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# 24. Expressive genericity revisited: What EU policymakers can learn from Rochelle Dreyfuss

**Martin Senftleben**

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## 1. INTRODUCTION

In her 1990 landmark article *Expressive Genericity: Trademarks as Language in the Pepsi Generation*,<sup>1</sup> Dreyfuss discusses the need for trademark rules that offer breathing space for the use of expressive meanings of strong brands that symbolize a particular lifestyle or attitude. These expressive meanings may be the result of investments made by the trademark proprietor.<sup>2</sup> The richness of associations and meanings may also follow from consumer activity. The consuming public frequently imbues trademarks with connotations distinct from the advertising messages conveyed by the trademark owner.<sup>3</sup> More than 30 years after publication, Dreyfuss' text has lost nothing of its relevance and power of persuasion. She identified a strong need to keep expressive use of the associations and meanings triggered by iconic trademarks free. Otherwise, the loss of the ability to use trademarks may impede the ability to communicate.<sup>4</sup> In her words, trademarks:

have become products in their own right, valued as indicators of the status, preferences, and aspirations of those who use them. Some trademarks have worked

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<sup>1</sup> Rochelle Cooper Dreyfuss, 'Expressive Genericity: Trademarks as Language in the Pepsi Generation' (1990) 65 *Notre Dame L Rev* 397.

<sup>2</sup> cf Jane C. Ginsburg, 'Intellectual Property As Seen by Barbie and Mickey: The Reciprocal Relationship of Copyright and Trademark Law' (2018) 65 *Journal of the Copyright Society of the USA* 245, 254–255.

<sup>3</sup> Dreyfuss (n 1) 415 and 424; Jessica Litman, 'Breakfast with Batman: The Public Interest in the Advertising Age' (1999) 108 *Yale LJ* 1717, 1732–1733; Deborah R. Gerhardt, 'Consumer Investment in Trademarks' (2010) 88 *North Carolina L Rev* 101; Steven Wilf, 'Who Authors Trademarks?' (1999) 17 *Cardozo Arts and Entertainment LJ* 1, 4–5.

<sup>4</sup> Dreyfuss (n 1) 415–418.

their way into the English language; others provide bases for vibrant, evocative metaphors. In a sense, trademarks are the emerging lingua franca: [W]ith a sufficient command of these terms, one can make oneself understood the world over, and in the process, enjoy the comforts of home.<sup>5</sup>

Trademarks, thus, constitute focal points of communication.<sup>6</sup> They may be capable of evoking ‘vibrant, evocative metaphors.’<sup>7</sup> However, the fact that trademarks may become information shortcuts that condense a highly complex amalgam of connotations does not mean that they are generic in the sense of the traditional concept underlying Article 6quinquies(B) No. 2 of the Paris Convention. Traditional genericity relating to use as a generic term in a current language or trade practice differs markedly from the expressive genericity concept that Dreyfuss describes. She distinguishes between use of the ‘signalling function’ of trademarks – corresponding with the traditional function of indicating the commercial origin of goods or services,<sup>8</sup> and use of the ‘expressive function’ of trademarks, which concerns use of the trademark as a shortcut for a certain image, lifestyle or attitude:

In referring to ‘Barbie’ in order to indicate that she was treated like a beautiful but empty-headed accessory, [Joan] Kennedy exploited a set of meanings that are quite different from the ones invoked by Mattel, and I label this use of the trademark ‘expressive.’<sup>9</sup>

Hence, ‘expressive genericity’ does not mean that the trademark as such has become a generic element of the current language. By contrast, it refers to a specific form of using trademarks in a metaphorical sense: not as identifiers of commercial source but as symbols of personal or societal conditions.<sup>10</sup> Despite the connotations allowing this play, the trademark serves as a reliable and distinctive indicator of commercial source. The distinction between a trademark’s ‘signalling function’ and its ‘expressive function’ is of particular importance. It allows traditional trademark protection of the signalling func-

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<sup>5</sup> *ibid* 397–398.

