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Public Order in the Light of Aesthetic Theory: The Copyright/Trademark Interface after *Vigeland*

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27.1 INTRODUCTION

Annette Kur's publications on the coherence of the intellectual property system are an incessant source of inspiration for further research and critical reflection. In one of her landmark essays on overlapping intellectual property rights, she develops a general framework for the assessment of cumulative protection. According to this framework, the combination of different intellectual property rights is not problematic per se. In principle, the cumulation of rights is acceptable as long as the individual protection regimes involved are balanced in the sense that the prerequisites for obtaining protection are appropriately aligned with the contents and limits of exclusive rights.[2] From this perspective, it is not the cumulation of rights that causes overprotection problems. By contrast, these problems are symptoms of imbalances within the protection systems involved.[3] If the prerequisites for obtaining different types of intellectual property rights remain distinct from each other, and the checks and balances in the different protection regimes are sufficient to prevent excessive protection, the overlap is unlikely to obstruct competition and should be deemed permissible.[4] If, however, the requirements for obtaining protection in different regimes converge while the contents and limits of protection remain unchanged, overlapping protection raises the problem of "asymmetric convergence" and requires appropriate countermeasures.[5]

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[2] A. Kur, *Funktionswandel von Schutzrechten: Ursachen und Konsequenzen der inhaltlichen Annäherung und Überlagerung von Schutzrechtstypen*, in: G. Schricker/T. Dreier/A. Kur (eds.), Geistiges Eigentum im Dienst der Innovation, Nomos 2001, 23 (45 and 50).

[3] Kur, ibid., 45.

[4] Ibid., 42–43.

[5] Ibid., 43–44.

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This assessment standard paves the way for nuanced solutions. Instead of bright-line rules, the acceptance of overlaps depends on a thorough scrutiny of the intellectual property systems involved. As long as a sufficient arsenal of legal safeguards against excessive protection is available – safeguards that are aligned with the prerequisites for obtaining protection – it is possible to afford intellectual property owners the opportunity to combine exclusive rights stemming from different protection regimes.

27.2 COPYRIGHT/TRADEMARK PROTECTION OVERLAPS

In the debate on cumulative protection, overlaps between intellectual property rights with a limited period of protection and indefinitely renewable trademark rights have attracted attention for a long time. Case law sheds light on the underlying problem. In *Dastar/Twentieth Century Fox*, the U.S. Supreme Court held that overlaps between trademark rights and copyright or patent protection can have a corrosive effect on the "carefully crafted bargain" under which, once the patent or copyright monopoly has expired, the public may use the invention or work at will.[6] The Court of Justice of the European Union (CJEU) expressed similar concerns in *Hauck/Stokke*, where it explained that the functionality doctrine in trademark law served the purpose of preventing the exclusive and permanent right which a trademark confers "from serving to extend indefinitely the life of other rights which the EU legislature has sought to make subject to limited periods."[7] However, the prevention of an artificial extension of rights is not an end in itself. As Annette Kur has emphasized[8] – and judges have confirmed[9] – an artificial extension of protection via trademark law is undesirable because it may impede competition. The grant of trademark rights may lead to a continuous monopolization of decisive product features which consumers are likely to seek in the products of competitors.[10]

Despite widespread agreement on this problem statement, intellectual property legislation does not devote the same attention to all overlap scenarios. Instruments to draw a boundary line between copyright and trademark protection, for instance, seem underdeveloped. Character merchandising leads to cumulative copyright and trademark protection of contemporary cultural symbols.[11] In principle, it is also possible to acquire trademark rights to cultural heritage symbols once distinctive

[6] U.S. Supreme Court, 2 June 2003, *Dastar/Twentieth Century Fox*, 539 U.S. 23 (2003), 33–34.
[7] CJEU, 18 September 2014, case C-205/13, *Hauck/Stokke*, paras. 19–20.
[8] A. Kur, *Too Pretty to Protect? Trade Mark Law and the Enigma of Aesthetic Functionality*, Max Planck Institute for Intellectual Property & Competition Law Research Paper No. 11-16, Max Planck Institute 2011, 21.
[9] CJEU, supra note 7, paras. 18–19.
[10] CJEU, ibid., para. 18; CJEU, 18 June 2002, case C-299/99, *Philips/Remington*, para. 78.
[11] Cf. I. Calboli, *Overlapping Trademark and Copyright Protection: A Call for Concern and Action*, Illinois Law Review Slip Opinion 2014, No. 1, 25 (29–30).

