



University of Bayreuth

Chair for Civil Law VIII: Private Law and Intellectual Property Law -  
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# Trade Marks and Free Speech – Interfaces between Trade Mark Law and European Constitutional Law

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Conference “Global IP and New Interfaces”  
Helsinki, 16 April 2010



# 1. Introduction



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A conservative approach:

TM  
guarantees  
correct  
indication of  
commercial  
origin

Freedom of  
expression is  
limited to  
political  
speech



# 1. Introduction



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But TM law has been extended and strengthened...

- Protection of other functions
  - Protection of well-known marks against dilution and misappropriation (Arts 5 (2) TMD, 9 (1)(c) CTMR)
  - Broad interpretation of “double identity” infringement (Arts 5 (1)(a) TMD, 9 (1)(a) CTMR) in case C-487/07, *L'Oréal*
  - → TM has developed from indication of origin to right of communication
- Constitutional law protection of TMs
  - Art 1 Prot 1 ECHR: ECHR, *Anheuser-Busch v Portugal*, 73049/01 [2007] ECHR 40
  - Art 17 (2) EU Charter of Fundamental Rights



## 1. Introduction



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... and Art 10 ECHR protects commercial speech.

- “Everyone has the right to freedom of expression.”
- Commercial speech protected ...
  - *Hertel v Switzerland*, 25181/94 [1998] ECHR 77
  - *Krone Verlag (No 3) v Austria*, 39069/97 [2003] ECHR 683
  - *Brzank v Germany*, 7969/04
- ... but courts enjoy a wider degree of appreciation in commercial matters
- How about Art 11 EU Charter?

