

Legal Opinion

The Interface between Freedom of Expression and Trade Marks: a
Comparative Analysis

1. Introduction

As trade mark law developed from competition and consumer protection, with the purpose of identifying the origin of a product, to a more complex set of rules, that envisage both the protection of consumers and the protection of trade mark owners, with regard to many other factors, the role of fundamental rights became more noticeable. Freedom of expression and trade marks seem like two topics that are uneasily related, like the water and oil of law. The “constitutionalisation” of private law is a lively fear of lawyers that rely on legal certainty and contracts. The direct involvement of general principles and the uncertainty therein in the interpretation of EU norms brought some potentially significant changes. Although trade mark law already provides for exceptions that are meant to achieve a fair balance, interpreting that legislation in light of a fundamental freedom is an important tool for third parties to prevent unjust outcomes.

Fair competition and freedom of expression dictate that, generally, the use of all signs is public domain, while trade marks grant their owners *quasi* absolute rights regarding the exclusive use of their trade mark, as is characteristic of intellectual property rights. It is a powerful exception that is justified in the name of consumer protection and fairness, allowing the owners of trade marks from benefiting from the goodwill they have achieved to establish around the goods or services they offer, by prohibiting others from doing the same. Namely, the Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trade marks (hereinafter EU TMD) grants exclusive use of identical signs for identical goods, the use of identical signs for similar goods or similar signs for identical use, if there is a likelihood that it will cause confusion to the public, including a likelihood of association. Additionally, if the trade mark in question is of repute, the owner will have an exclusive use, limited by a few exceptions, of identical and similar signs, even regarding goods which are not similar, if such a use, without due cause, would take unfair

advantage of, or be detrimental to, the distinctive character or the repute of the trade mark¹. In the USA similar general rules apply.

Freedom of expression limits the ability of trademark holders to push exclusivity in ways that harm cultural development, public debate, and fair competition². It is particularly relevant when non-commercial use is at stake, as critique is an essential trigger to development. In this line, the ECtHR stated in *Handyside* that article 10 (2) is applicable not only to “information” or “ideas” that are favourably received or regarded as inoffensive or as a matter of indifference, but also to those that offend, shock or disturb the State or any sector of the population. Such are the demands of that pluralism, tolerance and broadmindedness without which there is no “democratic society”. This means, amongst other things, that every "formality", "condition", "restriction" or "penalty" imposed in this sphere must be proportionate to the legitimate aim pursued³. Allowing the public to discuss and critique a trade mark or its owner is an important part of the democratic system. As such, the legislator is supposed to regulate trade marks in a manner that is not abusive and that protects the free speech.

Besides recognising the importance of freedom of expression to the functioning of democracy itself, one must also acknowledge its importance when it comes to commercial expression of third parties, who may be competitors or not. Third party trademark use is often of a purely commercial nature, e.g. when trademarks are used in comparative advertising, descriptive use, or referential use on products or services may be entirely commercial⁴. There are critics who argue that commercial expressions should not be

¹ Article 5 EU TMD.

² Jens Schovsbo, “Mark My Words” Trademarks and Fundamental Rights in the EU’ 8 UC IRVINE LAW REVIEW.

Handyside v UK (App no 5493/72) (1976) [49].

³ Wolfgang Sakulin, *Trademark protection and freedom of expression* (Kluwer Law International BV 2011) 122.

⁴ Łukasz Żelechowski, ‘Invoking freedom of expression and freedom of competition in trade mark infringement disputes: legal mechanisms for striking a balance’ ERA Forum 19, 115–135 (2018).

protected at all⁵, because it lacks the strong rationales which justify the protection of freedom of expression. Consumer protection is one of the main goals here: information is power and allowing for references, descriptions and comparative advertisement will increase consumer awareness and allows for informed consumer choices.

2. The role of freedom of expression in trade mark registration

Freedom of expression impacts trade mark registration in both the EU and the USA. In the registration application process, registries must consider this fundamental right both from the applicant's point of view and from the general public's perspective. The limitations to this fundamental freedom have suffered a few recent changes through case law. Namely the USA Supreme Court has deemed the exceptions relating to scandalous and immoral trade marks to be unconstitutional and the EU has interpreted the concept of immorality more narrowly than usual. These developments favour trade mark owners, but may increase the risks of an unprotected cultural property.

2.1. Freedom of expression in the EU

Freedom of expression is one of the most fundamental and core values on which the EU is based on and, as such, all courts in the EU have to ensure its protection. With this in mind, both the Council of Europe and European Court of Human Rights (hereinafter ECtHR), as well as the Court of Justice of the European Union (hereinafter CJEU) are competent to ensure compliance with fundamental rights and freedoms, according to the Convention and the Charter of Fundamental Rights, respectively. Both courts work under the jurisdiction of the EU in principle, as the Council of Europe is also subject to EU law. Nonetheless, they often develop different elements in their decisions and base these in different legal instruments, hence delivering distinct decisions and justifications in cases that could have similar facts. This tendency has been recognised by the international community on different instances and it finds its reasoning in the margin of appreciation

5

that is granted to member states in the decisions of the ECtHR. However devoid of sense this divergence may be, so far, there has been no acceptable solution. With that in mind, when considering case law of the EU regarding freedom of expression, one must consider both the decisions of the ECtHR and the CJEU. When dealing with trade marks specifically, one must bear in mind that the decisions of the ECtHR help determine the standards of protection that member states have to observe when freedom of expression is at stake, within a certain margin of appreciation.

Even though freedom of expression is traditionally at stake in vertical relationships between the state and the individual, horizontal relationships between a trade mark owner and a third party may also engage in limits to freedom of expression of individuals. Though the state is usually the recipient of duties envisaging the protection of fundamental rights, there is an somewhat indirect application to individuals (indirect horizontal effect theory)⁶. This is done through the taking into account fundamental rights and principles in the interpretation of relevant EU and national legislation and through the national court's decisions, as a last resource.

2.1.1. The European Convention of Human Rights and European Court of Human Rights

Freedom of expression is enshrined in article 10 of the European Convention on Human Rights (hereinafter ECHR). It encompasses all kinds of expressions, as the ECtHR has made clear in several judgements⁷, provided that these do not constitute “hate speech” or are somehow misleading. As the ECtHR puts it, for the public, advertising is a means of discovering the characteristics of services and goods offered to them⁸ and so, misleading

⁶ For more on this subject, see Paul Craig and Gráinne de Búrca, *EU Law: Text, Cases, and Materials* (6th Edn, OUP 2015).

⁷ Namely in *De Geillustreerde Pers v Netherlands* (1876), *Lingens v Austria* (1986), *Groppera Radio AG v Switzerland* (1990), *Casado Coca v Spain* (1994), *Krone Verlag v Austria* (2003), *Vajnai v Hungary* (2008).

⁸ *Krone Verlag GMBH v Austria* (App no 27306/07) (2003) [31].

commercial expressions deceive the public, hence defeating the purpose of freedom of expression.

Article 10 also expands on the conditions that have to be met to legally restrict it: besides having to be necessary in a democratic society and established by law, such a restriction has to be made in the interest of a reason listed in §2 of article 10. For assessing the necessity of such a measure, one conducts a proportionality test. Hence, for public policy and principles of morality to be lawful restrictions to freedom of speech in the EU, they have to be deemed proportionate. As such, “article 10 ECHR obliges states to ensure that the exercise of trademark rights will cause no disproportionate limitations of freedom of expression”. In its judgements, the ECtHR sets relevant standards of protection that Member States have to ensure, within a margin of appreciation, which “depends on factors such as the right at stake, the complexity of the factual situation, the reason for limitation of a right or discrepancies between the legal situations in various Member States”⁹. This margin of appreciation that is granted to member states has an impact on the proportionality assessment, as the test of necessity is greatly influenced by the variable margin of appreciation¹⁰. Additionally, the ECtHR will consider other factors, such as if the expression is artistic or commercial and the intention of the owner. Usually, commercial expressions are less protected. This is true in both the ECtHR and national courts within the EU¹¹. In *DOR v Roumanie*¹², though the ECtHR based its decision to refuse the trade mark “*crucifix*” on the fact that it was deceptive, the court addressed freedom of expression in the context of trade mark registrations. While it admitted that freedom of expression also applies to commercial expressions (which is what it considered a trade mark application to be), it also made clear that commercial expressions

⁹ Wolfgang Sakulin, *Trademark protection and freedom of expression: an inquiry into the conflict between trademark rights and freedom of expression under European, German, and Dutch law* (IViR FdR 2010) 93.

