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Gripe Sites & Trademark User Rights: Lessons from Canada's Cooperstock Case

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GRIPE SITES & TRADEMARK USER RIGHTS: LESSONS FROM CANADA'S *COOPERSTOCK* CASE

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This is a draft of a chapter that will appear in the forthcoming edited collection by Barton Beebe & Haochen Sun (eds), CHARTING LIMITATIONS ON TRADEMARK RIGHTS (Oxford University Press, 2022)

ABSTRACT

This Chapter is concerned with the nature of trademarks as vehicles of expression. It takes, as its lesson study, the unfortunate Canadian Federal Court case of *United Airlines v. Cooperstock* in which a disgruntled United passenger quite spectacularly failed in his efforts to defend a trademark parody on his consumer complaints “gripe” site. The case demonstrates the risks of relying on trademark law’s internal limits and implicit exceptions to define the boundaries of the trademark owner’s control. I argue, first, that the case therefore underscores the need for explicit statutory exceptions to ensure breathing space for parody, criticism, and other fair and expressive uses of protected marks. Second, the case reveals the need for a positive conception of “user rights” in the trademark scheme parallel to that already recognized in Canada’s copyright law. But finally, I argue, if user rights are to have any real traction in the legal landscape of trademark law, a fuller appreciation is needed of the communicative and social value of marks—not just as indicators of source and incubators of commercially valuable meaning, but also as public sites of dialogic engagement and discursive struggle. Canada’s *United* case is a paradigmatic example—and a cautionary tale—of what happens when owners’ rights are overprotected, users’ rights are disregarded, and trademark limits are irresolutely drawn.

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INTRODUCTION

Readers may have heard it said that bad cases make bad law; but sometimes good cases can make bad law too—and when that happens, the bad law becomes a particularly ugly authority. So it is, I fear, with the Canadian case of *United Airlines v. Cooperstock*¹—a case with the near-perfect set of facts to tee up a much-needed judicial statement defining the outer limits of trademark protection in Canada; but one that has, instead, trampled over those limits, reinforcing the fullest reach of trademark owners’ rights. This Chapter examines the unfortunate ruling with a view to identifying, not only the obvious flaws in the Federal Court of Canada’s doctrinal reasoning and the shortcomings of the statutory text that permitted them, but also the deeper pathology of a decision that defies the principled limits of trademark protection. It means to present Canada’s *United* case as paradigmatic example—and a cautionary tale—of what happens when owners’ rights are overprotected, users’ rights are disregarded, and trademark limits are irresolutely drawn.

Part I will provide the background and overview of the controversial case, pointing to the legal issues, arguments and judicial interpretations that present cause for concern. From overly expansive conceptions of trademark use to tenuous claims of confusion, and from dubious dilution claims to a total disregard for free expression, we will see how the plaintiff prevailed at every point along the path towards a finding in its favour. Part II will dig a little deeper to draw some important lessons from the *United* case. The case has revealed the weakness of trademark law’s so-called internal limits, which leaves them vulnerable and ultimately unfit for purpose, while external limits like the

¹ *United Airlines, Inc. v. Cooperstock*, 2017 FC 616, [2018] 1 F.C.R. 188 (Can.).

constitutional right of free expression failed to find any firm footing. The first lesson, then, is that trademark law requires explicit statutory exceptions, ideally in the form of a general fair use defence, to circumscribe the reach of the trademark owner's rights. The second lesson is that such limits and exceptions need to be recognized as *user rights* (as they have been in Canadian copyright jurisprudence) if they are to be an effective counterbalance against expanding owners' rights.

While such developments are sorely needed, however, they are likely insufficient to prevent similar rulings in the future. Underpinning the Court's reasoning throughout the judgment was an almost palpable disapproval of the defendant's critical engagement with the plaintiff's brand and the potential damage this posed to its economic value. As such, I will argue that what is really required—in Canada and elsewhere—is a departure from the loose proprietary logic that has, for too long, propped up trademark rights as intellectual *property* not to be trespassed upon. If the trademark system is to give adequate space to expressive uses of protected trade symbols (whether parodic, satirical, critical, or nominative), the infringement analysis needs to be reoriented away from proprietary entitlement and towards a concern with the communicative and dialogic nature of marks. It is in the expressive nature of commercial symbols as socially-situated speech that we should find the reason for—and so the limits of—the rights that trademark law affords.

I. THE UNFORTUNATE CASE OF *UNITED AIRLINES V. COOPERSTOCK*

A. *The Background*

Jeremy Cooperstock was, like so many of us, a disgruntled customer of United Airlines. Following an unhappy trip from Toronto to Tokyo, Cooperstock, who is a professor of engineering at McGill University, wrote twice to United to complain about his seating. After finally receiving a form letter in response, he posted the written exchange to his personal website under the title “Poor Show.” He soon began receiving letters from other unsatisfied travellers, which he added to the webpage. Within a year, he had launched UNTIED.com, a consumer criticism website (sometimes referred to as a “gripe site”) where visitors could read and submit complaints about United Airlines. Starting in 1997, the site amassed roughly 32,000 complaints from disconsolate consumers and employees.



Fig. 1. A portion of the home page of the UNTIED.com site (May 26, 1998)



Fig. 2. The Untied Logo as it originally appeared on the site (October 12, 1999)

UNTIED.com was, of course, a play on the name UNITED, chosen by Cooperstock to suggest the disconnection and disorganization that he perceived in the company.² After news of a corporate merger and redesign of the United logo in 2011, Cooperstock redesigned his own website logo accordingly, adopting the same color and font for the lettering, and mimicking United's blue globe image but with the pointed addition of a sad frowny face. Next to this, playing on US airlines' Star Alliance network, appeared the words: "AN EVIL ALLIANCE MEMBER."



from March 2011.



from September 2011.

Thereafter, Cooperstock received several communications from United demanding that changes be made to the appearance of the UNTIED.com website in order to reduce the potential for confusion in the minds of visitors. In response, he changed the colour of the "TI" in UNTIED and the frown face to red, and added a disclaimer disavowing any connection with the official United Airlines website.

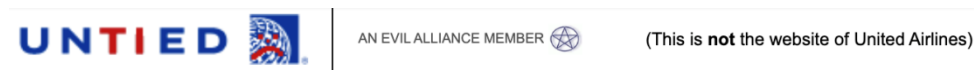


Fig. 5. Revised Untied.com logo and disclaimer, from October 2012.

Unimpressed by these modifications, United commenced an action against Cooperstock in the Federal Court of Canada for trademark infringement, passing off, depreciation of goodwill, and copyright

² *Id.*, para. 7.

infringement. Thereafter, Cooperstock added a pop-up disclaimer to his site explaining that the site, which “is not the website of United Airlines,” exists “only because of the airline’s outright hostility toward its passengers and many of its employees,” and requiring visitors to indicate their understanding or leave the page.³



Fig. 6. The pop-up disclaimer added to UNTIED.com after the action commenced in November 2012.



Fig. 7. What visitors now see at www.untied.com.

Cooperstock represented himself and appeared as his sole fact witness at trial. Justice Phelan of the Federal Court ruled that Cooperstock had infringed United’s trademarks and copyright, and issued an injunction restraining their use. An appeal of the decision, scheduled to be heard in December 2019, was discontinued after the parties reached a confidential settlement—one that presumably included taking down the gripe site. This was an unfortunate development. In the intervening period, recognizing the seriousness of the issues at stake, Cooperstock had been able to obtain pro bono legal representation, and the Federal Court of Appeal had granted intervenor status to the *Canadian Civil Liberties Association* and the *Canadian Intellectual Property and Public Interest Clinic*, each of which was prepared to argue in Cooperstock’s favour, citing user rights, the public interest, and freedom of expression.⁴

It might be tempting to assume that the lower court ruling will now be of little consequence—that it can be brushed aside as a single case with a self-represented defendant and an overly-censorious judge. But in Canada, trademark litigation is relatively rare, and Federal Court cases that directly address the interaction of trademark rights and free expression arise

³ See Daniel R. Bereskin QC, *United Airlines, Inc. v. Jeremy Cooperstock: A Critical Review*, 33 INTELL. PROP. J. 91, 94 (2020).

⁴ See Memorandum of Fact and Law of Samuelson-Glushko Canadian Internet Policy and Public Interest Clinic, *Jeremy Cooperstock v. United Airlines, Inc.* (Federal Court of Appeal File No. A-262-17), http://cippic.ca/sites/default/files/File/CIPPIC_memorandum_of_fact_and_law_-_FINAL_-_3_July_2018.pdf; Memorandum of Fact and Law of The Intervener, Canadian Civil Liberties Association, *Jeremy Cooperstock v. United Airlines, Inc.* (Federal Court of Appeal File No. A-262-17), <http://ccla.org/cclanewsites/wp-content/uploads/2018/07/UA-v-Cooperstock-CCLA-Memo-of-Fact-Law-FINAL-July-3-2018.pdf>.

infrequently indeed. As such, there is a real risk that this judgment will set the stage for the use of trademarks in critical or parodic speech for many years to come.⁵ And the unfortunate reality is that, in many respects, the ruling, though wrong, is far from anomalous in the Canadian trademark terrain. There is good reason for pessimism.⁶

B. *The Break Down*

Before we embark on our overview of the ruling, readers should note some trademark law's internal safety features. Trademark law in Canada contains very little in the way of explicit exceptions or defences.⁷ The limits of the trademark owner's rights are defined instead by the *scope* of the exclusive rights protected at common law or granted under the *Trademarks Act*,⁸ and owners' overreach prevented only by the consistent recognition of those limits. A variety of key requirements must be met in order to establish infringement or passing off, which should, in combination, carefully circumscribe the boundaries of the trademark owner's claim against unauthorized users. These limiting requirements relate to the mark that is being used; the goods or services in association with which it is used; the nature of the use; and the function or effect of the use.

