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## 8. Cultural heritage branding: societal costs and benefits

*Martin Senftleben*

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### 1. INTRODUCTION

In trademark law, attempts to protect signs with a pre-existing cultural meaning pose particular difficulties. Geographical indications that represent a traditional way of producing goods have led to a heated international debate about the relationship between trademark rights and more specific *sui generis* protection regimes.<sup>1</sup> To this day, the incessant fight for market shares around the globe adds fuel to this discussion. As a geographical name with a positive, pre-existing reputation may ensure favourable consumer responses,<sup>2</sup> it can offer significant advantages when used strategically as a marketing tool. Another discussion point that features prominently on the agenda of international policymakers concerns the grant of trademark rights in symbols and other traditional cultural expressions of indigenous peoples.<sup>3</sup> In this case, the acquisition of trademark rights by a commercially oriented outsider – not belonging

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<sup>1</sup> Cf. the various contributions to I. Calboli/W.-L. Ng-Loy (eds.), *Geographical Indications at the Crossroads of Trade, Development, and Culture in the Asia-Pacific*, Cambridge: Cambridge University Press 2017; M. Handler/R. Burrell, 'GI Blues: The Global Disagreement over Geographical Indications', in: K. Bowrey/M. Handler/D. Nicol (eds.), *Emerging Challenges in Intellectual Property*, Oxford: Oxford University Press 2011, 126; D.S. Gangjee, *Relocating the Law of Geographical Indications*, Cambridge: Cambridge University Press 2012; K. Das, 'Unresolved Issues on Geographical Indications in the WTO', in: C. Correa (ed.), *Research Handbook on the Protection of Intellectual Property under WTO Rules*, Cheltenham, UK and Northampton, MA, USA: Edward Elgar Publishing 2010, 448; D.S. Gangjee, 'Quibbling Siblings: Conflicts Between Trademarks and Geographical Indications', *Chicago-Kent Law Review* 82 (2007), 1253; K. Raustiala/S. Munzer 'The Global Struggle over Geographic Indications', *The European Journal on International Law* 18 (2007), 337; J. Hughes, 'Champagne, Feta, and Bourbon: The Spirited Debate about Geographical Indications', *Hastings Law Journal* 58 (2006), 299; B. Goebel, 'Geographical Indications and Trademarks – The Road from Doha', *The Trademark Reporter* 93 (2004), 964. As to the approach in the EU, see T. Engelhardt, 'Geographical Indications Under Recent EU Trade Agreements', *International Review of Intellectual Property and Competition Law* 46 (2015), 781; G. Evans, 'The Comparative Advantages of Geographical Indications and Community Trade Marks for the Marketing of Agricultural Products in the European Union', *International Review of Intellectual Property and Competition Law* 41 (2010), 645.

<sup>2</sup> Cf. CJEU, 4 May 1999, cases C-108/97 and C-109/97, *Windsurfing Chiemsee*, para. 26. Cf. I. Calboli, 'Geographical Indications of Origin at the Crossroads of Local Development, Consumer Protection and Marketing Strategies', *International Review of Intellectual Property and Competition Law* 46 (2015), 760.

<sup>3</sup> Cf. A. Taubman, 'New Dialogues, New Pathways: Reframing the Debate on Intellectual Property and Traditional Knowledge', *Washburn Law Journal* 58 (2019), 373; J.J. Osei-Tutu, 'Harmonizing Cultural IP Across Borders: Fashionable Bags and Ghanaian Adinkra Symbols', *Akron Law Review* 51 (2017), 1051; R.M. Hilty, 'Rationales for the Legal Protection of Intangible Goods and Cultural Heritage', *International Review of Intellectual Property and Competition Law* 40 (2009), 883; S.R. Frankel, 'Trademarks and Traditional Knowledge and Cultural Intellectual Property', in: G.B.

to the indigenous group and disregarding traditional use protocols – may be seen as an act of misappropriation.<sup>4</sup> The indigenous community in which the sign originated may perceive use for the purpose of advertising and selling goods as an act of freeriding that derives unfair advantage from the positive image and power of attraction which the sign may have acquired as a traditional symbol.<sup>5</sup> Depending on the meaning of the affected symbol, use as a brand may also culminate in sign desecration.<sup>6</sup>

While the discussion surrounding the aforementioned categories of signs with a pre-existing cultural meaning – geographical indications and traditional cultural expressions – has already led to international norms regulating the interface with trademark protection,<sup>7</sup> or international norm setting activities that may address the interface question,<sup>8</sup> much less attention has been devoted to a further category of signs with a pre-existing cultural meaning, namely artworks in the public domain. The interface between trademark law and cultural heritage law – in the sense of legislation seeking to preserve a country’s literary and artistic heritage or, more generally, humankind’s universal cultural heritage – remains underdeveloped in many national trademark systems.<sup>9</sup> Considering the spectrum of cases where trademark rights relating to

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Dinwoodie/M.D. Janis (eds.), *Trademark Law and Theory: A Handbook of Contemporary Research*, Cheltenham, UK and Northampton, MA, USA: Edward Elgar Publishing 2008, 433.

<sup>4</sup> Cf. Hilty, supra note 3, 885; Osei-Tutu, supra note 3, 1072; B. Ubertazzi, ‘EU Geographical Indications and Intangible Cultural Heritage’, *International Review of Intellectual Property and Competition Law* 48 (2017), 562 (563–568).

<sup>5</sup> Cf. Taubman, supra note 3, 384; S. Frankel, ‘Branding Indigenous Peoples’ Traditional Knowledge’, in: A.T. Kenyon/M. Richardson/W.L. Ng-Loy (eds.), *The Law of Reputation and Brands in the Asia Pacific*, Cambridge: Cambridge University Press 2012, 253.

<sup>6</sup> For trademark legislation seeking to minimize this risk, see S.R. Frankel, ‘Third-Party Trade Marks as a Violation of Indigenous Cultural Property – A New Statutory Safeguard’, *Journal of World Intellectual Property* 2005, 83.

<sup>7</sup> See Article 24(5) TRIPS with regard to the relationship between trademark protection and the protection of geographical indications. Cf. also WTO Panel, 15 March 2005, WTO Document WT/DS174/R, European Communities – Protection of Trademarks and Geographical Indications for Agricultural Products and Foodstuffs, para. 7.659–7.677, based on a complaint by the US. A second and almost identical report, WTO Document WT/DS290/R, deals with a parallel complaint by Australia. For a discussion of these reports, see M.R.F. Senftleben, ‘Towards a Horizontal Standard for Limiting Intellectual Property Rights? – WTO Panel Reports Shed Light on the Three-Step Test in Copyright Law and Related Tests in Patent and Trademark Law’, *International Review of Intellectual Property and Competition Law* 37 (2006), 407.

<sup>8</sup> Cf. World Intellectual Property Organization, *The Protection of Traditional Cultural Expressions: Draft Articles, Facilitators’ Revision*, dated 19 June 2019, WIPO: Geneva 2019, available at: [https://www.wipo.int/meetings/en/doc\\_details.jsp?doc\\_id=439176](https://www.wipo.int/meetings/en/doc_details.jsp?doc_id=439176).

