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**DOI**

[10.1093/grurint/ikab107](https://doi.org/10.1093/grurint/ikab107)

**Publication date**

2022

**Document Version**

Final published version

**Published in**

GRUR International

**License**

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**Citation for published version (APA):**

Senftleben, M. (2022). No Trademark Protection for Artworks in the Public Domain – A Practical Guide to the Application of Public Order and Morality as Grounds for Refusal. *GRUR International*, 71(1), 3-17. <https://doi.org/10.1093/grurint/ikab107>

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MARTIN 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

With its 2017 landmark decision in *Vigeland*, the Court of Justice of the European Free Trade Association States (EFTA Court) has paved the way for the invocation of public order and morality as grounds for refusal when trademark protection is sought for cultural expressions in the public domain. Dealing with an attempt to register artworks of the famous Norwegian sculptor Gustav Vigeland as trademarks, the EFTA Court took this step to safeguard the public domain status of literary and artistic works after the expiry of copyright, shield cultural creations against ‘commercial greed’ and ensure the freedom of the arts.<sup>1</sup> Trademark examiners and judges seeking to follow in the footsteps of the EFTA Court, however, may find it difficult to operationalize the *Vigeland* criteria and put corresponding arguments for refusal into practice. Against this background, the following analysis provides guidelines for the practical application of public order and morality arguments in cultural heritage cases. It describes problems arising from the grant of trademark rights in cultural public domain material (Section I) and the traditional reluctance of trademark offices and courts to rely on public order and morality considerations in this context (Section II). After this statement of the problem, the criteria following from the *Vigeland* decision will be introduced (Section III) before we explore the practical implementation of the EFTA Court’s morality (Section IV) and public order (Section V) arguments in more detail. The final Section VI summarizes the results of the analysis.

## I. Introduction

Article 7(1)(f) of the EU Trade Mark Regulation (EUTMR)<sup>2</sup> and Art. 4(1)(f) of the Trade Mark Directive (TMD)<sup>3</sup> bar from registration trademarks ‘which are contrary to public policy or to accepted principles of morality.’ Experiences with this ground for refusal, however, show that judges and examiners may be hesitant to argue that considerations of public order or morality militate against the grant of trademark rights to signs with cultural significance. In the *Winston Churchill* decision, for example, the Dutch Supreme Court rejected the argument that registration of the name and portrait of Winston Churchill as a trademark for cigars was contrary to morality or public order.<sup>4</sup> The Court found that, even though some may perceive the use of Churchill’s name and portrait for tobacco marketing as vulgar, others may find it acceptable. Moreover, use for this purpose may keep the memory of this popular statesman alive.<sup>5</sup> The German Federal Patent Court also rejected the public order and morality argument in respect of an attempt to

register the Mona Lisa as a trademark. Instead, the Court assumed a lack of distinctive character and denied trademark protection for this reason.<sup>6</sup> A similar pattern arose in the more recent *Nachtwacht* (*Night Watch*) decision of the Court of Appeals of The Hague. The case concerned an application to register the famous painting by Rembrandt van Rijn as a trademark for the marketing of the chemical element strontium. Despite the fact that use of the *Night Watch* in respect of this chemical product seemed rather exotic, the Court arrived at the conclusion that the painting could not be deemed inherently distinctive. It lent weight to the fact that the Benelux Office for Intellectual Property had demonstrated that the *Night Watch* had been used frequently as a decorative element on various goods.<sup>7</sup> On this basis, the Court concluded that the average consumer of strontium would immediately recognize a reproduction of the *Night Watch* on the packaging of strontium as one of the most famous paintings of the world and fail to understand that the sign was intended to indicate the commercial origin of the goods. The consumer would perceive the sign as a mere decoration.<sup>8</sup> Like the German Federal Patent Court in *Mona Lisa*, the Court of Appeals of The Hague saw no need to base its rejection of trademark rights not only on a lack of distinctiveness but also on a conflict with *ordre public*.

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<sup>1</sup> EFTA Court, 6 April 2017, Case E-5/16 *Municipality of Oslo* (*‘Vigeland’*), paras 65–66 and 92–96.

<sup>2</sup> Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark (codification) [2017] OJ L 154/1.

<sup>3</sup> Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trade marks [2015] OJ L336/1.

<sup>4</sup> Dutch Supreme Court, 28 October 1948, [1949] *Bijblad bij de industriële eigendom 24 – Bureau I.E. v Churchill’s Cigars* (*‘Winston Churchill’*).

<sup>5</sup> *ibid.*

<sup>6</sup> German Federal Patent Court, 25 November 1997, Case 24 W (pat) 188/96, [1998] GRUR 1022–1023 – *Mona Lisa*.

<sup>7</sup> Court of Appeals of The Hague, 29 August 2017, Case 200.205.771/01 *Chiever v Benelux-Organisatie voor de Intellectuele Eigendom* (*‘Nachtwacht’*) ECLI:NL:GHDHA:2017:2446, para 12.

<sup>8</sup> *ibid* para 12.

The Benelux Office for Intellectual Property had explicitly invoked this additional ground for refusal.<sup>9</sup> Nonetheless, the Court refrained from a discussion of a conflict with public policy or accepted principles of morality even though it was fully aware that a denial of rights because of a lack of distinctive character would leave open the backdoor of acquiring distinctiveness – and trademark protection – as a consequence of use in the course of trade.<sup>10</sup>

The latter feature of trademark law – the option of acquiring trademark rights to cultural heritage material through continuous use in trade – is worrisome when the registration of cultural heritage material as trademarks is seen as an act of re-monopolizing and misappropriating cultural expressions that should remain free as sources of inspiration and building blocks of new literary and artistic productions.<sup>11</sup> From this perspective, the rejection of public policy and principles of morality as further grounds for refusal in *Mona Lisa* and *Nachtwacht* has far-reaching consequences. The exclusion of cultural heritage signs on the ground of a lack of distinctive character following from the painting's widespread use in advertising is weak because cultural signs can acquire distinctive character as a result of use in trade.<sup>12</sup> The decisions of the German Federal Patent Court and the Court of Appeals of The Hague allow the possibility of overcoming the obstacle to registration through intensive use in product marketing and advertising. Once consumers have been taught to perceive the *Mona Lisa* and the *Night Watch* as source identifiers referring to the applicant's enterprise, a registration of the famous paintings becomes possible. Furthermore, the assessment of distinctive character may differ from trademark examiner to trademark examiner. The verdict of a lack of distinctive character in the Benelux, for instance, did not prevent the EUIPO from assuming inherent distinctive character and granting EU-wide trademark rights to the *Night Watch* for the sale of strontium.<sup>13</sup> An exclusion based on a conflict with public policy and principles of morality would be more robust. Proof of the acquisition of distinctive character through use is not sufficient to surmount this registration hurdle. In contrast to a refusal based on a lack of distinctiveness, the rejection of trademark rights on the ground that the application is contrary to public policy or accepted principles of morality leads to an outright exclusion – irrespective of whether the painting is distinctive or not. Instead

<sup>9</sup> *ibid* para 1.4.

<sup>10</sup> *ibid* paras 8-9.

<sup>11</sup> For a more detailed discussion of this argument, see Martin RF Senftleben, *The Copyright/Trademark Interface – How the Expansion of Trademark Protection Is Stifling Cultural Creativity* (Wolters Kluwer 2020) 25-98.

<sup>12</sup> Nonetheless, Yann Basire, 'Public Domain Versus Trade Mark Protection: The Vigeland Case' (2018) 13 *Journal of Intellectual Property Law and Practice* 434, 435, prefers a solution based on the requirement of distinctiveness and the assumption that consumers will perceive cultural signs as descriptive or decorative product elements. This solution, however, does not address the destabilizing effect of the possibility of acquiring distinctiveness through continuous use in trade.

<sup>13</sup> EUTM No 016613903. As the CJEU, 6 September 2018, Case C-488/16 P *Bundesverband Souvenir – Geschenke – Ehrenpreise ('Neuschwanstein')* ECLI:EU:C:2018:673, 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.

of following this secure route, the German Federal Patent Court and the Court of Appeals of The Hague deemed it sufficient to rely on the basic requirement of distinctive character. Hence, they failed to permanently eliminate the risk of a removal of the *Mona Lisa* and the *Night Watch* from the public domain.

## II. Roots of the problem

The *Mona Lisa* and *Nachtwacht* decisions seem grounded in traditional assumptions about the field of application of public order and morality as grounds for refusal.<sup>14</sup> The guidelines developed by the Grand Board of Appeal of the former Office for Harmonisation in the Internal Market (OHIM), for instance, indicate that the focus has traditionally been on the offensive character of the sign as such, or the offensive character of the use of a particular sign in respect of objectionable goods or services.<sup>15</sup> The test for refusing trademark rights to a cultural sign would thus culminate in the question whether a sufficiently broad part of the relevant public considered the sign in and of itself offensive, or would find the use of the sign in relation to certain goods or services unacceptable. With regard to signs of symbolic value, the decision of the General Court of the European Union (GCEU) in *Couture Tech v OHIM ('Soviet coat of arms')* illustrates this field of application. In this case, trademark protection was sought for a figurative sign showing the coat of arms of the former Soviet Union.<sup>16</sup> The application had been rejected by OHIM on the ground that in Latvia and Hungary, the registration of official symbols of the former USSR would cause a conflict with public policy. Confirming this decision, the GCEU pointed out that in the assessment of a sign's offensive character, national circumstances had to be factored into the equation that were likely to influence the perception of a mark by the relevant public.<sup>17</sup> As it seemed obvious that a substantial part of the public in Hungary and Latvia would consider the mark offensive, the application for registration had to be refused.<sup>18</sup>

This traditional focus on the offensive nature of the sign for which protection is sought narrows the field of application with regard to cultural signs. Obviously, a sign consisting of the *Mona Lisa* or the *Night Watch* is not scandalous in and of itself. Under the traditional approach, cultural signs can thus only be refused in extreme cases where the sign is placed in an objectionable context, for instance, because of the goods or services involved.

<sup>14</sup> For an overview of this traditional approach, see Christophe Geiger and Leonardo Machado Pontes, 'Trade Mark Registration, Public Policy, Morality and Fundamental Rights' (2017) Centre for International Intellectual Property Studies Research Paper No 2017-01, Strasbourg: CEIPI 8-11; Annette Kur and Martin RF Senftleben, *European Trade Mark Law – A Commentary* (Oxford University Press 2017) paras 4.205-4.218; 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' (2017) 39 *EIPR* 457 (459-460).

<sup>15</sup> EUIPO Board of Appeal, 6 July 2006, Case R 495/2005-G – *Jebaraj Kenneth trading as Screw You v OHIM (SCREW YOU)*, para 30. See also EUIPO Board of Appeal, 25 March 2003, Case R 111/2002-4 – *Dick Lexic Ltd. v OHIM (DICK & FANNY)*.

<sup>16</sup> GCEU, 20 September 2011, Case T-232/10 *Couture Tech Ltd v OHIM ('Soviet coat of arms')* ECLI:EU:T:2011:498, para 2-3.

<sup>17</sup> *ibid* paras 36 and 53.

<sup>18</sup> *ibid* paras 57-62.