So, for example, trademark rights extend only to uses of a mark in connection with "goods" or "services," from which it is understood to follow that infringing uses must be *commercial* in nature⁹—a conclusion shored up in Canada by the grounding of federal jurisdiction over trademark law in the constitutional power to regulate "Trade and Commerce."¹⁰ Non-commercial

⁵ I am thinking here of the unfortunate and longstanding authority of *Cie Générale des Etablissements Michelin-Michelin & Cie v. C.A.W.-Canada*, (1996) 71 C.P.R. (3d) 348 (Can. F.T.C.D.) [hereinafter *Michelin*], discussed *infra*.

⁶ Cf. Teresa Scassa, *Trademarks Worth a Thousand Words: Freedom of Expression and the Use of the Trademarks of Others*, 53 LES CAHIERS DE DROIT 877, 896 (2012).

⁷ Trademarks Act, R.S.C. 1985, c T-13, ss. 20(1.1), (1.2), (2) (Can.) (setting out limited exceptions for bona fide, non-depreciating use of personal and geographical names and descriptions, as well as exceptions for the use of utilitarian features and specific geographical indications). See David Vaver, *Towards a Distinctive Trademark Law for the 21st Century*, 30 INTEL. PROP. J. 183, 193 (2018) (aptly describing these as "two lonely subsections hidden away at the end of a long list of user taboos.")

⁸ Trademarks Act, R.S.C. 1985, c T-13, ss. 19, 20, 22 (Can.) (setting out the rights of registered trademark owners).

⁹ Trademarks Act, R.S.C. 1985, c T-13, s. 2 (Can.) (defining "trademark" as "a sign or combination of signs that is used or proposed to be used by a person for the purpose of distinguishing or so as to distinguish their goods or services from those of others.") See also *Michelin*, 71 C.P.R. (3d) 348, para. 40 (finding that "use" of the plaintiff's marks in a Union's campaign literature was not "use" in "advertising" because not in pursuit of profit).

¹⁰ British North America Act, 1867, 30-31 Vict., c. 3, s. 91(2) (UK). See *Kirkbi AG v. Ritvik Holdings Inc.*, [2005] 3 S.C.R. 302, 2005 SCC 65.

uses should therefore fall outside the scope of trademark protection. Nor do the trademark owner's rights extend to uses that fall outside of the technical definition of "use" under the *Trademarks Act*. This definition requires that a mark appears on the goods or is associated with them at the time of transfer, or that it is displayed in the performance or advertising of services.¹¹ For unauthorized use to infringe a registered owner's exclusive right, it is further required that the infringing use be use *as a trademark*.¹² Uses that are not for the purpose of, or likely to, identify the source of a product or service, are not uses *as a trademark*.¹³ Arguably, such uses can still depreciate goodwill,¹⁴ but they are otherwise beyond the reach of the owner's "exclusive right to the use throughout Canada of the mark,"¹⁵ as well as the right to prevent use of a confusing mark.¹⁶

Other defining limits to trademark rights flow directly from the specific grounds of infringement. Section 19's "double-identity" infringement requires use of the same mark as registered and in association with the same goods or services.¹⁷ Section 20's confusion infringement requires use of a "confusing" mark, of course, which means that the owner cannot prevent use of a mark unless it "would be likely to lead to the inference that the wares or services...are manufactured, sold, leased hired or performed by the same

¹¹ Trademarks Act, R.S.C. 1985, c T-13, s. 4 (Can.). See *Clairol International Corp. v. Thomas Supply & Equipment Co. Ltd.*, [1968] 2 Ex. C.R. 552 (Can. Ex. Ct.) (finding that only technical trademark uses within the meaning of section 4 could infringe the plaintiff's rights).

¹² See *MC Imports Ltd. v. Afod Ltd.*, 2014 FC 1161, para. 44 (Can. F.C.T.D), aff'd 2016 FCA 60 (Can. C.A.)

¹³ See, e.g., *Bombardier Ltd. v. British Petroleum Co.*, 1971 CarswellNat 511 (Can. F.T.C.D.) (WL).

¹⁴ Trademarks Act, R.S.C. 1985, c T-13, s. 22 (Can.) (prohibiting the use of a registered trademark "in a manner that is likely to have the effect of depreciating the value of the goodwill attaching thereto."). See *Clairol International Corp.*, [1968] 2 Ex. C.R. 552 (finding depreciation liability in respect of a hair color comparison chart that did not use plaintiff's mark as a trademark to identify source). But see also Daniel Bereskin, *Clairol Revisited: Trademark Rights v. Freedom of Expression and Competition in Canada*, 110(5) TRADEMARK REP. 809 (2020) (disputing the conclusion in *Clairol* that section 22 does not require use as a trademark); *Venngo Inc. v. Concierge Connection Inc.*, [2017] 146 C.P.R. (4th) 182 (finding no violation of Section 22 ostensibly because the "use" was not use as a trademark).

¹⁵ Trademarks Act, R.S.C. 1985, c T-13, s. 19 (Can.) (providing that registration "gives to the owner of the trademark the exclusive right to the use throughout Canada of the trademark in respect of those goods or services.").

¹⁶ *Id.*, s. 20(a) ("The right of the owner of a registered trademark to its exclusive use is deemed to be infringed by a person...who sells, distributes or advertises goods or services in association with a confusing trademark.").

¹⁷ *Id.*, s. 19. See, e.g., *Mr. Submarine Ltd. v. Amandista Investments Ltd.* (1987), [1988] 3 F.C. 91 (Can. C.A.) (holding that the extent of the exclusive right given by s. 19 is defined by the mark "as registered").

person.”¹⁸ The owner’s expansive rights under section 22 (Canada’s counterpart to the U.S. “dilution” provisions)¹⁹ extend only to uses of a “sufficiently well-known”²⁰ registered trademark “likely to have the effect of depreciating the value of the goodwill attaching thereto.”²¹ With or without registration, a passing off claim can extend only to uses of a mark with acquired reputation that amount to a misrepresentation likely to cause confusion and damage.²²

These built-in limits are fundamental to defining the trademark owner’s rights and ensuring the appropriate “balance between free competition and fair competition”²³—but, as the *United* ruling demonstrates all too well, they are also frustratingly fragile and prone to malfunction.²⁴

1. Use in Association with Services

Based on this brief catalogue of internal limits, Cooperstock’s first argument in his own defense is an obvious one: he had not “used” the UNTIED marks in “the sale, distribution, or advertisement of ‘services.’” While acknowledging that his website provided “services in the form of information delivery, advice on legal rights, and publication of complaints,” he argued that these were not commercial services of the kind covered by the *Trademarks Act*.²⁵

This argument, though quite clearly correct, was dismissed by Justice Phelan on the basis that “[t]here is no explicit requirement in the legislation of a monetary or commercial element to services.”²⁶ In support of the proposition that “‘services’ should not be given a narrow interpretation,” Justice Phelan cited a ruling in which a website that “offered services in the form of information and guidance to visitors” was found to be sufficient to establish “use” in Canada.²⁷ He neglected to note that the information offered in that case was specifically concerned with where to purchase a vast array of products being offered for sale in the United States by the second largest

¹⁸ Trademarks Act, R.S.C. 1985, c T-13, s. 6 (Can.) (defining when a mark or name is confusing).

¹⁹ Cf. Lanham Act, 15 U.S.C. § 1125(c).

²⁰ *Veuve Clicquot Ponsardin v. Boutiques Cliquot Ltée*, 2006 SCC 23, [2006] 1 S.C.R. 824, para. 46 (Can.).

²¹ Trademarks Act, R.S.C. 1985, c T-13, s. 22 (Can.). *See also* *Veuve Clicquot Ponsardin*, 2006 SCC 23, para. 46.

²² *Ciba-Geigy Canada Ltd. v. Apotex Inc.* [1992] 3 S.C.R. 120, 132 (Can.).

²³ *Mattel, Inc. v. 3894207 Canada Inc.*, 2006 SCC 22, [2006] 1 S.C.R. 772, para. 21 (Can.).

²⁴ Cf. Scassa, *supra* note 6, at 897 (2012) (describing the “fragility of the built-in limits on the scope of trademark rights” when it comes to protecting free expression).

²⁵ *United Airlines, Inc. v. Cooperstock*, 2017 FC 616, para. 32 (Can.).

²⁶ *Id.*, para. 33.

²⁷ *Id.*

sporting goods retailer in the world. In that case, it was said that “the Act makes no distinction between primary, incidental or ancillary services. As long as some members of the public, consumers or purchasers, receive a benefit from the activity, it is a service.”²⁸ Justice Phelan’s reframing, notably omits the mention of “consumers or purchasers” and concludes simply that “the key element of ‘services’ was the benefit to the public.”²⁹ By providing information that could benefit the public, then, Cooperstock’s free public service to disgruntled United customers (which the Court equated to a “consumer help line”) was caught, notwithstanding that he offered the public no commercial goods or services to which these information services could be said to be “ancillary.”

This finding, if followed, could extend trademark protection to cover informational and expressive uses of marks entirely untethered to any trade or commerce as such.³⁰ This is surely a startling development. Not only does it flout longstanding judicial recognition that “use” in association with “services” necessarily contemplates a commercial element,³¹ but it also disregards the constitutional limits of trademark protection—both in terms of the limits of federal jurisdiction and the right of free expression (to which we shall return).³²

²⁸ *Société Nationale des Chemins de fer Français SNCF v. Venice Simplon-Orient-Express Inc.* (2000), 9 C.P.R. (4th) 443 (Can. F.T.C.D.) (finding that it is not necessary to show a ticket sale to an ultimate consumer in order to demonstrate use in association with “railway passenger services.”).

²⁹ *United Airlines, Inc.*, 2017 FC 616, para. 33.