<sup>9</sup> For a more detailed overview of existing literature and an in-depth discussion, see M.R.F. Senftleben, *The Copyright/Trademark Interface – How the Expansion of Trademark Protection Is Stifling Cultural Creativity*, The Hague/London/New York: Kluwer Law International 2020, 105–115 and 279–310. Cf. M.R.F. Senftleben, ‘No Trademark Protection for Artworks in the Public Domain – A Practical Guide to the Application of Public Order and Morality as Grounds for Refusal’, *Gewerblicher Rechtsschutz und Urheberrecht – International* 71 (2022), 3; R.S. Curtin, ‘Zombie Cinderella and the Undead Public Domain’, *Tennessee Law Review* 85 (2018), 961; V. Vanovermeire, ‘Inschrijving als merk van een in het publiek domain gevallen werk’, in: A. Cruquenaire/S. Dusollier (eds.), *Le Cumul des droits intellectuels*, Larcier 2009, 177 (182); A. Ohly, ‘Von einem Indianerhauptling, einer Himmelscheibe, einer Jeans und dem Lacheln der Mona Lisa – Uberlegungen zum Verhaltnis zwischen Urheber- und Kennzeichenrecht’, in: L. Pahlow/J. Eisfeld (eds.), *Grundlagen und Grundfragen des Geistigen Eigentums, Festgabe fur Diethelm Klippel zum 65. Geburtstag*, Tubingen: Mohr Siebeck

cultural heritage symbols in the public domain have been granted, the absence of regulatory initiatives in this area is surprising. In *Vigeland*, the Court of Justice of the European Free Trade Association States (EFTA Court) dealt with an attempt to register various artworks of the famous Norwegian sculptor Gustav Vigeland as trademarks.<sup>10</sup> The reason for the initiative to acquire trademark rights was the expiry of the term of copyright protection. The trademark applicant – the Municipality of Oslo – sought to preserve exclusive rights to the artworks even though they had already become freely available public domain material.<sup>11</sup> Following the guidance which the EFTA Court provided, the Norwegian Board of Appeal for Industrial Property Rights finally refused the trademark application.<sup>12</sup>

This final decision in this Norwegian case, however, does not mean that attempts to register cultural heritage material as trademarks can never have success. Another iconic piece of Norwegian art – Edvard Munch’s famous painting *The Scream (Skrik)* – has been registered as a trademark at the international level with legal effect in the EU, Japan and the US.<sup>13</sup> In France, Vermeer’s famous *The Milkmaid (Het Melkmeisje)* has been used for the marketing of dairy products to such an extent that it seems safe to assume that the registered cultural icon has become a well-known mark.<sup>14</sup> In Germany, the State of Saxony-Anhalt managed to acquire EU trademark rights in the ancient Nebra Sky Disk that was found on its territory.<sup>15</sup> The Higher Court of Appeals of Dresden had to deal with the registration of the name and portrait of Johann Sebastian Bach as trademarks for a broad range of goods and services.<sup>16</sup> As the trademark registration had been obtained in 1999, it seems to have been the trademark owner’s intention to exploit Bach’s name and portrait during the anniversary year 2000 (Bach

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2008, 203 (205 and 208–210). For examples ranging from Raphael Putti to Michelangelo’s *Creation of Adam* and a Rembrandt self-portrait, see V. Bugdahl, ‘Marken und Kunst – Kunst und Marken’, *Markenrecht* 2010, 369 (372–373).

<sup>10</sup> EFTA Court, 6 April 2017, case E-5/16, Municipality of Oslo (‘Vigeland’), para. 20–26. Cf. European Copyright Society, ‘Trade Mark Protection of Public Domain Works: A Comment on the Request for an Advisory Opinion of the EFTA Court: Case E-05/16: Norwegian Board of Appeal for Industrial Property Rights – Appeal from the Municipality of Oslo’, *European Intellectual Property Review* 39 (2017), 457.

<sup>11</sup> EFTA Court, *ibid.*, para. 20. Gustav Vigeland died on 12 March 1943. As to the reasons underlying the registration initiative, see Report for the Hearing, Judge-Rapporteur Baudenbacher, 5 October 2016, case E-5/16, Municipality of Oslo (‘Vigeland’), para. 32 and 36.

<sup>12</sup> Norwegian Board of Appeal for Industrial Property Rights, 13 November 2017, cases 16/00148, 16/00149, 16/00150, 16/00151, 16/00152 and 16/00154, ‘Vigeland’, para. 14 and 23–24.

<sup>13</sup> IR no. 1179290 concerning beers, mineral waters and other alcoholic and non-alcoholic beverages.

<sup>14</sup> EUTM no. 002998334 concerning, among other goods, dietetic foodstuffs and baby food; vegetables, fruits, meat, poultry, game, fish and seafood; milk products; coffee, tea, cocoa and chocolate products; bakery products, snack foods, breakfast cereals and ice cream. Cf. F. Bianchi, ‘La Laitière: comment un tableau de Vermeer a fini sur un pot de yaourt’, *BFM Business*, posted 20 February 2017, available at: <https://bfmbusiness.bfmtv.com/entreprise/la-laitiere-comment-un-tableau-de-vermeer-a-fini-sur-un-pot-de-yaourt-1106560.html>.

<sup>15</sup> EUTM no. 009763475. As to the previous controversy about the grant of the trademark right in Germany, see Regional Court of Magdeburg, 16 October 2003, case 7 O 847/03, ‘Himmelscheibe von Nebra’, *Gewerblicher Rechtsschutz und Urheberrecht* 2004, 672. Cf. M. Stieper, ‘Geistiges Eigentum an Kulturgütern – Möglichkeiten und Grenzen der Remonopolisierung gemeinfreier Werke’, *Gewerblicher Rechtsschutz und Urheberrecht* 114 (2012), 1083 (1090–1091); Ohly, *supra* note 9, 209–211.

<sup>16</sup> Higher Court of Appeals of Dresden, 4 April 2000, case 14 U 3611/99, ‘Johann Sebastian Bach’, *Neue Juristische Wochenschrift* 2001, 615 (616).

died on 28 July 1750).<sup>17</sup> Despite a finding of lack of distinctive character at the Benelux level,<sup>18</sup> the European Union Intellectual Property Office (EUIPO) registered the original Dutch titles of Anne Frank's famous books – *Het achterhuis* (*The Secret Annex*) and *Het dagboek van Anne Frank* (*The Diary of Anne Frank*) – in respect of books, films, theatre productions and guided tours.<sup>19</sup> In contrast to the Court of Appeals of Brussels,<sup>20</sup> the EUIPO deemed these titles distinctive and granted trademark rights in areas of literary and artistic creativity where the books play a crucial role.<sup>21</sup> Similarly, the verdict of insufficient distinctive character at the Benelux level<sup>22</sup> could not prevent the EUIPO from granting EU-wide trademark rights to Rembrandt's famous painting *The Night Watch* (*De Nachtwacht*).<sup>23</sup>

In *Neuschwanstein*, the Court of Justice of the European Union (CJEU) further encouraged cultural heritage branding by holding that frequent use on souvenir items was irrelevant for the purpose of assessing the descriptive character of the name of the famous castle in Bavaria. According to the Court, the fact that the name 'Neuschwanstein' transformed regular goods into souvenir articles could not be deemed an essential descriptive characteristic of the goods concerned. The memory evoked in the minds of consumers was not sufficient to qualify the name as an indication of a product quality or an essential product characteristic.<sup>24</sup> If this line of reasoning is applied *mutatis mutandis* to souvenir and merchandising articles bearing famous artworks, it will inevitably deprive trademark offices of the possibility to deny the grant of exclusive rights on the grounds that the artwork is descriptive or decorative. It may also pose an obstacle to a finding of aesthetic functionality. Prior to the CJEU decision, the EUIPO already granted trademark rights in a prominent cultural heritage sign – the ancient Nebra Sky Disk – in respect of souvenir and merchandising articles.<sup>25</sup> The *Neuschwanstein* ruling is likely to increase this tendency to burden more and more cultural heritage signs with trademark rights. Discussing cultural heritage branding in the aforementioned *Vigeland* case,

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<sup>17</sup> Cf. H.-P. Götting, 'Persönlichkeitsmerkmale von verstorbenen Personen der Zeitgeschichte als Marke', *Gewerblicher Rechtsschutz und Urheberrecht* 2001, 615. In addition to the Johann Sebastian Bach registration, the trademark proprietor had also registered signs relating to Michelangelo, Leonardo da Vinci, Paul Gauguin and Paul Cézanne.

