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Sacrificing the Gods on the Altar of Sports: The Redefinition of Cultural Symbols in the Sports Sector

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Publication date

2021

Document Version

Final published version

Published in

Intellectual Property and Sports: Essays in Honour of P. Bernt Hugenholtz

[Link to publication](#)

Citation for published version (APA):

Senftleben, M. R. F. (2021). Sacrificing the Gods on the Altar of Sports: The Redefinition of Cultural Symbols in the Sports Sector. In M. Senftleben, J. Poort, M. van Eechoud, S. van Gompel, & N. Helberger (Eds.), *Intellectual Property and Sports: Essays in Honour of P. Bernt Hugenholtz* (pp. 233-247). (Information Law Series; No. 46). Wolters Kluwer.

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Sacrificing the Gods on the Altar of Sports: The Redefinition of Cultural Symbols in the Sports Sector

Martin Senftleben

1. INTRODUCTION

In the area of sports, I have always been a big disappointment to Bernt Hugenholtz. When I applied for the position of a junior researcher at IViR twenty years ago, he did not raise the issue of my participation in the IViR football team during the job interview. Most probably he simply assumed – considering my German passport – that I would be an asset for the team and more than happy to join. To this day, it remains unclear whether strategic considerations of this nature (rather than academic credentials) tipped the scales in my favour and led to the decision to offer me the job and an entrance door to an academic career.

Be that as it may, I never lived up to Bernt's expectations in sports and, more specifically, on the football pitch. Instead of becoming one of the greatest strikers, I refused to join the IViR football team declaring that I had neither football skills nor any football interests (which, by the way, was conducive to my integration into Dutch society – I did not even have a clue about the 1974 FIFA World Cup final). After several legendary matches against law firm teams, the IViR team was dissolved at some point. Honestly speaking, I firmly believe that the decline of the team would have been faster if I had decided to join. But I am not sure whether Bernt shares this view. I also have serious doubts that I will manage to appease him and repair the damage with the following essay. But I hope that at least from an academic perspective, he will enjoy the analysis.

2. SPORTS AND GODS

In her article ‘The Dilution of Culture and the Law of Trademarks’,¹ Katya Assaf 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.²

While it is generally known that there is no weapon enabling humans to kill a god, the extinction of knowledge about the god is a death blow. A cult that sinks into oblivion, is a dead cult. In the following discussion, I will raise the question of whether a similar conclusion can be drawn with regard to cultural symbols. Does a sign stemming from the literary and artistic domain lose its value for cultural creativity – its capacity to serve as a source of inspiration and basis for new literary and artistic productions – if it is no longer primarily perceived as a cultural sign? Katya Assaf rightly 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.³

Evidently, Nike is not the only deity that the ingenuity of modern marketers has driven out of the Pantheon. Further examples can easily be found in the sports sector. Katya Assaf mentions several commercial meanings of the Greek hero Ajax,⁴ son of king Telamon and Periboea, great warrior in the Trojan War.⁵ Most probably, Bernt and other aficionados of Dutch football will immediately think about a certain football club in the Amsterdam region (even I have learned to associate the name with the football club) and not about its mythological origin.⁶ The Wikipedia entry reflects this shift:

Amsterdamsche Football Club Ajax (Dutch pronunciation: [ˈɑːjɑks]), also known as AFC Ajax, Ajax Amsterdam, or simply Ajax, is a Dutch

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1. Katya Assaf, ‘The Dilution of Culture and the Law of Trademarks’, 49 *IDEA: The Intellectual Property Law Review* (2008), 1.
 2. *Ibid.*, 11.
 3. *Ibid.*, 45.
 4. *Ibid.*, 12.
 5. See https://en.wikipedia.org/wiki/Ajax_the_Great#Trojan_War.
 6. As to the history of the football club, see <https://english.ajax.nl/club/history/#>.

professional football club based in Amsterdam, that plays in the Eredivisie, the top tier in Dutch football.⁷

In other words, the Trojan War hero is in danger of falling prey to the marketing efforts of an immensely popular sports undertaking in the Netherlands. In the minds of football fans, 'Ajax' primarily signifies the football club ('or simply Ajax'). The heroic cultural past, at best, constitutes a secondary meaning.

