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# Robustness Check: Evaluating and Strengthening Artistic Use Defences in EU Trademark Law

Martin Senftleben

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**Abstract** The 2015 EU trademark law reform introduced a peculiar rule for reconciling trademark rights with freedom of artistic expression. According to Recital 21 EUTMR and Recital 27 TMD, artistic use can be deemed fair as long as the artist ensures compliance with “honest practices in industrial and commercial matters”. The honest practices proviso forges a link with the provisions on limitations of trademark rights. Article 14(1) EUTMR and Art. 14(1) TMD exempt from the control of trademark proprietors several types of use that can allow for artistic use. All these limitations, however, apply only when the use satisfies the test of honest practices. Confirming the obligation to comply with honest practices in industrial and commercial matters, the fairness rule of Recital 21 EUTMR and Recital 27 TMD turns out to be a double-edged sword. Instead of readily immunizing artistic use against trademark claims, it obliges artists to rely on limitations of trademark rights and furnish corresponding proof. Moreover, artists are expected to align their artistic activity with behavioural standards in the field of industry and commerce – a realm that is alien to the artistic community. Evidently, this approach endangers artistic autonomy. To avoid detrimental effects on artistic expression, it is advisable to strengthen the position of artists and develop a legal solution that resembles the measures taken in Art. 9(3)(f) EUTMR and Art. 10(3)(f) TMD with regard to freedom of commercial expression. Drawing inspiration from cultural sciences and case law on both sides of the Atlantic, the analysis explores avenues for achieving this goal.

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## 1 Introduction

In the EU, trademark examiners and judges must find the right balance between trademark protection on the one hand, and freedom of expression on the other. Legislative developments and the jurisprudence of the Court of Justice of the European Union (CJEU) leave no doubt about this overarching task.<sup>1</sup> In *Constantin Film Produktion/EUIPO* (“*Fack Ju Göhte*”), the General Court expressed the view that there was, “in the field of art, culture and literature, a constant concern to preserve freedom of expression that does not exist in the field of trade marks”.<sup>2</sup> The CJEU corrected this statement by pointing out that:

contrary to the General Court’s finding [...], freedom of expression, enshrined in Article 11 of the Charter of Fundamental Rights of the European Union, must [...] be taken into account when applying Article 7(1)(f) of Regulation No 207/2009.<sup>3</sup>

The CJEU added that, more generally, EU trademark law had to be applied “in such a way as to ensure full respect for fundamental rights and freedoms, in particular freedom of expression”.<sup>4</sup>

The Court was able to derive this insight from legislative developments. In the framework of the 2015 trademark law reform,<sup>5</sup> several new rules have been introduced that regulate the relationship between trademark protection and specific forms of freedom of expression. With regard to comparative advertising – a specific form of commercial expression – Art. 9(3)(f) of the European Union Trade Mark Regulation (EUTMR)<sup>6</sup> and Art. 10(3)(f) of the Trade Mark Directive (TMD)<sup>7</sup>

<sup>1</sup> As to the literature discussion on the need to strike a proper balance between trademark rights and freedom of expression, see Senftleben (2020), pp. 135–138; Izyumenko (2020), pp. 440–446; Bohaczewski (2020), p. 856; Żelechowski (2018), pp. 115–135; Jacques (2016), p. 479; Senftleben (2015), p. 354; Ramsey and Schovsbo (2013), p. 671; Simon Fhima (2013), p. 293; Sakulin (2010), pp. 247–282; Geiger (2010), p. 163; Burrell and Gangjee (2010), p. 544; Nasser (2009), p. 188; Assaf (2008), p. 56; Geiger (2007), p. 317; Ramsey (2010), p. 405; Weckström (2007), p. 671; Gulasekaram (2005), p. 887; Leval (2004), p. 187; Dreyfuss (1990), pp. 415–418.

<sup>2</sup> GCEU, 24 January 2018, case T-69/17, *Constantin Film Produktion v. EUIPO* (“*Fack Ju Göhte*”), para. 29.

<sup>3</sup> CJEU, 27 February 2020, case C-240/18P, *Constantin Film v. EUIPO* (“*Fack Ju Göhte*”), para. 56.

<sup>4</sup> CJEU, *id.*, para. 56.

<sup>5</sup> At the end of 2015, the reform led to the trademark norms enshrined in the current versions of the EUTMR and the TMD. As to the underlying preparatory work in the area of limitations of trademark rights, see Knaak et al. (2011), pp. 117–124.

<sup>6</sup> Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union Trade Mark (codification), OJ 2017 L 154, p. 1.

<sup>7</sup> Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trade marks, OJ 2015 L 336, p. 1.

provide for a particularly robust solution that makes infringement claims against legitimate forms of comparative advertising futile from the outset. Stipulating that unauthorized use in comparative advertising is only actionable if it is contrary to the rules laid down in the Directive on Misleading and Comparative Advertising (MCAD),<sup>8</sup> Art. 9(3)(f) EUTMR and Art. 10(3)(f) TMD impose the burden of proving non-compliance with one of the advertising requirements on the trademark proprietor.<sup>9</sup> If the trademark owner fails to produce sufficient evidence, it will be unable to establish *prima facie* infringement. The claim will thus be dismissed without there being any need for the advertiser to invoke a limitation of trademark protection. This regulatory design can be seen as a corollary of the freedom of lawful comparative advertising that the CJEU recognized in *O2/Hutchison* and *L'Oréal/Bellure*.<sup>10</sup> In line with these decisions, use in comparative advertising that fulfils the MCAD requirements is exempted from the control of the trademark proprietor altogether.

If EU trademark law achieves this robust result in respect of a specific form of commercial expression, one might expect similar measures with regard to freedom of artistic expression. In the human rights analysis following from the jurisprudence of the European Court of Human Rights,<sup>11</sup> freedom of commercial expression carries less weight than freedom of artistic or political expression.<sup>12</sup> Therefore, measures to safeguard artistic expression should be at least as effective as those adopted to allow for commercial freedom of expression.<sup>13</sup> As the burden of proof rests on the trademark owner in the case of comparative advertising, it would be consistent to take the same step with regard to artistic activities that involve trademarks.

Unfortunately, however, things are less clear in the area of artistic expression. Instead of equipping artists with a solid shield against allegations of trademark infringement, the 2015 law reform only led to the adoption of a peculiar guideline for reconciling trademark protection with freedom of artistic expression. Recital 21 EUTMR and Recital 27 TMD stipulate that:

<sup>8</sup> Directive 2006/114/EC of the European Parliament and of the Council of 12 December 2006 Concerning Misleading and Comparative Advertising (codified version), OJ 2006 L 376, p. 21.

<sup>9</sup> Kur and Senftleben (2017), paras. 5.308–5.309.

<sup>10</sup> CJEU, 12 June 2008, case C-533/06, *O2 v. Hutchison*, para. 45; CJEU, 18 June 2009, case C-487/07, *L'Oréal v. Bellure*, para. 54. Cf. Kur and Senftleben (2017), para. 5.308.

<sup>11</sup> For an overview of criteria and the interplay between CJEU and ECtHR jurisprudence, see Geiger and Izyumenko (2020), pp. 292–302.

<sup>12</sup> As to the recognition of the fundamental freedom of expression with regard to commercial speech, see ECtHR, 22 May 1990, app. No. 12726/87, *Autronic v. Switzerland*, para. 47. With regard to the wider margin of appreciation in cases concerning commercial freedom of expression, see ECtHR, 20 November 1989, app. No. 10572/83, *Markt Intern Verlag GmbH and Klaus Beermann v. Germany*, paras. 26 and 32–38.

<sup>13</sup> As to the elevated status of freedom of artistic expression, see Geiger and Izyumenko (2020), pp. 293–294. Cf. ECtHR, 24 May 1988, app. No. 10737/84, *Müller and Others v. Switzerland*, para. 27; ECtHR, 8 July 1999, app. No. 23168/94, *Karataş v. Turkey*, paras. 49–52; CJEU, 29 July 2019, case C-476/17, *Pelham and Others*, para. 34.

[u]se of a trade mark 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.

Considering the reference to “honest practices in industrial and commercial matters”, this fairness rule seems to supplement the provisions on limitations of trademark rights. Article 14(1) EUTMR and Art. 14(1) TMD exempt several types of use from the control of trademark proprietors, including forms of use that may become relevant in the context of artistic expression. Article 14(1)(c) EUTMR and Art. 14(1)(c) TMD permit so-called “referential use” without prior authorization of the trademark owner. Article 14(1)(b) EUTMR and Art. 14(1)(b) TMD prevent the trademark owner from invoking trademark rights against descriptive use and non-distinctive use. All these limitations of trademark rights, however, apply only when the use complies with the general requirement of “honest practices in industrial or commercial matters”. This horizontal requirement is laid down in Art. 14(2) EUTMR and Art. 14(2) TMD.

Evidently, the EU legislator found it unnecessary to adopt a rule that, like Art. 9(3)(f) EUTMR and Art. 10(3)(f) TMD in the area of comparative advertising, immunizes artistic forms of expression from the outset by making it particularly difficult for trademark owners to establish *prima facie* infringement. Instead of imposing the burden on trademark proprietors to demonstrate non-compliance with standards of fairness and honesty in the field of art and culture, the guideline given in Recital 21 EUTMR and Recital 27 TMD seems to reflect the opposite approach: the artist is forced into a defensive position and obliged to prove compliance with standards of honesty in industrial and commercial matters.

Putting artists and artistic expression at a disadvantage compared with advertisers and commercial expression, EU trademark law raises several questions that need to be inspected more closely. First, it is conceivable that, in the case of artistic use, trademark owners will hardly ever be able to build a valid *prima facie* case of infringement anyway.<sup>14</sup> If this were true, there would be no need to develop a specific rule shielding artists from infringement claims. However, an analysis of central gatekeeper criteria that could thwart infringement claims from the outset, in particular use “in the course of trade” and “in relation to goods or services”,<sup>15</sup> shows that artists seek sufficient legal certainty – in the sense of a major obstacle to trademark actions – in vain (Sect. 2 below). Considering this result, it is important to clarify, as a second step, whether defences ensuing from the limitation of trademark rights with regard to referential, descriptive and non-distinctive use can be deemed sufficiently robust while artists must ensure compliance with honest practices in industrial and commercial matters (Sect. 3). As the honest practices proviso poses several practical difficulties and forces artists to align their creative choices with behavioural standards in the field of industry and commerce, the answer to this question can hardly be in the affirmative (Sect. 4). Third, it must therefore be clarified whether the guideline given in Recital 21 EUTMR and Recital 27 TMD

<sup>14</sup> Bohaczewski (2020), pp. 864–867; Ohly (2019), p. 334; Kur (2017), p. 1086; Loughlan (2000), p. 328.

<sup>15</sup> Article 9(2) EUTMR; Art. 10(2) TMD.

with regard to the fairness and permissibility of artistic use can be construed in a way that removes disadvantages for artists and offers them a legal position that is comparable with the robust position of advertisers that comply with MCAD rules (Sect. 5). The discussion of these questions will lead to the insight that a bias in favour of artistic expression – in the sense of a legal presumption of non-infringement that the trademark owner must rebut – should be introduced into EU trademark law (concluding Sect. 6).

## 2 Gatekeeper Requirements for Infringement Claims

In the absence of a rule that explicitly shifts the burden of proof in favour of artists, like Art. 9(3)(f) EUTMR and Art. 10(3)(f) TMD in the area of comparative advertising, general infringement criteria may still have a comparable immunizing effect against trademark infringement claims. In particular, gatekeeper requirements, such as use in the course of trade (Sect. 2.1) and in relation to goods or services (Sect. 2.2), could thwart trademark actions from the outset when they are applied in a way that makes it particularly difficult for trademark owners to demonstrate an actionable form of use in the case of artistic expression.<sup>16</sup> Unfortunately, however, under the *aegis* of the CJEU, the gatekeeper requirements in EU trademark law have lost their potential to put an end to infringement actions at an early stage (Sect. 2.3). As a result of this development, artists are exposed to infringement claims that cannot readily be dismissed as invalid (Sect. 2.4).

### 2.1 Use in the Course of Trade

The exclusive rights granted in EU trademark law are confined to use “in the course of trade”.<sup>17</sup> Therefore, use is actionable only where it occurs “in the context of commercial activity with a view to economic advantage and not as a private matter”.<sup>18</sup> This formula developed by the CJEU leads to a distinction between private and commercial spheres. The condition of use in the course of trade draws an important boundary line between the private exclusive rights of the trademark proprietor on the one hand, and the entitlement of the general public to freely use protected marks in non-commercial contexts on the other. It confines EU trademark rights to use that takes place in a commercial context. The use of a trademark for the purposes of private study, political debate, teaching or academic research is unlikely to constitute use in the course of trade as long as it does not have a commercial background. If use for cultural purposes, such as the creation of an artwork that includes elements protected by trademark law, does not enter the commercial sphere, any interference with artistic expression is thus unlikely.<sup>19</sup>

<sup>16</sup> Bohaczewski (2020), pp. 864–867; Ohly (2019), p. 334; Kur (2017), p. 1086; Loughlan (2000), p. 328.

<sup>17</sup> Article 9(2) EUTMR and Art. 10(2) TMD.

<sup>18</sup> CJEU, 23 March 2010, cases C-236/08 to 238/08, *Google France and Google*, para. 50; CJEU, 12 November 2002, case C-206/01, *Arsenal v. Reed*, para. 40.

<sup>19</sup> Żelechowski (2018), pp. 118–119.

Given the elasticity of the formula of use “in the context of commercial activity with a view to economic advantage and not as a private matter”,<sup>20</sup> however, the test of use in the course of trade constitutes a low threshold. Use of a trademark in a cultural context will be qualified as use in trade the moment it is combined with a commercial activity.<sup>21</sup> Case law concerning the marketing of T-shirts or postcards with statements critical of trademarked products or policies of the trademark proprietor can serve as examples.<sup>22</sup> New developments in the artistic field, such as the use of fashion items enjoying trademark protection in non-fungible token (NFT) artworks<sup>23</sup> or “upcycling” projects,<sup>24</sup> provide further illustrations. The moment a cultural sign is placed in a commercial context, the assumption of use in the course of trade will be inescapable. Surveying similar developments in the U.S., Katya Assaf concludes that “even types of speech traditionally considered non-commercial, such as magazines, books, movies and stand-up comedies, often become subject to scrutiny and restriction because of violation of trademark rights”.<sup>25</sup>

Cultural activities, however, require not only freedom to create new works on the basis of pre-existing material, but also freedom to bring these new works to the attention of the public and create a market for them. In this vein, it is recognized, in the context of the fundamental guarantee of freedom of expression and freedom of art, that sufficient scope must be provided not only for the creation of art but also for its marketing. In Germany, for instance, it is established case law of the Federal Constitutional Court that the freedom of art

protects artistic activity itself (the “work produced” [“Werkbereich”]), but also the presentation and dissemination of the artwork, which are essential in

<sup>20</sup> CJEU, C-236/08–238/08, *Google France and Google*, para. 50; CJEU, C-206/01, *Arsenal v. Reed*, para. 40.