<sup>18</sup> Court of Appeals of Brussels, 3 October 2013, cases 2013/7132 and 2013/7133, Anne Frank Foundation/Benelux Office for Intellectual Property, para. 8.

<sup>19</sup> See EUTM no. 012451787 (HET ACHTERHUIS) and EUTM no. 012452281 (HET DAGBOEK VAN ANNE FRANK) which cover various goods and services in classes 9, 16 and 41.

<sup>20</sup> As the CJEU, 6 September 2018, case C-488/16P, Bundesverband Souvenir – Geschenke – Ehrenpreise ('Neuschwanstein'), para. 72, pointed out, the EU trademark system is 'an autonomous system with its own set of objectives and rules peculiar to it; it applies independently of any national system'. Hence, the EUIPO was not bound to follow the decision on distinctiveness taken by the Court of Appeals of Brussels on the basis of the harmonized Benelux trademark system.

<sup>21</sup> For the particulars of EUTMs no. 012451787 and 012452281, see <https://euipo.europa.eu/eSearch/>.

<sup>22</sup> Court of Appeals of The Hague, 29 August 2017, case 200.205.771/01, ECLI:NL:GHDHA:2017:2446, Chiever/Benelux-Organisatie voor de Intellectuele Eigendom ('Nachtwacht'), para. 12.

<sup>23</sup> EUTM no. 016613903 concerning the chemical element strontium.

<sup>24</sup> CJEU, 6 September 2018, case C-488/16P, Bundesverband Souvenir – Geschenke – Ehrenpreise ('Neuschwanstein'), para. 44–46.

<sup>25</sup> EUTM no. 009763475. As to the previous debate about the trademark right in Germany, see Regional Court of Magdeburg, 16 October 2003, case 7 O 847/03, 'Himmelsscheibe von Nebra', *Gewerblicher Rechtsschutz und Urheberrecht* 2004, 672. Cf. Stieper, *supra* note 15, 1090–1091, and Ohly, *supra* note 9, 209–211, whose counterarguments based on the assumption that the Nebra Sky Disk would only be perceived as a descriptive or decorative element seem difficult to maintain after the CJEU decision in *Neuschwanstein*.

the EFTA Court, by contrast, saw a need of ‘protecting creations of the mind from commercial greed’ and ‘ensuring the freedom of the arts’.<sup>26</sup> The EFTA Court did not hesitate to point out that we live in a ‘greedy’ era where trademark law is employed strategically to withhold or remove cultural symbols from the public domain.

The critical statements of the EFTA Court, however, have not changed the permissive attitude towards cultural heritage branding that often prevails in literature. The possibility of granting trademark protection is frequently mentioned without much commentary on potential risks for innovation processes in the literary and artistic domain.<sup>27</sup> It may also be accepted on the grounds that, in contrast to copyright, trademark rights do not offer protection for a cultural creation as such, but only for certain functions which the cultural creation fulfils as a distinctive sign in respect of goods and services to which it is attached.<sup>28</sup> The acceptance of cultural heritage branding can thus be justified by pointing out that the grant of trademark rights need not lead to the full monopolization and privatization of cultural public domain material that was entirely free before.<sup>29</sup>

Invoking general arguments in favour of trademark protection, it is also possible to paint a positive picture of benefits accruing from the grant of trademark rights. Rochelle Dreyfuss, for instance, has expressed the view that cultural heritage branding may further enrich the spectrum of connotations which a cultural heritage symbol evokes in the minds of consumers. In her opinion, a ban on cultural heritage branding

could also decrease incentives to innovate. While the main goal of trademark law is to ensure the reliability of signals about source, encouraging traders to develop new language and rhetorical devices is a socially beneficial side effect. Yet traders may be discouraged from adopting marks with

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<sup>26</sup> EFTA Court, 6 April 2017, case E-5/16, Municipality of Oslo (‘Vigeland’), para. 65.

<sup>27</sup> T. Cohen Jehoram/C.J.J.C. van Nispen/J.L.R.A. Huydecoper, *European Trademark Law*, Alphen aan den Rijn: Kluwer Law International 2010, 556.

<sup>28</sup> J.C. Ginsburg, ‘Intellectual Property as Seen by Barbie and Mickey: The Reciprocal Relationship of Copyright and Trademark Law’, *Journal of the Copyright Society of the U.S.A.* 65 (2018), 245 (261–264); J.C. Ginsburg, ‘Licensing Commercial Value: from Copyright to Trademarks and Back’, in: I. Calboli/J. de Werra (eds.), *The Law and Practice of Trademark Transactions – A Global and Local Outlook*, Cheltenham, UK and Northampton, MA, USA: Edward Elgar Publishing 2016, 53 (60–63); Stieper, *supra* note 15, 1090–1091; C.S. Mende/B. Isaac, ‘When Copyright and Trademark Rights Overlap’, in: N. Wilkof/S. Basheer (eds.), *Overlapping Intellectual Property Rights*, Oxford: Oxford University Press 2012, 137 (144); A. Peukert, *Die Gemeinfreiheit*, Tübingen: Mohr Siebeck 2012, 111–113.

<sup>29</sup> A. Ohly, ‘Schutz von Kulturgütern durch das Markenrecht?’, in: F. Hacker/F. Thiering (eds.), *Festschrift für Paul Ströbele zum 75. Geburtstag*, Cologne: Carl Heymanns 2019, 325 (332); M.-R. McGuire, ‘Kumulation und Doppelschutz – Ursachen und Folgen des Schutzes einer Leistung durch mehrere Schutzrechte’, *Gewerblicher Rechtsschutz und Urheberrecht* 2011, 767 (774); E. Derclaye/M. Leistner, *Intellectual Property Overlaps – A European Perspective*, Oxford and Portland (Oregon): Hart Publishing 2011, 314–315 and 320. For a statement pointing in the same direction, see A. Kur, ‘Gemeinfreiheit und Markenschutz – Bemerkungen zur Entscheidung des EFTA-Gerichtshofs im Vigeland-Fall’, *Gewerblicher Rechtsschutz und Urheberrecht* 2017, 1082 (1086). However, see also the focus on appropriate checks and balances in A. Kur, ‘Funktionswandel von Schutzrechten: Ursachen und Konsequenzen der inhaltlichen Annäherung und Überlagerung von Schutzrechtstypen’, in: G. Schrickler/T. Dreier/A. Kur (eds.), *Geistiges Eigentum im Dienst der Innovation*, Baden-Baden: Nomos 2001, 23 (45 and 50).

the potential for significant cultural resonance if they cannot acquire the legal rights associated with registration.<sup>30</sup>

On the opposite side of the spectrum of literature statements, Katya Assaf warns of the corrosive effect of cultural heritage branding. She provides the following example of cultural signs losing their primary cultural meaning as a result of use in commerce and the impregnation of the sign with marketing messages:

Consider the trademark 'Nike.' The initial significance of the cultural sign 'Nike' was as the name of the Greek Goddess of Victory. The sign was chosen to serve as a trademark for its ability to convey the message of success, overcoming adversity and victory, stated succinctly by the phrase 'Just Do It.' The trademark grew so strong that it turned into the sign's primary meaning while its original significance grew weaker and became a kind of secondary meaning.<sup>31</sup>

Katya Assaf also points out that safeguards against the erosion of cultural meaning are sought in vain in trademark law:

cultural signs are generally not protected from alteration of their meaning due to their adaptation into trademarks. Thus, Nike, the Greek Goddess, was not protected from the additional meaning imposed on it through a brand of shoes.<sup>32</sup>

Contrasting Dreyfuss's optimistic prediction of an enrichment of expressive tools with Assaf's pessimistic warning against the loss of cultural meaning, the central question is whether it is possible to assess the pros and cons of cultural heritage branding and formulate solid recommendations for further policymaking in this area. Can potential benefits accruing from the grant of trademark protection outweigh the detriment flowing from the risk of losing cultural connotations?

