

**14th EIPIN Congress, CEIPI
Strasbourg, April 7, 2013**

Freedom of Expression and Trademarks



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From concepts...



Trademark = communication tool



- 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

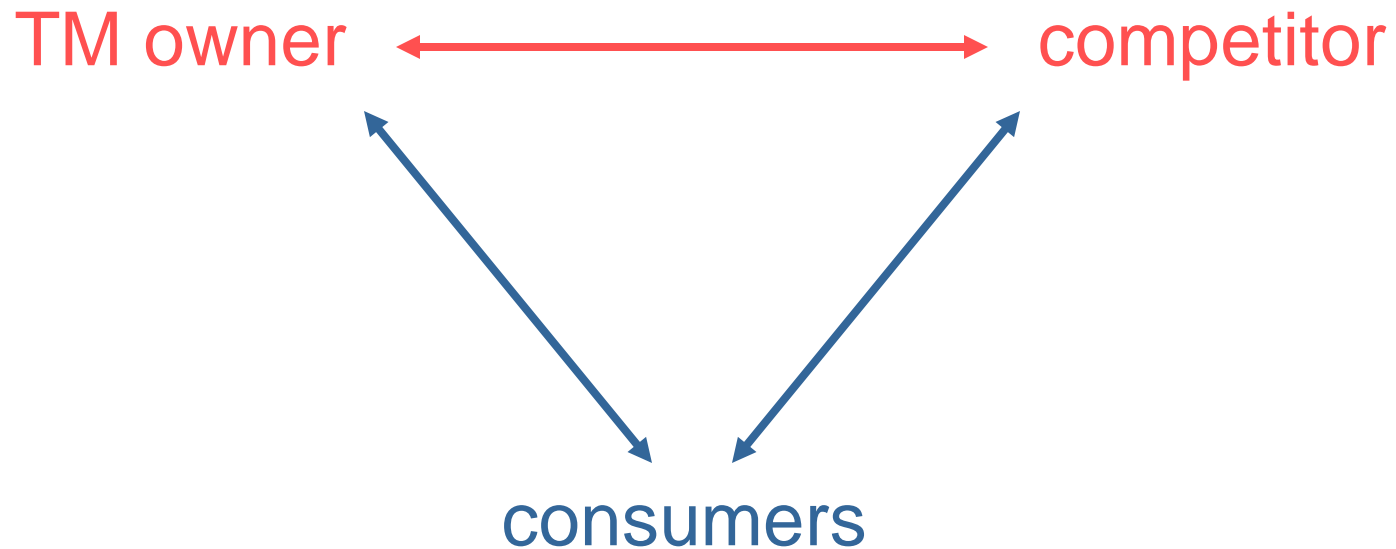
**new meanings,
new connotations
(enrichment)**

**monopolization,
redefinition
(impoverishment)**



Stakeholders

- social, political, cultural speech
- commercial speech



Online market places

The screenshot shows a web browser window displaying the eBay website. The address bar shows the URL http://www.ebay.com/sch/i.html?_nkw=Tiffany. The search bar contains the text "Tiffany". The page displays 52,048 search results. The left sidebar lists various categories such as Jewelry & Watches, Sports Mem, Cards & Fan Shop, and Home & Garden. The main content area shows three search results for Tiffany jewelry items, including a signed sterling silver chain bracelet with a heart charm, an authentic Tiffany T & Company 1837 padlock charm bracelet, and a Tiffany & Co 'Michigan Ave' sterling silver pendant.

Categories: JEWELRY & WATCHES, ELECTRONICS, FASHION, MOTORS, TICKETS, DEALS, CLASSIFIEDS

Search: Tiffany

52,048 results found for Tiffany

Categories:

- Jewelry & Watches (12,853)
- Designer Brands (10,452)
- Fine Jewelry (841)
- Watches (640)
- Vintage & Antique Jewelry (688)
- Fashion Jewelry (261)
- More
- Sports Mem, Cards & Fan Shop (10,988)
- Cards (10,489)
- Fan Apparel & Souvenirs (435)
- More
- Home & Garden (6,781)
- Lamps, Lighting & Ceiling Fans (4,841)
- Home Decor & Accents (953)
- More

All items | Auctions only | Buy It Now | Products & reviewsBeta

View as: [List] [Grid]