An attempt to register a sign derived from Pablo Picasso's famous painting 'Guernica' for the sale of weapons might be such an example where the goods concerned contradict the meaning of the affected cultural sign.<sup>19</sup> As long as the traditional focus on the scandalous nature of the sign as such, or an objectionable context arising from the goods or services, is not abandoned in favour of a more flexible approach, public order and morality can hardly play an effective role with regard to cultural signs.

### III. Alternative *Vigeland* approach

A national precursor of a more elastic application of public order and morality can be found in the area of religious signs. In *Messias*, for example, the German Federal Patent Court denied the registration of the word mark MESSIAS for clothing, shoes and hats. Obviously, the sign as such was not offensive. To pave the way for the application of public order and morality as grounds for refusal, the Court focused on the fact that the trademark registration would lead to commercial use of the religious sign in trade.<sup>20</sup> In *Budha*, the German Federal Patent Court assumed that significant parts of the German public would perceive the word BUDHA (which the trademark applicant sought to register for perfumery, cosmetics, jewellery, watches, clothing, shoes and hats) as a reference to the Buddha as the founder of Buddhism. As the grant of trademark rights would lead to the commercial exploitation of the word 'Budha,' the Court held that the trademark application was contrary to the religious or ethical values of significant parts of the German public. The relevant public would perceive the registration as offensive.<sup>21</sup> The focus, therefore, switched from the offensive nature of the sign to the offensive nature of the registration as a trademark and the subsequent commercialization of the religious sign.

Similar impulses for a broader application of public order and morality as grounds for refusal in cases involving cultural heritage material can follow from the milestone ruling of the EFTA Court in *Vigeland*. In this case, the EFTA Court was called upon to assess an attempt to register several artworks made by Gustav Vigeland – one of the most eminent Norwegian sculptors – as trademarks. The reason for the initiative to acquire trademark rights was the expiry of the term of copyright protection.<sup>22</sup> The questions referred to the Court came from the Norwegian Board of Appeal for Industrial Property Rights. The Board of Appeal was wondering about the application of several grounds for refusal, including public order and morality.<sup>23</sup> Among other works, the underlying trademark application concerned Vigeland's 'Monolith' (*Monolitten*) and 'Angry Boy' (*Sinnataggen*) – popular works which feature prominently in the Vigeland Installation in the centre of Oslo's Frogner Park. Interestingly, the registration initiative had not been taken by a trademark 'troll' seeking to obtain rights to popular artistic works for the sole purpose of threatening users

with infringement claims and pressing for excessive licence fees without any intention to make genuine use of the works itself.<sup>24</sup> On the contrary, the trademark application had been filed by the Municipality of Oslo. In respect of this remarkable step, Oslo submitted arguments to the EFTA Court which were derived from a distinction between Vigeland's artistic work on the one hand, and the city's commercial marketing efforts on the other. In particular, Oslo argued that '[a]ll of the shapes have been exclusively connected to, and used by or through, the Municipality since the death of Gustav Vigeland in 1943. Many of these shapes are well known and valuable, in particular, due to the efforts and investments made by the Municipality.'<sup>25</sup>

Hence it seems that from the perspective of the Municipality of Oslo the city ought to be entitled to the rights to Vigeland's works – even after the expiry of the copyright – because of the efforts made to ensure that the works became well known. Oslo stated that against this background no other entity could have justifiable interests in the commercial exploitation of Vigeland's works.<sup>26</sup> The Municipality also pointed out that it had specifically been chosen by Gustav Vigeland to administer and safeguard his artistic reputation and memory.<sup>27</sup> Nonetheless, considerations of art custodianship, such as the need to preserve the cultural dimension of Vigeland's works by preventing third parties from attaching undesirable commercial connotations, did not play a central role in the submission to the EFTA Court.<sup>28</sup> Instead, Oslo insisted that 'it should be assessed whether the value and fame of the work are related to characteristics and qualities of the artwork alone, or if the value and renown may be attributed to investments and efforts made by the Municipality.'<sup>29</sup>

With this strategy, the city of Oslo had little success in its own country. The Norwegian Industrial Property Office remained unimpressed and refused the trademark application on the grounds that Vigeland's works were non-distinctive, descriptive and functional. The shape of the works added substantial value to at least some of the goods, in respect of which registration was sought.<sup>30</sup> Instead of dispelling these concerns, the Board of Appeal decided to supplement the list of grounds for refusal with a further argument. It expressed the view that a trademark registration of works belonging to the cultural heritage may be contrary to public policy or accepted principles of morality, and wondered which factors should inform the decision on these grounds for refusal.<sup>31</sup>

<sup>24</sup> For a case that has arisen from this practice, see Higher Court of Appeals of Dresden, 4 April 2000, Case 14 U 3611/99, [2001] NJW 615 – *Johann Sebastian Bach*. The case concerned the registration of the name and portrait of Johann Sebastian Bach as a trade mark for various goods and services, including glassware, porcelain and crockery. While the trade mark proprietor had not commenced using the sign himself, he systematically asserted his trade mark rights against users referring to Johann Sebastian Bach; cf the background information given by Horst-Peter Götting, 'Persönlichkeitsmerkmale von verstorbenen Personen der Zeitgeschichte als Marke' [2001] GRUR 615.

<sup>25</sup> Report for the Hearing, Judge-Rapporteur Baudenbacher, 5 October 2016, Case E-5/16 – *Municipality of Oslo* ('*Vigeland*'), para 32.

<sup>26</sup> *ibid* para 36.

<sup>27</sup> *ibid* para 36.

<sup>28</sup> *ibid* paras 31-42.

<sup>29</sup> *ibid* para 37.

<sup>30</sup> *Vigeland* (n 1) para 27.

<sup>31</sup> *ibid* paras 28-30.

<sup>19</sup> See the discussion of this example by European Copyright Society (n 14) 459-460.

<sup>20</sup> German Federal Patent Court, 2 November 1993, Case 27 W (pat) 85/92, [1994] GRUR 377 – *Messias*.

<sup>21</sup> German Federal Patent Court, 17 January 2007, Case 28 W (pat) 66/06, 5 – *Budha*.

<sup>22</sup> *Vigeland* (n 1) para 20; Gustav Vigeland died on 12 March 1943.

<sup>23</sup> *ibid* paras 28-30.

Answering this question submitted, the EFTA Court took several important steps towards a more flexible application of public order and morality as grounds for denying trademark rights to cultural signs. First, the EFTA Court stated that for a cultural creation to be part of the public domain, it had to be unencumbered by intellectual property rights.<sup>32</sup> According to the EFTA Court, the legal status of ‘absence of individual protection for, or exclusive rights to, a work’<sup>33</sup> is the normal status of literary and artistic works and the period of copyright protection is an anomaly during which the work is withheld from a free and entirely open communication process.<sup>34</sup> Precursors of this approach can be found in the domestic law of EU Member States. The German Federal Constitutional Court, for instance, also held that a work, once published, becomes an independent factor influencing the cultural and intellectual perception of its age, which increasingly evaporates in the process of its communication until the time of protection finally expires.<sup>35</sup>

Second, the EFTA Court clarified the policy objectives which formed the basis of its approach. In the Court’s view, the determination of a fixed time frame of copyright protection after which anyone can draw from ideas and creative content of others without limitation served the principles of legal certainty and protection of legitimate expectations.<sup>36</sup> It also served the general interest in ‘protecting creations of the mind from commercial greed’ and ‘ensuring the freedom of the arts.’<sup>37</sup>

Third, the EFTA Court recalled the remarkable development of EU trademark protection in recent years: from a protection system that focused on the protection of consumers against confusion as to origin, to a protection regime that recognized investment in brand development as an independent objective of protection.<sup>38</sup> While explicitly referring to remaining differences in the configuration of copyright and trademark protection,<sup>39</sup> this modern understanding of the trademark system led to a clear articulation of the risk of wrong incentives for investment in cultural heritage grabbing:

‘The possibility of acquiring distinctiveness through use provided for in Art. 3(3) of the Trade Mark Directive may lead undertakings, which seek to transfer the appeal of formerly copyright protected works to their goods or services, to try to appropriate the work through targeted marketing campaigns.’<sup>40</sup>

<sup>32</sup> *ibid* para 66.

<sup>33</sup> *ibid* para 66.

<sup>34</sup> *ibid* para 66.

<sup>35</sup> German Federal Constitutional Court, 31 May 2016, Case 1 BvR 1585/13, [2016] GRUR 690 – *Sampling*, para 87; cf Alexander Peukert, ‘Fictitious Commodities: A Theory of Intellectual Property Inspired by Karl Polanyi’s Great Transformation’ (2019) 29 *Fordham Intellectual Property, Media and Entertainment Law Journal* 1151, 1180-1181; Julie E Cohen, ‘Copyright, Commodification, and Culture: Locating the Public Domain’ in Lucie MCR Guibault and P Bernt Hugenholtz (eds), *The Future of the Public Domain – Identifying the Commons in Information Law* (Kluwer Law International 2006) 121, 154-155; Reinhold Kreile, ‘Die Sozialbindung des geistigen Eigentums’ in Peter Badura and Rupert Scholz, *Festschrift für Peter Lerche zum 65. Geburtstag* (CH Beck 1993) 251, 257-258; Paul Kirchhof, *Der Gesetzgebungsauftrag zum Schutz des geistigen Eigentums gegenüber modernen Vervielfältigungstechniken* (Decker & Müller 1988) 34-35.

<sup>36</sup> *Vigeland* (n 1) para 65.

<sup>37</sup> *ibid* para 65.

<sup>38</sup> *ibid* para 72; cf Kur and Senftleben (n 14) paras 1.12-1.39.

<sup>39</sup> *Vigeland* (n 1) para 62.

Therefore, the understanding of trademark law as an incentive and investment scheme – and trademark rights as brand exploitation instruments<sup>41</sup> – yielded the insight that the mere possibility of acquiring distinctiveness through use in trade could lead to rights acquisition strategies aimed at the exploitation of positive cultural connotations attached to cultural signs such as the Mona Lisa and the Night Watch. In line with its earlier reference to the need to protect cultural creations from ‘commercial greed,’ the Court thus warned against ‘targeted marketing campaigns’ seeking to derive profit from valuable cultural meanings.<sup>42</sup>

On the basis of these considerations, the EFTA Court finally embarked on a closer inspection of public order and morality as grounds for refusing trademark rights to Vigeland’s artworks. In this context, the Court made a first contribution to the further development of public order and morality as grounds for refusal by clearly distinguishing two aspects: a refusal based on grounds of public policy requires an assessment of objective criteria, whereas a refusal based on accepted principles of morality implies the examination of subjective values.<sup>43</sup>

As to the subjective criterion of a conflict with accepted principles of morality, the Court underlined the necessity to examine on a case-by-case basis how the relevant public would perceive the sign at issue. In line with the traditional approach outlined above,<sup>44</sup> the Court posed the question whether Vigeland’s works – in and of themselves – would be considered offensive by reasonable

<sup>40</sup> *ibid* para 75. As to the risk of dysfunctional cumulation, see also European Copyright Society (n 14) 458.