<sup>21</sup> Cf. Izyumenko (2020), pp. 415–416; Bohaczewski (2020), p. 861; Żelechowski (2018), pp. 119–120.

<sup>22</sup> For instance, see German Federal Supreme Court, 3 February 2005, case I ZR 159/02, *Lila Postkarte*, GRUR 2005, p. 583; French Supreme Court, 8 April 2008, case 06-10961, *Greenpeace v. Esso*; French Supreme Court, 8 April 2008, case 07-11251, *Greenpeace v. Areva*. For commentary, see Kur and Senftleben (2017), paras. 6.59–6.70; Jacques (2016), pp. 471–472 and 479; Geiger (2007), p. 317.

<sup>23</sup> For example, see the NFT artwork “Baby Birkin” by Mason Rothschild and Eric Ramirez, available at <https://basic.space/auctions/baby-birkin>, which led to allegations of trademark infringement. See <https://brandwrit.es.law/hermes-accuses-artist-of-infringing-trade-mark-over-metabirkins/> and (last visited: 15 March 2022).

<sup>24</sup> “Upcycling” refers to “the process of transforming by-products, waste materials, useless, or unwanted products into new materials or products perceived to be of greater quality, such as artistic value or environmental value”. See <https://en.wikipedia.org/wiki/Upcycling>. In a trademark context, upcycling that uses second hand (luxury) garments as raw materials for new artistic creations is of particular relevance. Transforming used pieces of clothing into new fashion products that may become even more luxurious and sought-after than the source material, the process of artistic fashion upcycling adds value to used garments instead of merely recycling them. For example, see the creations by Duran Lantink, available at <https://duranlantink.com/ssaw21> (last visited: 15 March 2022). For a more detailed discussion of trademark implications, cf. Kur (2021), pp. 228–236.

<sup>25</sup> Assaf (2008), p. 56.

order for the public to encounter the work (the “effect produced” [“Werkbereich”]).<sup>26</sup> (original German words inside square brackets added)

Hence, it would be wrong to confine the debate on the potential impediment of artistic expression to the creation of literary and artistic works. It is not sufficient that artists enjoy the freedom of using trademarked material in their ateliers or studios. The guarantee of freedom of expression and freedom of art requires that artists also be free to sell and promote their artwork.<sup>27</sup> This, in turn, implies that the boundary line between non-actionable private use and actionable use in the course of trade is not sufficient to dispel concerns about an encroachment upon artistic expression. The basic infringement criterion of “use in the course of trade” does not constitute a strong enough safeguard to declare trademark rights unproblematic in an artistic context.

## 2.2 Use as a Trademark

In addition to the general infringement requirement of “use in the course of trade”, EU trademark law also requires use “in relation to goods or services”.<sup>28</sup> In principle, this further prerequisite for protection could be understood to require “use as a trademark”. It may be applied to confine the scope of trademark rights to instances where another’s trademark is employed as an identifier of commercial source in relation to one’s own goods or services.<sup>29</sup> Following this approach, access to trademark protection could be contained from the outset.<sup>30</sup> The gatekeeper requirement of use “in relation to goods or services” – understood in the sense of “use as a trademark” – would serve as a filter to exclude claims that are unrelated to the identification and distinction of goods and services.

When seeking to prevent trademark rights from posing an obstacle to artistic expression, this approach to the requirement of use in relation to goods or services can play a crucial role.<sup>31</sup> In a cultural context, a sign is used for the purpose of expressing thoughts and ideas. Normally, the public will not perceive individual artistic expression as an indication of commercial source aiming at the identification and distinction of goods and services. As the decision of the Higher Court of Appeals of Dresden in *Johann Sebastian Bach* shows, this line of reasoning – based

<sup>26</sup> German Federal Constitutional Court, 31 May 2016, case 1 BvR 1585/13, “*Sampling*”, para. 68. English translation available at: [https://www.bundesverfassungsgericht.de/e/rs20160531\\_1bvr158513en.html](https://www.bundesverfassungsgericht.de/e/rs20160531_1bvr158513en.html). The same point is made in German Federal Constitutional Court, 13 June 2007, case 1 BvR 1783/05, “*Roman Esra*”, BVerfGE 119, pp. 1 (21–22); German Federal Constitutional Court, 17 July 1984, case 1 BvR 816/82, “*Anachronistischer Zug*”, BVerfGE 67, p. 213 (224); German Federal Supreme Court, 21 February 2019, case I ZR 98/17, “*HHole (for Mannheim)*”, GRUR 2019, p. 609, para. 35.

<sup>27</sup> Cf. Peukert (2016), pp. 424–425.

<sup>28</sup> Article 9(2) EUTMR and Art. 10(2) TMD.

<sup>29</sup> CJEU, 25 January 2007, case C-48/05, *Opel v. Autec*, para. 24, pointed in this direction. The course adopted in this judgment, however, was not followed in further decisions.

<sup>30</sup> Dinwoodie and Janis (2007), pp. 1599–1600; Dogan and Lemley (2004), pp. 809–811.

<sup>31</sup> Bohaczewski (2020), pp. 864–867; Ohly (2019), p. 334; Kur (2017), p. 1086; Loughlan (2000), p. 328.

on a strict requirement of “use as a trademark” – allows courts to create considerable breathing space for the use of trademarked signs in an artistic context.

The case concerned the registration of the name and portrait of Johann Sebastian Bach as a trademark for various goods and services, including glassware, porcelain and crockery.<sup>32</sup> While the trademark proprietor had not commenced using the sign itself, it systematically asserted its trademark rights against users referring to Johann Sebastian Bach.<sup>33</sup> As the trademark registration had not been obtained until 1999, it seems to have been the trademark owner’s intention to exploit Bach’s name and portrait during the anniversary year 2000 (Bach died on 28 July 1750). In addition to the Johann Sebastian Bach registration, the trademark proprietor had also registered signs relating to Michelangelo, Leonardo da Vinci, Paul Gauguin and Paul Cézanne.<sup>34</sup> Given this portfolio of cultural signs, there were clear indications of an exploitation strategy based on “cultural heritage grabbing”.

The case decided by the Higher Court of Appeals of Dresden, however, was not brought by the owner of the Johann Sebastian Bach trademarks. Instead, the Meissen porcelain manufactory sought a declaration that the trademark proprietor was not entitled to prevent Meissen from using Bach’s name and portrait as decorative elements on glassware, porcelain and crockery. Having received a cease-and-desist letter, the Meissen factory wanted clarity about the scope of the trademark rights that had been asserted against product lines that referred to the famous composer. Considering the facts of the case, the Court saw clear indications that the signs concerning Johann Sebastian Bach had been registered for the sole purpose of using the legal position ensuing from the grant of trademark rights to prevent use by others and forcing the latter to enter into licensing agreements – without any true intention on the part of the trademark owner to use the signs as source identifiers itself.<sup>35</sup> Nonetheless, the Court felt that there was no room for assuming an abuse of rights. Regardless of clear indications that the Bach trademarks were owned by a trademark “troll”, the fact remained that the German Patent and Trade Mark Office had registered the name and portrait of the composer and had granted trademark rights. As the trademark had been registered in 1999 and the case was decided in 2000, an obligation to put the trademarks to genuine use had not arisen yet. Instead, the trademark proprietor could rely on the possibility of acquiring trademark rights in the EU on the basis of mere registration – with the requirement of genuine use becoming an issue only five years after completion of the registration procedure.<sup>36</sup> The fact that the trademark owner had not developed plans for the use of the Bach signs to create or preserve an “outlet for the goods or services”<sup>37</sup> was thus insufficient to justify the verdict of abuse of

<sup>32</sup> Higher Court of Appeals of Dresden, 4 April 2000, case 14 U 3611/99, “*Johann Sebastian Bach*”, *N/W* 2001, p. 615 (616).

<sup>33</sup> Götting (2001), p. 615, refers to parallel cases where the plaintiff sought to prohibit the sale of a Johann Sebastian Bach anniversary champagne and Johann Sebastian Bach souvenir articles.

<sup>34</sup> Götting (2001), p. 615.

<sup>35</sup> Higher Court of Appeals of Dresden, *id.*, p. 617.

<sup>36</sup> Article 15(1) EUTMR; Art. 16(1) TMD.

<sup>37</sup> CJEU, 11 March 2003, case C-40/01, *Ansul v. Ajax*, para. 37.

rights.<sup>38</sup> Instead, the Higher Court of Appeals of Dresden was bound by the registration decision taken by the German Patent and Trade Mark Office.<sup>39</sup>

Against this background, the case had to be solved on the basis of the applicable infringement criteria. As already indicated, the general requirement of use in relation to goods or services – understood in the sense of use as a trademark – played a decisive role in this context. The Court held that, insofar as the Meissen porcelain manufactory dealt with the composer Johann Sebastian Bach in an artistic manner, the basic requirement of use as a trademark was not fulfilled and the use did not amount to infringement.<sup>40</sup> The Court based this conclusion on the assumption that use as a trademark required the attachment of Bach’s name or portrait to goods for the purpose of distinguishing them from others of a different commercial origin. In the case of an artistic discussion of historical events or historical persons, however, the name or portrait would not be used – in the Court’s view – to identify the commercial source of goods. Hence, the use would not serve the purpose of distinguishing them from other goods with a different origin and would not amount to actionable use as a trademark. By contrast, a risk of confusion could be ruled out. In an artistic context, the consuming public would not perceive the Bach name and portrait as trademarks used to distinguish goods or services.<sup>41</sup>

The Higher Court of Appeals of Dresden thus created room for artistic use by relying on the requirement of use as a trademark and interpreting this requirement strictly – in the sense of a requirement of use for the purpose of indicating the commercial origin of goods. The Court did not address other trademark functions that the CJEU recognized later.<sup>42</sup> As the decision in *Johann Sebastian Bach* dates back to the year 2000, it is not surprising that the Dresden Court did not include communication, investment and advertising functions in its assessment of “use as a trademark”.<sup>43</sup> Instead, the Court added normative considerations. It stated that trademark law should not be employed in an inconsistent manner to prevent an artistic discussion of the person of Johann Sebastian Bach, who had become part of the universal cultural heritage because of his musical works. Moreover, the protection of trademarks should not lead to a “re-monopolization” of public domain works, such as the Bach portrait painted by Elias Gottlob Haussmann.<sup>44</sup>

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<sup>38</sup> In *Sky*, the CJEU confirmed in the context of the bad faith analysis that trademark applicants were not required “to indicate or even to know precisely” what use they would make of the mark in the five-year period following registration. See CJEU, 29 January 2020, case C-371/18, *Sky and Others*, para. 76. Cf. Senfileben (2020), pp. 407–410.

<sup>39</sup> Higher Court of Appeals of Dresden, *id.*, pp. 617–618.

<sup>40</sup> Higher Court of Appeals of Dresden, *id.*, p. 616.

<sup>41</sup> Higher Court of Appeals of Dresden, *id.*, p. 616.

<sup>42</sup> CJEU, 18 June 2009, case C-487/07, *L’Oréal v. Bellure*, para. 58.

<sup>43</sup> These accessory trademark functions have been recognized in later CJEU decisions. See in particular CJEU, 18 June 2009, case C-487/07, *L’Oréal v. Bellure*, para. 58.

<sup>44</sup> Higher Court of Appeals of Dresden, *id.*, p. 616.

### 2.3 Erosion of Gatekeeper Requirements in CJEU Jurisprudence

However, the resoluteness of the Higher Court of Appeals of Dresden in *Johann Sebastian Bach* must not conceal the fact that the strict interpretation applied of the requirement of use as a trademark – in the sense of use for the purpose of distinguishing goods of the alleged infringer from others of a different commercial origin – has not been confirmed in subsequent CJEU jurisprudence. Therefore, it would be wrong to conclude on the basis of the *Johann Sebastian Bach* decision that the basic infringement criterion of “use as a trademark” eliminates the risk of an impediment to artistic expression from the outset because use in an artistic context will hardly ever be qualified as actionable trademark use.

At the time of the *Johann Sebastian Bach* decision, the status and scope of the requirement of use as a trademark was unclear at EU level. The adoption of the first Trade Mark Directive 89/104/EEC and the Community Trade Mark Regulation 40/94 had harmonized EU trademark law. However, the CJEU had not been given the opportunity to draw the conceptual contours of “use as a trademark” prior to the *Johann Sebastian Bach* judgment. Discussing this vacuum, the Higher Court of Appeals of Dresden mentioned that it was not entirely clear whether the traditional, strict understanding of use as a trademark in Germany (in the sense of use to distinguish goods and services of the alleged infringer) had to be abandoned under the harmonized rules of EU trademark law. Nonetheless, the Court was confident that, in principle, the traditional requirement of use as a trademark, as interpreted and applied in *Johann Sebastian Bach*, had survived the harmonization of trademark law.<sup>45</sup>

This assumption, however, was premature. EU trademark law does not explicitly state that, for an infringement claim to be successful, the allegedly infringing use must constitute use for the purpose of distinguishing the alleged infringer’s own goods. The CJEU could have deduced this strict trademark use requirement from the statutory criterion of use “in relation to goods or services” laid down in Art. 9(2) EUTMR and Art. 10(2) TMD.<sup>46</sup> Arguably, the statutory criterion of use in relation to goods or services can be understood to require use of a conflicting sign for the purpose of identifying and distinguishing the goods and services of the alleged infringer. Following this approach, the CJEU could have established a strict trademark use requirement which, as demonstrated in *Johann Sebastian Bach*, could have served as a safeguard to prevent trademark rights from being asserted against use in an artistic context. At the same time, the development of a strict trademark use requirement would have led to a boundary line between trademark actions falling under harmonized trademark law and additional protection against “use of a

<sup>45</sup> Higher Court of Appeals of Dresden, *id.*, p. 616.

