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5. Towards a new copyright/trademark interface—why (and how) signs with cultural significance should be kept outside trademark law

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I. INTRODUCTION

To this day, trademark law and practice have not managed to eliminate a serious imbalance within the intellectual property system: while the functionality doctrine in trademark law can be employed to prevent overlaps between patent and trademark protection² and achieve a far-reaching separation of industrial design and trademark protection,³ a comparably strong mechanism for policing the border between copyright and trademark protection has not yet evolved.⁴ As in the case of corresponding features of the patent and industrial design systems, however, indefinitely renewable trademark rights involve the risk of an artificial extension of the limited term of copyright protection and the impoverishment of the public domain of cultural expressions. Moreover, trademark protection may lead to free-riding on the reputation and positive image of cultural symbols, the blurring of a sign's cultural meaning through the attachment of commercial connotations, and the impairment of an open communication process in the cultural domain. Against this background, the following discussion of the need to recalibrate the copyright/trademark interface will first shed light on the societal importance of preserving the cultural meaning of artworks as

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² Developments in the E.U. can serve as an example in this regard. Decisions by the Court of Justice have led to a separation of the two protection regimes by denying trademark protection to technical shapes even if alternative shapes are available to competitors. *See* CJEU, 18 June 2002, case C-299/99, ECLI:EU:C:2002:377, *Philips v. Remington*, para. 82; CJEU, 14 September 2010, case C-48/09 P, ECLI:EU:C:2010:516, *Lego Juris v. OHIM (Mega Brands)*, paras. 45 and 53–58.

³ In the EU, the potential of the doctrine of aesthetic functionality has been enhanced significantly by the decision in *Hauck* where the Court developed a list of flexible factors for the identification of signs that are to be excluded from trademark protection for this reason. *See* CJEU, 18 September 2014, case C-205/13, ECLI:EU:C:2014:2233, *Hauck v. Stokke*, paras. 19–20.

⁴ Martin R.F. Senftleben, *Public Domain Preservation in EU Trademark Law – A Model for Other Regions?*, 103 TRADEMARK REPORTER 775, 814–17 (2013).

a basis for dialogue and discussion in the artistic domain (Section II). On this basis, the current practice of accepting simultaneous and subsequent trademark protection (Sections III and IV) will be criticized (Section V) before arguing for the introduction of more robust grounds for refusal that allow the categorical exclusion of signs with cultural significance from trademark protection (Sections VI and VII).

II. SOCIETAL IMPORTANCE OF PRESERVING AN ARTWORK'S ARTISTIC DISCOURSE POTENTIAL

In the debate about cumulative copyright and trademark protection, it must not be overlooked that because of their cultural meaning, literary and artistic works are indispensable source materials for an open, dialogic communication process in the artistic domain.⁵ As the following analysis will show, the preservation of this *artistic discourse potential* of literary and artistic works is of utmost importance to society. Friedrich Schiller's and Theodor Adorno's aesthetic theories offer key insights in this regard that are relevant to the debate on the societal role and function of art to this day. While Schiller sees works of art as catalysts paving the way for an ethical and free society (subsection A), Adorno describes the task of art to challenge reality and suggest necessary societal changes (subsection B). The subsequent discussion of these aesthetic theories in the light of contemporary art theory will show that the attachment of commercial connotations to works of art is undesirable from this perspective. It involves the risk of diminishing the artistic discourse potential of affected works and losing important impulses for the improvement of societal conditions (subsection C).

Copyright/trademark overlaps thus raise complex questions. Trademark rights in signs that are artworks are problematic because they can pose an obstacle to remix and reuse of cultural material which is indispensable for cultural follow-on innovation.⁶ More fundamentally, however, trademark rights are particularly problematic

⁵ For a more detailed discussion of the dialogic process underlying acts of creation, see MARTIN R.F. SENFLEBEN, *THE COPYRIGHT/TRADEMARK INTERFACE: HOW THE EXPANSION OF TRADEMARK PROTECTION IS STIFLING CULTURAL CREATIVITY* 63–67 (2021); Séverine Dusollier, *Realigning Economic Rights with Exploitation of Works: The Control of Authors over the Circulation of Works in the Public Sphere*, in *COPYRIGHT RECONSTRUCTED – RETHINKING COPYRIGHT'S ECONOMIC RIGHTS IN A TIME OF HIGHLY DYNAMIC TECHNOLOGICAL AND ECONOMIC CHANGE* 163, 180–83 (P. Bernt Hugenholtz (ed.), 2018); CARYS J. CRAIG, *COPYRIGHT, COMMUNICATION AND CULTURE – TOWARDS A RELATIONAL THEORY OF COPYRIGHT LAW* 52–56 (2011); Julie E. Cohen, *Copyright, Commodification, and Culture: Locating the Public Domain*, in *THE FUTURE OF THE PUBLIC DOMAIN – IDENTIFYING THE COMMONS IN INFORMATION LAW* 121, 144–52 (L.M.C.R. Guibault/P.B. Hugenholtz (eds.), 2006).

⁶ For a sociological analysis of this point, see PIERRE BOURDIEU, *DIE REGELN DER KUNST. GENESE UND STRUKTUR DES LITERARISCHEN FELDES* 370–72 (1999) (French original: PIERRE BOURDIEU, *LES RÈGLES DE L'ART. GÈNESE ET STRUCTURE DU CHAMP LITTÉRAIRE* (1992)). As to the corresponding legal debate on encroachments upon freedom of expression, see WOLFGANG SAKULIN, *TRADEMARK PROTECTION AND FREEDOM OF EXPRESSION – AN INQUIRY INTO THE*

because the communication concerning the sign is no longer left to the process of discussion and assessment that occurs in the artistic domain. Instead, the commercial messages introduced by the trademark owner shape the perception of the sign and may devalue the sign as a reference point for cultural creativity that may offer important alternative visions of society.

A. Schiller's Aesthetic Theory

Disillusioned by the French Revolution, which had culminated in chaos and violence instead of leading to a free and equal society, Schiller wrote his *Letters on the Aesthetic Education of Man* to explore the possibility of a transition from an absolutist, authoritarian state to a purified, ethical state that is founded on human reason.⁷ As a precondition for this transition, Schiller emphasizes the need to harmonize human desires with the rules of reason. As it is not the destiny of mankind to renounce its

CONFLICT BETWEEN TRADEMARK RIGHTS AND FREEDOM OF EXPRESSION UNDER EUROPEAN LAW (2010). See also Lisa P. Ramsey and Jens Schovsbo, *Mechanisms for Limiting Trade Mark Rights to Further Competition and Free Speech*, 44 INT'L REV. INTELL. PROP. AND COMP. L. 671 (2013); Martin R.F. Senftleben, *Free Signs and Free Use - How to Offer Room for Freedom of Expression within the Trademark System*, in RESEARCH HANDBOOK ON HUMAN RIGHTS AND INTELLECTUAL PROPERTY 354 (Christophe Geiger (ed.), 2015); Ilanah Simon Fhima, *Trade Marks and Free Speech*, 44 INT'L REV. INTELL. PROP. AND COMP. L. 293 (2013); Robert Burrell & Dev Gangjee, *Trade Marks and Freedom of Expression: A Call for Caution*, 41 INT'L REV. INTELL. PROP. AND COMP. L. 544 (2010); Christophe Geiger, *Marques et droits fondamentaux*, in LES DÉFIS DU DROIT DES MARQUES AU 21^E SIÈCLE/CHALLENGES FOR TRADEMARK LAW IN THE 21ST CENTURY 163 (Christophe Geiger/Ioanna Schmidt-Szalewski (eds.), 2010); Mohammad A. Naser, *Trade Marks and Freedom of Expression*, 40 INT'L REV. INTELL. PROP. AND COMP. L. 188 (2009); Lionel Bently, *From Communication to Thing: Historical Aspects of the Conceptualisation of Trade Marks as Property*, in TRADEMARK LAW AND THEORY: A HANDBOOK OF CONTEMPORARY RESEARCH (Graeme B. Dinwoodie & Mark D. Janis, 2008); William McGeeveran, *Four Free Speech Goals for Trademark Law*, 18 FORDHAM INTEL. PROP., MEDIA AND ENT. L.J. 1205 (2008); Christophe Geiger, *Trade Marks and Freedom of Expression—the Proportionality of Criticism*, 38 INT'L REV. INTELL. PROP. AND COMP. L. 317 (2007); Lisa P. Ramsey, *Free Speech and International Obligations to Protect Trademarks*, 35 YALE J. INT'L L. 405 (2010); Katja Weckström, *The Lawfulness of Criticizing Big Business: Comparing Approaches to the Balancing of Societal Interests Behind Trademark Protection*, 11 LEWIS & CLARK L. REV. 671 (2007); Pratheepan Gulasekaram, *Policing the Border Between Trademarks and Free Speech: Protecting Unauthorized Trademark Use in Expressive Works*, 80 WASH. L. REV. 887 (2005); Pierre N. Leval, *Trademark: Champion of Free Speech*, 27 COLUM. J. L. AND THE ARTS 187 (2004); Rochelle Dreyfuss, *Reconciling Trademark Rights and Expressive Values: How to Stop Worrying and Learn to Love Ambiguity*, in TRADEMARK LAW AND THEORY: A HANDBOOK OF CONTEMPORARY RESEARCH 261 (Graeme B. Dinwoodie & Mark D. Janis (eds.), 2008); 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*, 17 LOYOLA L.A. ENT. L. J. 523 (1997).

⁷ Friedrich Schiller, *Über die ästhetische Erziehung des Menschen* (K.L. Berghah (ed.), 2000) 11–14 (Letter 3).

natural senses in favour of moral laws,⁸ support for an ethical, reasonable state must come from the totality of human dispositions: desire and reason alike. Individuals should not only feel an obligation to follow the rules of reason, they should feel a desire to do so. If human desires are brought in line with the postulates of reason, a revolution will no longer end in chaos and violence. It will lead to the establishment of a moral state instead.⁹

To align human desires with the rules of reason, however, a catalyst is required that brings moral laws not only to people's heads but also to their hearts. Schiller solves this problem by positing that art can serve as such a catalyst. Even though being incapable of changing mankind directly, art can point the way to a change for the better by focusing people's thoughts on the "necessary and eternal", and make them strive for this ideal.¹⁰ Art is predestined to accomplish this task because it satisfies the desire to play and enjoy. Instead of openly criticizing people's actions and attitudes, art can improve society in a subtle way by making visions of ethical behaviour part of people's play and pleasure.¹¹

Schiller thus relies on art as a vehicle to let people experience an ideal balance between desire and reason until they finally orient their actions by following moral laws instead of pursuing mere physical necessities. Offering appearances of beauty, a true work of art is capable of evoking an equilibrium between reason and desire.¹² In Schiller's view, the experience and enjoyment of this ultimate perfection can pave the way for the establishment of a moral society in which individual freedom no longer follows from the restriction of the freedom of others but from a consensus on ethical norms that corresponds with people's desires, as refined in aesthetic play.¹³ An individual driven by physical necessity must first experience beauty – the aesthetic balance between desire and rules of reason – before he can actively and freely opt for moral norms and moral actions.¹⁴ It is thus the task of art to prepare mankind for the transition from the physical state of desire to the moral state of reason.¹⁵

B. Adorno's Aesthetic Theory

In his aesthetic theory, Theodor Adorno also underlines the societal relevance of art. Against the background of the alienation which the individual faces in a fully rationalized, efficiency-driven world, he warns of the affirmative nature of art. An artwork bringing a conciliatory reflection of enchantment into the disenchanting, empirical reality offers comfort in the rationalized world and supports the unbearable

⁸ *Id.* at 28 (Letter 6).

⁹ *Id.* at 120–21 (Letter 27).

¹⁰ *Id.* at 36 (Letter 9).

¹¹ *Id.* at 37 (Letter 9).

¹² *Id.* at 111–12 (Letter 26).

¹³ *Id.* at 120–21 (Letter 27).

¹⁴ *Id.* at 90–91 (Letter 23).

¹⁵ *Id.* at 92 (Letter 23).

status quo.¹⁶ In the light of the inhumanity of the real world, art would make itself an accomplice of present and coming disasters if it sustained positive visions of society and obscured the defects and poorness of reality.¹⁷ With the prospect of a better world which, as an ultimate truth,¹⁸ shimmers through each genuine artwork,¹⁹ art may falsely pretend that existing societal conditions are acceptable. Therefore, art is constantly at risk of becoming guilty of supporting the inhuman status quo and fortifying present ideologies.²⁰

On the other hand, art must not be condemned altogether because true art is capable of unmasking the negativity of present societal conditions. Showing visions of a better, happier life, art can rouse opposition against the existing reality and contribute to necessary societal changes.²¹ Art can thus play a decisive role in society because it generates utopian views of a better life that may become drivers of a change for the better. This role of authentic art defines its social character: art is the “social antithesis” of society.²² Given this delicate position in the social fabric of modern societies, there is a fine line to be walked: the artist must relentlessly expose the inhumanity of reality without offering any prospect of reconciliation. In doing so, the artist creates genuine works that, by their very nature, offer shining visions of a better life and a better society in spite of the hopelessness reflected in the artworks themselves.²³ As an antithesis of the disaster in the real world, art becomes the messenger of an ideal, utopian world.²⁴

C. Improvement of Social and Political Conditions

By no means do these two aesthetic theories exhaust the possibilities of describing the role of artworks in society. Nonetheless, the two examples of an assessment of art’s societal relevance already show that by presenting alternative visions of society, literary and artistic works can play a crucial role in the improvement of social and political conditions. As Schiller’s Letters date back to the Age of Enlightenment and Adorno developed his Aesthetic Theory in the second half of the last century, however, the question arises whether it is still appropriate to rely on this theoretical framework. In his discussion of aesthetic progress in the light of the progress clause of the U.S. Constitution,²⁵ Barton Beebe resorts to John Dewey’s and Richard

¹⁶ Theodor W. Adorno, *Ästhetische Theorie* (G. Adorno/R. Tiedemann (eds.), 1970), 10 and 34.

