ultimately still communicate in the same manner of all marks.

[29] Belson (n 7) para 5.08 (original emphasis).

[30] Lionel Bently and others, *Intellectual Property Law* (5th edn, Oxford University Press 2018) 975.

6.2.2 The less appreciated role of trust

Trust is already recognised to play a pivotal role in the functioning of trademarks. The conventional account of ordinary trademarks—the search costs account—recognises and requires that trademarks command trust on the part of consumers and those who rely on them in the market. The informational efficiency account, or search-costs account, theorises that trademarks can be used to achieve efficiency in marketplace communication, and that the regulation, and protection, of trademarks can be justified on this basis:

> Perhaps the most convincing, and certainly the most prevalent, of the arguments for the protection of trade signs is that they operate in the public interest insofar as they increase the supply of information to consumers and thereby increase the efficiency of the market.[31]

Under this account, discussed earlier in Chapter 2, a trademark produces information that helps a consumer reduce their search costs, that is find their desired product in a market with more ease and efficiency than they otherwise would, by communicating the source of the product.[32]

The concept of trust is thus not alien to trademark law; the dominant account of trademarks is somewhat premised on it. Yet, the concept of trust in trademark law today is rather limited. What is meant by *trust* in trademark law is a very narrow set of expectations. The conventional account of trademark law holds that consumers can trust, and reasonably hold, the following expectations: (i) that a mark is properly affixed and used in the course of business with the consent of the mark owner, (ii) that the mark owner has the exclusive

[31] ibid 816.

[32] Landes and Posner (n 8) 275–6. Landes and Posner also mention that trademarks which are descriptive in part, can usefully describe the properties of a brand.

right to control the use of their mark, and (iii) that the mark owner is enforcing their rights. Thus, trust in this context is generally a stand-in for a far more familiar legal term—reliance.

The conventional account of trademark law holds that by granting a trademark proprietor the exclusive right to control their mark,[33] 'consumers can trust such marks and are thus spared the effort of having to investigate a product's provenance.'[34] Giving a trademark owner exclusive control of their mark, provides the basis for a consumer to *rely* on a trademark as having been used with the consent of the trademark owner. As discussed above, when the consumer can trust a mark as an indicator of commercial source, they can then rely – or trust – a mark to indicate a host of meanings. The nature of trust recognised and protected in trademark law is limited:

> The Trade Marks Act 1994 (TMA 1994) vindicates purchaser trust through, among other things, prohibitions on registration of misleading certification marks, provision for infringement proceedings, and criminal sanctions against false trademarking and unauthorized use of a certification mark. TMA 1994 in effect accords purchasers indirect protection only. The proprietor of the mark, in exercising his right to sue for trademark infringement, may be protecting purchasers against deception, but such protection is largely outside the purchaser's legal sphere of influence.[35]

There is, however, a broader and more robust sense of trust lurking beneath the surface of trademark law; sometimes trust is discussed explicitly, other times it is embedded in other ideas. As Belson explains:

[33] This exclusivity is subject to some exceptions, such as descriptive use in accordance with honest business practices and use in comparative advertising. For a more through discussion of trademark defences, see: Bently and others (n 30) ch 41 Trade Mark Defences.

[34] Dev Gangjee, 'Trade Marks and Allied Rights' in Rochelle Dreyfuss and Justine Pila (eds), *The Oxford Handbook of Intellectual Property Law* (Oxford University Press 2018) 1.

[35] Belson (n 7) para 5.02. Similar provisions exist in other jurisdictions of interest.

> Though a certification mark may not represent a legally binding guarantee of the certifier it ought manifestly to be conducive to **trust** on the part of the buyer. Here, trust means **trust in the truthfulness of the message** communicated by the mark **and trust in its communicator**. Upon seeing a certification mark and recognizing it as such the buyer is disposed to trust the mark, assuming that it is affixed by a bona fide authorized user. The mark is an attestation of product conformity to an objective requirement or requirements concerning its geographical origin, material or mode of manufacture, or some other characteristic. A buyer may be knowledgeable about the product and its certification, but he still needs to be trusting to some degree if he is to buy confidently. His trust is predicated on a belief in the trustworthiness of the mark, that the mark is affixed by an authorized user, and that the goods are genuine.[36]

This richer concept of trust already exists but is insufficiently recognised within the certification mark context.[37]

6.3 A richer concept of trust

When it comes to the regulation of certification marks specifically, and not the general enterprise of increasing accountability and certainty in the marketplace, I argue the goals of certification marks are better served by appreciating the role that this richer notion of trust plays in motivating the certifying function. As I have discussed above, the idea of trust is not alien to trademark law nor the extra-legal discussion of attestation marks generally. Using trust to overcome uncertainty in the market is far from a novel idea. The concept of 'trust' has been greatly debated in a range of disciplines.[38] Trust is what allows us to act with confidence even when the thing we are relying on, the person or institution,

[36] ibid 5.43 (emphasis added).

[37] I believe this richer concept of trust is applicable to trademarks at large and could help provide a conceptual framework for understanding several tensions that exist within trademark law today. Nevertheless, that is an undertaking outside the scope of this work.

[38] 'Many different disciplines use the concept, often with imprecision and ambiguity.' Christopher R Leslie, 'Trust, Distrust, and Antitrust' (2004) 82 Texas Law Review 515, 529.

is unknown. Trust is ‘a confident relationship with the unknown.’[39] Trust does not exist when one *knows* or has a guarantee as to an outcome; in these cases, trust is simply not required. Trust, therefore, inevitably involves a *risk*. The risk of trusting is that our trust was unwarranted and thus our trust is betrayed.[40] Trust has a role, and an increasingly central role, in the contemporary market. An increasingly complex world is often unknown or opaque to ordinary persons, requiring them to trust.[41] This is precisely the position of consumers interacting with certification marks.

Consumers must operate based on trust in the marketplace because neither certification marks, nor trademarks, are a legal guarantee. This is even more so the case where the characteristic of a product a consumer seeks is a credence attribute. Given the nature of credence attributes, ‘consumers are not often in a position to be able to assess the truthfulness of a claim made about a product’s qualities; thus, the issue of consumer trust is central to the legitimate functioning of this regulatory regime.’[42]

Additionally, *trust* is an ordinary and accepted feature of attestation marks. Trust, in this larger sense, is already understood by the political science and private governance communities as being fundamental to the operation of eco-justice labels, for example: ‘[E]co-labels serve as marks of *trust* that reduce information asymmetries between producers and consumers.’[43] Similarly, Belson argues:

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[39] Rachel Botsman, *Who Can You Trust? How Technology Brought Us Together - and Why It Could Drive Us Apart* (Penguin Books 2017).

[40] Carolyn McLeod, ‘Trust’ in Edward N Zalta (ed), *The Stanford Encyclopedia of Philosophy* (Fall 2015, Metaphysics Research Lab, Stanford University 2015).

[41] Piotr Sztompka, *Trust, A Sociological Theory* (Cambridge University Press 2000) 13.

[42] Margaret Chon, ‘Marks of Rectitude’ (2009) 77 Fordham Law Review 101, 109.

[43] Van Der Ven (n 28) 8 (emphasis added).

> Because ecolabels reflect credence qualities such as methods of production, sustainability of the manufacturer's operations and the like, they are promoted as a means of redressing or mitigating the inherent imbalance of knowledge between the supplier and the consumer, known as 'information asymmetry'. Simply put, the consumer must trust the supplier and the ecolabel licensor regarding the quality of the 'organic farming'.[44]

More than the narrow idea of trust embedded in trademark law, the trust relevant here is more akin to the kind of relationship someone has with their friend, or local politician. Some scholars recognise the role of trust in trademark law beyond this thin sense of trusting mark owners to have exclusive control over, and enforce their rights to, their marks. For instance, Ariel Katz has argued that trust is one of the two functions of trademarks.[45] For Katz, the trust function of a trademark is its 'capacity to denote unobservable experience and credence attributes, thus allowing consumers to trust specific sellers or products.'[46] Similarly, trademarks have the capacity for several functions that can be seen as supporting the existence of relational trust, particularly where a trademark helps protect the reputation of a mark which in turn allows a consumer to determine if they trust that source.

Trust in this richer sense is about acting in the face of uncertainty and risk as trusting is an inherently risky endeavour.[47] This reveals something about the nature of trust, however. Trust is not a personal virtue or a blanket position. Trust adheres to a specific

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[44] Belson (n 7) para 7.69.

[45] The other function he identifies is the linguistic function, see: Katz (n 14). Katz uses the term 'function' as distinct from the discussion of functions in the British and European context, see: Bently and others (n 30) 1116–25.

[46] Katz (n 14) 1563.

[47] Russell Hardin, *Trust & Trustworthiness* (Russell Sage Foundation 2002); Sztompka (n 41).

target, and each act of trust contains specific substance, that is involves specific expectations:[48]

> The great variety of expectations that can be involved imply that the content of trust is extremely variable. Speaking about trust, we must always specify: *trust to do what*? Absolute trust is a rarity. 'Only a small child, a lover, Abraham speaking to God, or a rabid follower of a charismatic leader might be able to say "I trust you" without implicit modifier'. Most often trust is relative. 'Trust is a three-part relation: A trust B to do X. Typically, I trust you to do certain kinds of things. I might distrust you with respect to some other things and I may merely be sceptical or unsure with respect to still other things.'[49]

Specific trusting expectations are relative to the target of trust, and these expectations are often normatively prescribed, and attach to a specific role or position, rather than the underlying object or person:[50]

> Expectations involved in trust are congruent or incongruent with the nature of objects toward which trust is directed. Specific expectations fit to specific objects, and do not fit to others. It seems obvious to expect care from a mother (but not necessarily from a competitor in business), or help from a friend (but not necessarily a stranger in the street), ….[51]

In this account of trust, therefore, there exists this three-part relation or dynamic, as set out above: 'A trust B to do X.' This is the dynamic that needs to be explored, as it is trust in this context that motivates the certifying function.

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[48] Sztompka (n 41) 25–33.

[49]ibid 55 (citations omitted, emphasis added).

[50] ibid 56.

[51] ibid 55.

6.3.1 A relational view of trust

To explore how trust is situated within the context of certification marks, and the motivation behind the certifying function, it is necessary to set out the trusting dynamic. Who or what is trusting whom and for what purpose? For this discussion, I draw on Russell Hardin's concept of relational trust is particularly helpful.[52]

Hardin's account holds that trust in relationships can be best understood in terms of 'encapsulated interest':

> On this account, I trust you because I think it is in your interest to take my interests in the relevant matter seriously in the following sense: You value the continuation of our relationship, and you therefore have your own interests in taking my interests into account. That is, you encapsulate my interests with your own interests.[53]

An instance of encapsulated interest does not necessarily come to fruition because two actors have mutual interests. This account of trust requires something more. Moreover, there are some instances where 'institutional devices that arrange for merely stable expectations have, of necessity, been substituted for relations of trust in our complex modern times.'[54]

Rather there must be a mechanism by which the trust is embedded in what can be an ongoing relationship, such that 'You can more confidently trust me if you know that my own interest will induce me to live up to your expectations.'[55] Thus, while institutional

[52] There are different dimensions of trust, the one I think most fitting this discussion is the concept of trust as relationships, but the others are: ibid 13. I rely almost exclusively on this account of trust.

[53] Hardin (n 47) 1.

[54] ibid 5.

[55] ibid.

devices surrounding regulations and consumer protection laws may help consumers have 'stable expectations'—such as a product label cannot outright lie or be incorrect—several of consumer's expectations of products still rely on trust. So, to use Sztompka's concept of the three-part trusting relation, if the consumer is 'A' what is the target of their trust, who or what is 'B'? And what is the substance of their trust, what are the specific expectations that embody 'X'?

6.3.1.a Target of trust: the trusting relationship

I suggest that in the case of certification marks, and all attestation markets, the target of trust is the brand evoked by the signifier and embodied in the signified of the mark, and the brand in its entirety as it exists beyond the triadic structure of the mark. That is, the target of the trust is the brand as a social object, as set out in Chapter 4. This position is not intended to undermine or disparage the depth of meaning and value that an individual trademark has, particularly with respect to the reputation or goodwill embodied in the signified of each individual mark. As previously discussed, the goodwill and reputation of any given trademark, housed by the mark's signified, also forms part of the embodied brand. Brands are the social objects which act as information platforms and mediate relationships.[56] Thus, while a consumer may *rely* on a given trademark, the consumer *trusts* the brand.

To hold that an individual certification mark or attestation mark is the target of this richer notion of trust is too narrow. As explained by Andrew Griffiths:

[56] See discussion in Chapter 4, subsection 4.5.3.

> In effect, a brand invites consumers to place their trust in it as a substitute for the information they lack and its power to attract specific demand reflects the willingness of consumers to place their trust in it.[57]

This vision of brands fits quite well within the understanding of trust as set out in the encapsulated interest account.[58] Brand owners are not required to ensure consistency of quality or characteristic of their products, even those traits which a brand has worked, or come, to be defined by.[59] The same is true of brands relating to attestation marks.[60] This source of flexibility for brands can be beneficial, both to the brands themselves and to their consumers; 'It gives brand owners the scope to develop and improve their products and to engage in other forms of innovation.'[61] Nevertheless, consumers have certain interests with respect to the products they buy and their engagement with certain brands, and expect brands are concerned with fulfilling these expectations and interests. For instance, Cathy is familiar with PATAGONIA, an outdoor clothing and gear company, as a brand known for its ethical and sustainable approach to its work as well as making high-quality and well-designed clothing and gear. As PATAGONIA works to brands itself as an ethical and sustainable brand, Cathy may begin to trust this is as a motivating value of the brand they will work to maintain.

The lack of certainty that consumers have in the face of certification marks, given that they do not serve the role of a legal guarantee, is precisely the condition that creates

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[57] Andrew Griffiths, 'Brands and Corporate Power' (2018) 18 Journal of Corporate Law Studies 75, 81–2 (emphasis added).

[58] It bears noting that trust within this account can be unilateral. It is sufficient that consumers seek to trust brands; brands need not in return trust consumers. See: Hardin (n 47) 14–7.

[59] Griffiths (n 57) 81–2.

[60] The only exception for pure certification marks is to submit changes to the underlying regulations to the registrar for approval, see: TMA 1994, sch 2, para 11.

[61] Griffiths (n 57) 84.

the potential for trust. Trademark law is driven on the assumption that a mark owner is sufficiently incentivised to maintain the quality of their product, or to develop the quality in accordance with consumers' desires and values. This is also the premise of the encapsulated interest account of trust. A certifier that markets itself on ensuring a given quality, for example, likely has an encapsulated interest in a customer continuing to find that quality exists in their certified product. This account also aligns with how many consumers today view certain brands; brands are no longer solely commercial sources of products they purchase and use. Brands today are social objects that consumers engage with, and relate to, in several ways.

Survey research has concluded that consumers *trust* brands for a range of expectations far beyond the qualities of their products. For example, in the wake of the Coronavirus pandemic, 50% of consumers surveyed stated that brands must partner with government and relief agencies to address the crisis to earn or keep their trust.[62] Similarly, 41% of consumers said for brands to earn or keep their trust that brands must be a 'safety net, stepping in where they are needed and able, to fill gaps in the government's response to the virus.'[63] These trusting expectations are not divorced from brands as commercial sources. In fact, consumers have stated that their ability to trust brands in a range of expectations directly impacts whether they will purchase from a brand. For instance in 2019, 81% of consumers surveyed stated that it was a 'deal breaker or deciding factor in

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[62] Edelman, 'Special Report: Brand Trust and the Coronavirus Pandemic' (2020) Edelman Trust Barometer 2020 10. Additionally, 40% of consumers said while they hoped brands would do this, there was no obligation for them to do so.

[63] ibid. Additionally, 45% of consumers said while they hoped brands would do this, there was no obligation for them to do so.

their brand buying decision' that they are able to 'trust the brand to do what is right.'[64] Likewise, in 2020, whether a consumer trusted a brand that makes a product was rated highly as an attribute that motivated both their purchasing behaviour and their loyalty.[65] What this underscores is that brands are not seen merely as commercial sources, but social objects to which consumers and stakeholders *relate* to by, among other things, trusting:

> It seems artificial to restrict the legal understanding of trade mark functions to commercial source and consistent quality, when brands like Apple® form the basis for consumer communities, inspire tribal loyalties and are framed in the language of relationships rather than transactions.[66]

This is congruent with my account of brands set out in Chapter 4. As previously discussed, consumers now relate to trademarks act as brand identifiers;[67] brands now play a pivotal role in our cultural landscape, and in consumers forming their identity and communities.[68]

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[64] Edelman, 'In Brands We Trust?' (2019) 2019 Edelman Trust Barometer Special Report.

[65] 53% of consumers said they focused the 'most' (but not exclusively) on whether they 'trust the company that owns the brand *or* brand that makes the product' in deciding whether to buy a new brand, and 49% of consumers said they focused on this the most when deciding whether to be a loyal customer, see: Edelman (n 62) (emphasis in original).

[66] Dev Gangjee, 'Property in Brands: The Commodification of Conversation' in Helena R Howe and Jonathan Griffiths (eds), *Concepts of property in intellectual property law* (Cambridge University Press 2013) citing Albert M Muñiz and Thomas C O'Guinn, 'Brand Community' (2001) 27 Journal of Consumer Research 412 (emphasis added).

[67] Bently and others (n 30) 848–9; Albert M Muñiz and Thomas C O'Guinn, 'Brand Community' (2001) 27 Journal of Consumer Research 412.

[68] JL Aaker, 'Dimension of Brand Personality' (1997) 34 Journal of Marketing Research 347, 347; Dan Ariely and Michael I Norton, 'Conceptual Consumption' (2009) 60 Annual Review of Psychology 475; Hope Jensen Schau, Albert M Muñiz and Eric J Arnould, 'How Brand Community Practices Create Value' (2009) 73 Journal of Marketing 30.

6.3.1.b Specific Expectations: Substance of trust

If consumers are the trusting party ('A'), and the object of their trust is the brand of the attestation source ('B'), then what is the specific expectation of trust ('X')?[69] As explained above, specific expectations of trust, that is trusting expectations, 'fit' with specific objects.[70] Therefore, we must ask what trust expectations are reasonable for consumers to have of a brand that makes claims regarding the certification of a product.

For certification marks, and attestation marks generally, it may seem at first blush that the substance of any trust is both a demarcated expectation and universal, in that it would hold true for all consumers. This is because, under the conventional account, certification marks are intended to signal the same objective truthful information to all consumers. Accordingly, it appears a reasonable assumption that the only trusting expectation a consumer will have of a certification mark's embodied brand is that the characteristic the mark is signalling is present in the associated product. When we consider this assumption more critically, however, we can see the nature of trusting expectations is more complex.