¹⁰ W Sakulin, *Trademark protection and freedom of expression* (Kluwer Law International BV 2011) 95.

¹¹ See, for example, in Germany: BVerfG 26 February 1969 (Blinkfür); BVerfG 22 June 1960 (Jugendgefährdende Schriften); BVerfG 12 December 2000 (Benetton I).

¹² 2015.

receive less protection in EU law by granting member states a larger margin of appreciation when it came to these. As Wolfgang Sakulin puts it, ‘problems arise where the kind of expression involved requires a strict proportionality test, but the ECtHR still grants a wide margin of appreciation’, namely when one is dealing with artistic expression and trade mark law and unfair competition¹³, where member states have a larger margin of appreciation, especially when determining if morality and public policy are at stake. This apparent limit to freedom of expression is adequate and proportionate, as is evidenced by subsequent decisions in favour of registration of potentially immoral marks.

This development contrasts deeply with the approach of Chinese courts, which tend to use vastly the statutory prohibition, which denies the registration of signs that can potentially offend traditional norms or socialist ethics. Considering the socio-political environment and taking into account its efforts in dealing more and more with the western civilisations, hopefully this practice will become less prominent in the near future.

2.1.2. The Trade Marks Directive and the EUIPO

Considering that article 10 ECHR is subject to indirect application and that article 11 of the Charter cannot be invoked by individuals, freedom of expression is protected through other means. In the EU, the main statutory legal instruments applicable to trade mark law are the EU TMD and the Regulation (EU) No. 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark (hereinafter EU TMR). These state in articles 4§1(f) and 7§1(f) respectively, that “public policy” and “the accepted principles of morality” are absolute grounds for refusal or invalidity of trade marks. Considering that these are ambiguous, volatile concepts, that adapt to the reality of the present and what is deemed to be socially acceptable at that moment in time, there is a broadened scope of interpretation which leads to uncertainty and can lead to restriction of fundamental rights, namely, here, freedom of speech. In this regard, whereas

¹³ Ibid 6.

27 of the EU TMD and 21 of the EU TMR are especially relevant. These state that their application should ensure ‘full respect for fundamental rights and freedoms, and in particular the freedom of expression’ and, though not legally binding, the recitals provide guidance on the interpretation of these legislative documents.

The EU TMD states in article 4(1)(f) that public policy and the accepted principles of morality are absolute grounds for refusal or invalidity of trade marks. These concepts are both ambiguous and volatile, as they may vary widely over time, as social mores change¹⁴, adapting to what is deemed to be socially acceptable at that moment in time. This is the typical catch-all provision, which is meant to provide the courts with a tool that will allow them to limit activities that seem unpredictable at the time of legislating. Its broad scope of interpretation leads to uncertainty and the susceptibility of abuse by the courts, which can lead to an undue restriction of fundamental rights, namely, here, freedom of speech. In this regard, whereas 27 of the EU TMD is especially relevant, as it states that the application should ensure “full respect for fundamental rights and freedoms, and in particular the freedom of expression” and, though not legally binding, the recitals provide guidance on the interpretation of these legislative documents. Moreover, this fundamental freedom is enshrined in the Charter of Fundamental Rights of the EU, article 11, and so, it has to be taken into account when interpreting all EU law. As is typical in the cases that appear before the ECtHR, a proportionality exercise is conducted by the Boards of Appeal of the European Union Intellectual Property Office (hereinafter EUIPO). The Boards of Appeal’s approach has been confirmed substantially by the General Court¹⁵.

¹⁴ Tanya Aplin and Jennifer Davis, *Intellectual Property Law: Text, Cases, and Materials* (Third Edn, OUP 2017).

¹⁵ Christophe Geiger and Leonardo Machado Pontes, ‘Trade mark registration, public policy, morality and fundamental rights’ (CEIPI Research Paper No 2017-01 2017).

This exercise of proportionality is conducted by the courts and, in the EU, one of the leading cases on freedom of expression in trade mark registration is the FCUK case¹⁶. Besides underlining the applicability of human rights to trade mark registration the Appointed Person stated a few guidelines on how this is achieved, namely clarifying that a mere offence to a section of the public, in the sense that that section of the public would consider the mark distasteful, is not enough¹⁷ and that, for article 4(1)(f) to apply the sign will have to cause outrage or undermine current religious, family or social values¹⁸. Furthermore, in *Dennis Nazir v George V Entertainment*¹⁹, it was clarified that the standards of a reasonable person with normal levels of sensitivity and tolerance apply²⁰. These developments were all made after the refusal of registration of trade marks “Tiny Penis”²¹, “Jesus”²² and for the coat of arms of the former USSR²³ for clothing. In addition to that, in the recent case *Fack ju Göhte* (March 2020)²⁴ the CJEU interpreted public morals in a modern way, taking into account that there was no big controversy around the name of the movie or a negative reaction by the relevant general public. It also referred specifically to the preamble of the directive. Considering moral principles are fluid and change over time, the Boards have concluded that the best way to determine what is against public policy or immoral “in the absence of particular surveys, is provided by the historical background, the national office’s guidelines and the case-law of Member States”²⁵. In the ‘Soviet Coat of Arms’²⁶ decision, ‘the General Court held that the concepts of ‘public policy’ and ‘acceptable principles of morality’ must be interpreted not only with reference to the circumstances common to all Member States but by taking

¹⁶ *French Connection Ltd’s Trade Mark Application* (2007) ETMR 8.

¹⁷ *Ibid* 14 [60] 7.

¹⁸ *Ibid* 14 [60] 8.

¹⁹ *Dennis Nazir v George V Entertainment SA (BUDDHA-BAR)* (2011).

²⁰ *Ibid* 13.

²¹ *Ghazilian’s Trade Mark Application* (2002) ETMR 56, RPC 33.

²² *Basic Trade Marks SA’s Trade Mark Application* (2006) ETMR 24, RPC 25.

²³ *Case T-232/10 Couture Tech Ltd v OHIM*, ECLI:EU:T:2011:498 (2011).

²⁴ *Case C-240/18 P Constantin Film Produktion v EUIPO*, ECLI:EU:C:2020:18 P (2020) OJ C 161.

²⁵ *Ibid* 13 7.

²⁶ *Ibid* 22.

into account ‘the particular circumstances of individual Member States which are likely to influence the perception of the relevant public within those States’^{27,28}. National historic and cultural background is important for mirroring the perception of the public regarding the trade mark in question, especially considering that historically and/or ideologically offensive trade marks are not permitted. However, the Boards of Appeal are not bound by national authorities. They are to make an objective assessment of the mark, relating to the obvious perception that the public will have of the mark. This assessment is, in practice, more subjective when concerning “accepted principles of morality” (as opposed to public policy principles). Nonetheless, it is supposed to be conducted by the registrar in a manner that is as objective as possible. If the trade mark is deemed offensive, it may still be registrable, depending on the public’s potential reaction. Though the lack of manifestation of the public against a trade mark did not serve in itself as a proof of its acceptance²⁹, in the latest “Fack ju Göhte”³⁰ decision the court decided in favour of the applicant, taking into consideration the fact that the movie was a success and not perceived as immoral by the public. This development has increased the importance of practical evidence in this sense. Not only did the CJEU interpret public morals in a modern way but it also took into account there was no big controversy around the name of the movie or a negative reaction by the relevant general public. It also referred specifically to the preamble of the EUTMR. This decision went against the argument of the general court that ‘in the field of art, culture and literature, there is a permanent concern about preserving freedom of expression that does not exist in the field of trade marks’³¹ and adopted the position of the advocate general³² that freedom of expression

²⁷ Ibid 22 [34].