³⁰ *But see id.* (Justice Phelan cautioning that “services” should not be cast so broadly as to cover “any provision of information” but only “in certain circumstances,” which remained unspecified.).

³¹ *Clairol International Corp. v. Thomas Supply & Equipment Co. Ltd.*, [1968] 2 Ex. C.R. 55, para. 36 (Can.) (opining that “use” under s. 4 is confined to “use in the course of trading ... the statute being one relating to trade marks and unfair competition”); *Les Rotisseries St.-Hubert Ltée v. Le Syndicat des Travailleurs(euses) de la Rotisserie St.-Hubert de Drummondville (C.S.N.)* 1986 CarswellQue 91, para. 51 (Can. Qc Sup Ct) (WL) (finding that a trade union had not “used” a trademark because it was not engaged in the regular course of trade); *Michelin*, [1968] 71 C.P.R. (3d) 348, para. 40 (finding that a trade union had not “used” the employer’s trademark because handing out leaflets to recruit members does not qualify as commercial activity).

³² The constitutional significance of “wares or services” was hinted at in *Bell ExpressVu Ltd. Partnership v. Tedmonds & Co. Inc.*, 2001 CanLII 28350, para. 43 (Can. Ont. Sup. Ct.) (“The website does not promote wares or services...Rather, the website promotes criticism of the plaintiff as a commercial enterprise. In that regard, its function could be characterized as the exercise of free speech...”). *See also* *British Columbia Automobile Assn. et al. v. Office and Professional Employees’ Int. Union et al.*, 2001 BCSC 156, para. 153 (Can. B.C.) (finding that infringement requires a commercial element, the absence of which “would place an unwarranted restriction on free speech.”). In the US context, *see, e.g.*, *Radiance Foundation, Inc. v. National Association for the Advancement of Colored People*, 786 F.3d 316, 322 (4th Cir. 2015) (recognizing that a broad construction of “use in connection with goods or services” would “expose to liability a wide array of noncommercial expressive...activities” and thereby “push the Lanham Act close against a First Amendment wall.”). *See also* *Rogers v.*

Cooperstock further argued that he had not used the marks *as a trademark* to indicate the origin of goods or services. Justice Phelan was again unconvinced. Noting the similarity between the marks and their placement on the website, he found that the UNTIED marks would serve the purpose of indicating origin, bringing them within the ambit of the plaintiff's exclusive right. Cooperstock's explanation that he deliberately mimicked the appearance of the plaintiff's website for parodic effect was cited in the judgment as though it were a damning moment of self-incrimination.³³

2. Confusion

Confusion among consumers is “the grave iniquity against which trademark laws and jurisprudence are intended to guard.”³⁴ As the Supreme Court of Canada has stated, trademark law “is, in that sense, consumer protection legislation.”³⁵ And so, in *United*, it was claimed that consumers must be protected from the misapprehension that Cooperstock's website was operated by or in association with the plaintiff—something that, in Cooperstock's raw assessment, “you'd have to be..., you know, cognitively challenged...to believe.”³⁶

Once again, Justice Phelan regarded Cooperstock's stated intentions to be damning, noting that “the Defendant's obvious imitation of the United Marks and the United Website is meant to cause visitors to associate UNTIED.com with the Plaintiff.”³⁷ Indeed, he emphasized, Cooperstock's “core purpose” was that the visitors to his website would identify his symbols and name with the Plaintiff, as “[h]is efforts serve no other useful purpose.”³⁸ This is true; but it is also quite beside the point. Again, marks are confusing when their use “would be likely to lead to the inference that the goods or services associated with those trademarks are...performed by the same person.”³⁹ The UNTIED marks were designed to make it abundantly clear that United was the target of the complaints collected there, and in this sense, consumers would “identify” or “associate” them with UNITED—but this

Grimaldi, 875 F.2d 994, 998 (2d Cir. 1989); *Taubman Co. v. Webfeats*, 319 F.3d 770, 774 (6th Cir. 2003) (stating that the “Lanham Act is constitutional because it only regulates commercial speech.”).

³³ *United Airlines, Inc. v. Cooperstock*, 2017 FC 616, [2018] 1 F.C.R. 188, para. 40 (Cooperstock explaining, “I decided I could be far more effective in the parody by humorously mimicking the appearance, but with a twist on numerous elements of United's own website.”).

³⁴ Ann Bartow, *Likelihood of Confusion*, 41 SAN DIEGO L. REV. 721, 722 (2004).

³⁵ *Mattel, Inc. v. 3894207 Canada Inc.*, 2006 SCC 22, [2006] 1 S.C.R. 772, para. 2 (Can.).

³⁶ *United Airlines, Inc.*, 2017 FC 616, para. 46.

³⁷ *Id.*, para. 57.

³⁸ *Id.*, para. 68.

³⁹ Trademarks Act, R.S.C. 1985, c T-13, s. 6(2) (Can.).

kind of referential use is the opposite of confusing: it is pointing to the trademark owner not as the misrepresented source of the service, but as the explicit object of critique.⁴⁰

The multifactorial confusion analysis was off course from the outset, due to the mischaracterisation of Cooperstock's "services," but the error compounded with each step. First, in what is supposed to be a comparison of the respective strength of plaintiff's and defendant's marks, Justice Phelan spoke only of the significant acquired distinctiveness and longstanding use of United's trademarks. Then, when comparing the nature of services offered, he found a direct overlap because both parties "provide information to prospective travellers as well as post-flight engagement with United customers."⁴¹ Looking to the nature of the trade, he concluded that the character of the market for each was "identical" because consumers would reach both sites by searching online for "United" and "Complaints."⁴² Regarding the resemblance of the marks, the analysis acquired a copyright hue, noting that Cooperstock "took a substantial majority of the UNITED Mark" and "took the entirety of the Globe Design," and "admitted that he was aware that the Globe Design was from the United Website when he appropriated it."⁴³ The language of "taking" and "appropriation" cast United's claim over its marks in proprietary terms, while the notion of an "admission" again gestures at some inherently wrongful act to which Cooperstock accidentally confessed.

In considering surrounding circumstances, evidence of actual confusion by one travel agent who submitted a customer complaint to Untied.com in error, together with examples of letters addressed to the attention of United, confirmed for Justice Phelan that confusion was likely. Cooperstock's motives weighed heavily: "Although the Defendant's intent is not determinative in an action under section 20(1), [h]istorically, courts have been slow to conclude that a demonstrated piratical intent has failed to achieve its purpose."⁴⁴ To ascribe to the defendant a "piratical intent" is to cast him in the role of pirate or thief, intent on taking away from the rightful owner something to which he can lay no lawful claim. Framed in this way, of course, the finding of infringement naturally follows.

⁴⁰ See *United Airlines, Inc.*, 2017 FC 616, para. 53 (noting "Defendant *admitted* he wanted visitors to UNTIED.com to 'recognize the similarities to the target of my criticism' [emphasis added]). Cf. *Radiance Foundation, Inc. v. National Association for the Advancement of Colored People*, 786 F.3d 316, 328 (4th Cir. 2015) ("It is not immediately apparent how someone would confuse an article which is strongly critical of an organization with the organization itself. The mark in this case was used primarily to identify...the object of criticism... albeit by employing a modified version of the name.")

⁴¹ *Id.*, para. 49.

⁴² *Id.*, para. 52.

⁴³ *Id.*, para. 55.

⁴⁴ *Id.*, para. 68.

Similar contortions animated the Court's passing off analysis. Justice Phelan again wrote at length of United's commercial success, noting its estimated brand value of \$4.5 billion USD, the "significant resources" it devotes to its advertising and branding strategy, and how it "carefully controls the consumer experience of its branded spaces."⁴⁵ United was found to have proved the necessary likelihood of damage due to a loss of control over the brand, potential tarnishment of the UNITED mark, and depreciation of its acquired goodwill. Rather than an independent site for consumer information-sharing, Cooperstock's website was characterized as a "barrier" between United and its customers.⁴⁶ Thus, it was apparently assumed, the law must provide a remedy, in the form of an injunction, to protect the value of the brand by reinstating United's singular control over its marketing message.

A final argument advanced by Cooperstock was that the UNTIED marks were obvious "spoofs," which would be recognized as parody or satire in spite of the similarities. This was promptly dismissed as irrelevant: "As parody and satire are not defences to trademark infringement, the addition of the frown to the Frowning Globe Design on UNTIED.com does not avoid trademark infringement or passing off."⁴⁷ In this respect, the ruling is regrettably consistent with the sparse Canadian jurisprudence on point. Cited in support is the Federal Court case of *Source Perrier S.A. v. Fira-Less Marketing Co.*, in which an interlocutory injunction was issued to restrain the defendant from marketing bottled water with the name PIERRE EH!—a spoof on PERRIER and a satirical reference to then Canadian Prime Minister Pierre Trudeau.⁴⁸ There, it was found that deliberate similarities in the marks and packaging were "obviously meant to cause confusion. Otherwise, the spoof would not be a spoof." Moreover, the fact that the defendant intended to produce a spoof did "not take away from the deception created in the minds of the customers;" rather it was a "clear[] attempt[] to cash in on the well-established reputation of Perrier."⁴⁹ Also cited was a case involving a parody of the famous Canadian ROOTS clothing brand (featuring the name ROTS and a macabre looking beaver), where an injunction was granted because "notwithstanding that the defendant is obviously spoofing the plaintiff's trade mark he is also cashing in on the goodwill that the plaintiff has obtained for its trade mark."⁵⁰

⁴⁵ *Id.*, para. 76.

⁴⁶ *Id.*, para. 87.

⁴⁷ *Id.*, para. 83.

⁴⁸ *Source Perrier S.A. v. Fira-Less Marketing Co.*, [1983] 2 F.C. 18 (Can. F.C.T.D.).

⁴⁹ *Id.*, para. 11.