To lay groundwork for this discussion, it is important to point out first that the scope of trademark rights has been expanded considerably during the last decades. The nature of the right has changed: trademark protection is no longer limited to the core function of indicating the commercial origin of goods or services. Instead, trademark law is capable of protecting cultural heritage signs as powerful communication tools. Once trademark rights are granted, the trademark owner can exert far-reaching control over the communication process surrounding the protected sign (Section 2). The use in product marketing may also be problematic from a conceptual perspective. Marketing messages may render affected cultural heritage symbols less attractive as a basis for new literary and artistic productions (Section 3). The decision on the grant of trademark rights, thus, requires a careful analysis of potential obstacles to freedom of artistic expression (concluding Section 4).

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<sup>30</sup> R.C. Dreyfuss, 'Cultural Heritage and the Public Domain: What the US's Myriad and Mayo can Teach Oslo's Angry Boy', in: N. Bruun/G.B. Dinwoodie/M. Levin/A. Ohly (eds.), *Transition and Coherence in Intellectual Property Law: Essays in Honour of Annette Kur*, Cambridge: Cambridge University Press 2020, 322 (328).

<sup>31</sup> K. Assaf, 'The Dilution of Culture and the Law of Trademarks', *IDEA: The Intellectual Property Law Review* 49 (2008), 1 (11).

<sup>32</sup> Assaf, *supra* note 31, 45.

## 2. TRADEMARKS AS COMMUNICATION TOOLS

Trademark law aims at market transparency to ensure fair competition, consumer protection and the proper functioning of markets. Trademark rights concern the exclusive link which a trademark establishes between the trademark owner and the goods and services offered under the mark. Hence, trademark rights are not designed as exploitation rights. They have a rather defensive character. Taking traditional trademark theory as a starting point, the CJEU refers to

the essential function of the trade mark, which is to guarantee the identity of the origin of the trademarked product to the consumer or final user by enabling him to distinguish without any possibility of confusion between that product and products which have another origin.<sup>33</sup>

This traditional protection against ‘any possibility of confusion’ gives trademark owners only limited control over communication concerning their marks – control that only covers the identification and distinction of the goods or services they offer in the marketplace. Protection against confusion can be understood to serve the defensive purpose of preventing competitors from use that would interfere with the basic communication of information about the commercial origin of goods and services offered by the trademark owner.<sup>34</sup> However, the scope of trademark protection becomes broader with every additional trademark function – and every additional basis for infringement claims – that is recognized in trademark law. The inclusion of additional trademark functions may follow from strategic use of basic protection against confusion. To allow trademarks to convey reliable information on the commercial origin of goods and services, it is indispensable to reserve use of the trademark exclusively for the trademark owner in all market segments where use of identical or similar signs could lead to confusion.<sup>35</sup> As a result, the trademark owner obtains an exclusive channel of communication in all areas of the market where she is active. In principle, only the enterprise holding trademark rights is entitled to convey information to consumers via the trademark in these protected areas.<sup>36</sup>

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<sup>33</sup> For an early use of this formula, see CJEU, 3 December 1981, case C-1/81, Pfizer/Eurim-Pharm, para. 8. As to the reappearance of the same formula in later judgments, see CJEU, 12 November 2002, case C-206/01, Arsenal/Reed, para. 48. Cf. I. Simon Fhima, ‘How Does “Essential Function” Doctrine Drive European Trade Mark Law?’, *International Review of Intellectual Property and Competition Law* 36 (2005), 401.

<sup>34</sup> CJEU, 18 June 2009, case C-487/07, L’Oréal/Bellure, para. 59; CJEU, 11 November 1997, case C-251/95, Puma/Sabel, para. 16–26.

<sup>35</sup> In the case of collective marks, this exclusive reservation of a sign concerns an association of enterprises who use the trademark in trade. The basic mechanism, however, remains unchanged. The information conveyed via the trademark, by contrast, will focus on certain product characteristics rather than one particular commercial origin. See Articles 74(1) and 83(1) of Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union Trade Mark, *Official Journal* 2017 L 154, 1 (EUTMR). Cf. CJEU, 8 June 2017, case C-689/15, Gözze Frottierweberei, para. 50.

<sup>36</sup> As in other fields of intellectual property protection, it is indispensable to set certain limits to the exclusive rights of trademark owners. The principle of an exclusive communication channel, therefore, is limited in several respects. See the general limitations set forth in Article 14 EUTMR and Article 14 of 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, *Official Journal* 2015 L



Investing in advertising, the trademark owner can use this exclusive communication channel to add messages that are unrelated to the underlying objective of ensuring accurate information about the commercial source of goods or services. In particular, an enterprise can launch advertising campaigns to educate consumers to associate a certain attitude or lifestyle with the trademark.<sup>37</sup> The moment a trademark ‘speaks’ to consumers about a particular image that can be associated with the trademarked product, consumers no longer simply purchase products from a particular commercial source. They also buy the respective ‘trademark experience’ and ‘brand image’.<sup>38</sup>

Inevitably, the exclusive rights necessary to ensure protection against confusion, therefore, also protect the investment made in the creation of a favourable trademark image. Basic protection against confusion safeguards the exclusive link between an enterprise and its trademark. However, it also offers legal security for substantial investment in the evocation of brand-related associations in the minds of consumers. This protection reflex<sup>39</sup> may be elevated to an independent subject matter of protection. In *L’Oréal/Bellure*, the CJEU held that the circle of protected trademark functions was not limited to the basic function of indicating the commercial origin of goods or services. By contrast, 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.<sup>40</sup>

Hence, the Court expressly recognized brand image protection as an independent objective of EU trademark law.<sup>41</sup> Communication, investment and advertising functions are typically

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336, 1 (TMD). With regard to comparative advertising, see CJEU, 12 June 2008, case C-533/06, *O2/Hutchison*, para. 45; CJEU, 18 June 2009, case C-487/07, *L’Oréal/Bellure*, para. 54.

<sup>37</sup> Cf. Assaf, *supra* note 31, 13–14; A. Griffiths, ‘A Law-and-Economic Perspective on Trade Marks’, in: L. Bently/J. Davis/J.C. Ginsburg (eds), *Trade Marks and Brands – An Interdisciplinary Critique*, Cambridge: Cambridge University Press 2008, 241 (255); R.S. Brown, ‘Advertising and the Public Interest: Legal Protection of Trade Symbols’, *Yale Law Journal* 108 (1999), 1619 (1619–1620); K.H. Fezer, ‘Entwicklungslinien und Prinzipien des Markenrechts in Europa – Auf dem Weg zur Marke als einem immaterialgüterrechtlichen Kommunikationszeichen’, *Gewerblicher Rechtsschutz und Urheberrecht* 2003, 457 (461–462).