First, as discussed in Chapter 2, for all types of marks, from bare to robust, consumers may not know or understand the characteristic being certified, nor the standard being implemented. It is difficult to discern how a consumer would then have a trusting expectation about this without truly understanding the standard being certified. While some consumers may have this knowledge, it is also likely that consumers see an attestation mark

[69] I explained the concept of attestation source in Chapter 2. Attestation source is akin to the concept of source for ordinary trademarks, in that it allows consumers to identify that the same anonymous or unknown body stands behind an attestation mark.

[70] Sztompka (n 41) 55.

and have some sort of general assumptions or 'fuzzy' expectations about what the mark is signalling.[71] While this lack of knowledge may be problematic for an account of certification marks driven on truth, it is not a problem for relational trust—trusting expectations need not be nearly as precise. A consumer can merely trust a certifier is 'trying to help the environment' or 'interested in fair employment' without knowing the exact nature of the standard the mark purports to promulgate.

Second, even with a consistent underlying signal, consumers may view the underlying information differently from one another and therefore trust different things. Consider again Calvin and Cathy in the shoe shop. When Cathy sees a FAIRTRADE mark she may think, for example, the factory workers who assemble the shoes are being treated well and paid a living wage. Calvin, on the other hand, may see the same mark and think the shoes were made to a holistically created standard, blending social, economic, and environmental criteria. This divergence in understanding can exist even when the mark has a common understanding, such as a kosher mark that indicates a food product has been prepared in accordance with Jewish law. One consumer may see a kosher certification mark and trust that the mark is in accordance with their religious beliefs. Another consumer may view the same mark and not trust it to be sufficiently adherent to their religious faith. A third consumer may be agnostic as to whether the food is certified kosher but instead trusts the mark to indicate that a food product is 'healthy.'[72] Likewise, a consumer may trust a vegan certification mark to indicate that a product is kosher.

[71] Dev Gangjee, 'Book Review: Jeffrey Belson, Certification and Collective Marks: Law and Practice, 2nd Edn (Edward Elgar 2017) 320 Pp.' (2018) 8 Queen Mary Law Journal 4.

[72] MINTEL, '3 in 5 Kosher Food Buyers Purchase for Food Quality, Not Religion' (*MINTEL Press Office*, 17 February 2009) <https://www.mintel.com/press-centre/food-and-drink/3-in-5-kosher-food-buyers-purchase-for-food-quality-not-religion> accessed 9 December 2019.

Third, expectations of certifying brands are not as universal as we may expect. When it comes to general market practices, consumers trust (or distrust) different sources for different things, and the same can be said regarding the brands embodied in certification marks. For instance, in the trademark context, we may trust STARBUCKS to make strongly caffeinated coffee, but not to be a fair employer. Or we may trust that APPLE makes trendy computers, and not trust the longevity of their products.[73] Trust can be equally multifaceted for certifying brands.

A consumer may have expectations (and correspondingly trust or distrust) with respect to a range of qualities pertaining to a certification standard. Not only is the authenticity of the standard an expectation—for example, that an ecojustice label is actually environmentally preferable—but there may be numerous expectations into the making of the underlying standard. Consumers may expect, for example, that: (i) the certification standard is regularly updated and improved, (ii) the standard is developed in consultation with specific stakeholder groups, or (iii) the standard is in accordance with broad industry-specific norms. Perhaps slightly removed from the nature of the certification standard itself, consumers may have expectations for the behaviours of the embodied brand or associated certifying body, such as: (i) they do advocacy work or are involved in policy discussions; (ii) that they treat their own employees and volunteers fairly; (iii) that they will not partner with other organisations or bodies that act in ways that are antithetical to their own cause; (iv) that they share in a certain set of politics or have a certain set of values. Thus, while

[73] As APPLE has been accused of orchestrating programmed obsolescence of their products: John Naughton, ‘Want to Save the Earth? Then Don’t Buy That Shiny New IPhone’ *The Guardian* (18 September 2021) <https://www.theguardian.com/commentisfree/2021/sep/18/want-to-save-the-earth-then-dont-buy-that-shiny-new-iphone>.

the meaning of the mark may not be as inherently individuated as trademarks, there is certainly space for individuated meaning and specific expectations of trust, ie trusting expectations, for certification marks.

Trusting expectations can be shared, or differ, from consumer to consumer, and the same consumer can hold a bundle of trusting expectations. This account does not negate the possibility that most consumers have a shared trusting expectation for a given certification body, but it does not require nor rely on it. Known or robust certification marks may command a more consistent trusting expectation across a range of consumers. Consumers can expect that labels and certification marks cannot be patently deceptive. Nevertheless, consumers can trust the brand embodied in the certification mark for a range of expectations particular to each consumer's own interests and desires. The 'X' in the trusting dynamic is therefore rationally bounded in some respects but is a flexible and individualised component of trust.

6.3.1.c Commitment

Beyond the trusting dynamic, for trust to be embodied in a particular action, there needs to be a commitment through action. Trust 'involves a commitment through action, or—metaphorically speaking—placing a bet.'[74] That is, the notion of trust requires that our trusting expectation has a bearing on our decisions or actions. In the case of certification marks, our trusting expectations results in us buying or using a given product, or not.

[74] Sztompka (n 41) 26.

6.4 The misguided search for more truthful certification marks

Consumer trust in certification marks, as currently regulated, still has its limits. As Margaret Chon explains, 'Currently, consumer trust in certified goods and services can only operate at the caveat emptor level, because so much of the standard-setting and certification process is beyond public oversight.'[75] That is, the average consumer in the market that cannot discern the quality being certified through viewing the certification mark (which may be bare certification marks), nor through experiencing the product (given that most certified qualities are credence attributes). Consumers' interactions with certification marks are almost necessarily premised on trust rather than the provision of truthful information:

> The quality guaranteed by a certifying firm may or may not be reflected in a mark per se; many sustainability standards are used in addition to a mark as part of a marketing strategy.[109] For a product and process method (PPM) standard, the quality of a process is typically not something that the consumer can verify directly. The consumer simply must trust the certifier. A consumer is not going to be able to tell whether a firm claiming that its products are not tested on animals has in fact tested its mascara on bunnies.[76]

Consumers trusting certifiers is therefore marked by a certain level of risk; this risk is inherent in the act of trusting. While that may be so, it is easy enough to understand why one may want to minimise this risk and look for ways to provide this information.

There is a body of scholarship and activism which examines ways in which marks can be more credible and we can safeguard against marks and standards which are

[75] Chon (n 42) 106.

[76] ibid 121 (emphasis added).

misleading.[77] Discussions around the need for more objective information, or to ensure the veracity of information,[78] distinguish between socially desirable, or *helpful* marks from those that are not. There have been numerous documented cases where signs and logos claiming to represent or signal a given quality are misleading or deceptive. In this space, the discussion relates to how trust is an insufficient tool in the face of corporate misdeeds. Among these ranks are generally what is referred to marks and logos that are associated with *greenwashing*.

The practice of 'CSR washing' is a term that refers to insincere claims of responsibility, generally by corporations.[79] The most publicised examples are that of greenwashing, which is when corporations make false or misleading claims about the environmental preferability of their productions.[80] There are, unfortunately, many different forms of this practice. 'Pinkwashing' for instance, began with companies using the colour pink to suggest or demonstrate solidarity with the search for curing breast cancer while also using chemicals, and engaged in other activities, that may further the instances of breast cancer.[81] 'Pinkwashing' is now also used to refer to the overuse or misstating of being aligned and supportive of the LGBTQ+ community and values.[82] Similarly, the term

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[77] See, for example: Graeme Auld, *Constructing Private Governance: The Rise and Evolution of Forest, Coffee, and Fisheries Certification* (Yale University Press 2014).

[78] Or, as discussed in Chapter 7, what Chon calls 'smart' information, see: Margaret Chon, 'Tracermarks: A Proposed Information Intervention' (2015) 53 Houston Law Review 101.

[79] Although this is not the purview of corporations alone, non-profit organisations and even nation states have been accused of 'washing, see for example: Stephan Dahl, 'The Rise of Pride Marketing and the Curse of "Pink Washing"' *The Conversation* (26 August 2014) <https://theconversation.com/the-rise-of-pride-marketing-and-the-curse-of-pink-washing-30925>.

[80] Van Der Ven (n 28).

[81] Mia Davis and Amy Lubitow, 'Pastel Injustice: The Corporate Use of Pinkwashing for Profit' (2011) 4 Environmental Justice.

[82] Jessica C Lai, 'Hijacking Consumer Trust Systems: Of Self-Declared Watchdogs and Certification Trade Marks' (2021) 52 International Review of Intellectual Property and Competition Law 34.

‘blue washing’ was coined by activists to describe companies participating in the UN Global Compact (a voluntary UN initiative to support corporate sustainability) to re-direct or distract from their own corporate transgressions (‘thus, draping themselves in UN-blue’).[83] In that greater social and marketplace problem, relying on trust mechanisms alone offers insufficient recourse; someone can always trust the teller of a falsehood. Or rather, we are all liable to be manipulated and mislead by a source we trusted—such is the nature of trust.[84]

In response to these problems, scholars often look to either more regulation and oversight as a solution, or the provision of more and better information.[85] Where risk is created by uncertainty, a straightforward way to minimise the uncertainty is the provision of *more* and *better* information. The idea being that with enough good information, the uncertainty could be rendered trivial, or even abolished altogether; given enough information less oversight and regulation is even required.[86]

This is the approach that some actors are taking. Provenance, for instance, is a company that seeks to provide methods of transparency regarding companies’ sustainability practices using software solutions.[87] Their mission statement is to ‘[t]urn

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[83] David M Biggie, ‘Bring on the Bluewash: A Social Constructivist Argument against Using Nike V. Kasky to Attack the UN Global Compact’ (2004) 14 6.

[84] Although some research has suggested instances of CSR-washing are not as high as one would expect, see: Shawn Pope and Arild Wæraas, ‘CSR-Washing Is Rare: A Conceptual Framework, Literature Review, and Critique’ (2016) 137 Journal of Business Ethics 173.

[85] Lucy Atkinson, ‘“Wild West” of Eco-Labels: Sustainability Claims Are Confusing Consumers’ *The Guardian* (2014); Lucy Atkinson and Sonny Rosenthal, ‘Signaling the Green Sell: The Influence of Eco-Label Source, Argument Specificity, and Product Involvement on Consumer Trust’ (2014) 43 Journal of Advertising 33.

[86] While this may be true, it only takes us so far before non-experts need information curated. See: Omri Ben-Shahar and Carl E Schneider, *More than You Wanted to Know: The Failure of Mandated Disclosure* (Princeton University Press 2014).

[87] ‘Provenance’ (*Provenance*, 6 July 2016) <https://www.provenance.org> accessed 6 July 2016.

positive social and environmental impact into brand value.'[88] This company, like others, offer producers the ability to digitise their verification process for consumers. A consumer does not need to merely trust a specific claim, such as a beauty product has been made cruelty free. Rather, Provenance provides the platform for the producer to have this claim verified by consumers. In many ways, this circumvents the need for certification marks as a mechanism for communicating the quality altogether. Thus, we can see why it is so attractive to focus on integrating and enhancing the aspect of certification marks that make them more truthful. This technology, and others like it, entirely bypass the need for standards to be expressed in a single mark. Consumers do not need a guarantee when they can have claims verified using blockchain technology with all the data spelled out.

Providing more information may ameliorate some of our social problems around corporate conduct and disclosing the uncertain nature of products in the market. These are some of the social problems certification marks also seem particularly well positioned to address, and it is in this context that certification marks often get swept into the conversation, and for good reason. Under the conventional account, the role of certification marks is to minimise uncertainty with respect to the same types of qualities that are frequently the subject of 'washing'. Given the idea that the provision of more information helps improve certainty, and that the role of certification marks is to improve certainty—it is easy to conflate the two. Certification marks seem part of the same enterprise.

Yet, despite the optimism, there is a limit to the role and efficacy of providing more objective truthful information within the certification mark context. While disclosing and

[88] ibid.

providing more information may be helpful in some situations and in some avenues, the certification mark regime is not the right vehicle for this type of solution to these problems. In fact, having too many means of protecting the same signal or underlying content could become unruly. For one, the intellectual property regime is simply not concerned with regulating and overseeing the *content* of the information signalled by marks, rather their form. As a result, certification marks exist that convey on their face no information about the underlying standard, that is, bare certification marks (as illustrated in Chapter 2).

The complications of regulating the nature of truthful information of certification marks through regulatory mechanisms internal to trademark law run deeper.[89] One approach to enhance the truthfulness of certification marks would be to regulate the underlying standards they seek to communicate; this approach is what Jeanne Fromer calls 'substantive regulation.'[90] Ensuring that the underlying standards being signalled are clearly defined and generally concretised would certainly enhance the truthfulness of certification marks, but the consequences of this would undermine other goals of the certification mark regime. As Fromer explains:

> [T]his approach would directly thwart flexible certification standards and the problems they enable but at the too-heavy price of the benefits that can also come from certification standard flexibility: agility and awareness to respond to changing or unexpected conditions out of responsiveness to

[89] Discussed further in Chapter 7.

[90] Jeanne C Fromer, 'The Unregulated Certification Mark(Et)' (2017) 69 Stanford Law Review 121, 174–80. Fromer considers this potential reform as a solution to the competition problems that arise from certifier's being able to maintain highly flexible, vague, and exclusionary standards.

> consumer welfare and competition, the precise goal of protecting certification marks in the first place.[91]

The ability of certifiers to keep their marks adaptative and open is part of what is identified in the private governance literature, a critical aspect of a certifier's credibility and efficacy.[92]

There would be further problems that arise if governments set or approved the standards that underlie every potential certification mark as a default position. Government bodies have set standards for various areas of certification—predominately around organic foods and environment sustainability standards. For instance, the UK government has regulated organic food labels,[93] and European Union has developed an ecolabel scheme.[94] Gaining consensus in these areas is a complicated and drawn-out task.[95] Requiring a central set of standards would prevent individual certifiers to create standards that reflect values key to their certification, and intended audience, and to compete with other bodies based on their certification. Moreover, governments are often not best positioned to make decisions regarding certain certification standards for both practical and political reasons.[96] It would be difficult, for instance, to imagine a government-created scheme to certify

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[91] ibid 174.

[92] Van Der Ven (n 28).

[93] UK Government, 'Guidance. Organic Food: Labelling Rules' (*GOV.UK*, 26 January 2022) <https://www.gov.uk/guidance/organic-food-labelling-rules> accessed 23 May 2022.

[94] European Commission, 'EU Ecolabel: Product Groups and Criteria' (*European Commission: Environment*) <https://ec.europa.eu/environment/ecolabel/products-groups-and-criteria.html> accessed 23 May 2022.

[95] Fromer discusses this in the context of the American organic certification scheme: Fromer (n 90) 175–7.

[96] Particularly for religious and other cultural standards, see: ibid 179.

businesses that pay their workers a living wage, when the living wage is far higher than a government-mandated minimum wage.[97]

Last, if the standards signalled by a mark were to become part of the mark itself, that is a ground on which a certification mark owner could claim exclusive rights to, this would be deeply problematic from a competition standpoint as it would effectively grant a monopoly in the underlying certification standard.[98] This is antithetical to the notion of private governance and allowing for several competing standards for the same characteristic within an industry.

Another, perhaps more viable, way to substantively regulate the standards underlying certification marks would be to have another governmental body review the standards before the mark is accepted by the Intellectual Property Office.[99] This is the practice followed in Australia where the Australian Competition and Consumer Commission is statutorily required to review and approve proposed certification marks before they can be registered.[100] This approach to increasing the truthfulness of certification marks is not unknown or unrealistic for other jurisdictions. For instance, this approach existed historically in the UK.

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[97] See for instance the Living Wage Foundation, which accredits businesses that meet their standards and licenses the use of their logo: Living Wage Foundation, 'What Is the Real Living Wage?' (*Living Wage Foundation: For the Real Cost of Living*) <https://www.livingwage.org.uk/what-real-living-wage> accessed 23 December 2021.

[98] Discussed further in Chapter 7.

[99] For brief discussion on this see: Chon (n 42) 138; Fromer (n 90) 180.

[100] Under Australia's trademark legislation, certification marks are called certification trade marks: Australian Competition & Consumer Commission, 'Certification Trade Marks' (*Australian Competition & Consumer Commission*) <https://www.accc.gov.au/business/exemptions/certification-trade-marks> accessed 13 November 2021.

The truthfulness of certification marks has become diluted over time. In previous iterations of UK's trademark legislation, the Consumer Affairs Division was involved in the overseeing of certification marks, for example. Under the 1994 Act, however, this is no longer the case.[101] There are no prescriptive for what a sign that constitutes a trademark must include. Another example of this is the requirement that the mark owner be competent to certify, as required by para 7(b), sch 2 of the TMA 1994. In the UK Intellectual Property Office handbook, little guidance is offered to discern whether applicants (besides trade bodies) are competent to certify.[102] This is in stark contrast to previous regulatory schemes that involved a consumer protection body to determine this issue,[103] and appears consistent with an overarching trend: 'In most jurisdictions, the state has gradually withdrawn from any meaningful oversight in relation to the certification criteria or the applicant's competence to certify.'[104]

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[101] Norma Dawson, *Certification Trade Marks: Law and Practice* (Intellectual Property Publishing Limited 1988).

[102] 'An additional requirement is that the applicant must be competent to certify the goods and services for which the mark is to be registered. If the Registrar is not satisfied on this point then the mark shall not be registered (Para 7 (1)(b) of Schedule 2 of the Act). If the applicant is an established trade body or Government Department then it is unlikely that the Registrar will raise any questions relating to their competency. Save for the aforementioned circumstances, the applicant will, as part of the examination process, be asked to provide information to clarify why they are competent to certify. There is no set manner of providing this information, but an explanation of the applicant's history in the particular field will often suffice.' Intellectual Property Office (UK), 'Manual of Trade Marks Practice: Certification and Collective Marks' (2019) Document 11 <https://www.gov.uk/guidance/trade-marks-manual/certification-and-collective-marks> accessed 27 October 2015. The American trademark examining handbook that appears silent on the need to demonstrated subject matter credibility to be able to certify for a particular standard: United Stated Patent and Trademark Office (USPTO) (n 23).

[103] Dawson (n 101) 107.