<sup>46</sup> The gatekeeper requirement of use in relation to goods and services has remained unchanged since the adoption of the first harmonized trademark legislation in the EU. *Cf.* Article 9 of Council Regulation (EC) No. 207/2009 of 26 February 2009 on the Community Trade Mark (codified version), OJ 2009 L 78, p. 1, and Art. 5 of Directive 2008/95/EC of the European Parliament and of the Council of 22 October 2008, to approximate the laws of the Member States relating to trade marks (codified version), OJ 2008 L 299, p. 25 (TMD 2008), which repealed earlier Directive 89/104/EEC of the Council of 21 December 1988 without changing the requirement of use in relation to goods and services.

sign other than use for the purposes of distinguishing goods or services”, which EU law leaves to the discretion of EU Member States in accordance with Art. 10(6) TMD.<sup>47</sup>

Instead of drawing these boundary lines, however, the CJEU opted for a much more flexible application of the gatekeeper criterion of use in relation to goods or services.<sup>48</sup> The Court refrained from sharpening the conceptual contours of use in relation to goods or services in the way described. It did not establish a strict requirement of “use as a trademark.” Instead, the CJEU constantly weakened this general protection requirement. Prior to the German *Johann Sebastian Bach* decision, the CJEU had already found in *BMW/Deenik* that use for the purpose of informing the public about repair and maintenance services offered with regard to trademarked products satisfied the criterion of use in relation to goods or services – even though Deenik had not used the trademark BMW to pass off his second-hand cars and repair services as offers stemming from BMW. Deenik had merely referred to BMW as the owner of the car brand that was central to his own activities.<sup>49</sup>

The CJEU also qualified use in comparative advertising as use in relation to goods or services on the ground that the advertiser made use of a competitor’s trademark to distinguish its own products from those of the competitor.<sup>50</sup> Summarizing the notion of use “in relation to goods or services,” the Court held that, to satisfy this precondition for an infringement action, it was sufficient that a link be established with goods or services. This formula can be found in the *Celine* decision where, with regard to the interface between trademark and trade name rights, the Court held that, once a link was established between the company, trade or shop name and the goods or services offered by the alleged infringer, trademark use in relation to goods or services could no longer be denied – even where the name was not affixed to marketed goods as such.<sup>51</sup> The formula of a link with goods or services, then, became established case law in later decisions dealing with keyword advertising. In *Google France and Google*, the CJEU confirmed that relevant use in relation to goods or services existed “in any event” where a third party used a conflicting sign in such a way that a link was established between that sign and the goods or services offered by the third party.<sup>52</sup> In *L’Oréal/eBay*, the Court found that the criterion of a link was satisfied because eBay’s advertisements

<sup>47</sup> Article 10(6) TMD. As to this boundary line between harmonized trademark law and room for national approaches, see CJEU, 21 November 2002, case C-23/01, *Robelco*, paras. 30–31 and 34; CJEU, 16 November 2004, case C-245/02, *Anheuser-Busch*, paras. 62 and 64. Cf. Kur and Sentfleben (2017), paras. 5.361–5.379; Henning-Bodewig (2008), pp. 306–309.

<sup>48</sup> Cf. Ohly (2019), p. 335. For an overview of developments in this area, see Kur (2008), p. 11.

<sup>49</sup> See CJEU, 23 February 1999, case C-63/97, *BMW v. Deenik*, para. 42.

<sup>50</sup> See CJEU, 12 June 2008, case C-533/06, *O2 v. Hutchison*, paras. 35–36. As to keyword advertising on the basis of services offered by a search engine, use of a competitor’s trademark as a keyword for a sponsored link with one’s own advertising has been found to constitute trademark use on similar grounds. See CJEU, 23 March 2010, cases C-236/08 to 238/08, *Google v. Louis Vuitton et al.*, para. 71.

<sup>51</sup> CJEU, 11 September 2007, case C-17/06, *Celine*, para. 23.

<sup>52</sup> CJEU, 23 March 2010, C-236/08–238/08, *Google France and Google*, para. 72; CJEU, 12 July 2011, case C-324/09, *L’Oréal v. eBay*, para. 92; CJEU, 19 February 2009, C-62/08, *UDV North America*, paras. 47–48.

created “an obvious association between the trade-marked goods which are mentioned in the advertisements and the possibility of buying those goods through eBay”.<sup>53</sup> Besides extending the trademark use concept to referential use that designates the goods or services of the trademark owner, the CJEU thus also adopted a low threshold requirement with regard to the connection with goods or services as such: a mere “link” or “association” is sufficient.<sup>54</sup>

#### 2.4 Full Exposure of Artists to Infringement Claims

As a result, the gatekeeper criterion of use “in relation to goods or services” does not prevent a trademark claim against references to the trademark that are made only to identify goods or services as those of the trademark owner and are not perceived by the public as indications of commercial source. The strict test of use as a trademark that the Higher Court of Appeals of Dresden applied in *Johann Sebastian Bach* has not been confirmed at EU level. By contrast, the CJEU brought several forms of referential use – references to the trademark as the distinctive sign of the trademark owner – within the scope of EU trademark rights.<sup>55</sup>

In contrast to the approach taken in *Johann Sebastian Bach*, this elastic interpretation of the trademark use requirement at EU level can have a deep impact on use in a cultural context. If a mere link with goods or services is sufficient to bring unauthorized use within the scope of trademark rights, there is no clear boundary between non-actionable use for artistic expression and actionable use as a trademark. This development can be placed in the context of the extension of EU trademark protection to a mark’s economic and communication value.<sup>56</sup> The CJEU explicitly recognized a trademark’s communication, investment and advertising functions in *L’Oréal/Bellure*.<sup>57</sup> Once trademark law is employed as a vehicle to protect not only the traditional origin function but also these accessory functions, the broadening of the concept of use in relation to goods or services is almost inevitable. A trademark’s economic and communication value may be damaged in contexts that do not involve confusion about commercial source. A biting Mickey Mouse parody, for example, is unlikely to mislead the public into believing that it stems from Disney. Nonetheless, it may have a negative effect on the perception of the Mickey Mouse trademark and its brand value. Hence, the Court’s elastic interpretation of the threshold requirement of use in relation to goods or services can be regarded as a corollary of the broad function theory that recognizes communication, investment and advertising functions in addition to the traditional origin function.<sup>58</sup>

<sup>53</sup> CJEU, 12 July 2011, case C-324/09, *L’Oréal v. eBay*, para. 93.

<sup>54</sup> As to the debate on this development, see the summary in Knaak, Kur and von Mühlendahl 2011, para. 2.178.

<sup>55</sup> Cf. Ohly (2019), p. 335; Kur and Senftleben (2017), paras. 5.50–5.54.

<sup>56</sup> Cf. Gangjee (2013), pp. 47–51.

<sup>57</sup> CJEU, 18 June 2009, case C-487/07, *L’Oréal v. Bellure*, para. 58.

<sup>58</sup> As to the evolution of the function theory in CJEU jurisprudence, see Kur and Senftleben (2017), paras. 1.12–1.39.

In practice, the evolution of this elastic concept of use in relation to goods or services brings about a remarkable change in the climate surrounding the use of protected signs in a cultural context. In the absence of a strict requirement of use as a trademark – understood in the sense of use for the purpose of identifying and distinguishing the goods or services of the alleged infringer – the threshold criterion of use in relation to goods or services loses its gatekeeper function.<sup>59</sup> With jurisprudence encouraging the inclusion of mere references to protected signs, the CJEU has opened the doors to trademark protection wide. A trademark claim can no longer be excluded from the outset if reference is made to protected signs in an artistic context. The mere use of a trademark in some relation to goods or services can serve as a starting point for an infringement claim.<sup>60</sup> In line with CJEU jurisprudence, a mere reference to the trademark and a mere link with goods or services may be sufficient to trigger an infringement action.<sup>61</sup> In the light of the elastic standard developed by the CJEU, even decorative use of a trademark may amount to actionable trademark use.<sup>62</sup> Not only references in comparative and keyword advertising, but also references for artistic purposes, such as the use of a trademark in a parody, may thus fall within the scope of the exclusive rights awarded under EU trademark law.

Again, it is remarkable that the reaction of EU policymakers to this development differs substantially when comparing artistic and commercial expression. While the inclusion of referential use in the canon of actionable trademark use led to the adoption of Art. 9(3)(f) EUTMR and Art. 10(3)(f) TMD, which explicitly immunize comparative advertising against trademark infringement claims, no comparable safeguard has been adopted in favour of artistic use. This difference is even more surprising when it is considered that advertisers are commercial parties involved in the fight for market share and are used to corresponding lawsuits. Artists, by contrast, are not commercial entities and are far less used to legal uncertainty and allegations of trademark infringement. In fact, there is evidence that artists are risk-averse. Mere exposure to a trademark action is likely to have a deterrent effect on artists even if judges do not rule in favour of trademark proprietors in the end.<sup>63</sup> In

<sup>59</sup> Kur and Senftleben (2017), paras. 5.14–5.15 and 5.49–5.56. As to the discussion on the cultivation of the requirement of “use as a trademark”, see Peukert (2012), pp. 96–107; Senftleben (2011), p. 39; Yap (2009), pp. 86–87; Kur (2008), p. 11; Dogan and Lemley (2008), p. 542; Dinwoodie and Janis (2007), pp. 1657–1658; Davison and Di Giantomasso (2009), p. 443; McKenna (2009), p. 773; Simon Fhima (2005), p. 401; Loughlan (2000), p. 328.

<sup>60</sup> Cf. Derclaye and Leistner (2011), p. 328; Simon Fhima (2006), p. 321. The risk of creating an automatism of property claims (“*Eigentumslogik*”) is also recognized by proponents of an elastic notion of trademark use. See Kur (2008), p. 12.

<sup>61</sup> CJEU, 23 October 2003, case C-408/01, *Adidas v. Fitnessworld*, para. 39; CJEU, 10 April 2008, case C-102/07, *Adidas v. Marca*, para. 41; CJEU, 11 September 2007, case C-17/06, *Celine*, para. 23.

<sup>62</sup> For a more detailed discussion of this point, see Senftleben (2020), pp. 426–427; Simon Fhima (2006), p. 321. See CJEU, 23 October 2003, case C-408/01, *Adidas v. Fitnessworld*, paras. 39–41, where the Court established an ambiguous test by holding that “[t]he 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”.

<sup>63</sup> Cf. Lemley and McKenna (2010), pp. 418–422 and 443; Calboli (2014a), p. 31.

various areas of creative activity, concerns have been articulated about artists' growing fear of being sued for intellectual property infringement.<sup>64</sup> These fears can have a chilling effect on creativity and cultural diversity. A cease-and-desist letter will be sufficient in many cases to frustrate use of trademarked symbols in an artistic context. An artist seeking to avoid potential lawsuits will refrain from the creation of works based on protected pre-existing material or limit takings to an absolute minimum.<sup>65</sup> Artists cannot be expected to have sufficient confidence and financial resources to take the risk of a lengthy lawsuit.<sup>66</sup> Discussing the impact of trademark claims on artistic activity, Florian Cramer gives the following example:

Recently the Rotterdam art platform Roodkapje [Little Red Riding Hood] received mail from a lawyer. The content: a steep bill. For their annual programme "Roodkapje Radicals" the curators advertised with an armed jihad fighter on a fake H&M poster. It was intended as a literal representation of the concept of radical chic, as a playful relativization of their own programme. But for H&M this was a violation of trademark law. When Roodkapje received the invoice from the H&M lawyer, they withdrew the poster. This is not a special event. Artists are regularly confronted with lawsuits.<sup>67</sup> (explanation within brackets added)

Hence, the legal uncertainty arising from the elastic application of gatekeeper criteria, such as use in the course of trade and use in relation to goods or services, in the jurisprudence of the CJEU leads to a climate that is not conducive to artistic expression. Instead, it is likely to stifle and impoverish artistic productions.

<sup>64</sup> Ramsey (2018), p. 427; Schovsbo (2018), p. 562; Adler (2016), p. 566; Cramer (2015); Aufderheide et al. (2014), p. 5; Frosio (2014), pp. 378–380; Calboli (2014a), pp. 31–32; Lemley and McKenna (2010), pp. 418–422 and 443; Banerjee (2012), p. 564; Sakulin (2010), pp. 292–293; McGeveran (2008), pp. 1206–1207 and 1224–1225; Morrison (2008), pp. 131–136; Hofrichter (2007), p. 1926; Gibson (2007), p. 913; Cohen (2006), pp. 154–156; Aufderheide and Jaszi (2004), pp. 29–30; Lessig (2004), pp. 185–188; Coombe (2003), p. 1174; Amabile (1996), pp. 115–120 and 231–232.

<sup>65</sup> German Federal Constitutional Court, 31 May 2016, case 1 BvR 1585/13, "Sampling", para. 100. Cf. Adler (2016), 566, who stresses the chilling effect of legal uncertainty in the field of copyright: "the disparate results in these cases, not to mention the high costs of litigating against a backdrop of uncertainty, help explain why a climate of "self-censorship" has taken hold in the art world." The same conclusion is drawn by Aufderheide et al. (2014), p. 5, pointing out that artists "pay a high price for copyright confusion and misunderstanding. Their work is constrained and censored, most powerfully by themselves, because of that confusion and the resulting fear and anxiety."

<sup>66</sup> For a more detailed discussion of the chilling effect of cease-and-desist strategies, see Ramsey (2018), p. 427; Schovsbo (2018), p. 562; Dogan (2016), p. 1293; Greener (2015), p. 598; Calboli (2014a), pp. 31–32; Lemley and McKenna (2010), pp. 418–422 and 443; McGeveran (2008), pp. 1206–1207; Lessig (2004), pp. 185–188.

<sup>67</sup> Cramer (2015): "Onlangs kreeg het Rotterdamse kunstpodium Roodkapje post van een advocaat. De inhoud: een gepeperde rekening. Voor hun jaarprogramma "Roodkapje Radicals" adverteerden de curatoren met een bewapende jihadstrijder op een nepaffiche van H&M. Het was bedoeld als een letterlijke verbeelding van het begrip radical chic, als speelse relativering van hun eigen programma. Maar voor H&M was dit schending van het merkrecht. Toen Roodkapje de factuur van de H&M-advocaat kreeg, trokken zij het affiche in. Dit is geen bijzondere gebeurtenis. Geregeld krijgen kunstenaars rechtszaken aan hun broek." (translation from Dutch into English by Martin Senftleben).