<sup>41</sup> Kur and Senftleben (n 14) paras 1.29-1.39; Jane C Ginsburg, ‘Licensing Commercial Value: from Copyright to Trademarks and Back’ in Irene Calboli and Jacques de Werra (eds), *The Law and Practice of Trademark Transactions – A Global and Local Outlook* (Edward Elgar 2016) 53, 75-77; Martin RF Senftleben, ‘The Trademark Tower of Babel – Dilution Concepts in International, US and EC Trademark Law’ (2009) 40 *IIC* 45, 48-49; Lionel Bently, ‘From Communication to Thing: Historical Aspects of the Conceptualisation of Trade Marks as Property’ in Graeme B Dinwoodie and Mark D Janis (eds), *Trademark Law and Theory: A Handbook of Contemporary Research* (Edward Elgar 2008) 3, 15-41; Jonathan E Schroeder, ‘Brand Culture: Trade marks, Marketing and Consumption’ in Lionel Bently, Jennifer Davis and Jane C Ginsburg (eds), *Trade Marks and Brands – An Interdisciplinary Critique* (Cambridge University Press 2008) 161; Robert G Bone, ‘Hunting Goodwill: A History of the Concept of Goodwill in Trademark Law’ (2006) 86 *Boston University Law Review* 547, 549; Jonathan Moskin, ‘Victoria’s Big Secret: Wither Dilution Under the Federal Dilution Act’ (2004) 93 *The Trademark Reporter* 842-859, 843-844; Graeme B Dinwoodie, ‘Trademark and Copyright: Complements or Competitors?’ in Jane C Ginsburg and June M Besek (eds), *Adjuncts and Alternatives to Copyright – Proceedings of the ALAI Congress June 13-17, 2001* (Columbia University School of Law 2002) 498, 503-504; Sabine Casparie-Kerdel, ‘Dilution Disguised: Has the Concept of Trade Mark Dilution Made its Way into the Laws of Europe?’ [2001] *EIPR* 185, 185-186; Glynn S Lunney, Jr, ‘Trademark Monopolies’ (1999) 48 *Emory Law Journal* 367, 437-439; Mark A Lemley, ‘The Modern Lanham Act and the Death of Common Sense’ (1999) 108 *Yale Law Journal* 1687, 1694-1698; Ralph S Brown, ‘Advertising and the Public Interest: Legal Protection of Trade Symbols’ (1999) 108 *Yale Law Journal* 1619, 1619-1620; Rochelle C Dreyfuss, ‘Expressive Genericity: Trademarks as Language in the Pepsi Generation’ (1990) 65 *Notre Dame Law Review* 397, 397-398; Michael Lehmann, ‘Die wettbewerbswidrige Ausnutzung und Beeinträchtigung des guten Rufes bekannter Marken, Namen und Herkunftsangaben – Die Rechtslage in der Bundesrepublik Deutschland’ [1986] *GRUR Int* 6, 14-17.

<sup>42</sup> *Vigeland* (n 1) paras 65 and 75.

<sup>43</sup> *ibid* paras 84-86. As to the innovative character of the decision, see Geiger and Machado Pontes (n 14) 11-12, who place the judgment in the context of previous EU office practice.

<sup>44</sup> For an overview, see Geiger and Machado Pontes (n 14) 8-11; Kur and Senftleben (n 14) paras 4.205-4.218; European Copyright Society (n 14) 459-460.

consumers with average sensitivity and tolerance thresholds.<sup>45</sup> Quite clearly, this question could be answered in the negative.<sup>46</sup> The EFTA Court, however, went beyond this standard analysis and added an important nuance by holding that ‘certain pieces of art may enjoy a particular status as prominent parts of a nation’s cultural heritage, an emblem of sovereignty or of the nation’s foundations and values. A trade mark registration may even be considered a misappropriation or a desecration of the artist’s work, in particular if it is granted for goods or services that contradict the values of the artist or the message communicated through the artwork in question. Therefore, the possibility cannot be ruled out that trade mark registration of an artwork may be perceived by the average consumer in the EEA State in question as offensive and therefore as contrary to accepted principles of morality.’<sup>47</sup>

This addition is remarkable. With this statement, the EFTA Court departed from the traditional focus on the scandalous nature of the sign itself. A refusal based on accepted principles of morality may also follow from a finding that the relevant public perceives the trademark registration of a work of art as offensive.<sup>48</sup> In this way, the EFTA Court substantially broadened the field of application of the ground for refusal. It extended the above-described broader perspective – including the possibility of the public perceiving the registration for use in commerce as offensive – from religious signs<sup>49</sup> to signs with cultural significance. While in the past the offensive nature of the cultural sign or its attachment to scandalous goods or services was decisive,<sup>50</sup> the offensive nature of the attempt to register a cultural sign as a trademark offers an alternative avenue for a refusal based on a conflict with morality in line with the approach taken by the EFTA Court.<sup>51</sup>

As to the second aspect – the objective criterion of a conflict with public policy – the EFTA Court noted that ‘public policy’ referred to principles and standards regarded to be of a fundamental concern to the state and the whole of society. Therefore, a refusal based on public policy required exceptional circumstances, namely ‘a genuine and sufficiently serious threat to a fundamental interest of society.’<sup>52</sup> Nonetheless, the Court saw room for applying this ground for refusal in the context of artwork registrations:

‘An artwork may be refused registration, for example, under the circumstances that its registration is regarded as a genuine and serious threat to certain fundamental values or where the need to safeguard the public domain, itself, is considered a fundamental interest of society.’<sup>53</sup>

As in the context of accepted principles of morality, the EFTA Court stated that a genuine and serious threat to public policy could follow from the trademark registration of an artwork.<sup>54</sup> The Court thus confirmed the substantial broadening of the scope of the ground for refusal: not only the nature of the sign at issue but also the registration attempt as such can be sufficient to justify a refusal based on public order.

However, the EFTA Court could hardly carry out a more concrete assessment of the situation surrounding the application filed by the Municipality of Oslo. Given the discretion enjoyed by the national authorities in this respect, it was for the Norwegian office and courts to determine whether these requirements were met in the *Vigeland* case. In fact, the Norwegian Board of Appeal for Industrial Property Rights finally rejected the trademark registration of Vigeland’s artworks on the basis of public order considerations. The Board of Appeal saw a conflict with public order arising from the registration of Vigeland’s works as trademarks ‘due to the signs depicting works of art which hold considerable cultural value to Norwegian society, and partly because the temporal limitation of the copyright protection period pursuant to the Copyrights Act is meant to safeguard fundamental societal considerations . . .’<sup>55</sup>

The Board of Appeal thus combined two lines of reasoning which the EFTA Court had declared valid in the context of the public order assessment. First, the Board of Appeal held that, because of their significant cultural value, the registration of Vigeland’s artworks threatened fundamental values of Norwegian society. Second, the Board stated that the temporal limitation of copyright constituted a fundamental interest of Norwegian society.<sup>56</sup> Offering further support for its refusal of trademark protection, the Board also pointed to unfair competitive advantages that could follow from free riding on the positive reputation which the artworks had already acquired during the term of copyright protection:

‘[n]ot only are there no costs in connection with development of a trademark, but the sign is in itself already known as a work of art and connected to something positive. As a result, there is no need to build consumer recognition of the mark or to generate the positive associations required for reoccurring purchases . . .’<sup>57</sup>

Finally, the Board made it clear that the intention of art investment and art custodianship did not constitute a legitimate interest in trademark law that could supersede the considerations and fundamental societal interests underlying the limitation of the term of copyright protection.<sup>58</sup>

This final outcome<sup>59</sup> shows that the EFTA Court has provided important exemplary lines of argument in *Vigeland* for a more systematic exclusion of cultural

<sup>45</sup> *Vigeland* (n 1) paras 89-90 and 93.

<sup>46</sup> *ibid* para 91.

<sup>47</sup> *ibid* para 92.

<sup>48</sup> *ibid* para 92. For the discussion of a similar concept of ‘cultural offensiveness’ that has evolved in New Zealand in respect of signs of indigenous peoples, see Susy R Frankel, ‘Third-Party Trade Marks as a Violation of Indigenous Cultural Property – A New Statutory Safeguard’ [2005] *Journal of World Intellectual Property* 83, 87-91.

<sup>49</sup> *Budha* (n 21) 5.

<sup>50</sup> *Jebaraj Kenneth trading as Screw You v OHIM* (n 15) para 30; *Dick Lexic Ltd. v OHIM* (n 15).

<sup>51</sup> *Vigeland* (n 1) para 93; cf *Basire* (n 12) 435.

<sup>52</sup> *Vigeland* (n 1) paras 94-96.

<sup>53</sup> *ibid* para 96.

<sup>54</sup> *ibid* para 96.

<sup>55</sup> Norwegian Board of Appeal for Industrial Property Rights, 13 November 2017, Cases 16/00148, 16/00149, 16/00150, 16/00151, 16/00153 and 16/00154 – *Vigeland*, para 14.

<sup>56</sup> *Vigeland* (n 1) para 96.

<sup>57</sup> *Vigeland* (n 55) para 23.

<sup>58</sup> *ibid* para 24; cf *Basire* (n 12) 435.

<sup>59</sup> The Municipality of Oslo did not appeal the decision of the Norwegian Board of Appeal for Industrial Property Rights. The decision of the Board thus remained the final word in the matter.

heritage material from trademark protection on the basis of public policy or morality. As already pointed out, this solution is more robust and complete than a refusal based on a lack of distinctiveness. The acquisition of distinctive character through use in trade does not affect a refusal based on public order or morality. As the Norwegian Board of Appeal finally qualified the *registration* of Vigeland's artworks – not the artworks themselves and not the context arising from use in respect of specific goods or services – as contrary to public order, the refusal of trademark rights also applies across the whole spectrum of goods and services. As the focus is on the mere fact of registration for use in commerce, any trademark registration is impermissible regardless of the goods or services involved.

Before embarking on a closer inspection of the refusal arguments which the *Vigeland* decision offers, it is important to note that the EFTA Court's approach has also drawn criticism. While recognizing the risk of an increasing commercialization of artworks and the potential deterrent effect of allegations of trademark infringement after the grant of protection,<sup>60</sup> Annette Kur considers a denial of trademark rights based on public order or morality unnecessary. In her opinion, the registration as such does not endanger public policies, but the way in which the trademark proprietor exercises his rights.<sup>61</sup> Against this background, she recommends a targeted approach relying on bad faith in cases where the trademark applicant seeks to artificially prolong protection after the expiry of copyright.<sup>62</sup> As to the infringement analysis, she relies on the unwritten requirement of 'use as a mark' to prevent excessive claims.<sup>63</sup>

Both elements of Kur's alternative solution, however, seem inefficient. The bad faith analysis, as conducted by the Court of Justice of the European Union (CJEU), focuses on the trademark owner's intention of making genuine use of an affected artwork in the sense of trademark law: use 'falling within the functions of a trade mark, in particular the essential function of indicating origin . . .'.<sup>64</sup> At the registration stage, however, the trademark applicant is not obliged to give evidence of use. Instead, he can acquire trademark rights in the EU by simply registering an artwork as a trademark – with the requirement of genuine use becoming an issue only five years after completion of the registration procedure.<sup>65</sup> In *Sky*, the CJEU confirmed that trademark applicants were not required 'to indicate or even to know precisely' which use they would make of the mark in the five-year period following registration.<sup>66</sup> Given this configuration of the test, bad faith has proven incapable of preventing trademark registrations even if the trademark applicant could easily be identified as a 'cultural heritage grabber.' In *Johann Sebastian Bach*, for instance, the Higher Court of Appeals of Dresden found no starting point for a refusal based on

bad faith even though it saw clear indications that signs concerning Johann Sebastian Bach (and various other cultural signs) had been registered for the sole purpose of preventing others from using them and forcing them to enter into licensing agreements – without any true intention of using the signs in trade.<sup>67</sup> As the registration had occurred in 1999 and the case was decided in 2000, an obligation to put the trademarks to genuine use had not arisen yet.