¹⁷ *Id.* at 28 and 503.

¹⁸ *Id.* at 128 and 196–97.

¹⁹ *Id.* at 199–200.

²⁰ *Id.* at 203.

²¹ *Id.* at 25–26 and 56.

²² *Id.* at 9–10, 19 and 53.

²³ *Id.* at 127 and 199.

²⁴ *Id.* at 55–56.

²⁵ As to the grant of intellectual property protection, Article I, Section 8 of the U.S. Constitution refers to the objective to “promote the Progress of Science and useful Arts, by

Shusterman's concept of "pragmatist aesthetics"²⁶ for the assessment of copyright law.²⁷ Pragmatist aesthetics focuses on everyday events as a gateway to aesthetic experience and practice:

In order to understand the meaning of artistic products, we have to forget them for a time, to turn aside from them and have recourse to the ordinary forces and conditions of experience that we do not usually regard as esthetic. We must arrive at the theory of art by means of a detour.²⁸

Providing examples, Dewey refers to "sights that hold the crowd,"²⁹ such as a fire-engine rushing by, machines that excavate enormous holes in the earth, men "perched high in air on girders, throwing and catching red-hot bolts."³⁰

Building on pragmatist aesthetics, Beebe departs from the focus on autonomous aesthetic objects in the Kantian tradition of aesthetic theory³¹—the predominant tradition in the Age of Enlightenment which also served as a reference point for Schiller's *Letters on the Aesthetic Education of Man*.³² In Beebe's analysis, a critique of the focus on "mummified museum art"³³ serves as a vehicle to arrive at a new progress paradigm for U.S. copyright law. Beebe seeks to overcome the traditional accumulationist approach (the more works, the more progress) and replace it with a focus on the encouragement of aesthetic practice.³⁴ He relies on pragmatist aesthetics because they offer a vision of aesthetic progress that focuses "not on the stockpiling over time of fixed, archivable works but rather on the quality of ephemeral aesthetic experience in the present."³⁵ This preference for pragmatist aesthetics, however, does not imply a rejection of the idea that art can play an important role in the improvement of societal conditions. Beebe explicitly confirms the positive social and political side effects of aesthetic experience and aesthetic play:

securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries." Cf. Barton Beebe, Bleistein, *the Problem of Aesthetic Progress, and the Making of American Copyright Law*, 117 COLUM. L. REV. 319, 371–73, 378 (2017).

²⁶ JOHN DEWEY, *ART AS EXPERIENCE* 5–10 (1934); RICHARD SHUSTERMAN, *PRAGMATIST AESTHETICS – LIVING BEAUTY, RETHINKING ART* 143, 208 (2d Ed. 2000).

²⁷ Beebe, *supra* note 25, at 342–48.

²⁸ DEWEY, *supra* note 26, at 4.

²⁹ *Id.* at 5.

³⁰ *Id.*; Beebe, *supra* note 25, at 344.

³¹ Beebe, *supra* note 25, at 344.

³² Schiller, *supra* note 7, as discussed in section 3.3.2.1. As to the impact of the Kantian school of thought on Schiller, see PETER OSBORNE, *ANYWHERE OR NOT AT ALL – PHILOSOPHY OF CONTEMPORARY ART* 42–44 (2013).

³³ Beebe, *supra* note 25, at 343.

³⁴ *Id.* at 347, 373–74, 384–85.

³⁵ *Id.* at 346.

Aesthetic play has intrinsic value—as a source of pleasure, of moral and political cultivation, of imaginative freedom and self-actualization—even when it does not ultimately result in the production of an aesthetic work.³⁶

As explained, Schiller’s aesthetic theory rests on similar considerations. The experience of a balance between desire and rules of reason in the aesthetic play enables the individual to opt actively and freely for moral norms and moral actions.³⁷ In the context of Beebe’s discussion of the role of copyright law, the focus on aesthetic practice, moreover, leads back to the question of freedom to use pre-existing aesthetic objects as raw materials for aesthetic play. Beebe emphasizes “the importance to the everyday individual of aesthetic engagement, aesthetic practice, and aesthetic play, in the form of the active assimilation, appropriation, and creative recombination of aesthetic expression.”³⁸

Beebe’s reliance on pragmatist aesthetics, thus, does not indicate that Schiller’s aesthetic theory has lost its relevance. By contrast, his analysis merely shifts the focus from the production of aesthetic works to the encouragement of aesthetic play. While the stimulation of new artistic productions may have been regarded as copyright’s primary policy goal in the past, Beebe considers it more important nowadays to facilitate the creative remix of protected works in the context of aesthetic play.³⁹ Instead of dismissing the idea that art is capable of providing impulses for desirable social and political changes, Beebe returns to Schiller’s aesthetic theory and its focus on aesthetic experience in his concluding remarks.⁴⁰

Besides this confirmation in legal literature, developments in aesthetic theory itself confirm that artworks, including works of contemporary art, are still seen as critical reflections of social and political conditions and manifestations of alternative visions of society. In his *Philosophy of Contemporary Art*, Peter Osborne refers to Adorno’s *Aesthetic Theory* as a text that “towers above all other twentieth-century philosophical texts about art.”⁴¹ His own description of the role of art in today’s society is embedded in the discussion of the subjective temporality of works of contemporary art and—in line with Augustine’s contraction of the temporal dimensions of present/past/future into the subjective orientations of attention/memory/expectation—the question of “what modes of *attention*, *memory* and *expectation* contemporary art produces and requires as conditions of its experience.”⁴²

With regard to the adequate mode of expectation, Osborne employs the concept of “horizon of expectation” as a point of departure: horizon of expectation in the sense of Edmund Husserl’s elaboration of a boundary concept that refers to an inde-

³⁶ *Id.* at 346–47.

³⁷ Schiller, *supra* note 7, at 90–91 (Letter 23); 120–21 (Letter 27).

³⁸ Beebe, *supra* note 25, at 347.

³⁹ *Id.* at 390–91.

⁴⁰ *Id.* at 395–96.

⁴¹ OSBORNE, *supra* note 32, at 10.

⁴² *Id.* at 175 (emphasis in the original text).

terminateness which, while being determinable as an obscure, misty phenomenon, never becomes fully determinable because the horizon is infinitely receding.⁴³ With increasing knowledge, the horizon of expectation is moved and expanded as well:

As a spatial image, horizon points towards a beyond, something existent but out of sight, and hence unknown—and yet in principle knowable once you travel there. The horizon will move, but what was beyond the horizon can come to be within it, if you travel; hence the inherent hopefulness of travel.⁴⁴

Despite the elasticity of the horizon metaphor, the concept of horizon of expectation has inherent limitations. In particular, it remains impossible to “break through the ultimate indeterminateness of the horizon of expectation as such.”⁴⁵ Otherwise, it would no longer be justified to speak of a horizon of expectation. According to Osborne, this inherent limitation of the concept has become problematic as a result of the abandonment of the Christian doctrine of the Last Days in modernity. Instead of a pre-determined expectation of the apocalypse, the individual in modern times is exposed to “the hazards of an open but ‘progressive’ future.”⁴⁶ The moment the future is open and known to bring something new, we paradoxically come to expect the unexpected. Only the unexpected has the “power to surprise”⁴⁷ and create new experiences. It is “the *unexpected* that we come to *expect* and also to value.”⁴⁸ Osborne describes this sensation as follows:

In the unexpected, meaning is produced (in so far as it is produced) through dialectical negation—not further determination—of the expected. It is true, of course, that we may come to expect such negations—and “revolution” did, of course, become established as a horizon of expectation in the 200-year period from 1789 to 1989.⁴⁹

The reference to the French Revolution and the fall of the Berlin Wall indicates that the paradoxical penetration of the horizon of expectation (following from the expectation of the unexpected that creates new meaning through negation) has a particular societal value. It enables the individual to include fundamental transformations of society in the spectrum of valid, determinable expectations for the future: even unexpected events can be deemed plausible projections of developments to come. In this regard, however, Osborne points out that alternative visions of society—capable of heightening expectations of the unexpected—have become scarce. In his view, the collapse of historical communism did not broaden the spectrum of horizons for further social and political development. While the concrete end of communist

⁴³ *Id.* at 203.

⁴⁴ *Id.* at 203–04.

⁴⁵ *Id.* at 204.

⁴⁶ *Id.* at 206–07.

⁴⁷ *Id.* at 207.

⁴⁸ *Id.* (emphasis in the original text).

⁴⁹ *Id.* at 208 (emphasis in the original text).

regimes at a particular point in time may have been unexpected, the inviability of non-capitalist systems did not come as a surprise.⁵⁰ Instead of opening up new horizons, the collapse of communism entailed the loss of two historical horizons, namely those of communism and revolution.⁵¹ At the same time, the inviability of communist systems confirmed and reinforced the victorious horizon of “capitalism”—in the sense of “the renewed development and planetary universalization of capital accumulation as the basis of social development.”⁵²

The current predominance of capitalism does not exclude unexpected events. Instead of opening new avenues for social and political changes, however, these unexpected events tend to remain within the prevailing capitalist paradigm. China’s adherence to the WTO and corresponding reforms of land ownership and capital regulation, for instance, opened up a new horizon for the global economic system. New prospects of business development in China, however, only brought “a new horizon of expectation within capitalism.”⁵³ According to Osborne, even the 9/11 terrorist attack was nothing more than “a symbolic harbinger of a new, religiously-coded geopolitical antagonism” that remained emblematic and merely darkened the capitalist Western horizon of expectation.⁵⁴ For the creation of truly alternative visions of society—expectations of the “genuinely *unexpected*”⁵⁵—it is necessary to commit to experimental practices of negation: practices that are capable of producing new meaning through the negation of established expectations.⁵⁶

In this regard, contemporary art plays a crucial role: “[a]t its best, contemporary art models experimental practices of negation that puncture horizons of expectation.”⁵⁷ Osborne’s analysis of the role of contemporary art, thus, confirms the conclusion that has been drawn above on the basis of Schiller’s and Adorno’s aesthetic theories: art can provide important impulses for social and political changes by modelling experimental practices that open up new horizons for the development of society.⁵⁸ Hence, the description of art’s societal impact in Schiller’s and Adorno’s theories is not outdated. The emphasis on moral and political cultivation in Beebe’s analysis relying on pragmatist aesthetics⁵⁹ and the importance which Osborne attaches to experimental artistic practices of negation in his *Philosophy of Contemporary Art*⁶⁰ confirm that by

⁵⁰ *Id.* at 208–09.

⁵¹ *Id.* at 209.

⁵² *Id.*

⁵³ *Id.* at 210.

⁵⁴ *Id.*

⁵⁵ *Id.* at 208 (emphasis in the original text).

⁵⁶ *Id.*

⁵⁷ *Id.* at 211.

⁵⁸ Cf. Florian Cramer, *Crapularity-Ästhetik. Dystopien zeitgenössischer Kunst – und das unterschiedliche Erbe von kritischer Theorie und Konzeptualismus in der Bildenden Kunst und Neuen Musik*, 180 *NEUE ZEITSCHRIFT FÜR MUSIK* 12, 15 (2019), who also draws a line between Adorno’s critical theory and Osborne’s focus on experimental practices of negation.

⁵⁹ Beebe, *supra* note 25, at 346–47.

⁶⁰ Osborne, *supra* note 32, at 211.

providing raw material for the aesthetic play and puncturing predominant horizons of expectation, art can play a crucial role in the improvement of social and political conditions. An artwork can unmask defects of existing societal conditions and prepare society for the transition to a better community.

Given this fundamental importance of literary and artistic productions, it is safe to assume that once a work of art is created, society should seek not to interfere with the artistic discourse potential which the respective literary and artistic creation offers. Otherwise, an important impulse for required social and political changes might be lost. Schiller directly points out the merit of preserving the cultural meaning of works of art as a basis for ongoing dialogue in the literary and artistic domain and impulses for societal change. As artworks reflect human dignity, they can serve as prototypes for the restoration of an ethical order whenever the principles of morality and reason are lost: “Humanity has lost its dignity, but art has saved it, and preserves it in marbles full of meaning; truth continues to live in illusion, and the copy will serve to reestablish the model.”⁶¹ From this perspective, the preservation of an artwork’s potential for dialogic communication in the artistic domain is an act of preserving expressions of human dignity as templates for desirable improvements of social and political conditions.