<sup>6</sup> *ibid* 415.

<sup>7</sup> *ibid* 397–398.

<sup>8</sup> cf Case C-1/81 *Pfizer vs. Eurim-Pharm* [1981] ECLI:EU:C:1981:291, para 8; Case C-206/01 *Arsenal v. Reed* [2002] ECLI:EU:C:2002:651, para 48.

<sup>9</sup> Dreyfuss (n 1) 400.

<sup>10</sup> cf Katya Assaf, ‘The Dilution of Culture and the Law of Trademarks’ (2008) 1 *IDEA: Intellectual Property Law Review* 49, 58–61.

tion of iconic trade symbols, while still offering room for freedom to use the expressive, metaphorical aspect of trade symbols.<sup>11</sup> As Dreyfuss concludes:

[I]t should be possible to build upon the defences that trademark law has constructed for the competitive vocabulary a parallel set of principles to protect expressive speech. In a regime that recognized the facility to compartmentalize, signaling functions would be analysed according to the conventional Polaroid principles, and the newly developed doctrines would operate to allocate rights when trademarks are used expressively. Proprietary rights to marks would then be protected across the entire signaling spectrum, except in instances in which expressive communication was suppressed by the loss of vocabulary.<sup>12</sup>

Hence, a central point of Dreyfuss' analysis is this: Expressive use of trademarks is different and should be treated differently. Instead of rendering the verdict of infringement on the basis of standard infringement tests, expressive use should be assessed in the light of specific criteria that lend sufficient weight to the metaphorical context in which the use takes place.

## 2. HONEST PRACTICES IN INDUSTRIAL OR COMMERCIAL MATTERS

Unfortunately, this central lesson – the insight that the application of standard infringement criteria is unlikely to yield satisfactory results – is still not fully understood on the other side of the Atlantic. With the 2015 reform of EU trademark law, a peculiar guideline for reconciling trademark protection with freedom of artistic expression made its way into Recital 27 of the EU Trade Mark Directive ('TMD')<sup>13</sup> and Recital 21 of the Trade Mark Regulation ('EUTMR').<sup>14</sup> '[u]se of a trade mark by third parties for the purpose of artistic expression should be considered as being fair as long as it is at the same time in accordance with honest practices in industrial and commercial matters.'<sup>15</sup>

This fairness rule supplements the provisions on limitations of trademark rights. Article 14(1) EUTMR and Article 14(1) TMD exempt several types of use from the control of trademark proprietors, including forms of use that may become relevant in the context of artistic expression. Article 14(1)(c) EUTMR

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<sup>11</sup> *ibid* 79–80.

<sup>12</sup> Dreyfuss (n 1) 418.

<sup>13</sup> 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 [2015] OJ L336/1.

<sup>14</sup> Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union Trade Mark (codification) [2017] OJ L154/1.

<sup>15</sup> EUTMR, Recital 21; TMD, Recital 27.

and Article 14(1)(c) TMD, for instance, permit referential trademark use without prior authorization of the trademark owner. Article 14(1)(b) EUTMR and Article 14(1)(b) TMD prevent the trademark owner from invoking trademark rights against descriptive use and non-distinctive use.<sup>16</sup> All these limitations of trademark rights, however, only apply ‘where the use made by the third party is in accordance with honest practices in industrial or commercial matters.’<sup>17</sup> With regard to artistic expression, the fairness rule in Recital 21 EUTMR and Recital 27 TMD, thus, confirms that the honest practices test is fully applicable. The fact that artistic expression is at stake does not exempt the artist from the obligation to meet the honest practices test.

