Rebranding strategies and their boomerang effect - the curious case of Burberry

1. Introduction

The idea of protecting trade marks with reputation against dilution is justified, among other things, on the principle that it is only fair to reward the trade mark holder for her financial investment in creating a strong brand.1 The idea that the image and value of the trade mark are under the exclusive control of the trade mark holder, regarded by Gangjee as ‘the corporate or managerial approach to brands’,2 has been embraced by the Court of Justice of the European Union (‘CJEU’) in its decisions construing the European provisions regarding trade mark dilution.3 However, this approach has been rightly criticized in the literature4 considering that there are other factors equally important in the creation of the brand such as ‘the culture industries, intermediaries, such as critics and salespeople, and customers as individuals, but more significantly as communities’.5 Among these factors, the ‘immaterial labour of consumers’6 it is said to generate in relation to brands ‘a social relation, a shared meaning, or a sense of belonging’7 thus making the brand in question more valuable for its owner.8 While this ‘free labor is managed so that it comes to produce desirable and valuable outcomes’,9 under the dilution provisions it is trade mark owners and not consumers that are rewarded by trade mark law for ‘succeeding in creating a famous mark’.10

In this essay I intend to make a minimal contribution in support of these earlier, more complex and much better written works criticising law’s disregard of other factors equally important in creating a valuable and popular trade mark worthy of dilution protection. For this purpose, I will use Burberry as a case study to illustrate that in its recent branding strategies, this

---

3 See (n 1).
8 ibid.
9 Arvidsson refers to this value as ‘ethical surplus’. See Arvidsson, ‘Brands. A critical Perspective’ (n 6).
company capitalized on the immaterial contribution of its core consumers and on the values that consumers attached to historical events or particular lifestyles considered fashionable at a specific point in time. With this analysis I do not intend to argue that Burberry’s financial efforts in creating a strong brand were insignificant. What I want to highlight instead is that sometimes the image of a brand can get outside the control of the brand owner regardless of the efforts of the respective brand owner to position itself in a certain way on the market. This aspect is essential for the analysis of tarnishment and free-riding infringement cases because both the detriment to the reputation of the trademark and the taking of unfair advantages are assessed considering the image of the trademark. The reason I chose Burberry is that throughout its 150 years history, this brand faced several ebbs and flows in terms of both profitability and success in positioning itself as a luxury brand.11

I will begin my analysis in section 2 by presenting some of the patterns that guide the case law of the CJEU with respect to what the reputation of a trademark consists of and who is considered responsible for it. Section 3 presents Burberry’s branding strategies and the way in which this company exploited the effects of social, cultural and technological changes in order to create a powerful brand. The period from the establishment of the company in 1856 to the present day is divided into four phases and the analysis will proceed according to these phases.12 The examination will also bring to light the evolution of the notion of innovation, from the creation of tangible items (i.e. the patenting of gabardine in 1898) to the digitalization and thus the disembodiment of ‘many dimensions of the physical embodiment of the brand into the virtual world’.13 In section 4 I will bring together the arguments presented in the previous sections, concluding that sometimes the public’s perception of a brand’s image may be different from what the trademark owner wants it to be.

---


2. Stereotypes Relating to the Brand-Consumers Relationship

2.1 The Relationship between Trade Marks and Brands

Although there is no unanimously accepted definition of the brand,\(^{14}\) it is quite clear that this notion is not tantamount to registered trade marks. A registered trade mark is a sign which, if successfully registered, becomes personal property\(^{15}\) thus bestowing its holder with certain exclusionary rights. Such rights authorise the trade mark holder to prohibit any acts which are likely to hinder the trade mark’s ability to differentiate the products of one undertaking from those of another and to indicate the origin of the goods sold under the said trade mark.\(^{16}\) In contrast, the concept of a brand does not have a unique definition in law nor in another authoritative instrument.\(^{17}\) Nevertheless, the recent\(^{18}\) marketing literature has outlined the basic components of brands: ‘identity, functionality, symbol(ism), sustainability, differentiation, and value creation/delivery’.\(^{19}\) These features resulted from a historical analysis of the brand concept that has evolved over time as shown in the following paragraphs.\(^{20}\)

In the beginning of the 19\(^{\text{th}}\) century, ‘brand marketing’ involved the use of ‘brand identifiers’ (such as the names of the founders of a company or words that described the products of that undertaking which were most of the times the actual trade marks of the undertaking) without the intention of creating a particular brand personality outside the quality of the product.\(^{21}\) Apparently, the purpose of brands at that time was to support direct communication between customers and producers ‘through presentation, packaging and other media’.\(^{22}\) Later on, towards the end of the 19\(^{\text{th}}\) century, noticing that brands had the ability ‘to conjure feelings’,\(^{23}\) marketing techniques shifted focus. Thus, instead of promoting the quality of the products as the identity of the brand, branding strategies started to centre on ‘more psychological/anthropological examinations’.\(^{24}\) This was made possible through the use, in

---


\(^{15}\) S.22 Trade Marks Act 1994.

\(^{16}\) The original function of trade marks.


\(^{18}\) According to Hunt, the definition of ‘marketing’ is considered to have evolved over time. In this paper I will refer to marketing as ‘the performance of business activities that direct the flow of goods and services from producer to user’. See Shelby D. Hunt, ‘The Nature and Scope of Marketing’ (1976) 40 Journal of Marketing 17.

\(^{19}\) Tynan and others (n 17) 1157.

\(^{20}\) ibid.