⁵⁰ *Green v. Schwarz* (1986) 12 C.P.R. (3d) 84, para. 5 (Can. Ont. H.C.J.). *Cf. Horn Abbott Ltd. et al. v. Thurston Hayes Developments Ltd. et al.* (1985), 4 C.P.R. (3d) 376 (Can. F.T.C.D.) (granting a permanent injunction against the makers of SEXUAL PURSUIT board game for trading on the goodwill and commercial success of TRIVIAL PURSUIT); *Subway IP LLC v.*

With this framing, parodic and satirical uses of a well-known trademark were reduced, in the eyes of the court, to an effort to benefit from the trademark owner's goodwill and misappropriate the fruits of the owner's investment in its brand. But if a spoof readily reveals itself as such to the ordinary consumer, then that consumer is not confused.⁵¹ If trademark law is, as Canada's Supreme Court has stated, consumer protection law aimed at preventing confusion and "get[ting] the consumer where they want to go,"⁵² then there is no reason to enjoin an obvious spoof. If anything, such an allusive use of the trademark reinforces the connection between the owner and the mark rather than undermining it.⁵³ But if trademark law is, alternatively, primarily concerned with protecting the owner's exclusive control over the meaning of the mark and preventing intrusions that might threaten the brand value in which it has invested, then such satirical uses take on the taint of misappropriation—and the law leaps to the rescue of the maligned trademark owner.⁵⁴

3. Depreciation

Even if Justice Phelan had remained unconvinced of the likelihood of confusion, United had another promising route to the injunction: the controversial claim of depreciation of goodwill, to which we now turn. As mentioned above, Section 22 of Canada's *Trademarks Act* gives to the registered owner of a well-known mark the right to prevent another person from using it in a manner likely to depreciate the value of the goodwill, even where that use is not confusing. I have previously warned that the potential scope of this statutory right is enormous, and clearly capable of extending to

Budway, Cannabis & Wellness Store, 2021 FC 583 (Can. F.C.T.D.) (finding a likelihood of confusion between SUBWAY for sandwich restaurants and BUDWAY for a cannabis store, noting that "the respondents have adopted their mark by deliberately drawing on the famous mark of the applicant.").

⁵¹ See, e.g., *Tommy Hilfiger Licensing, Inc. v. Nature Labs, LLC*, 221 F. Supp. 2d 410, 420 (S.D.N.Y. 2002) ("[D]efendant's use of the mark is an obvious parody or pun, readily so perceived, and unlikely to cause confusion among consumers"); *Vuitton Malletier v. Haute Diggity*, 507 F.3d 252, 261 (4th Cir. 2007) ("[T]he strength of a famous mark allows consumers immediately to perceive the target of the parody, while simultaneously allowing them to recognize the changes to the mark that make the parody funny or biting."); *Louis Vuitton Malletier, S.A. v. My Other Bag, Inc.*, 156 F. Supp. 3d 425, 441-44 (S.D.N.Y. 2016).

⁵² *Mattel, Inc. v. 3894207 Canada Inc.*, 2006 SCC 22, [2006] 1 S.C.R. 772, para. 21 (Can.).

⁵³ See Michael Spence, *The Mark as Expression/The Mark as Property*, 58 CURRENT LEGAL PROBLEMS 491, 498 (2005).

⁵⁴ See *Radiance Foundation, Inc. v. National Association for the Advancement of Colored People*, 786 F.3d 316, 328 (4th Cir. 2015) ("Intemperate and worse as the commentary is, holding it actionable risks creating the paradox that criticism equals confusion, thereby permitting companies to shield themselves from adverse assessments").

restrict basic competitive practices as well as commercial (and other) speech unless its meaning is kept firmly in check⁵⁵—fears that have now been realized in Cooperstock’s case.

First, it should be underscored, the extension of section 22 to cover non-commercial expression requires deliberate disregard for the limiting concept of “use.” A use need not be *as a trademark* in order to depreciate goodwill, but it must still be “use” *of a trademark*, in the technical sense: that is, use in association with goods or services in the course of trade. For this reason alone, Cooperstock’s website and logos should have been beyond the reach of United’s depreciation claim. As we have seen, however, the Court’s expansive concept of “services” allowed United to crash straight through this barrier.⁵⁶

According to the Supreme Court of Canada, in addition to use, a plaintiff pleading depreciation must also prove sufficient goodwill; a likely effect on that goodwill (i.e. a linkage or connection in the minds of consumers); and that the likely effect is depreciation of value (i.e. damage).⁵⁷ Justice Phelan had already found significant goodwill, of course, and once again quoted Cooperstock admitting his purpose (“to identify the target of [his] criticism as that of United.”) In Justice Phelan’s assessment, “[t]he Defendant therefore appropriated the goodwill associated with the United Marks.”⁵⁸ “Goodwill” has been defined in Canadian jurisprudence as “the positive association that attracts customers toward [the trademark] owner’s wares or services rather than those of its competitors.”⁵⁹ Depreciation of its value can occur “through reduction of the esteem in which the mark itself is held or through the direct persuasion and enticing of customers who could otherwise be expected to buy or continue to buy goods bearing the trademark.”⁶⁰ Drawing on US “dilution” jurisprudence, Canada’s Supreme Court of Canada has identified, as activities that could depreciate goodwill, “disparagement” or “tarnishing” of the mark through the creation of a negative association, as well as “blurring” or “whittling away” its power to

⁵⁵ See Carys Craig, *Perfume by Any Other Name May Smell as Sweet . . . But Who Can Say? A Comment on L’Oréal v. Bellure*, 22 I.P.J. 321, 332 (2010).

⁵⁶ *United Airlines, Inc. v. Cooperstock*, 2017 FC 616, [2018] 1 F.C.R. 188, para. 91 (restating the finding that “the Defendant has made use of the Plaintiff’s registered trademarks on UNTIED.com.”).

⁵⁷ *Veuve Clicquot Ponsardin v. Boutiques Cliquot Ltée*, 2006 SCC 23, [2006] 1 S.C.R. 824, para. 46 (Can.).

⁵⁸ *United Airlines, Inc.*, 2017 FC 616, para. 96.

⁵⁹ *Veuve Clicquot Ponsardin*, 2006 SCC 23, para. 50. See also *Clairol International Corp. v. Thomas Supply & Equipment Co. Ltd.*, [1968] 2 Ex. C.R. 552 at 573 (Can.) (Thurlow J. explaining that goodwill “consists of the whole advantage...of the reputation and connection, which may have been built up by years of honest work or gained by lavish expenditure of money and which is identified with the goods distributed by the owner in association with the trade mark.”).

⁶⁰ *Clairol International Corp.*, [1968] 2 Ex. C.R. 552, para. 42.

distinguish the owner's products.⁶¹ Readers will not be surprised to learn that the requisite depreciation of goodwill was found in Cooperstock's treatment of United's marks, but may still be taken aback by the terms (and tone) in which this harm was described:

The Defendant reproduces and disparages the Plaintiff's registered trademarks on UNTIED.com... Further, the crudeness of UNTIED.com is likely to depreciate the goodwill of United's marks. ...The unprofessional nature of the Defendant's website ... tarnishes the goodwill attached to United's trademarks.

Further, the Defendant's use...decreases the distinctiveness of the United Marks. The similarities...may discourage others from continuing their search for the Plaintiff's customer service website due to anger, frustration, or the mistaken belief that the Plaintiff does not have a "complaints" page.

Therefore, I find that the Defendant has intentionally attempted to attract the Plaintiff's online consumers to his own website for notoriety. In doing so, he has depreciated the value of goodwill attached to the United Trademarks contrary to s 22.

Justice Phelan's disapproval is palpable. The defendant's critical commentary and the sharing of consumer information is reduced to a personal quest to attract "notoriety" (since attracting custom is not applicable),⁶² and responsibility for anger or frustration felt by United's customers is placed onto Cooperstock's shoulders. Meanwhile, his efforts are diminished as "crude" and "unprofessional." Also worth noting is the continued creep of copyright morality. That the marks were "reproduced" should be of no concern to trademark law because the relevant wrong is not one of copying. Moreover, the notion that the distorted reproduction might "disparage" the rightholder has the rhetorical ring of a moral rights concern—except that here, the person claiming prejudice to their honour and reputation is a corporation, thereby implicating none of the relevant personhood concerns that underlie moral rights protections against reputational harm.⁶³ Cooperstock argued that the Court should distinguish between United's business reputation as a service-provider and the goodwill attached to its marks: his website might harm the former, but it would be "ludicrous" to suggest it depreciated the latter.⁶⁴ With the Justice Phelan's flat rejection of this distinction, the legal right to protect

⁶¹ *Veuve Clicquot Ponsardin*, 2006 SCC 23, paras. 64-67.

⁶² See *Clairol International Corp.*, [1968] 2 Ex. C.R. 552, para. 45 (finding a violation of section 22 because the defendants used the plaintiff's registered mark "for the express purpose of taking away custom enjoyed by competitors.").

⁶³ See Copyright Act, R.S.C. 1985, c C-42, ss. 14, 28.2 (Can.) (providing for an author's right to prevent mutilations or distortions of their work that prejudice their honor or reputation).