### 3. INAPPROPRIATE ASSESSMENT CRITERION

As Dreyfuss demonstrated more than 30 years ago, it is highly problematic to align a fairness rule for expressive use with the requirement of honest industrial and commercial practices. Instead of providing a specific set of infringement criteria for expressive use, the honest practices test is a prime example of a ‘conventional Polaroid principle’<sup>18</sup> that can be traced back to the ban on unfair commercial practices in Article 10*bis*(2) of the Paris Convention.<sup>19</sup> In the light of Dreyfuss’ analysis, this regulatory design raises the question whether the standard of honesty ‘in industrial and commercial matters’ can ever be an appropriate yardstick for the assessment of expressive use in an artistic context. From the outset, the fair use analysis may be doomed to fail because industrial and commercial considerations are inapt to clarify the legitimacy of use in the artistic domain. Practical (section 3.1), socio-cultural (section 3.2) and legal-doctrinal (section 3.3) considerations militate against reliance on industrial and commercial standards when artistic expression is at stake.

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<sup>16</sup> For a more detailed discussion, see Martin Senftleben, ‘Robustness Check: Evaluating and Strengthening Artistic Use Defences in EU Trademark Law’ (2022) 53 IRIPCL 567, 581–585.

<sup>17</sup> EUTMR, art 14(2); TMD, art 14(2).

<sup>18</sup> Dreyfuss (n 1) 418.

<sup>19</sup> cf *Australia – Certain Measures Concerning Trademarks, Geographical Indications and Other Plain Packaging Requirements Applicable to Tobacco Products and Packaging* (28 June 2018) WT/DS435/R, WT/DS441/R WT/DS458/R, WT/DS467/R (Panels Reports), para 7.2666; Sam Ricketson, *The Paris Convention for the Protection of Industrial Property – A Commentary* (Oxford University Press 2015) paras 13.33–13.43.

### 3.1 Practical Concerns

It is not practical to expect an artist to be aware of behavioural standards in industry and commerce. The proviso of honest practices in industrial and commercial matters is impractical and disadvantageous for artists because they do not have the knowledge necessary to comply with these standards. The information deficit weakens the strategic position of artists in infringement proceedings. Even if the burden of establishing dishonest practices is placed on the trademark proprietor,<sup>20</sup> the artist must ascertain which behavioural norms are applicable to successfully rebut dishonesty arguments. As a trader, the trademark owner can be expected to be well acquainted with standards of honesty in industrial and commercial matters. The use of industrial and commercial standards as a yardstick for the assessment of expressive use in the artistic domain, thus, causes an information imbalance that gives the trademark proprietor an advantage and disregards the specific metaphorical context in which the use occurs. In contrast to the artist, the trademark owner can remain in her own sector and play a home game.

### 3.2 Theoretical Concerns

Recital 21 EUTMR and Recital 27 TMD, however, also give rise to a more fundamental issue. The subordination of artistic expression to an industrial and commercial assessment standard is highly undesirable. It obliges artists to align their work with commercial standards of fairness and honesty that are inappropriate in the case of cultural productions. Cultural sociology sheds light on the serious risk of eroding art autonomy that arises from the current configuration of the fairness test for artistic expression in EU trademark law. Pierre Bourdieu's sociological analysis of the field of literary and artistic production leaves no doubt that a thriving literary and artistic sector – capable of unmasking deficiencies in society and providing impulses for the improvement of social and political conditions<sup>21</sup> – requires independence of artists from economic and political powers.

Refining Niklas Luhmann's concept of relatively closed social systems with a distinct identity and a boundary between them and their environment,<sup>22</sup> Pierre Bourdieu developed the concept of 'fields' in society. Although constituting

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<sup>20</sup> Cf. Annette Kur and Martin Senftleben, *European Trade Mark Law – A Commentary* (Oxford University Press 2017) paras 6.78–6.79.

<sup>21</sup> Cf. Martin Senftleben, *The Copyright/Trademark Interface – How the Expansion of Trademark Protection Is Stifling Cultural Creativity* (Wolters Kluwer 2020) 54–66.