### 3 Limitations of Trademark Rights

As gatekeeper criteria, such as use in the course of trade and use in relation to goods or services, do not have an immunizing effect similar to the effect of the statutory comparative advertising rule enshrined in Art. 9(3)(f) EUTMR and Art. 10(3)(f) TMD, the question arises whether defences are available in EU trademark law that offer support for artistic expression – in the sense of providing sufficiently robust arguments to refute infringement claims. A survey of limitations of trademark rights shows that several limitations of trademark rights, in particular the referential use defence (Sect. 3.1), the descriptive use defence (Sect. 3.2) and the non-distinctive use defence (Sect. 3.3), are capable of covering artistic forms of use.

#### 3.1 Referential Use Defence

Artists using trademarked source material for their creative work may invoke the defence of referential use that is laid down in Art. 14(1)(c) EUTMR and Art. 14(1)(c) TMD. These provisions define referential use as use “for the purpose of identifying or referring to goods or services as those of the proprietor of that trade mark”. A parody using a trademark to symbolize and criticize policies of the trademark proprietor may fall within the scope of this referential use concept. Prior to the 2015 trademark law reform, EU law only exempted the unauthorized use of trademarks to “indicate the intended purpose of a product or service”.<sup>68</sup> The law reform broadened the referential use concept substantially.<sup>69</sup> As indicated, the current version of the provision seems capable of offering breathing space for artistic forms of use, such as use for the purposes of parody.

The potential of the broadened referential use defence to cover artistic use, however, has hardly ever been tested in practice. Nonetheless, it seems possible to illustrate its ambit of operation in light of case scenarios that predate the trademark law reform. The German Federal Supreme Court’s 2005 case *Lila Postkarte*, for instance, concerned the marketing of postcards that alluded ironically to trademarks and advertising campaigns of the chocolate producer Milka. On purple background corresponding to Milka’s abstract colour mark, the postcard sought to ridicule the nature idyll with cows and mountains that is evoked in Milka advertising. It showed the following poem attributed to “Rainer Maria Milka”:

Über allen Wipfeln ist Ruh,

<sup>68</sup> Article 6(1)(c) TMD 2008. Cf. CJEU, 17 March 2005, case C-228/03, *Gillette v. LA-Laboratories*, para. 30.

<sup>69</sup> As to the considerations underlying the broadening of the referential use concept as a result of the trademark law reform, see Kur and Senftleben (2017), paras. 6.39–6.41.

irgendwo blökt eine Kuh.

Muh!<sup>70</sup>

Discussing this ironic play with Milka insignia, the German Federal Supreme Court applied a broad notion of actionable use as a trademark in light of CJEU jurisprudence.<sup>71</sup> Following this approach, the fact that the postcard producer merely referred to Milka trademarks (without employing the Milka trademarks as indications of origin) was sufficient to meet the threshold requirement of use in relation to goods or services.<sup>72</sup> The German Federal Supreme Court deemed it sufficient that the postcard called to mind the well-known Milka signs.<sup>73</sup> Accordingly, the Court embarked on a scrutiny of the trademark parody in light of the dilution criteria of detriment to distinctive character or repute, and the taking of unfair advantage.<sup>74</sup> Weighing Milka's concerns about a disparagement of the trademarks against the fundamental guarantee of freedom of the arts, however, the Court finally concluded that freedom of art had to prevail in light of the ironic statement made by the postcard.<sup>75</sup> The use of Milka trademarks was found to have taken place with "due cause" in the sense of Art. 10(2)(c) TMD.<sup>76</sup> At the time of the decision, the inherent limitation of dilution claims in the EU to uses "without due cause"<sup>77</sup> constituted the only defence argument for artistic users. Arguably, the case scenario underlying the *Lila Postkarte* lawsuit would nowadays also allow the referential use defence ensuing from Art. 14(1)(c) TMD and Art. 14(1)(c) EUTMR to be successfully invoked.<sup>78</sup>

<sup>70</sup> "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 German Federal Supreme Court, 3 February 2005, case I ZR 159/02, *Lila Postkarte*, GRUR 2005, 583. Cf. Born (2006), p. 192.

<sup>71</sup> See the reference to CJEU, 23 October 2003, case C-408/01, *Adidas v. Fitnessworld*, para. 39, in the German Federal Supreme Court's *Lila Postkarte* decision, *id.*, p. 584. With regard to the qualification of decorative use as relevant trademark use, see also Kur (2008), pp. 5–6.

<sup>72</sup> For this general prerequisite for trademark infringement actions in the EU, see Art. 9(2) EUTMR and Art. 10(2) TMD. Cf. Kur and Senftleben (2017), paras. 5.49–5.56.

<sup>73</sup> German Federal Supreme Court, *id.*, p. 584.

<sup>74</sup> Article 10(2)(c) TMD; Art. 9(2)(c) TMD.

<sup>75</sup> German Federal Supreme Court, *id.*, pp. 584–585. For a further case in which freedom of speech prevailed over trademark protection, see German Federal Supreme Court, 11 March 2008, case VI ZR 7/07, "Gen-Milch", *Neue Juristische Wochenschrift* 2008, p. 2110.

<sup>76</sup> German Federal Supreme Court, 3 February 2005, case I ZR 159/02, GRUR 2005, p. 583 (585). As to the defence of due cause, see CJEU, 22 September 2011, case C-323/09, *Interflora v. Marks & Spencer*, para. 91; CJEU, 6 February 2014, case C-65/12, *Leidseplein Beheer v. Red Bull*, paras. 54–58.

Cf. Vanovermeire (2009), pp. 187–188.

<sup>77</sup> Article 10(2)(c) TMD; Art. 9(2)(c) EUTMR. Cf. Kur and Senftleben (2017), paras. 5.265–5.268 and 6.59–6.63; Di Cataldo (2011), p. 833.

<sup>78</sup> For a more detailed discussion of the scope of the referential use defence in current EU trademark law, see Senftleben (2020), pp. 507–509.

### 3.2 Descriptive Use Defence

A further example of a defence argument that can support artistic expression is the defence of descriptive use. In line with Art. 17 TRIPS which explicitly refers to “fair use of descriptive terms”, Art. 14(1)(b) EUTMR and Art. 14(1)(b) TMD permit the unauthorized use of “signs or indications which [...] concern the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of the service, or other characteristics of the goods or services”. This limitation of trademark rights can play an important role when work titles or other signs with cultural significance are registered as trademarks. In the *Marlene Dietrich* decision – concerning an attempt to register a portrait photograph of the famous actress as a trademark – the German Federal Supreme Court held that a photograph of Marlene Dietrich constituted a descriptive indication of product characteristics in respect of books, magazines, photographs, posters, CDs, DVDs, musical performances and film productions.<sup>79</sup> On the basis of the descriptive use defence, use of the portrait photograph as an indication of film, book or poster characteristics thus remains permissible even if trademark rights are acquired through use in trade.<sup>80</sup>

However, the concept of descriptive use has its limits. Use of a trademarked Marlene Dietrich portrait in a parody or in appropriation art, for instance, is unlikely to constitute permissible descriptive use. It incorporates the trademark itself – in this case a portrait of the actress – in the product. In contrast to a label that is merely attached to the product (and may indicate certain product features), the portrait becomes a central element of the very contents of the product. Decorative use of this nature is unlikely to fall within the scope of the descriptive use concept.<sup>81</sup> As the CJEU concluded in *Adidas/Marca*, the purely decorative use of a two-stripe motif on sports clothing “is not intended to give an indication concerning one of the characteristics of those goods”.<sup>82</sup> Constituting design features, the stripes were not intended to indicate characteristics of the sports and leisure garments.<sup>83</sup> Similarly, the Court denied descriptive use in *Opel/Autec* on the ground that the faithful reproduction of the Opel logo on a scale model car could not be regarded as an indication of product characteristics. Instead, the logo became part of the product itself:

However, the affixing of a sign which is identical to a trade mark registered, inter alia, in respect of motor vehicles to scale models of that make of vehicle in order to reproduce those vehicles faithfully is not intended to provide an

<sup>79</sup> German Federal Supreme Court, 24 April 2008, case I ZB 21/06, *Marlene-Dietrich-Bildnis*, paras. 12–15.

<sup>80</sup> In *Marlene Dietrich*, the German Federal Supreme Court denied trademark protection in respect of the goods and services mentioned because of a lack of distinctive character. See German Federal Supreme Court, *id.*, paras. 12–15. As to CJEU case law addressing the descriptive use defence, see CJEU, 7 January 2004, case C-100/02, *Gerolsteiner v. Putsch*, paras. 25–26.

<sup>81</sup> Kur and Senftleben (2017), paras. 6.23–6.27.

<sup>82</sup> CJEU, 10 April 2008, case C-102/07, *Adidas v. Marca*, para. 48.

<sup>83</sup> CJEU, *id.*, para. 48.

indication as to a characteristic of those scale models, but is merely an element in the faithful reproduction of the original vehicles.<sup>84</sup>

### 3.3 Non-Distinctive Use Defence

Besides the descriptive use defence, Art. 14(1)(b) EUTMR and Art. 14(1)(b) TMD also stipulate that the grant of trademark rights will not entitle the proprietor to prohibit a third party from using “signs or indications which are not distinctive”. Evidently, this exemption of non-distinctive use constitutes an important additional defence argument. Annette Kur draws the following line between descriptive use and non-distinctive use:

Similar to descriptive signs which, even when they are registered after having acquired distinctiveness, still contain residues of their original descriptive character that others are free to make use of, inherently indistinctive signs as well will never become the “sole property” of the trademark holder, but must leave room for use by others that only relates to the sign in its original, non-distinctive capacity.<sup>85</sup>

This explanation sheds light on the important function that exempting non-distinctive use may fulfil when trademark protection is acquired with regard to literary and artistic works. In its primary state, a cultural icon, such as the “Mona Lisa” or “The Night Watch” (*De Nachtwacht*), lacks the inherent distinctive character necessary to serve as an identifier of commercial source – at least in respect of literary and artistic productions.<sup>86</sup> The trademark owner must actively transform the sign into a badge of origin. Regardless of the acquisition of distinctive character through use, however, a non-distinctive “residue” in the sense of Kur’s explanation, namely the sign’s original cultural meaning, always remains. Like other types of non-distinctive and descriptive signs,<sup>87</sup> a cultural sign never becomes the sole property of the trademark owner. The sign’s literary and artistic character – the residue stemming from the sign’s evolution in the cultural domain – is beyond reach for the trademark owner.<sup>88</sup> As this cultural residue is non-distinctive in the context of literary and artistic productions, it falls outside the scope of trademark rights, which – by definition – should cover only the secondary, source-identifying

<sup>84</sup> CJEU, 25 January 2007, case C-48/05, *Adam Opel v. Autec*, para. 44.

<sup>85</sup> Kur (2018), p. 101.

<sup>86</sup> Cf. German Federal Patent Court, 25 November 1997, case 24 W (pat) 188/96, *Mona Lisa*, GRUR 1998, pp. 1021 and 1023; Court of Appeals of The Hague, 29 August 2017, case 200.205.771/01, ECLI:NL:GHDHA:2017:2446, *Chiever v. Benelux-Organisatie voor de Intellectuele Eigendom* (“*Nachtwacht*”), para. 12.

<sup>87</sup> Kur (2018), p. 103, gives the example of a shape that, as such, is non-distinctive but may acquire distinctive character through use. Notwithstanding the acquisition of distinctive character, the non-distinctive use defence may allow use of a similar product shape in packages that clearly indicate the defendant’s own word mark. Arguably, this use only relates to the non-distinctive properties of the shape and the function of indicating commercial source is left to the defendant’s own word mark on the packages.

<sup>88</sup> For an aesthetic functionality concept reflecting these residues of “widely shared cognitive, psychological, or aesthetic propensities”, see Hughes (2015), p. 1231.

meaning added by the trademark owner. Exempting use of non-distinctive signs or indications, Art. 14(1)(b) EUTMR and Art. 14(1)(b) TMD thus allow for artistic use that relates only to a sign in its original, cultural (and non-distinctive) capacity.<sup>89</sup> As use of a sign with cultural significance to indicate a specific artistic position is use of the sign as a non-distinctive, artistic reference point, the non-distinctive use defence can be deemed applicable. Rightly understood, Art. 14(1)(b) EUTMR and Art. 14(1)(b) TMD therefore cover use of a trademarked cultural sign in an artistic way – as an indication of a cultural meaning that does not concern the sign’s trademark function of indicating commercial source.<sup>90</sup>

#### 4 Test of Honest Practices

All limitations listed in Art. 14(1) EUTMR and Art. 14(1) TMD, however, are subject to the general “honest practices” proviso set forth in Art. 14(2) EUTMR and Art. 14(2) TMD. In line with this overarching requirement, the limitation of trademark rights in favour of referential, descriptive and non-distinctive use “shall only apply where the use made by the third party is in accordance with honest practices in industrial or commercial matters”. With regard to artistic expression, the new fairness rule enshrined in Recital 21 EUTMR and Recital 27 TMD confirms that the honest practices test is fully applicable. The fact that artistic expression is at stake does not exempt the artist from the obligation to ensure compliance with “honest practices in industrial and commercial matters”.

In principle, the evolution of a fairness rule for artistic expression is a positive development. It offers an important counterbalance to the expansion of trademark protection that allows trademark proprietors to threaten artists with infringement claims,<sup>91</sup> and to the increasing tendency to grant trademark rights in contemporary cultural symbols and cultural heritage material, which exposes artists to trademark infringement claims when they use trademarked cultural signs as building blocks for new productions.<sup>92</sup> Given these parallel trends, the adoption of a fairness rule in

<sup>89</sup> Cf. Ohly (2019), pp. 337–338, who also sees room for the cultivation of this defence argument in cases of remix in the artistic domain.

<sup>90</sup> For a more detailed discussion of this field of application of the non-distinctive use defence, see Senftleben (2020), pp. 509–512.

<sup>91</sup> Cf. Senftleben (2020), pp. 135–138; Izyumenko (2020), pp. 440–446; Bohaczewski (2020), p. 856; Żelechowski (2018), pp. 115–135; Jacques (2016), p. 479; Senftleben (2015), p. 354; Ramsey and Schovsbo (2013), p. 671; Simon Fhima (2013), p. 293; Sakulin (2010), pp. 247–282; Geiger (2010), p. 163; Burrell and Gangjee (2010), p. 544; Nasser (2009), p. 188; Assaf (2008), p. 56; Geiger (2007), p. 317; Ramsey (2010), p. 405; Weckström (2007), p. 671; Gulasekaram (2005), p. 887; Leval (2004), p. 187; Dreyfuss (1990), pp. 415–418.