The central question, then, is whether this development is problematic. Resisting the temptation to answer 'no, of course not' without hesitation in this book in honour of Bernt Hugenholtz, the following analysis sheds light on considerations that may raise doubts about the appropriateness of cultural heritage branding. To lay the groundwork, it is important to point out first that the scope of trademark rights has been expanded considerably during recent 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 protects the sign 'Ajax' as a communication tool. Trademark owners, such as the football club,⁸ can exert far-reaching control over the communication process surrounding the protected sign (section 3). The use in product marketing may also be problematic from a conceptual perspective. Marketing messages may tarnish the name 'Ajax' and render the cultural sign less attractive as a basis for new literary and artistic productions (section 4). The decision on the grant of trademark rights, thus, requires a careful analysis of potential obstacles to free expression (section 5).

3. 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 Court of Justice of the European Union (CJEU) refers to:

the essential function of the trade mark, which is to guarantee the identity of the origin of the trade-marked 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.⁹

7. See https://en.wikipedia.org/wiki/AFC_Ajax.

8. As to the word mark AJAX, see Benelux registrations 850058, 875974, 846441. As to the Ajax logo and the Ajax Amsterdam logo, see European Union Trade Mark registration 000424036 and Benelux registrations 757053, 943415, 875975, 757054, 850056.

9. 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?', 36 *International Review of Intellectual Property and Competition Law* (2005), 401.

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.¹⁰ However, the scope of trademark protection becomes broader with every additional trademark function – and every additional basis for infringement claims – that is recognised 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.¹¹ 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.¹²

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.¹³ The moment a trademark ‘speaks’ to consumers about a particular image that

10. CJEU, 18 June 2009, case C-487/07, *L'Oréal/Bellure*, para. 59; CJEU, 11 November 1997, case C-251/95, *Puma/Sabel*, paras. 16–26.

11. 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.

12. 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 336, 1 (TMD). With regard to comparative advertising, see CJEU, 12 June 2008, case C533/06, *O2/Hutchison*, para. 45; CJEU, 18 June 2009, case C-487/07, *L'Oréal/Bellure*, para. 54.

13. Cf. Assaf, *supra* note 1, 13–14; A. Griffiths, ‘A Law-and-Economic Perspective on Trade Marks’, in L. Bently, J. Davis and J.C. Ginsburg (eds.), *Trade Marks and Brands – An Interdisciplinary Critique* (Cambridge University Press, Cambridge, 2008), 241 (255); R.S. Brown, ‘Advertising and the Public Interest: Legal Protection of Trade Symbols’, 108 *Yale Law Journal* (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).

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’.¹⁴

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 reflex¹⁵ 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.¹⁶

Hence, the Court expressly recognised brand image protection as an independent objective of EU trademark law.¹⁷ Communication, investment, and advertising functions are typically fulfilled by marks with a reputation: marks with a strong

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14. A. Peukert, ‘Vom Warenzeichen zum Markeneigentum. Ein polyanischer Erklärungsversuch’, in W. Büscher, J. Glöckner, A. Nordemann, C. Osterrieth and R. Rengier (eds.), *Marktkommunikation zwischen Geistigem Eigentum und Verbraucherschutz. Festschrift für Karl-Heinz Fezer zum 70. Geburtstag* (C.H. Beck, Munich, 2016), 405 (412–414); J.E. Schroeder, ‘Brand Culture: Trade marks, Marketing and Consumption’, in L. Bently, J. Davis and J.C. Ginsburg (eds.), *Trade Marks and Brands – An Interdisciplinary Critique* (Cambridge University Press, Cambridge, 2008), 161.
 15. 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, 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 the 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’, 37 *International Review of Intellectual Property and Competition Law* C (2006), 407.
 16. CJEU, 18 June 2009, case C-487/07, *L’Oréal/Bellure*, para. 58.
 17. A. Kur and M.R.F. Senftleben, *European Trade Mark Law – A Commentary* (Oxford University Press, Oxford, 2017), paras. 1.20–1.39. For a positive assessment of this development, see H. Sun, ‘Reforming Anti-Dilution Protection in the Globalization of Luxury Brands’, 45 *Georgetown Journal of International Law* (2014), 783 (794–795); A. Griffiths, ‘Quality in European Trade Mark Law’, 11 *Northwestern Journal of Technology and Intellectual Property* (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’, 43 *International Review of Intellectual Property and Competition Law* (2012), 123 (138–139). For critical comments, see I. Simon Fhima, ‘Trade Mark Law and Advertising Keywords’, in A. Savin and J. Trzaskowski (eds.), *Research Handbook on EU Internet Law* (Edward Elgar, Cheltenham, 2014), 143 (161); A. Banerjee, ‘Non-Origin Infringement – Has Trade Mark Law Gone Too Far?’, 43 *International Review of Intellectual Property and Competition Law* (2012), 555; M.R.F. Senftleben, ‘Trade Mark Protection – A Black Hole in the Intellectual