<sup>22</sup> Niklas Luhmann, *Soziale Systeme: Grundriß einer allgemeinen Theorie* (Suhrkamp 1984) 31 and 35–70.

an autonomous social space with individual rules, dominance structures and an established set of opinions, a field is not isolated from other social spaces and processes surrounding it. According to Bourdieu, the structure of a field results from constant internal fights of competing players for predominance and leadership.<sup>23</sup> A field's degree of autonomy, then, depends on the extent to which external players can influence these internal fights.<sup>24</sup> For the assessment of the autonomy of a given field, it is thus necessary to examine its relationship with the social environment in which it is embedded at a given point in time.<sup>25</sup>

Applying this theoretical model to the field of literary and artistic production, Bourdieu assumes that the field's autonomy rests on the rejection of the capitalism of the bourgeoisie. The specific 'nomos' of the literary and artistic field lies in the independence from economic and political powers.<sup>26</sup> Instead of aligning her work with commercial or political considerations, an autonomous artist aims at internal recognition within the field. The artist emancipates herself from the focus on commercial necessities and rewards.<sup>27</sup> As a result, the consecration mechanisms in the literary and artistic field – the power to set quality standards and dominate the internal discourse – become self-referential: *l'art pour l'art*. The field of literature and art becomes a universe countering the profit logic that impregnates the economic and political discourse in society.<sup>28</sup> The break with commercial and political powers constitutes the basis of an artist's independent, autonomous existence.<sup>29</sup> It allows artworks to critically reflect on societal conditions and pave the way for necessary reforms.<sup>30</sup>

This cultural sociology perspective offers an important theoretical confirmation of Dreyfuss' plea for a specific set of criteria to assess expressive use in trademark law. It follows from this configuration of the field of literary and artistic production that an artist must not be obliged to align her work with behavioural standards that stem from another field of society. From this perspective, it is intolerable that EU trademark law pressures artists to observe standards of honesty in industrial and commercial matters. Recital 21 EUTMR

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<sup>23</sup> Pierre Bourdieu, *Die Regeln der Kunst. Genese und Struktur des literarischen Feldes* (Suhrkamp 1999) 253–255 and 368.

<sup>24</sup> P. Bourdieu, R. Chartier and R. Darnton, 'Dialog über die Kulturgeschichte', *Freibeuter – Vierteljahrszeitschrift für Kultur und Politik* (Verlag Klaus Wagenbach 1985) 22, 28.

<sup>25</sup> Bourdieu (n 23) 134.

<sup>26</sup> *ibid* 103–105.

<sup>27</sup> *ibid* 344.

<sup>28</sup> cf Alexander Peukert, 'Fictitious Commodities: A Theory of Intellectual Property Inspired by Karl Polanyi's Great Transformation' (2019) 29 *Fordham Intell. Prop. Media & Ent L.J.* 1151, 1178–1179.

<sup>29</sup> Bourdieu (n 23) 105.

<sup>30</sup> *ibid* 342.

and Recital 27 TMD appear as an institutionalized subordination of cultural productions to the predominant commercial orientation of modern capitalist societies.<sup>31</sup>

The potential corrosive effect of this legislative decision must not be underestimated. On the basis of his analysis of the power relations in the literary and artistic field, Bourdieu painted an alarming picture of the field's degree of autonomy 30 years ago – two years after the publication of Dreyfuss' landmark article. In the light of reduced state subsidies for cultural productions and the rise of sponsoring by enterprises, Bourdieu warned of an increasing mutual penetration of the world of art and the world of money: He saw more and more literary and artistic productions becoming subject to entrepreneurial marketing strategies and commercial pressures.<sup>32</sup> Therefore, he predicted the loss of autonomous literary and artistic productions.<sup>33</sup> Considering the growing influence of commercial players and profit rationales, he feared that commercial influences would finally suppress the critical thinking that is necessary for independent avant-garde works.<sup>34</sup>

Considering these insights from cultural sociology, it becomes evident that the reference point chosen in Recital 21 EUTMR and Recital 27 TMD is wrong. The requirement of use in accordance with behavioural norms in the industrial and commercial sector cements the supremacy of trade and commerce over the field of art and culture: Even if use appears fair and legitimate in the light of artistic standards, it may still amount to trademark infringement when established industrial and commercial practices point in the opposite direction. The legislator allows the logic of commerce and trade to prevail over the *l'art pour l'art* logic of culture and art – an alarming decision that encourages the erosion of the autonomy of literary and artistic productions.