<sup>92</sup> Cf. Senftleben (2020), pp. 202–205; Ramsey (2018), p. 427; Schovsbo (2018), p. 562; Adler (2016), p. 566; Cramer (2015); Aufderheide et al. (2014), p. 5; Frosio (2014), pp. 378–380; Calboli (2014a), pp. 31–32; Lemley and McKenna (2010), pp. 418–422 and 443; Banerjee (2012), p. 564; Sakulin (2010), pp. 292–293; McGeveran (2008), pp. 1206–1207 and 1224–1225; Morrison (2008), pp. 131–136; Hofrichter (2007), p. 1926; Gibson (2007), p. 913; Cohen (2006), pp. 154–156; Aufderheide and Jaszi (2004), pp. 29–30; Lessig (2004), pp. 185–188; Coombe (2003), p. 1174; Amabile (1996), pp. 115–120 and 231–232.

Recital 21 EUTMR and Recital 27 TMD that specifically deals with artistic expression is an important and welcome step in the right direction.

The alignment of the fairness rule with behavioural standards in industry and commerce, however, is problematic. As already explained, Recital 21 EUTMR and Recital 27 TMD allow a finding of fair use for the purpose of artistic expression only “as long as it is at the same time in accordance with honest practices in industrial and commercial matters”. Immediately, this legislative guideline raises the question whether this standard of honesty can ever be an appropriate yardstick for the assessment of unauthorized use in an artistic context. The fair use analysis may be doomed to fail because industrial and commercial considerations are inappropriate for clarifying the legitimacy of use in the cultural domain. Practical (Sect. 4.1), socio-cultural (Sect. 4.2) and legal-doctrinal (Sect. 4.3) considerations militate against reliance on industrial and commercial standards when artistic expression is at stake.

#### 4.1 Practical Concerns

From a practical point of view, an artist can hardly be expected to be aware of behavioural standards in industry and commerce. The proviso of honest practices in industrial and commercial matters is impractical and disadvantageous for artists because they do not have the knowledge necessary to ensure compliance with these standards. The information deficit weakens the strategic position of artists in infringement proceedings. Even if the burden of establishing dishonest practices is placed on the trademark proprietor,<sup>93</sup> the artist must ascertain which behavioural norms are applicable to successfully rebut dishonesty arguments. As a trader, the trademark owner can be expected to be well acquainted with standards of honesty in industrial and commercial matters. The artist, by contrast, must first explore applicable behavioural norms. The use of industrial and commercial standards as a yardstick for the assessment of artistic use thus causes an information imbalance that gives the trademark proprietor an advantage. In contrast to artists, trademark owners can remain in their own sector and “play a home game”.

#### 4.2 Theoretical Concerns

Recital 21 EUTMR and Recital 27 TMD, however, also give rise to a more fundamental issue. They raise the question whether artists and artistic productions ought to be subject to industrial and commercial behavioural norms *at all*. The subordination of artistic expression to an industrial and commercial assessment standard is highly undesirable. It obliges artists to align their cultural work with commercial standards of fairness and honesty that are inappropriate from the outset. Cultural sociology sheds light on the serious risk of eroding art autonomy that arises from the current configuration of the fairness test for artistic expression in EU trademark law. The sociological analysis of the field of literary and artistic

<sup>93</sup> For arguments in favour of this distribution of the burden of proof, see Kur and Senftleben (2017), paras. 6.78–6.79.

production conducted by Pierre Bourdieu leaves no doubt that a thriving literary and artistic sector – capable of unmasking deficiencies in society and providing impulses for the improvement of social and political conditions<sup>94</sup> – requires artists' independence from economic and political powers.

Refining Niklas Luhmann's concept of relatively closed social systems with a distinct identity and a boundary between them and their environment,<sup>95</sup> Pierre Bourdieu developed the concept of "fields" in society. Although constituting an autonomous social space with individual rules, dominance structures and an established set of opinions, a field is not isolated from other social spaces and processes surrounding it. According to Bourdieu, the structure of a field results from constant internal conflict between players competing for predominance and leadership.<sup>96</sup> A field's degree of autonomy, then, depends on the extent to which external players can influence this internal conflict.<sup>97</sup> To assess the autonomy of a given field, it is thus necessary to examine its relationship with the social environment in which it is embedded at a given point in time.<sup>98</sup>

Applying this theoretical model to the field of literary and artistic production, Bourdieu assumes that the field's autonomy rests on the rejection of the capitalism of the bourgeoisie. The specific "nomos" of the literary and artistic field lies in its independence from economic and political powers.<sup>99</sup> Instead of aligning their work with commercial or political considerations, autonomous artists aim at internal recognition within the field. Artists emancipate themselves from the focus on commercial necessities and rewards.<sup>100</sup> As a result, the consecration mechanisms in the literary and artistic field – the power to set quality standards and dominate the internal discourse – become self-referential: *l'art pour l'art*. The field of literature and art becomes a universe that counters the profit logic impregnating economic and political discourse in society.<sup>101</sup> The break with commercial and political powers constitutes the basis of an artist's independent, autonomous existence.<sup>102</sup> It allows artworks to critically reflect on societal conditions and pave the way for necessary reforms.<sup>103</sup>

It follows from this configuration of the field of literary and artistic production that artists must not be obliged to align their work with behavioural standards that stem from another field of society. From this perspective, it is intolerable that Recital 21 EUTMR and Recital 27 TMD put pressure on artists to observe standards of honesty in industrial and commercial matters. Recital 21 EUTMR and Recital 27

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<sup>94</sup> For a more detailed discussion of these societal functions of art, see Senftleben (2020), pp. 54–66.

<sup>95</sup> Luhmann (1984), p. 31 and pp. 35–70.

<sup>96</sup> Bourdieu (1996), pp. 134–135; Bourdieu (1999), pp. 253–255 and 368.

<sup>97</sup> Bourdieu et al. (1985), p. 28.

<sup>98</sup> Bourdieu (1996), p. 134.

<sup>99</sup> Bourdieu (1999), pp. 103–105.

<sup>100</sup> Bourdieu (1999), p. 344.

<sup>101</sup> Cf. Peukert (2019), pp. 1178–1179.

<sup>102</sup> Bourdieu (1999), p. 105.

<sup>103</sup> Bourdieu (1999), p. 342.

TMD appear as an institutionalized subordination of cultural productions to the predominant commercial orientation of modern capitalist societies.<sup>104</sup>

The potential corrosive effect of this legislative decision must not be underestimated. On the basis of his analysis of the power relations in the literary and artistic field, Bourdieu already painted an alarming picture of the field's degree of autonomy 30 years ago. In light of reduced state subsidies for cultural productions and the rise of culture sponsoring by enterprises, Bourdieu warned of an increasing mutual penetration of the world of art and the world of money: he saw more and more literary and artistic productions becoming subject to entrepreneurial marketing strategies and commercial pressures.<sup>105</sup> Therefore, he predicted the loss of autonomous literary and artistic productions.<sup>106</sup> Considering the growing influence of commercial players and profit rationales, he feared that commercial influences would finally suppress the critical thinking that is necessary for independent avant-garde works.<sup>107</sup>

Considering these insights from cultural sociology, it is evident that the reference point chosen in Recital 21 EUTMR and Recital 27 TMD is fundamentally wrong. The requirement of use in accordance with behavioural norms in the industrial and commercial sector cements the supremacy of trade and commerce over the field of art and culture: even if use appears fair and legitimate in the light of artistic standards, it may still amount to trademark infringement when established industrial and commercial practices point in the opposite direction. The legislator allows the logic of commerce and trade to prevail over the *l'art pour l'art* logic of culture and art – an alarming decision that encourages the erosion of the autonomy of literary and artistic productions.

#### 4.3 Legal-Doctrinal Concerns

The problem becomes even greater when legal-doctrinal developments are factored into the equation. The CJEU tends to determine compliance with honesty in industrial and commercial matters on the basis of the same criteria that inform the analysis of *prima facie* infringement in trademark confusion and dilution cases.<sup>108</sup> This jurisprudence strengthens concerns that, by examining artistic use in the light of the honest practices proviso, industrial and commercial standards will prevail and finally erode artistic autonomy. As currently applied, the inquiry into honest commercial practices is far from including values from other societal domains, such

<sup>104</sup> See Fromer (2010), pp. 1479–1480, with regard to consumers' preference for limited newness in the area of literary and artistic works; Buccafusco et al. (2017), pp. 41–43, for a discussion of consumers' preference for established, known forms of literary and artistic expression, and the impact of this preference on innovation in the cultural domain.

<sup>105</sup> Bourdieu (1999), p. 530.

<sup>106</sup> Bourdieu (1999), p. 533.

<sup>107</sup> Bourdieu (1999), p. 531.

<sup>108</sup> CJEU, 8 July 2010, C-558/08, *Portakabin*, para. 69; CJEU, 17 March 2005, case C-228/03, *Gillette v. LA-Laboratories*, para. 49. Cf. Kur and Senftleben (2017), para. 6.73; Senftleben et al. (2015), p. 339; Senftleben (2013), pp. 168–169; Simon Fhima and Jacob (2014), p. 274; Simon Fhima (2012), pp. 501–502.

as the field of literary and artistic production. Instead, the CJEU simply replicates infringement criteria that belong to the canon of standard behavioural norms in the sector of industry and commerce. In *Gillette*, the Court held that use would fail to comply with honest practices in industrial and commercial matters if, for example:

- it is done in such a manner as to give the impression that there is a commercial connection between the third party and the trade mark owner;
- it affects the value of the trade mark by taking unfair advantage of its distinctive character or repute;
- it entails the discrediting or denigration of that mark;
- or where the third party presents its product as an imitation or replica of the product bearing the trade mark of which it is not the owner.<sup>109</sup>

While some of these assessment factors can be traced back to EU legislation in the field of comparative advertising,<sup>110</sup> the prohibition of use that gives the impression of a commercial connection with the trademark owner, and the ban on use that damages or takes unfair advantage of the mark's distinctive character or repute, correspond to infringement criteria in the field of trademark protection against confusion and dilution.<sup>111</sup> The risk of circularity is obvious: by copying almost literally the criteria for establishing *prima facie* infringement, the CJEU subjects defences to additional scrutiny in light of the same criteria that enabled the trademark owner to bring the infringement claim in the first place. This circular line of reasoning may render defence arguments, such as referential, non-distinctive and descriptive use, moot in practice.<sup>112</sup> In the keyword advertising case *Portakabin*, for instance, the Court did not find it contradictory to conclude that

the circumstances under which a trade mark proprietor is, pursuant to Article 5(1) of Directive 89/104 [nowadays Article 10(2)(a) TMD], entitled to prevent an advertiser from using a sign identical with, or similar to, that trade mark as a keyword may [...] easily correspond to a situation in which the advertiser cannot claim that it is acting in accordance with honest practices in industrial or commercial matters, and cannot therefore validly rely on the exception ...<sup>113</sup> (comment inside square brackets added)

The corrosive effect of this circular approach on defence arguments that could support artistic expression is evident. Following the current CJEU approach, the same behavioural norms – stemming from the sector of industry and commerce – that have led to a finding of *prima facie* infringement, support a finding of dishonest practices. In consequence, the requirement of use in accordance with honest practices in industrial and commercial matters degenerates into a torpedo that the trademark proprietor can employ to neutralize limitations of trademark rights that

<sup>109</sup> CJEU, 17 March 2005, case C-228/03, *Gillette v. LA-Laboratories*, para. 49.

<sup>110</sup> Article 4(d), (f), (g) and (h) MCAD. Cf. Kur and Senftleben (2017), para. 6.72.

<sup>111</sup> Article 9(2)(b) and (c) EUTMR; Art. 10(2)(b) and (c) TMD.

<sup>112</sup> Cf. Kur and Senftleben (2017), para. 6.73; Senftleben et al. (2015), p. 339; Senftleben (2013), pp. 168–169; Simon Fhima and Jacob (2014), p. 274; Simon Fhima (2012), pp. 501–502.

<sup>113</sup> CJEU, 8 July 2010, C-558/08, *Portakabin*, para. 69.

provide defence arguments for artists. The symmetry of criteria for assessing *prima facie* infringement and determining honesty in industrial and commercial matters can easily lead to a situation where a finding of a likelihood of confusion or dilution already foreshadows that of a lack of compliance with honest commercial practices.

## 5 Towards an Appropriate Fairness Rule

Hence, the question arises whether, despite the approach chosen by the CJEU, it is possible to alleviate the problems arising from a fairness rule for artistic expression that is aligned with behavioural standards in the industrial and commercial domain. A first signpost for potential solutions came to light during the debate on the amendment of EU trademark law. Seeking to provide guidance for the 2015 law reform, the “Recommendation on Measures to Safeguard Freedom of Expression and Undistorted Competition in EU Trade Mark Law”<sup>114</sup> proposed to solve the problem of circularity in the honest practices jurisprudence as follows:

The only way to make sense of the wording would be to clarify that although the basic concepts (likelihood of confusion, abuse of reputation) informing the evaluation of honest business practices are the same as those governing infringement, their application is different in that the leeway for using a basically conflicting mark is much broader where applications or limitations apply, thereby confining the proprietor’s right to oppose such use to cases of disproportionate harm.<sup>115</sup>

The argument thus runs as follows: even if the assessment of honesty in industrial and commercial matters rests on the same criteria that have previously been used to establish *prima facie* infringement, the outcome can still be different when the criteria are applied in a more flexible way.<sup>116</sup> The required flexibility can be derived from the values underlying the adoption of limitations in EU trademark law, such as the defences for referential, non-distinctive and descriptive use. Weighing the interests of the trademark owner against the interests of the defendant, trademark judges can attach particular importance to the values that support the position of the defendant and avoid the verdict of infringement. In the balancing process, the principle of proportionality plays a central role. The scope of the trademark owner’s exclusive rights should be confined to cases of disproportionate harm.

When a trademark is used for the purpose of artistic expression, these guidelines allow the artist to prevail for at least two reasons: the need to reconcile trademark protection with freedom of expression and freedom of the arts (Sect. 5.1), and the disproportionality of enforcing trademark rights even though artistic use is unlikely to imperil the essential origin function of the trademark (Sect. 5.2). As the status quo is unacceptable in light of these fundamental considerations, it is advisable to

<sup>114</sup> Senftleben et al. (2015), pp. 341–343. Cf. Kur (2018), p. 105; Kur and Senftleben (2017), para. 6.74.