\(^{24}\) Klein (n 23) 7.
advertising,\textsuperscript{25} of ‘the systemic use of strong emotional appeals like fear rage and love’\textsuperscript{26} which were said to ‘foster new forms of overall consumer behaviour regardless of the individual situation of consumers’.\textsuperscript{27} It seems, however, that the thing that contributed most to changing the content of the brand concept from something related to the quality of the products to something related to the feelings of those who bought them, was the phenomenon of mass production and its inevitable consequence of ‘mass consumerism which underpinned consumers society from the 1960s to the 1980s’.\textsuperscript{28} Berg argues that since the 1980s this ‘phenomenon of upscaling, branding and status seeking through consumer goods has intensified dramatically’.\textsuperscript{29} This sociological change generated a ‘consumer culture’ concerned with ‘the significance and character of values, norms and meanings produced’\textsuperscript{30} by consumers in the process of consumption.\textsuperscript{31} Lury, citing the work of Douglas and Isherwood explains that nowadays ‘consumption is to do with meaning, value and communication as much as it is to do with exchange and economic relations’.\textsuperscript{32} Thus, the content of the notion of brand, although not completely departing from the initial meaning of the brand seen as a source of origin and quality of the goods, came to embody ‘a person's gut feeling about a product, service or organization’.\textsuperscript{33} Nowadays, it is quite undisputed that the content of the brand is built via complex branding techniques which are seen ‘as a primarily communicative process that involves the efforts of corporations to shape human identity and influence the cultural and social landscape in order to sell consumer products’.\textsuperscript{34}

Such feelings or ‘future experiences and attachments’\textsuperscript{35} that consumers perceive in relation to a product or undertaking safeguarded via anti-dilution protection are triggered by what can be regarded as ‘the brand name’.\textsuperscript{36} The fact that the brand name (or its logo) coincides with the ‘name’ of the registered trade mark of an undertaking (especially in those cases when the trade mark contains a word element or a figurative element) represents another point of intersection between the world of trade marks and the world of brands. The existence of this junction provides a basis for trade marks to transform into something more than an origin indication sign. The same

\textsuperscript{25} As Klein correctly points out, advertising is only one of the various tools by which branding is done. See Klein (n 23) 5.
\textsuperscript{26} Adam Arvidsson, \textit{Brands Meaning and Value in Media Culture} (Routledge 2006) 44.
\textsuperscript{27} Arvidsson, \textit{Brands Meaning and Value} (n 26) 44.
\textsuperscript{28} Maxine Berg, ‘Luxury, the Luxury Trades, and the Roots of Industrial Growth: A global Perspective’ in Frank Trentmann (ed.), \textit{The Oxford Handbook of the History of Consumption} (OUP 2012) 177.
\textsuperscript{29} Berg (n 28) 177.
\textsuperscript{30} Burberry is a good example in this regard. As it will be shown in the sections below, the waterproof fabric patented by Thomas Burberry was one of a kind and its popularity was boosted by this.
\textsuperscript{31} Lury n (22) 44.
\textsuperscript{32} ibid 14.
\textsuperscript{34} Dennis K. Mumb, \textit{Organizational Communication A Critical Approach} (Sage 2012) 282.
\textsuperscript{35} Arvidsson, \textit{Brands Meaning and Value} (n 26) 8.
\textsuperscript{36} ibid.
can be said also for the costs invested in advertising which are no longer strategic costs and become an investment in ‘hard equity’.\textsuperscript{37} This adds a different type of value to the product, a value in the ‘form of immaterial capital’.\textsuperscript{38} While this process in which the trade mark signifies to consumers more than the origin of the goods may occur \textit{organically}, let’s say for example because of the innovative nature of the goods,\textsuperscript{39} more recently ‘creating associations between products is becoming established as the exclusive prerogative of the trade mark owner’.\textsuperscript{40} It could be argued thus, that the provisions regarding protection against dilution contribute to the transformation of the trade mark into a brand and to the preservation of the image of the brand as designed by the brand owner.

\subsection*{2.2 What is Trade Mark Reputation and Who Creates It According to the Law}

Under the European dilution provisions, the owner of a trade mark with reputation may prohibit the registration or use of a sign identical with, or similar to, her earlier reputed trade mark ‘irrespective of whether the goods or services for which it is applied or registered are identical with, similar to or not similar to those for which the earlier trade mark is registered’\textsuperscript{41} if ‘the use of the later trade mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark’.\textsuperscript{42}

In \textit{General Motors}, one of its first landmark decisions, the CJEU defined reputation as a ‘knowledge threshold requirement’,\textsuperscript{43} more specifically ‘a certain degree of knowledge of the earlier trade mark among the public’.\textsuperscript{44} While the CJEU stated that a certain percentage of knowledge may not be set by the court, it made clear that the part of the public concerned should be significant.\textsuperscript{45} The CJEU indicated that ‘it is only where there is a sufficient degree of knowledge of that mark that the public, when confronted by the later trade mark, may possibly make an association between the two trade marks, even when used for non-similar products or services,

\footnotesize
\begin{itemize}
  \item \textsuperscript{37} Klein (n 23) 7.
  \item \textsuperscript{38} Arvidsson, \textit{Brands Meaning and Value} (n 26) 7.
  \item \textsuperscript{39} Lury (n 22) 14.
  \item \textsuperscript{40} Celia Lury, ‘Trade mark style as a way of fixing things’ in Lionel Bently, Jane Ginsburg and Jennifer Davis, \textit{Trade Marks And Brands: An Interdisciplinary Critique} (CUP 2010) 212.
  \item \textsuperscript{43} Case C-375/97 \textit{General Motors Corporation v Yplon} SA [1999], para 22.
  \item \textsuperscript{44} \textit{General Motors} (n 43) para 23.
  \item \textsuperscript{45} ibid para 24.
\end{itemize}
and that the earlier trade mark may consequently be damaged’. The court clarified that the degree of recognition of the senior mark among the relevant public is one of the elements that determines the association between two trade marks or a trade mark and a sign.

The subsequent decisions of the CJEU however have further divided the analysis of the reputation requirement in two stages. After establishing that a trade mark is known by a significant part of the public, thus allowing the analysis of infringement to go forward, the reputation is re-assessed in order to determine whether it is the kind that may generate a link between the senior trade mark and the junior sign. Once the courts establish that the public is likely to associate the two trade marks because the reputation of the senior trade mark is strong enough, the same ‘strength of the reputation’ benchmark is used in order to assess to what extent one of the dilution harms is likely to occur. In this sense, in General Motors, the court consecrated the famous expression that ‘the stronger the earlier mark’s distinctive character and reputation the easier it will be to accept that detriment has been caused to it’. Consequently, a third role played by the reputation requirement may be deduced from CJEU’s reasoning, namely that reputation is the element of the trade mark that could be impaired through prohibited dilutive acts. In correlating reputation with the dilution harms, the CJEU promoted a coherent interpretation of the role of the reputation requirement. This interpretation of the role of the reputation requirement meant that reputation could have been assessed in a qualitative way, depending on the ‘specific content of the ‘reputation’ connected with the protected mark’.