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character is acquired through use in trade.[12] The situation differs markedly from the status quo reached in the area of patent/trademark overlaps. At the intersection of these two protection regimes, the doctrine of utilitarian functionality prevents the cumulation of exclusive rights.[13] Similarly, the doctrine of aesthetic functionality can be employed to arrive at a far-reaching separation of trademark and industrial design protection.[14]

Against this background, the question arises whether the copyright/trademark interface is configurated in a way that can be deemed acceptable. Employing Annette Kur's assessment criteria, it may be asked whether trademark law offers sufficient gatekeeper instruments to prevent the acquisition of cumulative copyright and trademark protection in cases where the overlap would lead to excessive protection in the light of available checks and balances.

27.3 VIGELAND

In this respect, the *Vigeland* decision of the Court of Justice of the European Free Trade Association States (EFTA Court) is of particular interest. The Court cultivates public order and morality as absolute grounds for refusal that can be invoked in cases where trademark protection is sought for signs that constitute literary and artistic works.[15] From a legal-doctrinal perspective, it is consistent to use public order

[12] For example, see Court of Appeals of Brussels, 3 October 2013, cases 2013/7132 and 2013/7133, *Anne Frank Foundation/ Benelux Office for Intellectual Property* (concerning the book titles *The Diary of Anne Frank* and *The Secret Annex*), and OHIM Board of Appeal, 31 August 2015, case R 2401/2014-4, *Anne Frank Fonds*, paras. 32–36 (granting trademark rights to the French indication *Le Journal d'Anne Frank*); German Federal Court of Justice, 24 April 2008, case I ZB 21/06, *Marlene-Dietrich-Bildnis* (concerning a portrait photograph of the actress); German Federal Patent Court, 25 November 1997, case 24 W (pat) 188/96, *Mona Lisa* (concerning the *Mona Lisa* painting), Gewerblicher Rechtsschutz und Urheberrecht 1998, 1022. For an even broader concept of assuming distinctiveness in cases involving cultural heritage names, see CJEU, 6 September 2018, case C-488/16 P, *Bundesverband Souvenir – Geschenke – Ehrenpreise/EUIPO*, paras. 65–66, 69.

[13] Developments in the EU can serve as an example in this regard. See the decisions CJEU, 18 June 2002, case C-299/99, *Philips/Remington*, para. 82, and CJEU, 14 September 2010, case C-48/09 P, *Lego/Mega Brands*, paras. 45, 53–58, which lead to a separation of the two protection regimes even if technical alternatives exist.

[14] In the EU, the potential of the doctrine of aesthetic functionality has been enhanced significantly in CJEU, 18 September 2014, case C-205/13, *Hauck/Stokke*, paras. 19–20, where the Court developed a list of flexible factors for the identification of signs that are to be excluded from trademark protection for this reason. This is not to say that the doctrine of aesthetic functionality has not been criticized. For example, see G. B. Dinwoodie, *The Death of Ontology: A Teleological Approach to Trademark Law*, Iowa Law Review 84 (1999), 611 (685–691); Kur, supra note 8, 6–12. The central point here, however, is that in practice the application of the functionality doctrine can have the effect of separating the protection regimes to a considerable extent.

[15] For case comments, see A. Kur, *Gemeinfreiheit und Markenschutz – Bemerkungen zur Entscheidung des EFTA-Gerichtshofs im 'Vigeland'-Fall*, Gewerblicher Rechtsschutz und Urheberrecht 2017, 1082; M. R. F. Senftleben, *Vigeland and the Status of Cultural*

and morality for this purpose. As Annette Kur has demonstrated, the functionality doctrine in trademark law is a subcategory of a refusal based on public order or morality.[16] The invocation of functionality leads to a categorical exclusion of the sign concerned – irrespective of whether the sign is distinctive.[17] Therefore, the correct basis for explaining the application of the functionality doctrine – in particular under the *telle quelle* protection rule following from Article 6*quinquies* (B) No. 3 PC – is public order and morality.[18] Given this close connection, it appears consistent to rely on public order and morality as grounds for refusal that supplement the doctrine of aesthetic functionality when it comes to copyright/trademark overlaps. The field of application of this supplementary rule must not be underestimated. By definition, the functionality doctrine only covers essential product characteristics. Cultural signs, however, need not feature prominently on the product itself. If merely used as a label, a cultural sign can hardly be found to define product characteristics.[19]