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.¹⁸

On its merits, the grant of brand image protection thus leads to protection of a trademark as an individual communication product.¹⁹ 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 recognised 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 unauthorised user of a protected sign cannot escape an infringement claim by

Property Galaxy?', 42 *International Review of Intellectual Property and Competition Law* (2011), 383.

18. Cf. Peukert, *supra* note 14, 421–422; Fezer, *supra* note 13, 461–462; J. Moskin, 'Victoria's Big Secret: Wither Dilution Under the Federal Dilution Act', 93 *The Trademark Reporter* (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.'
19. Kur and Senftleben, *supra* note 17, paras. 1.29–1.39; Peukert, *supra* note 14, 421–422; J.C. Ginsburg, 'Licensing Commercial Value: from Copyright to Trademarks and Back', in I. Calboli and J. de Werra (eds.), *The Law and Practice of Trademark Transactions – A Global and Local Outlook* (Edward Elgar, Cheltenham, 2016), 53 (75–77); M.R.F. Senftleben, 'The Trademark Tower of Babel – Dilution Concepts in International, US and EC Trademark Law', 40 *International Review of Intellectual Property and Competition Law* (2009), 45 (48–49); L. Bently, 'From Communication to Thing: Historical Aspects of the Conceptualisation of Trade Marks as Property', in G.B. Dinwoodie and M.D. Janis (eds.), *Trademark Law and Theory: A Handbook of Contemporary Research* (Edward Elgar, Cheltenham, 2008), 3 (15–41); Schroeder, *supra* note 14, 161; R.G. Bone, 'Hunting Goodwill: A History of the Concept of Goodwill in Trademark Law', 86 *Boston University Law Review* (2006), 547 (549); Moskin, *supra* note 18, 843–844; G.B. Dinwoodie, 'Trademark and Copyright: Complements or Competitors?', in J.C. Ginsburg and J.M. Besek (eds.), *Adjuncts and Alternatives to Copyright – Proceedings of the ALAI Congress June 13–17, 2001* (Kernochan Center for Law, Media and the Arts, Columbia University School of Law, New York, 2002), 498 (503–504); Fezer, *supra* note 13, 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', 48 *Emory Law Journal* (1999), 367 (437–439); M.A. Lemley, 'The Modern Lanham Act and the Death of Common Sense', 108 *Yale Law Journal* (1999), 1687 (1694–1698); Brown, *supra* note 13, 1619–1620; M. Lehmann, 'Die wettbewerbswidrige Ausnutzung und Beeinträchtigung des guten Rufs bekannter Marken, Namen und Herkunftsangaben – Die Rechtslage in der Bundesrepublik Deutschland', *Gewerblicher Rechtsschutz und Urheberrecht – International* (1986), 6 (14–17).

simply arguing that her use would not mislead consumers into believing that there 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.²⁰