With this central insight in mind, it is easy to understand why overlapping copyright and trademark protection raise particular concerns. The grant of trademark rights gives one individual speaker—the trademark proprietor—more communication power than other participants in the debate. Even if trademark infringement claims finally have no success, the mere fact that the trademark owner can bring a lawsuit because of her exclusive rights to the sign can change “the nature of the social conversation about things.”⁶² As trademark rights offer the trademark owner an exclusive position, the definition power is higher than the degree of control resulting from other forms of commercial use, such as mere use in advertising without trademark rights. The grant of stable, indefinitely renewable rights substantially enhances the risk of impregnating the artwork with commercial messages that may devalue the sign as a reference point in the artistic discourse. The debate on the artwork is no longer as open and free as it was before.⁶³

Considering this problem scenario, it is of particular interest that Adorno explicitly warns of the risk of artworks losing their subversive character through efforts to submerge their critical meaning and popularize them in commercial products.⁶⁴ Once art is consumed and enjoyed, it inevitably loses its value as a mirror of defects in society and a provocation that is capable of triggering necessary changes. Instead, it becomes a means of pretending that the present situation is sufficient and acceptable.⁶⁵ Hence,

⁶¹ Schiller, *supra* note 7, at 35 (Letter 9).

⁶² Mark A. Lemley & Mark P. McKenna, *Irrelevant Confusion*, 62 STAN. L. REV. 413, 443 (2010).

⁶³ SENFTLEBEN, *supra* note 5, at 293–299.

⁶⁴ Adorno, *supra* note 16, at 33–34.

⁶⁵ *Id.* at 32.

it is necessary to shield artworks from the corrosive effect of use in product marketing to safeguard the potential of art to expose flaws in society.

Therefore, the preservation of an artwork's potential for dialogic communication in the artistic domain is of particular importance to society. It ensures that alternative visions of society that are evoked in literary and artistic works remain intact—visions that may provide impulses for artistic follow-on innovation and societal reforms. The grant of trademark rights in the content of artworks is undesirable from this perspective. It allows the trademark owner to interfere with the communication process in the cultural domain, blur a sign's cultural meaning through the attachment of commercial connotations and impede the sign's potential to serve as a reference in the artistic discourse.

III. ACCEPTANCE OF SIMULTANEOUS AND SUBSEQUENT TRADEMARK PROTECTION

Despite these societal concerns, the intellectual property system fails to draw a clear boundary line between the subject matter of copyright and trademark protection. Instead, character merchandising leads to cumulative copyright and trademark protection of contemporary cultural symbols (Mickey Mouse).⁶⁶ In principle, it is also possible to acquire trademark rights to cultural heritage symbols once distinctive character is acquired through use in trade (Mona Lisa).⁶⁷ In contrast to the efforts

⁶⁶ Cf. Irene Calboli, *Overlapping Trademark and Copyright Protection: A Call for Concern and Action*, ILL. L. REV. SLIP OPINION 25, 29–30 (2014). Examples can easily be found in trademark registers. As to Mickey Mouse, see IR no. 296478. As to Superman, see German registration no. DD643100. As to Miffy, see Benelux registration no. 0653451. For further examples, see SENFTLEBEN, *supra* note 5, at 3–4.

⁶⁷ Cf. SENFTLEBEN, *supra* note 5, at 4–7. For example, see CJEU, 6 September 2018, case C-488/16P, ECLI:EU:C:2018:673, Bundesverband Souvenir - Geschenke - Ehrenpreise v. EUIPO (concerning “Neuschwanstein” as an indication of Neuschwanstein Castle); Court of Appeals of Brussels, 3 October 2013, cases 2013/7132 and 2013/7133, Anne Frank Foundation/Benelux Office for Intellectual Property (concerning the book titles “The Diary of Anne Frank” and “The Secret Annex” and recognizing the possibility of acquiring distinctiveness through use), and OHIM Board of Appeal, 31 August 2015, case R 2401/2014-4, Anne Frank Fonds, paras. 32–36 (granting trademark rights to the French indication “Le Journal d’Anne Frank”); German Federal Court of Justice, 24 April 2008, case I ZB 21/06, Marlene-Dietrich-Bildnis (concerning a portrait photograph of the actress and recognizing the possibility of acquiring distinctiveness through use); German Federal Patent Court, 25 November 1997, case 24 W (pat) 188/96, Mona Lisa (concerning the Mona Lisa painting and recognizing the possibility of acquiring distinctiveness through use), *Gewerblicher Rechtsschutz und Urheberrecht* 1998, 1022. For case comments, see Martin R.F. Senftleben, *Der kulturelle Imperativ des Urheberrechts*, in KUNST IM MARKT – KUNST IM RECHT (Matthias Weller/Nicolai B. Kemle/Thomas Dreier (eds.), 2010), 75, 102–04; Katya Assaf, *Der Markenschutz und seine kulturelle Bedeutung: Ein Vergleich des deutschen mit dem US-amerikanischen Recht*, GEWERBLICHER RECHTSSCHUTZ UND URHEBERRECHT – INTERNATIONALER TEIL 1, 5 (2009); Ansgar Ohly, *Von einem Indianerhäuptling, einer Himmelsscheibe, einer Jeans und dem Lächeln der Mona Lisa*

made to prevent trademark protection for inventions and industrial designs,⁶⁸ the cumulation of copyright and trademark protection is often deemed unproblematic even though copyright law, like patent and industrial design legislation, only offers a limited period of protection and rests on a clear *quid pro quo*: in return for the grant of protection, the legislator expects an enrichment of the public domain at the end of the term of copyright protection.⁶⁹ This configuration of the copyright system is crucial to cultural follow-on innovation: the public domain of cultural expressions serves as a source of inspiration and basis of new creative efforts.

The grant of trademark rights, however, changes the conditions surrounding the creation of derivative works significantly. Once trademark rights are granted, the use of cultural heritage works that entered the public domain is no longer as free as it was before. Artists can no longer rely on complete freedom of use when they base their creations on public domain works. As long as public domain material remains unencumbered with intellectual property rights, the risk of a lawsuit arising from unauthorized use can be excluded from the outset. With the registration of cultural signs as trademarks, however, this freedom is sacrificed in favour of a scenario in which trademark rights can serve as a basis for an infringement action. If commercial players start investing in public domain artworks in order to acquire trademark rights, the climate change in respect of reuse and remix of cultural material is considerable. Hence, there are several reasons for being critical about trademark rights relating to signs with cultural significance: the blurring of the sign's cultural meaning through the attachment of commercial marketing messages, the impairment of an open communication process in the cultural domain and the impediment of cultural follow-on innovation.

– *Überlegungen zum Verhältnis zwischen Urheber- und Kennzeichenrecht, in GRUNDLAGEN UND GRUNDFRAGEN DES GEISTIGEN EIGENTUMS, FESTGABE FÜR DIETHELM KLIPPEL ZUM 65. GEBURTSTAG 203* (Louis Pahlow/Jens Eisfeld (eds.), 2008); Friedrich Klinkert & Florian Schwab, *Markenrechtlicher Raubbau an gemeinfreien Werken – ein richtungsweisendes „Machtwort“ durch den Mona Lisa-Beschluss des Bundespatentgerichts?* 101 *GEWERBLICHER RECHTSSCHUTZ UND URHEBERRECHT* 1067 (1999); Wilhelm Nordemann, *Mona Lisa als Marke, WETTBEWERB IN RECHT UND PRAXIS* 389 (1997).

⁶⁸ As already indicated, the vehicle to achieve this separation of protection regimes is the doctrine of technical and aesthetic functionality in trademark law. This is not to say that the functionality has not been criticized. For example, see Graeme B. Dinwoodie, *The Death of Ontology: A Teleological Approach to Trademark Law*, 84 *IOWA L. REV.* 611, 685–91 (1999); Annette Kur, *Too pretty to protect? Trademark Law and the Enigma of Aesthetic Functionality*, Max Planck Institute for Intellectual Property & Competition Law Research Paper No. 11–16, Munich: Max Planck Institute 2011, 6–12. The central point here is, however, that in practice, the application of the functionality doctrine has the effect of separating the protection regimes to a considerable extent.

⁶⁹ Cf. *Dastar v. Twentieth Century Fox*, 539 U.S. 23, 33–34 (2003).

A. Statements in Literature

Nonetheless, a rather uncritical view seems to prevail in the legal literature. The possibility of combining copyright and trademark protection is often mentioned without much commentary on potential risks for cultural follow-on innovation, or accepted on the ground that trademark rights do not offer protection for a cultural creation as such, but only for certain functions which the cultural creation fulfils as a distinctive sign in respect of goods and services to which it is attached.⁷⁰ Arguing in favour of an entitlement of rights owners to accumulate copyright and trademark protection, Tobias Cohen Jehoram, Constant van Nispen and Tony Huydecoper posit that

[i]n principle, there is no objection against cumulation or concurrence of trademark rights and copyrights and the benefits of the two protection regimes exist independently for the two rights. The proprietor of these rights satisfied all requirements stipulated by the different laws, so that there is no reason to limit the protection under one of the legal regimes for the sole reason that another legal protection exists.⁷¹

Besides this maximalist view which readily accepts the cumulation of rights as a corollary of formal eligibility for protection under copyright and trademark law, more nuanced approaches have also evolved in the debate. Annette Kur pointed out that the cumulation of different intellectual property rights could be deemed acceptable as long as the individual protection regimes involved were balanced in the sense that the prerequisites for obtaining protection were appropriately aligned with the contents and limits of exclusive rights.⁷² From this perspective, it is not the cumulation of rights that causes problems. By contrast, these problems are symptoms of imbalances within the protection systems involved.⁷³ If the prerequisites for obtaining different types of intellectual property rights remain distinct from each other, and the checks and balances in the different protection regimes are sufficient to prevent excessive protection, the overlap is unlikely to obstruct competition and should be deemed permissible.⁷⁴ If, however, the requirements for obtaining protection in different regimes converge while the contents and limits of protection remain unchanged, overlapping protection raises the problem of “asymmetric convergence” and requires appropriate

⁷⁰ Malte Stieper, *Geistiges Eigentum an Kulturgütern – Möglichkeiten und Grenzen der Remonopolisierung gemeinfreier Werke* 114 *GEWERBLICHER RECHTSSCHUTZ UND URHEBERRECHT* 1083, 1090–91 (2012); Alexander Peukert, *DIE GEMEINFREIHEIT* (2012) 111–13.

⁷¹ TOBIAS COHEN JEHORAM, CONSTANT J.J.C. VAN NISPEN & J.L.R. ANTHONY HUYDECOPER, *EUROPEAN TRADEMARK LAW* 556 (2010).

⁷² Annette Kur, *Funktionswandel von Schutzrechten: Ursachen und Konsequenzen der inhaltlichen Annäherung und Überlagerung von Schutzrechtstypen*, in *GEISTIGES EIGENTUM IM DIENST DER INNOVATION* (Gerhard Schricker, Thomas Dreier & Annette Kur (eds.), 2001) 23, 45 and 50.

⁷³ *Id.* at 45.

⁷⁴ *Id.* at 42–43.

countermeasures.⁷⁵ The acceptance of overlaps, thus, depends on a thorough scrutiny of the intellectual property systems involved. As long as a sufficient arsenal of legal safeguards against excessive protection are available—safeguards that are aligned with the prerequisites for obtaining protection—it is possible to afford intellectual property owners the opportunity to combine exclusive rights stemming from different protection regimes.

Turning to the spectrum of critical statements, the position taken by Feer Verkade is of particular interest. He expressed concerns about the corrosive effect of overlapping protection on the individual balance and structure of copyright and trademark law. Instead of affording rights owners the opportunity to always enjoy the “best of both worlds,” they should be bound to accept the “one world” offered by each individual law.⁷⁶ Hence, potentially indefinite trademark protection should not be available as a vehicle to undermine the limited term of copyright protection and the absence of formalities in copyright law should not allow the circumvention of the registration requirement in (Benelux) trademark law.⁷⁷ Seeking to prevent one protection regime from blurring the conceptual contours of the other, Verkade proposes to determine on a case-by-case basis whether the trademark or copyright aspect takes precedence.⁷⁸

The critical comments on trademark/copyright overlaps, finally, comprise proposals seeking to eliminate cumulative copyright and trademark protection for literary and artistic works altogether. A categorical rejection of the cumulation of rights can result from a strong preference for freedom of competition based on the public interest in the optimal use of intellectual resources and the encouragement of follow-on innovation after the expiry of the limited term of copyright protection.⁷⁹ If the constant enrichment and cultivation of the public domain is treated as an element of the *ordre public*, an amalgam of copyright and trademark rights which allows the continuation of trademark protection after copyright expiry can also be deemed impermissible because it withholds literary and artistic works from the public domain and causes a conflict with public order and morality.⁸⁰

⁷⁵ *Id.* at 43–44.