Sort by: Best Match | Page 1 of 1015

	SIGNED TIFFANY & CO. STERLING SILVER CHAIN BRACELET WITH HEART Returns: Accepted within 7 days Enlarge	26 Bids	\$89.00	3m
	Authentic Tiffany T & Company 1837 Padlock Charm Bracelet ~Sterling 925~ Expedited shipping available Returns: Accepted within 14 days	Top-rated seller	Buy It Now \$249.95 Free Shipping	29d 11h 18m
	TIFFANY & CO 'MICHIGAN AVE' STERLING SILVER PENDANT! ***NO RESERVE*** Returns: Not accepted	0 Bids	\$99.95 Free Shipping	10m

Windows taskbar: 17:58 7-5-2012

Search engines

The image shows a screenshot of a Google search for "coca cola". The browser window displays the search results page with a grid of images. The search bar contains "coca cola" and the results show "About 145,000,000 results (0.39 seconds)". The left sidebar includes navigation options like "Everything", "Images", "Maps", "Videos", "News", "Shopping", and "More". The main content area features a grid of images related to Coca-Cola, including logos, bottles, cans, and promotional graphics. The Windows taskbar at the bottom shows the time as 18:15 on 7-5-2012.

Search engines

http://www.google.com/search?hl=en&q=coca%20

coca cola - Google Search

Google coca cola

Norton

+You Search Images Maps Play YouTube News Gmail Documents Calendar More

Google coca cola

Search About 145,000,000 results (0.39 seconds)

Safe Search

Everything

Related searches: [coca cola bottle](#) [coca cola logo](#) [coca cola ads](#) [coca cola wallpaper](#) [coca cola can](#) [coca cola zero](#)

Images

Maps

Videos

News

Shopping

More

Any time

Past 24 hours

Past week

Custom range...

All results

By subject

Any size

Large

18:15
7-5-2012



i-pod

Zoeken

[Geavanceerd zoeken](#)Doorzoek: het internet pagina's in het Nederlands pagina's uit NederlandWeb [+ Opties weergeven...](#)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!

Gesponsorde links

[iPod MP3-spelers](#)www.bol.com/iPod

Zeer scherpe prijzen, alle iPods. Voor 21.30 besteld, morgen in huis!

[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](#)

Gesponsorde links

[Nano kopen?](#)Alle top mp3-spelers in diverse uitvoeringen. Bekijk ons aanbod!
www.dynabyte.nl[De Nano of toch de Touch?](#)Op zoek naar mooie Mp3 spelers? Alle modellen & prijzen!
Vergelijk.nl/mp3_speler/iPod[Uw advertentie hier >](#)[Apple \(Polska\) - iPod - Porównaj modele iPoda i znajdź odpowiedni ...](#) - [[Vertaal deze pagina](#)]

Nietwzwykle smukły, kolorowy iPod nano ma teraz nowy wygląd, kamerę video, ... iPod classic z pamięcią o pojemności 160 GB na muzykę, zdjęcia i video 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

The image shows a screenshot of a web browser displaying the Facebook page for Louis Vuitton. The browser's address bar shows the URL <http://www.facebook.com/LouisVuitton>. The search bar contains the text "louis vuitton facebook". The browser's taskbar at the bottom shows icons for Internet Explorer, a folder, a media player, and other applications. The Facebook page header includes the "facebook" logo, a login form with fields for "E-mailadres" and "Wachtwoord", and a "Aanmelden" button. Below the header is a promotional banner for Louis Vuitton featuring various trunks and the "LV" logo. The banner text reads "Louis Vuitton is op Facebook." and "Registreer je vandaag nog bij Facebook zodat je een connectie kunt maken met Louis Vuitton." with buttons for "Registreren" and "Aanmelden". Below the banner, the page name "Louis Vuitton" is displayed, along with the text "7.492.883 personen vinden dit leuk · 149.178 praten hierover" and a "Vind ik leuk" button. The page content area shows a "Bedrijf" profile description: "Louis Vuitton: a world of elegance, inspiration and innovation." and a row of navigation tabs: "Info", "Foto's", "Vind-ik-leuks" (with a "7,4m" count), "Core Values", and "Etoile Maison". The system tray at the bottom right shows the date and time as "18:08 7-5-2012".

http://www.facebook.com/LouisVuitton

Louis Vuitton | Facebook

Google louis vuitton facebook

Norton

Google™ This page is in Dutch. Translate it using Google Toolbar? [Learn more](#) Not in Dutch? [Help us improve](#)

Translate Turn off Dutch translation

facebook

E-mailadres Wachtwoord

Aanmelden

Laat mij aangemeld blijven Je wachtwoord vergeten?

Louis Vuitton is op Facebook.