### 3.3 Legal-doctrinal Concerns

The problem becomes greater when legal-doctrinal developments are factored into the equation. The Court of Justice of the European Union ('CJEU') tends to determine compliance with honesty in industrial and commercial matters on the basis of the same criteria that inform the analysis of *prima facie* infringement in trademark confusion and dilution cases.<sup>35</sup> This jurisprudence strength-

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<sup>31</sup> cf Senftleben (n 16) 581–585.

<sup>32</sup> Bourdieu (n 23) 530.

<sup>33</sup> *ibid* 533.

<sup>34</sup> *ibid* 531.

<sup>35</sup> Martin Senftleben and others, 'The Recommendation on Measures to Safeguard Freedom of Expression and Undistorted Competition: Guiding Principles for the Further Development of EU Trade Mark Law' (2015) 37 *EIPR* 337, 339.



ens concerns that, examining artistic expression in the light of the honest practices proviso, industrial and commercial standards will prevail and finally erode art autonomy. As currently applied, the inquiry into honest commercial practices is far from including values from other societal domains, such as the field of literary and artistic production. Instead, the CJEU simply replicates infringement criteria that belong to the canon of standard behavioural norms in the sector of industry and commerce. In *Gillette*, the Court held that use would fail to comply with honest practices in industrial and commercial matters if, for example:

- it is done in such a manner as to give the impression that there is a commercial connection between the third party and the trade mark owner;
- it affects the value of the trade mark by taking unfair advantage of its distinctive character or repute;
- it entails the discrediting or denigration of that mark;
- or where the third party presents its product as an imitation or replica of the product bearing the trade mark of which it is not the owner.<sup>36</sup>

While some of these assessment factors can be traced back to EU legislation about comparative advertising,<sup>37</sup> the prohibition of use that gives the impression of a commercial connection with the trademark owner, and the ban on use that damages or takes unfair advantage of the mark's distinctive character or repute, correspond to infringement criteria in the field of trademark protection against confusion and dilution.<sup>38</sup> The risk of circularity is obvious: by copying almost literally the criteria for establishing *prima facie* infringement, the CJEU subjects defences to additional scrutiny in the light of the same criteria that enabled the trademark owner to bring the infringement claim in the first place.<sup>39</sup>

This circular line of reasoning may render defence arguments for artistic expression, such as the specific character of expressive, metaphorical use of trademarks, moot in practice.<sup>40</sup> The requirement of use in accordance

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<sup>36</sup> Case C-228/03 *Gillette v LA-Laboratories* [2005] ECLI:EU:C:2005:177, para 49.

<sup>37</sup> Directive 2006/114/EC of the European Parliament and of the Council of 12 December 2006 Concerning Misleading and Comparative Advertising (codified version) [2006] OJ L376/21, art 4(d), (f), (g) and (h). cf Kur and Senftleben (n 9) para 6.72.

<sup>38</sup> EUTMR, art 9(2)(b) and (c); TMD, art 10(2)(b) and (c).

<sup>39</sup> cf Case C-558/08 *Portakabin Ltd v Primakabin BV*, para 69.

<sup>40</sup> cf Kur and Senftleben (n 20) para 6.73; Senftleben and others (n 35) 339; Ilanah Simon Fhima, 'The Role of Legitimacy in Trade Mark Law' (2012) 65 *Current Legal Problems* 489, 501–502.

with honest practices in industrial and commercial matters degenerates into a torpedo, which the trademark proprietor can employ to neutralize limitations of trademark rights that provide defence arguments for artists. The symmetry of criteria for assessing *prima facie* infringement and determining honesty in industrial and commercial matters can easily lead to a situation where a finding of a likelihood of confusion or dilution foreshadows the denial of compliance with honest commercial practices. Once again: Instead of developing, in line with Dreyfuss' recommendation, individual infringement criteria to properly assess the special situation that arises in the case of expressive use, the approach that has evolved in EU trademark law and practice leads to the opposite result. Expressive use is exposed to an assessment in the light of conventional infringement criteria that may fail to attach weight to the specific expressive context.