In *Vigeland*,[20] the EFTA Court dealt with an attempt to register several artworks made by Gustav Vigeland – one of the most eminent Norwegian sculptors – as trademarks. Among other works, the underlying trademark application concerned Vigeland's *Monolith* (*Monolitten*) and *Angry Boy* (*Sinnataggen*) – popular works that feature prominently in the Vigeland Installation in the centre of Oslo's Frogner Park. The initiative to acquire trademark rights was taken after the expiry of the term of copyright protection.[21] The trademark applicant – the Municipality of Oslo – argued that the rights to Vigeland's works ought to be due to the city – even after copyright expiry – because of the efforts made to ensure that the works became well-known.[22] The Norwegian Industrial Property Office, however, remained unimpressed and refused the application on the grounds that Vigeland's works were non-distinctive, descriptive and functional.[23] Instead of dispelling these concerns, the Board of Appeal added that the registration of cultural heritage signs may be

Concerns in Trade Mark Law – The EFTA Court Develops More Effective Tools for the Preservation of the Public Domain, International Review of Intellectual Property and Competition Law 48 (2017), 683.

[16] Kur, supra note 8, 20; Kur, supra note 15, 1086.

[17] CJEU, 18 June 2002, case C-299/99, *Philips/Remington*, para. 57; CJEU, 20 September 2007, case C-371/06, *Benetton/G-Star*, paras. 25–27; CJEU, 14 September 2010, case C-48/09 P, *Lego/Mega Brands*, para. 47.

[18] Kur, supra note 8, 20.

[19] German Federal Court of Justice, 24 April 2008, case I ZB 21/06, *Marlene-Dietrich-Bildnis*, paras. 19–22. See also the confirmation of this point in German Federal Court of Justice, 31 March 2010, case I ZB 62/09, *Marlene-Dietrich-Bildnis II*, paras. 20–28.

[20] EFTA Court, 6 April 2017, case E-5/16, *Municipality of Oslo* ("*Vigeland*").

[21] EFTA Court, ibid., para. 20. Gustav Vigeland died on 12 March 1943.

[22] Report for the Hearing, Judge-Rapporteur Baudenbacher, 5 October 2016, case E-5/16, *Municipality of Oslo* ("*Vigeland*"), para. 36.

[23] EFTA Court, supra note 20, para. 27.

contrary to public policy or accepted principles of morality, and sought the EFTA Court's guidance on factors that should inform the decision on these grounds for refusal.[24]

27.4 PUBLIC ORDER AND MORALITY

The EFTA Court clearly distinguished the two branches of the ground for refusal: a denial of trademark protection based on grounds of public policy required an assessment of objective criteria, whereas a rejection based on accepted principles of morality implied the examination of subjective values through the prism of consumer perception.[25] As to the objective criterion of a conflict with public policy, the EFTA Court noted that "public policy" referred to principles and standards regarded to be of a fundamental concern to the State and the whole of society. A refusal based on public policy required exceptional circumstances, namely "a genuine and sufficiently serious threat to a fundamental interest of society."[26] Nonetheless, the Court saw room for applying this ground for refusal in the context of artwork registrations:

> An artwork may be refused registration, for example, under the circumstances that its registration is regarded as a genuine and serious threat to certain fundamental values or where the need to safeguard the public domain, itself, is considered a fundamental interest of society.[27]

Interestingly, the Court stated that a genuine and serious threat to public policy could follow from the "registration" of an artwork as a trademark.[28] Hence, not only the nature of the sign at issue but also the registration attempt as such can be sufficient to justify a refusal based on *ordre public*.

27.5 AESTHETIC THEORY

To explore the full potential of the approach taken by the EFTA Court, it is advisable to embark on an interdisciplinary analysis. As the Court points out, public order constitutes a ground for refusal that refers to the importance attached to cultural signs in society. With regard to this broader societal perspective, aesthetic theory can offer important insights. The aesthetic theories of Schiller and Adorno can serve as examples.

[24] Ibid., paras. 28–30.
[25] Ibid., paras. 84–86.
[26] Ibid., paras. 94–96.
[27] Ibid., para. 96.
[28] Ibid.