Registreer je vandaag nog bij Facebook zodat je een connectie kunt maken met Louis Vuitton.

Registreren Aanmelden

LV

Louis Vuitton

7.492.883 personen vinden dit leuk · 149.178 praten hierover

Vind ik leuk

Bedrijf
Louis Vuitton: a world of elegance, inspiration and innovation.

Info Foto's Vind-ik-leuks Core Values Etoile Maison

7,4m

6

18:08
7-5-2012

CJEU, Google/Louis Vuitton, Opinion AG Poiares Maduro

‘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)

CJEU, L'Oréal/eBay, Opinion AG Jääskinen

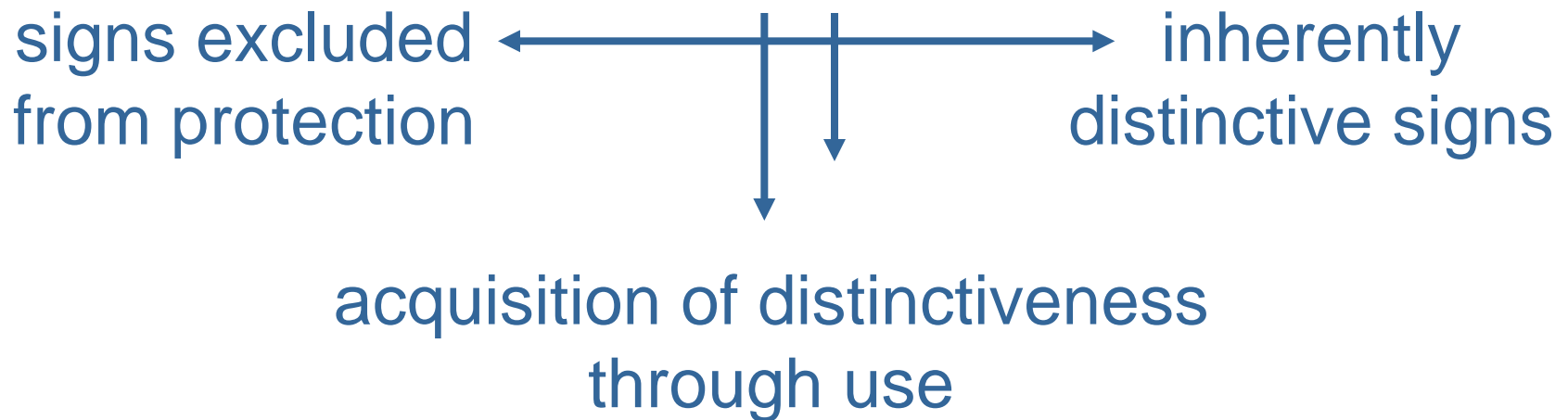
'...that the listings uploaded by users to eBay's marketplace are communications protected by the fundamental rights of freedom of expression and information provided by Article 11 of [the] Charter of Fundamental Rights of the EU and Article 10 of the European Convention on Human Rights.' (para. 49)