⁷⁶ D.W. Feer Verkade, *The Cumulative Effect of Copyright Law and Trademark Law: Which Takes Precedence?*, in INTELLECTUAL PROPERTY AND INFORMATION LAW – ESSAYS IN HONOUR OF HERMAN COHEN JEHORAM 69, 72 (J.J.C. Kabel & G.J.H.M. Mom (eds.), 1998).

⁷⁷ *Id.* at 72.

⁷⁸ *Id.* at 73.

⁷⁹ BENJAMIN RAUE, NACHAHMUNGSFREIHEIT NACH ABLAUF DES IMMATERIALGÜTERRECHTSSCHUTZES? (2010) 120–22 and 199–201.

⁸⁰ CASPAR VAN WOENSEL, MERK, GOD EN VERBOD (2007) 412–13; Klinkert & Schwab, *supra* note 67, 1073; Nordemann, *supra* note 67, 391; Ralph Osenberg, *Markenschutz für urheberrechtlich gemeinfreie Werkteile* 98 GEWERBLICHER RECHTSSCHUTZ UND URHEBERRECHT 101, 102–03 (1996).

B. Approach Taken in Practice

In practice, however, the courts seem reluctant to adopt positions leading to the separation of copyright and trademark protection.⁸¹ Even nuanced approaches, such as Verkade's proposal to determine the predominant protection aspect case-by-case, have not made their way into court decisions. Instead, judges seem to favour the uncritical attitude toward cumulative copyright and trademark protection that comes to the fore in many statements in the literature. In *Danjaq v. OHIM (Mission Productions)*, the General Court of the European Union (GCEU) clearly followed this uncritical approach.⁸² The case concerned an opposition brought by Danjaq—a holding company managing the copyright and trademark rights to characters and other material related to James Bond movies—against the attempt of the film production company Mission Production to register the sign “Dr. No” as a trademark in respect of film apparatus, recording discs, vehicles, leather goods, clothing and beverages. Dr. No is the title of the first James Bond film and the name of James Bond's antagonist. Danjaq's opposition was based on the argument that it was the proprietor of the earlier well-known marks “Dr. No” and “Dr. NO” and that it had acquired non-registered trademark and film title rights relating to the use of these signs to designate films, DVDs, videos, comic books, music recordings, books, posters and action figures.⁸³ Commenting on the possibility of copyright/trademark overlaps in this context, the Court pointed out that

[t]he same sign may be protected as an original creative work by copyright and as an indicator of commercial origin by trade mark law. It is therefore a matter of different exclusive rights based on distinct qualities, that is to say the original nature of a creation, on the one hand, and the ability of a sign to distinguish the commercial origin of the goods and services, on the other.⁸⁴

Hence, the Court readily accepted the protection overlap on the ground that trademark rights do not offer protection for a cultural creation as such, but only for certain functions which the cultural creation fulfils as a distinctive sign in respect of goods and services to which it is attached.⁸⁵ In this vein, the Court stated that “only signs which develop characteristic trade mark functions”⁸⁶ were eligible for trademark protection. It rejected trademark rights to “Dr. No” because the sign would be perceived as a mere descriptive reference to the film and not as an identifier of

⁸¹ Cf. Calboli, *supra* note 66, at 28–30.

⁸² GCEU, 30 June 2009, case T-435/05, ECLI:EU:T:2009:226, *Danjaq v. OHIM (Mission Productions)*, para. 26.

⁸³ *Id.* at paras. 2–3.

⁸⁴ *Id.* at para. 26.

⁸⁵ Stieper, *supra* note 70, at 1090–91; Peukert, *supra* note 70, at 111–13.

⁸⁶ GCEU, 30 June 2009, case T-435/05, ECLI:EU:T:2009:226, *Danjaq v. OHIM (Mission Productions)*, para. 26.

commercial source.⁸⁷ While an explicit confirmation of this position is still missing, CJEU decisions point in a similar direction. In *Gömböc*, the CJEU recalled that it was necessary to prevent indefinitely renewable trademark rights from “evergreening” other intellectual property rights with a limited term of protection.⁸⁸ This statement, however, did not inhibit the Court from concluding that “such an objective does not mean that EU intellectual property law prevents the coexistence of several forms of legal protection.”⁸⁹ Hence, there is room for holding that cumulative copyright and trademark protection is possible when a literary and artistic work has the distinctive character necessary to serve as a trademark. This, in turn, would confirm the GCEU approach regarding the overlap question as a matter of “different exclusive rights based on distinct qualities.”⁹⁰

Similar considerations play a role in national court decisions. The Dutch Supreme Court, for instance, traditionally permits the cumulative assertion of copyright and trademark claims.⁹¹ In recent decisions, the Court has added that a holder of rights under trademark and copyright law could invoke both rights simultaneously only if he had a distinct interest in the protection following from each individual right.⁹² However, this additional condition need not constitute a substantial hurdle. If the cumulation of rights is accepted on the ground that copyright protects a cultural creation as such, whereas trademark law protects specific trademark functions, it is easy to justify the assertion of trademark rights by pointing to the interest in preserving the trademark features of the intellectual creation concerned.⁹³ The Dutch Supreme Court relied on similar considerations to explain the acceptance of combined copyright and trademark claims.⁹⁴

The result is a rather low, if not negligible, threshold for the cumulation of copyright and trademark protection. If the difference between the purpose and configuration of the two protection regimes is already sufficient to justify overlapping rights, there seems to be no substantial obstacle to the assertion of cumulative protection in case of subject matter capable of constituting both an original work and a trademark. In any case, courts do not seem hesitant to hear claims based on cumulative copyright

⁸⁷ *Id.* at paras. 25–28.

⁸⁸ CJEU, 23 April 2020, case C-237/19, ECLI:EU:C:2020:296, *Gömböc*, para. 50. As explained above, the Court had already made this general point in CJEU, 18 September 2014, case C-205/13, ECLI:EU:C:2014:2233, *Hauck v. Stokke*, paras. 19–20.

⁸⁹ CJEU, 23 April 2020, case C-237/19, ECLI:EU:C:2020:296, *Gömböc*, para. 51.

⁹⁰ GCEU, 30 June 2009, case T-435/05, ECLI:EU:T:2009:226, *Danjaq v. OHIM* (Mission Productions), para. 26. Cf. CJEU, 23 April 2020, case C-237/19, ECLI:EU:C:2020:296, *Gömböc*, para. 53, which emphasizes the need to satisfy the distinctiveness requirement.

⁹¹ Dutch Supreme Court, 16 April 1999, case number 9098 (R97/163HR), *Nederlandse Jurisprudentie* 1999, no. 697, *Bigott-Batco/Doucal*, para. 3.9. Cf. COHEN JEHORAM, VAN NISPEN & HUYDECOPER, *supra* note 71, 556.

⁹² Dutch Supreme Court, 8 September 2006, case LJN AV3384, ECLI:NL:HR:2006:AV3384, *Benetton v. G-Star*, para. 3.11.

⁹³ *Stieper*, *supra* note 70, 1090–91; *Peukert*, *supra* note 70, 111–13.

⁹⁴ Dutch Supreme Court, 8 September 2006, case LJN AV3384, ECLI:NL:HR:2006:AV3384, *Benetton v. G-Star*, para. 3.11.

and trademark protection. Instead, they favour elastic tests of eligibility for a combined claim, such as the test of “different exclusive rights based on distinct qualities” used by the GCEU or the “distinct interest in protection” requirement introduced by the Dutch Supreme Court.

IV. RELIANCE ON CHECKS AND BALANCES IN TRADEMARK LAW

Looking for reasons for this approach, it may be said that judges seem to be confident that they can solve cases concerning cumulative copyright and trademark protection satisfactorily by employing the tools available in the respective protection regimes.⁹⁵ More concretely, they seem to assume that the checks and balances in trademark law are sufficient to prevent an encroachment upon the public domain of cultural expression and the artistic discourse potential of literary and artistic works. The registration requirement of distinctiveness, the impact of cultural significance on the infringement analysis and defences to trademark infringement claims play a central role in this context.

A. No Registration Because of Lack of Distinctiveness

To illustrate the reliance on the basic eligibility criterion of distinctiveness, the *Mona Lisa* decision of the German Federal Patent Court can serve as an example. The case concerned an attempt to register the famous da Vinci painting as a trademark for various goods ranging from perfume, clothing, leather goods, beverages and toys to film apparatus and recording disks.⁹⁶ Rejecting the application, the Court held that the applicant had failed to establish the requisite distinctiveness. Because the painting was frequently used by third parties in advertising, the public would regard the *Mona Lisa* as a mere advertising instrument rather than as an indication of source.⁹⁷ The Court also held that, because of the frequent use in advertising, the painting had become customary in established trade practices.⁹⁸ However, the Court was unwilling to accept the further argument that registration of the *Mona Lisa* was contrary to public policy or accepted principles of morality. In the Court’s view, the

⁹⁵ See also European Copyright Society, *Trademark 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* 39 EUROPEAN INTELLECTUAL PROPERTY REVIEW 457, 458–59 (2017), summarizing this practical approach.

⁹⁶ EFTA Court, 6 April 2017, case E-5/16, Municipality of Oslo (“Vigeland”), para. 29.

⁹⁷ German Federal Patent Court, 25 November 1997, case 24 W (pat) 188/96, *Mona Lisa, Gewerblicher Rechtsschutz und Urheberrecht* 1998, 1022.

⁹⁸ German Federal Patent Court, *id.* at 1023. For case comments, see Senftleben, *supra* note 67, at 102–04; Assaf, *supra* note 67, at 5; Ohly, *supra* note 67, at 203; Klinkert/Schwab, *supra* note 67, at 1067; Nordemann, *supra* note 67, at 389.

appropriation of the Mona Lisa on the basis of trademark law would not violate the principle that cultural expressions should remain freely available for the public after the expiry of copyright protection.⁹⁹ Instead of openly addressing the cultural and societal dimension of the trademark application, the German Federal Patent Court thus relied exclusively on the basic requirement of distinctiveness.

B. No Confusion Because of Cultural Significance

In the context of the infringement analysis, a sign's cultural significance can tip the scales against a finding of a likelihood of confusion. In the EU, this became apparent in *Ruiz Picasso and Others v. OHIM (Picasso/Picaro)* where the CJEU had to decide on an opposition to Daimler's application for registration of the sign PICARO for vehicles. The opposition had been lodged by the Picasso estate arguing that PICARO was likely to cause confusion with the earlier word mark PICASSO which it had registered for various goods, including vehicles.¹⁰⁰ Discussing the criteria for a finding of a likelihood of confusion in this context, the CJEU confirmed the first instance decision that in this particular case, conceptual differences between the PICASSO mark and the PICARO sign counteracted the low degree of visual and phonetic similarity.¹⁰¹ Conceptual differences could have this mitigating effect in cases where the meaning of at least one of the two signs was "clear and specific" so that the relevant public could grasp it immediately.¹⁰² As to the meaning of the PICASSO mark, the CJEU recalled the factual assessment of the first instance court which had found that

confronted with the word sign PICASSO, the relevant public inevitably sees in it a reference to the painter and that, given the painter's renown with that public, that particularly rich conceptual reference is such as greatly to reduce the resonance with which, in this case, the sign is endowed as a mark, among others, of motor vehicles.¹⁰³

Hence, the fact that the name "Picasso" is well known as a reference to the famous painter does not imply that the trademark PICASSO is highly distinctive and enjoys broad protection against confusion.¹⁰⁴ The painter's fame cannot simply be transferred to the trademark as an identifier of commercial source. By contrast, the well-known cultural meaning of the sign reduces the risk of confusion because its immediate impact on the perception of the public may outweigh visual and/or aural

⁹⁹ German Federal Patent Court, *id.* at 1023.

¹⁰⁰ CJEU, 12 January 2006, case C-361/04P, ECLI:EU:C:2006:25, *Ruiz Picasso and Others v. OHIM ("Picasso/Picaro")*, para. 5-6.

¹⁰¹ *Id.* at para. 20.

¹⁰² *Id.*

¹⁰³ *Id.* at paras 27.