However, in order to understand what the reputation of the trade mark consists of, it was necessary for the CJEU to lay down assessment criteria as the European dilution provisions did not offer any benchmarks for measuring reputation. Thus, in General Motors the court stated that in assessing trade mark reputation, all ‘elements of the case’ need to be considered.

---

46 ibid.
49 General Motors (n 43) para 24; the identical wording may be found in 50 decisions and opinions issued by the CJEU between 1999 and 2018. For example Sigla (n 1) 3; Case T-67/04 Spa Monopole v OHMI - Spa-Finders Travel Arrangements (SPA-FINDERS) [2005] ECLI:EU:T:2005:179.
50 Fhima, *Trade mark dilution in Europe* (n 47) 95.
52 General Motors (43) para 9.
Nevertheless, the court stressed the following factors: ‘market share held by the trade mark, the intensity, geographical extent and duration of its use, the size of investment made by the undertaking in promoting it’,53 In addition, the subsequent case law of the Member States and the decisions of the European Intellectual Property Office (the ‘EUIPO’) have brought to light other criteria such as: ‘the company’s turnover, unit sales, the actual degree of knowledge among the public’54 or the value associated with the mark obtained through licensing, merchandising and sponsoring.55

Even if the General Motors criteria have a guiding role and are not exhaustive, they are the most frequently used criteria in evaluating reputation.56 These criteria are deficient from two points of view. First, the image of the trade mark may be a powerful one (i.e. benefiting from a high degree of recognition) even in those cases when less consumers buy the respective good. This is specifically the case of luxury products in relation to which the brand owners try to ‘maintain low sales’.57 While in this case the EUIPO Guidelines contain a caveat in the sense that a ‘moderate market share will not always be conclusive against reputation’,58 the trade mark owner will still be required to show that her goods have a certain market share. Instead, what is indeed accurate in terms of assessing the brand image that is likely to be unfairly exploited (or tarnished as further explained below) is ‘the nature and scale of the promotional activities undertaken’59 for the purposes of creating ‘brand image and enhance trade awareness among the public’.60 The EUIPO Guidelines recognize these qualitative factors which may be employed to determine the reputation of the trade mark. The Guidelines further explain that scale of the promotional activities may be proved ‘directly, by reference to the amount of promotional expenditure, or indirectly, by way of inference from the nature of the promotional strategy adopted by the opponent and the kind of medium used for advertising the mark’.61

53 ibid para 27.
54 Fhima, Trade mark dilution in Europe (n 47) 55.
56 Fhima, Trade mark dilution in Europe (n 47) 53.
57 ibid 53.
58 European Intellectual Property Office (n 55).
59 ibid.
60 ibid.
61 ibid 24.
Secondly, expensive promotional activities are not always successful. This was certainly not always the case in relation to one of Pepsi’s £40 million ad campaign undertaken which faced a backlash from millennials, the advertisement’s target audience, and decreased the popularity of the promoted drink.\(^62\) The advert portrays US celebrity, Kendall Jenner, joining a peace march and handing a can of Pepsi to a law enforcement officer as a sign of unity and understanding. Irrespective of Pepsi’s intention, the advert was perceived as Pepsi attempting to free-ride on the popularity of the Black Lives Matter movement (a protest condemning police violence against black people in the US\(^63\)). Pepsi’s actions were severely criticized as ‘simplistic and inconsiderate’ by Black Lives Matter activists, which not only caused Pepsi to the withdraw the commercial, but also a decrease in ‘Pepsi’s Purchase Consideration score with millennials down from 27% to 24% from early April to mid-July’.\(^64\)

Thirdly, from the analysis of the criteria used to measure reputation it seems that the trade mark holder is the one who is considered the ‘author’ of the brand image and of the messages it conveys. This proposition has been confirmed by the CJEU in the *Sigla* case.\(^65\) Although in *Sigla* the CJEU refrained from pointing out the ‘communication function of trade marks’ which was later coined in *L’Oreal*, the court explained that ‘a mark also acts as a means of conveying other messages concerning, inter alia, [...] luxury, lifestyle, exclusivity, adventure, youth’.\(^66\)

At the same time, the CJEU has made it clear that such messages endow the reputed trade mark with an inherent economic value that must be protected via dilution provisions.\(^67\) Next, the court contended that in most cases ‘the reputation of a mark is the result of considerable effort and investment on the part of its proprietor’.\(^68\) Nevertheless, this ‘corporate or managerial approach to brands’,\(^69\) promoted by the CJEU seems to ignore other factors equally important in the process of successfully creating a specific image of the brand. For example, consumer movements seem to be growing stronger, contributing themselves to creating brand images

---

64 The purchase consideration is a metric that indicates consumers’ buying preferences. For the purposes of determining Pepsi’s purchase consideration, adults in the US aged 18–34 were asked the following question ‘When you are in the market next to purchase beverages from which of the following brands would you consider purchasing?’. See Marzilli (n 62).
65 *Sigla* (n 1).
66 ibid para 35.
67 ibid.
68 ibid.
69 Gangjee (n 2) 37.
regardless of the financial efforts or wishes of the brand owner. Hilton shows that over the past 30 years, a type of consumerism has developed, one ‘which is associated with ethical consumerism, green consumerism, and fair trade’.\textsuperscript{70} Moreover, consumers’ contribution in developing a valuable image of the brand is prominent in the case of luxury brands as well. In a 2010 study on how consumers of luxury brands 'co-created a superior value'\textsuperscript{71} for these products, the authors concluded that ‘the constellation of individuals in these value-creating networks [...] includes unofficial and official brand communities, experts including the curator of a national museum, designers across a range of fields, symbols of popular culture (namely an iconic 1960's fashion model, a renowned musician, a photographer, a graphic artist), as well as editors and journalists’.\textsuperscript{72} What is even more interesting for the topic discussed in this section, is the fact that the findings of the study referred to above showed that ‘customers of Brand X were the most involved in creating events for themselves through enthusiasts' international, national and regional events and meetings’.\textsuperscript{73}

In a nutshell the reputation of a trade mark contains messages regarding the qualities of goods as well as ‘images and feelings which it conveys, such as, for example, luxury, lifestyle, exclusivity, adventure, youth’.\textsuperscript{74} From this point of view, the content of the trade mark with a reputation overlaps to a certain extent with what a brand means as the notion of brand has been depicted in section 2.1 above. In the next sub-section, I will briefly present the three types of negative consequences that may occur in relation to the image of a trade mark which the law prohibits.