**...to practice
(keeping signs free)**



Available balancing tools

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



Advertising slogans

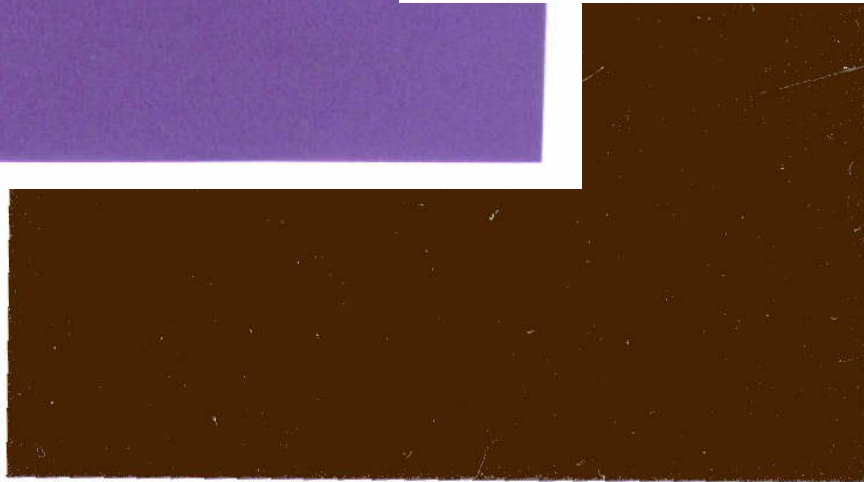
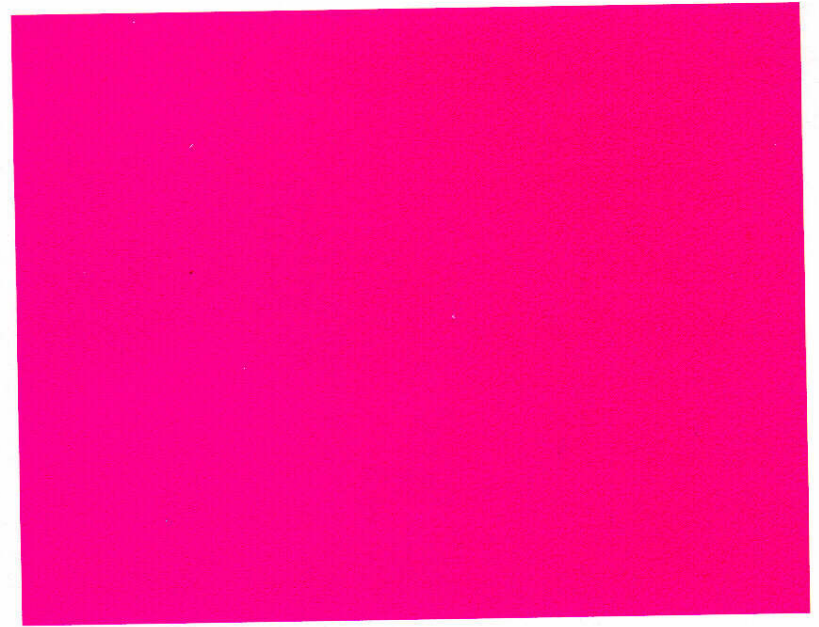
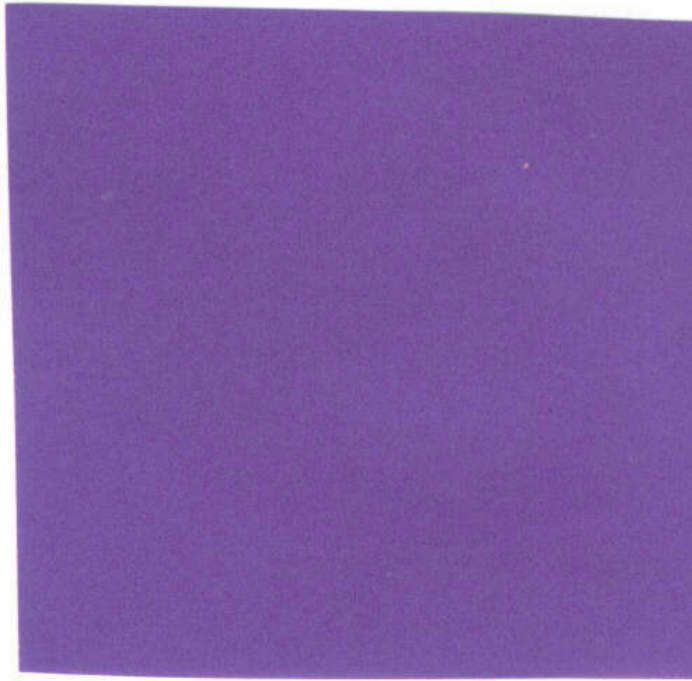


CJEU, 21 January 2010, case C-398/08 P, Audi/OHIM

‘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)