¹⁰⁴ As to the rejection of this counterargument advanced by the Picasso estate, see CJEU, *id.* at para. 11 and 32.

similarities. A sign with a strong cultural connotation may thus constitute a weak trademark.¹⁰⁵

The decision of the U.S. Supreme Court in *Dastar v. Twentieth Century Fox* is a further example illustrating the use of the infringement provision to avoid an encroachment upon copyright policies. The case concerned a TV series based on General Eisenhower's World War II book "Crusade in Europe." Although Fox had obtained the copyright to the series first broadcast in 1949, it did not renew copyright in 1977 when the initial term of protection expired. In consequence, the original 1949 version entered the public domain. In 1988, Fox reacquired the television rights in the Crusade book.¹⁰⁶ When Dastar released a video set called "World War II Campaigns in Europe" in 1995, Fox brought an action based on § 43(a)(1)(A) of the Lanham Act – the unfair competition provision in the U.S. trademark statute, which by its terms offers protection against false representations of origin likely to cause confusion.¹⁰⁷ Fox argued that Dastar's 1995 version caused actionable confusion because Dastar had failed to give proper credit to the original Crusade TV series even though its 1995 video set was a shortened and edited version of the original 1949 production. In fact, the screen credits of "World War II Campaigns in Europe" only mentioned Dastar and Entertainment Distributing, a company owned by Dastar. Moreover, Dastar had listed its own employees as executive producers, producers, and associate producers.¹⁰⁸

Therefore, the central question before the U.S. Supreme Court concerned the concept of "origin of goods" underlying § 43(a)(1)(A). If the concept meant only the producer of the physical goods made available to the public, Dastar would have made no false representation because it was, in fact, the commercial origin of the 1995 videotapes. If, however, "origin" could be understood to also include the creator of the underlying literary and artistic work—the original 1949 "Crusade in Europe" version—Fox might have been able to argue that Dastar was misleading the public into believing that it was the origin of the cultural expression embodied in the videotapes.¹⁰⁹

Addressing this question, the Court took the dictionary meaning of origin—in the sense of the "source of wares"—as a starting point.¹¹⁰ It proceeded on the general assumption that consumers buying a branded product would not automatically assume that the company using the brand was the same entity that developed the idea for the product, or designed the product.¹¹¹ The Court recognized that in the case of communicative products (such as movies), consumers may in fact be concerned

¹⁰⁵ With regard to examples of cases where this occurred, see Assaf, *supra* note 67, at 2–3; Senftleben, *supra* note 67, at 101–02.

¹⁰⁶ *Dastar v. Twentieth Century Fox*, 539 U.S. 23, 26 (2003).

¹⁰⁷ For a discussion of the scope of the provision, see *id.* at 29–31.

¹⁰⁸ *Id.* at 27.

¹⁰⁹ *Id.* at 31.

¹¹⁰ *Id.*

¹¹¹ *Id.* at 32.

with knowing the creator of the content rather than the physical item at issue. But the Court considered that such a broadening of the origin concept underlying § 43(a)(1) (A) would cause a conflict between copyright and trademark law:

The problem with this argument according special treatment to communicative products is that it causes the Lanham Act to conflict with the law of copyright, which addresses that subject specifically. The right to copy, and to copy without attribution, once a copyright has expired, like “the right to make [an article whose patent has expired]—including the right to make it in precisely the shape it carried when patented—passes to the public.”¹¹²

Drawing this line between the rule of a limited term of protection in copyright law, the Court warned of the erosion of the “carefully crafted bargain” underlying copyright law: a bargain based on the enrichment of the public domain as a corollary of the enjoyment of protection.¹¹³ Against this background, acceptance of a cause of action under § 43(a)(1)(A) would create a “species of mutant copyright law that limits the public’s ‘federal right to “copy and to use”’ expired copyrights.”¹¹⁴ The result would be perpetual copyright protection causing imbalances in the system of intellectual property protection. The concept of “origin of goods” in U.S. trademark legislation, therefore, had to be interpreted as a reference to the “producer of the tangible goods that are offered for sale, and not to the author of any idea, concept or communication embodied in those goods.”¹¹⁵

C. Limitations Supporting Freedom of Expression

Even if *prima facie* infringement is found, use of trademarked cultural material may still be found permissible in the light of available defences, such as the defences of “due cause”¹¹⁶ and “referential use”¹¹⁷ that can be found in E.U. trademark legislation. For example, the *Lila Postkarte* case of the German Federal Court of Justice concerned the marketing of postcards that alluded ironically to trademarks and advertising campaigns of the chocolate producer Milka.¹¹⁸ On purple background corresponding to Milka’s abstract colour mark, the postcard sought to ridicule the nature

¹¹² *Id.* at 33.

¹¹³ *Id.* at 33–34.

¹¹⁴ *Id.* at 34.

¹¹⁵ *Id.* at 37.

¹¹⁶ See Trademark Directive 2008/95, art. 5(2); Recast Trademark Directive 2015/2436, art. 10(2)(c). The open-ended defence of “due cause” is only available in the area of protection of trademarks against dilution. As to relevant case law, see M.R.F. Senftleben, *The Perfect Match – Civil Law Judges and Open-Ended Fair Use Provisions*, 33 AM. UNIV. INT’L L. REV. 231, 256–65 (2017).

¹¹⁷ See Trademark Directive 2015/2436, art. 14(1)(c).

¹¹⁸ German Federal Court of Justice, 3 February 2005, case I ZR 159/02, “Lila Postkarte,” *Gewerblicher Rechtsschutz und Urheberrecht* 2005, 583.

idyll with cows and mountains that is evoked in Milka advertising.¹¹⁹ It showed the following poem attributed to “Rainer Maria Milka”:

Über allen Wipfeln ist Ruh/
irgendwo blökt eine Kuh/
Muh!¹²⁰

Assessing this ironic play with Milka insignia, the German Federal Court of Justice held that for the use of Milka trademarks to constitute relevant trademark use in the sense of E.U. trademark law, it was sufficient that the postcard called to mind the well-known Milka signs.¹²¹ Even though it was decorative, the use in question therefore gave rise to the question of trademark infringement.¹²² Accordingly, the German Federal Court of Justice embarked on a scrutiny of the trademark parody in the light of the dilution requirement of detriment to distinctive character or repute, or the taking of unfair advantage.¹²³ Weighing Milka’s concerns about a disparagement of the trademarks against the fundamental guarantee of the freedom of art, however, the Court concluded that the freedom of art had to prevail in light of the ironic statement made with the postcard.¹²⁴ The use of Milka trademarks was thus found to have taken place with “due cause” in the sense of the dilution provision.¹²⁵

Similar decisions may follow from the application of the defence of “referential use” which was broadened in the framework of the E.U. trademark law reform and is now laid down in Article 14(1)(c) of Trademark Directive 2015/2436.¹²⁶ As the *Lila Postkarte* decision shows, the requirement of “use as a trademark” is applied flexibly in the EU. It does not serve as a filter to exclude, from the outset, all instances where the trademark is not used in the traditional manner, i.e., to indicate the commercial source of the user’s own goods or services.¹²⁷ Instead, a mere reference to the trademark¹²⁸ and a mere link with goods or services may be sufficient to trigger an

¹¹⁹ *Id.*

¹²⁰ “It is calm above the tree tops, somewhere a cow is bellowing. Moo!” The attribution to ‘Rainer Maria Rilke’ is an allusion to the famous German writer Rainer Maria Rilke. *See id.*

¹²¹ *Id.* at 584.

¹²² *Id.* at 584–85.

¹²³ *Id.*

¹²⁴ *Id.*

¹²⁵ *Id.* at 585.

¹²⁶ As to the considerations underlying this legislative change, see ANNETTE KUR & MARTIN R.F. SENFTLEBEN, *EUROPEAN TRADEMARK LAW – A COMMENTARY* paras. 6.39–6.41 (2017).

¹²⁷ This stricter test, however, was mentioned with regard to the traditional identification function of trademarks in *Adam Opel*. *See* CJEU, 25 January 2007, case C-48/05, ECLI:EU:C:2007:55, *Adam Opel*, para. 24.

¹²⁸ CJEU, 23 October 2003, case C-408/01, ECLI:EU:C:2003:582, *Adidas v. Fitnessworld*, para. 39; CJEU, 10 April 2008, case C-102/07, ECLI:EU:C:2008:217, *Adidas v. Marca Mode*, para. 41.

infringement action.¹²⁹ In the light of the elastic standard developed by the CJEU, even decorative use of a trademark may amount to actionable trademark use.¹³⁰ This development is worrisome from the perspective of cultural follow-on innovation. As a result, where there has been remix or reuse of trademarked cultural symbols in the artistic domain, it is no longer sufficient to argue that the use takes place in a cultural context and, from the outset, does not constitute use “as a trademark.” The moment the use establishes a link with a trademarked cultural symbol, this defence strategy will fail.

If a reference to a trademarked cultural symbol is qualified as actionable use “as a trademark,” however, the broadened defence of referential use offers the unauthorized user the opportunity to argue that the reference to the trademark is the result of an honest practice of using the sign. In the case of use in the cultural domain, this line of reasoning finds support in Recital 27 of Trademark Directive 2015/2436 which explicitly states that

[u]se of a trademark by third parties for the purpose of artistic expression should be considered as being fair as long as it is at the same time in accordance with honest practices in industrial and commercial matters.¹³¹

V. CRITIQUE

At first glance, the checks and balances described above may appear sufficiently robust to dispel concerns about a corrosive effect of trademark rights on the artistic

¹²⁹ CJEU, 11 September 2007, case C-17/06, ECLI:EU:C:2007:497, *Céline*, paras. 21–23; CJEU, 19 February 2009, case C-62/08, ECLI:EU:C:2009:111, *UDV North America*, para. 47. The emphasis on the criterion of a mere link with the goods or services offered under a conflicting sign was confirmed in cases dealing with keyword advertising. See CJEU, 23 March 2010, joined cases C-236/08–238/08, ECLI:EU:C:2010:159, *Google and Google France*, para. 72; CJEU, 12 July 2011, case C-324/09, ECLI:EU:C:2011:474, *L’Oréal v. eBay*, para. 92. For a discussion of this development, see Martin R.F. Senftleben, *Adapting EU Trademark Law to New Technologies – Back to Basics?*, in *CONSTRUCTING EUROPEAN INTELLECTUAL PROPERTY* 137, 147–48 (Christophe Geiger (ed.), 2013).

¹³⁰ See CJEU, 23 October 2003, case C-408/01, ECLI:EU:C:2003:582, *Adidas v. Fitnessworld*, paras. 39–41, where the Court established an ambiguous test by holding that “the fact that a sign is viewed as an embellishment by the relevant section of the public is not, in itself, an obstacle to the protection conferred by Article 5(2) of the Directive where the degree of similarity is none the less such that the relevant section of the public establishes a link between the sign and the mark.” For decisions illustrating the weakness of the descriptive use defence in this context, see CJEU, 10 April 2008, case C-102/07, ECLI:EU:C:2008:217, *Adidas v. Marca Mode*, paras. 47–49; CJEU, 25 January 2007, case C-48/05, ECLI:EU:C:2007:55, *Adam Opel*, para. 44; German Federal Court of Justice, 24 November 2011, case I ZR 175/09, “*Medusa*,” *Gewerblicher Rechtsschutz und Urheberrecht* 2012, 618, paras. 19–20.

¹³¹ For a more detailed discussion of this point, see Jens Schovsbo, “*Mark My Words*” – *Trademarks and Fundamental Rights in the EU*, 8 U.C. IRVINE L. REV. 555 (2018).

discourse potential of cultural signs. However, a closer look at these safeguards reveals how fragile they are. It also shows the core problem underlying the debate: the traditional acceptance of trademark rights relating to cultural material is based on an understanding of trademarks as source identifiers and trademark rights as tools to ensure market transparency. After the remarkable broadening of the concept of “use as a trademark” in advanced trademark systems, such as the E.U. trademark system,¹³² and the explicit recognition of advertising, investment and communication functions as independent reasons for protection,¹³³ this traditional understanding no longer corresponds with the current scope and reach of trademark rights.¹³⁴

A. Registration Requirement of Distinctiveness

In the *Mona Lisa* case, the German Federal Patent Court relied on the basic requirement of distinctiveness and saw no need to invoke public policy and accepted principles of morality as further grounds for refusal. This focus on distinctiveness as primary gatekeeper has far-reaching consequences. The denial of the *Mona Lisa* registration because of a lack of distinctive character following from the painting’s widespread use in advertising is weak because non-distinctive, descriptive and generic signs can acquire the requisite distinctive character as a result of use in trade.¹³⁵ The decision of the German Federal Patent Court thus offers the chance of overcoming the registration obstacle through intensive use in product marketing and advertising. Once consumers have been taught to perceive the *Mona Lisa* as a source

¹³² For a more detailed discussion of this development, see KUR & SENFTLEBEN, *supra* note 126, at paras. 5.14–5.15, 5.49–5.56; Martin R.F. Senftleben, *Keyword Advertising in Europe – How the Internet Challenges Recent Expansions of EU Trademark Protection*, 27 U. CONN. J. INT’L L. 39 (2011). As to the recognition of a potential gatekeeper function of the trademark use requirement in U.S. law, see Stacey L. Dogan & Mark A. Lemley, *The Trademark Use Requirement in Dilution Cases*, 24 SANTA CLARA COMP. & HIGH TECH. L. J. 541, 542 (2008) (“By maintaining the law’s focus on misleading branding, the trademark use doctrine keeps trademark law true to its ultimate goal of promoting competitive markets.”) However, see also Graeme B. Dinwoodie & Mark D. Janis, *Confusion Over Use: Contextualism in Trademark Law*, 92 IOWA L. REV. 1597, 1657–58 (2007) (expressing doubt that problems arising in the current “expansionist climate” could be solved by recalibrating the notion of trademark use, and asserting that “[t]rademark use is simply too blunt a concept, no matter how defined, to capture the full range of values at play in these debates.”) For a summary of the U.S. debate, see Mark Davison & Frank Di Giandomasso, *Use as a Trademark: Avoiding Confusion When Considering Dilution*, 31 EUROPEAN INTELL. PROP. REV. 443 (2009); Mark P. McKenna, *Trademark Use and the Problem of Source*, 2009 ILL. L. REV. 773 (2009).