²⁸ EUIPO, *Guidelines for Examination of European Union Trade Marks, Part B, Examination, Section 4, Absolute Grounds for Refusal*, <https://euipo.europa.eu/tunnel-web/secure/webdav/guest/document_library/contentPdfs/law_and_practice/decisions_president/ex16-1_en.pdf> 4.

²⁹ Ibid 20.

³⁰ Ibid 23.

³¹ Case T-69/17 *Constantin Film Produktion v EUIPO*, ECLI:EU:T:2018:814 (2018).

³² Case C-240/18 P *Constantin Film Produktion v EUIPO*, ECLI:EU:C:2019:553 (2019) Opinion of AG Bobek.

does play a role in trade mark law, especially when a field of culture and arts is at stake. This interpretation is more in line with the interpretation of the ECtHR that stresses the importance of freedom of expression in cultural, artistic, critique-prone and journalistic settings, as opposed to purely commercial expressions. Nonetheless, purely commercial expressions are still awarded some protection, as is evidenced by the registration of trade marks such as “SCREW YOU”³³ for sex toys.

Regarding purely commercial expressions, one could argue that there is no sufficient protection, especially considering the somewhat protectionist position of EU institutions. One example of this, is the EUIPO considering that there is an interest in ensuring that children and young people, even if they are not the relevant public of the goods and services in question, do not encounter offensive words in shops that are accessible to the general public³⁴. Though such an extreme example relating to the protection of susceptibilities of children and their innocence may make sense at a first glance, it is important to keep in mind that the prohibition of registration does not preclude one to use an unregistered trade mark³⁵. Of course, it may demotivate a trader to use such a mark, as their expectations for protection will be significantly reduced, but it does not guarantee the desired outcome. In this instance, children today are constantly subjected to what could be considered “immoral” speech and behaviour, on the streets, in the supermarket, at school, on the internet, computer games or on TV. The fact that the EUIPO still factors in this type of consideration can be perceived as an unbalanced and excessive restriction to freedom of expression, as it does not achieve the goal it seeks and especially considering there are no other legislative instruments to this end at the EU level.

In my opinion, the midway solution offered by the EU is the right approach in protecting freedom of expression in trade mark registrations, provided that the EUIPO is able to

³³ R 0495/2005-G SCREW YOU (2006).

³⁴ Ibid 24 6.

³⁵ Jonathan Griffiths, ‘Is there a right to an immoral trade mark?’ Intellectual Property and Human Rights, P Torremans, ed, Kluwer Law International (2008).

modernize its approach to purely commercial expressions. Though it is understandable that critiques, political speech and the arts in general are awarded special protection, purely commercial speech is a form of freedom of expression that is potentially excessively restricted at the moment. The prohibition of registration of marks that are racist, homophobic or offensive to protected minorities is acceptable, in my view. However, considering the increased “normalisation” of slang or speech with sexual connotations and innuendos, these trade marks should be acceptable to the registrar. The flexibility that is awarded to the registrar in the vague concepts of “public policy and the accepted principles of morality”, in my view, allows for such an adaptation of the EUIPO’s position, considering these are to be interpreted in light of the socioeconomic development of the public. In line with the decision in *La Mafia v EUIPO*, the courts take a balancing test between the two conflicting rights, namely the right of traders to freely employ words and images in the signs they wish to register as trade marks against the right of the public not to be confronted with disturbing, abusive, insulting or even threatening trade marks³⁶. As had been clarified before in the FCUK case³⁷, “any real doubt as to the applicability of the objection should be resolved by upholding the right to freedom of expression and thus permitting the registration”. This, in addition to the abovementioned limit set out by the ECtHR to freedom of commercial expression, protects freedom of expression proportionately and fairly, awarding more protection to expressions which are not purely commercial and still some (hopefully increased) protection to commercial expressions.

2.2. Freedom of speech in the USA

As the First Amendment, traditionally, free speech is of central importance in the USA, be it commercial or not. Kozinski and Banner even argued that the distinction between commercial and non-commercial speech should not exist, as all forms of speech carry the

³⁶ EUIPO in *Dennis Nazir v George V Entertainment SA (BUDDHA-BAR)*.

³⁷ *Ibid* 14.

same value and should be protected equally as such. The supreme court accepted that purely commercial speech should be protected³⁸ as 'it is a matter of public interest that those decisions [of the consumer], in the aggregate, be intelligent and well informed. To this end, the free flow of commercial information is indispensable³⁹.

Up until recently, section 2 of the Lanham Act did not allow for the registration of immoral or scandalous trade marks. These grounds for refusal of registration were invoked against vulgar word marks or marks which were offensive or obscene, such as the use of the word mark Madonna⁴⁰ or Khoran⁴¹ for wine or Jack-off⁴² for adult phone conversations. Considering the importance of free speech to US courts, when balancing the First Amendment against section 2 of the Lanham Act, the decisions would, generally, only end in a refusal of registration in particularly extreme cases, most of which are immoral or even offensive in an obvious manner.

The *Matal v Tam* decision⁴³ of 2017 confirmed the *In re Tam* federal circuit decision⁴⁴ which held the prohibition on the registration of disparaging trade marks was unconstitutional. In it, the Supreme Court did not state clearly if trade marks are commercial speech or more, it underlined that commercial speech could simultaneously be partly political or artistic and thus, granting it less protection to these borderline cases would ultimately endanger free speech⁴⁵. In the view of Christopher Geiger and Leonardo Machado Pontes, the distinction between commercial and non-commercial speech seized

³⁸ *Virginia State Board of Pharmacy v Virginia Citizens Consumer Council* (1976) 425 US 784, 765, 48 L. Ed. 2d 346, 96 S. Ct 1817.

³⁹ *Ibid* 26 p 425 U. S. 765.

⁴⁰ *In re Riverbank Canning Co*, [1938] 25 C.C.P.A. 1028, 95 F.2d 327, 37 U.S.P.Q. 268.

⁴¹ *In re Lebanese Arak Corporation*, [2010] 94 U.S.P.Q.2d 1215 (Trademark Tr. & App. Bd.).

⁴² *In re Boulevard Entertainment, inc* [2003] 334 F.3d 1336, 67 U.S.P.Q.2d 1475, later revoked by *In re Simon Shiao TAM* [2015] 808 F.3d 1321, 117 U.S.P.Q.2d 1001, 44 Media L. Rep. 1037.

⁴³ *Joseph Matal, Interim Director, United States Patent and Trademark Office, Petitioner v Simon Shiao Tam* [2017] 137 S.Ct. 1744, 198 L.Ed.2d 366, 85 USLW 4389.

⁴⁴ *In re Tam* (2015) 808 F.3d 1321 1358 (Fed Cir).

⁴⁵ *Ibid* 38 Part IV.

to matter when a viewpoint-based restriction on speech⁴⁶ is at stake, as there is higher constitutional protection in this case. This decision was the beginning of the end for grounds to refuse registration that conflicted with free speech. More recently, the *Iancu v Brunetti* decision went even further, as was expected⁴⁷. In June 2019, the US supreme court decided that the 'Lanham Act's prohibition of immoral or scandalous trade marks violated the First Amendment⁴⁸, thus removing these grounds for refusal of registration from its statutory laws. The Federal Circuit held that both the immoral and scandalous bars to registration created a content-based restriction on free speech. Those sections forbid registration to particular words or images on the basis of the topic discussed or the idea or message expressed.⁴⁹ This development eliminated essentially all meaningful restrictions to freedom of expression in the registration of trade marks and in doing so, it increased the differences from the EU courts' typical positions, which, in line with the decision in *La Mafia v EUIPO*, tend to balance the interests at stake with freedom of expression. In contrast with the EU's approach, not only did the US Supreme Court not establish trade marks as a form of commercial expression, but also it indicated that viewpoint discrimination⁵⁰ must be held to rigorous constitutional scrutiny⁵¹, which renders the classification of commercial or non-commercial speech indifferent.