In other words, the grant of trademark rights gives the trademark proprietor an elevated position in the discourse about the registered cultural sign. The broader the scope of trademark protection as a result of investment in advertising and marketing, the stronger the influence of Ajax Amsterdam on the communication surrounding the cultural sign ‘Ajax’.²¹ Given the immense popularity of Ajax sports events and merchandising articles, there can be little doubt that the football club’s word and figurative marks built on ‘Ajax’²² constitute marks with a reputation that enjoy broad protection against confusion (including confusion as to affiliation and sponsorship) and additional protection against dilution.²³ In EU trademark law, protection against dilution covers all types of goods and services (‘in relation to goods or services which are identical with, similar to, or not similar to...’).²⁴ Goods and services in the cultural sector thus fall within the scope of protection.²⁵

This expansion of communication power entails the risk of censorship. Intentionally or unintentionally, Ajax Amsterdam will bring trademark claims against forms of unauthorised use which, from the club’s point of view, denigrate the trademarked cultural sign (and, therefore, damage the reputation of the football brand), whereas Ajax Amsterdam is likely to refrain from taking action against forms of use that do not interfere with the club’s own strategy for the development of the message and meaning of the sign (and, thus, are no threat

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

21. For a discussion of the growing impact of trademark rights on communication based on the protected sign, see Senftleben, *supra* note 17, 383; L.P. Ramsey, ‘Descriptive Trademarks and the First Amendment’, 70 *Tennessee Law Review* (2003), 1095; R.C. Dreyfuss, ‘Expressive Genericity: Trademarks as Language in the Pepsi Generation’, 65 *Notre Dame Law Review* (1990), 397 (397–398).

22. Benelux registrations 850058, 875974, 846441 (word mark AJAX). As to the Ajax logo and the Ajax Amsterdam logo, see European Union Trade Mark registration 000424036 and Benelux registrations 757053, 943415, 875975, 757054, 850056

23. For a detailed discussion of the scope of protection against confusion and dilution in cases of cultural heritage branding, see M.R.F. Senftleben, *The Copyright/Trademark Interface – How the Expansion of Trademark Protection Is Stifling Cultural Creativity* (Kluwer Law International, The Hague/London/New York, 2020), 141–190.

24. Article 9(2)(c) EUTMR; Article 10(2)(c) TMD.

25. Cf. Senftleben, *supra* note 23, 141–200. The fact that other companies may have acquired trademark rights with regard to the name ‘Ajax’ in good faith (cf. CJEU, 11 March 2003, case C-40/01, *Ajax/Ansul*, with regard to use of the name for fire extinguishers) does not prevent the football club from bringing claims against unauthorised third parties without such earlier rights.

to the value and renown of the football brand).²⁶ This enforcement behaviour is a corollary of the registration of a cultural 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.²⁷

4. 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 cultural follow-on innovation because it leads to the attachment of commercial marketing messages.²⁸ 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, Ajax Amsterdam must make genuine use of the Trojan War hero in the sense of trademark law. Otherwise, the trademark registration is exposed to the risk of cancellation after an uninterrupted non-use period of five years.²⁹ 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.³⁰ 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.³¹ Once a cultural sign is registered as a trademark, the owner of the registration is bound to develop the sign as a badge of origin and marketing tool for the goods and services involved. As already pointed out, marketing efforts are capable of blurring cultural connotations which the sign had prior to the acquisition of trademark rights. They may even gradually supersede the sign's cultural meaning.³²

In the light of an economic analysis of the interplay between intellectual property protection and the public domain, this development may seem

26. 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', 48 *International Review of Intellectual Property and Competition Law* (2017), 683 (688–689).

27. 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 LJN BQ3525, *Nadia Plesner/Louis Vuitton*, paras. 2.1–2.8. Cf. Senftleben, *supra* note 23, 171–174, 191; Peukert, *supra* note 14, 424; D.J.G. Visser, 'Darfurnica: model-lenrecht versus kunstvrijheid', *Nederlands Juristenblad* (2011), 740 (740–742).

28. Cf. Assaf, *supra* note 1, 21–23.

29. Cf. Kur and Senftleben, *supra* note 17, paras. 6.176–6.182. Article 19(1) TRIPS sets forth an international minimum standard of 'at least' three years of non-use.