⁶⁴ *United Airlines, Inc. v. Cooperstock*, 2017 FC 616, [2018] 1 F.C.R. 188, para. 91 (Can.).

the value of goodwill in a trademark becomes the power to control corporate reputation by quashing critique.⁶⁵

4. Freedom of Expression

By now, readers may be wondering whether there is a constitutional right to freedom of expression in Canada, and if so, whether it would have occurred to Cooperstock, self-represented as he was, to argue that his rights would be violated by an injunction. There is, and he did. Section 2(b) of the *Canadian Charter of Rights and Freedoms* guarantees to everyone “freedom of thought, belief, opinion and expression, including freedom of the press and other media of communication.”⁶⁶ In two sentences, however, Justice Phelan dismissed Cooperstock’s contention that an injunction would limit his freedom of speech, and rejected the suggestion that freedom of speech was even “at issue in this litigation.”⁶⁷

Unlike the US First Amendment, Canada’s Charter divides the question of whether free expression is being restricted (under section 2(b)) from the determination of whether the restriction is nonetheless reasonable and justified (under section 1): any activity that conveys or attempts to convey meaning *prima facie* comes within the scope of the section 2(b) right;⁶⁸ but a law that limits free expression might be constitutionally valid if it falls within “such reasonable limits prescribed by law as can be demonstrably justified in a free and democratic society.”⁶⁹ To say that a law simply does not implicate the right of free expression, then, is to deny the expressive nature of the activity being enjoined, and so to sidestep the question of whether the law imposes a “justifiable” limit. It thereby avoids asking the question—an awkward one, to be sure, where section 22 is concerned⁷⁰—of whether the limitation is

⁶⁵ *Cf.* *Radiance Foundation, Inc. v. National Association for the Advancement of Colored People*, 786 F.3d 316, 332 (4th Cir. 2015) (“Trademarks do not give their holders under the rubric of dilution the rights to stymie criticism”); *New Kids on the Block v. News Am. Publ'g, Inc.*, 971 F.2d 302, 307 (9th Cir. 1992) (“Much useful social and commercial discourse would be all but impossible if speakers were under threat of an infringement lawsuit every time they made reference to a person, company or product by using its trademark”).

⁶⁶ *Canadian Charter of Rights and Freedoms*, Part I of the Constitution Act, 1982, *being* Schedule B to the Canada Act, 1982, c11, s. 2(b) (U.K.) [hereinafter *Charter*].

⁶⁷ *United Airlines, Inc.*, 2017 FC 616, para. 16.

⁶⁸ *Irwin Toy v. Quebec*, [1989] 1 S.C.R. 927 (Can.).

⁶⁹ *Charter*, *supra* note 66, s. 1. *See R. v. Oakes*, [1986] 1 S.C.R. 103 (Can.) (establishing as the criteria for satisfying section 1: a sufficiently important objective; a rational connection to the objective; impairing the right no more than necessary to accomplish the objective; and not having a disproportionately severe effect on persons to whom it applies.).

⁷⁰ If the objective is to protect both consumers and traders by preventing confusion in the marketplace, then evidently section 22 impairs free expression more than is reasonably necessary. *See generally* Scassa, *supra* note 6.

rationally connected to the objective of the legislation and minimally impairs the right of free expression.

Disappointing as this detour around free expression was, Justice Phelan was on well-travelled Canadian terrain here. Canada's courts have, thus far, been derelict in their duty to examine intellectual property laws through a constitutional lens.⁷¹ In the *Source Perrier* case, when freedom of expression was raised in defence of the PIERRE EH parody, the court dismissed it, opining:

[T]he most liberal interpretation of “freedom of expression” does not embrace the freedom to depreciate the goodwill of registered trade marks, nor does it afford licence to impair the business integrity of the owner of the marks merely to accommodate the creation of a spoof. It must be borne in mind that this application for an injunction does not originate from the targets of the parody ... but from the owner of the trade marks⁷²

Because it was the *owner* of a trademark who requested an injunction—someone trying to protect a property interest and not only to silence critique—section 2(b) was found not to be at issue. In other words, expression that might depreciate the goodwill of a registered trademark is not free expression: however broadly that freedom is construed, we are told, it could not possibly give the right to interfere with the value of intellectual property. A familiar tone of moral disapproval pervades this passage, with the “business integrity of the owner” being juxtaposed against the defendant's mere “creation of a spoof.” In this moral hierarchy, the injured corporate owner of intellectual property is lauded as deserving rightholder while the defendant's expressive efforts are trivialized and dismissed—predictably elevating property and diminishing speech.⁷³

The assumptions embedded in this IP/speech hierarchy were made even more explicit in the controversial *Michelin* case.⁷⁴ There, the defendant trade union argued that prohibiting the use of an employer's trademark in a

⁷¹ See Bitá Amani & Carys Craig, *The 'Jus' of Use: Trademarks in Transition*, 30(2) INTELL. PROP. J. 217, 255-57 (2018). In contrast, US courts have explicitly recognized and grappled with the potential clash between trademark and free speech protections. *See, e.g.*, *Radiance Foundation, Inc. v. National Association for the Advancement of Colored People*, 786 F.3d 316, 319 (4th Cir. 2015) (“Courts have taken care to avoid Lanham Act interpretations that gratuitously court grave constitutional concerns”); *Lamparello v. Falwell*, 420 F.3d 309, 313 (4th Cir. 2005) (“Congress “did not intend for trademark laws to impinge the First Amendment rights of critics and commentators”); *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 900 (9th Cir. 2002); *Rogers v. Grimaldi*, 875 F.2d 994, 998 (2d Cir. 1989).

⁷² *Source Perrier S.A. v. Fira-Less Marketing Co.* (1983), 70 C.P.R. (2d) 61, 67 (Can. F.T.C.D.).

⁷³ *Cf.* CARYS CRAIG, *COPYRIGHT, COMMUNICATION AND CULTURE: TOWARDS A RELATIONAL THEORY OF COPYRIGHT LAW* 211 (2011).

⁷⁴ *Michelin*, [1996] 71 C.P.R. (3d) 348.

union organizing campaign would be an unconstitutional restriction on the Charter right of freedom of expression. The Federal Court correctly found no trademark infringement in the absence of commercial use; but issuing the injunction for copyright infringement, the Federal Court reasoned that the defendants' right to free expression was not restricted: "The *Charter* does not confer the right to use private property - the Plaintiff's copyright - in the service of freedom of expression."⁷⁵ The same principles would have applied, the Court made clear, if trademark infringement had occurred: the right to freedom of expression cedes to the protection of intellectual property.

The *Michelin* ruling is over twenty years old and yet it continues to loom large at the intersection of freedom of expression and intellectual property in Canada.⁷⁶ I have argued elsewhere that the ruling rested on a misconstruction of the nature of intellectual property, its relationship to property and to constitutional rights.⁷⁷ Even if correct at the time, however, intervening developments in the Charter and IP jurisprudence present compelling grounds for concluding it is no longer good law.⁷⁸ While some Canadian courts have since given greater credence to the possibility of a conflict between trademark protection and freedom of expression, there remains a distinct ambivalence around the issue, and no direct engagement with the section 1 criteria for justifying trademark limitations on free speech.⁷⁹

⁷⁵ *Id.*, para. 85. Justice Teitelbaum explicitly stated that the conclusion would apply equally to the infringement provisions of the Trade-marks Act, at para. 82: "if I am incorrect in holding that there has been no infringement of the *Trade-marks Act*, the principles and outcome detailed below on the infringement of the *Copyright Act*, are equally relevant to the *Trade-marks Act*."

⁷⁶ See, e.g., *Corporation Sun Media c. Syndicat canadien de la fonction publique*, 2007 QCCS 2943, para. 32 (Can. Que.) (a Quebec Court ruled against strikers reproducing an employer newspaper's masthead on placards, reasoning that the injunction was not a limit on their free expression because use of another's property is a just limit on that freedom).

⁷⁷ Carys J. Craig, *Putting the Community in Communication: Dissolving the Conflict Between Freedom of Expression and Copyright*, 56 U. OF TORONTO L.J. 75 (2006); See also David Fewer, *Constitutionalizing Copyright: Freedom of Expression and the Limits of Copyright in Canada*, 55 U. Tor. Fac. L. Rev. 175 (1997); Jane Bailey, *Deflating the Michelin Man: Protecting Users' Rights in the Canadian Copyright Reform Process*, in IN THE PUBLIC INTEREST: THE FUTURE OF CANADIAN COPYRIGHT LAW 125 (Michael Geist ed., 2005); Bita Amani, *Copyright and Freedom of Expression: Fair Dealing Between Work and Play*, in DYNAMIC FAIR DEALING: CREATING CANADIAN CULTURE ONLINE 43 (Rosemary J. Coombe, Darren Wershler & Martin Zellinger eds., 2013).

⁷⁸ Graeme J. Reynolds, *Reconsidering Copyright's Constitutionality*, 53 OSGOODE HALL L.J. 898 (2016).

⁷⁹ See *Bell ExpressVu Ltd. Partnership v. Tedmonds & Co. Inc.*, 2001 CanLII 28350, para. 43 (Can. Ont. Sup. Ct.) (stating, with regard to a gripe site that included the trademark in its domain name, that "the website promotes criticism of the plaintiff as a commercial enterprise. In that regard, its function could be characterized as the exercise of free speech and, consequently, may well be said to be protected by virtue of Section 2 (b) of the *Charter of Rights and Freedoms*, although that issue was not raised before me."). But see also *United Food and Commercial Workers International Union v. Sigurdur (c.o.b. Members for Democracy)*, 2005

Michelin remains oft-cited and available as authority to support dismissing out of hand, as Justice Phelan did, the Charter's relevance to intellectual property rights and their enforcement.

Of course, it simply cannot be correct that the *Trademarks Act* takes priority over a constitutional right. This, as Jane Bailey pithily explains, would mean putting the statutory IP horse before the constitutional cart.⁸⁰ But the characterisation of trademarks as intellectual *property* allows the logic of private property to prevail, distorting the nature of the rights in the balance, and suppressing the essence of trademarks *as speech*. Rather than competing speech interests, then, the court sees parody versus property; rather than criticism, it sees misappropriation. And so infringement is found, and an injunction issued.