Hence, an approach based on bad faith does not offer a convincing solution. Instead, it gives trademark trolls seeking to exploit cultural heritage material ample room to threaten users with infringement claims.<sup>68</sup> Kur's second argument – a strict gatekeeper requirement of 'use as a mark' – could reduce the trademark proprietor's chances of success in infringement proceedings. The strict gatekeeper criterion which she has in mind against the background of German jurisprudence,<sup>69</sup> however, has not been adopted by the CJEU. Instead of developing a robust requirement of use as a mark, the CJEU follows a flexible approach that opens wide the doors to trademark protection in order to maximize the harmonizing effect of EU trademark law.<sup>70</sup> Considering this development, the proposal to abandon an *ex ante* approach based on public order and morality in favour of *ex post* corrections of the infringement analysis is not convincing. It is unclear whether the 'use as a mark' doctrine which Kur recommends will ever evolve in CJEU jurisprudence.<sup>71</sup>

The invocation of public order and morality in *Vigeland* has also been criticized by Rochelle Dreyfuss. Drawing an analogy between public order/morality exclusions of trademark rights and the outright exclusion of patent protection in cases involving genes and metabolic pathways, diagnostics and fundamental business practices, she arrives at the conclusion that the categorical exclusion of trademark protection for artworks is problematic.<sup>72</sup> More specifically, she fears that the denial of trademark protection based on public order and morality may – depending on the cultural and societal background – differ from country to country, deprive competitors of the legal certainty following from a registration decision in favour of one trader, decrease incentives to develop new language and rhetorical devices, limit branding opportunities that may cross-subsidize literary and artistic productions, and deflect attention away from the need to strengthen defences to infringement in trademark law.<sup>73</sup>

These concerns, however, are unfounded. In the case of universal cultural heritage, such as the Mona Lisa and the Night Watch, trademark offices will have little difficulty in arriving at more or less uniform, corresponding decisions across countries. If the risk of artificially extending

<sup>60</sup> Annette Kur, 'Gemeinfreiheit und Markenschutz – Bemerkungen zur Entscheidung des EFTA-Gerichtshofs im Vigeland-Fall' [2017] GRUR 1082, 1084-1086.

<sup>61</sup> *ibid.* 1086.

<sup>62</sup> *ibid.*

<sup>63</sup> *ibid.*

<sup>64</sup> CJEU, 29 January 2020, Case C-371/18 *Sky and Others* ECLI:EU:C:2020:45, para 75; CJEU, 11 June 2009, Case C-529/07 *Lindt v Hauswirth* ECLI:EU:C:2009:361, para 44.

<sup>65</sup> art 18(1) EUTMR and art 16(1) TMD.

<sup>66</sup> *Sky and Others* (n 64) para 76.

<sup>67</sup> *Johann Sebastian Bach* (n 24) 615, 617.

<sup>68</sup> Senftleben (n 11) 407-411.

<sup>69</sup> Kur (n 60) 1086.

<sup>70</sup> Senftleben (n 11) 146-152 and 426-427.

<sup>71</sup> See Kur (n 60) 1086, footnote 46, pointing out that EU-wide agreement on a strict gatekeeper requirement of use as a mark is missing. For a detailed proposal to develop such a robust doctrine, see Senftleben (n 11) 426-477.

<sup>72</sup> Rochelle C Dreyfuss, 'Cultural Heritage and the Public Domain: What the US's Myriad and Mayo can Teach Oslo's Angry Boy' in Niklas Bruun and others (eds), *Transition and Coherence in Intellectual Property Law: Essays in Honour of Annette Kur* (Cambridge University Press 2020) 322, 325-331.

<sup>73</sup> Dreyfuss (n 72) 328-329.

protection after copyright expiry and removing artworks from the public domain is recognized as a basis for invoking public order or morality, the application of these grounds for refusal can moreover be grounded in objective facts – the public domain status/the expiry of copyright – that do not depend on a specific cultural or societal background. The legal certainty and incentive arguments which Dreyfuss advances overlook negative effects of the grant of trademark rights. Dreyfuss' analysis conceals the fact that legal certainty and the encouragement of investment following from the grant of trademark rights are highly problematic. By awarding one trader an exclusive trademark right in an artwork, the trademark office encourages this trader to impregnate the artwork with commercial connotations. In the light of sociological insights into literary and artistic creation processes, these commercial connotations are likely to devalue the sign as a basis for cultural follow-on innovation.<sup>74</sup> By awarding an exclusive right, the trademark office, furthermore, gives the trader a stronger position in the communication process surrounding the affected artwork. It offers a control instrument that allows the trader to suppress use by others, in particular use by artists who are risk-averse and likely to refrain from use once they are confronted with a cease-and-desist letter.<sup>75</sup>

Therefore, legal certainty for cultural heritage branding is not desirable. Instead of contributing to new language and rhetorical devices, as Dreyfuss expects, it seriously impedes the remix and reuse of affected artworks in the literary and artistic discourse.<sup>76</sup> Potential opportunities for subsidizing literary and artistic productions can hardly outweigh the broader and more fundamental risk of losing artworks as meaningful reference points for new literary and artistic productions. It also remains unclear why reliance on public order and morality would reduce the need for more robust defences in trademark law. This need arises in particular from the increasing cultural significance of genuine trademarks, such as 'Coca Cola'.<sup>77</sup> It does not depend on the acceptance of artworks as trademarks.

Finally, it is noteworthy that Dreyfuss chooses a doubtful reference point for her entire critique. If trademark law had all the positive effects Dreyfuss describes, it would be high time to offer trademark protection for the genes and metabolic pathways, diagnostics and fundamental business practices that remain underprotected according to her analysis. Interestingly, however, her analysis does not raise the question whether the trademark law doctrine of utilitarian functionality (categorically excluding technical subject matter from trademark protection)<sup>78</sup> should be abandoned to pave the way for the extension of trademark protection to technical know-

how in the public domain, or the perpetuation of protection after the expiry of patent rights.

In sum, the critique of the *Vigeland* decision only confirms that public order and morality are indispensable tools in the regulation of cultural heritage branding. If public order and morality are not properly developed and cultivated as grounds for refusal, alternative instruments – ranging from distinctiveness and bad faith to 'use as a mark' – are unlikely to yield satisfactory results. Purported advantages of artwork branding, such as clarity about use entitlements and opportunities to invest in the development of commercial connotations, can be unmasked as heavy burdens on artistic creativity that are likely to devalue affected artworks and thwart new literary and artistic creations. Against this background, it is important to explore the full potential of the arguments which the EFTA Court developed to enable a broader application of public order and morality as grounds for refusing trademark rights in cultural heritage material.

#### IV. Morality as a ground for refusal after *Vigeland*

With regard to morality as a ground for refusal, the EFTA Court provided two core arguments for an outright exclusion:

- the relevant public may perceive the registration as a trademark as offensive because certain pieces of art enjoy a 'particular status as prominent parts of a nation's cultural heritage, an emblem of sovereignty or of the nation's foundations and values'<sup>79</sup> (morality ground 1);
- the relevant public may perceive the registration as a trademark as offensive because it would lead to a 'misappropriation or a desecration of the artist's work, in particular if it is granted for goods or services that contradict values of the artist or the message communicated through the artwork in question'<sup>80</sup> (morality ground 2).

##### 1. Misappropriation and desecration arguments

At first sight, the latter argument focusing on misappropriation or desecration (morality ground 2) may appear narrow. Quite clearly, the scenario mentioned above – an attempt to register a distinctive element of Pablo Picasso's *Guernica* for the marketing of weapons – would fall within this category. However, this example also illustrates potential limits of the approach. While consumers may regard the registration in respect of weapons as a desecration of the artwork in the light of the painting's message, the outcome may be different when the trademark application concerns goods and services that do not contradict the values conveyed by the painting. If interpreted strictly, the desecration argument will thus fail in many cases.

However, the EFTA Court used the words 'in particular'<sup>81</sup> to introduce the scenario in which goods or services contradict values communicated through the artwork. This specific example does not prevent the invocation of

<sup>74</sup> Senftleben (n 11) 293-299.

<sup>75</sup> *ibid* 200-205 and 291-293.

<sup>76</sup> *ibid* 63-67.

<sup>77</sup> *ibid* 456-459; Dreyfuss (n 41) 397-398, 413 and 418.

<sup>78</sup> art 7(1)(e) EUTMR and art 4(1)(e) TMD; cf CJEU, 23 April 2020, Case C237/19 *Gömböc* ECLI:EU:C:2020:296, para 34; CJEU, 18 June 2002, Case C-299/99 *Philips v Remington* ECLI:EU:C:2002:377, para 82; CJEU, 14 September 2010, Case C-48/09 P *Lego v Mega Brands* ECLI:EU:C:2010:516, paras 45 and 53-58. As to the situation in the US, see U.S. Supreme Court, 20 March 2001, *TrafFix Devices v Marketing Displays* 532 U.S. 23, 29-34 (2001); Mark P McKenna, '(Dys)Functionality' (2011) 48 *Houston Law Review* 823, 827-830.

<sup>79</sup> *Vigeland* (n 1) para 92.

<sup>80</sup> *ibid* para 92.

<sup>81</sup> *ibid* para 92.



the desecration argument in other cases. It does not prevent the use of morality as a ground for refusal when the registration of a cultural sign as a trademark is likely to trigger a redefinition process in the commercial domain that is undesirable.<sup>82</sup> Arguably, the attachment of marketing messages blurs a sign's cultural meaning and reduces its potential to serve as a reference point for the discourse in the artistic domain. The original message of the artwork may even be suppressed and lost in the end.<sup>83</sup> In other words, it may be argued that, regardless of the goods and services involved, the grant of trademark rights to cultural heritage material *always* leads to a desecration of the artist's work, namely the desecration following from the attachment of commercial marketing messages that interfere with the sign's cultural meaning.<sup>84</sup> A trademark registration entails the obligation to make genuine use of the registered sign as a trademark. This, in turn, requires the attachment of commercial marketing messages to the affected sign. The desecration of an artwork is thus inherent in the grant of trademark protection. Viewed from this perspective, the argument applies across all goods and services and has the potential to categorically exclude cultural heritage signs from trademark protection. Consumers may perceive the attachment of marketing messages to cultural heritage material as offensive because it suppresses the sign's cultural meaning and desecrates the artwork in this way.