[104] Gangjee, 'Book Review: Jeffrey Belson, Certification and Collective Marks: Law and Practice, 2nd Edn (Edward Elgar 2017) 320 Pp.' (n 71). Gangjee goes on to say 'Applicants seem to be largely left to their own devices with revocation – where a mark becomes deceptive because it no longer effectively certifies – being the only nuclear option, which in turn requires a sufficiently motivated challenger to commence proceedings before the trade mark registry. With practicality in mind, one can understand why this is the case. A trade mark registry lacks the expertise to assess the "worthiness" of such applications. Trade mark examiners are not equipped to assess whether a

Another similar example is the degree of responsibility mark owners have for the quality of products bearing their certification. While historically this may have been required, that is no longer the case. As Belson explains:

> The impracticality of personal certification of 100 per cent of an authorized user's production was recognized early in the statutory and case law development of certification mark. Section 62 of the UK Trade Marks Act of 1919 altered the requirement for a proprietor to undertake to examine goods and to certify the result of such examination to an undertaking to certify, with the requirement that the Board of Trade should be satisfied that the certifying association or person was competent to certify.[105]

The mechanisms that exist today are far less burdensome and onerous than we might expect. The level of responsibility and control levied onto certification mark owners by various regimes of interest is not entirely different from the responsibility most trademark owners assume:

> Continuous real-time quality control of the merchandise of the manufacturer who affixes the mark is not the aim or the responsibility of the proprietor. His function is to control use of the mark and to ensure that his authorization to affix the mark is not abused by use on non-compliant goods.[106]

Thus, even this more attenuated substantive regulatory approach is an artefact of historical approaches of certification marks. The direction of certification mark regulation has been to move away from this more substantive form of regulation and to treat certification marks more akin to ordinary trademarks. To try to increase the substantive regulation of

certification specification incorporates appropriate quality benchmarks for the wool or cotton being certified.'

[105] Belson (n 7) para 3.71.

[106] ibid 3.70.

certification marks in this way would be to return to a previous approach and would be inconsistent with the direction of trademark law's development.

Furthermore, the development of a brand provides a fertile ground for trust to develop. There is research to suggest investing in a brand is more effective in promoting the uptake of a standard, such as organic:

> The intricacies of the process by which consumers make judgements about differentiated products create a challenge for the promotion of organic consumption. Public policy is often based on the assumption that more information is better, but sometimes officially provided information is not useful. By revealing a lower marginal impact of organic labels on high-equity brands, we suggest that strong manufacturer brands, such as market leaders, innovators, and trendsetters, might be less interested in undertaking a labelling process, especially when labels mean external constraints without clear advantages. These brands must trade-off between investments in quality signalling that might enhance brand equity directly (e.g., advertising, promotions) or in labelling. Furthermore, whereas investing in brand equity helps differentiate the firm from competitors, labelling tends to homogenize perceptions.'[107]

Apart from the problems of enhancing the truthfulness of certification marks through substantive regulations, attempting to enhance the truthfulness in other more procedural ways incurs other issues. That is, across the jurisdictions of interest here, the mechanisms of current certification mark regulation that make them more truthful than ordinary trademarks are also in tension with what many mark owners consider a key value of their trademarks, the ability to control and develop brand value.

As discussed in Chapter 5, the ability to use ordinary trademarks as an attestation mark is an existing practice. While there is no empirical research regarding why this trend

[107] Fabrice Larceneux, Florence Benoit-Moreau and Valérie Renaudin, 'Why Might Organic Labels Fail to Influence Consumer Choices? Marginal Labelling and Brand Equity Effects' (2012) 35 Journal of Consumer Policy 85, 99 (emphasis added, citation omitted).

exists, anecdotal evidence suggests it is at least in part due to a mark owner's desire to create and control brand value. As seen in the case of *Omega Flex Ltd v British Standards Institution*, the owners of one of the most notable certification marks in the UK opted to let their registration lapse and instead register their mark as an ordinary trademark.[108] The British Standards Institution (BSI) led evidence stating the decision to register their Kitemark as an ordinary trademark was 'driven by legitimate commercial objectives' which included, among other things, 'aligning the branding of the Kitemark to realise the full value of its goodwill.'[109]

Increasing the regulatory burdens on certification mark owners further may also act as a disincentive to potential mark owners, particularly when an alternative is available. For instance, another way to increase the truthfulness of certification marks would be to require the mark to stand for a legally binding guarantee. This solution may be beneficial for customers and users of the mark but would likely act as too significant a burden for certifiers to register their marks as certification marks when an alternative is available. As Belson asserts:

> Unless the certifier contracts freely to stand surety and there is a contractually agreed examination of the goods, it does not seem equitable to make the certifier's position that of a legally bound guarantor. Furthermore, imposing a legally binding guarantor function on the certifier

[108] *Omega Flex Ltd v British Standards Institution*, BL O/765/18, [2019] RPC 10 [20] (Intellectual Property Office). I discuss this case further in Chapter 7.

[109] *Omega Flex Ltd v British Standards Institution*, BL O/765/18, [2019] RPC 10 [23] (Intellectual Property Office).

> would be a major disincentive to operators of certification mark schemes with little gain in economic utility.[110]

Adding more procedural mechanisms only adds to these regulatory burdens, which again, appear to (at least anecdotally) act as a disincentive to registering and maintaining certification marks.[111]

The ability to enhance the truthfulness of attestation marks within trademark law is a fraught task. Providing more truthful objective information within the certification mark regime problematic. Moreover, focusing on the increasing provision of truth within the certification mark context does not sufficiently consider the role that this richer, relational type of trust plays in allowing the certifying function to function. To focus on truth in this context, would mean the *modus operandi* of certification marks is the provision of the quality and not the *guarantee*. If certification marks were all about truth, they wouldn't be certification marks—they would be labels. It is, therefore, *trust* that drives the certifying function.

6.5 Conclusion

While both truth and trust are features of how certification marks function today, there is a fundamental difference between a certification mark that reduces uncertainty with respect to a quality by communicating a *guarantee* of that quality, versus reducing uncertainty by communicating *the quality* itself.[112] These actions—to certify, to guarantee, to attest—

[110] Belson (n 7) para 5.09.

[111] In *Omega Flex Ltd*, BSI also lead evidence that part of the impetus for allowing their certification mark to lapse in favour of registering an ordinary trademark was 'a number of commercial restrictions placed upon the proprietor due to the fact that the Kitemark was protected by certification mark registrations which impacted upon the business in ways that did not apply to an ordinary mark.' [13]

[112] As discussed further in Chapter 7, if the goal of certification marks, to reduce uncertainty with respect to a quality by *solely and exclusively* communicating the quality, then a given mark would become

require the information given be modified in nature by the source of that information; the modification is the truth of the content. By signalling which products in a market are certified to meet a specific standard, every certification mark is a proxy for two things: the characteristic/standard being certified, and the body doing the certifying, the attestor. Trust is inherently involved in this enterprise.

Thus, attempting to enhance the truthfulness aspects of certification marks is fraught and it would undermine the greater value of certification marks—its ability, *qua* mark, to command a relational sense of trust. Ultimately the role of truth will always be limited by the fact that where consumers cannot assess the truthfulness of a claim themselves, the role of trust is 'central.'[113] The corollary of recognising this distinction is what motivates the next chapter, how do we reform certification mark law in recognition of this core, and critical, aspect of the certifying function.

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synonymous with the quality in question, rather than a proxy of information that signals that quality. The difference is relevant with respect to a fair and competitive market. If a certification mark was only meant to signal a specific quality, and was the exclusive indicator of that quality, then there could be no market for certification marks.

[113] Chon (n 42) 109.

VII. Re-Situating the Certifying Function

7.1 Introduction

The institution of certification marks is, in many respects, stale.[1] As discussed in Chapter 3, there are several issues with certification marks as marketplace signs and as a legal institution. Certification marks are not always being used as expected. Little, if any, attention has been paid to the intersection between certification marks (as apart from ordinary trademarks) and brands. Accordingly, there are several ways in which the use of certification marks, and attestation marks more generally, demonstrate a departure from the expected legal norms of this area of trademark law.

The struggle the institution of certification marks faces can be distilled to a core misconception of how certification marks operate and a tension between the public interest role they are deemed to serve, and their legal form as objects of private property. Simply put, certification marks need modernising. Mark owners—even of well-recognised and seemingly successful certification marks—are opting to register their marks as ordinary trademarks instead of certification marks.[2] Likewise, limited research in this area, along with illustrative examples I provided in Chapter 5, suggests that organisations and standard setting bodies that we would expect to make use of certification marks are opting for ordinary trademarks, even in jurisdictions where certification marks are available.[3] It is

[1] Notwithstanding the relatively recent introduction of the European Union certification mark.

[2] For example, USB: Interview with Jeff Ravencraft and Traci Donnell, 'Interview with Representatives of USB Implementers Forum' (3 March 2022).

[3] C Bradford Biddle and others, 'Standards Setting Organizations and Trademark Registration: An Empirical Analysis' [2019] (Working Draft: Available on SSRN) 1.

unclear whether this is driven by mark owners' inability to acquire a certification mark, or as I have hypothesised in earlier chapters, due to growing relevance of brands in both our markets, and in trademark law, and the ability of ordinary trademarks to nurture and accommodate brands.

In this chapter, I argue that ways of reforming or improving certification marks to make them more robust, or improve their truth capacity, is an inherently limited and an ultimately doomed approach to reform certification marks. Such proposals may seek to improve the certifying function in one sense: to make it more truthful. While these proposals may be successful at achieving that end, I argue these proposals are ultimately undesirable. The key to certification marks, and the certifying function, is *trust*. Therefore, any attempt to reform certification marks in a way that does not enhance trust would be insufficient.

Building on my arguments in the previous chapter, that the certifying function is bet understood as serving as a vehicle of trust, I make a more radical proposal—to abolish certification marks. In forming a trusting expectation, a crucial consideration is the trustworthiness of the object of trust. For example, can the Forest Stewardship Council be trusted to enforce standards in the paper industry that are environmentally preferable? Determining trustworthiness is therefore central, and while one draws on numerous sources to assess trustworthiness, as discussed further in this chapter, experience with the object of trust is a chief way to do so. Allowing brands to develop better more fulsomely allows for a better determination of trustworthiness and supports consumers in making a more informed decision regarding whether to trust the brand evoked by, and embodied in, an attestation mark. Put another way, the more consumers are able to interact with and *relate* to brands, as a social objects, the greater the ability of trademark law to nurture the reliance on attestation marks.

Accordingly, to enhance the ability of consumers to build relationships, and allow trust to be positioned as the cornerstone of the certifying function, we ought to reform certification marks to better accommodate, and even nourish, brands. That is, design a legal architecture that allows and supports marks which perform a certifying function to also be used in the development of hearty brands. As brands are sustained by trademarks, rather than reform certification marks to better accommodate brands, we should allow trademarks to function as the sole form of attestation mark at the exclusion of certification marks. This proposal is driven, in part by the recognition that the aspects of certification mark regulation that sets them apart from ordinary trademarks actively inhibit brand control, and in turn brand development. While it is helpful to have more robust and more truthful information available for consumers in the market, I argue that certification marks, as a form of trademarks, are ultimately not an appropriate or desirable avenue to achieve that end. Ordinary trademarks are positioned to be the only form of attestation marks and can absorb the certifying function.

Thus, I suggest we abandon the certification mark law regime, as allowing it to remain concurrently with trademarks performing an attestation function would be redundant, add confusion, and ultimately certification marks are not appropriate objects of private property rights. Ordinary trademarks are sufficiently equipped to continue to perform as attestation marks, and trademark law has already developed such that it can absorb this function. Reforming certification marks to allow for this enhanced brand development would result in an even barer form of certification mark than exists today.

I conclude by discussing how any disruptions caused by my proposal can be accommodated within existing trademark law doctrine and other doctrinal areas of law. This chapter proceeds as follows. In section 7.2, I briefly set out some existing proposals to reform certification marks in ways that enhances their truthfulness and argue that these proposals are in tension with other goals of trademark law. In section 7.3, I set out why trademarks, as marketplace signs, can perform a certifying function, and how trademark law can be developed to protect a certifying function. I further explain why my proposal opts for abolishing certification marks rather than reforming them. In section 7.4, I turn to consider the normative case for centring trust, as drivers for the certifying function, over truth. Last, in section 7.5 I consider the impact of my proposal. Referring back to the problems with certification marks highlighted in Chapter 3, I address which of these problems my proposal addresses, and which it does not. I also consider the potential for use and abuse of ordinary trademarks as the sole form of attestation marks, focusing on competition and consumer deception concerns.

7.2 Proposals to reform and 'purify' the certifying function

In this section, I consider the few proposals put forward by other scholars which look to purify certification marks by enhancing their ability to signal more truthful information. They do this by targeting different aspects of the triadic structure of certification marks, the signifier and the signified, rather than by attempting to substantively regulate the underlying standards.[4]

[4] Barton Beebe, 'The Semiotic Analysis of Trademark Law' (2004) 51 UCLA Law Review 621, 645–6. Neither target the third part of the triadic structure, the referent.

Given my focus in this section on proposals that address the nature of certification marks' signalling capacity, I have not addressed reform proposals which go more to the substantive and procedural aspects of certification marks, such as Jeanne Fromer's proposals to reform certification marks from a competition standpoint or Jessica Lai's proposal to not allow trademarks to perform a certifying function.[5] Fromer's proposal for procedural reform targets aspects of the certification process that underlie certification marks:

> [T]he law ought to require private certifiers to install some combination of procedural protections to minimize the possibility that certifiers can subvert the goals of certification marks and act counterproductively to exclude businesses from certification. These procedural possibilities include certifier disclosure of its detailed certification test; an opportunity for interested parties to have notice and comment on certification standards being set or revised; certifier disclosure of certification decisions and reasoning; procedural protections for businesses in certification decision making, such as robust appeal processes for certification denials; and random audits by the government of certification decisions.[6]

As I discuss further in section 7.5 of this chapter, Fromer's proposal for reform need not be housed within trademark law to be adopted, and I argue that it more appropriately belongs outside of trademark law. Jessica Lai proposes all registered certification marks should have to bear some symbol or design to identify themselves as such, such as "Cert. TM" as a response to what she identifies as a problem in Australia and New Zealand of ordinary trademarks being used as attestation marks. For Lai, this proposal is not intended to strengthen the truth aspect of certification marks per se, but to identify it apart from pseudo-certification marks. This proposal arises out of a concern that, in some instances,

[5] These proposals identify three potential sites of regulatory reform: substantive regulation, procedural regulation, and anti-trust scrutiny, see: Jeanne C Fromer, 'The Unregulated Certification Mark(Et)' (2017) 69 Stanford Law Review 121, 180–98.

[6] ibid 181.

the use of an ordinary trademark to perform a certifying function may mislead consumers to the nature of the mark.[7] In this sense, Lai's proposal is to distinguish certification marks from trademarks further by making certification marks less like ordinary trademarks and thus less bare. While I do not consider their proposals below, I recognise that these proposals highlight other issues with certification mark use and regulation as the system is currently constituted, and therefore raises issues that my proposal also must reckon with.[8]

7.2.1 Existing proposals to reform certification marks

I argue that while the reforms set out below would be successful at achieving their stated ends, enhancing the truthfulness of the certifying function without regulating the underlying standards, they are ultimately undesirable in that they fail to enhance the ability of the certifying function to develop and command trust. Furthermore, these suggested reforms would be in tension with other stated goals of trademark law as an institution which regulates distinctive signs as private property. In the subsections that follow, I set out three proposals for reform and then address their shortcomings collectively.

7.2.1.a Enhancing the signifier

One idea for reform is to require all certification marks to become robust certification marks. This would require certification marks to incorporate more information regarding their underlying standards and the characteristics being certified into the face of the mark

[7] She further argues that given this potential to mislead consumers as to the underlying nature of a pseudo-certification mark, all such applications for ordinary trademarks where the owner intends it to perform a certifying function should be deemed to have been made in bad faith, see: Jessica C Lai, 'Hijacking Consumer Trust Systems: Of Self-Declared Watchdogs and Certification Trade Marks' (2021) 52 International Review of Intellectual Property and Competition Law 34, 53–4.

[8] See discussion in section 7.5 below.

itself. This reform recommends certification marks become more transparent and less, what Jeffrey Belson calls, 'opaque'. This could be done by requiring the use of more descriptive words into a mark's signifier:

> One could perhaps use the term 'opaque' to characterize a certification mark that does not use words to identify basic features of the goods, their certified characteristics and the relevant standard. <u>If consumer confidence in the certification of goods is to be encouraged, then increased transparency of certification marks, through addition of descriptive words, should be encouraged.</u> Of course, product information may be obtained from inquiries to the manufacturer or vendor, together with the identity of the certifier, certified characteristics and standards. Such information may also be accessed from advertisements, the website of the certifier or manufacturer, and the like. This is frequently done before sophisticated technical products are purchased in the course of a business. Furthermore, a full description of the certified characteristics and the standard may be obtained from inspection of the certifier's regulations, which are open to public inspection in the same way as the register in the UK Trade Marks Registry. <u>However, such means are inappropriate or inconvenient for purchases of consumer products</u>.[9]

Requiring the addition of more descriptive words is somewhat in tension with a distinctive sign institution.

7.2.1.b Enhancing the signified

Other suggestions for reform involve requiring additional information about a mark outside the mark itself as a means to enhance the signified. These proposals view the signified of a mark as commodious enough to incorporate additional objective and truthful information

[9] Jeffrey Belson, *Certification and Collective Marks: Law and Practice* (2nd edn, Edward Elgar Publishing Limited 2017) s 5.28 (emphasis added).

about the mark.[10] This can be done in several ways, and not all discussions of such an approach have been limited to certification marks.[11]

One way is to require explanatory text to accompany certification marks on the referent or packaging itself:

> Consumer understanding of what a given certification or collective mark means needs to be improved if the inherent information asymmetry between producer and purchaser is to be reduced. It is submitted that a more directly consumer-oriented model of these types of marks would improve consumer understanding. Such a model might yet emerge as a result of guidance provided by the US Federal Trade Commission (FTC) that <u>seals or ecolabels used in advertising be accompanied by adjacent or co-located explanatory text specifying and delimiting the certified attributes</u>…. [12]

In this approach for reform, the text would not form part of the protected mark, but rather be mandated to be used alongside it. For instance, there would be a logo with explanatory text accompanying its use on the product or advertising.

7.2.1.c The signifier as a portico to an enhanced signified

Another approach relies on the use of technology to incorporate some referral mechanism, such as a barcode or QR code, inside the signifier of the mark to direct a consumer to

[10] This may be seen as congruent with Gangjee's observations about brand meaning, 'It is the signified that is commodious enough to incorporate the brand dimension.' See: Dev Gangjee, 'Property in Brands: The Commodification of Conversation' in Helena R Howe and Jonathan Griffiths (eds), *Concepts of property in intellectual property law* (Cambridge University Press 2013) 31.

[11] Margaret Chon, for example, raises this reform proposal for ordinary trademarks as well as certification marks, as she argues that goodwill can act as an information platform: 'the goodwill associated with trademarks and certification marks could better reflect the environmental impacts or sustainability (hereinafter sustainability standards or sustainability information) of products or services offered in global markets.' See: Margaret Chon, 'Trademark Goodwill and Green Global Value Networks' in Matthew Rimmer (ed), *Intellectual Property and Clean Energy: The Paris Agreement and Climate Justice* (Springer Singapore 2018) 276.