#### 4. A WAY OUT OF THE DILEMMA

Is it possible to alleviate the problems arising from a fairness rule for artistic expression that is aligned with conventional infringement criteria and behavioural standards in the industrial and commercial domain? After the 2015 trademark law reform in the EU, there is no planned legislative initiative for the adoption of a specific 'parallel set of principles to protect expressive speech.'<sup>41</sup> EU legislation is unlikely to revisit the expressive use question any time soon.

Hence, the only remaining option is the creation of a specific set of trademark rules for expressive use cases on the basis of the existing legislative text, including the honest practices proviso. Interestingly, the debate on the 2015 amendment of EU trademark law offers a reference point for this solution. Seeking to provide guidance for the reform, the *Recommendation on Measures to Safeguard Freedom of Expression and Undistorted Competition in EU Trade Mark Law*<sup>42</sup> proposed solving the problem of circularity in the honest practices jurisprudence as follows:

The only way to make sense of the wording would be to clarify that although the basic concepts (likelihood of confusion, abuse of reputation) informing the evaluation of honest business practices are the same as those governing infringement, their application is different in that the leeway for using a basically conflicting mark is much broader where applications or limitations apply, thereby confining the proprietor's right to oppose such use to cases of disproportionate harm.<sup>43</sup>

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<sup>41</sup> Dreyfuss (n 1) 418.

<sup>42</sup> Senftleben and others (n 35) 341–343. cf Kur and Senftleben (n 20) para 6.74.

<sup>43</sup> Senftleben and others (n 35) 339.

In the debate, Annette Kur added the following, more detailed explanation:

It is therefore important to emphasize that instead of applying those factors in the same way as when infringement is *prima facie* established, the interpretation must proceed in a more fine-grained fashion, taking account of the countervailing interests safeguarded by the limitations.<sup>44</sup>

The argument is thus: even if the assessment of honesty in industrial and commercial matters rests on the same criteria that have previously been used to establish *prima facie* infringement, the outcome can still be different when the criteria are applied in a more flexible way. The required flexibility can be derived from the values underlying the allegedly infringing use, such as freedom of artistic expression. Weighing the interests of the trademark owner against the interests of the defendant, judges can attach particular importance to the values that support the defendant and avoid the verdict of infringement. When a trademark is used for the purpose of artistic expression, these guidelines allow the artist to prevail for at least two reasons:

- the need to reconcile trademark protection with freedom of expression and freedom of the arts; and
- the disproportionality of enforcing trademark rights even though artistic use is unlikely to imperil the ‘signalling function’<sup>45</sup> of trademarks, which corresponds with the traditional function of indicating the commercial origin of goods or services.

As to the first point, artistic expression enjoys protection on the basis of the constitutional guarantee of freedom of expression and freedom of the arts in Articles 11 and 13 of the EU Charter of Fundamental Rights (‘CFR’).<sup>46</sup> The artist and the trademark proprietor, thus, meet at eye level. While the trademark owner can invoke the right to property, including the recognition of intellectual property in Article 17(2) CFR, the artist can rely on Articles 11 and 13 CFR. The legal position of the artist is not *a priori* weaker than the status that the trademark owner enjoys.<sup>47</sup>

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<sup>44</sup> Annette Kur, ‘Yellow Dictionaries, Red Banking Services, Some Candies, and a Sitting Bunny: Protection of Color and Shape Marks from a German and European Perspective’ in Irene Calboli and Martin Senftleben (eds), *The Protection of Non-Traditional Trademarks – Critical Perspectives* (Oxford University Press 2018) 89, 105.