<sup>115</sup> Senftleben et al. (2015), p. 339.

<sup>116</sup> Kur (2018), p. 105. Cf. also Kur and Senftleben (2017), para. 6.74; Di Cataldo (2011), p. 837.

introduce a bias in favour of artists: a legal presumption of fair use (Sect. 5.3). Court decisions on both sides of the Atlantic offer support for this solution (Sect. 5.4).

## 5.1 Fundamental Rights

Artistic expression enjoys protection on the basis of the constitutional guarantee of freedom of expression and freedom of the arts in Arts. 11 and 13 of the EU Charter of Fundamental Rights (CFR).<sup>117</sup> The artist and the trademark proprietor thus meet at the same level. While the trademark owner can invoke the recognition of intellectual property in Art. 17(2) CFR,<sup>118</sup> the artist can rely on Arts. 11 and 13 CFR. The legal position of the artist is not *a priori* weaker than the status enjoyed by the trademark owner. In copyright law, the CJEU already gave parody and quotation rules that serve freedom of expression and freedom of the arts<sup>119</sup> the elevated status of “user rights”.<sup>120</sup> In *Funke Medien* and *Spiegel Online*, the Court explicitly confirmed the status of user rights by pointing out that,

although Article 5 [of the Information Society Directive<sup>121</sup>] is expressly entitled “Exceptions and limitations”, it should be noted that those exceptions or limitations do themselves confer rights on the users of works or of other subject matter.<sup>122</sup> (explanation and reference inside square brackets added)

Taking this development in EU copyright law as a reference point, it seems only a small step to draw a parallel in trademark law and recognize that, by granting freedom of referential, non-distinctive and descriptive use, Art. 14(1)(b) and (c) EUTMR and Art. 14(1)(b) and (c) TMD bestow user rights upon artists.<sup>123</sup>

<sup>117</sup> Charter of Fundamental Rights of the European Union, OJ 2000 C 364, p. 1.

<sup>118</sup> Cf. Jongsma (2019), pp. 163–168; Griffiths and McDonagh (2013), pp. 75–93; Geiger (2009), pp. 113–117.

<sup>119</sup> Article 5(3)(d) and (k) of the Information Society Directive, *infra* note 119. Cf. CJEU, 1 December 2011, case C-145/10, *Painer*, paras. 132–134; CJEU, 3 September 2014, case C-201/13, *Deckmyn*, paras. 25–27. Cf. Jongsma (2019), pp. 126–135. For a decision devoting specific attention to freedom of the arts, see CJEU, 29 July 2019, case C-476/17, *Pelham and Others*, paras. 31–35. Cf. Geiger and Izyumenko (2020), pp. 293–294.

<sup>120</sup> As to the influence of freedom of expression on copyright protection, cf. Geiger and Izyumenko (2020), pp. 292–298; Jongsma (2019), pp. 195–222; Hugenholtz (2016), p. 242; Geiger and Izyumenko (2014), p. 316; Netanel (2008), pp. 84–95, 107–121, 144–153 and 195–199; Geiger (2006), p. 371; Strowel et al. (2006); Hugenholtz (2002), p. 239; Macciachini (2000), Netanel (1996), p. 283.

<sup>121</sup> Directive 2001/29/EC of the European Parliament and of the Council of 22 May 2001 on the Harmonisation of Certain Aspects of Copyright and Related Rights in the Information Society, OJ 2001 L 167, p. 10.

<sup>122</sup> CJEU, 29 July 2019, case C-516/17, *Spiegel Online*, para. 54; CJEU, 29 July 2019, case C-469/17, *Funke Medien NRW*, para. 70. For a more detailed discussion of this point, see Aplin and Bently (2020), pp. 75–84; Geiger and Izyumenko (2020), pp. 292–298.

<sup>123</sup> For a decision relying on freedom of the arts as a factor that weighs against the grant of trademark rights, see EFTA Court, 6 April 2017, case E-5/16, *Municipality of Oslo (“Vigeland”)*, para. 65. Cf. Senfleben (2020), p. 342.

## 5.2 Proportionality

In addition, use of trademarks in an artistic setting constitutes a specific form of use. It is use in a metaphorical, non-branding<sup>124</sup> sense: the trademark is not employed as an identifier of commercial source but as a symbol of personal or societal conditions. Use of trademarks in art concerns a metaphorical play with the associations evoked by a trademark in the minds of consumers and the societal conditions that a trademark reflects.<sup>125</sup> This insight has a deep impact on the balancing exercise to be conducted in light of the principle of proportionality. As the artist does not use the trademark as a badge of origin, the detriment to the trademark proprietor is, by definition, reduced.

Artistic use may still do harm by mocking and criticizing the trademark owner, or using the trademark for a critique of societal conditions that the trademark owner finds irreconcilable with the favourable brand image the latter wishes to maintain.<sup>126</sup> Nonetheless, the fact remains that artistic use does not encroach upon the essential function of the trademark: the function of guaranteeing the commercial origin of goods or services.<sup>127</sup> From this perspective, the detriment to the trademark owner is limited from the outset.

## 5.3 Legal Presumption of Compliance with Honest Practices

Taking the described insights together – the anchorage of artistic expression in constitutional freedoms and the proportionality of harm flowing from a metaphorical play with trademarks – it becomes possible to weave a general bias in favour of artistic expression into the fabric of the honest practices test: a legal bias in the sense of a legal presumption of fair use that allows use of a trademark for the purpose of artistic expression to routinely survive scrutiny in light of the honest practices proviso. Following this maxim, use of trademarks should be deemed fair in artistic contexts unless the trademark proprietor manages to overcome the legal presumption by presenting individualized facts<sup>128</sup> that provide proof of unusually grave trademark harm. More specifically, the trademark owner should be obliged to demonstrate that, despite the artistic setting, the use *explicitly* misleads consumers as to the commercial origin of the artwork. In the case of a trademark with a

<sup>124</sup> Dogan and Lemley (2008), p. 542.

<sup>125</sup> Cf. Dreyfuss (1990), p. 418; Dogan and Lemley (2008), p. 542. For an example of case law recognizing this metaphorical play as a central feature of the use of trade symbols in an artistic setting, see German Federal Supreme Court, 3 February 2005, case I ZR 159/02, *Lila Postkarte*, GRUR 2005, pp. 584–585.

<sup>126</sup> For an example of case law discussing this type of artistic expression, see District Court of The Hague, 4 May 2011, case LJN BQ3525, *Nadia Plesner v. Louis Vuitton*, paras. 2.1–2.8. Cf. Peukert (2016), p. 424; Visser (2011), pp. 740–742.

<sup>127</sup> CJEU, 3 December 1981, case C-1/81, *Pfizer v. Eurim-Pharm*, para. 8; CJEU, 12 November 2002, case C-206/01, *Arsenal v. Reed*, para. 48. Cf. Simon Fhima (2005), p. 401.

<sup>128</sup> Benkler (1999), pp. 362–363.

reputation that enjoys protection against dilution,<sup>129</sup> the trademark owner should be obliged to show that the use *deliberately* blurs, tarnishes or exploits in an unfair manner the distinctiveness or repute of such a trademark.<sup>130</sup> As the words “explicitly” and “deliberately” indicate, the threshold for a finding of dishonest practices should thus be higher than in the regular confusion or dilution analysis. This approach is in line with the strategy described above for remedying the circularity in CJEU jurisprudence. Although assessment criteria are used that have already supported a finding of *prima facie* infringement, the outcome of the honest practices analysis can be different because the criteria are applied in a modified way – in a way that lends sufficient weight to freedom of expression and freedom of the arts.

Interestingly, this modification of the honest practices test in cases of artistic expression finds support in Recital 21 EUTMR and Recital 27 TMD themselves. As discussed, these Recitals are problematic because they endanger art autonomy by stipulating that use for the purpose of artistic expression can be deemed fair only as long as it is in accordance with honest practices in industrial and commercial matters. In addition, however, Recital 21 EUTMR and Recital 27 recall the necessity to safeguard freedom of expression:

Furthermore, this Regulation [this Directive] should be applied in a way that ensures full respect for fundamental rights and freedoms, and in particular the freedom of expression. (addition within brackets added)

As Jens Schovsbo explains, this additional reference to freedom of expression impacts the application of all individual norms of EU trademark law, including the honest practices proviso itself:

The first part of the Recital provides for limitations but only to the extent that the use by third parties is fair and in accordance with honest practices in industrial and commercial matters. The application of fundamental rights and freedoms is not, however, made subject to the “fair and honest practices” test. Instead, this part constitutes a freestanding test (cf. the use of the word “furthermore”). This is also the effect of the use of the opening word – “furthermore” – and by the adjective “full respect.” It thus follows from the wording of the Recital itself that these interests should be taken into account when applying any rule or principle of trademark law [...] including the definition of which uses are “fair” and in conformity with “honest practices”.<sup>131</sup> (emphasis in the original text)

<sup>129</sup> CJEU, 14 September 1999, case C-375/97, *General Motors v. Yplon* (“Chevy”), paras. 24–28; CJEU, 6 October 2009, case C-301/07, *Pago v. Tirolmilch*, paras. 29–30; CJEU, 3 September 2015, case C-125/14, *Iron & Smith v. Unilever*, paras. 28–30. Cf. Kur and Senftleben (2017), paras. 5.201–5.204; Senftleben (2009), pp. 50–55; McCarthy (2004), p. 1163.

<sup>130</sup> As to the use of these criteria in the dilution analysis in EU trademark law, see Art. 10(2)(c) TMD; Art. 9(2)(c) EUTMR; and the distinction between three different anti-dilution actions in CJEU, 18 June 2009, case C-487/07, *L’Oréal v. Bellure*, paras. 39–41. Cf. Kur and Senftleben (2017), paras. 5.182–5.192; Senftleben (2013), p. 152.

<sup>131</sup> Schovsbo (2018), p. 568.

Therefore, it is important to recognize that the honest practices proviso itself is subject to more thorough scrutiny in light of freedom of expression. In cases where trademarks appear in a literary and artistic context, the second part of Recital 21 EUTMR and Recital 27 TMD (the sentence starting with “furthermore”) makes it necessary to give the honest practices proviso a meaning that “fully” respects freedom of expression. To achieve this goal, it is consistent to weave the bias described in favour of users in the artistic domain into the honest practices test. Instead of the standard confusion or dilution analysis, a higher threshold for demonstrating dishonest use must be applied.

The proposed higher bar of *explicitly* misleading or *deliberately* diluting use implements this approach. Only if use in the artistic domain is evidently disproportionate and harmful, should the trademark owner be able to demonstrate unusual circumstances that attest to dishonest practices and neutralize an artist’s invocation of referential, non-distinctive or descriptive use arguments. Only then is it justified to allow behavioural standards of industry and commerce to inform the analysis because the literary and artistic context proves to be a mere disguise for obvious trademark infringement. As this configuration of the honest practices test in cases of artistic use follows from the second “furthermore” part of Recital 21 EUTMR and Recital 27 TMD, the proposed solution based on a legal presumption of fair use is fully in line with EU trademark law. It is even a legal obligation that follows directly from the explicit confirmation of the need to safeguard freedom of expression in Recital 21 EUTMR and Recital 27 TMD.<sup>132</sup>

Moreover, the proposed distribution of the burden of proof is no outlier in EU trademark law. As explained, Art. 9(3)(f) EUTMR and Art. 10(3)(f) TMD already provide for a similar solution with regard to comparative advertising. Adopting a legal presumption of fair use in favour of artists can remedy the imbalance described in the treatment of commercial and artistic expression. Requiring *explicitly* misleading or *deliberately* diluting use in cases that concern artistic expression, EU trademark law offers a robust set of safeguards in both cases – commercial and artistic expression.

The proposed interpretation of the honest practices test in cases of artistic expression – leading to a legal presumption of fair use – also alleviates the problem of circularity of reasoning in CJEU jurisprudence. Providing qualified confusion and dilution criteria for the honest practices inquiry, this interpretation obliges the trademark owner to demonstrate a higher degree of harm. The artistic use of a trademark can be deemed to comply with honest practices in industrial and commercial matters as long as it does not *explicitly* mislead consumers as to the commercial source of the literary and artistic work, and as long as it does not *deliberately* damage or derive unfair advantage from the distinctiveness or repute of the trademark at issue. The introduction of the higher threshold of explicitly confusing or deliberately diluting use, makes the leeway for users in the artistic

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<sup>132</sup> Schovsbo (2018), p. 568, rightly refers to a “freestanding” obligation to provide sufficient room for freedom of expression. For confirmation of the impact of freedom of expression on the application of trademark norms, see CJEU, 27 February 2020, case C-240/18P, *Constantin Film v. EUIPO* (“*Fack Ju Göhte*”), para. 56.

domain broader and limits the rights of the trademark owner to cases of disproportionate harm.<sup>133</sup>

To some extent, the qualified confusion and dilution criteria for the honest practices test also takes care of the concern that behavioural standards in the sector of industry and commerce may prevail over art autonomy and govern creative processes in the artistic domain. Instead of allowing trademark categories of infringement to dominate the analysis, the question of an artistic context enters the picture and raises the bar for a finding of dishonest practices. In cases where a trademark is artistically relevant to the cultural production at issue, the trademark proprietor can only succeed if the allegedly infringing use explicitly misleads the public or deliberately dilutes the mark. As a result, an assessment criterion from the artistic domain – the artistic setting of the use – reduces the impact of trademark rights. Instead of allowing any form of confusion or dilution to tip the scales against the user in the artistic domain, only forms of use that are clearly harmful from a trademark perspective are actionable. The supremacy of behavioural standards known from the field of industry and commerce is confined to cases of evidently disproportionate harm that the trademark owner can hardly be expected to tolerate.

In sum, a circular repetition of standard confusion or dilution criteria in the honest practices analysis – and an erosion of art autonomy – can be prevented by aligning the honest practices proviso with the test of explicitly confusing or deliberately diluting use. This qualified test of confusion or dilution should constitute the threshold for rebutting the legal presumption of non-actionable use in an artistic context. When the higher threshold of explicitly misleading or deliberately diluting use is applied to identify dishonest practices in connection with the use of trademarks in an artistic setting, the honest practices test no longer deprives limitations of trademark rights of their function to allow for freedom of expression and freedom of the arts. Instead, the honest practices inquiry starts with a bias in favour of the artist – the presumption of fair use – and raises the question whether the trademark owner can rebut this legal presumption by providing proof of evidently disproportionate harm that unmask the artistic use argument as mere pretence to conceal blatant trademark infringement.