<sup>38</sup> A. Peukert, ‘Vom Warenzeichen zum Markeneigentum. Ein polanyischer Erklärungsversuch’, in: W. Büscher/J. Glöckner/A. Nordemann/C. Osterrieth/R. Rengier (eds.), *Marktkommunikation zwischen Geistigem Eigentum und Verbraucherschutz. Festschrift für Karl-Heinz Fezer zum 70. Geburtstag*, Munich: C.H. Beck 2016, 405 (412–414); J.E. Schroeder, ‘Brand Culture: Trade marks, Marketing and Consumption’, in L. Bently/J. Davis/J.C. Ginsburg (eds), *Trade Marks and Brands – An Interdisciplinary Critique*, Cambridge: Cambridge University Press 2008, 161.

<sup>39</sup> See WTO Panel, 15 March 2005, WTO Document WT/DS174/R, *European Communities – Protection of Trademarks and Geographical Indications for Agricultural Products and Foodstuffs*, para. 7.664. For a discussion of the report, see Senftleben, *supra* note 7, 407.

<sup>40</sup> CJEU, 18 June 2009, case C-487/07, *L’Oréal/Bellure*, para. 58.

<sup>41</sup> A. Kur/M.R.F. Senftleben, *European Trade Mark Law – A Commentary*, Oxford: Oxford University Press 2017, para. 1.20–1.39. For a positive assessment of this development, see H. Sun, ‘Reforming Anti-Dilution Protection in the Globalization of Luxury Brands’, *Georgetown Journal of International Law* 45 (2014), 783 (794–795); A. Griffiths, ‘Quality in European Trade Mark Law’, *Northwestern Journal of Technology and Intellectual Property* 11 (2013), 621 (635–637); A. Machnicka, ‘The Perfume Industry and Intellectual Property Law in the Jurisprudence of the Court of Justice of the European Union and of National Courts’, *International Review of Intellectual Property and Competition Law* 43 (2012), 123

fulfilled by marks with a reputation: marks with a strong brand image capable of conveying lifestyle messages that are the result of substantial investment in advertising. Protection of a trademark's communication, investment and advertising functions is protection of the investment in the creation of a favourable brand image and the brand communication based on this image. The extension of trademark protection to these functions transforms trademark rights into brand exploitation instruments.<sup>42</sup>

On its merits, the grant of brand image protection thus leads to protection of a trademark as an individual communication product.<sup>43</sup> The recognition of a trademark's economic and communication value means that trademarks enjoy protection not only as identifiers of commercial source but also as communication tools. Communication, however, also lies at the core of cultural processes of reuse and remix. The extension of trademark protection to communication, investment and advertising functions is thus particularly worrisome when assessing potential risks for cultural follow-on innovation. Once the economic and communication value of a trademark is recognized as an independent subject matter of protection, it is no longer accurate to confine the analysis to the question of a likelihood of confusion. In trademark systems, such as the EU system, that offer protection of a trademark's communication, investment and advertising functions, an unauthorized user of a protected sign cannot escape an infringement claim by simply arguing that her use would not mislead consumers into believing that there

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(138–139). For critical comments, see I. Simon Fhima, 'Trade Mark Law and Advertising Keywords', in: A. Savin/J. Trzaskowski (eds.), *Research Handbook on EU Internet Law*, Cheltenham, UK and Northampton, MA, USA: Edward Elgar Publishing 2014, 143 (161); A. Banerjee, 'Non-Origin Infringement – Has Trade Mark Law Gone Too Far?', *International Review of Intellectual Property and Competition Law* 43 (2012), 555; M.R.F. Senftleben, 'Trade Mark Protection – A Black Hole in the Intellectual Property Galaxy?', *International Review of Intellectual Property and Competition Law* 42 (2011), 383.

<sup>42</sup> Cf. Peukert, supra note 38, 421–422; Fezer, supra note 37, 461–462; J. Moskin, 'Victoria's Big Secret: Wither Dilution Under the Federal Dilution Act', *The Trademark Reporter* 93 (2004), 842 (843–844), refers to 'the expansion of trademark rights from a tort-based theory preventing direct diversion of sales between competitors to a broader set of rights resting on a recognition that trademarks themselves possess economic value'.

<sup>43</sup> Kur/Senftleben, supra note 41, para. 1.29–1.39; Peukert, supra note 38, 421–422; J.C. Ginsburg, 'Licensing Commercial Value: from Copyright to Trademarks and Back', in: I. Calboli/J. de Werra (eds.), *The Law and Practice of Trademark Transactions – A Global and Local Outlook*, Cheltenham, UK and Northampton, MA, USA: Edward Elgar Publishing 2016, 53 (75–77); M.R.F. Senftleben, 'The Trademark Tower of Babel – Dilution Concepts in International, US and EC Trademark Law', *International Review of Intellectual Property and Competition Law* 40 (2009), 45 (48–49); L. Bently, 'From Communication to Thing: Historical Aspects of the Conceptualisation of Trade Marks as Property', in: G.B. Dinwoodie/M.D. Janis (eds.), *Trademark Law and Theory: A Handbook of Contemporary Research*, Cheltenham, UK and Northampton, MA, USA: Edward Elgar Publishing 2008, 3 (15–41); Schroeder, supra note 38, 161; R.G. Bone, 'Hunting Goodwill: A History of the Concept of Goodwill in Trademark Law', *Boston University Law Review* 86 (2006), 547 (549); Moskin, supra note 42, 843–844; G.B. Dinwoodie, 'Trademark and Copyright: Complements or Competitors?', in: J.C. Ginsburg/J.M. Besek (eds.), *Adjuncts and Alternatives to Copyright – Proceedings of the ALAI Congress June 13–17, 2001*, New York: Kernochan Center for Law, Media and the Arts, Columbia University School of Law 2002, 498 (503–504); Fezer, supra note 37, 461–462; S. Casparie-Kerdel, 'Dilution Disguised: Has the Concept of Trade Mark Dilution Made Its Way into the Laws of Europe?', *European Intellectual Property Review* 2001, 185 (185–186); G.S. Lunney, Jr., 'Trademark Monopolies', *Emory Law Journal* 48 (1999), 367 (437–439); M.A. Lemley, 'The Modern Lanham Act and the Death of Common Sense', *Yale Law Journal* 108 (1999), 1687 (1694–1698); Brown, supra note 37, 1619–1620; M. Lehmann, 'Die wettbewerbswidrige Ausnutzung und Beeinträchtigung des guten Rufes bekannter Marken, Namen und Herkunftsangaben – Die Rechtslage in der Bundesrepublik Deutschland', *Gewerblicher Rechtsschutz und Urheberrecht – International* (1986), 6 (14–17).

was a connection with the trademark owner. In addition, the trademark proprietor has the argument at her disposal that – even in the absence of origin confusion – the use amounts to infringement because it damages or derives unfair benefits from the economic and communication value of the trademark.<sup>44</sup>