II. UNITED UNITED: LESSONS FROM COOPERSTOCK'S CASE

It should by now be clear that the internal limits of Canada's trademark law, described at the outset of Part I, simply failed and gave way in the *United* case. The concept of trademark "use" was stretched to capture a non-commercial activity; "services" extended to the provision of information for public benefit; "confusion" expanded to prevent an obvious parodic reference to the mark; and "dilution" was permitted to capture critical consumer commentary. Moreover, the external limits of trademark law found in the Constitution—the limited scope of federal jurisdiction and the fundamental right of free expression—also collapsed, with the latter being expressly dismissed as irrelevant. The case should therefore function as a vehicle for demonstrating the inherent weakness of relying on such implicit limits and exceptions to appropriately restrain trademark's reach. In Part II, then, my aim is to propose other routes towards adequately protecting the freedom to lawfully use a trademark as Cooperstock did: first, through the enactment of a statutory trademark fair use provision; second, through the recognition of lawful non-infringing use as a "user's right;" and finally through the normative shift to a communication theory of trademark law.

A. *The Case for Explicit Limitations*

The most obvious lesson to be learned from the *United* case is that explicit statutory exceptions and limitations upon trademark rights are essential

BCSC 1904, paras. 14-15 (Can.); *Law Society (British Columbia) v. Canada Domain Name Exchange Corp.* (2004), 243 D.L.R. (4th) 746, 753 (Can.) (finding that unmodified use of a trademark in a domain name can amount to passing off). *See generally* Scassa, *supra* note 6, at 887-89.

⁸⁰ Bailey, *supra* note 77, at 141-42.

to achieving the appropriate balance between protecting owners and users of trademarks. Conceptually, it is true that explicit exceptions are not required to render lawful activities that already occur outside the boundaries of the owner's claim to right. Practically and politically, however, the textual omission of such exceptions and the vagueness of these boundaries create the perfect conditions for over-claiming owners to succeed. As David Vaver notes, the failure to statutorily specify explicit exceptions means that they have to be "squeezed out of [the] Act...by a process of sophisticated, extensive, and expensive interpretation, making users look as if they are taking advantage of some loophole they have found only through the ingenuity of their lawyer."⁸¹ (This, of course, leaves little hope for the user without a lawyer.) In contrast, the Act sets out a broad list of owners' rights, which tend in turn to be expansively construed. In the wake of the *United* case, it is obvious that Canada's trademark regime now needs "an appropriate limitation infrastructure that is capable of counterbalancing the broad grant of protection."⁸² The CIPPIC intervenor factum in support of Cooperstock's appeal nicely captured the problem:

Unlike the Copyright Act, the Trademarks Act contains few explicit exceptions or user rights. This textual imbalance invites overreach: while the statute provides ample textual evidence of its objective, the lack of explicit acknowledgement of users offers courts few cues to constrain oppressive use of trade-mark rights.⁸³

If Canada is to shore up its trademark limits, a good starting point can be found in the US *Lanham Act* and the exclusions from dilution liability added in 2006.⁸⁴ Under these provisions, no actionable dilution can result from "any fair use, including a nominative or descriptive fair use, or facilitation of such fair use, of a famous mark" in connection with comparative advertising, "news reporting and commentary," "any non-commercial use of the mark," and—most notably for our purposes—"identifying and parodying, criticizing, or commenting upon the famous mark owner or the goods or services of the famous mark owner."⁸⁵ In the United States, these explicit exceptions have

⁸¹ Vaver, *supra* note 7, at 193.

⁸² Cf. Martin Senftleben, *Adapting EU Trademark Law to New Technologies: Back to Basics?*, in CONSTRUCTING EUROPEAN ON INTELLECTUAL PROPERTY 137, 176 (Christophe Geiger ed., 2013) (arguing that such a "limitation infrastructure" is needed in the context of EU trademark law).

⁸³ Memorandum of Fact and Law of Samuelson-Glushko Canadian Internet Policy and Public Interest Clinic, *supra* note 4, para. 14.

⁸⁴ Cf. Senftleben, *supra* note 82, at 172 (referencing Trademark Dilution Revision Act of 2006 (H.R. 683) amending the US Trademark Act of 1946 (15 U.S.C. 1125)).

⁸⁵ 15 U.S.C. § 1125 (C)(3).

enabled courts to better mediate the tension between trademark protection and free speech, permitting parodic plays on famous marks whether in service of commercial gain⁸⁶ or biting critique.⁸⁷ Such a provision, in the Canadian context, could at least have signaled to the court that Cooperstock's use of the UNITED mark to identify, comment on, and criticize the services offered by United Airlines should be a fair and lawful permitted use.⁸⁸

There are two important restrictions here, however, that mean Canadian policymakers ought to look beyond the US example in formulating a new fair use exception. First, the US exception is available only for uses "other than as a designation of source for the person's own goods or services."⁸⁹ As Stacy Dogan and Mark Lemley have noted in the US context, this unfortunately excludes cases where a critic or parodist is using the famous mark to brand his own products or services.⁹⁰ If Canada had an exception to depreciation liability crafted along similar lines, Cooperstock would have been entitled to benefit from it; however, the (mistaken) finding that he was using the mark as a trademark in association with services would have been sufficient to deprive him of those benefits. The other restriction, of course, is that the exception applies only to dilution by blurring or tarnishment, leaving open the risk of liability for confusion. While most parodies are by definition unlikely to confuse, confusion is a "fact-specific inquiry, often heavily reliant on manipulable survey evidence and subject to an ever-expanding notion of what it takes to confuse."⁹¹ The *United* case demonstrated the confusion doctrine's expansiveness and malleability. For this reason, too, even if Canadian law had included an equivalent exception, Cooperstock would likely not have been adequately shielded from liability.

What is really required in order to appropriately protect expressive uses such as Cooperstock's is a free-standing trademark fair use defence similar to the fair dealing defence found in Canada's *Copyright Act*.⁹² Such a provision could, for example, explicitly state that no registration of a trademark prevents a person from making any fair use, including a nominative or descriptive fair

⁸⁶ See, e.g., *Malletier, S.A. v. My Other Bag, Inc.*, 156 F. Supp. 3d 425, 433-38 (S.D.N.Y. 2016); *Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC*, 507 F.3d 252, 260 (4th Cir.2007).

⁸⁷ See *Radiance Foundation, Inc. v. National Association for the Advancement of Colored People*, 786 F.3d 316, 330 (4th Cir. 2015) (finding that replacing "Advancement" with "Abortion" in the National Association for the Advancement of Colored People trademark "falls plainly within the fair and noncommercial use exclusions.").

⁸⁸ See Bereskin, *supra* note 14 at 836-37 (proposing amendments to section 22 of Canada's *Trademarks Act* including the addition of explicit exclusions for parody, criticism, comment, and "any *bona fide* noncommercial or expressive use of a mark as a trademark or otherwise.").

⁸⁹ 15 U.S.C. § 1125 (C)(3).

⁹⁰ Stacy L. Dogan & Mark A. Lemley, *Parody as Brand*, 47 U.C. DAVIS L. REV. 473, 488, 503 (2013).

⁹¹ *Id.* at 487.

⁹² Copyright Act, R.S.C. 1985, c C-42, ss. 29, 29.1, 29.2 (Can.).

use, of a mark for purposes of parody or satire, criticism or review, news reporting, comparative advertising, or any non-commercial use. The assessment of fairness could, borrowing from the Supreme Court's copyright jurisprudence, involve consideration of the purpose and character of the use, the nature of the mark and the goods and services in association with which it is registered, available alternatives to the use, and its effect on the value of the goodwill attaching to the mark.⁹³ These factors would, of course, have to be analysed in light of the objectives of the *Trademarks Act*—in particular, the dual purposes of preventing consumer confusion and unfair competition—and with a view to *Charter* values including, most notably, freedom of expression. Even a small risk of consumer confusion, for example, would weigh against a finding of fairness in such an analysis, but it would not necessarily preclude fair use in cases where the countervailing speech interests are substantial.⁹⁴ Since copyright can vest in trademarks, as it did in the UNITED logos, thereby establishing a double layer of IP rights, an added benefit of enacting this kind of parallel fair use provision would be reducing the potential for trademark protection to undermine the carefully drawn limits of copyright control, and *vice versa*.

It should be emphasized that a fair use defence, drafted along these lines, would not be adding new exceptions into the trademark system or taking bites out of existing trademark rights; rather, it would be an explicit statutory foothold for users defending lawful activities that do not interfere with the existing rights and legitimate interests of the trademark owner, properly construed—and a clear cue to courts to appropriately constrain oppressive overreaching by trademark owners. As Canada's Supreme Court recognized in *Mattel*:

Trade-mark law rests on principles of fair dealing. It is sometimes said to hold the balance between free competition and fair competition.

Fairness, of course, requires consideration of the interest of the public and other merchants and the benefits of open competition as well as the interest of the trade-mark owner in protecting its investment in the mark. *Care must be taken not to create a zone of exclusivity and protection that overshoots the purpose of trade-mark law.*⁹⁵

⁹³ CCH v. Law Society of Upper Canada, 2004 SCC 13, [2004] 1 S.C.R. 339, para. 53 (Can.).

⁹⁴ See Dogan & Lemley, *supra* note 90, at 505 (suggesting that, in the case of brand parodies, “the risk of confusion...might be so small, and countervailing speech interests so substantial, that courts should dispense with analysis of likelihood of confusion.” (Citing Rogers v. Grimaldi, 875 F.2d 994, 999 (2d Cir. 1989)).

⁹⁵ *Mattel, Inc. v. 3894207 Canada Inc.*, 2006 SCC 22, [2006] 1 S.C.R. 772, paras. 21-22 (Can.) [emphasis added].

