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Freedom of Expression and Trademarks

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From concepts...
Trademark = communication tool

exclusive link with a sign → advertising quality control → creation of a brand image

- identification
- distinctive character
- protection against confusion

- communication
- reputation/repute
- protection against dilution
Recognition by the CJEU

- CJEU, 18 June 2009, L’Oréal/Bellure
- ‘These functions include not only the essential function of the trade mark, which is to guarantee to consumers the origin of the goods or services, but also its other functions, in particular that of guaranteeing the quality of the goods or services in question and those of communication, investment or advertising.’ (para. 58)
Impact on communication resources

new meanings, new connotations (enrichment)

monopolization, redefinition (impoverishment)
Stakeholders

- social, political, cultural speech
- commercial speech

TM owner ↔ competitor

consumers
Online market places

52,048 results found for Tiffany

Signed Tiffany & CO. Sterling Silver Chain Bracelet with Heart
Returns: Accepted within 7 days

Authentic Tiffany & Co. 1837 Padlock Charm Bracelet -Sterling 925-
Expedited shipping available
Returns: Accepted within 14 days

TIFFANY & CO ‘MICHIGAN AVE’ STERLING SILVER PENDANT!! ***NO RESERVE***
Returns: Not accepted
Search engines
Google

i-pod

Doorzoek: © het internet © pagina's in het Nederlands © pagina's uit Nederland

Resultaten 1 - 10 van circa 308.000.000 voor i-pod (0,42 seconden)

De Apple® iPod Store
store.apple.com/nl/iPod Nieuwe iPod nano, touch, shuffle, & classic. Gratis thuis geleverd!

iPod MP3-spelers

Pod
www.BigDennis.com/i-Pod Bestel hier je goedkope i-Pod. Check het BigDennis assortiment!

Apple - iTunes - Alles wat je nodig hebt om jezelf te amuseren
Met iTunes kun je al je materiaal afspelen, zowel op de Mac als op een pc, en overzetten naar je iPod, iPhone of Apple TV. Daarnaast kun je voor al je ...
Download iTunes 9 - iTunes-overzicht - Mogelijkheden van iTunes
www.apple.com/nl/itunes/ - Verenigde Staten - In cache - Vergelijkbaar

Apple (Polska) - iPod - Porownaj modele iPoda i znajdź odpowiedni ... - [ Vertaal deze pagina ]
Niezwykle smukły, kolorowy iPod nano ma teraz nowy wygląd, kamerę wideo, ... iPod classic z pamięcią o pojemności 160 GB na muzykę, zdjęcia i wideo to iPod ...
www.apple.com/pl/iPod/whichipod/ - Verenigde Staten - In cache

Meer resultaten van www.apple.com weergeven

iPod - Wikipedia
Een iPod is een draagbare muziek- en mediaspeler van het Amerikaanse technologiebedrijf
Social media
Nevertheless, whatever the protection afforded to innovation and investment, it is never absolute. It must always be balanced against other interests, in the same way as trade mark protection itself is balanced against them. I believe that the present cases call for such a balance as regards freedom of expression and freedom of commerce.’ (para. 102)
‘...that the listings uploaded by users to eBay’s marketplace are communications protected by the fundamental rights of freedom of expression and information provided by Article 11 of [the] Charter of Fundamental Rights of the EU and Article 10 of the European Convention on Human Rights.’ (para. 49)
...to practice
(keeping signs free)
Available balancing tools

- exclusion of signs
- acceptance on certain conditions
- direct grant only if inherently distinctive

acquisition of distinctiveness through use

signs excluded from protection

inherently distinctive signs
Advertising slogans
CJEU, 21 January 2010, case C-398/08 P, Audi/OHIM

‘It is clear, however, [...] that those marks are not, by virtue of that fact alone, devoid of distinctive character.’ (para. 56)

‘...in particular, where those marks are not merely an ordinary advertising message, but possess a certain originality or resonance, requiring at least some interpretation by the relevant public, or setting off a cognitive process in the minds of that public.’ (para. 57)
New kinds of signs
‘Consumers are not in the habit of making assumptions about the origin of goods based on their colour or the colour of their packaging, in the absence of any graphic or word element, because as a rule a colour *per se* is not, in current commercial practice, used as a means of identification. A colour *per se* is not normally inherently capable of distinguishing the goods of a particular undertaking.’ (para. 65)
Signs of cultural significance

Mickey Mouse

Mona Lisa
'I find it more difficult to accept [...] that a creation of the mind, which forms part of the universal cultural heritage, should be appropriated indefinitely by a person to be used on the market in order to distinguish the goods he produces or the services he provides with an exclusivity which not even its author's estate enjoys.'

(Opinion A-G Colomer, 3 April 2003, para. 52)
Too much reliance on distinctive character?

• investment in abstract colour marks desirable?

• investment in cultural heritage marks desirable?

• important policy decisions left to market participants?
Art. 3(2) TMD

‘Any Member State may provide that a trade mark shall not be registered or, if registered, shall be liable to be declared invalid where and to the extent that:

b) the trade mark covers a sign of high symbolic value, in particular a religious symbol;...’
...to practice (exempting relevant use)
Available balancing tools

- use in trade/use as a trademark
- specific infringement criteria
- limitation of trademark rights

specific infringement criteria: likelihood of confusion/dilution
CJEU, June 12, 2008, case C-533/06, O2/Hutchison

- **O2:**
  - registered bubbles as a trademark

- **Hutchison:**
  - shows in advertising for telecom services black-and-white pictures of moving bubbles
  - compares prices of telecom services
  - not perceived as a source identifier by the public
• referential use actionable

• creation of a further exception

‘...that the proprietor of a registered trade mark is not entitled to prevent the use, by a third party, of a sign identical with, or similar to, his mark, in a comparative advertisement which satisfies all the conditions, laid down in Article 3a(1) of Directive 84/450 [= Article 4 Directive 2006/114/EG], under which comparative advertising is permitted.’

(para. 45)
CJEU, 22 September 2011, case C-323/09, Interflora/Marks & Spencer

• Marks & Spencer
  – selects the trademark ‘Interflora’ and variants as search terms
  – sponsored search result:
    ‘M & S Flowers Online
    www.marksandspencer.com/flowers
    Gorgeous fresh flowers & plants
    Order by 5 pm for next day delivery’
CJEU, 22 September 2011, case C-323/09, Interflora/Marks & Spencer

- coat-tail riding actionable
- creation of a new ‘due cause’ defence

‘... without offering a mere imitation of the goods or services of the proprietor of that trade mark, without causing dilution or tarnishment and without, moreover, adversely affecting the functions of the trade mark concerned – an alternative to the goods or services of the proprietor of the trade mark with a reputation,...’
CJEU, 22 September 2011, case C-323/09, Interflora/Marks & Spencer

‘...it must be concluded that such use falls, as a rule, within the ambit of fair competition in the sector for the goods or services concerned and is thus not without ‘due cause’.’ (para. 91)

• new type of ‘due cause’ defence for informing consumers about alternatives

• considerable breathing space for commercial freedom of speech
‘Due cause’ defence for parody

‘It is calm above the tree tops somewhere a cow is bellowing. Moo!’

(German Supreme Court, 3 February 2005, case I ZR 159/02, ‘Lila Postkarte’)
But which parody defence in double identity cases?

- identical signs
- identical goods or services

adverse effect on one of the protected trademark functions, including investment, advertising, communication
Solved by Article 10(2)(a) TMD Amendment Proposal?

- identical signs
- identical goods or services

‘and where such use affects or is liable to affect the function of the trade mark to guarantee to consumers the origin of the goods or services’
The end. Thank you!


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