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27.5.1 *Friedrich Schiller*

Disillusioned by the French Revolution, which had culminated in chaos and violence instead of leading to a free and equal society, Schiller wrote his *Letters on the Aesthetic Education of Man* to explore the possibility of a transition from an absolutist, authoritarian state to a purified, ethical state that is founded on human reason.[29] As a precondition for this transition, Schiller emphasizes the need to harmonize human desires with the rules of reason. As it is not the destiny of mankind to renounce its natural senses in favour of moral laws,[30] support for an ethical, reasonable state must come from the totality of human dispositions: desire and reason alike. Individuals should not only feel an obligation to follow the rules of reason, they should feel a desire to do so. If human desires are brought in line with the postulates of reason, a revolution will no longer end in chaos and violence. It will lead to the establishment of a moral state instead.[31]

To align human desires with the rules of reason, however, a catalyst is required that brings moral laws not only to people's heads but also to their hearts. Schiller solves this problem by positing that art can serve as such a catalyst. Even though being incapable of changing mankind directly, art can point the way to a change for the better by focusing people's thoughts on the "necessary and eternal," and make them strive for this ideal.[32] Art is predestined to accomplish this task because it satisfies the desire to play and enjoy. Instead of openly criticizing people's actions and attitudes, art can improve society in a subtle way by making visions of ethical behaviour part of people's play and pleasure.[33]

Schiller thus relies on art as a vehicle to let people experience an ideal balance between desire and reason until they finally orient their actions by moral laws instead of following mere physical necessities. A true work of art is capable of evoking an equilibrium between reason and desire, and freedom of the mind through appearances of beauty that neither reflect nor require reality.[34] In Schiller's view, the experience and enjoyment of this ultimate perfection can pave the way for the establishment of a moral society in which individual freedom no longer follows from the restriction of the freedom of others but from a consensus on ethical norms that corresponds with people's desires, as refined in the aesthetic play.[35] An individual driven by physical necessity must first experience beauty – the aesthetical balance between desire and rules of reason – before he can actively and

[29] F. Schiller, Über die ästhetische Erziehung des Menschen, ed. K. L. Berghahn, Reclam 2000, 11–14 (Letter 3).
[30] Schiller, ibid., 28 (Letter 6).
[31] Ibid., 120–121 (Letter 27).
[32] Ibid., 36 (Letter 9).
[33] Ibid., 37 (Letter 9).
[34] Ibid., 111–112 (Letter 26).
[35] Ibid., 120–121 (Letter 27).

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freely opt for moral norms and moral actions.[36] It is thus the task of art to prepare mankind for the transition from the physical state of desire to the moral state of reason.[37]

27.5.2 *Theodor Adorno*

Theodor Adorno also underlines the societal relevance of art. Against the background of the alienation which the individual faces in a fully rationalized, efficiency-driven world, he warns of the affirmative nature of art. An artwork bringing a conciliatory reflection of enchantment into the disenchanted, empirical reality offers comfort in the rationalized world and supports the unbearable status quo.[38] In the light of the inhumanity of the real world, art would make itself an accomplice of present and coming disasters if it sustained positive visions of society and obscured the defects and poorness of reality.[39] With the prospect of a better world which, as an ultimate truth,[40] shimmers through genuine artworks,[41] art may falsely pretend that existing societal conditions are acceptable. Therefore, art is constantly at risk of becoming guilty of supporting the inhuman status quo and fortifying present ideologies.[42]

However, art must not be condemned altogether because true art is capable of unmasking the negativity of present societal conditions. Showing visions of a better, happier life, art can rouse opposition against the existing reality and contribute to necessary societal changes.[43] Art can play a decisive role in society because it generates utopian views of a better life that may become drivers of a change for the better. This role of authentic art defines its social character: art is the "social antithesis" of society.[44] Given this delicate position in the social fabric of modern societies, there is a fine line to be walked: the artist must relentlessly expose the inhumanity of reality without offering any prospect of reconciliation. In doing so, the artist creates genuine works which, by their very nature, offer shining visions of a better life and a better society in spite of the hopelessness reflected in the artworks themselves.[45] As an antithesis of real-world disasters, art becomes the messenger of an ideal, utopian world.[46]

[36] Ibid., 90–91 (Letter 23).
[37] Ibid., 92 (Letter 23).
[38] T. W. Adorno, Ästhetische Theorie, ed. G. Adorno/R. Tiedemann, Suhrkamp 1970, 10, 34.
[39] Adorno, ibid., 28, 503.
[40] Ibid., 128, 196–197.
[41] Ibid., 199–200.
[42] Ibid., 203.
[43] Ibid., 25–26, 56.
[44] Ibid., 9–10, 19, 53.
[45] Ibid., 127, 199.
[46] Ibid., 55–56.