B. *Taking the User Rights Route*

Although explicit limits and exceptions are necessary to clearly demarcate the boundaries of the owner's zone of exclusivity, they occupy a negative space in the IP imaginary, and tend to be easily diminished or set aside in the face of positive claims of right. If owners' rights need an appropriate counterbalance in the trademark system, then "balancing owner rights against user exceptions is incongruous."⁹⁶ As Vaver has noted, it "starts off with the scales biased towards rights and against exceptions."⁹⁷ Trademark law requires not only the clear articulation of exceptions, then, but their recognition as positive user rights that form an integral part of the overall trademark system and its operation.

In the copyright context, the Supreme Court of Canada has famously effectuated this conceptual shift, consistently employing the term "user rights" since 2004 to describe any actions, including those covered by fair dealing and other exceptions, that users and the public may carry out without infringing the copyright owner's exclusive rights.⁹⁸ In the paradigm-shifting case of *CCH v. Law Society of Upper Canada*, a unanimous Court endorsed Vaver's assertion that "User rights are not just loopholes. Both owner rights and user rights should therefore be given the fair and balanced reading that befits remedial legislation."⁹⁹ Fair dealing was thus declared an "integral part" of the copyright scheme and awarded a "large and liberal interpretation in order to ensure that users' rights are not unduly constrained."¹⁰⁰

In the trademark system, there has thus far been no equivalent judicial acknowledgement of user rights as such. There is no obvious reason why not. Perhaps it is because the attendant concept of a policy "balance" has been framed, in trademark jurisprudence, as a matter of competition (free versus fair) and so cast in terms of the competing rights of traders, while the public's interest has been relegated to a mere proxy for confusion (relevant primarily for determining whether a trader's rights have been violated). The would-be rights-bearing "user," in this frame, is thereby reduced to either competitor or consumer. Perhaps (as I discuss further below) it is because the idea of the

⁹⁶ Vaver, *supra* note 7, at 192.

⁹⁷ David Vaver, *User Rights*, 25 INTELL. PROP. J. 105, 109 (2013).

⁹⁸ *CCH v. Law Society of Upper Canada*, 2004 SCC 13, [2004] 1 S.C.R. 339, para. 48 (Can.); *Alberta (Education) v. Canadian Copyright Licensing Agency (Access Copyright)*, 2012 SCC 37, [2012] 2 S.C.R. 345, para. 22 (Can.); *SOCAN v. Bell Canada*, 2012 SCC 36, [2012] 2 S.C.R. 326, paras. 9-10 (Can.); *Keatley Surveying Ltd. v. Teranet Inc.*, 2019 SCC 43, paras. 44-47 (Can.); *York University v. Canadian Copyright Licensing Agency (Access Copyright)*, 2021 SCC 32, paras. 90-95 (Can.).

⁹⁹ 2004 SCC 13, para. 48 (Can.).

¹⁰⁰ *Id.*, para. 51.

trademark has concretized into commercial property in the legal imagination, such that its significance as a vehicle of expression, information, or education has been more thoroughly obscured. Or perhaps, as Vaver suggested in 2018, there has simply not yet been, in Canadian trademark law, the same opportunity or impetus to cast user rights in such terms:

Canadian courts have not yet had the occasion or need to employ the language of user rights to describe what people other than trademark owners can legitimately do with or to trademarks. ...The presumption in favour of applying the same [user rights] policy to the [Trademarks Act] (and for that matter to other IP rights) seems nevertheless strong...and no apparent contrary trademark policy applies.¹⁰¹

A coherent picture of the centrality and significance of user rights within the trademark scheme—and across IP regimes more broadly—is nonetheless critical to ensuring that the proliferation of ever-expanding and overlapping rights does not interfere with the legitimate use of trademarks by competitors, traders, consumers, and the public at large. In *Théberge v. Galerie d'Art du Petit Champlain Inc.*, the pivotal case that laid the groundwork for the initial recognition of copyright user rights, the Supreme Court cautioned that “[e]xcessive control by holders of copyrights *and other forms of intellectual property* may unduly limit the ability of the public domain to incorporate and embellish creative innovation in the long-term interests of society as a whole, or create practical obstacles to proper utilization.”¹⁰² In the *United* case, excessive control by the trademark owner unduly limited Cooperstock’s ability to incorporate the trademark into his consumer complaint’s website in the creation of a pointed parody for the purpose of effective critique. This is the kind of obstacle to the proper utilization of IP-protected subject matter of which the Supreme Court warned, and yet the Federal Court concerned itself with the protection of only the trademark owner’s rights while perceiving no countervailing user rights against which to balance them.

It is to be hoped, then, that future courts interpreting exceptions and limitations within the *Trademarks Act* heed Vaver’s call to recognize user rights as such, and to give them a fair and balanced reading to temper the reach of owners’ rights, just as Canadian copyright jurisprudence has done for over fifteen years. It should not be hard to capture a coherent conception of user rights that transcends the boundaries of IP’s categories and safeguards the

¹⁰¹ Vaver, *supra* note 7 at 192-93. The necessary occasion seemed finally to have arrived when Cooperstock was granted leave to appeal, which is why the non-disclosed settlement with United Airlines Inc. was so disappointing to many observers and would-be intervenors.

¹⁰² [2002] 2 S.C.R. 336, 355 (Can.).

public interest and the public domain against IP enclosures more broadly. If copyright user rights are indeed a matter of right, then it makes little sense to permit trademark rights to simply override them. Moreover, it should be recalled, if the public domain is the default for free competition and free expression, it is not user rights that are the exception, but owner rights.

C. *From Dominion to Dialogue*

A final vital lesson can be pulled from the wreckage of the United ruling, however: even the enactment of explicit exceptions and the rhetorical embrace of user rights will be insufficient to prevent the overreach of trademark rights without a more fundamental shift in the normative and political discourse around trademark protection. The prioritization of IP protection over consumer critique and parody—over participatory consumer culture and free expression—allowed Justice Phelan to find for the plaintiff, not only in respect of the trademark claim, but also with regard to the copyright claim. This was notwithstanding that, in contrast to the *Trademarks Act*, Canada's *Copyright Act* contains an explicit fair dealing exception for parody, satire, criticism and review that is judicially recognized as a user right. Justice Phelan acknowledged the Supreme Court's instructions that "the provision for fair dealing should not be interpreted restrictively," and that "users' rights are an essential part of furthering the public interest objectives of the *Copyright Act*,"¹⁰³ and yet he went on to hold:

Parody is not simply a defence to copyright infringement – it is also an aspect of free speech. However, like all free speech, it is not unrestricted. The Defendant's website...is for the allowable purpose of parody, but it does not meet the second step of the test [i.e. fairness]. The questionable purpose of the dealing, amount of the dealing, and effect of the dealing all weigh in favour of the conclusion that this dealing is not fair.

Even in the copyright fair dealing analysis, the court viewed Cooperstock's expressive activities through the lens of United's proprietary claim over its trademarks and the value of its goodwill: rather than a critical parody of the "work," Justice Phelan saw an intent "to defame or punish the plaintiff;"¹⁰⁴ and rather than seeing a critical commentary that would have no

¹⁰³ *United Airlines, Inc. v. Cooperstock*, 2017 FC 616, [2018] 1 F.C.R. 188, para. 107 (citing *Society of Composers, Authors and Music Publishers of Canada v. Bell Canada*, 2012 SCC 36, [2012] 2 S.C.R. 326, para. 11).

¹⁰⁴ *United Airlines, Inc.*, 2017 FC 616, para. 125.

substitution effect in the market for the original work, he saw a risk of confusion that would harm customers' perception of United's services.¹⁰⁵ The protection of United's IP rights was therefore regarded as an appropriate restriction on the defendant's free speech rights.

I have argued elsewhere that the rhetorical embrace of user rights is not a panacea to the imbalance of the copyright system, and brings some additional risk of reifying individual rights claims rather than examining them in light of the social goals that the system is intended to serve.¹⁰⁶ The difficulty with the rights-balancing metaphor is that, by pitting owners against users, it is likely to produce a bald assessment of the relative importance of protecting owners' rights over users' rights rather than a careful consideration of the various interests at stake and the broader implications of ruling one way or another. And where the balancing act is presented as placing the plaintiff's property rights against the defendant's speech rights, on either side of the metaphorical scale, then, as we have repeatedly seen, the former will likely be attributed greater weight in the balance. Each of these concerns was borne out in Cooperstock's case.

The better approach, I believe, is to consider the appropriate scope of rights and interests with a view to the objectives of the law, the relationships it shapes, and the social values that it is intended to foster. In the trademark context, this means looking at the relationships between traders as competitors, but also the relationship between the trademark owner, consumers and the public at large. As Dev Gangjee has argued, a proprietary conception of the trademark owner's entitlement assumes a certain kind of relationship between a brand owner and the consumer that is inapt and anachronistic in the modern participatory economy. Gangjee criticizes a judicial approach (akin to Justice Phelan's) that regards the brand as "an object of property rights," and sees the "effort and investment by the trade mark owner to create the brand...as the basis for preventing the unauthorised misappropriation of brand image."¹⁰⁷ This proprietary paradigm, he explains, fails to acknowledge "that brand formation is dialogic and iterative, as opposed to being the result of a one-way broadcast."¹⁰⁸ Brands like United's are not generated by the singular efforts of the brand owner, but "are negotiated,

¹⁰⁵ *Id.*, para. 138 ("In this case, it is not the effect on the market that ought to be considered, but rather the confusion caused by the similarity between UNTIED.com and the United Website."); *See also id.*, para. 140.

¹⁰⁶ *See* Carys J. Craig, *Globalizing User Rights-Talk: On Copyright Limits and Rhetorical Risks*, 33 AM. U. INT'L L. REV. 1 (2017).

¹⁰⁷ *See* Dev S. Gangjee, *Property in Brands: The Commodification of Conversation*, in CONCEPTS OF PROPERTY IN INTELLECTUAL PROPERTY LAW 29, 58 (Helena Howe & Jonathan Griffiths eds., 2013), http://papers.ssrn.com/sol3/papers.cfm?abstract_id=2249765.