#### 5.4 Case-Law Precedents

Case-law developments on both sides of the Atlantic offer additional support for this solution of the honest practices dilemma. With regard to protection against confusion, the evolution of the so-called “Rogers” test in the U.S. is of particular importance (Sect. 5.4.1). As to dilution claims, the decision of the Benelux Court of Justice in *Moët Hennessy/Cedric Art* offers a blueprint for the implementation of the bias described in favour of artistic use (Sect. 5.4.2).

<sup>133</sup> Cf. the above-cited recommendation by Senftleben et al. (2015), p. 339. Cf. the analysis by Schovsbo (2018), pp. 578–579, who raises the question whether “the courts should begin their analysis from the perspective of the artist or from the perspective of what is fair as seen from a commercial point of view”, and recommends an interpretation that supports artistic freedom of expression.

#### 5.4.1 Higher Threshold for Protection Against Confusion

The development of the “Rogers” test in the U.S. began with the decision of the U.S. Court of Appeals for the Second Circuit in *Rogers/Grimaldi*. In this case, the Court was called upon to decide on an infringement claim brought by the actress Ginger Rogers against the use of her name in the title of Federico Fellini’s film “Ginger and Fred.” The film told the story of two fictional Italian cabaret performers – Pippo and Amelia – who imitated Ginger Rogers and Fred Astaire and became known in Italy as “Ginger and Fred.” Seeking to make a satiric comment on television variety shows, the film focused on a televised reunion of Pippo and Amelia many years after their retirement. Ginger Rogers based her infringement claim on the argument that the film’s title created the false impression that she was associated with the film production.<sup>134</sup>

Dealing with this claim, the Court of Appeals emphasized the expressive dimension of film titles. Judge Newman explained that filmmakers frequently relied on “word-play, ambiguity, irony, and allusion in titling their works”.<sup>135</sup> The Court also lent weight to the interest of the audience in sufficient breathing space for free expression. The subtleties of a title could enrich understanding of the work. Consumers of artistic works had a dual interest against this background: on the one hand, the interest in not being misled; on the other hand, the interest in enjoying the results of the filmmaker’s freedom of expression. For all these reasons, the Court concluded that the expressive element of titles of literary and artistic works required more protection than the labelling of ordinary commercial products:

We believe that in general the [Lanham] Act should be construed to apply to artistic works only where the public interest in avoiding consumer confusion outweighs the public interest in free expression.<sup>136</sup> (text inside square brackets added)

From the outset, the Court thus established a bias in favour of users in the artistic domain. Instead of allowing concerns about regular confusion harm to occupy centre stage, the Court was willing to let the interest in free expression prevail. This approach corresponds with the strategy recommended above: to avoid an erosion of artistic autonomy and provide sufficient scope for freedom of expression and freedom of the arts, it is necessary to depart from the standard trademark infringement analysis and factor an element into the honest practices analysis that permits the expressive nature of the use to tip the scales in favour of the artistic user. In *Rogers*, this approach culminated in the creation of an assessment framework that later became known as the “Rogers” test:<sup>137</sup>

In the context of allegedly misleading titles using a celebrity’s name, that balance will normally not support application of the [Lanham] Act unless the

<sup>134</sup> U.S. Court of Appeals for the Second Circuit, 5 May 1989, *Rogers and Grimaldi*, 875 F.2d 994 (2nd Cir. 1989), 997.

<sup>135</sup> U.S. Court of Appeals for the Second Circuit, *id.*, 998.

<sup>136</sup> U.S. Court of Appeals for the Second Circuit, *id.*, 999.

<sup>137</sup> Cf. Dinwoodie (2022), pp. 1–2; Calboli (2014b), pp. 72–76.

title has no artistic relevance to the underlying work whatsoever, or, if it has some artistic relevance, unless the title explicitly misleads as to the source or the content of the work.<sup>138</sup> (text inside square brackets added)

Hence, permitted use in an artistic context is the rule; infringing use is the exception. Only if the unauthorized use *explicitly* misleads the public can an infringement claim have success.<sup>139</sup> Following this approach, the Second Circuit focused on the question whether there were clear indications that the name “Ginger” had been included in the film title for the very purpose of giving the false impression that Ginger Rogers endorsed and supported the film production. As there was no evidence that the film title was explicitly misleading in this sense, the Court found no infringement:

The survey evidence, even if its validity is assumed, indicates at most that some members of the public would draw the incorrect inference that Rogers had some involvement with the film. But that risk of misunderstanding, not engendered by any overt claim in the title, is so outweighed by the interests in artistic expression as to preclude application of the Lanham Act.<sup>140</sup>

The Court thus suppressed standard infringement arguments and instead lent weight to the expressive nature of the allegedly infringing use. Ginger Rogers could only have rebutted the presumption of non-infringement by demonstrating explicitly misleading use under the guise of literary and artistic expression. This approach – allowing artistic relevance to pose a substantial obstacle to standard trademark infringement arguments – is fully in line with the configuration of the honest practices proviso proposed above.

Subsequent developments in U.S. case law confirm that the “Rogers” test can provide a useful template for trademark cases. *Rogers* concerned the allegedly misleading use of a celebrity’s name in a film title.<sup>141</sup> The Second Circuit, however, did not hesitate to broaden the test’s ambit of operation several months later in *Cliffs Notes/Bantham Doubleday* – a case that concerned book parodies in study guide format that imitated distinctive elements of the covers of Cliffs Notes’ study guides for short stories, plays and books.<sup>142</sup> Dealing with the satirical play with the format and style of Cliffs Notes’ books, the Second Circuit pointed out that the case did not raise the question whether a title was false advertising but whether the appearance of a work’s cover was confusingly similar to the elements of an earlier cover protected by trademark. The Court also recognized that, in *Cliffs Notes*, an element of parody that had not been present in *Rogers* entered the picture. These differences, however, did not inhibit the Second Circuit from relying on the “Rogers” test. On the contrary, the Court emphasized that it was appropriate to weigh the public interest in free expression against the public interest in avoiding consumer

<sup>138</sup> U.S. Court of Appeals for the Second Circuit, *id.*, 999.

<sup>139</sup> Dinwoodie (2022), pp. 2–3.

<sup>140</sup> U.S. Court of Appeals for the Second Circuit, *id.*, 1001.

<sup>141</sup> U.S. Court of Appeals for the Second Circuit, *id.*, 999.

<sup>142</sup> U.S. Court of Appeals for the Second Circuit, 5 September 1989, *Cliffs Notes v. Bantham Doubleday Dell Publishing Group*, 886 F.2d 490 (2nd Cir. 1989), 492. *Cf.* Dinwoodie (2022), pp. 2–3.

confusion in any case where an expressive work was alleged to infringe a trademark right under the U.S. Lanham Act:

Thus, we hold that the Rogers balancing approach is generally applicable to Lanham Act claims against works of artistic expression, a category that includes parody.<sup>143</sup>

Applying the “Rogers” test, the Court then dismissed the infringement claim as a matter of law even though the district judge had found a strong likelihood of confusion. The Second Circuit recalled that trademark owners had to tolerate more and surmount a higher hurdle when artistic expression was involved.<sup>144</sup>

#### 5.4.2 Higher Threshold for Protection Against Dilution

In the field of protection against dilution, a similar tendency of immunizing artistic use against trademark infringement claims comes to the fore in the decision of the Benelux Court of Justice in *Moët Hennessy/Cedric Art*. The case concerned the open-ended defence of “due cause”, which, under Art. 9(2)(c) EUTMR and Art. 10(2)(c) TMD, makes it possible to escape dilution claims based on blurring, tarnishment or free-riding arguments.<sup>145</sup> In Benelux trademark law, the “due cause” defence is also available under Art. 2.20(2)(d) of the Benelux Convention on Intellectual Property (BCIP), which offers trademark owners the possibility of bringing infringement claims even if use does not serve the purpose of distinguishing goods or services in the course of trade.<sup>146</sup> Prior to the decision of the Benelux Court of Justice, the due cause defence had already prevented the condemnation of biting “Miffy” (*Nijntje*) parodies that had depicted the trademarked children’s book character as a 9/11 terrorist.<sup>147</sup> In *Moët Hennessy*, the Benelux Court of Justice went a step further. Reaching beyond parody cases, it developed an *exceptio artis* on the basis of the due cause defence. The case concerned the use of the trademarked Dom Pérignon bottle<sup>148</sup> in stylized form and neon colours in paintings, which, according to the artist Cédric Peers, played with pointillism and pop art.<sup>149</sup>

<sup>143</sup> U.S. Court of Appeals for the Second Circuit, *id.*, 495–496.

<sup>144</sup> U.S. Court of Appeals for the Second Circuit, *id.*, 498.

<sup>145</sup> As to these three anti-dilution actions, see CJEU, 18 June 2009, case C-487/07, *L’Oréal v. Bellure*, paras. 39–41. Cf. Kur and Senftleben (2017), paras. 5.182–5.192; Senftleben (2013), p. 152. As to the defence of due cause, see CJEU, 22 September 2011, case C-323/09, *Interflora v. Marks & Spencer*, para. 91; CJEU, 6 February 2014, case C-65/12, *Leidseplein Beheer v. Red Bull*, paras. 54–58. Cf. Kur and Senftleben (2017), paras. 5.265–5.268 and 6.59–6.63; Di Cataldo (2011), p. 833.

<sup>146</sup> Cf. Vanovermeire (2009), pp. 187–188.

<sup>147</sup> Court of Appeals of Amsterdam, 13 September 2011, case NL:GHAMS:2011:BS7825, *Mercis and Bruna v. Punt*, Tijdschrift voor auteurs-, media- en informatierecht 2012, p. 28, para. 4.19. For a further example of the successful invocation of the due cause defence in an artistic context, see German Federal Supreme Court, 3 February 2005, case I ZR 159/02, *Lila Postkarte*, GRUR 2005, p. 583 (585). Cf. Senftleben (2017), pp. 256–265.

<sup>148</sup> IR No. 323543.

<sup>149</sup> See <https://www.cedricgallery.com/> for examples.

Assessing this unauthorized use of Hennessy's trademark, the Benelux Court of Justice stated that artistic freedom – as an aspect of the artist's right to freedom of expression – could constitute a due cause when “there is an artistic expression that is the original result of a creative shaping process.”<sup>150</sup> The Court added, however, that the artistic expression must not specifically intend to harm the trademark or the proprietor of the trademark.<sup>151</sup> The Court thus brought into focus the question whether the artist intended to cause damage. Accordingly, it required evidence of intention to harm the trademark or the trademark owner.

Like the “Rogers” test in the U.S., the decision in *Moët Hennessy* points in the direction of a legal presumption of non-infringement that can only be rebutted when exceptional circumstances arise. Interestingly, the Benelux Court of Justice explicitly relied on Art. 10(1) of the European Convention on Human Rights (ECHR) to undergird the artist's right to include trademarks in artistic expression without prior authorization. Instead of referring to trademark norms, such as the honest practices proviso, the Court based the prohibition of use that specifically aims to cause harm on Art. 10(2) ECHR, which allows limitations of freedom of expression that are “necessary in a democratic society [...] for the protection of the reputation or rights of others ...”.<sup>152</sup> Hence, the Court viewed the trademark infringement claim through the prism of fundamental rights and refrained from presuming any superiority of trademark protection that could have led to an assessment on the basis of regular confusion or dilution standards. Instead of scrutinizing the artistic use in light of trademark infringement categories, such as blurring, tarnishment and unfair free-riding, the Court aligned its ruling with the guarantee of freedom of expression in the ECHR and required use that specifically aims to cause damage.

## 6 Conclusion

EU trademark law fails to provide for robust gatekeeper requirements that render infringement claims against use in artistic contexts futile from the outset. Under the *aegis* of the CJEU, the general requirements of use “in the course of trade” and “in relation to goods or services” have lost their potential to prevent trademark owners from establishing *prima facie* infringement. The regulation of artistic use differs markedly from the situation in the area of comparative advertising, where the 2015 trademark law reform led to the adoption of a new rule that shields advertisers complying with MCAD requirements against trademark infringement claims. In the absence of a comparable rule for artistic use, artists can only invoke defences for referential, descriptive and non-infringing use to justify the use of trademarks in their creative work. This imbalance in the treatment of commercial expression on the one hand, and artistic expression on the other, is further enhanced by the additional requirement to ensure compliance with honest practices in industrial and

<sup>150</sup> Benelux Court of Justice, 14 October 2019, case A2018/1/8, *Moët Hennessy v. Cedric Art*, para. 9.

<sup>151</sup> Benelux Court of Justice, *id.*, para. 9.

<sup>152</sup> Benelux Court of Justice, *id.*, para. 9.

commercial matters. The honest practices test subordinates artistic creativity to behavioural standards in the field of industry and commerce. It poses a threat to art autonomy. The CJEU enhances this risk by replicating standard confusion and dilution criteria in the honest practices analysis. To provide sufficient scope for freedom of expression and freedom of the arts, it is indispensable against this background to change the configuration of the EU limitation infrastructure for artistic use. As a way out of the dilemma, a legal presumption of fair use must be introduced, which the trademark owner can only overcome by showing that the artistic use explicitly causes confusion or deliberately blurs, tarnishes or takes unfair advantage of the distinctive character or repute of a trademark with reputation.