[12] Belson (n 9) s 5.03 (emphasis added).

information outside the triadic structure. This is the reform proposed by Margaret Chon's article, 'Tracermarks: A proposed information intervention.'[13]

The proposal for 'tracermarks', or incorporating QR codes into a mark's signifier, is premised on the goal of enhancing the truthfulness of certification marks by providing more transparency and information into the underlying standard. While this additional information is available by engaging with the signifier, ie scanning it, it takes a consumer to a source of information outside the mark to inform their understanding of the mark. This proposal makes use of what I call a hybrid approach. The impetus for Chon's proposal is the need for more 'smart' information in the market, that is, 'information that is traceable …[is] therefore reliable, trust-worthy and ultimately verifiable.'[14]

7.2.2 Shortcomings of proposals to purify the certifying function

All these proposals may help to improve the certifying function by asking marks to perform this function robustly. Therefore, they are successful on their own terms, as in they seek to—and successfully achieve—the goal of increasing the truthfulness of the certifying function. Nevertheless, there are limitations inherent in each proposal, as the ways in which the truthfulness of certification marks is enhanced is at odds with other goals of the trademark law.[15]

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[13] Margaret Chon, 'Tracermarks: A Proposed Information Intervention' (2015) 53 Houston Law Review 101.

[14] ibid 101. This lack of available information is odd given web-based platforms should make it easy to disseminate this information, see: Dev Gangjee, 'Book Review: Jeffrey Belson, Certification and Collective Marks: Law and Practice, 2nd Edn (Edward Elgar 2017) 320 Pp.' (2018) 8 Queen Mary Law Journal.

[15] Here, and throughout this chapter, I refer to trademark law as it exists generally across the jurisdiction of interest (like Canada, EU, UK, and US) unless otherwise noted.

For instance, reforms which seek to enhance the signifier by increasing the descriptiveness of the sign are in tension with the goal of trademark law to protect *distinctive* signs. Trademark law does not, as a default position, protect descriptive or generic signs. While there may be distinctive signs that incorporate descriptive elements, the more descriptive a sign becomes, arguably the more at risk it is for reduced protection. Similarly, trademark law does not make positive requirements of what a sign ought to be composed of to be registered. Quite the opposite: 'Indeed, one of the notable features of the current law is that there are very few a *priori* restrictions placed on what may be registered as a trade mark.'[16] To require substantive content in a sign to be eligible for registration is in tension with the current trademark law structure. Furthermore, requiring this would be an uneasy fit with another core tenet of trademark law law, that the openness of signs that may constitute a mark allows mark owners to consider the divergence in their consumer base, particularly with respect to language barriers or varying degrees of literacy.[17]

Other proposals to use the signifier as a portico to an enhanced signified by incorporating technology is a way around the problems created by requiring an increasingly descriptive sign. This would require assuming the average consumer has access to a certain level of smart technology. This may, as a descriptive fact, be true of today's average consumer. Nevertheless, accepting this vision of an average consumer risks perpetuating

[16] Lionel Bently and others, *Intellectual Property Law* (5th edn, Oxford University Press 2018) 956.

[17] ibid 957.

inequality within the market by ignoring consumers who cannot afford, or do not otherwise have access to, smart technology or constant reliable internet access.[18]

Moreover, proposals to incorporate access points to further technology as an essential element to the functioning of a mark, rather than a bonus feature, undermine the ability of marks to act as freestanding marketplace signs. This is not to say that incorporating such technological features would not be a welcome addition to consumers in the marketplace, but rather to rely on them as vital to the functioning of such marks shifts the focus of trademark law to the provision of information, rather than a proxy for such information.

Last, any element which seeks to enhance the truthfulness of a mark is only helpful to a point. No amount of information negates the requirement that consumers *trust* the source of the information. More information is not the solution to problems with certification marks. Acknowledging on the limited utility of more information is harmonious with the work of other scholars who have explored the issue of mandated disclosure as a regulatory solution to a wide range of problems that implicate the need for consent.[19] Omri Ben-Shahar and Carl E. Schneider argue that providing more information to decision makers, here consumers, is not the answer to regulatory problems. Mandated disclosure—or attempting to give enough information for a decision maker to make a truly

[18] Paola Serafino, 'Exploring the UK's Digital Divide' (Office for National Statistics (UK Government) 2019) Article; Joyce Winslow, 'America's Digital Divide' (*PEW Trust Magazine*, 26 July 2019) <https://www.pewtrusts.org/en/trust/archive/summer-2019/americas-digital-divide> accessed 1 June 2020.

[19] Omri Ben-Shahar and Carl E Schneider, *More than You Wanted to Know: The Failure of Mandated Disclosure* (Princeton University Press 2014).

informed decision—is unfeasible, impracticable, and undesirable.[20] Requiring disclosure may be a tempting solution to solve a wide range of problems, including marketplace information asymmetry for credence attributes and promulgated by what Ben-Shahar and Schneider call 'disclosurites'. That is, those who 'urge' for mandated disclosure, implicitly or explicitly, as a regulatory solution, because they erroneously assume the benefits outweigh the costs.[21]

Providing an abundance of *more* information does not help consumers make meaningful marketplace decisions. Rather, what we ought to be seeking is *trust* in the market. Not only do the above proposals fail to truly communicate more truthful information in a significant way, but these proposals fail to enhance what I argue is the crux of the certifying function – its ability to accommodate relational trust. Further, these proposals would have us *returning* certification marks to a more historical form of mark, towards a more consumer protection model. The architecture of trademark law is now, increasingly, built around brand functions, and to focus the goal of certification marks on the provision of objective truthful information is to try to fit certification marks back into a 19th century consumer protection model.[22] Thus, these proposed reforms are insufficient as none of them address what I consider the most critical problem of certification marks, which is that they do not position the signifier as performing a certifying function premised on commanding trust.

[20] ibid.

[21] ibid 6.

[22] This insight was developed in response to feedback I received by the participants of a research talk I gave at the Oxford Intellectual Property Research Centre's Intellectual Property Discussion Group Series on 30 November 2020 (online).

7.3 Abolishing certification marks; trademarks as the sole attestation mark

While we could look to reform the certification mark law to better accommodate brands, the aspects of certification mark law which make these marks more truthful are in tension with the ability of certification mark owners to develop their brands. Even still, to achieve a more brand friendly certification mark would be to reduce or eliminate the regulations that make them distinct from trademarks in the first place. Rather than reform certification marks to better accommodate brands, we should allow trademarks to carry on the role of attestation marks and abolish the legal institution of certification marks. Thus, under my proposal ordinary trademarks would be the only form of attestation marks.

While this approach is radical, it is not doctrinally out of step with the range of roles ordinary trademarks already perform. In this section, I consider this analysis in two distinct stages. First, I look to how trademarks, as marketplace signs, have already as an empirically observable matter absorbed the certifying function and can act like attestation marks. Then, I look to how trademark *law* has also already developed such that trademarks, as legal objects, can act like attestation marks. I also set out a suggestion for trademark statutes that could affirm the ability of trademarks to perform a certifying function more clearly and sustainably.

7.3.1 *Trademarks* can accommodate the certifying function

As a descriptive matter, trademarks have absorbed the certifying function. That is, trademarks are already operating in a way in the market such that they fulfil a certifying function. In this section, I explain how trademarks can, and have, already accommodated the certifying function.[23]

Today, ordinary trademarks are used to convey a range of commercial relationships such as sponsorship and affiliation.[24] Consumers are accustomed to seeing, for instance, trademarks belonging to social media platforms on their coffee cups and knowing this signals that the respective source of the coffee has a profile on these platforms, not that the platform is related to the source of the product. Similarly, consumers understand when brands logos are used to communicate sponsorship. Perhaps more importantly, ordinary trademarks are already used to convey adherence to standards or certification schemes, such as the British Standard Institution (BSI)'s Kitemark and several USB technical marks.[25] This is notable. BSI's Kitemark had long been regarded as one of the most well-known certification marks, having been in use since 1902 and registered as a certification mark since at least 1921.[26] Nevertheless, in 2012 BSI sought to register its mark as an ordinary trademark. While their registration was contested, and ultimately significantly narrowed, the Kitemark still operates as an ordinary trademark and has done so since 2018. As BSI still offers certification *services* and describes the Kitemark as a 'quality mark,' it is easy to see why an average consumer would not treat the mark any differently despite the change in how the mark is registered and, consequently, regulated.

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[23] Although I would like to acknowledge that the below discussion captures *norms* in trademark practice, and as such, these norms of practice can be thwarted or change.

[24] Stacey L Dogan and Mark A Lemley, 'The Merchandising Right: Fragile Theory or Fait Accompli?' (2005) 54 Emory Law Journal 461.

[25] See for example, USB's mark filed in the EU, filing number 008187304 as an individual trademark, and other of USB's marks listed in 'Appendix A'.

[26] *Omega Flex Ltd v British Standards Institution*, BL O/765/18, [2019] RPC 10 (Intellectual Property Office).

Consumers are already accustomed to observing and interacting with a range of attestation marks. Furthermore, the average consumer is almost certainly unable to distinguish between an attestation mark that is a pure certification mark and pseudo-certification mark.[27] In fact, from the consumer perspective, certification marks and ordinary trademarks performing an attestation role are virtually indistinguishable in that they provide information about the quality or characteristic of a product.[28]

Our marketplace has developed such that consumers can identify which marks on a product are signalling quality apart from source:

> Consumers' expectations naturally evolve as they become more familiar with new commercial contexts or relationships. And consumers do not develop their expectations in a vacuum. Instead consumers are bombarded with marketing information designed to shape their understanding of commercial relationships, and there is substantial evidence of its success.[29]

I demonstrated this in Chapter 5, when I set out a typology of attestation marks used in practice. In Chapter 5, I identified several marks that perform a certifying function, and act as attestation marks notwithstanding that they are registered and regulated as ordinary trademarks. This is because, as argued earlier, there are various forms that attestation marks exhibit that make consumers live to their use as an attestation mark. For instance, attestation marks tend to be smaller in size than other marks and logos on a package, they tend to be off to the side, they are frequently part of a closed circle or other shape, and they

[27] As discussed in Chapter 5.

[28] The only exception to this is likely specious certification marks, which may be misleading regarding the attestation source, but not as to whether the mark is serving an attestation role or source indicating role.

[29] Mark McKenna, 'Trademark Use and the Problem of Source' [2009] University of Illinois Law Review 773, 821–2.

often make use of the word ‘certified’ or ‘seal.’ The Fifth Board of Appeal of the European Union Intellectual Property Office also observed this and held:

> ….Certification marks are normally used together with individual marks on the product itself, its packaging or in advertising. The public is accustomed to the fact that certification marks often (but not necessarily) have the shape of a label, logo or seal that alludes to certified characteristics or contain certain terms such as “certified’. ‘tested’. ‘checked’, ‘checked’, [*sic*] accepted’, ‘approved’, etc., not seldom appear on the label or seal also the name of the proprietor, which certifies the characteristic.[30]

Ordinary trademarks are also used in ways which meet the above description and in service of performing the same role as certification marks—a certifying function. As a matter of descriptive fact, ordinary trademarks can perform a certifying function and be perceived as an attestation mark. It is also true, however, that these practices are a norm and are not legislatively required. I discuss the need for some soft legislative reform to enforce the interpretation of practices below.

7.3.2 Trademark *law* can accommodate the certifying function

Not only can ordinary trademarks perform a certifying function, the current legal structure of trademarks is also able to accommodate the use of ordinary trademarks as attestation marks. Take for instance, the case of attestation marks that signal environmental standards, ecolabels:

> Where a sign is used simultaneously as an ecolabel and a trademark, is there duality in essential function? The essential function of an ecolabel is to communicate preferable environmental qualities. However, basic trademark theory requires the essential function of a trademark to be designation of source. So how can one reconcile the essential function of an

[30] Case R 2112/2019-5 *Qualität Gemeinschaft Biomineralwasser e.V* [23] (Fifth Board of Appeal 2021, EU IPO) (emphasis added, citations omitted).

> ecolabel with that of a trademark? An answer may lie in the way the concept of *source* has evolved with changing patterns of commerce.[31]

As trademark rights shifted away from limiting the diversion of trade, in the 19th century, and the view that consumer confusion was an evil emerged through the 20th century, the nature of source took more prominence because that formed the root of consumer confusion.[32] It is this shift in trademark law that also led to the nature of individuated meaning that lies at the heart of trademark law.[33] There is, naturally, an issue of whether this nature of individuated meaning which is acceptable for ordinary trademarks is acceptable, or even tolerable, for attestation marks.

Certainly, one may expect there to be *less* individuated meaning for an attestation mark than for ordinary trademarks. In any institution premised on distinctive signs, some level of individuated meaning is unavoidable and simply a feature of the institution given that it is a system of nonliteral symbols for communication. As long as a consumer can recognise that an attestation mark is signalling an unspecified quality an attestation mark is working. Beyond that required recognition that an attestation mark signal a consistent attestation source, any individuated meaning of that quality is acceptable in my proposal. Even for attestation marks, where one may expect some convergence of meaning, individuated meaning is inevitable and acceptable. Of course, this convergence may either be with respect to the fact of certification, which requires a shared recognition of the attestation source (analogous to ordinary trademarks), or with respect to the characteristic

[31] Belson (n 9) s 7.42.

[32] Mark McKenna, 'The Normative Foundations of Trademark Law' (2007) 82 Notre Dame Law Review 1839.

[33] Graeme B Dinwoodie, 'The Death of Ontology: A Teleological Approach to Trademark Law' (1999) 84 Iowa Law Review 611.

and standard being certified. The latter cannot be guaranteed to be shared in a distinctive mark system, rather, as discussed in 7.5 below, our goal ought to be not that this meaning is necessarily shared, but that this meaning is not misleading or deceptive.

Furthermore, in this shift, Mark McKenna suggests that the nature of 'source' became less about marks serving the purpose of indicating producers of products or allowing consumers to 'match' products with a given producer, as the role of trademarks became more about protecting marks themselves as assets and vehicles of meaning. In his words:

> The real shift in modern trademark law then was not one from consumer focus to producer focus, or from consumer protection to property. Instead, modern trademark law differs fundamentally from its traditional counterpart in its understanding of what a trademark does and how it adds value. Courts traditionally saw a trademark as little more than a vehicle through which consumers could match products with their producers. Marks were important to producers because customers who were satisfied with a producer's products could use that producer's mark to find its products again in the market. But, on this view, the mark was only an instrumentality of the producer's business, which was the ultimate object of protection. Modern law, by contrast, sees a trademark as a repository for value and meaning, which may be deployed across a wide range of products and services. In other words, twenty-first century trademark law amounts to little more than industrial policy intended to increase brand value.[34]

Today, ordinary trademarks are used to convey a range of commercial relationships such as sponsorship and affiliation:

[34] McKenna, 'The Normative Foundations of Trademark Law' (n 32) 1843.

> 'Sponsorship' and 'affiliation' are broad enough concepts to encompass virtually any imaginable relationship between entities, and almost all of those imaginable relationships exist in the modern marketplace.[35]

The same can be said of trademarks acting as attestation marks. To actualise the certifying function, in the bare sense, a mark need only be identified as an attestation mark and to identify an attestation source. Ordinary trademarks can perform this certifying function. As I set out above, trademarks are, descriptively, capable of performing this function. Here I turn to instances where trademark law has been engaged in an ordinary trademark's performance of a certifying function.

For one, ordinary trademarks that are used as attestation marks have successfully entered the registry and several are maintained unopposed—as demonstrated in Chapter 5. While this is insufficient to demonstrate that trademark law *can* absorb the certifying function into the purview of ordinary trademarks alone, it suffices to show ordinary trademarks that perform this role do not inherently run afoul of absolute grounds for registration that exist across jurisdictions.[36]

Attestation marks, under my proposal, will function like ordinary trademarks pointing to a single commercial source – an attestation source. I use the term 'attestation source' here to refer to firms which engage in a range of permissible services under the trademark law regimes of the jurisdictions of interest here, that can be broadly and collectively referred to as attestation services. By these I mean services such as, for example, advisory services, business management assessment and advice, product

[35] McKenna, 'Trademark Use and the Problem of Source' (n 29) 823.

[36] Trademarks Act, s 12 (Canada); EC EUTM Regulation 2017/1001, art 4 (EU); TMA 1994, s 3 (UK); 15 USC §§1051, 1052, 1127 (US).

evaluation, quality audits, and certification services. Thus, an attestation mark registered as an ordinary trademark is not functioning by communicating a standard but rather identifying the attestation firm as a commercial source. This is already done in the jurisdictions of interest and are the precise kind of mark that constitute quasi-certification marks, as discussed in Chapter 2.

The mechanism by which an attestation firm allows the use of their mark is through a licensing regime. This licensing mechanism is akin to well accepted ubiquitous licensing practices in various jurisdictions, such as affiliation, merchandising, and sponsorship licensing. This would not constitute naked licensing in the traditional sense, as the use of an attestation mark would, and should be, governed by clear licensing rules, the most common of which will be that a mark cannot be licensed and used by a third-party unless their products or practices meet a particular set of standards.

Perhaps the more compelling indication that trademark law can comfortably house ordinary trademarks performing a certifying function, however, are instances where there has been opposition to this very practice. Unfortunately, this is an area where the case law remains quite slim, and I am only aware of a few cases across jurisdictions that directly confront this issue and are instructive for this analysis. Nevertheless, by examining these cases I can demonstrate how trademark law is pliable enough to incorporate this additional function.

The case of *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* (‘*Gözze*’) is unique in its direct confrontation of the issue core to my proposal for reform:

can an individual trademark serve as an attestation mark?[37] In the words of Advocate General Wathelet:

> In its answer to the national court, the Court will have to rule on whether a label of quality – namely a sign intended to guarantee the material used in the goods to which it is affixed, their quality or manufacturing process – is capable of constituting an individual EU trade mark.[38]

This case appeared before the Second Chambers of the CJEU by way of a request for a preliminary ruling from the Oberlandesgericht Düsseldorf (Higher Regional Court) in Germany. The facts in the main proceeding pertained to two parties, W.F. Gözze Frottierweberei GmbH (Gözze) and its manager Wolfgang Gözze (Mr Gözze) and the association Verein Bremer Baumwollbörse (VBB) which represents the interests of actors in the cotton textile sector.

VBB owned an EU figurative trademark (the 'cotton flower' mark), registered in 2008 (prior to the introduction of the EU certification mark), figure 27. VBB operated this mark under a licensing scheme in where allowed others to use their mark by undertakings in the cotton sector in agreement with the terms set out by VBB pertaining to the quality of cotton in the products bearing the mark:

> VBB concludes licence agreements in respect of the 'cotton flower' mark with undertakings from the textile sector. Those undertakings agree to use

[37] Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse*, EU:C:2017:434.