The second aspect of morality ground 2 – the EFTA Court referred not only to 'desecration' but also to 'misappropriation' of the artist's work<sup>85</sup> – can have a broad exclusionary effect as well. In *Shield Mark v Kist* – the CJEU case that concerned an attempt to register, among other signs, the first nine notes of Ludwig van Beethoven's piano piece 'Für Elise' as a trademark – Advocate General Dámaso Ruiz-Jarabo Colomer addressed the misappropriation risk. He expressed the view that it was difficult to accept 'that a creation of the mind, which forms part of the universal cultural heritage, should be appropriated indefinitely by a person to be used on the market in order to distinguish the goods he produces or the services he provides with an exclusivity which not even its author's estate enjoys.'<sup>86</sup>

In the light of this statement, it is conceivable that consumers with a similar feeling of unease regard the registration of a cultural sign as an offensive misappropriation of the artist's work by third parties who – unlike the author's heirs – do not have a family connection. In this line of reasoning, the ground for refusal, again, applies across the whole spectrum of goods and services and leads to an outright exclusion of trademark protection. At the same time, Colomer's statement may set limits to

the misappropriation approach. What if an author's estate itself files the trademark application? Would the close connection with the author legitimize the registration attempt in the eyes of the relevant public? If so, the misappropriation argument would be rendered inapplicable. This, however, need not lead to a trademark registration. The desecration argument offers an alternative basis for an outright exclusion. As other trademark proprietors, the author's estate is bound to make genuine use of the cultural sign once it is registered as a trademark. The registration exposes the affected sign to the risk of desecration as a result of use for commercial marketing purposes. The refusal of trademark rights thus follows from the need to avoid the desecration of the artist's work. The fact that, in this case, the author's estate registers the sign and controls the use in commerce does not eliminate the desecration risk.

On balance, the amalgam of desecration and misappropriation considerations which the EFTA Court applied to establish morality ground 2 can thus have a far-reaching exclusionary effect. It can be a powerful legal instrument to keep cultural signs outside the trademark system. The exclusionary effect will be particularly strong when the commercial redefinition of the sign's meaning in the context of use in trade is qualified as a desecration of the artist's work.

## 2. Particular national status arguments

Morality ground 1 refers to a scenario where the relevant public finds the trademark registration offensive because the affected sign constitutes a prominent part of a nation's cultural heritage, an emblem of sovereignty or an emblem of a nation's foundations and values.<sup>87</sup> From the outset, this ground for refusal is confined to signs with a particular status. It is incapable of covering all kinds of signs with cultural significance. Nonetheless, practical experiences with cases involving signs that are important national cultural heritage, emblems of sovereignty or emblems of a nation's foundations and values show that there is room for a broader application of this line of argument. In the above-described *Nachtwacht* case, for instance, the Court of Appeals of The Hague explicitly pointed out that the Night Watch was 'carved in the collective memory of the inhabitants of the Benelux.'<sup>88</sup> Nonetheless, the Court refrained from a refusal based on a conflict with morality and relied on a lack of distinctiveness instead.<sup>89</sup> In fact, this is a missed opportunity. As the painting plays such a prominent role in the collective memory of the Benelux population, it would only have been a small step to assume that Benelux consumers would perceive the registration of the Night Watch – one of the most prominent parts of their cultural heritage – as offensive.

Hence it becomes apparent that trademark judges and examiners are not exhausting the full potential of morality considerations relating to a sign's particular status in the pantheon of a nation's cultural heritage, emblems of sovereignty or symbols of state foundations and societal values. This reluctance is problematic. While the

<sup>82</sup> cf Senftleben (n 11) 293-299.

<sup>83</sup> Katya Assaf, 'Der Markenschutz und seine kulturelle Bedeutung: Ein Vergleich des deutschen mit dem US-amerikanischen Recht' [2009] GRUR Int 1, 2-3; Martin RF Senftleben, 'Der kulturelle Imperativ des Urheberrechts' in Matthias Weller, Nicolai B Kemle and Thomas Dreier (eds), *Kunst im Markt – Kunst im Recht* (Nomos 2010) 75; Artur Wandtke and Winfried Bullinger, 'Die Marke als urheberrechtlich schutzfähiges Werk' [1997] GRUR 573, 578.

<sup>84</sup> cf Frankel (n 48) 88 and 94, who describes the formal recognition of cultural offensiveness – in the sense of the use of cultural symbols in inappropriate commercial contexts – with regard to symbols of Māori culture in the trademark legislation of New Zealand.

<sup>85</sup> *Vigeland* (n 1) para 92.

<sup>86</sup> Case C-283/01 *Shield Mark v Kist* ECLI:EU:C:2003:197, Opinion of AG Colomer, para 52.

<sup>87</sup> *Vigeland* (n 1) para 92.

<sup>88</sup> *Chiever v Benelux-Organisatie voor de Intellectuele Eigendom* (n 7) para 12.

<sup>89</sup> *ibid* paras 8-9.

aforementioned misappropriation and desecration arguments focus on a sign's meaning in the cultural domain (morality ground 2), the consideration of a sign's status as national cultural heritage, an emblem of sovereignty or a symbol of state foundations and values (morality ground 1) allows the social and political dimension of cultural signs to enter the picture. Taken together, the two categories of morality considerations identified by the EFTA Court offer a broad spectrum of reference points for the inquiry into a conflict with morality.

### 3. Impact of consumer perception

As the EFTA Court pointed out, however, a conflict with morality is a subjective criterion – subjective in the sense that the perception of reasonable consumers with average sensitivity and tolerance thresholds is decisive.<sup>90</sup> Accordingly, an examiner or judge following in the footsteps of the EFTA Court cannot posit readily that the registration of a given work of art would lead to the misappropriation or desecration of the artist's work. The central question is whether the relevant public would find the registration attempt unacceptable for this reason. In the case of artworks, the necessity to assess the situation through the lens of consumer perception raises further questions about the level of knowledge and sensitivity of the relevant public. Can consumers be expected to recognize the risk of a redefinition and devaluation of cultural signs as a result of use as trademarks? Do consumers have sufficient knowledge of the values and messages underlying affected artworks? Even if these works are not widely known?

In other words, it is important to clarify the reference point for the assessment. Quite clearly, an assessment based on the perception of consumers with sufficient awareness of matters of art and culture may enhance the potential of morality considerations to achieve a categorical exclusion of cultural signs from trademark protection, whereas an assessment based on the perception of consumers who do not care too much about matters of art may reduce this potential and limit the exclusionary effect of the ground for refusal. In practice, the consumer standard that is currently applied in the EU to assess conflicts with accepted principles of morality is the 'reasonable person with average thresholds of sensitivity and tolerance.'<sup>91</sup> According to the CJEU, the assessment from the perspective of this consumer must shed light on the 'fundamental moral values and standards' to which society adheres at the time of assessment: the prevailing 'social consensus.'<sup>92</sup> In *Constantin Film*, the CJEU emphasized that this determination should not be confined to an abstract assessment of the allegedly scandalous sign. The case concerned an attempt to register the title of the German film 'Fack Ju Göhte' (a phonetic transcription of 'Fuck you, Goethe' in German).<sup>93</sup> Considering the enormous success of the comedy among the German-speaking public and its worldwide educational use by the Goethe

Institute,<sup>94</sup> the Court insisted on an assessment that included the 'concrete and current social context' to ascertain whether the relevant public found the sign acceptable despite its vulgar nature.<sup>95</sup> As there were no indications that the film title had caused a controversy in Germany or Austria, the CJEU saw no reason to assume a conflict with morality.<sup>96</sup>

Quite clearly, the consideration of the 'concrete and current social context' surrounding a sign allows empirical findings to enter the picture, such as the popularity of a film with a vulgar title and its use by a renowned cultural institution. The consumer standard on which the assessment is to be based, however, is far from empirical reality. The qualification of relevant consumers as 'reasonable' with 'average thresholds of sensitivity and tolerance'<sup>97</sup> indicates that this consumer is a normative fiction. As Graeme Dinwoodie and Dev Gangjee rightly observed with regard to normative connotations of the average consumer in the infringement analysis, '[t]he more that the reasonably well-informed and reasonably observant and circumspect consumer is a normative fiction, the greater the scope for the CJEU to create legal rules that establish EU-wide standards. The more empirical that question becomes, then the greater the role of national courts and the more likely that divergent market realities in Europe will result in different outcomes with adverse effects on the creation of an integrated market.'<sup>98</sup>

Applying this insight to the prototype of a reasonable consumer with average sensitivity and tolerance thresholds in morality cases, it can thus be said that the assessment of consumer perception need not depend exclusively on empirical findings. Normative assumptions, such as the undesirability of trademark rights that may hamper the use of cultural heritage material as a basis for new literary and artistic creations,<sup>99</sup> can influence the determination of the degree of sensitivity and tolerance that is ascribed to the relevant consumer. The inclusion of normative considerations in the assessment is not unusual.<sup>100</sup> In *La Mafia Franchises*, the GCEU had to decide on the offensive nature of a figurative trademark showing a red rose and the slogan '*La Mafia se sienta a la mesa*' for restaurant services offered in themed restaurants, clothing and footwear, and business management and organization consultancy services.<sup>101</sup> As the words '*La Mafia*' constituted the dominant element of the mark,<sup>102</sup> the analysis focused on the question how the relevant public – reasonable consumers with average sensitivity and tolerance thresholds – would perceive that sign. The GCEU emphasized that the word element '*La Mafia*' was understood worldwide as a reference to a criminal organization

<sup>94</sup> *ibid* para 52.

<sup>95</sup> *ibid* para 43.

<sup>96</sup> *ibid* paras 52–53.

<sup>97</sup> *ibid* para 42.

<sup>98</sup> Graeme B Dinwoodie and Dev S Gangjee, 'The Image of the Consumer in European Trade Mark Law' in Dorota Leczykiewicz and Stephen Weatherill (eds), *The Images of the Consumer in EU Law: Legislation, Free Movement and Competition Law* (Hart Publishing 2016) 339, 367.

<sup>99</sup> cf Sentleben (n 11) 200–205.

<sup>100</sup> For instance, see the assessment in *Couture Tech Ltd v OHIM* (n 16) paras 57–62, where the Court derived a conflict with accepted principles of morality from legislation prohibiting the use of the type of signs for which registration was sought.

<sup>101</sup> *La Mafia Franchises v EUIPO* (n 90) paras 1–3.

<sup>102</sup> *ibid* para 32.

<sup>90</sup> *Vigeland* (n 1) paras 89–90 and 93; cf CJEU, 27 February 2020, Case C240/18 P *Constantin Film v EUIPO* ('*Fack Ju Göhte*') ECLI:EU:C:2020:118, para 42; GCEU, 15 March 2018, Case T-1/17 *La Mafia Franchises v EUIPO* ECLI:EU:T:2018:146, para 26.

<sup>91</sup> *Vigeland* (n 1) para 90; *Constantin Film v EUIPO* (n 90) para 42; *La Mafia Franchises v EUIPO* (n 90) para 26.

<sup>92</sup> *Constantin Film v EUIPO* (n 90) para 39.