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27.5.3 *Importance of a Robust Public Domain*

These aesthetic theories by no means exhaust the possibilities of describing the role of literary and artistic works in society. Nonetheless, the two examples already show that by presenting alternative visions of society, cultural signs can play a crucial role in the improvement of social and political conditions. For this purpose, however, it is necessary to preserve the genuine, cultural meaning of artworks as a basis for dialogue and discussion in the artistic domain.[47] Once a work of art is created, society should seek not to interfere with the artistic discourse. Otherwise, an important impulse for required social and political changes will be lost. Schiller directly points out the merit of leaving the artistic discourse on the meaning and message of works of art intact: as artworks reflect human dignity, they can serve as prototypes for the restoration of an ethical order whenever the principles of morality and reason are lost.[48] From this perspective, the preservation of an artwork's potential for dialogic communication in the artistic domain is an act of preserving expressions of human dignity as a basis for desirable improvements of social and political conditions.

The grant of trademark rights in a cultural sign, however, gives one individual speaker more communication power than other participants in the debate surrounding the sign. As trademark rights offer the trademark owner an exclusive position, the definition power which the trademark owner has in the communication process concerning the cultural sign is higher than the degree of control resulting from other forms of commercial use, such as mere use in advertising without trademark rights. The grant of stable, indefinitely renewable rights substantially enhances the risk of impregnating the artwork with commercial messages that may devalue the sign as a reference point in the artistic discourse. In any case, the debate on the artwork is no longer as open and free as it was before. If the trademark right is acquired after the artwork entered the public domain, the resulting imbalance is self-evident. Unlimited freedom of use is sacrificed in favour of a scenario where all speakers, including artists in the cultural domain, must ensure that their contributions to the debate do not amount to trademark infringement. Intentionally or unintentionally, the trademark proprietor will bring trademark claims against those

[47] For a more detailed discussion of the dialogic process underlying acts of creation, see S. Dusollier, *Realigning Economic Rights with Exploitation of Works: The Control of Authors over the Circulation of Works in the Public Sphere*, in: P. B. Hugenholtz, Copyright Reconstructed – Rethinking Copyright's Economic Rights in a Time of Highly Dynamic Technological and Economic Change, Kluwer Law International 2018, 163 (180–183); C. J. Craig, Copyright, Communication and Culture – Towards a Relational Theory of Copyright Law, Edward Elgar 2011, 52–56.

[48] Schiller, supra note 29, 35 (Letter 9, English translation taken from: C. W. Eliot (ed.), Literary and Philosophical essays: French, German and Italian. With Introductions and Notes, The Harvard Classics, vol. xxxii, Collier 1910, available at https://sourcebooks.fordham.edu/mod/schiller-education.asp).

forms of artistic use which, from her point of view, interfere with her own strategy for the development of the message and meaning of the sign. It does not seem decisive whether the trademark proprietor is a commercial enterprise or a public body. Even if the owner of the trademark right is a state, municipality or museum, and even if the objective underlying the acquisition of trademark rights is art custodianship rather than cultural heritage grabbing, the risk of censorship – in the sense of enforcement measures seeking to prevent interferences with the trademark proprietor's own vision of the sign – cannot be ruled out.[49]

Considering this problem scenario, it is of particular interest that Adorno explicitly warns of the risk of artworks losing their subversive character through efforts to submerge their critical meaning and popularize them in commercial products.[50] Once art is consumed and enjoyed, it inevitably loses its value as a mirror of defects in society and a provocation that is capable of triggering necessary changes. Instead, it becomes a means of pretending that the present situation is sufficient and acceptable.[51] From this perspective, it seems necessary to shield artworks from the corrosive effect of use in product marketing to safeguard the potential of art to expose flaws in society.