Though US courts had traditionally more liberal outcomes in their proportionality tests between a trade mark and free speech than the EU, as long as the commercial expressions were not misleading, the basic principles and exceptions were essentially similar. *Matal v Tam* and *Iancu v Brunetti* changed this convergence into a divergence. As Lisa Ramsey argued, in line with *Aplin and Davis*⁵² and *Griffiths*⁵³, the denial of registration is not such

⁴⁶ Ibid 13 15.

⁴⁷ Ibid 13 16.

⁴⁸ *Iancu v. Brunetti*, 588 U.S. ____ (2019) [1].

⁴⁹ J McCarthy, *McCarthy on Trademarks and Unfair Competition* (Fifth Edn) §19:77.

⁵⁰ Ibid 38 (Justice Kennedy concurring opinion).

⁵¹ Ibid 45.

⁵² Ibid 12.

⁵³ Ibid 31.

a limitation that it suppresses the use of a trade mark and, though it may demotivate its use, people are still allowed to market whatever trade mark they deem acceptable or desirable, without it being registered. This is especially true in the USA, where the rights of trade mark owners emerge from the use of the trade mark (first use doctrine) and so, the protection of trademarks in the USA is equal to both registered and unregistered trade marks.

Considering consumers are much more informed today, having internet and technology at their disposal, they may easily reject a trade mark through boycott or negative publicity. This is a practice which presently happens particularly often, as people seek to be more conscious and aware of the social practices of companies. Nonetheless, I believe if a trade mark outrageous or offensive, governments, and specifically the trade mark office, should be able to deny it. Taking into account the fact that the trade mark is protected regardless of whether it is registered or not, allowing public authorities to determine if a trade mark is against the morals of that community is something that should fall under the scope of the rights of said public authorities. In my opinion this would be minimally problematic to free speech, as trade mark owners would still be free to market whatever they wish and have a right to protect their trade marks. If the public reacts well to the trade mark, it may still be successful and it will be protected for its goodwill and eventually even reputation.

Moreover, I believe this development of the law in the USA may have a major impact at the international level. As intellectual property rights are in nature national, this could be an innocuous development for the EU. However, such a gap between the legislations of the EU and the USA, especially concerning exceptions to fundamental rights, could be detrimental to EU trade and to private entities, namely transnational companies and groups, which will not be able to register their trade marks which go against public policy or the accepted principles of morality in the EU, unless they are famous. Diverging laws are generally detrimental to transnational private parties, as they must constantly adapt to the several different legislative instruments of each territory they are in. This is a nuisance, but an understandable effort that is demanded of private parties that wish to

operate on a transnational level. Due to lobbying and the pressures of big companies and corporate groups, changes in the law of a meaningful player of the international setting naturally increases pressure on smaller States and the EU to change their laws. There is already an inherent pressure to conform with standard international practices and these are influenced by key economic players. In my opinion, free speech is of undeniable importance and a central cornerstone in democratic societies but it should not be without limits. Striking a balance between this fundamental freedom and others, though difficult, is an exercise worth practicing. The newest shifts of the US courts are against international common practices but may well be setting a trend, as the USA is such a meaningful party to world trade. The abovementioned decisions of the courts, without further legislation pending (so far), stripped consumers and the public of protection against obscene or hateful marks, as there will be no grounds of refusal to register such marks. Hate speech and offensive signs may be fair game too. Less shocking but equally concerning, there appear to be no impediments to trade marks that appropriate cultural signs and cultural heritage in general.

2.3. Cultural heritage and trade marks

In the EU, the registration of trade marks which consist of signs of high symbolic value may be refused⁵⁴, as well as trade marks which go against public policy and the accepted principles of morality, as discussed above. As public perceptions are volatile, public policy and principles of morality change over time, as does the symbolic value of signs. Courts take the susceptibilities of consumers into account but, as the board indicated in the FCUK case, an offence to a section of the public is not sufficient to refuse a trade mark. Nonetheless, when the trade mark affects a substantial part of the relevant public, then that may be sufficient for refusal or invalidity of a trade mark. Particularly, as the EFTA court noted in the Municipality of Oslo case⁵⁵, considering the accepted principles

⁵⁴ Article 4(3)(b) EU TMD.

⁵⁵ Case E-5/16 *Municipality of Oslo* (2017) EFTA.

of morality are based on subjective criteria, registration of trade marks which misappropriate cultural heritage may be denied, particularly when that registration will contradict the author's values. On the other hand, it is more difficult to refuse registration based on public policy, which is subject to an assessment based on objective criteria. Though public domain may be of fundamental importance to the whole national public, it can only be considered grounds for refusal if "there is a genuinely and sufficiently serious threat"⁵⁶ to it⁵⁷. As such, public domain is a less flexible option than the accepted principles of morality. With regard to signs having cultural significance but no high symbolic value, however, the EU trademark law does not provide for specific grounds for refusal.⁵⁸ Still, there is no legislation prohibiting the registration of cultural landmarks and even though in *Shield Mark/Kist*⁵⁹ it was not possible to register the first notes of "Für Elise", the court did not dismiss that possibility on the grounds of it being of cultural significance. Admitting that a cultural sign could be registered as a trade mark and that the scope of protection of trade marks is increasing, as the CJEU made clear in *L'Oréal v Bellure*⁶⁰, the free use of that cultural sign, particularly, in the course of trade, could be compromised.

One example regarding the registration of a trade mark that could potentially be a cultural heritage misappropriation was the KIMONO trade mark application in relation to underwear and shapewear on behalf of the infamous Kim Kardashian. There is an argument to be made that the registration office should take into account the possibility of cultural heritage appropriation, which would go against public policy. This could have been the case if the trade mark were to be registered in Japan. But in the EU, or in the USA (where this situation happened), it would be a lot more difficult to argue, especially

⁵⁶ *Ibid* 41 [95].

⁵⁷ Case E-12/10 *ESA v Iceland* (2011) EFTA Ct. Rep. 117 [56].

⁵⁸ Martin Senftleben, 'Free Signs and Free Use – How to Offer Room for Freedom of Expression Within the Trademark System' RESEARCH HANDBOOK ON HUMAN RIGHTS AND INTELLECTUAL PROPERTY, C. Geiger, ed., Edward Elgar Publishing (2015) 354-376.

⁵⁹ Case C-283/01 *Shield Mark*, ECLI:EU:C:2003:641 (2003).

⁶⁰ Case C-487/07 *L'Oréal SA, Lancôme parfums et beauté & Cie, Laboratoire Garnier & Cie v Bellure NV, Malaika Investments Ltd, Starion International Ltd*, ECLI:EU:C:2009:378 (2009).

considering the newest decision which deemed section 2 of the Lanham Act to be unconstitutional. The application was cancelled before anyone could oppose it, as public outrage dissuaded the celebrity of using that trade mark and so, there is no definitive answer on this subject in the USA. With the increased use of technological tools and social media, consumers are more informed than ever, thus more aware of potentially offensive practices and trade marks, which may constitute cultural heritage misappropriations. Public awareness was also clear in the “SUSSEX ROYAL” trade mark application outrage, largely promoted by the media in the UK and throughout the world. Nonetheless, this is a particularly special case, as in all countries signatory to the Paris Convention, an exception to the registration of trade marks stems from article 6ter of the Convention, which prohibits trade marks concerning State emblems, official hallmarks, and emblems of intergovernmental organizations. In the UK specifically, special provisions apply in relation to such a trade mark, because it contains the term “ROYAL”⁶¹. The registration of such trade marks in the name of authorities and agencies of the state could be a significant step towards a lucrative, controlled exploitation. Besides increasing state revenues, such an exploitation could arguably be of public interest, especially considering it could increase public awareness and promote the protection of cultural landmarks.

Nonetheless a trade mark which consists in cultural heritage and is owned by the State could be problematic for the public. Not only due to political instabilities and the difficulties that several States have in owning and exploiting entities for commercial purposes, as well as the recurrent mismanagements of some government owned entities, but also because of the general idea of cultural heritage belonging to an entity, that is, any entity at all. Cultural heritage, as the name puts it, belongs to the public in general, as it is its own heritage, and should be available for all uses by said public. Restricting that use to the authorisation of use granted by the state seems to defeat the purpose of protecting cultural heritage at all. The same goes for private parties.