\section*{2.3 Damaging the Reputation of the Trade Mark}

Dilution protects trade marks with reputation against the taking of unfair advantages of the reputation or distinctiveness of the trade mark or detriment to the repute (tarnishment) or distinctiveness (blurring) of the trade mark with reputation. These are the three types of negative consequences, sometimes also called 'harms' that owners of reputed trade marks may prohibit. In this essay I will not focus on the content of reputation for the purposes of protection against dilution by blurring. This is because the provisions against blurring tend to protect the distinctiveness of the mark and not necessarily the reputation of the mark in the sense of the

\textsuperscript{70} Matthew Hilton, 'Consumer Movements' in in Frank Trentmann (ed.), \textit{The Oxford Handbook of the History of Consumption} (OUP 2012) 508.

\textsuperscript{71} Tynan (n 17) 1160.

\textsuperscript{72} ibid.

\textsuperscript{73} ibid.

\textsuperscript{74} Sigla (n 1) para 35.
image of the mark that conveys messages to the public ‘such as, for example, luxury, lifestyle, exclusivity, adventure, youth’ which are the focal point of the essay.

Given that the content of each harm has not been addressed by the European legislation, this task fell on the CJEU. In its landmark decision in *L’Oreal*, the CJEU explained that the taking of unfair advantage of the trade mark’s distinctiveness or repute, also known as ‘free-riding’ covers ‘cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation’. Further, the court maintained that this happens when third parties want to benefit from the power of attraction, reputation and prestige of the trade mark in question but without ‘paying any financial compensation’. At paragraph 49 of the decision in *L’Oreal* the CJEU explains that ‘the power of attraction, reputation and prestige’ is due to the ‘marketing effort expended by the proprietor of that mark in order to create and maintain the image of that mark’. This wording leads to the conclusion that what it is intended to be protected is the image desired by the trade mark owner, regardless of how the respective mark is received by the public.

On the other hand, tarnishment or the degradation of the trade mark with reputation, occurs ‘when the goods or services for which the identical or similar sign is used by the third party may be perceived by the public in such a way that the trade mark’s power of attraction is reduced’. The CJEU stated that ‘such detriment may arise in particular from the fact that the goods or services offered by the third party possess a characteristic or a quality which is likely to have a negative impact on the image of the mark’. For tarnishing purposes, the reputation of the trade mark consists either in its image or its power of attraction. Thus, the reputation of the trade mark, the element of the trade mark which may be harmed by the junior use, embodies what the trade mark conveys to the public. Although the decision in *L’Oreal* is quite controversial and rightly criticized, especially for the elusive way in which free-riding was described by the court, the court’s recognition of these features of the trade mark that refer to communication through advertising is only an observation of how consumers engage with brands nowadays, as described

---

75 ibid.
76 Case C-487/07 L’Oreal S.A. v Bellure N.V. and others [2009], para 39.
77 *L’Oreal* (n 76) para 39.
78 ibid para 41.
79 ibid.
80 ibid para 49.
81 ibid para 40.
82 ibid.
As it was discussed in the previous section, branding strategies use advertising to convey messages to the public, and the vessel by which they do so is usually the registered trade mark, whether it consists of - a verbal element or a logo. However, from the analysis of how the CJEU explains that trade mark degradation occurs, it follows that the way the public perceives the image of a brand is relevant but not for the purposes of establishing what the image of the trade mark is. The public perception is only considered when this perception is different from what the trade mark owner claims that the image of the brand is and necessarily as a result of an external intervention (i.e. the inferior quality of the products of the junior user that can generate negative associations). Recognizing the importance of the public’s perception in determining how tarnishment can occur should provide some food for thought. Thus, we can ask ourselves why the public’s perception of the brand image (and not what the trade mark owner says about how the brand is perceived by the public) should not be taken into account in the analysis of oppositions or infringement claims based on free-riding on tarnishment provisions. Among other things, this will be highlighted in the next section using the example of Burberry’s branding campaigns and their results over time.

3. Creating Britishness or Something Else?

3.1 Some Facts and Figures about Burberry

Burberry was established in 1856 in Basingstoke, England by Thomas Burberry. The first Burberry store was ‘selling men’s outerwear’, with the stated intention to ‘protect people from the British weather’. On 15 February 1987, Thomas Burberry, on behalf of T. Burberry and Sons successfully filed with the Patent Office in London, patent application no. 4065 for the ‘improved manufacture of drabbet cloth for gabardine fabrics’, ‘a fabric that was resistant to tearing; was weatherproof but was also breathable’. Burberry’s monopoly over this new and innovative fabric made of the company a frontrunner in the supply of endurance clothing. To this end, in 1901 Burberry was ‘commissioned to design new service uniform for British officers’. Next, in 1903 the company equipped Norwegian explorer Roald Amundsen during the latter’s crossing of the

---

84 Klein (n 23).6
87 Burberry (n 85).
89 Moore and Birtwistle (n 86).
Northwest Passage. Ten years letter, Burberry dressed Sir Ernest Shackleton for his expedition to Antarctica. The iconic Burberry coat made of the newly invented gabardine fabric ‘was adapted for the military’s office coat for a War Office commission in 1914’ and acquired the name of ‘trench coat’ following its associations with Burberry’s supply of rain coats for the military during the First World War. Next on Burberry’s list of high profile events involvement is the sponsorship of the 1937 ‘record-breaking flight from Croydon to Cape Town in an aeroplane called “The Burberry”’. While Burberry’s association with the events described above aimed at highlighting the quality and durability of the Burberry’s fabrics, at least to a certain extent, Burberry’s later associations occurred in slightly different though equally popular contexts. In 1942 Burberry coats were worn by well-known actors Humphrey Bogart and Ingrid Bergman in the Academy Award movie Casablanca and then in 1961 by Audrey Hepburn in Breakfast at Tiffany’s.