[38] Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse*, ECLI:EU:C:2016:916, Opinion of AG Wathelet [2].

the mark only for high quality goods made from cotton fibres. Compliance with this commitment may be checked by VBB.[39]

Gözze is a business operating in the textile sector which, among other things, sells towels that were sold with a ‘hangtag’ which, among other information about the product, indicated the towels were made of cotton and made use of a symbol that is identical to VBB’s cotton flower mark, figure 28.[40] Gözze was not a licensee of VBB and did not have permission to make use of their mark. VBB brought an infringement proceedings against Gözze in a German Regional Court, and Gözze counterclaimed a declaration of invalidating, or in the alternative, a revocation claim. Gözze claimed ‘that the figurative “cotton flower” sign is purely descriptive and thus not distinctive. Since the sign cannot be used as an indication of origin, it should not have been registered as a trademark.’[41]

figure 27 VBB’s cotton flower mark

figure 28 Gözze’s hangtag

[39] Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse*, ECLI:EU:C:2016:916, Opinion of AG Wathelet [19].

[40] Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse*, ECLI:EU:C:2016:916, Opinion of AG Wathelet [20]-[21].

[41] Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse*, ECLI:EU:C:2016:916, Opinion of AG Wathelet [22]. The German court of first instance upheld VBB’s action and dismissed the counter claim, and Gözze appealed. The Higher Regional Court, hearing the appeal, in determining the issues before it stayed the proceedings to refer questions to the Court for a preliminary ruling.

Advocat Generale Wathelet, in their opinion, noted the introduction of EU legislation that provided for the registration of EU Certification Marks, and the intention behind this to have certification marks (and collective marks) exist concurrently and parallel to ordinary trademarks. Nevertheless, AG Wathelet found that while certification marks were intended (by virtue of Regulation 2015/2424) to allow for the registration of a sign which guarantees the material of good or mode of manufacture as a certification mark, this does not mean such a sign can never be eligible for production as an ordinary trade mark.[42] Rather, such marks can be registered as ordinary trademarks and receive protection under EC CTM Regulation 207/2009 where such marks also fulfil the essential function of a trade mark. Accordingly, AG Wathelet stated:

> In other words, if the use of a sign, as a label of quality, is not only associated with an indication of the quality of the goods but also and simultaneously with an indication of origin, there is use of a sign as a trade mark for the purpose of the case-law of the Court.[43]

Accordingly, a trademark can act as a label of quality if the use of the sign simultaneously performs the essential function of a mark, that is, by signalling an attestation source, as discussed above.[44] The Second Chamber, adopting the Advocate General's opinion, held that the essential function is not realised if the mark is used *only* for the purposes of guaranteeing a standard of quality. The Court ultimately held in this case that:

[42] Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse*, ECLI:EU:C:2016:916, Opinion of AG Wathelet [40]-[41].

[43] Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse,* ECLI:EU:C:2016:916, Opinion of AG Wathelet [47].

[44] Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse*, ECLI:EU:C:2016:916, Opinion of AG Wathelet [56].

> It follows, as the Advocate General observed in points 47 and 56 of his opinion, that there is no use in accordance with the essential function of the individual mark where it is affixed on goods for the sole purpose of being a label of quality for those goods and not that of guaranteeing, in addition, that the goods come from a single undertaking under the control of which they are manufactured and which is responsible for their quality.[45]

The Court thus found in the instance of *Gözze*, that the use by VBB was not genuine use. It is worth noting, however, that VBB's mark had been registered for various classes of goods relating to textiles and not classes of services pertaining to quality or education.[46]

This decision would suggest that my proposal that an attestation mark (such as what would be described as a quasi-certification mark in Chapter 5) would *not* be capable of being registered as an ordinary trademark under EU law, as such marks do not signal that goods come from a single undertaking. Although this leaves open the possibility that in the right circumstances a specious certification mark or an in-house certification mark would be permissibly registered as an ordinary trademark. Nevertheless, I would suggest this case is not determinative of my proposal. Rather, I adopt an approach more aligned with what the reasoning in *Omega Flex Ltd v British Standards Institution* ('*Omega Flex Ltd'*) discussed below.[47] I would further suggest trademark statutes adopt language which clarifies this latter approach. Interestingly, the case of *Omega Flex Ltd*, deals with a similar issue in a different context with slightly different results, although this was only an

[45] Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse*, EU:C:2017:434 [46].

[46] In particular classes 17, 18, 23, 24, 25 and 27, see EU trademark number 006029111.

This is particularly baffling as VBB also (and still) holds a trademark registration of an identical mark registered for service classes 36 and 39, see EU registration, trademark number 003915022.

[47] BL O/765/18, [2019] RPC 10 (Intellectual Property Office).

Appointed Person decision at the UK IPO level. Nevertheless, the outcome of *Omega Flex Ltd* is enlightening as to why *Gözze* may not be entirely inconsistent with my proposal.

In *Omega Flex Ltd*, Omega Flex, the applicant, sought to oppose British Standards Institution (BSI) registration of the Kitemark sign as a registered trademark. BSI sought to give up their registered certification mark to register the Kitemark. The Kitemark, as found by the Intellectual Property Office, is owned by a national standards authority, and is known and recognised as conveying a standard of quality. BSI intended to instead register the Kitemark as an ordinary trademark, and to license it to those who met their standards.[48] This was done for several reasons, including, realising the full goodwill of the Kitemark brand.

While Kitemark's previous life as a certification mark was recognised by the IPO board as a barrier to its registration as a trademark, the registration was allowed to stand for classes of goods and services that were not a part of the Kitemark's initial certification mark registration:

> As was pointed out by Mr Bloch, the book Kerly's Law of Trade Marks and Trade Names, 16 Edition uses 'the 'Kite' mark' as an example of a certification mark importantly, the proprietor is the UK's national standards and the proprietor's own evidence illustrates that the Kitemark benefits from an extraordinary level of recognition in the UK with 93% of UK adults believing that products carrying the Kitemark are safer. The proprietor makes the uncontested proclamation that no other certification mark carried the same weight. I accept that the Kitemark benefits from an enormous reputation as an indicator of attainment of a certain quality standard in the UK and that goods and services that are associated with the mark benefit from a perception of enhanced quality. However, a registration of the Kitemark as an ordinary mark permits the proprietor to use, or licence it, in respect of any goods or services regardless of whether they have attained an

[48] *Omega Flex Ltd v British Standards Institution*, BL O/765/18, [2019] RPC 10 [13] (Intellectual Property Office).

> objective and defined quality standard. Therefore, keeping in mind the ubiquitous perception of the Kitemark as an indicator of attainment of a particular quality standard, use in respect of goods and services not meeting those quality standards will have a wide and potentially deceptive application. It would also mean that the proprietor could refuse to licence its mark in relation to goods/services which meet the same standard as other licensed goods/services of the same kind. Its registration as an ordinary mark creates a very widespread threat of deception in respect of the relevant public. Consequently, I conclude that registration of the Kitemark in respect of all the goods and services for which it was originally registered (except those listed in paragraph 34, above) as an ordinary trade mark amounts to an exceptional circumstance where registration was contrary to public policy.[49]

The Kitemark registration was allowed to stand, and effectively operate as an attestation mark for classes of goods and services pertaining to certification and registration, in particular classes 35, 42, and 45.

Interestingly, the COTTON FLOWER mark at issue in *Gözze*, had not been registered by VBB in any class pertaining to certification, consultation, or evaluation services. Thus, it appears in the limited case law treating this issue that ordinary trademarks can in fact be successfully registered and maintained as attestation marks where the class of goods and services is properly selected and reflects that, at least part, of the mark owner's business pertains to assurance services. In these instances, the attestation mark in question is functioning as an ordinary trademark for a firm which performs attestation services.

Thus, an ordinary trademark with a licensing regime can achieve the same certifying function to the same ends as a certification mark. Trademark law has already incorporated this dimension and is capable of continuing. Relatedly, in the United States, a lower court (the United States District Court for the Eastern District of New York)

[49] *Omega Flex Ltd v British Standards Institution*, BL O/765/18, [2019] RPC 10 [44] (Intellectual Property Office).

dismissed a complaint, without leave to amend, where a trade association sued manufactures for self-certifying their product using a trademark.[50] The North American Olive Oil Association, a trade associate for producers, packagers and importers of olive oil, administers 'the nation's largest and most complete olive oil testing and certification program' across the United States and Canada.[51] They offer a 'Certified Quality Seal Program' for those members which comply with their standards by way of a registered certification mark.[52]

The defendant, an olive oil producer VFC was making use of a registered trademark as part of their own self-certification designation for 'Ultra Premium' olive oil. This mark was only used by them, and the mark included the term 'certification' within it. Under my attestation mark typology, this would be described as an in-house certification mark or a specious certification mark, depending on how the use of it related to the overall trade dress, branding, and advertising.[53] Nevertheless, the court held the use of the word 'certified' was not inherently misleading where the certification was first-party and not third-party, and that VFC falsely represented itself as a certification mark.[54]

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[50] See Rebecca Tushnet's helpful blogpost: Rebecca Tushnet, 'TM May Look like a Certification Mark, but That Doesn't Harm a Competing Trade Organization' (*Rebecca Tushnet's 43(B)log*, 1 May 2020) <https://tushnet.blogspot.com/2020/05/tm-may-look-like-certification-mark-but.html> accessed 14 May 2020.

[51] North American Olive Oil Association, 'NAOOA Certified Olive Oils' (*About Olive Oil*) <https://www.aboutoliveoil.org/certified-olive-oil-list> accessed 16 May 2020.

[52] Registered in the US under registration number 6099738.

[53] That is, were it obvious this the declaration was a self-certification it would be an in-house certification mark. If it were presented ambiguously a third-party certification it would more appropriately be identified as a specious certification mark.

[54] 'The court also dismissed NAOOA's claim for cancellation of the registration. Rejecting its argument that it falsely presented itself as a certification mark, the court ruled that the UP mark didn't misrepresent the source of the goods. I wonder if this theory would have gone better at the TTAB in a cancellation petition; the court doesn't seem particularly attentive to what the differences are supposed to be/why

This case is an interesting contrast to the *Omega Flex* case where an ordinary trademark is used as an attestation mark though a licensing regime. Here there was no plan to license the mark to other producers, simply to use this attestation mark to certify quality alongside their ordinary trademark. This case demonstrates the extent to which the ability to perform a certifying function is already inherent in the legitimate functioning of a trademark and how difficult it would be to parse out the certifying function altogether.

Allowing ordinary trademarks to perform this certifying function would not be a total upset to existing trademark law doctrine and there are some ready-made solutions within trademark law that could accommodate this. As discussed above, while trademark law can already accommodate this function, a reform or clarification of law would be helpful. This is most particularly needed around the interpretation of 'use as a mark,' which is statutory language present in several jurisdictions.[55] I would recommend that trademark statutes include language somewhere which makes it clear that 'source' for the purposes of a mark means more than strict commercial source. Thus, when determining whether a mark can distinguish the goods and services from one undertaking to another, the function at interest is about identity of the source rather than commercial source in a stricter sense. This would, admittedly, change the result in a certain class of cases that has found a mark was not sufficiently used as a mark because it was exclusively used in licensing.[56] For instance the case of *Animated Music Ltd's Trade Mark*,[57] where the UK Trade Mark

certification marks are not supposed to discriminate in terms of who can use them as long as their standards are met.' Tushnet (n 50).

[55] In the US and in UK and EU: Bently and others (n 16) 1081; Alexandra J Roberts, 'Trademark Failure to Function' (2019) 104 Iowa Law Review 1977.

[56] While I think engaging in this issue is outside the scope of this project, I plan to take this up in future work.

[57] *Animated Music Ltd's Trade Mark* BL O/392/03, [2004] ETMR (79) 1076 (Trade Mark Registry).

registry revoked a registered trademark on the basis that the evidence of use was not use 'as a trade mark' because it was only used on items related to licensing (brochures and invoices) and not with respect to indicate the trade origin or any goods or services.[58]

The analysis in such cases would, under my proposal, be driven by the question 'can the mark serve as a badge of source identity'? This would encompass all the ways marks are legitimately used in today's marketplaces, in addition to commercial source—affiliation, sponsorship, certifying. This would serve to acknowledge and solidify the recognition of the last few decades that source now has a range of meaning. Including such language would assist a decision maker in determining that an ordinary trademark, registered for a class of services related to certification can be thus licensed and meet the requirements for a registered trademark.

7.3.3 Why abolish rather than reform

One might wonder, even if trademarks can absorb the certifying function, and trademark law can accommodate and protect this function, why abolish certification marks? Why not reform certification marks or let the two systems continue to run concurrently? I consider each option—reform and concurrence—in turn.

First, as I set out in 7.2, proposed reforms to certification marks that seek to reform the nature of the sign itself are of limited utility and in tension with other stated goals of trademark law. Similarly, proposals to substantively reform certification marks to be more truthful marks are similarly problematic, as already discussed above. Any proper substantive regulation ought to take certification marks out of trademark law and create a

[58] Bently and others (n 16) 1081.

sui generis institution akin to geographical indications.[59] Of course we could consider reforming certification marks not towards substantive or more truthful regulation, but to become more trust-driven marks. This too is, nevertheless, problematic.

Where trust is contingent on brand identity, as discussed further below, control of a mark is of utmost importance. Perhaps the most promising avenue to allow certification marks to exist in furtherance of trust as the core of the certifying function is to enhance their ability to be used in nourishment of an underlying brand. Control of a mark is critical to its use in brand development and strategy. A modified certification mark that gave its owner more control over the use and administration of the mark would necessarily be more similar to an ordinary trademark. It is difficult to reform certification mark law in a way that allows its owners to fulsomely develop brands without eliminating most aspects the regulation of certification marks that differentiate them from how ordinary trademarks are regulated.

Rather than reform certification marks, we can allow trademarks (marks which are already well constituted to nourish brand meaning) to take up this role.[60] Why not then allow certification marks to exist concurrently with trademarks, why abolish them? One might argue that we ought to allow certification marks and trademarks acting as attestation marks to co-exist, rather than abolish certification marks. I disagree.

[59] A proposal which is outside the scope of this thesis, and which I think would likely face serious obstacles to get off the ground given the unbounded nature of the characteristics certified by certification marks, which stand in stark contrast to geographical indications which are inherently bounded by geographical region. For an in-depth discussion on the nature of geographical indications see: Andrea Zappalaglio, *The Transformation of EU Geographical Indications Law: The Present, Past and Future of the Origin Link* (Routledge 2021).

[60] As discussed in 7.4 below.

Abolishing certification marks is the more prudent and economical option. For one, trademarks are already performing a certifying function and acting as attestation marks. As a matter of positive law, where services such as 'standards development and implementation' (class 35), 'certification services' (class 42), and 'standards development and implementation', 'evaluation of the standards of others,' and 'information services relating to standards' (class 45) are permitted, it will be difficult to prevent trademarks from being used as attestation marks.[61] Thus if we want to end the redundancy of having two concurrent systems that ultimately achieve the same end – performing a certifying function – then the certification mark regime is the easier one to cut out.

Second, there is a general issue of confusion that can arise when there are multiple channels to achieve the same end. As Bill Cornish has said, of the multiple rules protecting designs, 'design law is an absurd maze', and there is no need to encourage the law regulating marks that perform a certifying function to go down the same trajectory.[62] Having multiple routes to protecting the same underlying resource or rights will results in unnecessary and unhelpful complexities.[63] One instance of such complexities that may arise is where there are multiple routes to protect the same rights, those left trying to navigate the scope of another's rights may be confused. Where trademarks and certification marks are both used to register marks performing a certifying function, and the former

[61] Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks (Nice Agreement) 1957.

[62] Lionel Bently, 'The Design/Copyright Conflict in the United Kingdom: A History' in Estelle Derclaye (ed), *The Copyright/Design Interface: Past, Present and Future* (Cambridge University Press 2018) 221.

[63] As David Vaver has observed, for instance, of the Canadian regime where the same entity can protect the same symbol in multiple ways, including a registered certification mark, this results in 'confusing untidiness.' David Vaver, *Intellectual Property Law* (2nd edn, Irwin Law 2011) 458.

necessitates an owners ability to exclude and the latter prevents an owner from excluding use where the requisite standards are met, confusion may follow.[64]

Last, there is an overarching concern of consistency and conceptual coherence at stake when there are, again, multiple routes to the same right. Over time courts would develop the jurisprudence of trademarks and certification marks in different directions with different purposes, we may then have a general problem of a cumulation of rights. This would make trademark law vulnerable to issues around inconsistency and, plausibly conceptual incoherence. This culminates in a cost around uncertainty that surrounds any accumulation of rights. By paring down, or slimming the scope of trademark law, so to speak, we can have one set of rights—a trademark right—that performs a certifying function and avoid future incoherence, inconsistency, confusion, and all the associated costs of such harms.

7.4 The normative case for centring trust over truth

In Chapter 6, I argued that conceptualising certification marks, and their essential function, as a vehicle for trust instead of truth offers a more suitable account of the certifying function. I argued that what is crucial to the functioning of certification marks is trust, not truth (truth being the provision of objective, specific, and accurate information). In the previous section I described how trademarks are already successfully behaving as attestation marks and argue that trademarks ought to replace certification marks. My reasons for this are two-fold. First, truth, and signals literally conveying truthful

[64] Laura Heymann explores this argument in the broader intellectual property context, see: Laura A Heymann, 'Overlapping Intellectual Property Doctrines: Election of Rights versus Selection of Remedies' (2013) 17 Stanford Technology Law Review 239.

information, are not the appropriate subject matter for a private property right. Second, trademarks are better suited for brand development and brands allow consumers to assess trustworthiness; ordinary trademarks thus are better positioned as vehicles that motivate trust.

7.4.1 Truth as an inappropriate subject-matter for private property rights

As set out in Chapter 6, there are two different elements at play in how we conceptualise the certifying function, and what motivates a successful manifestation of the certifying function—*trust* and *truth*. I posited that while truth is more predominantly featured in the conventional accounts of certification marks, trust plays a more central role and the ability to command trust ought to be advantaged as such. In this section, I take this argument one step further and argue that as a normative matter, truth ought not to be recognised as what motivates the certifying function. That is, it is both undesirable and inappropriate to centralise truth as the core of the certifying function, and then to ascribe a private property label to certification marks and protect them based on a successful certifying function. As I explain below, a certifying function which anchors and privileges truth is not only descriptively inaccurate, but also incongruous with the treatment of certification marks as private property.

To begin, we can consider what a certification mark looks like when its certifying function is best understood as motivated by signalling truth and protected on that basis. Where the goal of the certification mark is to convey the *nature of the quality being certified*, a certification mark will have information about the standard incorporated into the face of the mark or be integrated into the signified (as discussed above in 7.2). To use the language of Chapter 2, a mark motivated by truth is going to result in a more *robust* certification mark.