⁶¹ See section 4 Trade Marks Act 1994.

The interface between cultural heritage and trade marks begs for additional legislation on the topic. I believe, for the time being, consumer reactions, as the ones mentioned above, will keep some potentially harmful uses controlled in some jurisdictions. However, other, poorer, jurisdictions, which may be culturally rich, may not be able to enjoy this type of protection through consumer information. Situations such as the use of some traditional African names or patterns in clothes seem to be, so far, unavoidable, as these are left unprotected by both the uninformed public and (in)competent authorities. So, though consumer reactions may mitigate the damages, through boycotts and demonstrations of disapproval, depending only on these is insufficient. There is an urgent need for legislation on the topic cultural heritage appropriation through trade marks.

3. The Role of Freedom of Expression in Trade Mark Infringement

Trade marks are often abused through a “freedom of speech” defence, especially trade marks with a reputation, which are more often targeted and fall victim to counterfeits and lookalikes. Though competition is desirable for consumers, as is freedom of commercial expression, likelihood of confusion is undeniable in a lot of these products. It is difficult to strike a balance between freedom of commercial expression and the protection of trade marks.

3.1. Freedom of expression as a defence in the EU

In the EU, a sign will infringe a registered trade mark if it is likely to cause consumer confusion (article 10 EU TMD). Firstly, it is important to note that if there is double identity there is no need to show confusion, which means the burden of proof shifts. Additionally, the courts will balance the similarity of the sign used in the course of trade with the registered trade mark in question, particularly taking into account the goods and services it is used for.

Considering there is no free speech defence in the EU TMD, other than recital 27, this type of defence stems from the abovementioned ECHR general norm on freedom of expression⁶². With that in mind, the CJEU tends to generally adopt the concepts developed by the ECtHR, namely on what concerns the higher level of protection on artistic or political expressions, in comparison with purely commercial expressions.

Using infringement criteria such as “use in the course of trade” and “in relation to goods and services” may be useful in striking a balance between freedom of expression and protecting the rights of trade mark owners⁶³. Additionally, in some instances, the “fair use” or “referential use” defence could accommodate claims relating to artistic or critical uses. Nonetheless, relying on these may not be sufficient, as some would argue. In jurisdictions such as France, where competition laws are extensively developed, the lack of regulation regarding the interface between trade marks and freedom of expression is not as problematic. But other jurisdictions, namely the UK, suffer from the lack of a statutory free speech defence, as was clear from the *Betty Boop* case⁶⁴, especially when at stake are famous and well-known trade marks. This will be further elaborated on in section 3.3. of this research.

3.2. Free Speech as a defence in the USA

McCarthy underlines that trade marks and freedom of expression have conflicting goals. Trade mark owners seek to prevent likelihood of confusion with their trade mark, whereas others want to create a zone of open social, artistic, political and commercial expression⁶⁵. As such, one of the tools potential infringers have at their disposal when accused of infringement is alleging free speech. Considering there is no statutory free speech defence and that free speech is an ample constitutional right, it is important to determine the types

⁶² Article 10 ECHR.

⁶³ *Ibid* 4.

⁶⁴ *Hearst Holdings Inc & Another v A.V.E.L.A. Inc & Others* (2014) EWHC.

⁶⁵ J Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* (Fifth Edn) §31:139.

of expressions which fall under the scope of protection of free speech. US courts have dealt with this question extensively and, in line with their general tendencies, free speech has a wide scope when balanced with trade mark rights, which includes entertainment speech⁶⁶ and all types of entertainment media (entertainment motion pictures⁶⁷, comic books⁶⁸, video games⁶⁹, song titles and lyrics⁷⁰)⁷¹ besides political speech and ideological speech. Different courts have elaborated different tests and methods ‘to consider the defence that an accused use is an exercise of free speech and is not an infringement of a mark’⁷², though the Ginger Rogers two-step test is the most popular with most federal US courts. In it, ‘a mark used in an accused expressive work will be prohibited as an infringement or a false endorsement under the Lanham Act only if it has “no artistic relevance” to the underlying work or, if there is artistic relevance, the title “explicitly misleads as to the source or the content of the work.”’^{73,74}. So, inherently false, misleading or deceptive speech, especially purely commercial speech, is not protected as such by the First Amendment.

⁶⁶ See *Winters v New York* (29 March 1948) 333 U.S. 507, 68 S. Ct. 665, 92 L. Ed. 840, 35 Media L. Rep. 2619; *Zacchini v Scripps-Howard Broadcasting Co* (28 June 1977) 433 U.S. 562, 97 S.Ct. 2849, 53 L.Ed.2d 965, 40 Rad. Reg. 2d (P & F) 1485, 5 O.O.3d 215, 205 U.S.P.Q. 741, 2 Media L. Rep. 2089; *Guglielmi v Spelling-Goldberg Productions* (5 December 1979) 25 Cal.3d 860, 603 P.2d 454, 160 Cal.Rptr. 352, 205 U.S.P.Q. 1116, 5 Media L. Rep. 2208; *Schad v Borough of Mount Ephraim* (1 June 1981) 452 U.S. 61, 101 S.Ct. 2176, 68 L.Ed.2d 671, 7 Media L. Rep. 1426; *Montgomery v Montgomery* (21 November 2001) 60 S.W.3d 524, 61 U.S.P.Q.2d 1098, 30 Media L. Rep. 1045.

⁶⁷ *Joseph Burstyn, Inc v Wilson* (26 May 1952) 343 U.S. 495, 72 S.Ct. 777, 96 L.Ed. 1098, 1 Media L. Rep. 1357; *Tyne v Time Warner Entertainment Co, LP* (26 September 2005) 425 F.3d 1363, 76 U.S.P.Q.2d 1478, 33 Media L. Rep. 2318, 18 Fla. L. Weekly Fed. C 999.

⁶⁸ *Winter v DC Comics* (2 June 2003) 30 Cal.4th 881, 69 P.3d 473, 134 Cal.Rptr.2d 634, 66 U.S.P.Q.2d 1954, 31 Media L. Rep. 1774, 118 A.L.R.5th 727, 03 Cal. Daily Op. Serv. 4586, 2003 Daily Journal D.A.R. 5834.

⁶⁹ *Brown v Entertainment Merchants Association* (27 June 2011) 564 U.S. 786, 131 S.Ct. 2729, 180 L.Ed.2d 708, 79 USLW 4658, 11 Cal. Daily Op. Serv. 7874, 2011 Daily Journal D.A.R. 9459, 22 Fla. L. Weekly Fed. S 1259.

⁷⁰ *Ward v Rock Against Racism* (22 June 1989) 491 U.S. 781, 109 S.Ct. 2746, 105 L.Ed.2d 661, 57 USLW 4879; *Lohan v Perez* (21 February 2013) 924 F.Supp.2d 447.

⁷¹ *Ibid* 21.

⁷² *Ibid* 21.

⁷³ *Rogers v Grimaldi* (1989) 875 F.2d 994, 999, 16 Media L. Rep. (BNA) 1648, 10 U.S.P.Q.2d 1825.

⁷⁴ *Ibid* 21.

Regarding commercial speech, the US Supreme Court has held that free speech also protects advertising and commercial speech⁷⁵. This concept is defined in the US as speech which proposes a commercial transaction⁷⁶. Though protected, as in the EU, this type of speech has a more limited level of protection, less strict than other forms of non-commercial expressions. McCarthy puts this distinction as simply as advertising versus news⁷⁷. As was mentioned before, commercial speech may simultaneously be considered political speech or others, which is why the level of protection may vary according to the interpretation of the court regarding the purpose and significance of the communication (be it a trade mark in itself or advertisement). Nonetheless, if the communication inextricably intertwines the commercial speech with higher protection worthy speech, then it will be fully protected⁷⁸.