After being acquired in 1955 by Great Universal Stores, Burberry adopted a different type of public engagement as its business model focused on expanding to other geographic markets. To this end it started to license its trade marks to its subsidiaries in Spain and Japan. The number of Burberry trade mark registrations increased exponentially during 1960-1990, when 95 trade marks were registered by Burberry in the UK only. Despite this shift in its commercial strategy, Burberry’s historic tendencies to have its name associated with topical events and popular figures did not phase out. In 1964 the British Women’s Olympic team wore Burberry outfits for their publicized visit to Buckingham Palace. In 1968, Burberry’s photoshoot for magazine adverts took place at the recently inaugurated Hayward Gallery on London’s Southbank. It is submitted that ‘this particular venue helped the company to associate itself with an absolutely up-to-the-minute element of British culture – the contemporary visual art

91 Weston (n 11) 101.
92 ibid.
94 Moore and Birtwistle (n 86) 412.
95 Burberry (n 85); Figure 2.
97 Nebahat Tokatli, ‘Old firms, new tricks and the quest for profits: Burberry’s journey from success to failure and back to success again’ (2012) 12 Journal of Economic Geography 55, 57; Figure 3.
99 Sijuwola (n 96) 32.
100 Tokatli (97) 57.
101 According to EUIPO, Burberry had 252 trade marks registrations in the UK during 23 July 1909 and 7 October 2019.
102 Weston (n 11). Figure 6.
103 Weston (n 11) 118. Figure 7.
exhibition’. Other efforts aimed at allowing Burberry to benefit from a positive image transfer included the hiring of Lord Lichfield, a cousin of Queen Elizabeth II, as the company’s photographer and the use of Sherlock Holmes in one of their commercials. Sadly however, these latest attempts of Burberry to capitalise on the popularity of others were considered unsuccessful.

The company’s most notorious crisis in 1997 resulted in a decrease in profits from £62 million to £25 million. This downturn forced the company to undergo a significant transformation of its business model. The change started in the same year with the appointment of Rose Marie Bravo as the company’s CEO. Burberry’s new management focused, on the one hand, on updating the company’s brand image. In this sense, model icon Kate Moss became the focus of Burberry’s advertising campaigns as it will be further detailed in the next sections, as opposed to the previous ‘fashion-conservative men’ centred advertising campaigns. In addition, Bravo decided to ‘introduce lower cost product lines into the mainstream collection’ in an attempt to broaden the brand’s customer base. Although initially the repositioning campaign had promising results, the strategy was considered to ‘backfire’. In 2003 the brand became associated with football hooligans and the so called ‘chav’ culture. Furthermore, self-induced tarnishment and blurring contributed to the deterioration of the brand’s perception, the Burberry trade marks being widely licenced, including for products inconsistent with the luxury appearance of the brand such as dog diapers. The erosion of the brand’s premium image led to a significant drop in sales for the British household name, in some cases even by 40%. This called for a brand revitalisation process that successfully began in 2006 when a new CEO was

104 ibid.
105 ibid.
106 ibid.
107 Moore and Birtwistle (n 86) 412.
108 ‘Burberry. Fashionable from the 1920s through the 1960s, Burberry declined with deferential society but it is now reborn’ Marketing (1 August 2002) 17.
109 Moore and Birtwistle (n 86) 414.
110 ibid.
111 Weston (n 11) 175.
112 Moore and Birtwistle (n 86) 415.
115 Pike (n 93) 120.
appointed. This time, however, the branding strategy focused on integrating the historical heritage of the brand in its communication strategy and popularizing it through a digital agenda. The results of the campaign spoke for themselves: in 2015, Burberry achieved the highest rating in its recent history in terms of brand value. Moreover, in the same year Burberry managed to reach ‘a 10-year track record of dramatic growth in revenues, profitability, and market capitalization, even after accounting for the costs of resurrecting’. Today, Burberry is the proud owner of 122 registered trade marks in the UK, 59 at the level of the EUIPO and 63 at the level of the USPTO.

In the following sub-sections I will analyse Burberry’s advertising strategies as portrayed in the press (both print and online) adverts in parallel with the trends existing at that time in marketing and social communication in advertising. I have decided to only focus on this type of advertising as it is submitted that ‘Burberry’s preferred promotional media were newspapers and magazine advertisements, and in the late nineteenth and early twentieth century the company produced almost no ‘designed’ packaging’. The aim of this review is to investigate why consumers’ engagement with this brand was different despite Burberry’s attempt to keep up with the trends.

### 3.2 The Product Manufacturing Era

In the product manufacturing era beginning in the 1900s and ending approximately in the 1960s, at the macro level, companies’ competitive advantages relied heavily on their ‘manufacturing strength’. During this period, ‘the roles and functions of advertising’ were still confined to selling ‘products directly by informing or in some cases educating buyers about how to live better’. Until the 1930s, advertisers preferred ‘a product-focused descriptive rational approach due, in part, to embarrassment over the frequently dishonest ‘bombast and ballyhoo’, circus style

---

119 Weston (n 11) 217; Weinman (n 13) 110.
121 Weinman (n 13) 114.
122 In total 252 registrations.
123 Weston (n 11) 101.
126 Beard (n 125) 216-17.
entertainment and patent medicine advertising of the nineteenth century in their communication strategies. The analysis of three ads featured by Burberry in fashion magazines before 1910 shows that this company was also trying to emphasize in its commercial messages the superior qualities of Burberry products. Under the slogan ‘Burberry for the moors’, these ads depict women trying to protect themselves from the wind and rain. The commercial messages that accompany these images speak about the superior properties of the Burberry clothing which keeps them dry in case of rain and consequently kept the body temperature at a healthy level. Later, in the 1910s, in the context of Britain’s involvement in the wars that took place in that decade, the fact that Burberry was providing gear for the British Army was at the forefront of Burberry’s communication campaign. The silhouette of a military man appears on an advertisement featured in a 1910 magazine accompanied by a message describing Burberry’s reliability in relation to clothing for war, irrespective of climate.