A robust certification mark that conveys *truth* will be finding ways to signal or depict the greatest amount of objective, specific, and accurate information. The more successful a mark is at doing this, the closer they become to what can properly be termed a ‘label’. Labels are devices intended to convey descriptive information through written characters or other symbols.[65] Labels, unlike trademarks, are not intended to be a proxy or intermediary of information, but a provision of the information itself.[66]

The goal of a more robust certification mark, therefore, is to communicate to consumers not merely which products have the assurance of being certified to a particular standard, but conveying the quality being certified itself, directly. While the former may be described as carrying the assurances of a given actor, the more robust the mark becomes the more the product can be described by the quality being certified. For instance, consider the difference between a bare certification mark that is distinctive as belonging to the Gluten Intolerance Group as opposed to a robust certification mark owned by the Gluten Intolerance Group that communicates a product bearing it has been certified as being gluten free. In the former version, the bread can likely be described as ‘bread assured by the Gluten Intolerance Group as gluten-free friendly’ whereas the latter mark is more likely to result in the product being described as ‘gluten-free bread.’

[65] Oxford English Dictionary, ‘Label, n.1’.

[66] Even if sometimes the information being conveyed is limited, truncated, or includes indicating a further source to acquire more information.

The more robust a certification mark is, and the more driven by the goal of communicating truth it is, the more we can say that the goal of the mark is not to communicate the assurances or certification by a particular body, but to modify the nature of the product itself by making known an attribute of the product – as any label describing a product does. We must then consider that certification marks, as currently regulated under the trademark statutes, are a type of trademark and therefore a type of private property.[67] When it comes to ordinary trademarks, this private property paradigm resonates.[68] Trademarks are assets owned by individual actors, and can be licensed, or otherwise exploited to acquire capital and wealth. When it comes to certification marks, however, a private property framework is more awkward and ill-fitting.[69]

The awkwardness of certification marks as a form of private property is notable at two levels. The first is that certification marks, because of the limitations put on the owner by trademark law, may be a less desirable form of private property than an ordinary

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[67] Trademarks Act, s 19 (Canada); EC EUTM Regulation 2017/1001, recital 26 (EU); TMA 1994, s 22 (UK). For a discussion on the nature of trademarks as a form of property in the American context see: McKenna, 'The Normative Foundations of Trademark Law' (n 32). See also: Lionel Bently, 'From Communication to Thing: Historical Aspects of the Conceptualisation of Trade Marks as Property' in Graeme B Dinwoodie and Mark D Janis (eds), *Trademark Law and Theory: A Handbook of Contemporary Research* (Edward Elgar Publishing 2008).

[68] Particularly under Larissa Katz's account where she views ownership as an office. Under Katz's view, an owner has 'exclusivity' rights to a resource (rather than exclusionary rights) wherein an owner is in a position of agenda-setting authority for the resource to which proprietary rights attach. See: Larissa Katz, 'Exclusion and Exclusivity in Property Law' (2008) 58 University of Toronto Law Journal 275.

This is not to discount those property law purists who would argue intellectual property is unaptly named and is best understood by a bundle of non-proprietary rights, see: S Douglas and B McFarlane, 'Defining Property Rights' in James Penner and Henry Smith (eds), *Philosophical Foundations of Property Law* (Oxford University Press 2013).

[69] Not because the regulatory features of certification marks, above and beyond trademarks, make it undesirable to private property owners to invest and maintain their proprietary rights, but rather because of features of certification marks that make the resource to which the proprietary rights attach for a capitalist market.

trademark. Certification mark law generally requires all users who meet the stated specifications to be able to make use of their marks. This removes a significant degree of control on the part of the certification mark owner. While a certification mark owner can determine what the specifications that underlie their mark, in some jurisdictions they cannot prevent anyone from using their mark if they meet the set-out specifications. This is a problem on most dominant accounts of property – those who see proprietary rights as necessitating the right to exclude[70] or exclusivity.[71] Of course, one could argue that by determining the standards that underlie the mark the owner sets the agenda for the resource. However, I would suggest that while this may provide some degree of ownership right, not having control over who can make use of the mark, particularly when viewed through the lens of brand identity and meaning, significantly limits an agenda-setting ability for a certification mark. That is, the limited control conferred by a certification mark, with little benefit in return,[72] may make an owner hesitant to invest and maintain in this kind of mark. Nevertheless, beyond this question of the utility of certification marks as private property is a more concerning issue: if certification marks driven by truth act more like labels than proxies of quality, then what are the implications of allowing them to be privately owned?

Trademarks, as a form of private property, are controlled by their owner; their owner can exclude others from use of their registered trademark. Subject to a narrow scope of exceptions, this arguably provides the trademark owner on a monopoly over a given sign

[70] Thomas Merrill, 'Property and the Right to Exclude' (1998) 77 Nebraska Law Review 730; JE Penner, *The Idea of Property in Law* (Oxford University Press 2000).

[71] Katz (n 68).

[72] Particularly as there is no suggestion in the trademark law or political science literature that consumers can distinguish pure certification marks from pseudo-certification marks, as I argue in Chapter 5. Nor does there appear to be any jurisdiction that grants certification mark owners' preferential rights with respect to registration or protecting the scope of infringing activities.

in the market with reference to a scope of class of goods and services. To require certification marks to become more truthful, and more like robust certification marks, but to continue to regulate them within the existing trademark law scheme is to inch towards a monopoly on truthful information and the signalling thereof.

The obvious counter argument to this position, however, is the geographical indications (GI) regime. GIs are closer to a descriptive label while still being considered a form of intellectual property—and in several jurisdictions the function of GIs is performed by certification marks.[73] While GIs are an allied right to trademarks,[74] private property is an ill-suiting concept for them too given how much regulation of a GI mark is statutorily regulated and the level of oversight into the administration of the mark:

> There is also significantly greater state involvement in compiling inventories of target regional products, catalyzing producer group formation, providing support with registration costs, and mediating between conflicting stakeholder interests during the specification drafting process. Once registered, government departments or agencies may 'own' the GI while in some sui generis systems, public authorities help to police the GI by pursuing infringements in the marketplace.[75]

This makes GIs a significantly different form of mark than ordinary trademarks, and more importantly, today's certification mark. While certification marks could have been understood as closer to this public-esque regime at a time where the consumer protection board was involved in their oversight, that is not the case in the jurisdictions relevant here.[76]

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[73] For example, in Canada and the United States.

[74] In the European Union where geographical indications are a *sui generis* regime.

[75] Dev Gangjee, 'Trade Marks and Allied Rights' in Rochelle Dreyfuss and Justine Pila (eds), *The Oxford Handbook of Intellectual Property Law* (Oxford University Press 2018) 563.

[76] Whereas in Australia, for instance, there is substantive regulation of the standards underlying certification marks, referred to in Australia as 'certification trade marks', see: Australian Competition & Consumer Commission, 'Certification Trade Marks' (*Australian Competition & Consumer*

In the UK, for example, when certification mark regulation lost the involvement and oversight of a consumer protection body for the registration of certification marks, we effectively allowed for a non-trivial expansion of intellectual property rights. Certification mark owners received the same degree of protection in terms of the property rights of a mark, but the public got far less; when the level of administrative oversight into the quality of the standards of the characteristic being certified became diminished to basically none.

The greater the effort to purifying the truth function of certification marks, and the more robust the certifying function becomes, and therefore more analogous to a label, the further away a certification mark gets from what ought to be recognised as the proper subject-matter of a private property right, and a trademark right in particular. A label, that is a description of information, ought not to be protected by a private property right and a default private property regulatory approach. Trademark law already recognises this by not allowing purely descriptive marks on the registrar. Where a certification mark is increasingly a ‘truth mark’, then the competition on the market is based on the quality being conveyed, rather than the assurances of a certifier and their perceived credibility and the value they add.

7.4.2 Why centring brand relationships, via trademarks, anchors trust

In this section I consider why, as a normative matter, we ought to nourish brands to motivate the ability of attestation marks to command trust. In discussing this, I explain why

Commission) <https://www.accc.gov.au/business/exemptions/certification-trade-marks> accessed 13 November 2021.

the optimal vehicle for attestation marks moving forward are ordinary trademarks, as trademarks have developed into a rich vehicle for brand meaning.

In Chapter 6, I argued the certifying function of attestation marks is motivated by trust in a brand. Trust, while central, is the upshot of, and dependent on, *trustworthiness*. Increasing trustworthiness is best done by allowing the target of trust, brands, to develop more fully. The more hearty a brand's impression can be, the greater the potential to *relate* to a brand and to assess its trustworthiness. This ultimately enhances the capacity for trust because the primary basis of trust is *trustworthiness*. An estimation of trustworthiness, as Piotr Sztompka theorised, is 'the most important and most common ground for trust.'[77]

The ability to assess and estimate trustworthiness is necessary to decide whether to trust or distrust; 'trustworthiness begets trust'.[78] In the encapsulated-interest account of trust, that I adopted in Chapter 6, trustworthiness speaks to the motivations and likelihood one will act as trusted when the time comes:

> Betrayal is, of course, not a failure of trust but a failure of trustworthiness…. If my trust in you is well placed, that is because you are likely to have the motivation to do what I trust you to do. That is to say, you are likely to be trustworthy. <u>In the encapsulated-interest account, trustworthiness is just the capacity to judge one's interests as dependent on doing what one is trusted to do.</u> In virtually all accounts, the central problem in your trustworthiness is your commitment to fulfil another's trust in you. We commonly assert commitments, but those who are to rely on us want some hope that the commitment will actually motivate relevant actions in a future moment.[79]

The trustworthiness assessment of a brand, therefore, is premised on an evaluation of whether a brand will be sufficiently motivated to maintain your perceived commitment to

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[77] Piotr Sztompka, *Trust, A Sociological Theory* (Cambridge University Press 2000) 70–1.

[78] Russell Hardin, *Trust & Trustworthiness* (Russell Sage Foundation 2002) 28.

[79] ibid.

a given course of action or ideals. For instance, the motivation of a kosher certifier to maintain the religious standards underlying their certification you expect, or the Gluten Intolerance Group to continue to require the absence of gluten in products they certify.

One might wonder, is a brand capable of acting trustworthy and being assessed on the grounds of trustworthiness? I suggest yes. Trustworthiness can be distilled to two aspects: the motivation of the target of trust, and the assessment of trustworthiness by the person forming the trusting expectation. The first issue is about whether the target of trust can be committed to their actions such that their commitment can be described as a function of trust. The second issue hinges more on determining the viability of enhancing brands as a form of centring trust.

Addressing the former issue first, as I argue in Chapter 4 brands are social objects and have, among their other hallmarks, their own impression. Accordingly, while it may be incorrect to attempt to attribute some attributes to brands (such as emotions or feelings), others are quite appropriate (such as values, actions, and even politics). Trustworthiness is a function of one's motivations to not only assert a commitment but to act in accordance with it. Generally, the type of motivation one attributes to trustworthiness ventures into the realm of morality, emotions, or character. This would all be what Russell Hardin considers as 'internal inducements' of trustworthiness.[80] While this may not be relevant to brands, Hardin also recognised that trustworthiness may also be a function of 'external inducements.'[81] This latter category is more applicable to brands.

[80] ibid.

[81] ibid.

External inducements to fulfil one's commitments makes one capable of being trustworthy. External inducements include societal and institutional devices and arrangements.[82] Thus, a brand's value or goodwill and impact of a brand's value on its owners (particularly in the case of a corporation) operates as precisely this kind of constraint. Concern for a brand's repute or image is the type of societal arrangement that can motivate an external inducement to uphold a statement or suggested commitment. Similarly, '[l]egal and other institutional constraints can give us strong incentives to be trustworthy.'[83] The legal consequence for misrepresenting a brand or misstating the nature of a product does not *negate* the need for trust, but rather is another form of external inducement to motivate trustworthy behaviour.

How then can a consumer determine or assess trustworthiness? Where the brand itself is the target of trust, then greater and more holistic interaction with a brand becomes a valuable mechanism to allow our market to function based on trust. That is, the more interactions consumers have with a brand, directly and indirectly, the better their assessment of trustworthiness will be. Whether or not to trust a brand is, therefore, not necessarily premised on some anterior question of truth. Whether or not a particular claim is deemed truthful is often a result of how trusted the source of the claim is. That is, at times, claims are understood to be truthful because the speaker is so trusted in that regard. That being said, an assessment of trustworthiness is not static. This assessment grows, evolves, and more importantly, can be corrected in response to new interactions or experiences, as discussed below.

[82] ibid 28–9.

[83] ibid 29.

This brings us to the latter issue of assessing trustworthiness as a consumer, which is not done in isolation, but as part of a greater social network. For this, I rely on Belson's analysis regarding how trust motivates reliance on eco-labels.[84] Despite the value of Belson's work here, I argue he misidentifies the target of trust as the 'eco-label' itself, instead of more precisely identifying the brand the eco-label is associated with as the appropriate target of trust. Nevertheless, his work is instructive:

> How can trustworthiness be applied to consideration of the merits of an ecolabel scheme and a prediction of consumer trust in it? The first of the three components of trustworthiness – reputation – will depend on the degree to which the ecolabelling scheme has established a good reputation and developed goodwill in the ecolabel. Where reputation has been established it is due to historical success of the proprietor-operator of the scheme in achieving association of the label in the minds of consumers with goods or services that they seek or give them satisfaction.
>
> The second of the three components of trustworthiness – performance – depends on maintenance of the established reputation of the label. This requires the ecolabel proprietor-operator to be vigilant in protecting the reputation of the label by constantly policing its use against counterfeiting, use with substandard products, unlicensed use, and the like.
>
> From the consumer's perspective, the third component of trustworthiness – appearance – can be the major contributor of the three components to trustworthiness of an ecolabel because it is synonymous with the brand image. The commercial impression created and maintained by the brand image of an ecolabel and of the organization standing behind it is basic to consumers' purchasing decisions. Brand image directly addresses and influences the potential purchaser. The public distinctiveness of a brand implies that it has a unique identity in the market place that gives the brand holder a powerful means of reaching out to consumers, to inform and

[84] Belson (n 9) s 7.69-73.

> persuade them, and to generate brand-related cognitive responses, all of which strongly influence the decision whether to trust the label. [85]

Trustworthiness is determined by a range of information, three primary grounds to determine trustworthiness are: reputation, performance, and appearance. And it is within these three grounds that the role of *truth* is a factor, as discussed below.

First, *reputation* refers to 'record of past deeds.'[86] That is, what a consumer knows about how a brand behaves. This knowledge about brands will come from a range of sources. It may include, for example, reports of previous litigations or scandals the brand was implicated in. Long form journalism, leaked internal documents, or interviews with those who work at the brand may also shed light on a brand's reputation. Of course, not all consumers will be interested in all aspects of a brand's reputation and previous experience, as 'knowledge relevant for decision to trust depends on type of trust being considered.'[87] Thus the type of conduct being considered in the past, or their known past decisions, will vary based on the trust expectation being considered. Trademark law, and consumer law more generally, cannot force consumers to care about things they do not, no matter how much one might wish they did. Nevertheless, the reputation of a brand which acts as a certifier, and its history has a bearing on its trustworthiness. So, if a certifier has long been recognised by an industry or its peers as having integrity this will weigh positively in terms of its reputation and may militate in favour of a finding of greater trustworthiness.

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[85] ibid.

[86] Sztompka (n 77) 71.

[87] ibid.

Second, *performance* refers to the maintenance of an established reputation. Here, the past is bracketed, and focus on what the potential beneficiary of trust is currently doing.[88] In the context of certification marks, a mark owner's ability to ensure their mark is used correctly and guard against misuse would go to their trustworthiness. A consumer's own experiences with a brand will also inform this ground of trustworthiness. This could also include marketing efforts, educational campaigns, and activism by a certifier. Thus, while under my account objective information is not <u>required</u> to be shared by virtue of trademark law, its provision would ideally be rewarded by consumers. Although certain levels of disclosure by brands are required by various other institutions of law, such as securities law for example, and these broader disclosure practices are undoubtedly welcome.

Consumers may rely on this disclosure either directly, by conducting their own research, or indirectly by hoping that its provision will prompt intermediaries, such as experts, regulatory bodies, or journalists to investigate and affirm or refuse the credibility of a certifier and the trustworthiness of a brand. To some extent, this relies on market forces and the checks and balances that exist in other areas of law to hold brands and certifiers accountable. Ideally, performance as a ground of trustworthiness will be significantly premised on reliable information, or the trust on other credible sources, such as experts and vetted journalists, and not on the musings of a neighbour or an errant tweet.

Last, *appearance*, is the outward presentation of the target of trust. For brands, this will refer to their general brand image including marks used by a certifier, their website or

[88] ibid 77–8.

other visual material. Therefore, the more interaction a consumer has with a brand, and the more developed a brand's impression can become, the better the ability to engage in a trustworthiness assessment. For instance, brands that make use of QR codes to share more information with consumers about their products may, in turn, make a consumer deem them more trustworthy. This in turn cultivates a market of trust—or distrust, as the case may be.

Given that trademarks, as set out in Chapter 4, are a cornerstone feature of brand development, allowing trademarks to perform the role of attestation marks better promotes brand development in the attestation mark space. As brands are the social objects that consumers interact with, and relate to and assess, allowing brands to flourish is an appropriate way to promote trust. This can not only aid the existence of a relationship between the brand and consumer, but (and perhaps more vitally) these components of brands are also vital for an assessment of trustworthiness.

This assessment of trustworthiness would then, notionally, inform a consumer's relation with a brand including, including most critically, if they choose to support this brand. This support may come in various forms, such as, speaking well of them to their social networks, amplifying the brand's messaging and presence on social media platforms, purchasing from the brand, or brand endorsed products, identifying as a consumer of the brand outwardly. The loss of trust in a brand may equally result in a consumer opting to boycott that brand, or to share their negative experiences in news outlets, in public customer reviews, or on social media platforms.

7.5 Criticisms of my proposal

In sections 7.3 and 7.4 above, I proposed the optimal way forward is to abolish certification marks, allow trademarks to continue to perform the certifying function, and proposed a minor reform to trademark law to concretise the ability of individual trademarks to perform a certifying function.[89] Under my envisioned scheme, ordinary trademarks will absorb the certifying function and act as individual trademarks and attestation marks, to the exclusion of certification marks. In this section, I consider consequences of my proposal within the trademark law landscape, that is, what problems (identified in Chapter 3) have I resolved with my proposal, and what problems remain outstanding. Similarly, I consider what ways the approach I propose is liable to misuse and abuse.

7.5.1 The 'problems' with certification marks—revisited

In Chapters 2 and 3, I set out how the reality and practice of certification marks departed from expected legal norms. I identified, what I argued, were several issues with certification marks and the certification mark law as an institution. That is, ways in which certification marks fail to perform as statutorily envisioned across jurisdictions. In this section I revisit these three classes of identified problems. In doing so, I identify the problems that would persist, or be resolved, following my proposal. I do so to address the possible criticisms of my proposal as well as its strengths and limitations.