Besides having to balance the property right of a trade mark owner with the free speech right of others, one should also attribute some relevance to the indirect free speech right of the trade mark owner. In this regard, it is relevant to keep in mind the right of the trade mark owner not to have its message distorted or not to convey other people's messages⁷⁹. This is particularly important considering the main purpose of trade marks of identification of origin. Nonetheless, this is a particularly difficult balancing exercise that will often favour the infringer in their free speech defence. The opposite stand will most likely prevail in situations in which the message itself may be so "morally repugnant" that the person or company would be forced to speak in rebuttal⁸⁰. In this line, parodies which convey a false message of wrongdoing or malpractice are not generally allowed, though most parodies will fall under the scope of the First Amendment and are acceptable as a

⁷⁵ *Virginia State Board of Pharmacy v Virginia Citizens Consumer Council* (1976) 425 US 784, 765, 48 L. Ed. 2d 346, 96 S. Ct 1817.

⁷⁶ *Cincinnati v Discovery Network* (1993) 507 US 410, 123 L Ed 2d 99, 133 S Ct 1505, 1513.

⁷⁷ J Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* (Fifth Edn) §31:147.

⁷⁸ *Riley v National Federation of Blind, Inc* (1988) 487 US 781, 101 L Ed 2d 669, 109 S Ct 2667, 2677.

⁷⁹ J Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* (Fifth Edn) §31:145.

⁸⁰ *Ibid* 71.

defence. In addition to that, the means through which the infringing communication is delivered is also considered to determine whether such an infringement is permitted.

3.3. Dilution

A trade mark and its owner can be particularly hindered through a fair use or a free speech defence, especially when, at stake, is a famous or a well-known trade mark because of their prominent public status⁸¹. Because this danger was identified, anti-dilution laws came into place⁸². In these, the rights of trade mark owners are further protected as quasi-absolute rights, since for being famous they are subject to more attempts of free-riding and copying. Dilution claims differ from likelihood of confusion claims as the first is not dependent on the confusion of consumers, but rather on the diluting or diminishing of the trade mark through the infringing use. Dilution is characterised as the whittling away of the value⁸³ of the trade mark. This can happen by blurring or tarnishing the mark.

In the EU, with the relatively recent trade mark reform, trade mark owners of famous and well-known trade marks, or trade marks with a reputation saw their quasi exclusive rights protection increase, as the EU TMD protects them from the use of such marks where such use without due cause takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the EU trade mark⁸⁴. As such, this norm has a broad scope. Especially considering the interpretation of the CJEU regarding the concept of taking unfair advantage of a trade mark in the landmark case *L'Oréal v Bellure*⁸⁵, in which the court considered other functions of trade marks, other than the identifying function, such as the advertising and investment functions of trade marks. This development is particularly relevant for situations of comparative advertising, amongst others, as famous

⁸¹ Frederick W Mostert and Ludwig Baeumer, *Famous and Well-known Marks: An International Analysis* (London: Butterworths, 1997).

⁸² Note Lanham Act Section 43(c)(6).

⁸³ J Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* (Fifth Edn) §24:72.

⁸⁴ Article 10(2)(c) EU TMD.

⁸⁵ *Ibid* 58.

and well-known trade marks will enjoy a more comprehensive protection on more aspects.

The concept of dilution is more developed in the USA than in the EU. Statutory laws include a multifactored test to determine whether a mark possesses the degree of recognition required, and another multifactored test to determine if there is a likelihood of dilution. Having such a developed system has also attracted criticism, mostly aimed at the fact that, today, the concept of dilution has become overreaching and used by marks that should not be entitled to use it. It has become a common practice of several trade mark owners and the so called trade mark “bullies” to claim dilution where their trade marks are not sufficiently famous and there is a mere “likelihood of confusion”. Taking these concerns into account, one could question if it even makes sense to give added protection to these famous trade marks. Though understanding the ratio of these marks being more subject to potential free-riding attempts, one could find that they are less harmed by those practices than less famous trade marks. Considering they are better established, and consumers recognise the marks, their distribution channels, quality and characteristics, not only are consumers not confused, but they also do not associate lookalikes or dupes with the famous trade mark they were based on. Nonetheless, if this ratio were true, then consumers would never be confused by lookalikes of these trade marks and so, without dilution, famous and well-known trade marks would be left unprotected from these types of practices in many instances. Though not perfect, I find this to be a necessary instrument so that trade marks which have achieved a “golden status” of falling in this category are not prejudiced by it. Nonetheless, I agree with opinions which criticize how easy it has become for the courts to find situations of dilution.

In the USA, one of the biggest limits to the protection of trade marks against dilution (and their protection in general) concerns the potential conflicts with the federal laws of copyright and patent, which cannot be “altered” by state laws, i.e. there cannot be a further protection of these rights than the protection granted by the federal law. This federal pre-

emption can be particularly limiting to state laws and thus to trade mark owners in the overall protection of their trade marks, particularly when these marks are used in products protected by federal patent law or copyright law. In these situations, trade mark owners may not be able to claim dilution and so, be limited to likelihood of confusion claims which may not be successful (or, from a legal puritan's point of view, should not be successful) in likelihood of confusion claims.

3.4. Parody

A parody is a form of artistic expression, which is subject to a higher level of protection in both the EU and the USA, through freedom of expression and First Amendment, respectively. Though there are no specific provisions protecting parodies, these fall under the general rules on free speech. "While copyright and trade mark protection seek to promote one or two primary interpretations of a work, parody seeks to do the opposite, by creating a multifaceted view"⁸⁶. As McCarthy puts it, a successful trademark would merely amuse, not confuse⁸⁷. This is the golden rule when it comes to trade marks and not causing confusion is the reason why, arguably, there is no need for a statutory defence in these situations. In a well achieved parody, there is no likelihood of confusion nor deception, as the public will immediately recognise that it is before a mockery or a joke, distinct from the real trade mark. Even though some parodies may be less obvious than others, thus opening up the possibility of a likelihood of confusion or a likelihood of association, when in doubt, courts both in the EU and in the USA will tend to favour freedom of expression over the rights of trade mark owners, because of the tighter

⁸⁶ W SAKULIN, TRADEMARK PROTECTION AND FREEDOM OF EXPRESSION: AN INQUIRY INTO THE CONFLICT BETWEEN TRADEMARK RIGHTS AND FREEDOM OF EXPRESSION UNDER EUROPEAN LAW 6–7 (2011) (as cited in Leonardo Machado Pontes, 'Trademark and freedom of speech: a comparison between the U.S. and the EU system in the awakening of Johan Deckmyn v Helena Vandersteen' Ninth WIPO Advanced Intellectual Property Research Forum: Towards a Flexible Application of Intellectual Property Law - A Closer Look at Internal and External Balancing Tools (2015) 2.

⁸⁷ J Thomas McCarthy, McCarthy on Trademarks and Unfair Competition (Fifth Edn) §31:153.

protection around artistic expressions. As previously stated, even commercial speech may simultaneously be considered artistic or political.

Even so, considering the idea that famous and well-known trade marks enjoy a higher level of protection in the context of dilution, there is a possibility that parodic trade marks would not be able to effectively protect themselves against claims of dilution, which rely on something different from likelihood of confusion. Additionally, the decreasing threshold to be included in the category of famous and well-known trade marks, which was mentioned above, could essentially neutralise parodic trade marks as a defence.

In the USA, considering the ever-growing amplitude of free speech, there is a slightly higher level of protection for these cases. Namely, in 2007 the *Haute Diggity Dog*⁸⁸ decision created space for others in this line, such as the *MOB*⁸⁹ decision of 2016. So far, even though it does not have a specific statutory provision, the “parody defence” is the most effective against famous and well-known trade marks, especially against the so-called “trade mark bullies” which tend to be excessively protective of their trade marks and prone to litigation. However, as was commented above, in the section on dilution, the limit is when the parodic trade mark is particularly distasteful, as was the case in the “*Enjoy Cocaine*”⁹⁰ decision. Recognising that determining what may tarnish a trade mark’s reputation may unduly limit free speech, especially considering the most recent positions of the USA courts regarding limits on free speech, I wonder for how long this type of assessment will still last.