30. CJEU, 11 March 2003, case C-40/01, *Ajax/Ansul*, paras. 36 and 43. Cf. Kur and Senftleben, *supra* note 17, para. 6.154.

31. CJEU, 8 June 2017, case C-689/15, *Gözze Frottierweberei*, para. 42. Cf. Kur and Senftleben, *supra* note 17, para. 6.156.

32. Assaf, *supra* note 1, 11–12 and 21–23.

unproblematic at first glance: the more complex and diverse a sign's denotations, the higher might be its value. In *The Future of the Public Domain – Identifying the Commons in Information Law*³³ – edited by Lucie Guibault and Bernt Hugenholtz – 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.³⁴

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 undeveloped sign.³⁵ 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.³⁶

However, a different scenario arises when branding initiatives concern signs which already have complex meanings because of their evolution in the cultural domain.³⁷ The name 'Ajax', for instance, is pre-defined: referring to one of the main characters in Homer's *Iliad*,³⁸ it has complex cultural meanings and connotations: an aura of its own. The question, then, is whether potential benefits accruing from the grant of trademark protection outweigh the detriment flowing from the risk of losing these cultural connotations.³⁹ With regard to cultural material in the public domain, such as the iconic name 'Ajax', it is doubtful

33. Lucie Guibault and Bernt Hugenholtz (eds.), *The Future of the Public Domain – Identifying the Commons in Information Law* (Kluwer Law International, The Hague/London/New York, 2006).

34. E.M. Salzberger, 'Economic Analysis of the Public Domain', in Guibault and Hugenholtz, *ibid.*, 27 (55).

35. Cf. M. Richardson, 'Trade Marks and Language', 26 *Sydney Law Review* (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.

36. Cf. R.C. Dreyfuss, 'Cultural Heritage and the Public Domain: What the US's Myriad and Mayo can Teach Oslo's Angry Boy', in Niklas Bruun et al. (eds.), *Transition and Coherence in Intellectual Property Law: Essays in Honour of Annette Kur* (Cambridge University Press, Cambridge, 2020), 322 (325–331).

37. Cf. W.M. Landes and R.A. Posner, 'The Economics of Trademark Law', 78 *The Trademark Reporter* (1988), 267 (272–273), who recognise 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 35, 213, for a positive assessment of recoding because of additional connotations.

38. For an overview of the contents and main characters of this work, see <https://en.wikipedia.org/wiki/Iliad>.

39. Cf. Assaf, *supra* note 1, 77.

that branding will enrich language and offer additional rhetoric devices. The sign already has a whole heroic tale attached to it.⁴⁰ 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,⁴¹ the sign's expressive value may be reduced rather than being enhanced. The attachment of marketing messages may devalue the sign.⁴²

Admittedly, a fine line is to be walked here. In the absence of empirical evidence, it is unclear whether commercial messages added by Ajax Amsterdam interfere with the discourse surrounding the Greek hero Ajax as a literary and artistic symbol. Inevitably, the attachment of football marketing and merchandising messages influences the perception of the public: the sign is no longer exclusively seen as a literary and artistic symbol but also as an identifier of commercial source and an exponent of lifestyle messages conveyed by Ajax Amsterdam. However, I hear Bernt saying that, on several occasions, Ajax Amsterdam players have acted as heroically on the football pitch as Ajax in the Trojan War (and perhaps even adding that the Greek warrior is fortunate to have football heroes following in his footsteps).

To better illustrate the potential harm flowing from use in product marketing and the attachment of commercial messages, other transformations of the name 'Ajax' into trade symbols can be brought into focus. The use of 'Ajax' as a trademark for cleaning products by Colgate-Palmolive⁴³ adds connotations that give rise to greater concerns about a devaluation of the sign for artistic discourse.⁴⁴ For example, the Colgate-Palmolive trademark portfolio includes the marks AJAX WC POWER and AJAX EXPERT WC.⁴⁵ Even from a trademark perspective, these connotations are problematic. In the landmark decision *Claeryn/Klarein*, the Benelux Court of Justice confirmed more than forty years ago that use of a sign similar to an iconic gin brand for a cleaning detergent may cause prejudice 'by encroaching upon the trademark's potential for raising a desire to buy'. From this perspective, it is surprising that trademark offices did not feel sympathy for the Trojan War warrior and granted trademark rights in respect of goods that