[89] By optimal I mean the least imperfect solution, see: Neil Komesar, *Imperfect Alternatives: Choosing Institutions in Law, Economics, and Public Policy* (University of Chicago Press 1994).

7.5.1.a Problems with certification as a private governance institution

Certification marks are inextricably and inevitably tied to the practice of certification and the institution of certification as a form of private governance. The underlying mechanisms of certification embedded within certification marks create their own hosts of problems that to fix would require 'substantive regulation'—regulating the underlying standards themselves.[90] This would involve regulations that would treat issues such as: (i) the nature of the standards, (ii) how standards are created, (iii) how standards are updated and maintained, (iv) how underlying standards are validated and verified, and (v) how decisions around the use of a mark are made. Because my proposed reform operates on the mark level it does not deal with this class of problems.

My proposal does not seek to further integrate these substantive issues into trademark law but rather cleave them away and recognise they belong to another area of law. My approach is in line with a growing development of certification mark law to have the underlying standards less integrated into trademark law. A trend that has developed and continued to grow over time, beginning with the withdrawal of the oversight of the standards in certification marks by a specialised governmental body.[91] To deal with this class of problems would require far more substantive regulation, more akin to the European Union's *sui generis* geographical indications regime.[92] By not engaging in this realm of problems, but identifying them and leaving them aside, I leave the enterprise of using

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[90] Fromer (n 5). I use Fromer's term 'substantive regulation' here to refer to regulating the standards and practices that underlie the mark.

[91] As discussed in Chapter 6.

[92] Furthermore, it would be difficult to do this within this project give the functional approach to certification marks I adopted, and the need to situate specific legal reforms within the nuances of a particular jurisdiction.

marks to perform a certifying function no worse off. Rather, I identify that these problems are more appropriately belonging to the realm of private governance and that they ought to be dealt with at the level they occur, at the level of the certifier.

This is not to say these are not problems that ought to be addressed. Rather, there is a body of literature seeking to reform and improve the practice of certification in the regulatory space.[93] Attempting to make these reforms within trademark in isolation from these other impacted areas of law, practice, and scholarship would be not only ill-advised but incongruent with the purpose of trademark law and the movement within trademark law towards nourishing and facilitating brand meaning. To deal with these problems within trademark law would necessarily require reintegrating substantive regulation into trademark law and would be inconsistent with greater goals of trademark law and the underlying thrust of the certifying function—trust.[94]

7.5.1.b Problems with certification marks as marketplace signs

Certification marks, as a form of trademark, are also vulnerable to the class of problems that pertain to distinctive marketplace signs and their ability to communicate effectively. Under the status quo, this has given rise to two prongs of problems: (i) certification marks do not necessarily communicate the characteristic or standard being certified; and (ii)

[93] For example: Georg von Wangenheim, 'Certification as Solution to the Asymmetric Information Problem?' in Peter Rott (ed), *Certification – Trust, Accountability, Liability* (Springer International Publishing 2019); Victoria I Daskalova and Michiel A Heldeweg, 'Challenges for Responsible Certification in Institutional Context: The Case of Competition Law Enforcement in Markets with Certification' in Peter Rott (ed), *Certification – Trust, Accountability, Liability* (Springer International Publishing 2019).

[94] See discussion in Chapter 6, section 6.4 'The misguided search for more truthful certification marks'.

consumers cannot discern the difference between a pure certification mark and a pseudo-certification mark.

First, as previously discussed, certification marks are not required to convey the characteristic being certified or the standard being met. Accordingly, it is entirely possible for a consumer to interact with certification marks in the market and be utterly unaware of what it is they are trying to communicate. Certification marks, as currently understood and regulated, are not required to fulfil their certifying function robustly, and frequently are unable to do so. Yet on an account of certification marks that sees the certifying function as motivated by truth, this is problematic.

Second, given that trademarks are used as pseudo-certification marks alongside an existing certification mark law scheme, consumers encountering an attestation mark in the market are unable to discern the difference between a pure certification mark or a pseudo-certification mark. The extent to which this is a problem depends on whether there is any meaningful functional difference between a pure certification mark and a pseudo-certification mark from a consumer's perspective. Lai, for instance, suggests that allowing pseudo-certification marks to exist can 'hijack' the trust that accrues to certification marks by virtue of their registration as certification marks rather than the quality of the underlying certification.[95] I am, however, sceptical of the claim that a certification mark commands a higher degree of trust than a pseudo-certification mark. Given that it is doubtful most consumers are aware of how certification marks are regulated, or could differentiate between a pseudo-certification mark and pure certification mark, it would be difficult to

[95] Lai (n 7).

see, without empirical research, how consumers would attribute the trust to the underlying legal institution and not the attestation source identified in the mark.[96] I would argue that in most jurisdictions the difference between pure certification marks and pseudo-certification marks is not significant enough to mislead consumers, nevertheless my proposal nullifies this issue as there will no longer be two separate streams to protect attestation marks.

If trademarks absorb the certifying function, and certification marks are abolished, these two problems have less force. First, where a trademark is performing a certifying function, the thrust of this will be by acting as a vector of trust in the underlying brand. This does not require that consumers necessarily understand the characteristic being certified or the standard being conveyed, so long as they are able to identify the attestation source. This means that to perform properly a consumer need only identify an attestation mark as signalling an attestation source—akin to ordinary trademarks. Consumers unable to discern a standard from encountering the mark alone is not a problem given the mark is not intended to communicate truthful *information*. Second, when certification marks are abolished, there are no longer two channels of securing an attestation mark—pure certification marks and pseudo-certification marks. Thus, any perceived or real problems created by consumers being unable to identify the nature of an attestation mark become immaterial. Consumers will only have to evaluate whether they wish to rely on an

[96] When I presented on this research at the 19th Annual Intellectual Property Scholars Conference, some trademark scholars themselves were surprised to find out what they had considered to be pure certification marks were in fact quasi-certification marks. A Mogyoros, 'Pseudo-Certification Marks' Trademark Doctrine Breakout Session, Intellectual Property Scholars Conference 2019, DePaul University, Chicago Illinois, August 8-9 2019.

attestation mark based on that specific mark and their trust in the underlying brand, not on the basis of trademark law's institutional regulation of marks.

7.5.1.c Problems within trademark law as a legal institution

There is also a class of problems tethered to the nature of trademark law as a legal institution. That is problems with ways in which certification marks are regulated in and of themselves and vis-à-vis ordinary trademarks. Chief among these problems was the redundancy of allowing ordinary trademarks to act as attestation marks alongside pure certification marks. As discussed above, under my proposal there would no longer be concurrent registration systems for attestation marks—all marks would be registered as ordinary trademarks. By virtue of all attestation marks being registered as trademarks, all attestation mark owners will now have the same power, control, and ability to develop their brand vis-à-vis each other, and any ordinary trademark owner.

Permitting trademarks to function as attestation marks will result in the loss of some statutory boundaries created by most certification mark law schemes, such as certification mark owners being third-party independent certifiers. That being said, and as presented in Chapter 2, the field of certification has become more complex. Certifiers are infrequently truly independent, and first-party certification is an accepted practice. Also, brands are at times found to be better at conveying a standard through self-declaration than third-party certifiers.[97]

[97] Fabrice Larceneux, Florence Benoit-Moreau and Valérie Renaudin, 'Why Might Organic Labels Fail to Influence Consumer Choices? Marginal Labelling and Brand Equity Effects' (2012) 35 Journal of Consumer Policy 85.

Furthermore, and perhaps most pressing, once we recognise the centrality of trust in motivating the certifying function, the goal of certification marks is no longer to convey clear, delineated, and objective standards. This, however, may be seen as a loss to some. While certification mark law fails to ensure this truthful communication, it was at least an institutional goal. Under my proposed reform, this is no longer the aspiration of an attestation marks, and this in turn may be perceived as endorsing attestation mark owners as maintaining imprecise, fuzzy, and transient standards where their underlying regulations of a mark are not part of their trademark application.

Yet, nothing in my proposal *prevents* attestation mark owners from conveying more robust standards if desired and providing more information regarding certification standards based on the advertising and branding practices of the owner.[98] There was little rigour in the existing certification mark law scheme regarding the conveyance of standards that is being *lost* by my proposal. Rather, now it will be up to each individual attestation mark owner to compete on the quality and credibility of their standards and for the consumer market to react, and reward, accordingly.

7.5.2 Potential for misuse and abuse

While the certification mark law as an institution has several problems with the way it is currently constituted, no legal institution is without its problems. Rather, the goal in many ways is to seek the least imperfect solution available.[99] As discussed in the above section, my proposal addresses some of the current problems with certification marks as an

[98] A position Chon advocates for, see: Chon (n 11).

[99] Komesar (n 89).

institution and does not aggravate pre-existing problems. Nevertheless, it has its own weaknesses and vulnerabilities for misuse and abuse. Particularly as, under my account, consumers' assessments of trustworthiness drives a lot of the ultimate efficacy in a brand providing an attestation function. As trust, premised on trustworthiness, is individually cultivated, the content of trust is varied and without explicit legal substantiation. While the breaching of trust between a brand and consumer is not without consequence for the brand, there is a significant power differential between brands and consumers that inevitably favour the former.[100] Accordingly, the two greatest potential issues of concern can be described under the general headings of competition concerns and consumer deception concerns.

Issues pertaining to competition and deception are anticipated by current certification mark legislations even if current proposed solutions fall short. As previously discussed, for example, by bifurcating who can own a certification mark and who can carry on business under the auspice of the certification mark, the legislation attempts to ensure the impartiality and independence of certification marks to reduce competition problems. Similarly, certification mark owners are intended to make the standards for use of their mark reviewable to the registry and are generally required to allow anyone to use their mark who meets these standards. This practice of compulsory licensing or a non-discrimination feature of certification marks,[101] aims to reduce competition problems that may arise, as well as ensure the authenticity and legitimacy of certification marks. While

[100] If trademark law were to embrace the relevance of trust as a normative force more significantly, I think this power differential could, and ought to, be addressed through trademark law more generally, something I plan to consider further in future works.

[101] 15 USC §1064 (5)(D) (US); Belson (n 9) s 3.84.

current statutory approaches fall short of achieving this end, abolishing certification marks comes at a cost of losing whatever marginal progress these regulatory frameworks make towards these two pillars of potential abuse of attestation marks.

In the subsections below, I consider these two potential sources of misuse. I acknowledge that ordinary trademarks are not regulated to deal with these competition and deception claims as raised by attestation marks. Accordingly, I address the ways in which competition and deception concerns remain under my proposal, and where necessary point to other ways in which these problems can be treated by other areas of law.

7.5.2.a Competition concerns

Ordinary trademarks are regulated with competition concerns in mind, albeit significantly different competition concerns than that of certification marks. The predominant competition concern driving trademark law is ensuring (i) that a trademark owner not acquire an exclusive ability to use words, symbols, and other signs to adequately *describe* a product in the market, and (ii) that a trademark not become part of the underlying goods or service such that granting exclusivity in a trademark result in conferring a monopoly in an underlying product.[102] These are not the same set of concerns that arise in the instance of certification marks.

As discussed above and put forward by Fromer in her paper on certification mark markets, certification marks carry with them potential for different competition harm.[103] The competition harms in question would not directly affect consumers, end users of the

[102] Mark McKenna, 'An Alternate Approach to Channeling?' (2009) 51 William & Mary Law Review 873.
[103] Fromer (n 5).

mark, nor certification mark owners. Rather the harm arises as between users of a certification mark and certification mark owners who may wield their power in unfair ways, and users of a certification mark vis-à-vis their competitors who are non-users of the same certification mark. Competition concerns for users of the mark and other market players, manifest in two situations: where an attestation mark owner unfairly rejects a firm's request to make use of their mark, and issues of fairness that may arise between competitors on the marketplace where one has unfairly been granted the use of an attestation mark and the other is a non-user.

These two potential sources of harm are liable to occur where the owner of a certification mark has acquired significant market share or has become the industry standard for an area of certification—and then proceeds to wield their power anticompetitively or unfairly by not allowing those who meet the requisite standards to make use of their mark.[104] While this practice is not permitted under current certification mark legislation, it is certainly not prohibited under trademark legislation, which as a general principle allows trademark owners to decide if, when, and how to license their marks.[105] Thus, whatever limited protection users and non-users of marks are offered against certification mark owners is lost under my proposed abolition of certification marks. My response to this is two-fold.

First, the benefit of envisioning and regulating attestation marks as marks which act as an indication of trustworthiness rather than truth, is that powerful attestation marks

[104] For a more fulsome discussion on potential for such harm see: ibid.

[105] Although it is worth noting that Canada's certification mark law regime does not appear to require compulsory licensing, nor does the EU certification mark law regime. Furthermore, there has not been any reporting, in Canada for example, of certifiers acting in a discriminatory or unfair way against users and potential users of their marks in any frequent or significant fashion.

will no longer be an authority in an underlying *standard* or *quality*. Rather, they will be the attestation source which commands a greater or lesser amount of marketplace *trust*. And this trust will accrue on the basis of informed and empowered assessments of trustworthiness. The difference is when an attestation mark is an indication of underlying trust, and not truth, having market power is not the same as conferring a monopoly in an underlying product quality by virtue of having market share over a standard. Rather, the power is rooted in the trustworthiness of the actor – something for which there can be no true monopoly.

Second, the degree to which an attestation mark is owned by a certifier, there is a large extent to which anticompetitive marketplace behaviour of a certifier exceeds the ambit of trademark law. Even certification marks as currently constituted are distinguishable from the underlying certification and certifying body. Under my proposal this distinction will be even more significant. Certifiers seeking to have a logo to symbolise their assurance can make use of trademarks and license them as they see fit. Where certifiers act in arbitrary, unfair, and ultimately anticompetitively, this behaviour falls more appropriately within competition law's ambit. Where there is a need from more disclosure from certifiers to act as a ground of a trustworthiness assessment by consumers, this too is a better suited task for another area of law or industry specific regulation.

The private governance literature recognises that the problem of unfair business practices exists within in private certification. While a range of possible solutions exist, they fall outside the domain of trademark law. For instance, governments may consider regulatory schemes that oversee certifiers. One example is the European Union's current efforts to undertake an initiative that would oversee bodies that purport to certify products as organic. This initiative would require that '[c]ontrol authorities and bodies have to be recognised by the Commission to be able to certify operators in non-EU countries for the purpose of importing their organic products to the EU' for instance.[106] Similarly, in the United States, the US Department of Agriculture has introduced a program to oversee third-party organisations that certify organic standards by introducing an accreditation for certifiers in this area.[107] Further, my proposal does not diminish the ability of aggrieved non-users of certification marks to bring a private action against a certifier where their denial to use the mark was done to intentionally cause economic harm.[108]

Thus, while precedent exists for regulating certifiers on an industry-by-industry basis, ultimately not all certifications are created equal. That is, some certifiers are more likely to engage in anti-competitive behaviour than others and some forms of certification are more liable to be misused. Rather than attempt to deal with the looming threat of anti-competitive behaviour across the board, my proposal is to minimise its threat by having certifiers compete on the basis of *trust*, and for competition law to step in to deal with anti-competitive behaviour as required when a threat materialises.

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[106] European Commission, 'Organic Products – EU Recognition of Control Authorities & Bodies' (*European Commission: Law*, 2021) <https://ec.europa.eu/info/law/better-regulation/have-your-say/initiatives/12907-Organic-products-EU-recognition-of-control-authorities-bodies_en> accessed 4 July 2021.

[107] US Department of Agriculture, 'Organic Certification and Accreditation' (*USDA Agricultural Marketing Service*) <https://www.ams.usda.gov/services/organic-certification> accessed 3 July 2021.

[108] Such as, a private action in tort law for the tort of intentional interference with economic relations, as was recognised in Canada, see: *A.I. Enterprises v Bram Enterprises*, 2014 SCC 12 (Supreme Court of Canada).

7.5.2.b Deception Concerns

The second pool of concerns that remains with my proposal is the concern that consumers and the public will be deceived, to varying degrees, by attestation marks. There are different ways in which consumers may be confused and think they have been deceived, and they vary with regards to both the degree of confusion and the form. Consider, for instance, the following three circumstances.

Firstly, there will be instances where a consumer will be confused and misunderstand a standard being communicated and feel deceived when no deception has taken place. While unfortunate, there is little role for trademark law in ameliorating this class of confusion. This type of scenario is part-and-parcel of a commercial marketplace where misunderstandings occur. There is nothing in current certification mark law, nor in my proposal, that would guard against such instances of confusion where the attestation mark owner plays in part in perpetuating a misunderstanding.

Secondly, there may be instances where a consumer relies on an attestation mark that has been appropriated or misused. This category of misunderstandings are, indeed, problematic—but again no more likely to occur under my proposal than in the current state of affairs. This type of misunderstanding requires that a mark owner effectively enforce their mark. A consumer's ability to rely on a presence of a mark as being used with the explicit permission of the mark owner is, further, equally true for ordinary trademarks as attestation marks. It may even be possible that under my proposed reform, where attestation mark owners are able to develop a brand more fulsomely around their mark, they will be *more* invested in the active monitoring and policing of their property required to make this expectation come to fruition.

Lastly, are the cases where the attestation source is insufficiently upholding their stated standards or are advertising an inaccurate standard. Under current rules, and despite existing statutory protective measures across jurisdictions, certification marks do not act as the robust vectors of truth in the market that one would expect, nor does trademark law prevent the use of pseudo-certification marks—some of which invariably would fit within the description of corporate 'washing' or less credible marks. Current certification mark law attempts to guard against marks that make insincere or unsubstantiated claims by requiring, in some jurisdictions for instance, that the standards underpinning the certification are reviewable by the registrar as part of the mark application process, and that the owner of the mark is 'competent' to certify the goods or services.[109]

This is the class of potential deception with which I am most concerned and most implicated by my proposal. This is because this type of deception is squarely within the paradigm of what certification marks may be seen as attempting to rebuke—the ability to make insincere or unsubstantiated claims about the nature of a product or certification.[110] This is also the class of problems that the existing proposals for certification mark law reform attempt to ameliorate. While existing mechanisms, and proposals, fall short of tackling this problem, my proposal in pivoting away from a view of certification marks premised on truth similarly fails to address this.

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[109] TMA 1994, sch 2, paras 5(1), 6, 7(1)(b) (UK). In the other jurisdictions of interest here, there are limited requirements on who may apply to own a certification mark other than that they do not carry on in the business of goods and services for which the mark is to be used. Presumably this statutorily required 'arm-length' is intended to, in part, safeguard against insincere marks.