In other words, the grant of trademark rights gives the trademark proprietor an elevated position in the discourse about the registered cultural heritage sign. The broader the scope of trademark protection as a result of investment in advertising and marketing, the stronger the influence on the communication surrounding the affected cultural sign.<sup>45</sup> A trademark enjoys broader protection against confusion when it has a strong distinctive character.<sup>46</sup> It enjoys protection against dilution that goes beyond identical and similar goods and services when it acquires the status of a well-known, famous or reputed mark.<sup>47</sup> This gradual expansion of communication power entails the risk of censorship. Intentionally or unintentionally, the trademark owner will bring trademark claims against forms of unauthorized use which, from the perspective of the underlying marketing strategy, denigrate the trademarked cultural sign (and, therefore, damage the reputation of the cultural heritage brand), whereas the trademark owner is likely to refrain from taking action against forms of use that do not interfere with her own strategy for the development of the message and meaning of the cultural sign (and, thus, are no threat to the value and renown of the cultural heritage brand).<sup>48</sup> This enforcement behaviour is a corollary of the registration of a cultural heritage sign as a trademark and subsequent use as a tool to convey marketing messages. In extreme cases, the assertion of trademark rights against use that is undesirable from the perspective of a brand owner may even impact communication processes in the literary and artistic domain – the societal subsystem that made the evolution of the sign possible in the first place.<sup>49</sup>

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<sup>44</sup> Cf. S. Jacques, 'A Parody Exception: Why Trade Mark Owners Should Get the Joke', *European Intellectual Property Review* 38 (2016), 471 (473); M.P. McKenna, 'An Alternate Approach to Channeling?', *William and Mary Law Review* 51 (2009), 873 (883–884 and 895).

<sup>45</sup> For a discussion of the growing impact of trademark rights on communication based on the protected sign, see Senftleben, *supra* note 41, 383; L.P. Ramsey, 'Descriptive Trademarks and the First Amendment', *Tennessee Law Review* 70 (2003), 1095; R.C. Dreyfuss, 'Expressive Genericity: Trademarks as Language in the Pepsi Generation', *Notre Dame Law Review* 65 (1990), 397 (397–398).

<sup>46</sup> Kur/Senftleben, *supra* note 41, para 4.346–4.347; J.T. McCarthy, 'Dilution of a Trademark: European and United States Law Compared', *The Trademark Reporter* 94 (2004), 1163 (1170–1172).

<sup>47</sup> As to these different threshold requirements for the acquisition of protection in the area of dissimilar goods and services in international, US and EU law, see Senftleben, *supra* note 43, 50–55.

<sup>48</sup> Cf. M.R.F. Senftleben, 'Vigeland and the Status of Cultural 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 (688–689).

<sup>49</sup> For example, see Benelux Court of Justice, 14 October 2019, case A2018/1/8, Moët Hennessy/Cedric Art, para. 9; Court of Appeals of Amsterdam, 13 September 2011, case ECLI:NL:GHAMS:2011:BS7825, Mercis and Bruna/Punt, AMI 2012, 28, para. 4.19; District Court of The Hague, 4 May 2011, case LJM BQ3525, Nadia Plesner/Louis Vuitton, para. 2.1–2.8. Cf. Senftleben, *supra* note 48, 171–174, 191; Peukert, *supra* note 38, 424; D.J.G. Visser, 'Darfurnica: modellenrecht versus kunstvrijheid', *Nederlands Juristenblad* 2011, 740 (740–742).

### 3. SIGN DEVALUATION

In addition to censorship risks, the adoption of a cultural sign as a trademark and marketing tool may devalue the sign as a basis for innovation processes in the literary and artistic domain because it leads to the attachment of commercial marketing messages.<sup>50</sup> Due to the configuration of the trademark system, use of the cultural sign as a marketing instrument is inevitable once trademark rights are awarded. To maintain trademark rights, the trademark owner must make genuine use of the cultural heritage sign in the sense of trademark law. Otherwise, the trademark registration is exposed to the risk of cancellation in the EU after an uninterrupted non-use period of five years.<sup>51</sup> The requirement of genuine use has two facets. On the one hand, the trademark proprietor is obliged to use the trademark to create or preserve an outlet for goods or services, in respect of which the mark is registered.<sup>52</sup> On the other hand, the use must be in accordance with the essential trademark function of indicating the commercial origin of these goods or services.<sup>53</sup> Once a cultural heritage sign is registered as a trademark, the owner of the registration is therefore bound to develop the sign as a badge of origin and marketing tool for the goods and services involved. Marketing efforts, however, are capable of blurring cultural connotations which the sign had prior to the acquisition of trademark rights. Following Katya Assaf's line of argument, it may even be said that they gradually supersede the sign's cultural meaning.<sup>54</sup>

In the light of an economic analysis of the interplay between intellectual property protection and the public domain, this development may seem unproblematic at first glance: the more complex and diverse a sign's denotations, the higher might be its societal value. This argument seems to lie at the core of Rochelle Dreyfuss's positive assessment of cultural heritage branding.<sup>55</sup> From an economic perspective, Eli Salzberger describes this potential positive effect as follows:

Let us assume that the government changes the designation of particular common land into private property, this piece of land is subsequently purchased by an individual on which she builds an architectural masterpiece. This new building is privately owned in the sense that no one can enter the building, use it, sell it, or eliminate it save its private owner or under her permission. But the pleasure of viewing the building for the rest of the community, the inspiration it creates, its contribution to future architectural plans can be regarded as an enlargement of the public domain.<sup>56</sup>

In this vein, it might be argued that the grant of trademark protection enriches a sign in the public domain because it offers incentives to add complex commercial meanings to a formerly

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<sup>50</sup> Cf. Assaf, *supra* note 31, 21–23.

<sup>51</sup> Cf. Kur/Senftleben, *supra* note 41, para. 6.176–6.182. Article 19(1) TRIPS sets forth an international minimum standard of 'at least' three years of non-use.

<sup>52</sup> CJEU, 11 March 2003, case C-40/01, *Ajax/Ansul*, para. 36 and 43. Cf. Kur/Senftleben, *supra* note 41, para. 6.154.

<sup>53</sup> CJEU, 8 June 2017, case C-689/15, *Gözze Frottierweberei*, para. 42. Cf. Kur/Senftleben, *supra* note 41, para. 6.156.

<sup>54</sup> Assaf, *supra* note 31, 11–12 and 21–23.

<sup>55</sup> Dreyfuss, *supra* note 30, 328.

<sup>56</sup> Eli M. Salzberger, 'Economic Analysis of the Public Domain', in: L.C.M.R. Guibault/P.B. Hugenholtz (eds.), *The Future of the Public Domain – Identifying the Commons in Information Law*, The Hague/London/New York: Kluwer Law International 2006, 27 (55).

undeveloped sign.<sup>57</sup> In the case of an undefined sign which the trademark owner charges with source-identifying and lifestyle messages, the branding process may lead to an enhancement of language tools and rhetoric devices.<sup>58</sup>

However, a different scenario arises when branding initiatives concern signs which already have complex meanings because of their evolution in the cultural domain.<sup>59</sup> With regard to cultural heritage material in the public domain, for instance, it is doubtful that branding will enrich language and offer additional rhetoric devices, as Rochelle Dreyfuss assumes.<sup>60</sup> A sign in this category already has a whole spectrum of complex meanings and connotations attached to it.<sup>61</sup> It can hardly be compared with the undeveloped common land which Salzberger takes as a starting point in his explanation of potential positive effects. If the complex meanings and rich connotations evoked by a cultural sign are blurred or even suppressed as a result of the acquisition of trademark protection and the attachment of marketing messages,<sup>62</sup> the sign's expressive value – in line with Katya Assaf's prediction<sup>63</sup> – may be reduced rather than being enhanced. On balance, the attachment of marketing messages may devalue the sign.<sup>64</sup>

Inevitably, the attachment of commercial marketing messages influences the perception of the public: the sign is no longer exclusively seen as an artwork but is also seen as an identifier of commercial source, symbol of a particular lifestyle, etc. This risk must not be underestimated. In terms of potential repercussions on the availability of expressive and rhetoric tools, it seems particularly important to consider the impact on cultural follow-on innovation. Cultural heritage symbols in the public domain constitute central building blocks for follow-on innovation in the literary and artistic domain. Once trademark rights relate to this raw material for future creativity, however, second authors who want to build their creations on affected cultural heritage signs cannot escape commercial connotations which have been added to the sign as a result of use in trade. In consequence, the discussion and reinterpretation of the sign in the literary and artistic domain and its use as a reference point for future artistic creativity become more difficult.