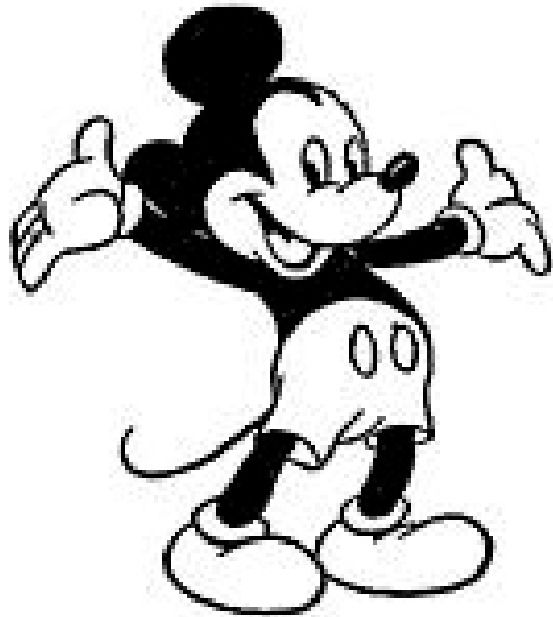
New kinds of signs



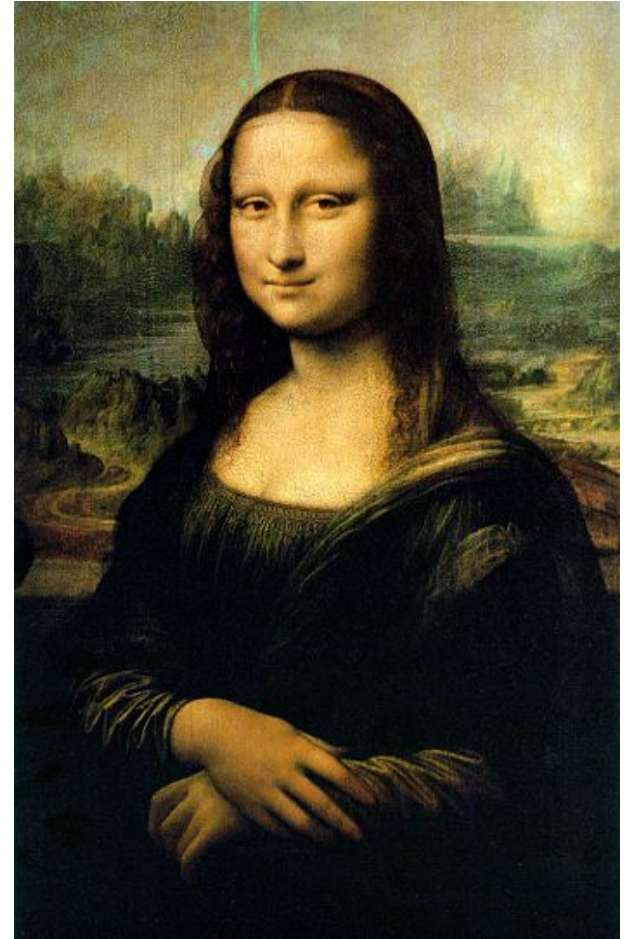
ECJ, 6 May 2003, case C-104/01, Libertel

‘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



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:

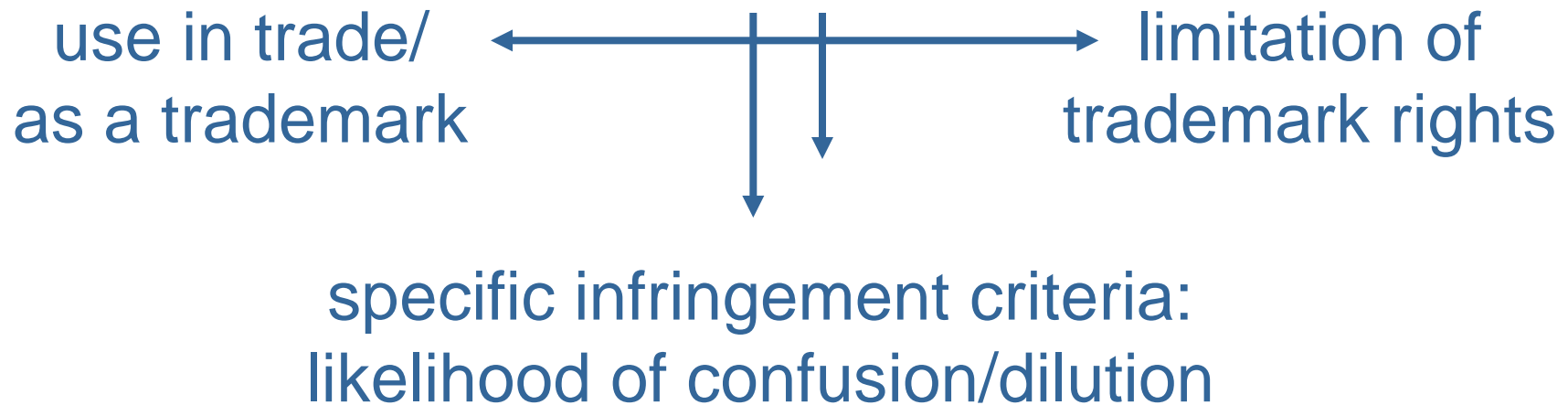
- b) the trade mark covers a sign of high symbolic value, in particular a religious symbol;...’

**...to practice
(exempting relevant use)**



Available balancing tools

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



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



CJEU, June 12, 2008, case C-533/06, O2/Hutchison

- 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!

**For publications, search for
'senftleben' on www.ssrn.com.**



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