¹³³ CJEU, 18 June 2009, case C-487/07, ECLI:EU:C:2009:378, L’Oréal v. Bellure, para. 58. Cf. KUR & SENFTLEBEN, *supra* note 126, at paras. 1.12–1.39.

¹³⁴ ESTELLE DERCLAYE & MATTHIAS LEISTNER, *INTELLECTUAL PROPERTY OVERLAPS – A EUROPEAN PERSPECTIVE* 328 (2011).

¹³⁵ Trademark Directive 2008/95, art. 3(3); Trademark Directive 2015/2436, art. 4(4).

identifier referring to the trademark applicant, a registration of the famous painting becomes possible.¹³⁶

Viewed in this light, the *Mona Lisa* decision is unsatisfactory. While the German Federal Patent Court may have felt that the distinctiveness test is sufficient to keep signs with cultural significance free of trademark protection, the reliance on the basic protection requirement may have the opposite effect. Enterprises may regard the prospect of acquiring trademark rights as a result of use in trade as an invitation to invest in marketing and advertising activities based on cultural signs. They may strive to make a particular cultural heritage symbol part of the trademark experience they are offering to consumers. The mere possibility of acquiring trademark rights in consequence of use in trade may be sufficient to support business activities that lead to the removal of cultural material from the public domain instead of putting an end to attempts to obtain trademark rights to cultural creations.¹³⁷

This risk must not be underestimated. Literary or artistic works in the public domain have rich and positive connotations. Investing in the acquisition of trademark rights to such a work, an enterprise can benefit from the favourable image which the cultural material already has. Given the popularity of the sign, the process of brand image creation need not be started from scratch. The establishment of a link with the cultural work offers the chance of an image transfer that may outweigh the costs of advertising necessary to acquire distinctiveness through use in trade. The enhanced value to be gained once trademark protection is acquired may allow bigger investments than in regular cases of brand development—investments capable of setting aside the cultural renown and “particularly rich conceptual reference” which the CJEU qualified as an obstacle to a strong distinctive character in *Picasso*.¹³⁸

In addition, relying on distinctiveness to prevent acquisition of trademark rights in cultural material fails to cover the entire spectrum of cultural public domain material. The *Mona Lisa* case concerned a famous cultural symbol belonging to mankind’s universal cultural heritage. In the light of the popularity of the painting and its widespread use in advertising, the Court could reject the registration attempt on the grounds that the sign had become a customary marketing tool and constituted a non-distinctive, generic sign. In the case of cultural material that is not well-known,

¹³⁶ For a detailed discussion of this conditional character of a refusal based on a lack of distinctiveness, see Senftleben, *supra* note 4, at 783–84.

¹³⁷ Cf. Lotte Anemaet, *The Public Domain is Under Pressure: Why We Should Not Rely on Empirical Data When Assessing Trademark Distinctiveness*, 47 INT’L REV. INTEL. PROP. AND COMP. L. 303, 331–32 (2016); Senftleben, *supra* note 4, at 812–13; Lisa P. Ramsey, *Descriptive Trademarks and the First Amendment*, 70 TENN. L. REV. 1095, 1150 (2003); Robert C. Denicola, *Trademarks as Speech: Constitutional Implications of the Emerging Rationales for the Protection of Trade Symbols*, 1982 WISC. L. REV. 158, 170 (1982). See also the ECS, *supra* note 95, at 460–61.

¹³⁸ CJEU, 12 January 2006, case C-361/04P, ECLI:EU:C:2006:25, Ruiz Picasso and Others v. OHIM (“Picasso/Picaro”), para. 27. Cf. Artur-Axel Wandtke/Winfried Bullinger, *Die Marke als urheberrechtlich schutzfähiges Werk* GEWERBLICHER RECHTSSCHUTZ UND URHEBERRECHT 573, 578 (1997).

this line of argument is not available.¹³⁹ For example, the registration of a culturally important, but not widely known melody taken from a classical piece of music could hardly be rejected based on the argument that the sign has been used so frequently in a commercial context that consumers are unlikely to perceive it as a reference to an individual commercial source.¹⁴⁰ Moreover, distinctive character may be found when the goods or services, in respect of which trademark protection is sought, are unrelated to the cultural domain and the genuine meaning of a cultural symbol.

B. Impact of Cultural Significance on Infringement Analysis

In *Picasso*, the CJEU held that the renown of a cultural creation may constitute such a rich conceptual reference that it greatly reduces the recognition of the sign as a trademark.¹⁴¹ Hence, it seems that in the Court's view, cultural significance is a factor weighing against the assumption of a highly distinctive character. This, in turn, is a factor weighing against broad protection against confusion and excluding protection against dilution.

Nonetheless, it would be wrong to jump to the conclusion that trademark rights relating to cultural signs are generally unproblematic because the scope of protection against confusion and dilution will always remain limited. By contrast, the elasticity of distinctive character as a parameter for determining the scope of protection must be factored into the equation. A relatively weak trademark may be developed into a powerful brand over time. This is inherent in the configuration of trademark law. In addition, the acquisition of a considerable degree of distinctive character and a broad scope of trademark protection does not seem particularly difficult when a trademark consists of a sign that has cultural significance but is not widely known among the consuming public. A symbol, shape or melody stemming from a culturally important but relatively unknown work is unlikely to have a strong cultural connotation capable of weakening the recognition of the sign as an indication of commercial origin. Who thinks of Nike, the Greek goddess of victory, when seeing the trademark NIKE?¹⁴² Who is aware of culturally important signs of indigenous communities?

Given the relatively low threshold of reputation for acquiring anti-dilution protection in the E.U., there is also a substantial risk of unknown signs with cultural significance becoming eligible for enhanced protection against dilution. In contrast to the U.S. trademark system requiring recognition among the general consuming

¹³⁹ See Klinkert & Schwab, *supra* note 67, at 1068, who express similar concerns. Cf. Senftleben, *supra* note 67, at 103–04.

¹⁴⁰ Examples of this kind are not of a theoretical nature. In Germany, for instance, the beer producer Licher has consistently used “Solveig’s Song” from Edvard Grieg’s “Peer Gynt Suite” in advertising since the 1990s. See <https://www.youtube.com/watch?v=dfGGjkIQEeM>.

¹⁴¹ CJEU, 12 January 2006, case C-361/04P, ECLI:EU:C:2006:25, Ruiz Picasso and Others v. OHIM (“Picasso/Picaro”), para. 27.

¹⁴² With regard to these and further examples, see Assaf, *supra* note 67, at 2–3; Senftleben, *supra* note 67, at 101–02.

public, niche reputation is sufficient under E.U. trademark law.¹⁴³ For a trademark to constitute a mark with a reputation, it must be known by the target group of the goods or services marketed under the trademark. In the case of specific products, this target group may be a specialized public, such as traders in a specific sector. The required degree of knowledge is reached when the mark is known by a significant part of the relevant public.¹⁴⁴

Once reputation is established, E.U. trademark law offers anti-dilution protection covering blurring, tarnishment and unfair free-riding in competitive and non-competitive situations.¹⁴⁵ The evidence to be produced need not necessarily include proof of a change in the economic behaviour of consumers.¹⁴⁶ For a claim based on the taking of unfair advantage, it suffices to argue that “a third party attempts, through the use of a sign similar to a mark with a reputation, to ride on the coat-tails of that mark.”¹⁴⁷ Moreover, the CJEU refuses to consider the need to keep protected signs freely available in the context of the infringement analysis. In

¹⁴³ Cf. Martin R.F. Senftleben, *The Trademark Tower of Babel – Dilution Concepts in International, US and EC Trademark Law*, 40 INT’L REV. INTELL. PROP. AND COMP. L. 45, 50–55 (2009); J. Thomas McCarthy, *Dilution of a Trademark: European and United States Law Compared*, 94 TRADEMARK REP. 1163 (2004); Barton Beebe, *A Defense of the New Federal Trademark Antidilution Law*, 16 FORDHAM INTELL. PROP., MEDIA & ENT. L. J. 1143, 1157 (2006).

¹⁴⁴ CJEU, 14 September 1999, case C-375/97, ECLI:EU:C:1999:408, *General Motors*, paras. 24 and 26. In respect of the territorial expansion required, see *id.* at para. 28; CJEU, 6 October 2009, case C-301/07, ECLI:EU:C:2009:611, *Pago International*, para. 29.

¹⁴⁵ Trademark Directive 2015/2436, art. 10(2)(c). Cf. CJEU, 9 January 2003, case C-292/00, ECLI:EU:C:2003:9, *Davidoff*. As to the scope of protection offered in cases of marks having a reputation, see particularly CJEU, 18 June 2009, case C-487/07, ECLI:EU:C:2009:378, *L’Oréal v. Bellure*, and the comments by Martin R.F. Senftleben, *Trademark Protection – A Black Hole in the Intellectual Property Galaxy?*, 42 INT’L REV. INTELL. PROP. AND COMP. L. 383 (2011); Ansgar Ohly, *Keyword-Advertising auf dem Weg von Karlsruhe nach Luxemburg*, GWERBLICHER RECHTSSCHUTZ UND URHEBERRECHT 709, 711–12 (2009).

¹⁴⁶ This test applies in cases of blurring and tarnishment. See CJEU, 27 November 2008, case C-252/07, ECLI:EU:C:2008:655, *Intel Corporation*, para. 77; CJEU, 14 November 2013, case C-383/12 P, ECLI:EU:C:2013:741, *Environmental Manufacturing v. OHIM*, para. 37. Cf. KUR & SENFTLEBEN, *supra* note 126, para. 5.223–5.228; Adrien Bouvel, *Marques et renommée: À propos de l’arrêt “Intel” rendu par la Cour de justice des communautés européennes le 27 novembre 2008 (aff. C-252/07)*, in LES DÉFIS DU DROIT DES MARQUES AU XXI^E SIÈCLE (Christophe Geiger/Ioanna Schmidt-Szalewski (eds.), 2010) 123; Antoon A. Quaedvlieg, *INTEL en verwatering: Economisch gedrag en juridisch bewijs*, BIJBLAD BIJ DE INDUSTRIËLE EIGENDOM 253 (2009); Antoon A. Quaedvlieg, *Herkomst- en goodwillinbreuk in het merkenrecht na INTEL en l’Oréal*, ARS AEQUI 799 (2009); Susie Middlemiss and Steven Warner, *The Protection of Marks with a Reputation: Intel v CPM*, 31 EUROPEAN INTELL. PROP. REV. 326, 331–32 (2009).

¹⁴⁷ CJEU, 18 June 2009, case C-487/07, ECLI:EU:C:2009:378, *L’Oréal v. Bellure*, para. 49. For a critical comment on intuitive protection against free-riding as a species of unjust enrichment law, see Mark A. Lemley & Mark P. McKenna, *Owning Mark(ets)*, 109 MICH. L. REV. 137 (2010).

Adidas v. Marca Mode, the Court explained that it was clear that the requirement of availability was

extraneous both to the assessment of the degree of similarity between the mark with a reputation and the sign used by the third party and to the link which may be made by the relevant public between that mark and the sign.¹⁴⁸

In addition to these developments in the field of specific infringement criteria, current E.U. trademark law is an example of an advanced trademark system in which inherent limits of exclusive rights, such as the requirements of “use in the course of trade” and “use in relation to goods or services” have lost much of their potential to contain access to trademark protection from the outset. As already indicated above, the requirement of use in relation to goods or services is applied flexibly by the CJEU. In principle, this general prerequisite for obtaining protection could be applied to confine the scope of trademark rights to instances where the senior user’s trademark is employed by a junior user as an identifier of commercial source with regard to its own goods or services. Following this approach, the requirement of trademark use could serve as a filter to exclude claims that are unrelated to the identification and distinction of goods and services from the outset. Considerable breathing space for freedom of use in a cultural context could be created in this way.¹⁴⁹

However, the CJEU takes the opposite approach, weakening the trademark use requirement instead of sharpening its conceptual contours. As explained, the Court even expressed the view that, for satisfying the requirement of trademark use, it was sufficient that a mere link was established with the trademark.¹⁵⁰ In consequence, the purported threshold of establishing trademark use does not prevent trademark owners from successfully pursuing third party uses that are not—and are not intended to be—perceived as indications of commercial source. On the contrary, referential use

¹⁴⁸ CJEU, 10 April 2008, case C-102/07, ECLI:EU:C:2008:217, *Adidas v. Marca Mode*, para. 43.

¹⁴⁹ For a discussion of the concept of trademark use in E.U. trademark law, see KUR & SENFTLEBEN, *supra* note 126, paras. 5.14–5.15 and 5.49–5.56; Annette Kur, *Confusion over Use? – Die Benutzung “als Marke” im Lichte der EuGH-Rechtsprechung*, GWERBLICHER RECHTSSCHUTZ UND URHEBERRECHT – INTERNATIONALER TEIL 1, 11 (2008); Paul J. Yap, *Essential Function of a Trademark: From BMW to O2*, 31 EUROPEAN INTELL. PROP. REV. 81, 86–87 (2009); Ilanah Simon Fhima, *How Does “Essential Function” Doctrine Drive European Trademark Law?*, 36 INT’L REV. INTELL. PROP. AND COMP. LAW 401 (2005); Patricia L. Loughlan, *Protecting Culturally Significant Uses of Trademarks (Without a First Amendment)*, 22 EUROPEAN INTELL. PROP. REV. 328 (2000). For a fundamental critique of the continuous expansion seeking to reduce the scope of trademark protection to the traditional origin function, see moreover Peukert, *supra* note 70, at 96–107.