Nonetheless, Burberry has not positioned itself to the public only as Army’s preferred supplier. In a 1918 ad under the slogan ‘The 1918 Burberry. The New Weatherproof Service’, Burberry promises to its customers that the 1918 Burberry coat can be made available to them ‘as supplied to His Majesty the King’. Hence, during that difficult period, although they did not give up the idea of highlighting the superior quality of their products through magazine advertisements, it looks like Burberry tried to also capitalize on topical events and situations, probably to benefit from a transfer of popularity. According to Weston’s findings in her thesis examining how Burberry metamorphosed from a ‘semi-rural craft-based’ business into a ‘successful, global luxury fashion brand in the 21st Century’ during this period in which Burberry’s apparently benefited from positive associations, the company has entered the Government’s spotlight for exploiting women in illegal working conditions at its factories. At that time, the public disclosure of these practices may not have necessarily had a significant impact on the brand’s image and may not have had any effect on the purchase consideration among consumers. But nowadays, when society is ‘marked by the popularity of the boycott’, such information would have the potential to contribute to the deterioration of the image of such a brand, irrespective of how luxurious the undertaking is.

127 Beard (n 125) 217.
128 Figures 1 and 2, Appendix.
129 Figure 3, Appendix.
130 Figure 4, Appendix.
131 Weston (n 11) 6.
132 Ibid.
133 Weston (n 11) 107-08.
134 Hilton (70) 514.
The advertisements featured in magazines in the 1920s continue to spread the company’s initial message regarding the weatherproof and weightless qualities of the Burberry clothing. But many of the ads from the 1920s also portray groups of people having a great time while skiing and hints to the idea that Burberry provides adequate clothing for winter and field sports thus endorsing this type of lifestyle. Later, in its ads during the 1930s, the frequency of the words ‘quality’, ‘style’ and ‘distinction’ distinguish themselves. While still portraying elegant figures in its ads in the 1940s, Burberry seems to position itself as the efficient choice for consumers on a budget.

Beginning with the 1950s, several changes occurred in the way advertising practices are applied. Leiss, Kline and Jhally in their book on social communication in advertising identified the ‘evolution of cultural frames for goods in relation to the development of media, marketing and advertising’ by analysing historical magazine advertising and advertising practices during 1890-1980. According to these authors, the 1950s were characterized by behaviourist marketing strategies and personalization in advertising strategies. Moreover, the topics covered in commercials during this decade include to ‘glamor, romance, sensuality, black magic, self-transformation’. Burberry’s magazine ads during this period do not seem to reflect any of these themes that apparently were popular in the 1950. On the contrary, most of its ads feature traditional couples and sometimes even the motto ‘A Family Tradition’.

3.3 The Product Distribution Era

During the 1960s until 1990, ‘global connections and transportation systems make distribution key’ in terms of competitive advantages. At the same time, this period is marked by the establishment of a consumer culture in most industrialized countries, including the UK. Trentmann explains that this was possible because the phenomenon of consumption ‘in the 1970-1980 appeared in a new positive light. It was hailed as a source of creativity and meaning central to social relations and identity formation’. According to the sociologists of the time, this new

---

135 Figure 6, Appendix.
136 Figures 7 and 8, Appendix.
137 Figure 9, Appendix.
138 Figure 10, Appendix.
140 Leiss and others (n 139) 328.
141 ibid 329.
142 Figure 11, Appendix.
143 Grant (n 12).
144 Beard (n 125) 218;
mode of consumption during the 1970s also gave rise to the phenomenon of ‘cultural class’,\(^\text{146}\) a ‘component group within a modern society that has a shared pattern of consumption’.\(^\text{147}\) Hence, starting with the 1960s the transition from a behaviourist approach to marketing to a market segmentation based one began.\(^\text{148}\) Market segmentation is ‘the process of breaking down the total market for a product or service into distinct sub-groups’.\(^\text{149}\) This is generally necessary because in this way ‘the company is best able to serve in such a way that pressure from competition is minimized’.\(^\text{150}\) From the perspective of the advertising strategies, during the 1960s until 1990, they were focused on lifestyle, and the main themes addressed in advertisements were ‘activity (person / thing) leisure, health, groups, friendship’.\(^\text{151}\)

Burberry’s intention to persuade the public to become part of a particular group, namely the group that adopts the ‘Burberry look’, is conspicuous in its advertisements in fashion magazines between 1960 and 1980.\(^\text{152}\) In this sense, the tag line ‘The Burberry Look’ is pervasively accompanying the images portrayed in these magazine ads. However, according to Weston, these images ‘seemed old fashioned, often depicting a gentle and cozy middle-aged, middle-class, semi-rural life’.\(^\text{153}\) At first glance, it seemed that Burberry was doing things by the book, adapting its communication strategy to the trends in advertising that suggested that commercial messages portrayed in advertisements must induce the idea of a certain lifestyle to which consumers to aspire and belong. However, the lifestyle that Burberry was proposing was not necessarily appealing to consumers. In his work on branding and origination, Pike points out that Burberry’s image of that period was perceived as dying, lacking in innovation and lacking in style.\(^\text{154}\) Burberry’s image problems did not stop there: since the 1980s, excessive licensing of the brand in Asia and Europe (including for coasters, whiskey and umbrellas), although apparently bringing in sales, has diluted the ‘brand’s meaning and value’.\(^\text{155}\) Thus, the end of the product distribution era caught the Burberry brand in a ‘relative decline’,\(^\text{156}\) one in which it had lost its component of ‘luxury exclusivity and premium pricing’.\(^\text{157}\)

\(^{146}\) Leiss and others (n 139) 304.
\(^{147}\) Ibid.
\(^{148}\) Ibid; Beard (n 125) 218.
\(^{149}\) Paul Reynolds and Geoff Lancaster, *Marketing* (Routledge 2013) ch.5.1.
\(^{150}\) Reynolds and Lancaster (n 149).
\(^{151}\) Leiss and others (n 139) 329.
\(^{152}\) Figures 12 and 13, Appendix.
\(^{153}\) Weston (n 11) 118.
\(^{154}\) Pike (n 93) 120.
\(^{155}\) Ibid.
\(^{156}\) Ibid 130.
\(^{157}\) Ibid 123.
3.4 The Information Era