<sup>45</sup> Dreyfuss (n 1) 418.

<sup>46</sup> Charter of Fundamental Rights of the European Union [2000] OJ L364/1.

<sup>47</sup> cf Lisa P. Ramsey and Jens Schovsbo, ‘Mechanisms for Limiting Trade Mark Rights to Further Competition and Free Speech’ (2013) 44 *IRIPCL* 671; Wolfgang Sakulin, *Trademark Protection and Freedom of Expression – An Inquiry into the*

In addition, use of trademarks in an artistic setting is use in an expressive, metaphorical sense: The trademark is employed as a symbol of personal or societal conditions. Use of trademarks in art concerns a metaphorical play with the associations evoked by a trademark in the minds of consumers and the societal conditions that a trademark reflects.<sup>48</sup> This insight has a deep impact on the balancing exercise to be conducted in the light of the principle of proportionality. As the artist does not use the trademark as a badge of origin, the detriment to the trademark proprietor, by definition, is reduced. Artistic use may still do harm by mocking and criticizing the trademark owner, or using the trademark for a critique of societal conditions that the trademark owner finds irreconcilable with the favourable brand image she wishes to maintain.<sup>49</sup> Nonetheless, the fact remains that artistic use does not encroach upon the signalling function of the trademark. From this perspective, the detriment to the trademark owner is limited from the outset.

## 5. CONCLUSION

Taking the described insights together – the anchorage of artistic expression in constitutional freedoms and the proportionality of harm flowing from a metaphorical play with trademarks – it becomes possible to weave a general bias in favour of artistic expression into the fabric of the honest practices test: a legal bias in the sense of a legal presumption of fair use that allows use of a trademark for the purpose of artistic expression to routinely survive scrutiny in the light of the honest practices proviso. Following this maxim, use of trademarks should be deemed fair in artistic contexts unless the trademark proprietor manages to overcome the legal presumption by presenting individualized facts<sup>50</sup> that provide proof of unusually grave trademark harm. More specifically, the trademark owner should demonstrate that, despite the artistic setting, the use *explicitly* misleads consumers as to the commercial origin of the artwork. In the case of a trademark with a reputation that enjoys protection against dilution in the EU,<sup>51</sup> the trademark owner should show that the use *deliberately* blurs, tarnishes or exploits in an unfair manner the distinctive-

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*Conflict between Trademark Rights and Freedom of Expression under European Law* (Kluwer 2010) 247-282; Christophe Geiger, 'Trade Marks and Freedom of Expression – the Proportionality of Criticism' (2007) 38 *IRIPCL* 317.

<sup>48</sup> Cf. Dreyfuss (n 1) 418.

<sup>49</sup> See the case law overview in Kur and Senftleben (n 20) paras 5.267 and 6.59–6.70.

<sup>50</sup> Yochai Benkler, 'Free as the Air to Common Use: First Amendment Constraints on Enclosure of the Public Domain' (1999) 74 *NYULR* 354, 362-363.

<sup>51</sup> Cf. Kur/Senftleben (n 19) paras 5.201–5.204.

ness or repute of the trademark with a reputation.<sup>52</sup> As the words ‘explicitly’ and ‘deliberately’ indicate, the threshold for a finding of dishonest practices should thus be higher than in the regular confusion or dilution analysis.<sup>53</sup> This approach is in line with the above-described strategy for remedying the circularity in CJEU jurisprudence and Dreyfuss’ recommendation to develop specific rules when expressive use is at issue. Although assessment criteria are used that have already supported a finding of *prima facie* infringement, the outcome of the honest practices analysis can be different because the criteria are applied in a modified way – in a way that lends weight to freedom of expression and freedom of the arts.

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<sup>52</sup> TMD, art 10(2)(c); EUTMR, art 9(2)(c). Cf. Kur/Senftleben (n 19) paras 5.182–5.192.

<sup>53</sup> For a more detailed discussion, see Senftleben (n 21) 432–456.