<sup>93</sup> *ibid* para 46.

involved in illegal activities, such as drug and arms trafficking, money laundering and corruption, and not shying away from intimidation, physical violence and murder.<sup>103</sup> The Court went on to explain that such criminal activities breached the very values on which the EU was founded, in particular the values of respect for human dignity and freedom (Art. 2 of the Treaty on European Union) and the right to life, integrity of the person, liberty and security (Arts. 2, 3 and 6 of the Charter of Fundamental Rights). Those values were indivisible and made up the spiritual and moral heritage of the EU.<sup>104</sup> In sharp contrast to the illicit practices of the criminal organization, the connection with the sentence ‘*se sienta a la mesa*’ (‘takes a seat at the table’ in Spanish), trivialized the violence of Mafia activities by referring to the idea of sharing a meal and thus conviviality and relaxation.<sup>105</sup> Based on these findings and normative considerations, the Court arrived at the conclusion that ‘the contested mark, considered as a whole, refers to a criminal organisation, conveys a globally positive image of that organisation and, therefore, trivialises the serious harm done by that organisation to the fundamental values of the European Union [...]. The contested mark is therefore likely to shock or offend not only the victims of that criminal organisation and their families, but also any person who, on EU territory, encounters that mark and has average sensitivity and tolerance thresholds.’<sup>106</sup>

On its merits, the Court thus inferred from normative values reflected in primary EU legislation that the relevant public could not help but find the mark scandalous. In the light of the values at stake, it was inconceivable for the Court that any EU citizen could accept the trademark registration. The way in which the Court dealt with counterarguments pointing to acceptance of references to the Mafia in the creative sector, confirms this impression. The GCEU remained unimpressed by the defence argument that the Mafia was often the subject of fictional accounts in literature and in cinema, and that the registration was not intended to shock or offend, but to allude to the ‘Godfather’ film series on which the concept of the themed restaurants using the figurative mark was based.<sup>107</sup> The Court dismissed these arguments by stating that the existence of Mafia books and films in no way altered the perception of the harm done by that organization.<sup>108</sup> It thus disregarded starting points for an inquiry into the empirical reality of consumer perception and, instead, relied on normative considerations focusing on the seriousness of the crimes committed by the criminal organization. Arguably, an empirical analysis could have led to a different outcome. Use of Mafia insignia in films and books impacts consumer perception and raises the question whether a reasonable consumer with average sensitivity and tolerance thresholds would place the contested Mafia trademark in the context of the Mafia genre in the creative sector (and find the trademark acceptable), or see a connection with the organization’s crimes (and find the trademark unacceptable).

<sup>103</sup> *ibid* para 35.

<sup>104</sup> *ibid* para 36.

<sup>105</sup> *ibid* para 45.

<sup>106</sup> *ibid* para 47.

<sup>107</sup> *ibid* paras 39–42.

<sup>108</sup> *ibid* para 43.

With regard to the question whether the registration of cultural signs as trademarks gives rise to a conflict with morality, the decision in *La Mafia Franchises* offers important insights. It shows that normative considerations can play a crucial role. The assessment need not follow the dictates of empirical findings reflecting consumer perception. By contrast, the normative construct of a reasonable consumer with average sensitivity and tolerance thresholds allows judges and examiners to make assumptions about the perception of a contested sign in the light of societal values. Hence, the analysis need not remain limited to the question how flesh and blood consumers actually perceive the sign. Instead, what is decisive is the perception to be expected from the prototype of a reasonable consumer with average sensitivity and tolerance thresholds who knows and cares about overarching societal values. This normative colouring paves the way for a value-based evaluation of cultural signs with the status of important cultural heritage, an emblem of state sovereignty or a symbol of societal foundations and values (morality ground 1). It also offers the opportunity of a value-based assessment when the risk of artwork misappropriation or desecration (morality ground 2) is central to the analysis and the inquiry into consumer perception must address concerns about an undesirable redefinition and devaluation of cultural signs in the commercial domain of trade. The focus on the ‘concrete and current social context’ in *Constantin Film*<sup>109</sup> does not preclude the inclusion of normative considerations. As the CJEU also pointed out in *Constantin Film*, the yardstick for assessing the concrete and current social context remains the ‘reasonable person with average thresholds of sensitivity and tolerance.’<sup>110</sup> This reasonable person, however, is the ‘normative fiction’<sup>111</sup> that offers room for the inclusion of normative considerations, such as sufficient sensitivity regarding the risk of blurring and suppressing the cultural meaning of affected signs through use in product marketing and devaluing them for the discourse in the artistic domain.<sup>112</sup>

## V. Public order as a ground for refusal after *Vigeland*

In *Vigeland*, the EFTA Court characterized public order considerations as objective criteria in the sense of not requiring an assessment through the prism of consumer perception.<sup>113</sup> The assessment can thus focus directly on the objective to safeguard the public domain – regardless of whether consumers would find the registration of a cultural sign objectionable. As to relevant public order criteria, the Court provided the following central arguments for an outright exclusion of cultural signs from trademark protection:

- the registration as a trademark would pose a genuine and sufficiently serious threat to ‘certain fundamental values,’<sup>114</sup> ‘a fundamental interest of society’<sup>115</sup> or ‘a

<sup>109</sup> *Constantin Film v EUIPO* (n 90) para 43.

<sup>110</sup> *ibid* para 42.

<sup>111</sup> Dinwoodie and Gangjee (n 98) 367.

<sup>112</sup> cf Senftleben (n 11) 293–299.

<sup>113</sup> *Vigeland* (n 1) paras 84–86.

<sup>114</sup> *ibid* para 96.

<sup>115</sup> *ibid* para 95.

fundamental concern to the State and the whole of society'<sup>116</sup> (public order ground 1);

- the registration as a trademark would run counter to the need to safeguard the public domain which amounts to a genuine and serious threat if this need 'itself, is considered a fundamental interest of society'<sup>117</sup> (public order ground 2).

As with the morality argument, these lines of reasoning have the potential to effectively achieve a categorical exclusion of cultural signs from trademark protection across the whole spectrum of goods and services.

### 1. Need to safeguard the public domain

Public order ground 2 – referring to the preservation of the public domain as a fundamental interest of society – directly addresses the cultural concerns at stake. It can be seen as a special case of the broader reference to fundamental interests, values and concerns of society in public order ground 1. On its merits, public order ground 2 deals with a specific scenario where a legal system recognizes the preservation and cultivation of the public domain as a fundamental societal interest in its own right – with the consequence that attempts to reappropriate cultural public domain material on the basis of trademark law, and attempts to prevent literary and artistic works from entering the public domain at the end of copyright protection, automatically give rise to a conflict with this element of *ordre public*.

As to theoretical groundwork capable of elevating the preservation and cultivation of the public domain to an independent element of public order, Séverine Dusollier explicitly recognized that, in order to immunize the public domain of cultural expressions from renewed commodification on the basis of trademark rights, 'the registration of a trademark should be denied when it would lead to the reconstitution of a monopoly akin to that provided formerly by copyright and preventing use of the work in creative expression. The public interest or general interest could be taken into account as a ground for such a refusal.'<sup>118</sup>

To strengthen the arsenal of legal tools contributing to the preservation of the public domain, Dusollier proposes the qualification of the public domain as a *res communis*: a legal status that implies the prohibition of 'a recapture of the work as a whole' and guarantees 'collective use of the work' in the sense of an entitlement of each member of the public to use, modify, exploit, reproduce and create new works from public domain material.<sup>119</sup> In the light of the *Vigeland* decision, a refusal of trademark protection because of a conflict with *ordre public* appears as a first step in the right direction from this perspective. Commenting on the above-described *Mona Lisa* decision of the German Federal Patent Court,<sup>120</sup> Wilhelm Nordemann argued for a broad concept of public order, including the entirety of all legally binding laws that are currently in force. As copyright legislation belongs to this

circle of binding laws, Nordemann argued that a trademark proprietor's exclusive right to a work in the public domain had to end where the assertion of the trademark right would run counter to the free use of the public domain material concerned – irrespective of whether the use took place in the private sphere or in commerce.<sup>121</sup> Based on this recognition of copyright's public domain principle as an element of *ordre public*, Nordemann saw room for limiting the exclusive right of trademark owners in cases where the exercise of this right would impede use in the cultural domain.<sup>122</sup>

Nordemann's broad concept of public order is in line with the concept of 'constitutional order' in the German Constitution (*Grundgesetz*). Article 2(1) of the German Constitution guarantees a person's general freedom of action.<sup>123</sup> With regard to this fundamental freedom, the German Federal Constitutional Court held that the concept of 'constitutional order' was not confined to the norms of the *Grundgesetz* or fundamental constitutional principles. It encompassed every legal norm which formally and substantially complied with the *Grundgesetz*.<sup>124</sup> A person's freedom to act, in other words, falls within the constitutional guarantee of freedom as long as it keeps within the legal framework set by the entirety of legal norms satisfying the requirements of the Constitution. Applying this line of reasoning to the problem of copyright/trademark overlaps, it may be said that the registration of public domain material as a trademark, and the invocation of trademark rights to a cultural sign after the expiry of copyright protection, are illegitimate actions and in conflict with public order because they thwart the public domain principle (limited term of protection) in copyright law – a copyright rule that is formally and substantially in conformity with constitutional norms. This line of argument goes beyond Nordemann's proposal of a mere limitation of trademark rights. It employs public order – understood broadly as a reference to all legally binding laws that comply with a country's constitution – to arrive at an outright exclusion of cultural signs from trademark protection.

With regard to the evident counterargument that not only copyright but also trademark law has the status of legally binding and constitutional legislation, Friedrich Klinkert and Florian Schwab argued convincingly in the German debate about the *Mona Lisa* decision that, as an

<sup>121</sup> Wilhelm Nordemann, 'Mona Lisa als Marke' [1997] WRP 389, 391; cf also Friedrich Klinkert and Florian Schwab, 'Markenrechtlicher Raubbau an gemeinfreien Werken – ein richtungsweisendes „Machtwort“ durch den Mona Lisa-Beschluss des Bundespatentgerichts?' [1999] GRUR 1067, 1073; Ralph Osenberg, 'Markenschutz für urheberrechtlich gemeinfreie Werkteile' [1996] GRUR 101, 102-104) For an overview of the debate in Germany, see Artur Geier, *Schutzkumulationen* (Mohr Siebeck 2015) 158-162.

<sup>122</sup> According to Nordemann (n 121) 391, this limitation would only have effect when the trademark owner seeks to prohibit use in relation to cultural productions, such as use on a book cover. For an approach seeking to establish the public domain principle in international intellectual property law, see Kaya Köklü and Sylvie Nérissou, 'How Public Is the Public Domain? The Perpetual Protection of Inventions, Designs and Works by Trademarks' in Hanns Ullrich and others (eds), *TRIPS plus 20 – From Trade Rules to Market Principles* (Springer 2016) 561, 573-577.

<sup>123</sup> art 2(1) Grundgesetz, available in English at <[https://www.gesetze-im-internet.de/englisch\\_gg/](https://www.gesetze-im-internet.de/englisch_gg/)> accessed 19 July 2021, reads as follows: 'Every person shall have the right to free development of his personality insofar as he does not violate the rights of others or offend against the constitutional order or the moral law.'

<sup>124</sup> German Federal Constitutional Court, 16 January 1957, Case 1 BvR 253/56, BVerfGE 6, 32 (37-38), [1957] NJW 297 – *Elfes*.

<sup>116</sup> *ibid* para 94.

<sup>117</sup> *ibid* para 96.

<sup>118</sup> Séverine Dusollier, 'A Positive Status for the Public Domain' in Dana Beldiman (ed), *Innovation, Competition and Collaboration* (Edward Elgar 2015) 135, 163.

<sup>119</sup> *ibid* 167.

<sup>120</sup> *Mona Lisa* (n 6) 1021-1023.

absolute ground for refusal in trademark law, a conflict with public order provided room within the trademark system to take account of the public domain principle stemming from copyright law. Given this openness of the trademark system, the recognition of copyright's public domain principle did not presuppose a higher rank of copyright legislation. Deference to copyright's public domain principle in trademark law simply ensured the most harmonious interplay of two sets of laws with the same rank in the norm hierarchy.<sup>125</sup> As use of a broad concept of public order leads to the most consistent calibration of the relationship between copyright and trademark legislation, this solution is better than an interpretation that would neglect the public domain principle when taking registration decisions in trademark law.