[110] Although trademark regimes to prohibit misleading marks, see for instance as explained on UK Intellectual Property Office website instructing what can be registered as a trademark: 'Your trade mark cannot: be misleading, for example use the word "organic" for goods that are not organic.' See: UK Government, 'Register a Trade Mark' (*GOV.UK*) <https://www.gov.uk/how-to-register-a-trade-mark> accessed 2 February 2022.

As a brief aside, ordinary trademarks perform a quality function and can therefore be used legitimately in ways that have an air of quality assurance, in the form of first-party certification. The line between an ordinary trademark that legitimately engages in this practice for the benefit of their own range of products and what I call a pseudo-certification mark is razor thin. Engagement in this practice is so embedded within the structure of trademark law that, as discussed above, preventing the use of pseudo-certification marks would be a challenge.[111]

One obvious cost of my proposal, vis-à-vis the regulation of certification marks is that there will be no requirement for standards and regulations underpinning marks to be available to the registry.[112] Given how difficult it is for the average consumer to obtain a copy of the standards underlying these marks under the status quo, this does not practically pose a significant difference. Nevertheless, a corollary of not requiring the creation or sharing of the standards and regulations underpinning a mark is that these standards will not necessarily be concretised or made known publicly.

One obvious problem that flows from this is the inability to know what a standard is, or allow them to change frequently, can result in anti-competitive results.[113] To the extent this is a true competition problem, and not the spectre of a competition problem, I argue that this problem is more suitably dealt with under the ambit of competition law.

[111] As discussed earlier, in contrast to dealing with this problem by trying to bolster and differentiate pure certification marks from pseudo-certification marks, my proposal 'steers into the skid' and reduces complexity and redundancy by eliminating pure certification marks.

[112] As required currently required, for instance, the Canadian and American statutes require 'standards' and the British and EU statutes require 'regulations' see: Trademarks Act, s 30(2)(b) (Canada); EC EUTM Regulation 2017/1001, art 84 (EU); TMA 1994 Sch 2 para 6 (UK); 37 Code of Federal Regulations (CFR) §2.45 (US).

[113] Fromer (n 5).

Again, this is not a problem that exists by virtue of trademarks but rather the underlying certification as a private governance institution.[114]

The second problem that flows from losing the mandated sharing of standards, however, is on its face more problematic. That is that without a concretised and public set of standards, it is difficult to gauge deviation from intended messaging to received messaging. Furthermore, by proposing we recognise trust as the motivating feature of attestation marks, and not truth, the question of what the consequences are where a consumer's trusting expectation are is not fulfilled, or their trust is betrayed is left open.

To some extent, the paradigmatic cases of misleading standards will be an issue for consumer protection legislation. Neither certifiers nor brands can make inaccurate claims about their product on the marketplace without consumers having some sort of legal recourse. This problem exists irrespective of the mark used to convey accordance with any certification standard. Things get trickier, however, when the description is of a credence attribute of a product that is open to a degree of interpretation.

This brings us to my second point, which is where a legitimate trusting expectation of a consumer is betrayed or unfulfilled. For instance, where a consumer trusts a kosher mark to indicate that a product is healthy, and this is not what kosher marks seek to communicate, or where an attestation mark communicates that a product is environmentally preferable but are not *as* environmentally preferable as the consumer trusts it to be. This is an inevitable corollary of a system of communication premised on distinctive signs. Meaning is individuated. These may strike us as two different situations, but inherent in all trusting is *risk*.

Under a trust-driven framework, there is not intrinsic difference between a trusting expectation that is not met because a consumer was mistaken versus a trusting expectation unfilled because a consumer was misled. Similarly, there is no intrinsic difference between a trusting expectation that goes to the core understanding of what an attestation mark signifies, versus one that is more peripheral. Trust is trust.

This view is premised on the understanding that trademark law does not embrace a single moral theory, and that this is an element of trademark law that is of great value. Trademark law today is built on the appreciation that meaning is individuated and cultivated subjectively. Trademarks, thus, turn on individual meaning, and individuals do not uniformly care about the same things. While with attestation marks we may assume that the *majority* of reasonable consumers will form the same trusting expectation when viewing the mark there is nothing in the moral fabric of trademark law that requires this is so.

Rather, to require that trademarks advance a singular meaning that is understood objectively is to undermine the current trajectory of trademark law. There exists, for instance, a line of doctrine in the UK and the EU that recognises the various roles of functions of a trademark and that ultimately trademark law protects what people care about.[115] Trademark law is neutral in determining whether the endorsement of a celebrity

[115] As explained by Advocat-General Mengozzi in *L'Oréal v Bellure* a trademark can convey various kinds of information to consumers, and it is this capacity to communicate information pertaining to a range of attributes, including quality, trustworthiness, luxury, reliability etc merited protection: Case C-487/07 *L'Oréal v Bellure* [2009] ECR I-5185 [AG 54].

is of the same value as the quality of a product.[116] Rather, other areas of law and policy regulate the harm of relying on representations made, such as consumer protection regimes.[117]

Similarly, even attestation marks do not require an objective content or truth to be communicated. If attestation marks are sufficiently distinctive such that the attestation source is identifiable and distinguishable, then the certifying function can be achieved. Thus, there is no hierarchy of information nor is there a hierarchy of trusting expectations within trademark law. This leads us to two final thoughts. First, if we accept that there is no hierarchy of trusting expectations, then all trusting expectations are, as far as trademark law is considered, equal. Inherent in the act of trust is the risk of ones trusting expectations not being met. This begs the question, however, of what consequence is there for a consumer who has had this trusting expectation betrayed?

On the one hand, the consequence is no different than what is true for any relationship where trust has been betrayed—ruptured trust and perhaps a change in the assessment of trustworthiness. On the other hand, this does hint at a point of future development of trademark law, particularly around remedies, revocation, and defences. While outside the scope of this work, once we recognise the proper place trust has in motivating attestation marks (and trademarks at large) we can begin to consider how other

[116] Although David Simon has argued that a 'deception' analysis should reflect the nature of the risk posed by the trademark in question: 'This Article argues that trademark law should extend its risk-management role to cases where trademarks pose a risk of physical harm because they are deceptive. To better protect the public… when the product on which the mark appears poses a higher risk to public safety, courts should lower the standard of deceptiveness…'

David A Simon, 'Trademark Law & Consumer Safety' (2020) 72 Florida Law Review 673, 675.

[117] Thus, to the extent trust may be undermined by harm, consumer protection laws, of which the UK, US, Canada and the EU have varying but relatively robust regimes, step in.

doctrinal developments may be made to better recognise and protect this normative foundation.

Second, the violation of trust may also be a violation of some other legal right. This, again, is more appropriately dealt with under the purview of consumer protection law and contract law. For industries and sectors where truth has become murk and deception pervasive, we ought to encourage industry specific regulations. This is a way forward to what some may consider a problem of attestation marks and trademark law, but I think is more rightly regarded as consumer protection law. There have been instances where industry specific regulation has stepped in to regulate both the certification but related communications regarding certain attributes as has occurred in, for example, the organic and environmental preferability industry.[118]

7.6 Conclusion

In this chapter, I further developed my recommendation to abolish certification marks as a legal institution and set out my proposal for reform. That is, I recommended rather than adopt attempts to purify the certifying function within the certification mark law, certification marks, as a legal institution, ought to be abolished. Instead, ordinary trademarks ought to be embraced as marks capable of performing a certifying function, and that trademark law be developed to accommodate this function. I note that notwithstanding the various limitations of my proposal, allowing trademarks to continue as the sole form of attestation mark, and recognising and protecting the capacity of ordinary

118 Competition and Marketing Authority, 'Greenwashing: CMA Puts Businesses on Notice' <https://www.gov.uk/government/news/greenwashing-cma-puts-businesses-on-notice>.

trademarks to perform a certifying function, is the most justifiable way to reform certification mark law to be aligned with what I have identified as the core purpose of the certifying function: commanding relational trust.

While this conclusion finds support in examples of attestation marks already being used, these commercial practices do not motivate nor drive my proposal. My central argument, rather, is that when certification marks are conceptualised more aptly, particularly in recognition of the way that meaning has developed in our 21st century markets and society, *trust* plays a more crucial role in the understanding of the certifying function. It is this understanding of the certifying function as a vehicle for relational trust that ultimately inspires this reform. Unfortunately, this reform does not address the social problem addressed at the outset of this thesis. Particularly, consumers' desire to make purchasing decisions on the basis of product attributes and process attributes and the need to curtail insincere and misleading claims around a product's nature or a brand's socially responsible activities.

Consumers want to make decisions in the marketplace based on a wide range of information.[119] As discussed in Chapter 1, consumers are not always interested in the nature of the products they purchase alone; consumers have preferences for process attributes not just product ones.[120] Consumers are also interested in the brands they are purchasing from, and brands are becoming more vibrant, social, and political.[121] As brands showcase more of their political identities and undertake more social cause, consumers expectations of

[119] Fran Hawthorne, *Ethical Chic: The inside Story of the Companies We Think We Love* (Beacon Press 2012).

[120] Douglas A Kysar, 'Preferences for Processes: The Process/Product Distinction and the Regulation of Consumer Choice' (2004) 118 Harvard Law Review 525.

[121] As discussed in Chapters 4 and 5.

brands have shifted too. Consumers are interested in rewarding brands with their loyalty for a host of reasons that extend far beyond the nature of the products brands sell.[122] Consumers want brands to behave as socially responsible leaders in society, consumers want to *trust* brands to do what is moral and righteous.[123] This trust is, at times, at odds with consumers' desires for more information.

Against the backdrop of an ever-increasing range of factors in motivating a consumer's purchasing interests is the reality that our supply chains and markets are more complex. Consumers *need* some form of information intermediary if they are to navigate the onslaught of information available to them. While certification is one way to navigate this complexity of information, and the challenges posed by opaque supply chains and credence attributes, certification *marks* do not appear to hold up their end of the bargain.

Certification mark owners must put in time, investment, and maintenance into their marks comparable to that of an ordinary mark owner, yet their freedom and control over certification marks is comparatively curtailed. Certification marks are not *required* to incorporate into their sign information regarding what standard or characteristic they certify nor how. Several certification marks exist across the registries of the jurisdictions of interest here that do not convey anything about the standard in question. The ability of any certification mark, bare or robust, to transform a credence attribute into a search attribute is reliant on a consumers' individuated understanding of the certifying body, or

[122] As discussed in Chapter 6.

[123] Edelman, 'In Brands We Trust?' (2019) 2019 Edelman Trust Barometer Special Report; Edelman, 'Special Report: Brand Trust and the Coronavirus Pandemic' (2020) Edelman Trust Barometer 2020; Edelman, '2021 Edelman Trust Barometer Special Report Business and Racial Justice in Canada' (2021).

brand, behind the mark—the *attestation source*.[124] In this way, certification marks pose trouble to the search costs account; the prevailing, yet imperfect, account of trademark law.

The conventional justification for the protection of trademarks through law has long been that these marks allow our markets to behave more efficiently; the informational efficiency of such marks merits their protection as private property.[125] Yet, the suggestion that a certification mark can reduce search costs by communicating, at a glance, a range of qualities (and credence attributes at that) about a product is deeply inadequate. Certification marks, as previously discussed, are simply not required to signal the type or amount of information required to properly overcome the informational asymmetry gap with respect to credence attributes required to pass the muster of the search-costs account. Likewise, attempting to reform the ways in which we regulate certification marks (substantively or otherwise), is also problematic.[126]

While this thesis focused exclusively on certification marks and the role of trust in motivating and shaping the certifying function, the relevance of trust as a normative force runs deeper.[127] This is particularly so when we see how brands, as social objects, are the targets of trust, and how trademarks are required to sustain and nourish brands.[128] The relevance of brands, as viewed through this light, illuminates how viewing brands as

[124] As discussed in Chapter 2.

[125] William M Landes and Richard A Posner, 'Trademark Law: An Economic Perspective' (1987) 30 The Journal of Law and Economics 265.

[126] As discussed in Chapters 6 and 7.

[127] This is something I plan to explore in future works.

[128] As discussed in Chapter 4.

merely valuable assets or receptacles of reputation and goodwill is lacking. Brands can play a much more powerful, and pro-social, role in facilitating marketplace trust.[129]

Furthermore, when the role of brands is cast in this light, we can see why the discussion surrounding brands in the trademark law literature despite being so fulsome is so fraught. The relationship between brands and the protection of trademarks is a normative one. This conversation has been scaffolded over a prevalent account of trademarks, the search costs account, that is neither normative in nature nor widely accepted as satisfactory. Yet, the role of brands can be crucial in allowing consumers to develop instructive and appropriate trusting expectations, particularly with respect to attestation marks. The next step of this body of research will be to explore precisely how we may continue to develop our conceptualisation of trademarks, and develop trademark law more generally, to regulate trademarks and brands in accordance with the role of trust and trustworthiness.

[129] Particularly when we begin to recognize this and regulate trademarks in light of this role brands may play.

VIII. CONCLUSION

This thesis interrogated the nature of certification marks. I argued that the current practice and regulation of certification marks is misaligned with the fundamental nature of the certifying function—as a mechanism to signal trustworthiness and foster trust, and not truth. Accordingly, this project challenged the conventional account of certification marks, and demonstrated that signalling an attestation source is what lies at the crux of a successful attestation mark, and that this can be achieved by ordinary trademarks. I concluded by arguing that rather than reform certification marks to better centre the certifying function as a vehicle for trust, we ought to abolish certification marks. Instead, we ought to allow ordinary trademarks to perform the certifying function and develop trademark law to protect this function. I further argued that this approach is more congruent with the justifications of trademark law, and consistent with the nature of brands and brand meanings in the market.

In Chapter 1, I introduced the social problem of consumers desiring more marketplace information and transparency to make decisions which, among other things, rewards socially desirable corporate conduct. In Chapter 2, I described the state of affairs with respect to the laws and practice of certification marks. I focused on how certification marks are conceptualised as occupying a role in the trademark law landscape unique and apart from ordinary trademarks. I identified the essential function of certification marks, what I termed, the *certifying function*. I further provided an account of how this certifying function is manifested in practice across a spectrum, from bare to robust. In Chapter 3, I explained how the institutions associated with certification marks, both the private governance institution of certification and the institution of certification marks, do not harmoniously map on to the conception of certification marks envisioned by certification mark law.

In Chapters 4 and 5, I turned to consider the context in which certification marks and general trademark meaning currently exists, particularly with respect to brands. In Chapter 4, I set out to unpack the nature of brands, particularly with respect to their ontological relationship with marks. I suggested that while the signifier of a mark can evoke a brand, the signified of a mark can embody it. I further suggested we could understand brands as social objects with three key features or *hallmarks*. Namely, that all brands (i) have an impression, (ii) supervene on a touchstone object, that facilitates brands existing beyond the triadic structure of marks, and (iii) mediate relations. In Chapter 5, and against this backdrop of the nature of brands, I explored how the certifying function can exist alongside a brand impression. That is, how a certification mark can evoke and embody a brand such that the certifying function is imbued with brand meaning. I further demonstrated how, as a descriptive matter, ordinary trademarks at times perform a certifying function. The contributions of these chapters provided the concepts and language I needed to consider the certifying function more deeply.

In Chapter 6, I turned to consider how the certifying function is conceptualised under the conventional account of trademark law to signal objective, specific, and truthful information. I argued that despite the need for this sort of marketplace transmission of information to occur, certification marks are better understood as commanding trust. I argued that by appreciating the centrality of *relational trust* in motivating the certifying function, we could better understand the nature of the certifying function.

Recognising the critical role of *trust* in motivating the certifying function, and in particular its primacy over truth, informed my proposal for reform in Chapter 7 that we ought to abolish certification marks as a legal institution. I argued that rather than reform certification marks, substantively or by purifying the certifying function to enhance the truthfulness of these marks, we ought to embrace ordinary trademarks as the sole form of attestation mark and develop trademark law to accommodate this additional function. While there are already examples of the practice of pseudo-certification marks, which my proposal suggests ought to be the new norm, my proposal is motivated by normative arguments. That is, the ill-suitability of marks intended to convey truth being treated as private property, and the need to support and centre the role of trust in performing the certifying function.

As discussed in Chapter 7, my proposal for reform does not solve the need for increased transparency and accountability in our markets, particularly with respect to credence attributes and ethical market behaviour. However, I argue that my proposal to abolish certification marks, and recognise the role of trust in consumers reliance in marks, moves us in a desirable direction. Ordinary trademarks are already constituted to perform a certifying function, and trademark law is capable of incorporating recognition and protection for this function. This proposal inescapably relies on other areas of law to treat potential harms that may arise, particularly around competition and consumer deception. Nevertheless, abolishing certification marks and allowing trademarks to exist as the sole form of attestation mark, will result in a more authentic use of attestation marks, and ultimately a more integrated trademark law regime.

APPENDIX 'A'

Below is a list of some of the pseudo-certification marks registered in the UK.

No	UK IPO Trademark Number	Owner(s) names	Trademark
1	UK00002656190	Roundtable on Sustainable Palm Oil (RSPO)	CERTIFIED SUSTAINABLE PALM OIL RSPO
2	UK00003052876	Golf Environment Organization	GEO CERTIFIED
3	UK00003059355	Golf Environment Organization	OnCourse™
4	UK00003472535	Council For Responsible Jewellery Practices Limited	rj

5	UK00801103307	UL LLC	
6	UK00801103308	UL LLC	
7	UK00801149680	Stichting UTZ CERTIFIED	
8	UK00801171776	Roundtable on Sustainable Palm Oil (RSPO)	
9	UK00801336598	Signify Holding B.V.	

10	UK00902038784	USB Implementers Forum, Inc.	
11	UK00902805307	Rainforest Alliance, Inc.	
12	UK00902974905	FSC International Center gemeinnützige Gesellschaft mbH	
13	UK00903182037	DNV GL SE	

14	UK00903337185	Canadian Standards Association	
15	UK00903337623	Canadian Standards Association	
16	UK00903339579	Canadian Standards Association	
17	UK00903540978	USB Implementers Forum, Inc.	
18	UK00904137361	USB Implementers Forum, Inc.	

19	UK00905139563	SKYPE	skype Certified
20	UK00907593643	USB Implementers Forum, Inc.	SUPERSPEED CERTIFIED USB
21	UK00908187304	USB Implementers Forum, Inc.	SS
22	UK00908251571	GoodWeave International	goodweave
23	UK00908962391	Rainforest Alliance, Inc.	RAINFOREST ALLIANCE CERTIFIED

24	UK00911580941	USB Implementers Forum, Inc.	
25	UK00911796471	Marine Stewardship Council	
26	UK00912297735	USB Implementers Forum, Inc.	
27	UK00918007598	GoodWeave International	
28	UK00918148182	FSC International Center gemeinnützige Gesellschaft mbH	

29	UK00918148189	FSC International Center gemeinnützige Gesellschaft mbH	
30	UK00918255085	Sustainable Rice Platform e.V.	

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