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## References

- Adler A (2016) Fair use and the future of art. *N Y Univ Law Rev* 91:559
- Amabile TM (1996) *Creativity in context*. Westview Press, Boulder
- Aplin T, Bently L (2020) *Global mandatory fair use: the nature and scope of the right to quote copyright works*. Cambridge University Press, Cambridge
- Assaf K (2008) The dilution of culture and the law of trademarks. *IDEA Intellect Prop Law Rev* 1:49
- Aufderheide P, Jaszi P, Bello B, Milosevic T (2014) *Copyright, permissions, and fair use in the visual arts communities: an issues report*. American University, Washington D.C. [https://cmsimpact.org/wp-content/uploads/2016/01/fair\\_use\\_for\\_visual\\_arts\\_communities.pdf](https://cmsimpact.org/wp-content/uploads/2016/01/fair_use_for_visual_arts_communities.pdf)
- Aufderheide P, Jaszi P (2004) *Untold stories: creative consequences of the rights clearance culture for documentary filmmakers*. American University, Washington D.C.
- Banerjee A (2012) Non-origin infringement – has trade mark law gone too far? *IIC* 43:555
- Benkler Y (1999) Free as the air to common use: first amendment constraints on enclosure of the public domain. *N Y Univ Law Rev* 74:354
- Bohaczewski M (2020) Conflicts between trade mark rights and freedom of expression under EU trade mark law: reality or illusion? *IIC* 51:856
- Born C (2006) Zur Zulässigkeit einer humorvollen Markenparodie – Anmerkungen zum Urteil des BGH “Lila Postkarte”, *GRUR*, p 192
- Bourdieu P, Chartier R, Darnton R (1985) Dialog über die Kulturgeschichte. *Freibeuter Vierteljahreszeitschrift für Kultur und Politik* 26:22
- Bourdieu P (1996) Die Logik der Felder. In: Bourdieu P, Wacquant LJD (eds) *Reflexive Anthropologie*. Suhrkamp, Frankfurt/Main, p 124
- Bourdieu P (1999) Die Regeln der Kunst. *Genese und Struktur des literarischen Feldes*. Suhrkamp, Frankfurt/Main 1999 (French original: Bourdieu P (1992) *Les règles de l'art. Genèse et structure du champ littéraire*. Éditions du Seuil, Paris)
- Buccafusco C, Bechtold S, Sprigman CJ (2017) The nature of sequential innovation. *William Mary Law Rev* 59:1
- Burrell R, Gangjee D (2010) Trade marks and freedom of expression: a call for caution. *Int Rev Intellect Prop Compet Law* 41:544

- Calboli I (2014) Overlapping rights: the negative effects of trademarking creative works. In: Frankel S, Gervais DJ (eds) *The evolution and equilibrium of copyright in the digital age*. Cambridge University Press, Cambridge, p 52
- Calboli I (2014a) Overlapping trademark and copyright protection: a call for concern and action. *Illinois Law Review Slip Opinion No. 1*, 25
- Cohen JE (2006) Copyright, commodification, and culture: locating the public domain. In: Guibault LMCR, Hugenholtz PB (eds) *The future of the public domain – identifying the commons in information law*. Kluwer Law International, The Hague, p 121
- Coombe RJ (2003) Fear, hope, and longing for the future of authorship and a revitalized public domain in global regimes of intellectual property. *DePaul Law Rev* 52:1171
- Cramer F (2015) Geef iedereen het recht op parodie. *NRC Handelsblad* posted 15 April 2015. <https://www.nrc.nl/nieuws/2015/04/15/geef-iedereen-het-recht-op-parodie-1484558-a197827>. Accessed 12 Jan 2022
- Davison M, Di Giantomasso F (2009) Use as a trade mark: avoiding confusion when considering dilution. *EIPR*, p 443
- Derclaye E, Leistner M (2011) *Intellectual property overlaps – a European perspective*. Hart Publishing, Oxford and Portland (Oregon)
- Di Cataldo V (2011) The trade mark with a reputation in EU law – some remarks on the negative condition “without due cause.” *IIC* 42:833
- Dinwoodie GB (2022) *Rogers* and the structure of trademark defenses. In: Beebe B, Sun H (eds) *Charting limitations on trademark rights*. Oxford University Press, Oxford, p 1
- Dinwoodie GB, Janis MD (2007) Confusion over use: contextualism in trademark law. *Iowa Law Rev* 92:1597
- Dogan SL (2016) Bullying and opportunism in trademark and right-of-publicity law. *Boston Univ Law Rev* 96:1293
- Dogan SL, Lemley MA (2004) Trademarks and consumer search costs on the internet. *Houston Law Rev* 41:777
- Dogan SL, Lemley MA (2008) The trademark use requirement in dilution cases. *Santa Clara Comput High Technol Law J* 24:541
- Dreyfuss RC (1990) Expressive genericity: trademarks as language in the Pepsi generation. *Notre Dame Law Rev* 65:397
- Fromer JC (2010) A psychology of intellectual property. *Northwest Univ Law Rev* 104(2010):1441
- Frosio GF (2014) Rediscovering cumulative creativity from the oral formulaic tradition to digital remix: can I get a witness? *John Marshall Rev Intelect Prop Law* 13:341
- Gangjee DS (2013) Property in brands: the commodification of conversation. In: Howe HR, Griffiths J (eds) *Concepts of property in intellectual property law*. Cambridge University Press, Cambridge, p 29
- Geiger C (2006) “Constitutionalising” intellectual property law? The influence of fundamental rights on intellectual property in the European Union. *IIC* 37:371
- Geiger C (2007) Trade marks and freedom of expression – the proportionality of criticism. *IIC* 38:317
- Geiger C (2009) Intellectual property shall be protected!?! Article 17(2) of the Charter of Fundamental Rights of the European Union: a mysterious provision with an unclear scope. *Eur Intelect Prop Rev* 31:113
- Geiger C, Izyumenko E (2014) Copyright on the human rights’ trial: redefining the boundaries of exclusivity through freedom of expression. *IIC* 45:316
- Geiger C, Izyumenko E (2020) The constitutionalization of intellectual property law in the EU and the *Funkel Medien, Pelham and Spiegel Online* decisions of the CJEU: progress, but still some way to go! *IIC* 51:282
- Geiger C (2010) Marques et droits fondamentaux. In: Geiger C, Schmidt-Szalewski J (eds) *Les défis du droit des marques au 21<sup>e</sup> siècle/Challenges for Trademark Law in the 21st Century*. Litec 2010, Paris, p 163
- Gibson J (2007) Risk aversion and rights accretion in intellectual property law. *Yale Law J* 116:882
- Götting H-P (2001) Persönlichkeitsmerkmale von verstorbenen Personen der Zeitgeschichte als Marke. *GRUR*, p 615
- Greener J (2015) If you give a mouse a trademark: Disney’s monopoly on trademarks in the entertainment industry. *Wake Forest J Bus Intelect Prop Law* 15:598

- Griffiths J, McDonagh L (2013) Fundamental rights and European IP law – the case of Art 17(2) of the EU Charter. In: Geiger C (ed) *Constructing European intellectual property achievements and new perspectives*. Edward Elgar, Cheltenham, p 75
- Gulasekaram P (2005) Policing the border between trademarks and free speech: protecting unauthorized trademark use in expressive works. *Washington Law Rev* 80:887
- Henning-Bodewig F (2008) Nicht markenmäßiger Gebrauch und Art. 5 Abs. 5 Markenrichtlinie. *GRUR Int.*, p 301
- Hofrichter JA (2007) Tool of the trademark: brand criticism and free speech problems with the federal Dilution Revision Act of 2006. *Cardozo Law Rev* 28:1923
- Hughenoltz PB (2002) Copyright and freedom of expression in Europe. In: Elkin-Koren N, Netanel NW (eds) *The commodification of information*. Kluwer, The Hague, p 239
- Hughenoltz PB (2016) Flexible copyright, can EU author's right accommodate fair use? In: Okediji R (ed) *Copyright law in an age of limitations and exceptions*. Cambridge University Press, Cambridge, p 242
- Hughes J (2015) Cognitive and aesthetic functionality in trademark law. *Cardozo Law Rev* 36:1227
- Izumenko E (2020) The freedom of expression perspectives on intellectual property in Europe. CEIPI, Strasbourg
- Jacques S (2016) A parody exception: why trade mark owners should get the joke. *Eur Intellect Prop Rev* 38:471
- Jongsma DJW (2019) *Creating EU copyright law – striking a fair balance*. Hanken School of Economics, Helsinki
- Knaak R, Kur A, von Mühlendahl A (2011) *Study on the Functioning of the European Trade Mark System*, Max Planck Institute for Intellectual Property & Competition Law Research Paper No. 12–13. Max Planck Institute, Munich. [http://ec.europa.eu/internal\\_market/indprop/tm/index\\_en.htm](http://ec.europa.eu/internal_market/indprop/tm/index_en.htm)
- Kur A (2018) Yellow dictionaries, red banking services, some candies, and a sitting bunny: protection of color and shape marks from a German and European perspective. In: Calboli I, Senftleben MRF (eds) *The protection of non-traditional trademarks – critical perspectives*. Oxford University Press, Oxford, p 89
- Kur A (2021) “As good as new” – sale of repaired or refurbished goods: commendable practice or trade mark infringement? *GRUR Int* 70:228
- Kur A, Senftleben MRF (2017) *European trade mark law – a commentary*. Oxford University Press, Oxford
- Kur A (2008) Confusion over use? – Die Benutzung “als Marke” im Lichte der EuGH-Rechtsprechung. *GRUR Int.*, p 1
- Kur A (2017) Gemeinfreiheit und Markenschutz – Bemerkungen zur Entscheidung des EFTA-Gerichtshofs im Vigeland-Fall. *GRUR*, p 1082
- Lemley MA, McKenna MP (2010) Irrelevant confusion. *Stanford Law Rev* 62:413
- Lessig L (2004) *Free culture: how big media uses technology and the law to lock down culture and control creativity*. Penguin Press, New York
- Leval PN (2004) Trademark: champion of free speech. *Columbia J Law Arts* 27:187
- Loughlan PL (2000) Protecting culturally significant uses of trade marks (without a first amendment). *EIPR* 22:328
- Luhmann N (1984) *Soziale Systeme: Grundriß einer allgemeinen Theorie*. Suhrkamp, Frankfurt/Main
- Macciaccchini S (2000) *Urheberrecht und Meinungsfreiheit*. Stämpfli, Bern
- McCarthy JT (2004) Dilution of a trademark: European and United States law compared. *Trademark Report* 94:1163
- McGeever W (2008) Four free speech goals for trademark law. *Fordham Intellect Prop Media Entertain Law J* 18:1205
- McKenna MP (2009) Trademark use and the problem of source. *Univ Ill Law Rev* 2009:773
- Morrison DM (2008) Bridgeport redux: digital sampling and audience recoding. *Fordham Intellect Prop Media Entertain Law J* 19:75
- Nasser M (2009) Trade marks and freedom of expression. *IIC* 40:188
- Netanel NW (1996) Copyright and a democratic civil society. *Yale Law J* 106:283
- Netanel NW (2008) *Copyright's paradox*. Oxford University Press, New York
- Ohly A (2019) Schutz von Kulturgütern durch das Markenrecht? In: Hacker F, Thiering F (eds) *Festschrift für Paul Ströbele zum 75. Geburtstag*, Cologne: Carl Heymanns, p 325
- Peukert A (2019) Fictitious commodities: a theory of intellectual property inspired by Karl Polanyi's great transformation. *Fordham Intellect Prop Media Entertain Law J* 29:1151

- Peukert A (2012) *Die Gemeinfreiheit*. Mohr Siebeck, Tübingen
- Peukert A (2016) Vom Warenzeichen zum Markeneigentum. Ein polyanischer Erklärungsversuch. In: Büscher W, Glöckner J, Nordemann A, Osterrieth C, Rengier R (eds) *Marktkommunikation zwischen Geistigem Eigentum und Verbraucherschutz*. Festschrift für Karl-Heinz Fezer zum 70. Geburtstag. C.H. Beck, Munich, p 405
- Ramsey LP (2010) Free speech and international obligations to protect trademarks. *Yale J Int Law* 35(2010):405
- Ramsey LP (2018) Free speech challenges to trademark law after *Matal v. Tam*. *Houston Law Rev* 56:401
- Ramsey LP, Schovsbo J (2013) Mechanisms for limiting trade mark rights to further competition and free speech. *IIC* 44:671
- Sakulin V (2010) *Trademark protection and freedom of expression – an inquiry into the conflict between trademark rights and freedom of expression under European law*. Kluwer Law International, The Hague
- Schovsbo J (2018) “Mark my words” – trademarks and fundamental rights in the EU. *UC Irvine Law Rev* 8:555
- Senftleben MRF (2009) The trademark tower of Babel – dilution concepts in international, US and EC trademark law. *IIC* 40:45
- Senftleben MRF (2011) Keyword advertising in Europe – how the internet challenges recent expansions of EU trademark protection. *Conn J Int Law* 27:39
- Senftleben MRF (2013) Adapting EU trademark law to new technologies – back to basics? In: Geiger C (ed) *Constructing European intellectual property*. Edward Elgar, Cheltenham, p 137
- Senftleben MRF (2015) Free signs and free use – how to offer room for freedom of expression within the trademark system. In: Geiger C (ed) *Research handbook on human rights and intellectual property*. Edward Elgar, Cheltenham, p 354
- Senftleben MRF (2017) The perfect match – civil law judges and open-ended fair use provisions. *Am Univ Int Law Rev* 33:231
- Senftleben MRF, Bently LAF, Dinwoodie GB et al (2015) The recommendation on measures to safeguard freedom of expression and undistorted competition: guiding principles for the further development of EU trade mark law. *Eur Intellect Prop Rev* 37:337
- Senftleben MRF (2020) The copyright/trademark interface – how the expansion of trademark protection is stifling cultural creativity. Wolters Kluwer, Alphen aan den Rijn
- Simon Fhima I (2005) How does “essential function” doctrine drive European trade mark law? *IIC* 36:401
- Simon Fhima I (2012) The role of legitimacy in trade mark law. *Curr Leg Probl* 65:489
- Simon Fhima I (2013) Trade marks and free speech. *IIC* 44:293
- Simon Fhima I, Jacob R (2014) Unfair advantage law in the European Union. In: Bereskin D (ed) *International trademark dilution*. Thomson Reuters Westlaw, New York, p 251
- Simon Fhima I (2006) Embellishment: trademark use triumph or decorative disaster? *EIPR*, p 321
- Strowel A, Tulkens F, Voorhoof D (2006) *Droit d’auteur et liberté d’expression*. Editions Larcier, Brussels
- Vanovermeire V (2009) *Inschrijving als merk van een in het publiek domain gevallen werk*. In: Cruquenaire A, Dusollier S (eds) *Le Cumul des droits intellectuels*. Larcier, p 177
- Visser DJG (2011) *Darfurnica: modellenrecht versus kunstvrijheid*. *Nederlands Juristenblad* 2011:740
- Weckström K (2007) The lawfulness of criticizing big business: comparing approaches to the balancing of societal interests behind trademark protection. *Lewis Clark Law Rev* 11:671
- Yap PJ (2009) Essential function of a trade mark: from BMW to O2. *EIPR*, p 81
- Żelechowski Ł (2018) Invoking freedom of expression and freedom of competition in trade mark infringement disputes: legal mechanisms for striking a balance. *ERA Forum* 19:115

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