Hence, it may be posited that, as a legally binding and constitutional rule, copyright's public domain principle – understood as the obligation to leave the public domain of cultural expressions intact as a basis for artistic discourse,<sup>126</sup> and the obligation to release a literary and artistic work into the public domain in exchange for the enjoyment of exclusive rights during the term of copyright protection – falls within the scope of the concept of public order.

To this day, this argument remains underdeveloped in case law. In *Medusa* – a decision of the German Federal Supreme Court where the defendant referred to the ancient 'Medusa Rondanini' exhibited in the Glyptothek in Munich to demonstrate that he had not copied Versace's Medusa logo – the Court tersely concluded that the public domain status of a sign did not prevent its use as a trademark. In infringement proceedings, the judge was bound by the office decision to grant trademark rights and could not rely on a sign's public domain status to deny actionable trademark use.<sup>127</sup> In the aforementioned *Winston Churchill* decision – concerning the registration of Churchill's name and portrait as trademarks for cigars – the Dutch Supreme Court held that, in principle, the unauthorized communication of a portrait to the public may amount to an offence under Art. 35 of the Dutch Copyright Act (*Auteurswet*, as in force at the time of the decision) and conflict with public order for this reason.<sup>128</sup> Hence, the Court acknowledged that the infringement of a norm of copyright law (Arts. 19 to 21 of the Dutch Copyright Act set forth provisions regulating the protection of portraits) can give rise to a conflict with public order. In the concrete case, however, the requirements for the assumption of an offence were not fulfilled.<sup>129</sup> Moreover, the facts of the case did not offer starting points for the Court to discuss whether an encroachment upon copyright's public domain principle could come into conflict with public order even though the Dutch Copyright Act did not (and still does not) contain

criminal provisions seeking to safeguard the *quid pro quo* underlying the grant of protection.<sup>130</sup>

In U.S. case law, copyright's *quid pro quo* – copyright protection is granted with the ultimate goal in mind that the protected work will finally enter the public domain and enrich the reservoir of cultural expressions that can serve as the basis of new productions – features more prominently. The U.S. Supreme Court emphasized in *Dastar v Twentieth Century Fox* that it was necessary to shield the *quid pro quo* underlying copyright law from the corrosive effect of protection regimes with potentially indefinite rights. In this context, the Court explicitly referred to the 'carefully crafted bargain' that regulated the interplay between the grant of copyright and freedom of use after copyright expiry.<sup>131</sup> In its earlier decision in *Graham v John Deere*, the U.S. Supreme Court had already recognized the need to preserve the public domain of technical know-how in the context of patent law. According to the Court, Congress may not authorize the issuance of patents whose effects were to remove existing knowledge from the public domain, or restrict free access to materials already available.<sup>132</sup> However, the Court clarified in *Eldred v Ashcroft* and *Golan v Holder* that this passage of its earlier decision was not intended to put a categorical ban on legislation that, as a result of an extension of the term of copyright protection, delayed the entry of existing works into the public domain,<sup>133</sup> or restored copyright to works that had already entered the public domain for the purpose of achieving compliance with international minimum standards of copyright protection.<sup>134</sup> The statement made in *Graham v John Deere* only addressed 'an invention's very eligibility for patent protection.'<sup>135</sup> In *Golan v Holder*, the U.S. Supreme Court finally concluded that, for the purpose of allowing the U.S. to adhere to the Berne Convention, expand markets for U.S. authors and invigorate protection against copyright piracy abroad,<sup>136</sup> it was legitimate to remove foreign literary and artistic works from the U.S. public domain by reviving copyright protection.<sup>137</sup>

With regard to the question of whether use of trademark law to re-appropriate public domain material may be qualified as incompatible with public order, this U.S. judicial practice yields mixed results. On the one hand, *Eldred v Ashcroft* and *Golan v Holder* seem to indicate that the Supreme Court may accept a delay in public domain enrichment and the removal of cultural signs from the public domain.<sup>138</sup> On the other hand, it must not be overlooked that these decisions concerned the grant of an extended or revived term of copyright protection. Hence, the basic principle of a limited term of protection was not

<sup>125</sup> Klinkert and Schwab (n 121) 1070-1071.

<sup>126</sup> As to underlying copyright theory, see John Locke, *Two Treatises of Government* (3rd edn, Awnsham and John Churchill 1698) book II chapter 5 § 27; Wendy J Gordon, 'A Property Right in Self-Expression: Equality and Individualism in the Natural Law of Intellectual Property' (1993) 102 *Yale Law Journal* 1533, 1562-1564.

<sup>127</sup> German Federal Supreme Court, 24 November 2011, Case I ZR 175/09, paras 19-20 – *Medusa*.

<sup>128</sup> *Winston Churchill* (n 4) 24.

<sup>129</sup> *ibid* 24-25.

<sup>130</sup> For a rejection of the public order argument in the Benelux context, see Vinciane Vanovermeire, 'Inschrijving als merk van een in het publiek domain gevallen werk' in Alexandre Cruquenaire and Séverine Dusollier (eds), *Le Cumul des droits intellectuels* (Larcier 2009) 177, 180-183.

<sup>131</sup> U.S. Supreme Court, 2 June 2003, *Dastar v Twentieth Century Fox* 539 U.S. 23 (2003), 33-34.

<sup>132</sup> U.S. Supreme Court, 21 February 1966, *Graham v John Deere Co.* 383 U.S. 1, 5-6 (1966).

<sup>133</sup> U.S. Supreme Court, 15 January 2003, *Eldred v Ashcroft* 537 U.S. 186, 202 (2003).

<sup>134</sup> U.S. Supreme Court, 18 January 2012, *Golan v Holder* 565 U.S. 302, 321 (2012).

<sup>135</sup> *ibid* 321.

<sup>136</sup> *ibid* 324.

<sup>137</sup> *ibid* 315-321 and 328-329.

<sup>138</sup> cf Dusollier (n 118) 154-157.

at issue. Neither *Eldred* nor *Golan* addressed potential threats to public order that may arise from the grant of indefinitely renewable trademark rights. In respect of a trademark scenario with potentially perpetual protection, the concerns about an erosion of copyright's 'carefully crafted bargain'<sup>139</sup> which the Court expressed in *Dastar v Twentieth Century Fox* may finally prevail.<sup>140</sup> Moreover, it is noteworthy that the inquiry into a conflict with public order is one of the questions that informs the decision on a sign's eligibility for trademark protection. Even if the passage taken from *Graham v John Deere* was only meant to address 'an invention's very eligibility for patent protection,'<sup>141</sup> this specific focus does not render it inapplicable in a trademark scenario. By contrast, it is the very purpose of the public order inquiry to clarify whether cultural signs can be deemed eligible for trademark protection. In combination with *Dastar*, the decision in *Graham v John Deere* may thus serve as a basis for holding that the grant of trademark rights whose effects are to remove cultural signs from the public domain conflicts with public order because they undermine copyright's carefully crafted bargain.<sup>142</sup> Therefore, U.S. case law offers starting points for the recognition of the preservation and cultivation of the public domain as elements of *ordre public*.

In the EU, similar reference points can be found in CJEU judicial practice. To preserve the public domain of technical knowledge, the Court held in *Philips v Remington* that it was a legitimate aim to prevent individuals from using the 'registration of a mark in order to acquire or perpetuate exclusive rights relating to technical solutions.'<sup>143</sup> In *Hauck v Stokke*, the Court recognized the more general objective to prevent the exclusive and permanent right which a trademark confers 'from serving to extend indefinitely the life of other rights which the EU legislature has sought to make subject to limited periods.'<sup>144</sup> As copyright constitutes such a right with a limited term of protection, *Hauck v Stokke* can be seen as groundwork for a CJEU decision in which the Court invokes public order considerations to exclude cultural signs from trademark protection.<sup>145</sup>

Admittedly, the CJEU explicitly recognized in *Butterfly Music* and *Flos* that the introduction of a harmonized 70-year term of copyright protection<sup>146</sup> in the EU may have the effect of 'protecting afresh works or subject matter

which had entered the public domain.'<sup>147</sup> Like the U.S. Supreme Court in *Eldred v Ashcroft* and *Golan v Holder*,<sup>148</sup> the CJEU thus accepted inroads into the public domain to achieve overarching policy goals, in particular EU harmonization and internal market objectives.<sup>149</sup> This judicial practice, however, need not prevent the Court from generalizing the public domain rationale known from *Philips v Remington* and *Hauck v Stokke*. Like the U.S. decisions, *Butterfly Music* and *Flos* only concerned the extension and restoration of a limited term of copyright protection – without questioning the basic principle of a limited term as such.<sup>150</sup> Trademark law, however, offers potentially perpetual protection. The grant of trademark rights would undermine copyright's public domain principle altogether. With regard to this more fundamental assault on the public domain, the CJEU remains free to take measures on the basis of the concerns expressed in *Philips v Remington* and *Hauck v Stokke*, and qualify the acquisition of indefinitely renewable trademark rights as incompatible with public order.

Like U.S. case law, the judicial practice of the CJEU thus offers starting points for the inclusion of the preservation and cultivation of the public domain in the circle of public order considerations that can lead to a categorical exclusion of cultural signs from trademark protection. Against this background, the *Vigeland* decision of the EFTA Court can pave the way for a new approach. Highlighting the possibility of recognizing the need to safeguard the public domain as a fundamental interest of society,<sup>151</sup> it may inspire decisions that invoke public order as a ground for refusing trademark rights to cultural signs.<sup>152</sup> As explained, the Norwegian Board of Appeal for Industrial Property Rights has already given an example of this new approach. The Board qualified the attempt to register *Vigeland*'s sculptures as being contrary to public order because of the considerable cultural value of the artworks and the fundamental societal considerations underlying the temporal limitation of copyright protection.<sup>153</sup> This final word in the *Vigeland* case demonstrates the effectiveness of public order ground 2 as a means to keep cultural signs outside the trademark system: the scenario where a legal system recognizes the preservation and cultivation of the public domain, in and of itself, as a fundamental interest of society.

<sup>139</sup> U.S. Supreme Court, 2 June 2003, *Dastar v Twentieth Century Fox* 539 U.S. 23 (2003), 33-34.

<sup>140</sup> cf Irene Calboli, 'Overlapping Trademark and Copyright Protection: A Call for Concern and Action' [2014] Illinois Law Review Slip Opinion 25, 32-33.

<sup>141</sup> U.S. Supreme Court, 18 January 2012, *Golan v. Holder* 565 U.S. 302, 321 (2012).

<sup>142</sup> cf the corresponding lines of reasoning in U.S. Supreme Court, 21 February 1966, *Graham v John Deere Co.* 383 U.S. 1, 5-6 (1966), and U.S. Supreme Court, 2 June 2003, *Dastar v Twentieth Century Fox* 539 U.S. 23 (2003), 33-34.

<sup>143</sup> *Philips v Remington* (n 78) para 82.

<sup>144</sup> CJEU, 18 September 2014, Case C-205/13 *Hauck v Stokke* ECLI:EU:C:2014:2233, paras 19-20.