¹⁵⁰ CJEU, 23 October 2003, case C-408/01, ECLI:EU:C:2003:582, *Adidas v. Fitnessworld*, para. 39; German Federal Court of Justice, 3 February 2005, case I ZR 159/02, “Lila Postkarte,” *Gewerblicher Rechtsschutz und Urheberrecht* 2005, 583, 584–85.

is brought within the reach of the exclusive rights of trademark owners.¹⁵¹ The impact of this broad concept on use for cultural purposes is considerable. As described above, even decorative use that merely calls to mind the protected trademark may give rise to an infringement action.

Surveying these developments, it can be said that the inherent limits of exclusive trademark rights—use in the course of trade, use as a trademark, use likely to cause confusion and use likely to cause dilution—have become elastic and unreliable safeguards of freedom of use for cultural purposes. In many cases of use in a cultural context, it will be difficult to rule out the threat of a trademark claim on the basis of these infringement criteria.¹⁵²

C. Limitations of Trademark Rights Insufficient

This finding gives rise to the question whether the defences in trademark law are sufficient to eliminate the risk of a corrosive effect on the artistic discourse potential of cultural signs. Given the described elasticity of infringement criteria in advanced trademark systems, the risk of infringement can no longer be ruled out. This legal uncertainty is likely to have a deterrent effect on cultural follow-on innovation even if artists can rely on a defence, such as the E.U. defences of “due cause” or “referential use.” In various areas of creative activity, concerns have been articulated about a growing fear of artists being sued for intellectual property infringement because of the reuse of pre-existing cultural material that still enjoys protection.¹⁵³ These fears can have a chilling effect on creativity and cultural diversity. An artist seeking to avoid potential lawsuits will refrain from the creation of works based on pre-existing material or limit takings from pre-existing material to an absolute minimum.¹⁵⁴ Therefore, the legal uncertainty arising from the elastic application of trademark

¹⁵¹ Cf. KUR & SENFTLEBEN, *supra* note 126, at paras. 5.50–5.54; Derclaye & Leistner, *supra* note 134, at 328.

¹⁵² Cf. Irene Calboli, *Overlapping Rights: The Negative Effects of Trademarking Creative Works*, in THE EVOLUTION AND EQUILIBRIUM OF COPYRIGHT IN THE DIGITAL AGE 52, 52–54 (Susy Frankel & Daniel J. Gervais (eds.), 2014); Derclaye & Leistner, *supra* note 134, at 328.

¹⁵³ Sakulin, *supra* note 6, at 292–93; McGeeveran, *supra* note 6, at 1206–07, 1224–25; Jesse A. Hofrichter, *Tool of the Trademark: Brand Criticism and Free Speech Problems with the Federal Dilution Revision Act of 2006*, 28 CARDOZO L. REV. 1923, 1926 (2007); James Gibson, *Risk Aversion and Rights Accretion in Intellectual Property Law*, 116 YALE L.J. 882, 913 (2007); Cohen, *supra* note 5, at 156; PATRICIA AUFDERHEIDE & PETER JASZI, UNTOLD STORIES: CREATIVE CONSEQUENCES OF THE RIGHTS CLEARANCE CULTURE FOR DOCUMENTARY FILMMAKERS 29–30 (2004); LAURENCE LESSIG, FREE CULTURE: HOW BIG MEDIA USES TECHNOLOGY AND THE LAW TO LOCK DOWN CULTURE AND CONTROL CREATIVITY 185–88 (2004).

¹⁵⁴ Arpan Banerjee, *Non-Origin Infringement – Has Trademark Law Gone Too Far?*, 43 INT’L REV. INTELL. PROP. AND COMP. L. 555, 564 (2012); David M. Morrison, *Bridgeport Redux: Digital Sampling and Audience Recoding*, 19 FORDHAM INTELL. PROP., MEDIA AND ENT. L. J. 75, 131–36 (2008); Hofrichter, *supra* note 153, at 1926; Cohen, *supra* note 5, at 154–56; TERESA M. AMABILE, CREATIVITY IN CONTEXT 115–20, 231–32 (1996).

infringement criteria leads to a climate that is not conducive to new cultural productions. Instead, it is likely to impoverish new cultural productions in terms of creative inputs.

In many cases, artists will not have sufficient confidence and financial resources to take the risk of a lengthy lawsuit, such as the above-described case *Lila Postkarte* which finally required a decision of the German Supreme Court. If Disney sends a cease-and-desist letter stating that a given form of using Mickey Mouse amounts to trademark infringement, this will often suffice to put an end to the use in a cultural context.¹⁵⁵

The deterrent effect that arises from legal uncertainty surrounding a permitted use of protected material has explicitly been recognized by the German Federal Constitutional Court (Supreme Court in matters of constitutional law) discussing the constitutional guarantee of artistic freedom of expression in *Metall auf Metall*. The decision was triggered by the jurisprudence which the German Federal Court of Justice (Supreme Court in matters of civil law) had developed with regard to sound sampling. The underlying lawsuit had been brought by the iconic German electronic music pioneers Kraftwerk. They asserted copyright and phonogram producer rights against the unauthorized use of a rhythmic sound fragment of two seconds which served as the basis of a continuous rhythmic sequence in Sabrina Setlur's song "Nur mir." The sound fragment stemmed from the piece "Metall auf Metall" in Kraftwerk's 1977 album "Trans Europa Express."

In the national decisions in the *Metall auf Metall* saga¹⁵⁶ that preceded prejudicial questions and the *Pelham* ruling of the CJEU,¹⁵⁷ the German Federal Court of

¹⁵⁵ For a more detailed discussion of the chilling effect of cease-and-desist strategies, see Calboli, *supra* note 66, at 31–32; McGeeveran, *supra* note 6, at 1206–07; LESSIG, *supra* note 152, at 185–88.

¹⁵⁶ For a more detailed discussion of the *Metall auf Metall* decisions in Germany, see Rupprecht Podszun, *Postmoderne Kreativität im Konflikt mit dem Urheberrechtsgesetz und die Annäherung an "fair use"*, ZEITSCHRIFT FÜR URHEBER- UND MEDIENRECHT 606, 606–12 (2016); Matthias Leistner, *Die "Metall auf Metall"-Entscheidung des BVerfG – Oder: Warum das Urheberrecht in Karlsruhe in guten Händen ist*, GEWERBLICHER RECHTSSCHUTZ UND URHEBERRECHT 772, 772–77 (2016); Neil Conley & Tom Braegelmann, *Metall auf Metall: the Importance of the Kraftwerk Decision for the Sampling of Music in Germany*, 56 J. COPYRIGHT SOC'Y OF THE U.S.A. 1017 (2009); F. Jay Dougherty, *RIP, MIX and BURN: Bemerkungen zu aktuellen Entwicklungen im Bereich des digitalen Sampling nach US-amerikanischem und internationalen Recht*, GEWERBLICHER RECHTSSCHUTZ UND URHEBERRECHT – INTERNATIONALER TEIL 481 (2007).

¹⁵⁷ CJEU, 29 July 2019, case C-476/17, ECLI:EU:C:2019:624, *Pelham and Others*, paras. 29–31. For a more detailed description of the German decisions and a discussion of the CJEU decisions, see Martin R.F. Senftleben, *Flexibility Grave – Partial Reproduction Focus and Closed System Fetishism in CJEU, Pelham*, 51 INT'L REV. INTEL. PROP. AND COMP. L. 751 (2020); Christophe Geiger & Elena Izyumenko, *The Constitutionalization of Intellectual Property Law in the EU and the Funke Medien, Pelham and Spiegel Online Decisions of the CJEU: Progress, but Still Some Way to Go!*, 51 INT'L REV. INTEL. PROP. AND COMP. L. 282 (2020); Thom Snijders & Stijn van Deursen, *The Road Not Taken – the CJEU Sheds Light on the Role of Fundamental Rights in the European Copyright Framework – a Case Note on*

Justice had held that sound sampling fell outside the scope of permitted free use and amounted to infringement of the neighbouring right of the phonogram producer if the unauthorized user was capable of producing the desired sound fragment himself.¹⁵⁸ In a further decision, the Court had specified that this criterion required an assessment of whether a sound producer with average equipment and talent, at the time of unauthorized use, would have been capable of producing an own recording which, from the perspective of the target audience, could be qualified as equal to the original sound fragment.¹⁵⁹

The German Federal Constitutional Court found that this assessment criterion encroached upon the guarantee of free artistic expression because it created too much legal uncertainty. The Court expressed the fear that

even in cases where the production of an equal recording is not possible, artistic creators may refrain from use—which, in this case, would be permissible in the opinion of the German Federal Court of Justice—because the effort necessary to provide evidence of missing own production options and the legal risk appear too big. The criterion based on the feasibility of producing an equal sound thus has a deterrent effect which requires a particularly efficient control in the light of constitutional law.¹⁶⁰

Hence, the deterrent effect that arises from legal uncertainty surrounding a permitted use must be factored into the equation. The legal uncertainty surrounding the invocation of available defences, such as “due cause” and “referential use,” is relevant to the assessment. It is not sufficient that the statutory law provides for defences and that judges are willing to hear arguments based on these defences. It must also be considered whether artistic creators may nevertheless refrain from permissible use because the re-appropriation of an artwork as such leads to the acquisition of trademark rights and involves the risk of an infringement action. Even if courts may finally manage to arrive at reasonable solutions in cases involving use of trademarked cultural material, the fundamental difference remains that legal uncertainty about a potential trademark claim is surrounding the use of affected literary and artistic works once trademark rights are awarded. The risk of potential trademark infringement is hanging above use made of trademarked cultural creations like the sword of Damocles.

the Pelham, Spiegel Online and Funke Medien Decisions, 50 INT’L REV. INTELL. PROP. 1176 (2019); Matthias Leistner, “Ende gut, alles gut” ... oder “Vorhang zu und alle Fragen offen”? Das salomonische Urteil des EuGH in Sachen “Pelham [Metall auf Metall]”, *GEWERBLICHER RECHTSSCHUTZ UND URHEBERRECHT* 1008 (2019); Ansgar Ohly, *Hip Hop und die Zukunft der “freien Benutzung” im EU-Urheberrecht – Anmerkungen zum Vorlagebeschluss des BGH “Metall auf Metall III”*, *GEWERBLICHER RECHTSSCHUTZ UND URHEBERRECHT* 964 (2017).

¹⁵⁸ German Federal Court of Justice, 20 November 2008, case I ZR 112/06, “Metall auf Metall I,” *Gewerblicher Rechtsschutz und Urheberrecht* 2009, 403, para. 15.

¹⁵⁹ German Federal Court of Justice, 13 December 2012, case I ZR 182/11, “Metall auf Metall II,” *Gewerblicher Rechtsschutz und Urheberrecht* 2013, 614, para. 16.

¹⁶⁰ German Federal Constitutional Court, 31 May 2016, case 1 BvR 1585/13, “Sampling,” *Gewerblicher Rechtsschutz und Urheberrecht* 2016, 690, para. 100.

VI. REFORM PROPOSAL

Against this background, it seems advisable to strike at the root of the problem and pave the way for stricter access control that prevents the acquisition of trademark rights to signs with cultural significance from the outset.¹⁶¹ To effectively ban the risk of impeding the open, dialogic communication process in the artistic domain, it is necessary to go beyond distinctiveness-based grounds for refusal and develop more robust mechanisms to arrive at an outright exclusion of signs with cultural significance from trademark protection.¹⁶²

A. Functionality Doctrine Not Sufficient

Despite the results that have been achieved with regard to the separation of trademark protection from patent and industrial designs protection, the functionality doctrine in trademark law does not seem an appropriate vehicle to also achieve this goal in respect of literary and artistic works. Admittedly, aesthetic functionality offers a more robust ground for refusal than a rejection based on a lack of distinctiveness because it cannot be overcome through use in trade.¹⁶³ In respect of products that incorporate an artwork, such as decorative items and furniture, considerations of aesthetic functionality can lead to an effective ban on trademark protection. However, a trademark application seems immune from a refusal based on aesthetic functionality when it is argued that the cultural signs concerned would only be attached to the goods as a label.¹⁶⁴ If merely used as a label, a cultural sign can hardly be found to be functional.¹⁶⁵ Otherwise, the brand value which the sign represents in the form of the label would be sufficient to assume aesthetic functionality. This, in turn, would lead to a circular line of reasoning and the exclusion of any sign with brand value

¹⁶¹ For a more detailed discussion of this point, see SENFTLEBEN, *supra* note 5, at 326–392; Anemaet, *supra* note 137, at 331–32; Calboli, *supra* note 66, at 34; Calboli, *supra* note 152, at 76–78; Senftleben, *supra* note 4, at 816–17, 823–25. With regard to the field of traditional knowledge and traditional cultural expressions, see Susy R. Frankel, *Third-Party Trademarks as a Violation of Indigenous Cultural Property – A New Statutory Safeguard*, J. WORLD INTELL. PROP. 83 (2005); Susy R. Frankel, *Trademarks and Traditional Knowledge and Cultural Intellectual Property Rights*, in TRADEMARK LAW AND THEORY: A HANDBOOK OF CONTEMPORARY RESEARCH 433 (Graeme B. Dinwoodie/Mark D. Janis (eds.), 2008), discussing the concept of “cultural offence” in New Zealand and a *sui generis* protection regime that would offer grounds for opposition under trademark law.