40. CJEU, 12 January 2006, case C-361/04 P, *Picasso/Picaro*, para. 27.

41. 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 and T. Dreier (eds.), *Kunst im Markt – Kunst im Recht* (Nomos, Baden-Baden, 2010), 75 (101–102); A. Wandtke and W. Bullinger, 'Die Marke als urheberrechtlich schutzfähiges Werk', *Gewerblicher Rechtsschutz und Urheberrecht* (1997), 573 (578).

42. Cf. Senftleben, *supra* note 23, 63–67.

43. For example, see European Union Trade Mark registrations 000167361, 001663475, 002417913, 002424141, 004109815, 004109831, 004529012, 004805693, 004805727, 009097486, 009097544, 010081479 and 018139850.

44. Cf., by analogy, Benelux Court of Justice, 1 March 1975, case A 74/1, *Claeryn/Klarein*, *Nederlandse Jurisprudentie* (1975), no. 472.

45. European Union Trade Mark registrations 017891165 and 017937333.

tarnish the cultural sign. Evidently, cultural concerns – the preservation of the aura surrounding a cultural sign – do not have much weight in the trademark system.⁴⁶

In the light of registrations such as AJAX WC POWER and AJAX EXPERT WC, the risk of a sign devaluation must not be underestimated. Artists who want to build their creations on the genuine mythological meaning of the sign ‘Ajax’ may find it difficult to escape the cleaning detergent connotations which the sign has as a result of use as a trademark in this market segment. In consequence, the discussion and reinterpretation of the sign in the literary and artistic domain – its use as a reference point for future artistic creativity – become more difficult. Artists who feel that the connotations added by Colgate-Palmolive 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. Once impregnated with undesirable commercial connotations, a cultural sign, such as ‘Ajax’, may thus be rendered less attractive for use in the artistic domain because the remix of the sign’s artistic expression is no longer possible without evoking potentially conflicting commercial connotations. In consequence, the sign’s potential to serve as a basis for artistic dialogue will never be explored in its entirety. Society may lose important reflections on the cultural sign⁴⁷ which – in the absence of use as a mark for household cleaning – could have come to light in the artistic discourse. Because of the commercial redefinition of the sign’s meaning, artists may refrain from using the sign as a source of inspiration and a building block for new works.

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.⁴⁸

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

46. Cf. Senftleben, *supra* note 26, 685–686; Assaf, *supra* note 41, 18–28; Senftleben, *supra* note 41, 101–102; Wandtke and Bullinger, *supra* note 41, 578.

47. As to the societal role of art and its potential to offer alternative visions of society and pave the way for the improvement of social and political conditions, see Senftleben, *supra* note 23, 54–67.

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

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.⁴⁹

Applying these insights to Ajax *mutatis mutandis*, it may be said that use of the cultural sign in a football and cleaning 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 of Ajax Amsterdam and Colgate-Palmolive but also of the sign's cultural meaning when it appears in commercial communication. Even use of a cultural sign in an objectionable, negative context 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,⁵⁰ they fail to properly address the risk of devaluing cultural 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 marketing activities comply with the outlined genuine use requirements, the audience detecting Ajax in a derivative artwork will inevitably think of the pictures and marketing messages which trademark owners evoke with their marketing activities. 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.⁵¹

49. Tushnet, *supra* note 48, 543–544.

50. *Ibid.*, 562–565.