¹⁰⁸ *Id.*

context-sensitive and constantly reproduced by a range of actors.”¹⁰⁹ It is in the interaction between the corporate owner and the consumer that trademarks as brands are continually constructed and reconstructed through “social communication processes.”¹¹⁰

The significance of this social construction of brands explains why United would want to limit Cooperstock’s capacity to reconstruct the UNITED/UNTIED mark as something that has come undone. But it also underscores why United ought not to be permitted to invoke its brand *qua* private property in order to do so. The UNITED brand is necessarily open-ended and dynamic, not the singular static creation of United. The consumer is not reducible to a passive recipient of the brand owner’s intended messaging, but is a co-creator of the brand as a contested site of meaning that is always in flux. As Rosemary Coombe has explained, our engagement, as consumers and citizens, with commercial signs involves a collective *drive-to-meaning*: “the consumption of commodified representational forms is productive activity in which people engage in meaning-making to adapt signs, texts, and images to their own agendas.”¹¹¹ This is, of course, exactly what Cooperstock was doing.

When we regard the trademark in these terms, it ceases to resemble a static object of ownership. Situated in cultural context, the trademark is better understood as sign or text: a “signifier,” in semiotic theory;¹¹² or, in dialogic theory, an “utterance.”¹¹³ As such, it is never “monologic” (single-voiced) but is necessarily a site of discursive struggle.¹¹⁴ As Coombe cautioned, the protection that trademark law affords “may deprive us of the optimal cultural conditions for dialogic practice.”¹¹⁵ Certainly, trademark law awards the owner a privileged position in the public discourse, giving it the power to prevent others from making confusing uses of the mark that might harm its capacity to

¹⁰⁹ *Id.* See also Florian Martin-Bariteau, *The Idea of Property in Intellectual Property*, 52(3) U. BRIT. COL. L. REV. 891, n.20 and accompanying text (suggesting that a proprietary philosophy obscures the informational dimension of trademarks in cases like *Cooperstock*, where fundamental freedoms to access information and to express criticism are at stake).

¹¹⁰ *Id.* at 57.

¹¹¹ Rosemary Coombe, *Objects of Property and Subjects of Politics: Intellectual Property Laws and Democratic Dialogue*, 69 TEX. L. REV. 1853, 1863 (1990-1991).

¹¹² See generally Barton Beebe, *The Semiotic Analysis of Trade Mark Law*, 51 UCLA L. REV. 621 (2004).

¹¹³ See MIKHAIL M. BAKHTIN, *THE DIALOGIC IMAGINATION: FOUR ESSAYS* 354 (Michael Holquist ed., Caryl Emerson & Michael Holquist trans., 1981).

¹¹⁴ Notably, for Bakhtin, parody is the archetypal example of multivocal (double-voiced) utterance. See MIKHAIL BAKHTIN, *PROBLEMS OF DOSTOEVSKY’S POETICS* 194 (Caryl Emerson ed. & trans., 1984) (“[I]n all possible varieties of parodistic discourse the relationship between the author’s and the other person’s aspirations remains the same: these aspirations pull in different directions, in contrast to the unidirectional aspirations of [singled-voiced (monologic) discourse]).

¹¹⁵ Coombe, *supra* note 111, at 1866.

function as a distinctive communicator of meaning. But trademark law should not—indeed cannot—give the owner a monopoly on meaning.

Michael Spence has also argued that that language of property is inapposite to trademark law's task, producing a presumption that the trademark owner "ought, absent good reason to the contrary, to control all its potential uses"¹¹⁶—a presumption that pervades Justice Phelan's judgment. Palpable in the Court's reasons was the desire to grant strong protection to a highly valuable mark. This desire, Spence notes, reflects "the corollary of the property *topos* that investment should be protected."¹¹⁷ Spence similarly proposes a shift from what he calls the "property *topos*" to the "speech *topos*" as a way to both ground and limit trademark rights. Trademark law is "a regime concerned, at its very heart, with the regulation of speech," he argues, which has "important consequences for the interpretation of the legislative schema."¹¹⁸ Trademark law prevents potentially misleading commercial speech, of course, but also protects the owner's expressive autonomy. According to Spence, the owner should not be compelled to speak through others' unauthorized use of its mark or have its meaning "recoded;" but by the same token, its claim must be limited by the expressive autonomy of others who wish to allude to the mark, "especially where it is necessary for successful criticism of the mark, its owner or her goods or services."¹¹⁹ Regarded in these terms, Cooperstock's exercise of expressive autonomy established a just limit to the expressive autonomy of United, speaking as he was on his own behalf.¹²⁰

To Spence's position, I would add that expressive autonomy should be understood in relational terms: the concept of "autonomy within relations"¹²¹ places greater import on our essential interdependence, emphasizing that the act of communication is not an isolated exercise of individual autonomy but an interdependent process of exchange that is interactive and interanimating. While a property model understands the interaction of owner and user as one of exclusion and misappropriation, the communication model perceives that interaction as dialogic. This dialogic construction of meaning demands greater space for discursive struggle and the transformation or recoding of meaning as an exercise of expressive agency by the relational, socially-situated user.¹²² As

¹¹⁶ Spence, *supra* note 53, at 496.

¹¹⁷ *Id.* at 497.

¹¹⁸ *Id.*

¹¹⁹ *Id.* at 510.

¹²⁰ Spence may disagree, however, if he were to regard Cooperstock's speech as a recoding of the UNITED mark rather than a necessary allusion for comparison or cultural reference. *See id.* at 513.

¹²¹ *See generally* JENNIFER NEDELSKY, *LAW'S RELATIONS: A RELATIONAL THEORY OF SELF, AUTONOMY, AND LAW* (2011).

¹²² The proposed theory of trademark law centred on relations of communication rather than property draws on ideas that I have advanced elsewhere in respect of copyright law. *See, e.g.,*

such, it is this conceptual shift from dominion to dialogue that is, in my opinion, critical to redefining and appropriately delimiting trademark rights.

Recognizing the communicative function of the mark as its defining characteristic means recognizing its capacity to indicate not only the source of goods and services, but also all of the fluid meanings that emerge and evolve through our interaction with the mark, from producers' positive brand images to consumers' critical counter-narratives. As Teresa Scassa notes, it is precisely because the trademark is so "densely packed with meaning"—because of "the elliptical way in which [it] can convey complex messages"—that it is "an ideal vehicle for critical expression."¹²³ Outside of the trademark context, the Supreme Court of Canada has already recognized the social value of consumers' "counter-advertising activities" as a protected form of expression:

Consumers may express their frustration or disappointment with a product or service. Their freedom of expression in this respect is not limited to private communications intended solely for the vendor or supplier of the service. Consumers may share their concerns, worries or even anger with other consumers and try to warn them against the practices of a business. Given the tremendous importance of economic activity in our society, a consumer's "counter-advertising" assists in circulating information and protecting the interests of society just as much as does advertising or certain forms of political expression. This type of communication may be of considerable social importance, even beyond the merely commercial sphere.¹²⁴

It is only by denying the nature of a trademark as communication, in this sense, and instead treating it as a species of valuable private property to be controlled by the corporate owner, that Canadian courts have used trademark (and copyright) law to silence critical counter-messaging through the transformative use of commercial symbols. But if we expect the public to consume commodified signs, to assign value and meaning to them to the benefit of their owners, and to contribute to their construction and reconstruction, then we must respect that the public's reception and consumption of these signs will necessarily be a productive one: the very law that protects trademarks as sites of shared and shifting meaning cannot deny the public its informal discursive power to attach new meanings, use the signs in new contexts, discuss them, distort them, and critique them.

In the digital era, more than ever, it is the task of the trademark owner to engage effectively in this cultural conversation as a speaker in its own right,

Carys J. Craig, *Transforming "Total Concept & Feel": Dialogic Creativity and Copyright's Substantial Similarity Doctrine*, 38 *CARD. J. OF A. & ENT.* 603 (2020).

¹²³ Scassa, *supra* note 6, at 886.

¹²⁴ *R. v. Guignard*, 2002 SCC 14, [2002] 1 S.C.R. 472, para. 23 (Can.).

to attempt to create and maintain its desired meaning in the midst of this “heteroglossia” (the diversity of voices or clashing points of view that reside simultaneously within the mark).¹²⁵ It is not, and has never been, the task of trademark law to shield the trademark owner from this public discourse—under the pretence of preventing misappropriation—as the Federal Court sought to shield United from Cooperstock’s critique.

CONCLUSION

The problem that pervaded the court’s reasoning in *United Airlines, Inc. v. Cooperstock* was the perception of the United logos as valuable objects over which the corporate IP owner was entitled to exercise near-absolute control. The case reveals the flaw of relying on internal limits and implicit exceptions to circumscribe the scope of trademark owner’s control. It underscores the need for explicit exceptions that reflect the internal and external limits of trademark rights and ensure adequate breathing space for parody, criticism, and other fair uses and free expression. The case also reveals the need for a positive conception of “user rights” in the trademark scheme parallel to that already recognized in Canada’s copyright system. But if user rights are to have any real traction in the legal landscape of trademark law, Cooperstock’s plight suggests that a more fundamental shift is needed in the judicial mindset. Commodification has to give way to communication as a framing idea. Trademark law requires a fuller appreciation of the communicative and social value of marks as indicators of source and incubators of meaning, but also, therefore, as public sites of dialogic engagement and discursive struggle.

¹²⁵ Bakhtin uses the term ‘heteroglossia’ (or untranslated: *raznojazychie*) to capture the dynamic complexity and clamorousness of multivocal utterances: Mikhail Bakhtin, *Discourse in the Novel*, in *THE DIALOGIC IMAGINATION: FOUR ESSAYS BY M.M. BAKHTIN* 259, 271 (C. Emerson & M. Holquist eds., 1975).