Artists who feel that the commercial connotations added by the trademark owner thwart their intended artistic expression will avoid the sign and use other cultural creations instead. While their artistic creativity is unlikely to stop altogether, it will go in different directions:

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<sup>57</sup> Cf. M. Richardson, 'Trade Marks and Language', *Sydney Law Review* 26 (2004), 193 (193), who argues for the adoption of an incentive rationale in trademark law that seeks to stimulate popular brand culture and the creation of new brand language.

<sup>58</sup> Cf. Dreyfuss, *supra* note 30, 325–331.

<sup>59</sup> Cf. W.M. Landes/R.A. Posner, 'The Economics of Trademark Law', *The Trademark Reporter* 78 (1988), 267 (272–273), who recognize benefits accruing from incentives to invest resources in the invention of 'new words'. Arguably, the same argument cannot be made with regard to the recoding of signs which already have a rich spectrum of meanings. However, see Richardson, *supra* note 57, 213, for a positive assessment of recoding because of additional connotations.

<sup>60</sup> Dreyfuss, *supra* note 30, 328.

<sup>61</sup> CJEU, 12 January 2006, case C-361/04 P, Picasso/Picaro, para. 27.

<sup>62</sup> Cf. K. Assaf, 'Der Markenschutz und seine kulturelle Bedeutung: Ein Vergleich des deutschen mit dem US-amerikanischen Recht', *Gewerblicher Rechtsschutz und Urheberrecht – International* 2009, 1 (2–3); M.R.F. Senftleben, 'Der kulturelle Imperativ des Urheberrechts', in: M. Weller/N.B. Kemle/T. Dreier (eds.), *Kunst im Markt – Kunst im Recht*, Baden-Baden: Nomos 2010, 75 (101–102); A. Wandtke/W. Bullinger, 'Die Marke als urheberrechtlich schutzfähiges Werk', *Gewerblicher Rechtsschutz und Urheberrecht* 1997, 573 (578).

<sup>63</sup> Assaf, *supra* note 31, 45.

<sup>64</sup> Senftleben, *supra* note 9, 63–67.

second authors will no longer make an effort to reflect on the cultural message and importance of the trademarked sign. They will focus on other sources of inspiration. Once impregnated with commercial connotations, cultural signs are rendered less attractive for use in the artistic domain because the remix of the sign's artistic expression is no longer possible without evoking its commercial facets. In consequence, the sign's potential to serve as a basis for artistic dialogue will never be explored in its entirety. Society loses potentially important reflections on a cultural sign which – in the absence of use as a trade symbol – could have come to light in the artistic discourse: one of the seeds for cultural follow-on innovation will never grow into the tree that could have come into existence without commercial interference. Inevitably, the branches depending on the cultural dimension of the sign will remain underdeveloped. Because of the described communication power of the trademark owner (preceding Section 2) and the commercial redefinition of the sign's meaning, artists are likely to refrain from using the sign as a source of inspiration and a building block of new works. This problem may be particularly severe with regard to a country's own cultural heritage. When attempts to register cultural signs as trademarks concern domestic cultural symbols,<sup>65</sup> the grant of trademark rights renders these domestic reference points for cultural follow-on innovation unattractive in the eyes of artists looking for source material for new creations. Arguably, trademark rights in domestic cultural symbols bring in their wake a disincentive to use these symbols in derivative literary and artistic works. In consequence, the grant of trademark rights may hamper the renewal of the domestic cultural landscape.

Admittedly, research in the field of cognitive science has shown that dilutive use of a sign can reinforce, rather than chip away, the strength of its original meaning. With regard to dilutive use of well-known marks, Rebecca Tushnet has pointed out that

exposure to near variants or uses in other contexts makes the trademark more familiar and thus more easily retrieved from memory. This process can add value in the same way that marketers think preexisting associations carried by descriptive or suggestive terms add value to a trademark. Words with multiple associations may be more easily activated, or reference to one word may 'prime' us to recall a similar word. Tiffany's-the-restaurant may make us think of Tiffany's-the-jeweler when we are at lunch thinking of gifts for Mother's Day.<sup>66</sup>

Relying on brand-extension research, Tushnet also stresses that use of variants of a protected sign in a dubious context is unlikely to tarnish a strong brand as long as there is no source confusion and the brand messages are robustly embedded in the minds of consumers:

If consumers are given a reason to distinguish an authorized extension or cobranded product from the core brand – for example, a name like Courtyard by Marriott instead of Marriott or Coke Blak instead of Coke – they will do so, and negative opinions about the extension will not return to harm opinions of the core brand. If consumers seize on such fine distinctions for authorized line extensions, it seems implausible that, absent confusion, they will transfer negative opinions between unrelated products or services.<sup>67</sup>

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<sup>65</sup> For example, see EFTA Court, 6 April 2017, case E-5/16, Municipality of Oslo ('Vigeland'), para. 20–26.

<sup>66</sup> R. Tushnet, 'Gone in Sixty Milliseconds: Trademark Law and Cognitive Science', *Texas Law Review* 86 (2008), 507 (537). Cf. M.A. Lemley/M.P. McKenna, 'Irrelevant Confusion', *Stanford Law Review* 62 (2010), 413 (429–432).

<sup>67</sup> Tushnet, *supra* note 66, 543–544.

Applying these insights to cultural heritage symbols *mutatis mutandis*, it may be said that use of a cultural heritage sign in a commercial marketing context may enhance the familiarity of consumers with the cultural symbol. It may render the sign more easily accessible in the memory of the public. Consumers are likely to think not only of marketing messages but also of the sign's cultural meaning when it appears in commercial communication. Even use of a cultural heritage sign in an objectionable, negative context<sup>68</sup> need not erode the favourable, positive image which the sign may have as a result of its evolution in the cultural domain.

While these considerations unmask trademark dilution and brand erosion arguments as mere rhetoric,<sup>69</sup> they fail to properly address the risk of devaluing cultural heritage symbols through use in commercial communication. This risk arises even if the use makes consumers more familiar with the sign and its cultural meaning, and even if the use does not automatically kill cultural connotations. Inevitably, the sign becomes a hybrid. The time of its unchallenged existence as a cultural artefact is over. With the described communication power following from the grant of exclusive trademark rights, lasting commercial connotations enter the picture. If the activities of the trademark owner comply with the outlined genuine use requirements, the audience detecting the trademarked sign in a derivative artwork will inevitably think of the enterprise of the trademark owner and the pictures and marketing messages which the trademark owner evokes in advertising. An artist including the sign in a derivative work can hardly elude these commercial connotations. As Katya Assaf points out

the essence of the first task [the task of trademark developers to educate consumers to perceive the sign as a trademark] is to create a strong associative link between the trademark and the respective products or services in the consumer's mind. If the trademark consists of an existing cultural sign, this process will inevitably interfere with its meaning. This interference happens due to the reciprocal forces existing in the semantic field; while some of the cultural sign's initial meaning comes to be embedded in the trademark, the trademark also casts a shadow on the cultural sign.<sup>70</sup>

Hence, the mere existence of commercial connotations is problematic – regardless of their interplay with the sign's cultural meaning. The moment commercial marketing messages are added, the damage consisting of a 'shadow on the cultural sign' is done: the cultural sign is devalued as an expressive and rhetoric tool – as a basis for artistic remix and reuse that seeks to play with the sign's original, cultural meaning.<sup>71</sup> As the trademark owner creates an amalgam of commercial and cultural connotations, it is no longer possible to refer to the cultural meaning of affected cultural heritage symbols in isolation. An artist wishing to do so must realize that her intended artistic comment may be doomed to fail because of commercial connotations that blur the perception of the sign and the perception of the derivative work.