<sup>145</sup> cf Antoon A Quaadvlieg, 'Overlap/Relationships Between Copyright and Other Intellectual Property Rights' in Estelle Derclaye (ed), *Research Handbook on the Future of EU Copyright* (Edward Elgar 2006) 479, 511-512, discussing the 'public interest in ending protection' (emphasis in the original text) and whether the CJEU could recognize 'a reflex on trademark law.'

<sup>146</sup> art 1(1) TD.

<sup>147</sup> CJEU, 29 June 1999, Case C-60/98 *Butterfly Music* ECLI:EU:C:1999:333, para 18-20; CJEU, 27 January 2011, Case C-168/09 *Flos* ECLI:EU:C:2011:29, para. 42.

<sup>148</sup> U.S. Supreme Court, 15 January 2003, *Eldred v Ashcroft* 537 U.S. 186, 202 (2003); U.S. Supreme Court, 18 January 2012, *Golan v Holder* 565 U.S. 302, 321 (2012).

<sup>149</sup> *Butterfly Music* (n 147) paras 9-10 and 24; *Flos* (n 147) para 42.

<sup>150</sup> *Butterfly Music* (n 147) paras 18-20; *Flos* (n 147) paras 43 and 46.

<sup>151</sup> *Vigeland* (n 1) para 96.

<sup>152</sup> Martin RF 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' (2017) 48 IIC 683, 716-717. As to experiences in New Zealand with a concept of 'cultural offensiveness' that covers traditional cultural expressions, cf Michael Handler, 'Australia and the South Pacific' in Martin RF Senftleben (ed), *Study on Misappropriation of Signs*, WIPO Document CDIP/9/INF/5, Geneva: World Intellectual Property Organization 2012, 232 (242); Susy R Frankel, 'Trademarks and Traditional Knowledge and Cultural Intellectual Property' in Graeme B Dinwoodie and Mark D Janis (eds), *Trademark Law and Theory: a Handbook of Contemporary Research* (Edward Elgar Publishing 2008) 433, 455-456; Frankel (n 48) 90-93.

<sup>153</sup> *Vigeland* (n 55) para 14.

## 2. Threat to fundamental values, interests or concerns

As explained above, however, public order ground 2 is a special case of the broader, more general public order ground 1: the scenario where a trademark registration poses a genuine and sufficiently serious threat to ‘certain fundamental values,’<sup>154</sup> ‘a fundamental interest of society’<sup>155</sup> or ‘a fundamental concern to the State and the whole of society.’<sup>156</sup> If a legal system does not recognize the need to safeguard the public domain, in and of itself, as a fundamental interest of society, other values, interests or concerns can thus still support a refusal based on a conflict with public order. The objective to prevent unfair free-riding on positive connotations which signs may have as a result of their evolution in the cultural domain,<sup>157</sup> for instance, can be placed in the broader context of society’s fundamental interest in undistorted competition.<sup>158</sup>

In addition to these considerations relating to the prevention of unfair competitive advantages, the fundamental interest in freedom of expression enters the picture.<sup>159</sup> A copyright owner who seeks to artificially prolong the term of copyright exclusivity on the basis of trademark law withholds her cultural creation from the public domain and deprives subsequent generations of authors of the freedom to remix this creation without exposure to a potential trademark infringement claim. From this perspective, it is unfair to use trademark law to escape the obligation to release literary and artistic works in their entirety into the public domain when copyright expires. A copyright owner pursuing this evergreening strategy seeks to deprive second authors of the freedom of remix which she enjoyed herself when making the literary and artistic work at issue. A comparable scenario arises when a third party adopts cultural heritage material in the public domain as a trademark and removes it from the public

domain by acquiring trademark rights. Once trademark protection is granted, use of affected cultural expressions is no longer as free as it was before. The risk of potential trademark infringement is hanging above use made of affected cultural creations like the sword of Damocles. From the perspective of freedom of expression, the scenario in which an artwork belongs to the public domain and is entirely free, is clearly preferable over a situation where trademark rights are granted and artists are exposed to the risk of an infringement claim.<sup>160</sup> Given the human rights dimension and the fundamental importance of freedom of expression to society, it seems justified to apply public order as a ground for refusal to eliminate the risk of inroads into freedom of expression.<sup>161</sup>

## VI. Conclusion

On balance, the public order and morality arguments following from the *Vigeland* decision of the EFTA Court have a remarkable potential to support an outright exclusion of cultural heritage material, such as the Mona Lisa, the Night Watch, the Angry Boy and the Monolith, from trademark protection. Based on a normative understanding of the consumer prototype used for the assessment of conflicts with morality, applicable sensitivity and tolerance thresholds can be aligned with cultural concerns to a large extent. As the GCEU decision in *La Mafra Franchises* indicates, morality arguments are particularly strong when fundamental values are associated with the cultural heritage sign at issue. Morality considerations

<sup>154</sup> *Vigeland* (n 1) para. 96.

<sup>155</sup> *ibid* para 95.

<sup>156</sup> *ibid* para 94.

<sup>157</sup> For a more detailed discussion of this argument, see Senftleben (n 11), 290-291.

<sup>158</sup> Modern concepts of undistorted, fair competition recognize, besides the traditional protection of competitors and consumers, the public interest in the efficient functioning of competition – in the sense of a protection of market participants’ freedom of action and decision; cf Marcus Höpferger and Martin RF Senftleben, ‘Protection Against Unfair Competition at the International Level – The Paris Convention, the 1996 Model Provisions and the Current Work of the World Intellectual Property Organization’ in Reto M Hilty and Frauke Henning-Bodewig (eds), *Law Against Unfair Competition – Towards a New Paradigm in Europe?*, MPI Studies on Intellectual Property, Competition and Tax Law, Vol 1 (Springer 2007) 61, 74-76; Frauke Henning Bodewig, ‘A New Act Against Unfair Competition in Germany’ (2005) 36 IIC 421, 425-426; Ansgar Ohly, ‘Das neue UWG – Mehr Freiheit für den Wettbewerb?’ [2004] GRUR 889, 894-896; Eike Ullmann, ‘Das Koordinatensystem des Rechts des unlauteren Wettbewerbs im Spannungsfeld von Europa und Deutschland’ [2003] GRUR 817, 821.

<sup>159</sup> arts 11 and 13 CFR; art 10 ECHR; cf s 3.1. See the discussion of freedom of expression as guiding principles for the development of EU trademark law by Martin RF Senftleben and others, ‘The Recommendation on Measures to Safeguard Freedom of Expression and Undistorted Competition: Guiding Principles for the Further Development of EU Trade Mark Law’ (2015) 37 EIPR 337. As to the general potential of fundamental rights to ensure an appropriate calibration of intellectual property protection, see the groundwork laid by Christophe Geiger, ‘Fundamental Rights, a Safeguard for the Coherence of Intellectual Property?’ (2004) 35 IIC 268; Christophe Geiger, ‘“Constitutionalising” Intellectual Property Law? The Influence of Fundamental Rights on Intellectual Property in the European Union’ (2006) 37 IIC 371.

<sup>160</sup> For a discussion of the chilling effect of trademark protection, see Senftleben (n 11) 200-205.

<sup>161</sup> cf the debate on how to reconcile trademark protection with freedom of expression. See Łukasz Żelechowski, ‘Invoking freedom of expression and freedom of competition in trade mark infringement disputes: legal mechanisms for striking a balance’ (2018) 19 ERA Forum 115, 115-135; Martin RF Senftleben, ‘Free Signs and Free Use – How to Offer Room for Freedom of Expression within the Trademark System’ in Christophe Geiger (ed), *Research Handbook on Human Rights and Intellectual Property* (Edward Elgar 2015) 354; Lisa P Ramsey and Jens Schovsbo, ‘Mechanisms for Limiting Trade Mark Rights to Further Competition and Free Speech’ (2013) 44 IIC 671; Ilanah Simon Fhima, ‘Trade Marks and Free Speech’ (2013) 44 IIC 293; Wolfgang Sakulin, *Trademark Protection and Freedom of Expression – An Inquiry into the Conflict between Trademark Rights and Freedom of Expression under European Law* (Kluwer Law International 2010); Christophe Geiger, ‘Marques et droits fondamentaux’ in Christophe Geiger and Joanna Schmidt-Szalewski (eds), *Les défis du droit des marques au 21<sup>e</sup> siècle/ Challenges for Trademark Law in the 21<sup>st</sup> Century* (Litec 2010) 163; Robert Burrell and Dev Gangjee, ‘Trade Marks and Freedom of Expression: A Call for Caution’ (2010) 41 IIC 544; Mohammad Nasser, ‘Trade Marks and Freedom of Expression’ (2009) 40 IIC 188; Rochelle C Dreyfuss, ‘Reconciling Trademark Rights and Expressive Values: How to Stop Worrying and Learn to Love Ambiguity’ in Graeme B Dinwoodie and Mark D Janis (eds), *Trademark Law and Theory: A Handbook of Contemporary Research* (Edward Elgar Publishing 2008) 261; Christophe Geiger, ‘Trade Marks and Freedom of Expression – The Proportionality of Criticism’ (2007) 38 IIC 317; Lisa P Ramsey, ‘Free Speech and International Obligations to Protect Trademarks’ (2010) 35 Yale Journal of International Law 405; Katja Weckström, ‘The Lawfulness of Criticizing Big Business: Comparing Approaches to the Balancing of Societal Interests Behind Trademark Protection’ (2007) 11 Lewis & Clark Law Review 671; Pratheepan Gulasekaram, ‘Policing the Border Between Trademarks and Free Speech: Protecting Unauthorized Trademark Use in Expressive Works’ (2005) 80 Washington Law Review 887; Pierre N Leval, ‘Trademark: Champion of Free Speech’ (2004) 27 Columbia Journal of Law and the Arts 187; Kerry L Timbers and Julia Huston, ‘The “Artistic Relevance Test” Just Became Relevant: the Increasing Strength of the First Amendment as a Defense to Trademark Infringement and Dilution’ (2003) 93 The Trademark Reporter 1278; Keith Aoki, ‘How the World Dreams Itself to be American: Reflections on the Relationship Between the Expanding Scope of Trademark Protection and Free Speech Norms’ (1997) 17 Loyola of Los Angeles Entertainment Law Journal 523; Dreyfuss (n 41) 415-418.

can certainly acquire particular importance in the case of cultural heritage signs that play a central role in a country's cultural landscape and the discourse in the artistic domain.

The concept of public order following from *Vigeland* has a remarkable potential to achieve a categorical exclusion of cultural heritage signs from trademark protection as well. Unlike a scrutiny in the light of morality standards, public order criteria are not inherently limited by the need to conduct the analysis through the prism of consumer perception. By contrast, trademark tribunals can directly invoke fundamental values, interests and concerns that militate against the grant of trademark protection. The described lines of argument – based on

copyright's public domain principle, the need to ensure undistorted competition and the constitutional guarantee of freedom of expression – broaden the ambit of operation of public order as a ground for refusal. The EFTA Court expressed the view that 'registration of a sign as a trade mark may only be refused as contrary to public policy in accordance with [EU trademark legislation] in exceptional circumstances.'<sup>162</sup> Considering the societal values, interests and concerns discussed above, however, the threshold of exceptionality need not be high. Arguably, an exceptional situation that calls for caution arises whenever trademark protection is requested in respect of cultural heritage material in the public domain.

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<sup>162</sup> *Vigeland* (n 1) para 96.