The EU does not have a statutory parody defence *per se*. However, as it protects social and political speech, satire and artistic freedom of expression, a parody defence falls somewhere in between these. As such, a parody defence will depend on if there is a

⁸⁸ *Louis Vuitton Malletier SA v Haute Diggity Dog, LLC*, 507 F. 3d 252, 267, 84 U.S.P.Q. 2d 1969 (4th Cir. 2007).

⁸⁹ *Louis Vuitton Malletier SA v My Other Bag inc* 156 F. Supp. 3d 425 (S.D.N.Y. 2016).

⁹⁰ *Coca-Cola Co v Gemini Rising, Inc*, 346 F Supp. 1183, 1190-1191, 175 U.S.P.Q. 56 (E.D. N.Y. 1972).

humorous intention as well as a lack of competitive motives and absence of likelihood of confusion.⁹¹ Parodic use includes critique and controversial use, as long as there is no unfair advantage from said use, even if it is a commercial one. An interesting case on commercial use, though outside the EU, was the Laugh It Off decision⁹² in South Africa, in which the Constitutional Court drew from different jurisdictions to find that a parody is not acceptable if it is purely for commercial gain.⁹³ In the EU, the Deckmyn decision⁹⁴ was instrumental, as it stated that a parody is an autonomous concept of EU law, to be interpreted uniformly throughout the EU. The court summarised the criteria to take into account when deciding on whether a potentially parodic trade mark is admissible. According to the CJEU, a parody must evoke the original work, but be noticeably different from it and be likely to be understood as purposefully humorous or mocking in tone.⁹⁵ The parody must be fairly balanced with the rights of the trade mark owner, meaning, the parodic trade mark will not be allowed if it damages significantly the reputation or goodwill of the trade mark and its owner. Trade mark denigration is the harsh limit to parodic trade marks. In line with the typical *modus operandi* of the EU in balancing freedom of expression with trade marks, the principle of proportionality is plays a key role determining whether or not a parodic trade mark is allowed, as this decision is done on a case-by-case basis, weighing the specific circumstances, context and interests of the parties.

4. Conclusion

Regarding the registration of trade marks and freedom of expression, considering the recent developments in case law of the American jurisdiction, the USA registry and courts

⁹¹ Eniko Karsay and Laetitia Lagarde and Nikos Prentoulis ‘When trade mark rights meet free speech’ (2014) 243 *Managing Intell Prop* 16.

⁹² *Laugh It Off Promotions CC v South African Breweries International (Finance) BV t/a Sabmark International and Another* (CCT42/04) [2005] ZACC 7; 2006 (1) SA 144 (CC); 2005 (8) BCLR 743 (CC) (27 May 2005).

⁹³ Alan Smith ‘Trade Mark Dilution- You Can’t Laugh It Off’ (2004) *Juta's Business Law Vol 12 Issue 4*, 196-200.

⁹⁴ Case C-201/13 *Deckmyn and Vrijheidsfonds*, ECLI:EU:C:2014:2132 (2014).

⁹⁵ *Ibid* 83.

are better suited for trade mark owners, if they want to register a trade mark which may offend or be considered immoral. Conversely, the EU will still not allow for the registration of trade marks which go against public policy or the accepted principles of morality, though this may vary depending on the jurisdictions in which the trade mark seeks registration, according to the margins of appreciation granted by the ECtHR. Though the case *Fack Ju Göhte*⁹⁶ showed there is still space for parodic trade marks, as it stands, the American jurisdiction is more favourable for freedom of expression in general. However, there is a gap in both jurisdictions, namely concerning trade marks which appropriate cultural symbols. In this regard, the fact that the EU maintains a limit to registrations is less harmful, as symbols of high symbolic can include cultural heritage. Thus, freedom of expression should be, in some instances, limited, concerning the registration of trade marks, especially in those in which cultural signs are at stake. In that regard, the USA approach is more lacking than the EU one.

Similarly, regarding infringement and a potential defence based on freedom of expression, the USA courts have developed a more exhaustive defence, as is to be expected, considering the extraordinary importance of the First Amendment and its scarce limitations. In that line, parodic uses of trade marks are more acceptable in the USA than in the EU, especially if a commercial use is at stake. Particularly in the context of dilution, in which there is a higher protection granted to trade mark owners, both jurisdictions limit freedom of expression further. However, the USA is more inclusive in determining what trade marks are famous and well-known than the EU. This may be a compensation for the fact that trade mark owners are less protected against parodic uses, which tarnish their reputation, thus extending further protection to trade marks on a lower threshold of their status as famous.

The importance of free speech in trade marks is more developed in the USA than in the EU. The EU is gradually catching up but maintaining a more balanced approach.

⁹⁶ Ibid 23.

Considering the importance of cultural heritage to most of its Member States, it will probably always be more restrictive of free speech than the USA.

5. Bibliography

5.1. Primary Sources

5.1.1. Statutory law

- Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trade marks
- European Convention on Human Rights
- Lanham Act, 15 U.S.C. §§ 1051 et seq.
- Paris Convention for the Protection of Industrial Property

5.1.2. Case law

- *Basic Trade Marks SA's Trade Mark Application* (2006) ETMR 24, RPC 25
- *Brown v Entertainment Merchants Association* (27 June 2011) 564 U.S. 786, 131 S.Ct. 2729, 180 L.Ed.2d 708, 79 USLW 4658, 11 Cal. Daily Op. Serv. 7874, 2011 Daily Journal D.A.R. 9459, 22 Fla. L. Weekly Fed. S 1259
- *Casado Coca v Spain* (App no 15450/89) (1994)
- Case C-201/13 *Deckmyn and Vrijheidsfonds*, ECLI:EU:C:2014:2132 (2014)
- Case C-240/18 *P Constantin Film Produktion v EUIPO*, ECLI:EU:C:2020:18 P (2020) OJ C 161
- Case C-240/18 *P Constantin Film Produktion v EUIPO*, ECLI:EU:C:2019:553 (2019) Opinion of AG Bobek
- Case C-283/01 *Shield Mark*, ECLI:EU:C:2003:641 (2003)
- Case C-487/07 *L'Oréal SA, Lancôme parfums et beauté & Cie, Laboratoire Garnier & Cie v Bellure NV, Malaika Investments Ltd, Starion International Ltd*, ECLI:EU:C:2009:378 (2009)
- Case E-5/16 *Municipality of Oslo* (2017) EFTA
- Case E-12/10 *ESA v Iceland* (2011) EFTA Ct. Rep. 117
- Case T-232/10 *Couture Tech Ltd v OHIM*, ECLI:EU:T:2011:498 (2011)

- Case T-69/17 *Constantin Film Produktion v EUIPO*, ECLI:EU:T:2018:814 (2018)
- *Cincinnati v Discovery Network* (1993) 507 US 410, 123 L Ed 2d 99, 133 S Ct 1505, 1513
- *Coca-Cola Co v Gemini Rising, Inc*, 346 F Supp. 1183, 1190-1191, 175 U.S.P.Q. 56 (E.D. N.Y. 1972)
- *De Geillustreerde Pers v Netherlands* (App no 5178/71) (1876)
- *Dennis Nazir v George V Entertainment (SA) (BUDDHA-BAR)* (2011)
- *French Connection Ltd's Trade Mark Application* (2007) ETMR 8
- *Ghazilian's Trade Mark Application* (2002) ETMR 56, RPC 33
- *Groppera Radio AG v Switzerland* (App no 10890/84) (1990)
- *Guglielmi v Spelling-Goldberg Productions* (5 December 1979) 25 Cal.3d 860, 603 P.2d 454, 160 Cal.Rptr. 352, 205 U.S.P.Q. 1116, 5 Media L. Rep. 2208
- *Handyside v UK* (App no 5493/72) (1976)
- *Hearst Holdings Inc & Another v A.V.E.L.A. Inc & Others* (2014) EWHC
- *Iancu v. Brunetti*, 588 U.S. ____ (2019)
- *In re Boulevard Entertainment, inc* [2003] 334 F.3d 1336, 67 U.S.P.Q.2d 1475, later revoked by *In re Simon Shiao TAM* [2015] 808 F.3d 1321, 117 U.S.P.Q.2d 1001, 44 Media L. Rep. 1037
- *In re Lebanese Arak Corporation*, [2010] 94 U.S.P.Q.2d 1215 (Trademark Tr. & App. Bd.)
- *In re Riverbank Canning Co*, [1938] 25 C.C.P.A. 1028, 95 F.2d 327, 37 U.S.P.Q. 268
- *In re Tam* (2015) 808 F.3d 1321 1358 (Fed Cir)
- *Joseph Burstyn, Inc v Wilson* (26 May 1952) 343 U.S. 495, 72 S.Ct. 777, 96 L.Ed. 1098, 1 Media L. Rep. 1357
- *Joseph Matal, Interim Director, United States Patent and Trademark Office, Petitioner v Simon Shiao Tam* [2017] 137 S.Ct. 1744, 198 L.Ed.2d 366, 85 USLW 4389