51. Assaf, *supra* note 1, 11.

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 a basis for artistic remix and reuse that seeks to play with the sign’s original, cultural meaning relating to Greek mythology.⁵² As Ajax Amsterdam and Colgate-Palmolive create an amalgam of commercial and cultural connotations, it is no longer possible to refer to the Greek hero in isolation. An artist wishing to do so must realise that her intended artistic comment may be doomed to fail because of football and household cleaning 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 the commercial source and carrier of commercial marketing messages. While the owner of trademark rights obtains an exclusive right to prohibit unauthorised 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 cultural 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, such as Ajax Amsterdam and Colgate-Palmolive, 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 the Greek hero inspiring. If the artist herself is a fan of the football club, the sports 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 playing with the sign’s hybrid nature: the fact that the sign triggers an amalgam of cultural and

52. Cf. R.S. Curtin, ‘Zombie Cinderella and the Undead Public Domain’, 85 *Tennessee Law Review* (2018), 961 (998).

commercial associations. It is an open question whether the opportunity to experiment with football connotations can compensate for the loss of artistic expression based on the cultural meaning of the name 'Ajax'. 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 a Greek hero's name, the critical artistic comment would not have been necessary. The problem would not have arisen in the first place.

5. CONCLUSION

On balance, the adoption of cultural heritage signs as trademarks entails several risks. Trademark protection offers far-reaching control over the communication process surrounding the sign. It bestows upon the trademark proprietor broad definition power to shape the meaning of cultural public domain material. Instead of opening up the communication process, the grant of indefinitely renewable trademark rights to Ajax Amsterdam cements the club's hegemony in the communication process surrounding the Greek hero. 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 cultural 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.⁵³ 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.⁵⁴ It changes the rules of the communication process fundamentally.

53. Cf. *ibid.*, 1012–1013, who emphasises the need to ensure freedom of competition among producers of literary and artistic productions wishing to build upon public domain characters.

54. 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*', 56 *Houston Law Review* (2018), 401 (427); J. Schovsbo, "'Mark My Words' – Trademarks and Fundamental Rights in the EU', 8 *UC Irvine Law Review* (2018), 555 (562); F. Cramer, 'Geef iedereen het recht op parodie', *NRC Handelsblad*, posted 15 April 2015, available at: <https://www.nrc.nl/nieuws/2015/04/15/geef-iedereen-het-recht-op-parodie-1484558-a197827>; I. Calboli, 'Overlapping Trademark and Copyright Protection: A Call for Concern and Action', 1 *Illinois Law Review Slip Opinion* (2014), 25 (31–32); Lemley and McKenna, *supra* note 47, 418–422, 443; W. McGeeveran, 'Four Free Speech Goals for Trademark Law', 18 *Fordham Intellectual Property, Media and Entertainment Law Journal* (2008), 1205 (1206–1207); L. Lessig, *Free Culture: How Big Media Uses Technology and*

The adoption of a Trojan War hero as a football figurehead thus triggers an information law dilemma. The acquisition of trademark rights makes inroads into the public domain. The discourse surrounding the cultural sign is no longer as open and free as it was before. Invoking broad protection against confusion and dilution, Ajax Amsterdam can take steps to censor artistic expressions that interfere with its branding strategy.⁵⁵ From a conceptual perspective, it can be added that the grant of trademark rights may also lead to a commercial redefinition and devaluation of Ajax 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.⁵⁶ This corrosive effect will be the stronger the less desirable commercial connotations appear in the light of the sign's original cultural meaning.

Against this background, an affirmative 'Of course Ajax Amsterdam has every right to appropriate the Greek hero' is less obvious than fans of the football club may hope. The decision on the grant and scope of trademark rights requires a careful balancing of all rights and interests at stake.⁵⁷ Should freedom of expression and freedom of information prevail? As I am not a football fan, the answer seems clear to me, even in cases that concern the Greek hero Ajax. Bernt may find it harder to ban, or at least restrict, trademark rights in this particular case.

the Law to Lock Down Culture and Control Creativity (Penguin Press, New York, 2004), 185–188.

55. For a more detailed discussion of infringement arguments, see Senftleben, *supra* note 23, 141–200.

56. Assaf, *supra* note 41, 2–3; Senftleben, *supra* note 41, 101–102; Wandtke and Bullinger, *supra* note 41, 578.

57. Luckily, trademark law offers a broad spectrum of tools and regulatory responses: from the outright exclusion of trademark protection to the restriction of exclusive rights on the basis of a gatekeeper requirement of 'use as a mark' and robust defences. For a detailed discussion of these options, see Senftleben, *supra* note 23, 326–393, 424–521.