During the 1990s until the 2010s, having control over information flows was regarded as a company’s main competitive advantage.\textsuperscript{158} In the early 1990s, Burberry kept in its ads the already 30 years old ‘The Burberry Look’ tag line.\textsuperscript{159} By the end of the 1990s, however, and during the 2000s, with Bravo’s arrival as Burberry’s CEO,\textsuperscript{160} model Kate Moss started to dominate the company’s ads campaigns. And not only that, she was often photographed among groups of young and uninhibited people.\textsuperscript{161} In one ad, Kate Moss poses in a bathing suit made of the famous Burberry check, thus breaking the pattern of a traditionalist image.\textsuperscript{162} Bravo’s marketing strategy considered, among other things, the combination of novelty elements with those aspects that made the Burberry brand a symbol of Britishness (i.e. ‘black taxis or red telephone box’\textsuperscript{163}). The new image of the brand conveyed through the advertisements in fashion magazines, jointly with other measures of branding such as ‘brand association and placement among global celebrity’\textsuperscript{164} and marketing have been successful in creating a revitalized and aspirational image of the brand.\textsuperscript{165}

The joy did not last long because in 2004 the image of Burberry seemed to temporarily escape the control of the company. This happened because football hooligans adopted this style of clothing that was perceived as higher class and expensive for the purpose of ‘avoidance of police attention’.\textsuperscript{166} Thus a connection ‘between the brand and incidents of football hooliganism’\textsuperscript{167} was created. However, the scepticism related to Burberry clothing was not just a change of perception among the population. A network of bars and several other bars in Leicester have announced that they shall ban people wearing Burberry clothes from entering their premises.\textsuperscript{168} It all culminated with the statement that ‘many bar owners in Scotland felt that’ Burberry has become the badge of thuggery’.\textsuperscript{169} Weston analysed this phenomenon in depth, investigating the special police forums at the time of this conflict. In this regard, Weston points out that ‘the link between Burberry and hooliganism persisted, as these posts on the Police Specials Forum confirm’.\textsuperscript{170} One of the

\textsuperscript{158} Grant (n 12).
\textsuperscript{159} Figure 14, Appendix.
\textsuperscript{160} Weston (n 11) 123.
\textsuperscript{161} Figure 15, Appendix.
\textsuperscript{162} Ibid.
\textsuperscript{163} Pike (n 93) 123.
\textsuperscript{164} Ibid.
\textsuperscript{165} Ibid.
\textsuperscript{166} Weston (n 11) 188.
\textsuperscript{167} Ibid 189.
\textsuperscript{168} Ibid, Figure 16, Appendix.
\textsuperscript{169} Weston citing The Guardian.
\textsuperscript{170} Weston (n 11) 189.
participants in this forum quoted by Weston indicates that hooligans could be easily be identified among others as a result of wearing Burberry caps.

This is a very eloquent example to show that despite a luxury and refinement image that the owner of a brand promotes in her marketing strategy, and especially in her advertising campaigns, consumers may sometimes counter such desired image. At the same time, this example should give us something to think about when we are faced with the question of determining the image of a brand that is tarnished or unfairly taken advantage of. Indeed, it is hard to believe that in a context similar to the one presented above a new market entrant would like to be associated with a brand tarnished by a category of consumers with a bad reputation. What is however interesting is that this conflict between what Burberry wanted to communicate through its brand and what Burberry actually meant for UK consumers has led to a drop in demand for Burberry products, particularly in central London.\textsuperscript{171} Thus, consumers’ perception of the brand had a direct effect on the ‘economic behaviour of other consumers’. This example should therefore be a convincing argument in support of the idea that when a brand’s reputation needs to be proven, it is not enough for the person claiming tarnishment or free-riding to prove only how it has positioned her brand. It is even more relevant to see how the brand was received and perceived by the public. On the other hand, this example seems to confirm the assertion that, mainly at that time, those who lost controlled over the communication channels suffered negative consequences.

\subsection*{3.5 The Customers Era}

‘It is a time where profitability is a result of customer happiness. It is an age where the customers are the CEOs’ is the statement made in 2016 by the brand director of the largest supermarket chain in Singapore.\textsuperscript{172} It appears that during this ‘era’ which allegedly began in 2010 and continues today, the competitive advantage of a company is given by the undertaking’s success in engaging with its customers.\textsuperscript{173} The communication between companies and their customers has been bolstered by the World Wide Web where ‘emerging social networks offered the chance not just to advertise to consumers, but also to converse with them’.\textsuperscript{174} Digital platforms such as Facebook, Twitter, Instagram, Google, etc., not only connect consumers with the brand, but offer the brand the opportunity to obtain 'addressability at scale',\textsuperscript{175} considered in reality the real competitive

\begin{flushleft}
\textsuperscript{171} ibid 191.
\textsuperscript{173} Grant (n 12).
\textsuperscript{174} Mark Tungate, \textit{AdLand – A global History of Advertising} (2nd edn, KoganPage 2013) 201.
\textsuperscript{175} Craig Dempster and John Lee, \textit{The Rise of the Platform Marketer} (Wiley 2015) 3.
\end{flushleft}
advantage that a company can create nowadays.\textsuperscript{176} This happens through ‘the application of data and analytics to the digital audience platform marketplace that is now at a massive scale’.\textsuperscript{177} Nowadays Burberry is considered a ‘heavy user of analytics to understand shifts in consumer preferences and behavior, such as changing product or color preferences, items bought together, or growth in online purchasing’.\textsuperscript{178}

In its advertising campaigns, Burberry continued its tradition of being associated with the ‘it’ women and men. In 2010 they managed to co-opt Emma Watson, the lead female actor in the Harry Potter cult series, and in 2012 the then British rising stars Cara Delevingne and Eddie Redmayne.\textsuperscript{179} Next, Romeo Beckham was featured in 2013 in their ad campaigns targeting a younger but yet ‘sophisticated’ audience.\textsuperscript{180} The years 2014-2015 were marked by a reunion of the past with the present: 90s icon model Naomi Campbell is brought back to the spotlight by Burberry. The same comeback is enjoyed by Kate Moss, who appears alongside Cara Delevingne, promoting Burberry’s perfume called ‘My Burberry’. Nonetheless, Burberry did not given up on positioning itself as a conservative and rather traditional brand.

Thus, among the various ads featured during 2010 and 2019, Burberry continues to promote a somewhat aristocratic image of the brand.\textsuperscript{181} In contrast to the other periods analysed above, in which we can observe a certain pattern regarding the dominant aspects in the advertising campaigns of the Burberry brand, the advertisements from 2010 to date do not focus on a single segment of the population (i.e. a certain income category, a certain age category, a certain lifestyle).