- *Krone Verlag GMBH v Austria* (App no 27306/07) (2003)
- Laugh It Off Promotions CC v South African Breweries International (Finance) BV t/a Sabmark International and Another (CCT42/04) [2005] ZACC 7; 2006 (1) SA 144 (CC); 2005 (8) BCLR 743 (CC) (27 May 2005)
- *Lingens v Austria* (App no 9815/82) (1986)
- Lohan v Perez (21 February 2013) 924 F.Supp.2d 447
- Louis Vuitton Malletier SA v Haute Diggity Dog, LLC, 507 F. 3d 252, 267, 84 U.S.P.Q. 2d 1969 (4th Cir. 2007)
- Louis Vuitton Malletier SA v My Other Bag inc 156 F. Supp. 3d 425 (S.D.N.Y. 2016)
- Montgomery v Montgomery (21 November 2001) 60 S.W.3d 524, 61 U.S.P.Q.2d 1098, 30 Media L. Rep. 1045
- R 0495/2005-G *SCREW YOU* (2006)
- Riley v National Federation of Blind, Inc (1988) 487 US 781, 101 L Ed 2d 669, 109 S Ct 2667, 2677
- Rogers v Grimaldi (1989) 875 F.2d 994, 999, 16 Media L. Rep. (BNA) 1648, 10 U.S.P.Q.2d 1825
- Schad v Borough of Mount Ephraim (1 June 1981) 452 U.S. 61, 101 S.Ct. 2176, 68 L.Ed.2d 671, 7 Media L. Rep. 1426
- Tyne v Time Warner Entertainment Co, LP (26 September 2005) 425 F.3d 1363, 76 U.S.P.Q.2d 1478, 33 Media L. Rep. 2318, 18 Fla. L. Weekly Fed. C 999
- *Vajnai v Hungary* (App no 33629/06) (2008)
- Virginia State Board of Pharmacy v Virginia Citizens Consumer Council (1976) 425 US 784, 765, 48 L. Ed. 2d 346, 96 S. Ct 1817
- Ward v Rock Against Racism (22 June 1989) 491 U.S. 781, 109 S.Ct. 2746, 105 L.Ed.2d 661, 57 USLW 4879
- Winter v DC Comics (2 June 2003) 30 Cal.4th 881, 69 P.3d 473, 134 Cal.Rptr.2d 634, 66 U.S.P.Q.2d 1954, 31 Media L. Rep. 1774, 118 A.L.R.5th 727, 03 Cal. Daily Op. Serv. 4586, 2003 Daily Journal D.A.R. 5834

- *Winters v New York* (29 March 1948) 333 U.S. 507, 68 S. Ct. 665, 92 L. Ed. 840, 35 Media L. Rep. 2619
- *Zacchini v Scripps-Howard Broadcasting Co* (28 June 1977) 433 U.S. 562, 97 S.Ct. 2849, 53 L.Ed.2d 965, 40 Rad. Reg. 2d (P & F) 1485, 5 O.O.3d 215, 205 U.S.P.Q. 741, 2 Media L. Rep. 2089

5.2. Secondary sources

- Aplin T and Davis J, *Intellectual Property Law: Text, Cases, and Materials* (Third Edn, OUP 2017)
- Bently L, Sherman B and others, *Intellectual Property Law* (Fifth Edn, OUP 2018)
- Bereskin QC D R, 'Likelihood of confusion: the irrational basis of trade mark protection' *Journal of Intellectual Property Law & Practice*, 2019, Vol 14, No 3
- Burrell R and Gangjee Dev, 'Trade Marks and Freedom of Expression: A Call for Caution' *The University of Queensland, TC Beirne School of Law Legal Studies Research Paper Series* (2010)
- Craig P and de Búrca G, *EU Law: Text, Cases and Materials* (6th Edn, OUP 2015)
- EUIPO, *Guidelines for Examination of European Union Trade Marks, Part B, Examination, Section 4, Absolute Grounds for Refusal*
- Geiger C and Machado Pontes L, 'Trade mark registration, public policy, morality and fundamental rights' *CEIPI Research Paper No 2017-01* (2017)
- Griffiths J, 'Is there a right to an immoral trade mark?' *Intellectual Property and Human Rights*, P Torremans, ed, Kluwer Law International (2008)
- Karsay E, Lagarde L and Prentoulis N, 'When trade mark rights meet free speech' 243 *Managing Intell Prop* 16 (2014)
- Kur, A, 'Trademarks function, don't they? CJEU jurisprudence and unfair competition principles' *Max Planck Institute for Innovation and Competition Research Paper Series*
- Machado Pontes L, 'Trademark and freedom of speech: a comparison between the U.S. and the EU system in the awakening of *Johan Deckmyn v Helena Vandersteen*' *Ninth WIPO Advanced Intellectual Property Research Forum*:

Towards a Flexible Application of Intellectual Property Law - A Closer Look at Internal and External Balancing Tools (2015)

- McCarthy J, *McCarthy on Trademarks and Unfair Competition* (Fifth Edn)
- Mostert F and Baeumer L, *Famous and Well-known Marks: An International Analysis* (London: Butterworths, 1997)
- Ohly, A, *Common Principles of European Intellectual Property Law* (Mohr Siebeck 2012)
- Ramsey, L P 'Reconciling trademark rights and free expression locally and globally' (2014)
- Sakulin W, 'Trademark protection and freedom of expression' Kluwer Law International BV (2011)
- Sakulin W, '*Trademark protection and freedom of expression: an inquiry into the conflict between trademark rights and freedom of expression under European, German, and Dutch law*' IViR FdR (2010)
- Schovsbo J, "'Mark My Words" Trademarks and Fundamental Rights in the EU' UC IRVINE LAW REVIEW
- Senftleben M, 'A Clash of Culture and Commerce – Non-traditional Marks and the Impediment of Cyclic Cultural Innovation' OUP (2018)
- Senftleben M, 'Free Signs and Free Use – How to Offer Room for Freedom of Expression Within the Trademark System' RESEARCH HANDBOOK ON HUMAN RIGHTS AND INTELLECTUAL PROPERTY, C. Geiger, ed., Edward Elgar Publishing (2015)
- Senftleben M, Bently L and others, 'Recommendation on measures to safeguard freedom of expression and undistorted competition in EU trade mark law' (2014)
- Senftleben M, 'The Trademark Tower of Babel: Dilution Concepts in International, US and EC Trademark Law' 40(1) IIC 45 (2009)
- Snedden S, 'Immoral trade marks in the UK and at OHIM: how would the Redskins dispute be decided there?' *Journal of Intellectual Property Law & Practice*, Vol 11 No 4 (2016)

- Smith A, 'Trade Mark Dilution- You Can't Laugh It Off' Juta's Business Law Vol 12 Issue 4 (2004)
- Żelechowski Ł, 'Invoking freedom of expression and freedom of competition in trade mark infringement disputes: legal mechanisms for striking a balance' ERA Forum 19 (2018)