¹⁶² For an earlier exploration, see Senftleben, *supra* note 4, 825.

¹⁶³ With regard to E.U. legislation, this has explicitly been confirmed. See, e.g., CJEU, 18 June 2002, case C-299/99, ECLI:EU:C:2002:377, Philips v. Remington, para. 75.

¹⁶⁴ For an example of this line of reasoning, see German Federal Court of Justice, 24 April 2008, case I ZB 21/06, Marlene-Dietrich-Bildnis, *Gewerblicher Rechtsschutz und Urheberrecht* 2008, 1093, para. 19–22; German Federal Court of Justice, 31 March 2010, case I ZB 62/09, Marlene-Dietrich-Bildnis II, *Gewerblicher Rechtsschutz und Urheberrecht* 2010, 825, paras. 20–28.

¹⁶⁵ Cf. Ohly, *supra* note 157, 328.

from trademark protection. For example, the attachment of the Coca Cola logo to soft drinks would also lead to an exclusion of trademark rights because the brand value of the logo adds substantial value to the product.¹⁶⁶ Therefore, use as a label necessarily falls outside the scope of an outright exclusion of trademark protection based on considerations of aesthetic functionality. The same may be said about the use of a melody with cultural significance as a sound mark for goods. As the sign is not incorporated in the product itself, the doctrine of aesthetic functionality is not applicable as a tool to exclude trademark rights.

B. Public Order and Morality

This insight brings other grounds for refusal into focus. In particular, an effective separation of copyright and trademark protection for signs with cultural significance could follow from the invocation of public order and morality.¹⁶⁷ A refusal based on these grounds leads to an outright exclusion of trademark protection that cannot be overcome through use in trade and is not confined to situations where a sign with cultural significance constitutes a decisive element of the goods themselves. With regard to the further development of this ground for refusal, the *Vigeland* decision of the EFTA Court is of particular interest.¹⁶⁸

In the *Vigeland* case,¹⁶⁹ the EFTA Court was called upon to assess an attempt by the city of Oslo 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.¹⁷⁰ Among other works, the application filed by the Municipality of Oslo 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. To support its registration request, the city argued that

¹⁶⁶ Cf. England and Wales Court of Appeal, 1 November 2017, *London Taxi Corporation*, [2017] EWCA Civ 1729, *Gewerblicher Rechtsschutz und Urheberrecht – Internationaler Teil* 2018, 150, para. 75 (Justice Floyd); *Automotive Gold/Volkswagen of America*, 457 F.3d 1062, 1073–74 (9th Cir. 2006).

¹⁶⁷ EU law provides for this absolute ground for refusal in European Union Trade Mark Regulation 2017/1001, art. 7(1)(f) EUTMR and Trademark Directive 2015/2436, art. 4(1)(f) TMD. In the context of the international rules on *telle quelle* protection, the Paris Convention, art. 6quinquies(B) No. 2 and 3, reflects the possibility of cancelling a trademark registration when the sign concerned has become generic, or when it is contrary to morality or public order.

¹⁶⁸ The EFTA Court is the Supreme Court in matters concerning the interpretation of the Agreement on the European Economic Area with regard to the EFTA States Iceland, Liechtenstein and Norway. See <http://www.eftacourt.int/>.

¹⁶⁹ EFTA Court, 6 April 2017, case E-5/16, *Municipality of Oslo (“Vigeland”)*. For commentary, see Annette Kur, “Gemeinfreiheit und Markenschutz – Bemerkungen zur Entscheidung des EFTA-Gerichtshofs im *Vigeland-Fall*”, *Gewerblicher Rechtsschutz und Urheberrecht* 2017, 1082.

¹⁷⁰ EFTA Court, *id.*, para. 20. Gustav Vigeland died on 12 March 1943.

[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.¹⁷¹

With this argument, 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.¹⁷² Instead of rejecting 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 any decision on these grounds for refusal.¹⁷³

Addressing this question, the EFTA Court contributed to the further development of public policy and principles of morality as grounds for refusal by clearly distinguishing its two branches. In the Court's view, 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.¹⁷⁴

As to the subjective criterion of a conflict with accepted principles of morality, the Court underlined the necessity of examining on a case-by-case basis how the relevant public would perceive the sign at issue. In line with previous E.U. case law,¹⁷⁵ the Court posed the question whether Vigeland's works—in and of themselves—would be considered offensive by reasonable consumers with average sensitivity and tolerance thresholds.¹⁷⁶ Quite clearly, this question could be answered in the negative.¹⁷⁷ 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 trademark 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

¹⁷¹ Report for the Hearing, Judge-Rapporteur Baudenbacher, 5 October 2016, case E-5/16, Municipality of Oslo ("Vigeland"), para. 32.

¹⁷² EFTA Court, 6 April 2017, case E-5/16, Municipality of Oslo ("Vigeland"), para. 27.

¹⁷³ *Id.* at paras. 28–30.

¹⁷⁴ *Id.* at paras. 84–86.

¹⁷⁵ For an overview, see Christophe Geiger/Leonardo Machado Pontes, *Trademark Registration, Public Policy, Morality and Fundamental Rights*, Centre for International Intellectual Property Studies Research Paper No. 2017-01, Strasbourg: CEIPI 2017, 8–11; KUR & SENFTLEBEN, *supra* note 126, paras. 4.205–4.218; ECS, *supra* note 95, 459–60.

¹⁷⁶ EFTA Court, 6 April 2017, case E-5/16, Municipality of Oslo ("Vigeland"), paras. 89–90 and 93.

¹⁷⁷ *Id.* at para. 91.

or the message communicated through the artwork in question. Therefore, the possibility cannot be ruled out that trademark 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.¹⁷⁸

This addition is remarkable. With this statement, the EFTA Court departs 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 an artwork* as offensive.¹⁷⁹ Thus, the EFTA Court substantially broadened the field of application of the ground for refusal. While in the past the offensive nature of the sign was decisive, the offensive nature of the registration attempt offers an alternative avenue for a refusal in the view of the EFTA Court. In consequence, the assessment must take into account the status or perception of the artwork in the relevant national context and the nature of the goods or services for which registration as a trademark has been applied, “such that registration must be refused if the work is being misappropriated.”¹⁸⁰

As to the second branch of the ground for refusal—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.”¹⁸¹ 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.¹⁸²

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*.¹⁸³ Hence, the Court confirmed that not only the nature of the sign at issue but also the registration attempt as such could be sufficient to justify a refusal based on accepted principles of morality. The scope of the ground for refusal was thus broadened substantially.

Admittedly, the morality and public order criteria which the EFTA Court developed contain several open-ended assessment factors. Without case law that clarifies

¹⁷⁸ *Id.* at para. 92.

¹⁷⁹ *Id.*

¹⁸⁰ *Id.* at para. 93.

¹⁸¹ *Id.* at paras. 94–96.

¹⁸² *Id.* at para. 96.

¹⁸³ *Id.* at para. 96.

which “particular status”¹⁸⁴ is necessary for invoking morality and which “genuine and serious threat”¹⁸⁵ is required for applying public order reasoning, it will be difficult to foresee which literary and artistic works are excluded from trademark protection. This legal uncertainty, however, poses an obstacle to enterprises seeking to register an artwork as a trademark. It creates a lasting risk factor which a company cannot manipulate by investing in marketing campaigns that educate consumers to perceive a cultural creation as a badge of origin. In contrast to the fragile test of distinctiveness, the application of public order and morality as grounds for refusal creates a sword of Damocles that is permanently hanging above branding strategies that affect artworks.¹⁸⁶

Moreover, every decision to deny trademark protection because of a conflict with public order or morality creates maximum legal certainty with regard to the cultural sign concerned. Applying the *Vigeland* criteria, the Norwegian Board of Appeal for Industrial Property Rights qualified Oslo’s 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.¹⁸⁷ This final word in the *Vigeland* case makes it clear for every artist in Norway that *Vigeland*’s works are in the public domain and remain in the public domain. Hence, these works can be remixed and reused in an open, dialogic communication process in the artistic domain without any exposure to trademark infringement claims and without any predominance of one particular speaker who has a stronger position than others in the debate because of exclusive trademark rights.

VII. CONCLUSION

The time is ripe to recalibrate the copyright/trademark interface. Instead of relying on distinctiveness as a threshold criterion and volatile checks and balances within trademark law, more robust mechanisms should be developed to exclude the acquisition of trademark rights to cultural signs from the outset – grounds for refusal that apply across all goods and services and cannot be overcome through use in trade. In the *Vigeland* decision, the EFTA Court took important steps in this direction. The Court provided exemplary lines of argument that can support an exclusion of trademark protection on the basis of public policy or accepted principles of morality.

¹⁸⁴ *Id.* at para. 92.

¹⁸⁵ *Id.* at para. 96.

¹⁸⁶ For a detailed discussion of the different morality and public order arguments following from the *Vigeland* decision, see SENFTLEBEN, *supra* note 5, at 347–372.

¹⁸⁷ 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, available at <https://kfir.no>.

Moreover, considerations of public policy and principles of morality, as interpreted by the EFTA Court, offer trademark offices and courts room to clearly articulate cultural concerns in the context of a rejection of trademark protection. With the *Vigeland* decision, it becomes possible to state candidly that trademark law is not intended to serve as a basis for free-riding on the reputation and positive image of cultural symbols, the erosion of an artwork's artistic discourse potential as a result of exposure to commercial marketing strategies, and the impairment of the unhindered, open communication process surrounding the sign in the cultural domain. The *Vigeland* decision is thus an important step in the right direction.¹⁸⁸

However, the *Vigeland* decision also shows the limits of this approach. The application of public policy or principles of morality as grounds for refusal must not lead to an automatic rejection of all literary and artistic works. The EFTA Court makes it clear that “the fact that an artwork has previously enjoyed copyright protection may not in itself form the basis for refusing trademark registration.”¹⁸⁹ In particular, no threat to the need to safeguard the public domain can be found in the case of works that were primarily created to serve as signs to be registered as trademarks (where cumulative copyright and trademark protection is merely incidental).¹⁹⁰

This caveat brings a crucial point for future research into focus. What exactly is cultural significance? How to identify those signs that must be kept outside the realm of trademark law for the cultural reasons described above? Quite clearly, this question is beyond the scope of the present analysis.¹⁹¹ In the light of the societal importance of unhindered cultural follow-on innovation, however, it seems clear that the definition of cultural significance must not be overly restrictive. Signs belonging to mankind's universal cultural heritage, such as the Mona Lisa, obviously reach a degree of cultural importance that requires their exclusion from trademark protection.

However, it is also necessary to ensure that the public domain of cultural expression does not become outdated over time. The freedom to reuse and remix artworks without exposure to the risk of trademark infringement should not be confined to works belonging to a public domain that resembles an antiquated monolith of fascinating ideas and expressions of ancient times. By contrast, it must be ensured that contemporary, fresh cultural material also becomes freely available for artistic creativity when the term of copyright protection comes to an end. From this perspective, contemporary cultural icons, such as Mickey Mouse, also reach a degree of cultural significance that makes it desirable to exclude them from trademark protection. For art to fulfill the societal function described in the aesthetic theories of Schiller and Adorno—the unmasking of unsatisfactory societal conditions—it must be free to use

¹⁸⁸ Martin R.F. Senftleben, *Vigeland and the Status of Cultural Concerns in Trade Mark Law – The EFTA Court Develops More Effective Tools for the Preservation of the Public Domain*, 48 INT'L REV. INTEL. PROP. AND COMP. L. 683, 716–17 (2017).

¹⁸⁹ EFTA Court, 6 April 2017, case E-5/16, Municipality of Oslo (“*Vigeland*”), para. 88.

¹⁹⁰ *Id.* at paras. 97–98.

¹⁹¹ For a more detailed discussion of different categories of signs with cultural significance, see SENFTLEBEN, *supra* note 5, at 105–129.

not only classical literary and artistic works but also symbols of modern mainstream culture.

Therefore, the robust exclusion instruments advocated here should cover both situations: simultaneous cumulation of copyright and trademark rights following from modern merchandising strategies that leads to trademark rights that survive the expiry of copyright protection (Mickey Mouse), and subsequent trademark protection following from the re-appropriation of cultural public domain material that removes affected cultural creations from the public domain and leads to trademark rights that restrict the (previously unbridled) freedom of use (Mona Lisa).