Burberry’s success in recreating a positive luxury image was also recognized by the EUIPO in an opposition settled in 2016.\textsuperscript{182} In this case, Burberry filed an opposition against the registration of a trade mark very similar to Prorsum knight for goods in class 12, respectively ‘Cars; motor cars; vehicles for locomotion by land, air, water or rail; motorcycles; etc.’. Among others, Burberry claimed that the applicant sought to gain unfair advantages from the reputation of the Burberry brand. Burberry’s evidence in support of the reputation requirement included the following: ‘Brand Finance ranking mentioning Burberry among top 50 ‘Best Brands of British Origin’ between 2011 and 2014’\textsuperscript{183} and a report called ‘Deloitte Global Powers of Luxury Goods’

\textsuperscript{176} Dempster and Lee (n 175) 3.
\textsuperscript{177} ibid.
\textsuperscript{178} Weinman (n 13) 106.
\textsuperscript{179} Figure 17, Appendix.
\textsuperscript{180} Figure 18, Appendix.
\textsuperscript{181} ibid.
\textsuperscript{182} Opposition no B 2 506 098 - Burberry Limited v Hillsun International Industrial Co. Ltd [2016].
\textsuperscript{183} Burberry Limited v Hillsun International Industrial Co. Ltd [2016] (n 182) 8.
from 2014 and 2015 with Burberry being ranked among top luxury brands.\textsuperscript{184} EUIPO’s examiners in charge with settling this opposition concluded that ‘it transpires from the evidence that the opponent’s trade mark enjoys a special image of luxury and genuine Britishness’.\textsuperscript{185}

The positive image and the success that the brand enjoys nowadays seems to be due in large part to the contribution of its consumers, which, now more than ever, becomes easier to harvest through social media. Weinman in his book on market leadership obtained through cloud, big data, social, mobile, and the internet of things describes Burberry as ‘extremely effective in leveraging popular social platforms, not just maintaining a presence there but being on the cutting edge of innovation in partnership with them’.\textsuperscript{186} In 2015 it was reported that Burberry had ‘more than 30M fans across these various sites and platforms’.\textsuperscript{187} Angela Ahrendts herself, the former CEO of Burberry from 2006 to 2014, in an interview about the business model promoted by her talks about how Burberry managed to a 'social enterprise'.\textsuperscript{188}

4. Final Reflections

Without in any way attempting to minimize Burberry’s own efforts in creating a strong brand, we cannot help but notice that throughout history, Burberry’s endeavours to stay contemporary, rode, to a certain extent, on the coat-tails of popular people or events. And its attempts were, on balance, successful. Nonetheless, even in the case of a strong brand such as Burberry in which its luxurious and exclusivist image were the jewels in Burberry’s crown, it has been proven that sometimes the image of the brand can get out of the control of the brand owner. In the last decade, Burberry engaged in a new form of coat-tail ridding, namely ‘leveraging popular social platforms’.\textsuperscript{189} In this context, the question that one asks herself is how much of the success of the brand is owed to the actual effort of the trade mark owner? How much is owed to the immaterial labour of consumers?

Unfortunately these questions have not been answered by this essay. However, I hope that the analysis above managed to provide a concrete example that would dismantle some of the assumptions underlying the justifications for the protection against dilution and the underlying how this legal mechanism is considered to work. And then what is the practical purpose of the above analysis? What negative consequences could occur if the anti-dilution provisions are still

\textsuperscript{184} ibid.  
\textsuperscript{185} ibid 9.  
\textsuperscript{186} Weinman (n 13) 107.  
\textsuperscript{187} ibid.  
\textsuperscript{188} Angela Ahrendts, ‘Burberry’s Social Enterprise Story’ (Youtube) <https://www.youtube.com/watch?v=mj_NQvLgDs4> accessed 12 December 2019.  
\textsuperscript{189} Weinman (n 13) 107.
applied based on the same principles and taking into account only the image of the brand as depicted by the brand owner? A negative consequence that one can think about is the fact that the provisions against dilution are applied without too much doubt in the case of established brands, leading to the temporary creation of an unjustified barrier to entry into the market. I say temporary, because the party who was unsuccessful in registering a mark similar or identical to a reputed trade mark can still enter the market under a new trade mark. However, the party who was unsuccessful will have to bear some additional costs with the opposition and in relation to the creation and promotion of that new trade mark. Such ‘punishment’ however seems unjustified when the said party had nothing to gain anyway from the brand image of the senior user. From a normative perspective, the explanation that the protection against dilution is given to the brand owner to reward her for her efforts in creating a successful image through advertising should be treated with scepticism or at least not taken for granted. This approach would confer credibility to this type of unconventional trade mark protection.

Another interesting thing that I think the above analysis highlights is the fact that this theory according to which the image of a brand to consumers is the one that the trade mark holder wants was closer to reality until the early 1990s. Subsequently, the creation of a different image of a brand than what the owner of the brand wanted became easier to achieve considering the advent of the Internet which facilitated the interactions between consumer communities.

The same can be said about the financial efforts of the trademark owner in building a strong brand by generating brand awareness (letting people know about the brand) and then by communicating the qualities of the products sold under that brand. At the beginning of the 20th century, because the mass media were limited (i.e. newspapers, posters, etc.), such financial efforts were indeed significant and made a difference. Subsequently, the Internet allowed the process to be decentralized, causing many of the tasks that traditionally belonged to the brand owner to be delegated, willingly or not, to consumers. Thus, the two assumptions that underlie the way in which the anti-dilution protection is justified and applied, seem to correspond to a society, business model and marketing and advertising strategies of the past. Obviously, these assumptions are found in today’s society to a certain extent. However, I take the view that this is a matter of degree that cannot be ignored.
5. Appendix - Burberry Ads

1909 Ad Featured in Fashion Magazines

Figure 1

![Figure 1](image1.png)

Credit: ImageCourtesy of The Advertising Archives

Figure 2

![Figure 2](image2.png)

Figure 3

![Figure 3](image3.png)

Credit: ImageCourtesy of The Advertising Archives

Figure 4

![Figure 4](image4.png)

Credit: ImageCourtesy of The Advertising Archives
Figure 5

Credit: Image Courtesy of The Advertising Archives

Figure 6

Credit: Image Courtesy of The Advertising Archives

Figure 7
Figure 20

Credit: Image Courtesy of The Advertising Archives