27.5.4 *Vigeland* Criteria

A line between these considerations and the public order criteria developed by the EFTA Court can easily be drawn. As explained, the Court saw room for a refusal based on public policy where the trademark registration would pose a genuine and sufficiently serious threat to "certain fundamental values,"[52] "a fundamental interest of society"[53] or "a fundamental concern to the State and the whole of society."[54] Following Schiller's and Adorno's theories, it can be posited that the value at stake in cases where trademark rights are sought in relation to literary and artistic works, is of fundamental importance indeed. The use of artworks in product marketing and the attachment of commercial messages can blur a sign's genuine cultural meaning and devalue the sign as a basis for dialogue and discussion in the artistic domain.[55] It may deprive a literary and artistic creation of its potential to reveal shortcomings of

[49] Cf. Senftleben, supra note 15, 688–689.
[50] Adorno, supra note 38, 33–34.
[51] Ibid., 32.
[52] EFTA Court, 6 April 2017, case E-5/16, *Municipality of Oslo* ("*Vigeland*"), para. 96.
[53] Ibid., para. 95.
[54] Ibid., para. 94.
[55] Cf. M. R. F. Senftleben, *Der kulturelle Imperativ des Urheberrechts*, in: M. Weller/N. B. Kemle/T. Dreier (eds.), Kunst im Markt – Kunst im Recht, Nomos 2010, 75 (101–102); K. Assaf, *Der Markenschutz und seine kulturelle Bedeutung: Ein Vergleich des deutschen mit dem US-amerikanischen Recht*, Gewerblicher Rechtsschutz und Urheberrecht – Internationaler Teil 2009, 1 (2–3); A. Wandtke/W. Bullinger, *Die Marke als urheberrechtlich schutzfähiges Werk*, Gewerblicher Rechtsschutz und Urheberrecht 1997, 573 (578).

present society and encourage changes for the better. In other words: the grant of trademark rights may conflict with society's fundamental interest in art that can serve as an engine for the improvement of social and political conditions.

This line of reasoning is only one example of applying the EFTA Court's public order concept in the light of aesthetic theory. Further arguments can easily be found. The public domain of cultural expressions also serves as a source of inspiration and basis for new acts of creation. Artists often fulfil their fundamental societal role on the basis of a rich and diverse reservoir of works in the public domain. As pre-existing works on which they are built, new cultural productions may mirror social and political shortcomings and offer the prospect of a better society. The grant of trademark rights, however, offers the trademark proprietor the opportunity to influence – or even control – the communication surrounding the protected sign. Even if trademark law provides for defences, such as due cause, non-distinctive use and referential use, the risk of trademark infringement is hanging above unauthorized use in the artistic domain like the sword of Damocles. Given the deterrent effect of trademark enforcement measures on risk-averse artists with limited financial means for a lawsuit, trademark protection may impede or even stifle the dialogic remix and reuse of cultural resources in the artistic domain.[56] This corrosive effect can lead to a conflict with public order because it compromises society's fundamental interest in cultural expressions that can serve as a basis for new artworks and fresh reflections of societal conditions. This second argument refers to an additional point which the EFTA Court discussed: a refusal of trademark rights for public policy reasons may be necessary to safeguard the public domain. In the light of Schiller's and Adorno's theories, it may be said that the need to preserve and cultivate the public domain, itself, constitutes a fundamental interest of society that should be safeguarded by invoking public order as a ground for refusal.[57]

Aesthetic theory can thus serve as a basis for arguments that broaden the ambit of operation of public order as a ground for refusal in cases that concern artworks, such as Gustav Vigeland's creations. The EFTA Court expressed the view that "registration of a sign as a trade mark may only be refused as contrary to public policy in accordance with [EU trademark legislation] in exceptional circumstances."[58] In light of the societal values, interests and concerns which aesthetic theory reflects,

[56] Cf. Senftleben, supra note 15, 699–705.

[57] EFTA Court, supra note 52, para. 96. As to the debate on the legal status of the public domain, see S. Dusollier, *A Positive Status for the Public Domain*, in: D. Beldiman (ed.), Innovation, Competition and Collaboration, Edward Elgar 2015, 135; W. Nordemann, *Mona Lisa als Marke*, Wettbewerb in Recht und Praxis 1997, 389 (391); D. Lange, *Recognizing the Public Domain*, Law and Contemporary Problems 44 (1981), 147 (150). As to the removal of literary and artistic works from the public domain for a limited period of revived copyright protection, see U.S. Supreme Court, 18 January 2012, *Golan/Holder*, 565 U.S. 302, 315–321 and 328–329 (2012).

[58] EFTA Court, ibid., para. 96.