This corrosive effect of marketing messages is particularly strong when trademark rights are granted. In contrast to incidental and variable use in advertising, indefinitely renewable trademark rights enhance the risk of continuous and consistent genuine use as an identifier of

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<sup>68</sup> For a concrete example concerning the use of a cultural heritage sign as a trademark for cleaning detergents, see M.R.F. Senftleben, 'Sacrificing the Gods on the Altar of Sports – The Redefinition of Cultural Symbols in the Sports Sector', in: M.R.F. Senftleben/J. Poort/M. van Eechoud/S. van Gompel/N. Helberger (eds.), *Intellectual Property and Sports – Essays in Honour of Bernt Hugenholtz*, The Hague/London/New York: Kluwer Law International 2021, 233 (242–243).

<sup>69</sup> Tushnet, *supra* note 66, 562–565.

<sup>70</sup> Assaf, *supra* note 31, 11.

<sup>71</sup> Cf. Curtin, *supra* note 9, 998.

commercial source and carrier of commercial marketing messages. While the owner of trademark rights obtains an exclusive right to prohibit unauthorized use of the sign and an incentive to invest in the development of the sign as a commercial symbol, the freedom of using public domain material in advertising does not lead to an exclusive right that offers sufficient legal certainty for substantial investment in the attachment of lasting commercial connotations to the sign. Even more importantly, use in advertising does not lead to a legal position which the advertiser can invoke to substantiate threats of infringement when sending cease-and-desist letters to artists using the sign for their work. A user in the literary and artistic domain can re-establish the sign's cultural meaning without exposure to allegations of trademark infringement. Therefore, the mere invocation of freedom to use public domain material in advertising does not change the rules of the communication process as fundamentally as the grant of exclusive trademark rights. It does not give one individual speaker outstanding communication control. In the case of trademark rights, the damage to the communication process in the literary and artistic domain will therefore be more enduring than in the case of incidental use in advertising. Trademark rights impose a lasting burden on use of the sign in the artistic discourse.

Considering these consequences, it is doubtful whether commercial meanings added by trademark owners in cases of cultural heritage branding can outweigh the loss of dialogic communication potential for artistic purposes. Admittedly, the connotations stemming from genuine trademark use may serve as an alternative reference point for artistic creativity. An artist may find the hybrid nature of affected cultural heritage symbols inspiring. The commercial connotations may be a welcome starting point for an artistic comment. The resulting derivative work, however, must not be confused with a comment on the sign's genuine cultural meaning. It is a play with the sign's hybrid nature: the fact that the sign triggers an amalgam of cultural and commercial associations. It is an open question whether the opportunity to experiment with commercial connotations can compensate for the loss of artistic expression based on the cultural meaning of cultural heritage signs. For a more general comment on the omnipresence of commercial messages in modern society, a wide variety of genuine commercial symbols is available: signs that have been devised as trademarks and carriers of commercial messages from the outset. Moreover, it seems cynical to first allow commercial messages to permeate cultural signs and justify this process afterwards by pointing to critical artistic comments on the devaluation of affected signs. Without the acceptance of trademark rights and the commercial redefinition of cultural heritage material, the critical artistic comment would not have been necessary. The problem would not have arisen in the first place.

#### 4. CONCLUSION

On balance, the adoption of cultural heritage signs as trademarks entails several risks that must not be underestimated. Instead of enriching language and rhetoric devices, trademark protection restricts the freedom of future generations of authors to use affected cultural heritage signs for new literary and artistic productions. Trademark law offers the trademark owner far-reaching control over the communication process surrounding the sign. It bestows upon the trademark proprietor a broad definition power to shape the meaning of cultural public domain material. Instead of opening up the communication process, the grant of trademark rights in consequence of successful cultural heritage branding cements the



trademark owner's hegemony in the communication process surrounding affected cultural heritage signs for an indefinite time. Trademark protection means that one player in the communication process has strong incentives to invest in the development of her own messages and the suppression of the messages of others. The trademark owner becomes a centre of gravity in the communication process. Speakers in the literary and artistic domain – artists looking for sources of inspiration and building blocks for new creations – may find it difficult to push the trademark owner's commercial messages aside and recultivate the sign as a cultural symbol and reference point of literary and artistic creativity.<sup>72</sup> The grant of trademark rights leads to a legal position that allows the trademark owner to develop threats of infringement and send cease-and-desist letters.<sup>73</sup> It changes the rules of the communication process fundamentally.

Cultural heritage branding, thus, makes broad inroads into the public domain. The discourse surrounding affected cultural signs is no longer as open and free as it was before. Invoking broad protection against confusion and dilution, the trademark owner can take steps to censor artistic expressions that interfere with her branding strategy.<sup>74</sup> From a conceptual perspective, it can be added that the grant of trademark rights may also lead to a commercial redefinition and devaluation of affected cultural heritage material as a reference point for literary and artistic productions. Once a public domain sign is no longer exclusively linked with its cultural background in the mind of the audience, an artist cannot avoid the evocation of both cultural and commercial connotations. The addition of undesirable marketing messages tarnishes the cultural dimension of the affected sign. It will erode the sign's artistic meaning and discourse potential over time.<sup>75</sup> This corrosive effect will be the stronger the less desirable commercial connotations appear in the light of the sign's original cultural meaning.

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<sup>72</sup> Cf. Curtin, *supra* note 9, 1012–1013, who emphasizes the need to ensure freedom of competition among producers of literary and artistic productions wishing to build upon public domain characters.

<sup>73</sup> For a more detailed discussion of the chilling effect of cease-and-desist strategies in the artistic domain, see L.P. Ramsey, 'Free Speech Challenges to Trademark Law after *Matal v. Tam*', *Houston Law Review* 56 (2018), 401 (427); J. Schovsbo, "'Mark My Words' – Trademarks and Fundamental Rights in the EU', *UC Irvine Law Review* 8 (2018), 555 (562); I. Calboli, 'Overlapping Trademark and Copyright Protection: A Call for Concern and Action', *Illinois Law Review Slip Opinion* 2014, No. 1, 25 (31–32); Lemley/McKenna, *supra* note 47, 418–422, 443; W. McGeeveran, 'Four Free Speech Goals for Trademark Law', *Fordham Intellectual Property, Media and Entertainment Law Journal* 18 (2008), 1205 (1206–1207); L. Lessig, *Free Culture: How Big Media Uses Technology and the Law to Lock Down Culture and Control Creativity*, New York: Penguin Press 2004, 185–188.

<sup>74</sup> For a more detailed discussion of infringement arguments, see Senftleben, *supra* note 9, 141–200.

<sup>75</sup> Assaf, *supra* note 62, 2–3; Senftleben, *supra* note 62, 101–102; Wandtke/Bullinger, *supra* note 62, 578.