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this threshold of exceptionality need not be high. In particular, a sign need not have "high symbolic value."[59]

27.6 CONCLUSION

In sum, aesthetic theory offers starting points for the transformation of public order criteria stemming from the *Vigeland* decision into grounds for refusal that can fulfil a central function with regard to copyright/trademark overlaps – a function that is similar to the role which utilitarian and aesthetic functionality plays vis-à-vis patent/trademark overlaps and cumulative industrial design and trademark protection. However, it also becomes clear that the *Vigeland* decision – when combined with arguments derived from aesthetic theory – adds a further category of values. Annette Kur has developed a theoretical framework that focuses on the prevention of excessive protection to safeguard undistorted competition. Her approach to cumulative protection allows competition-based arguments to override considerations of aesthetic appeal and attractiveness:

> An absolute and permanent ban against trade mark protection for attractive shapes, which excludes any consideration of the fact that the aesthetic appeal may eventually become inferior to the message it conveys about commercial origin – meaning that it is primarily bought for the brand, and not for its design – does not make sense. At least, it can hardly be the attractiveness displayed at the early stages of marketing which accounts for the everlasting nature of that ban. It is yet another question, whether the shape – beyond the information it has come to convey about commercial origin, and unrelated to the goodwill it represents – still confers such strong competitive advantages to the prospective right holder that to keep it free from monopolisation appears "essential" for others to engage in meaningful competition.[60]

Once the public order criteria following from the *Vigeland* decision are charged with the outlined arguments derived from aesthetic theory, they constitute an independent, alternative basis for a categorical exclusion of cultural signs from trademark protection: the ban on the acquisition of trademark rights need no longer follow from economic concerns about undistorted competition. Alternatively, trademark rights may be denied because of cultural concerns about the blurring of the cultural meaning of artworks, an impediment to dialogic remix and reuse in the artistic domain and, ultimately, the loss of alternative visions of society.

In the analysis, competition-based and cultural concerns would thus have the same weight. The final decision on this equal status, however, depends on whether other checks and balances in trademark law, such as the gatekeeper requirement of

[59] Cf. Article 4(3)(b) EU Trade Mark Directive 2015/2436.
[60] Kur, supra note 8, 18.

use as a trademark[61] and defences against infringement claims, for example the referential use defence, the non-distinctive use defence and the due cause defence,[62] are sufficient to dispel concerns about an impediment of cultural follow-on innovation. Applying Annette Kur's criteria by analogy, it may be concluded: only if these checks and balances are sufficient to prevent excessive protection that endangers cultural values, is the cumulation of rights acceptable.[63]

[61] As to the debate on the desirability of solutions based on this gatekeeper requirement, see S. L. Dogan/M. A. Lemley, *The Trademark Use Requirement in Dilution Cases*, Santa Clara Computer & High Technology Law Journal 24 (2008), 541 (542); G. B. Dinwoodie/M. D. Janis, *Confusion Over Use: Contextualism in Trademark Law*, Iowa Law Review 92 (2007), 1597 (1657–1658). With regard to the EU, see A. Kur, *Confusion Over Use? Die Benutzung 'als Marke' im Lichte der EuGH-Rechtsprechung*, Gewerblicher Rechtsschutz und Urheberrecht International 2008, 1 (11), who warns of limiting trademark protection from the outset on the basis of a restrictive notion of trademark use, in particular with regard to European Union Trade Marks.

[62] For a more detailed discussion of the role of these defences in cases involving artistic expression, see A. 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: I. Calboli/M.R.F. Senftleben (eds.), *The Protection of Non-Traditional Trademarks – Critical Perspectives*, Oxford: Oxford University Press 2018, 89 (101–104). A. Kur/M. R. F. Senftleben, European Trade Mark Law – A Commentary, Oxford University Press 2017, paras. 5.265–5.268, 6.59–6.68; J. Schovsbo, *"Mark My Words" – Trademarks and Fundamental Rights in the EU*, UC Irvine Law Review 8 (2018), 555 (575–580); W. Sakulin, Trademark Protection and Freedom of Expression – An Inquiry into the Conflict between Trademark Rights and Freedom of Expression under European Law, Kluwer Law International 2010, 85–87; C. Geiger, *Trade Marks and Freedom of Expression – The Proportionality of Criticism*, International Review of Intellectual Property and Competition Law 38 (2007), 317.

[63] For a critical assessment of these checks and balances, see Senftleben, supra note 15, 699–705.