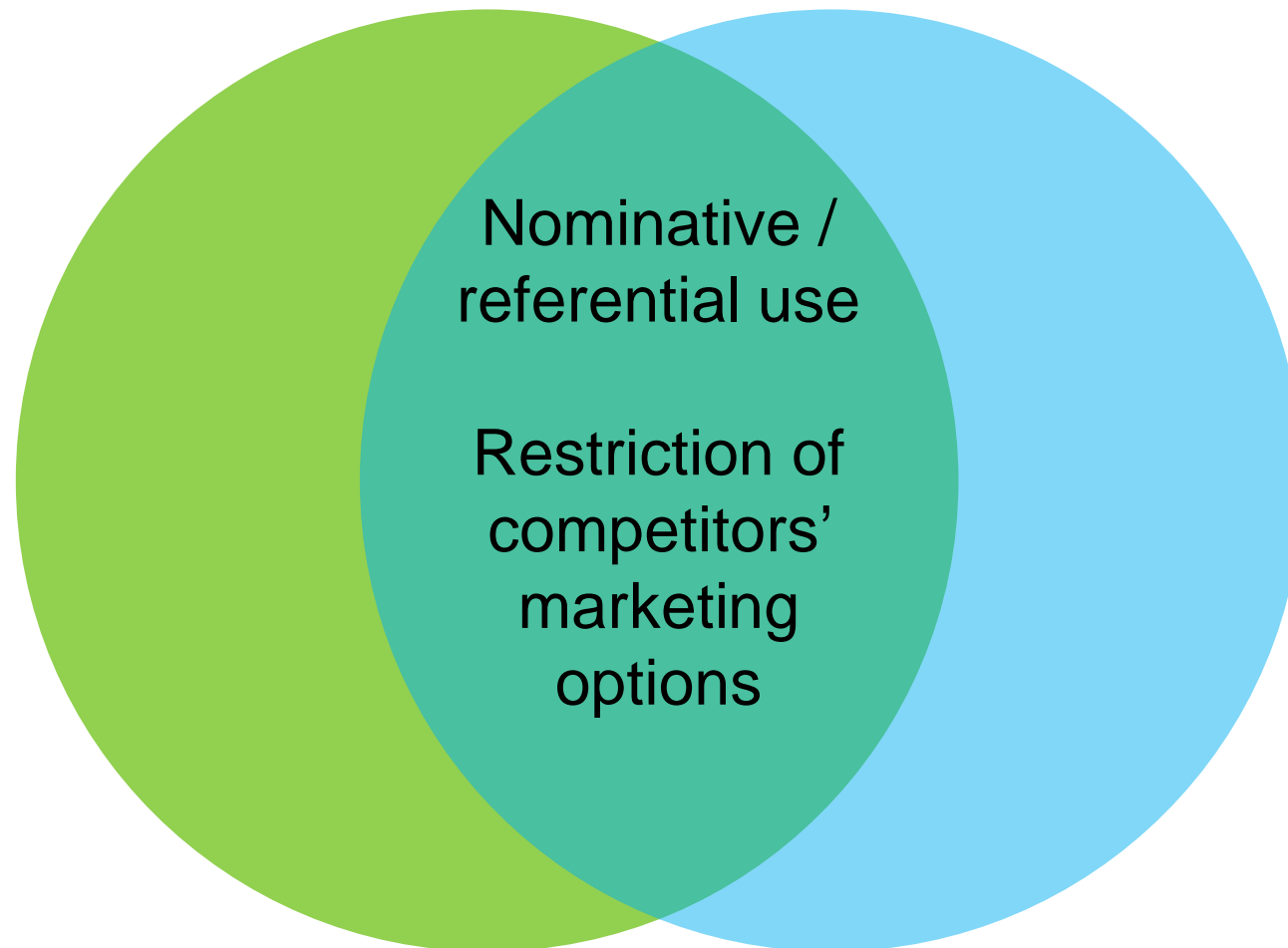


# 1. Introduction



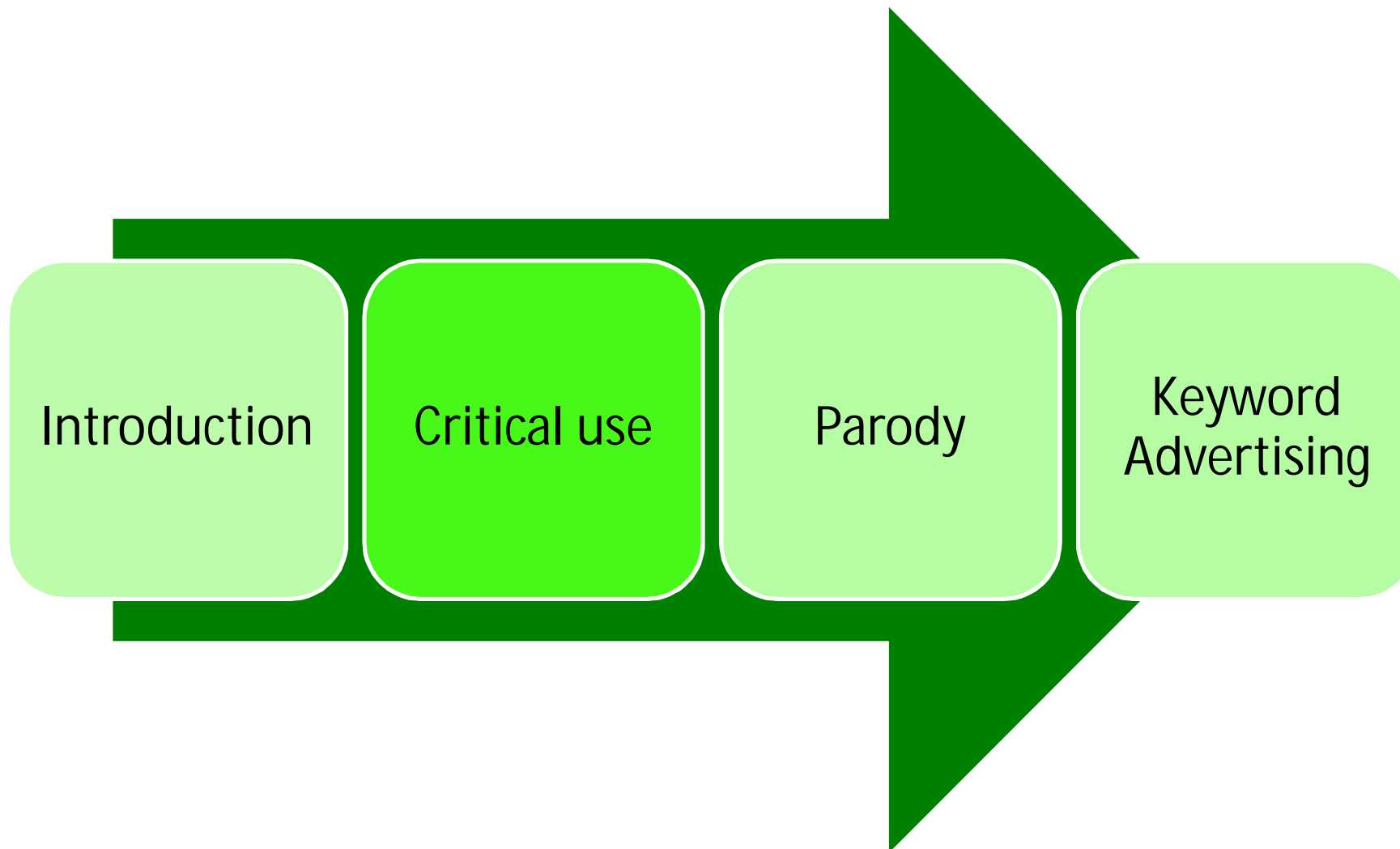
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The situation 2010:





# Outline





## 2. Critical use: examples



### The Greenpeace cases

Cour de Cassation (F), [2009] IIC 241 – *Esso v Greenpeace*

Federal Supreme Court (D), NJW 2008, 2110 – *Müller v Greenpeace*

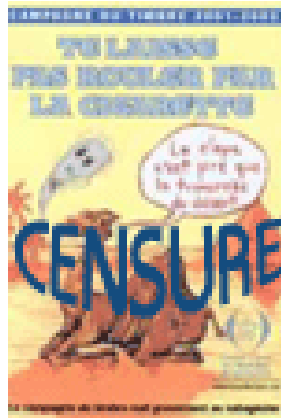




## 2. Critical use: examples



### The anti-smoking cases



Cour de Cassation (F)  
[2007] IIC 357 –  
*Camel v CNCMR*



November

Federal Supreme  
Court (D), GRUR  
1984, 684 – *Mordoro*

NICHTRAUCHER KALENDER 1981



So	1	15
Mo	2	16
Di	3	17
Mi	4	18
Do	5	19
Fr	6	20
Sa	7	21
So	8	22
Mo	9	23
Di	10	24
Mi	11	25
Do	12	26
Fr	13	27
Sa	14	28
So	29	
Mo	30	
Di	31	

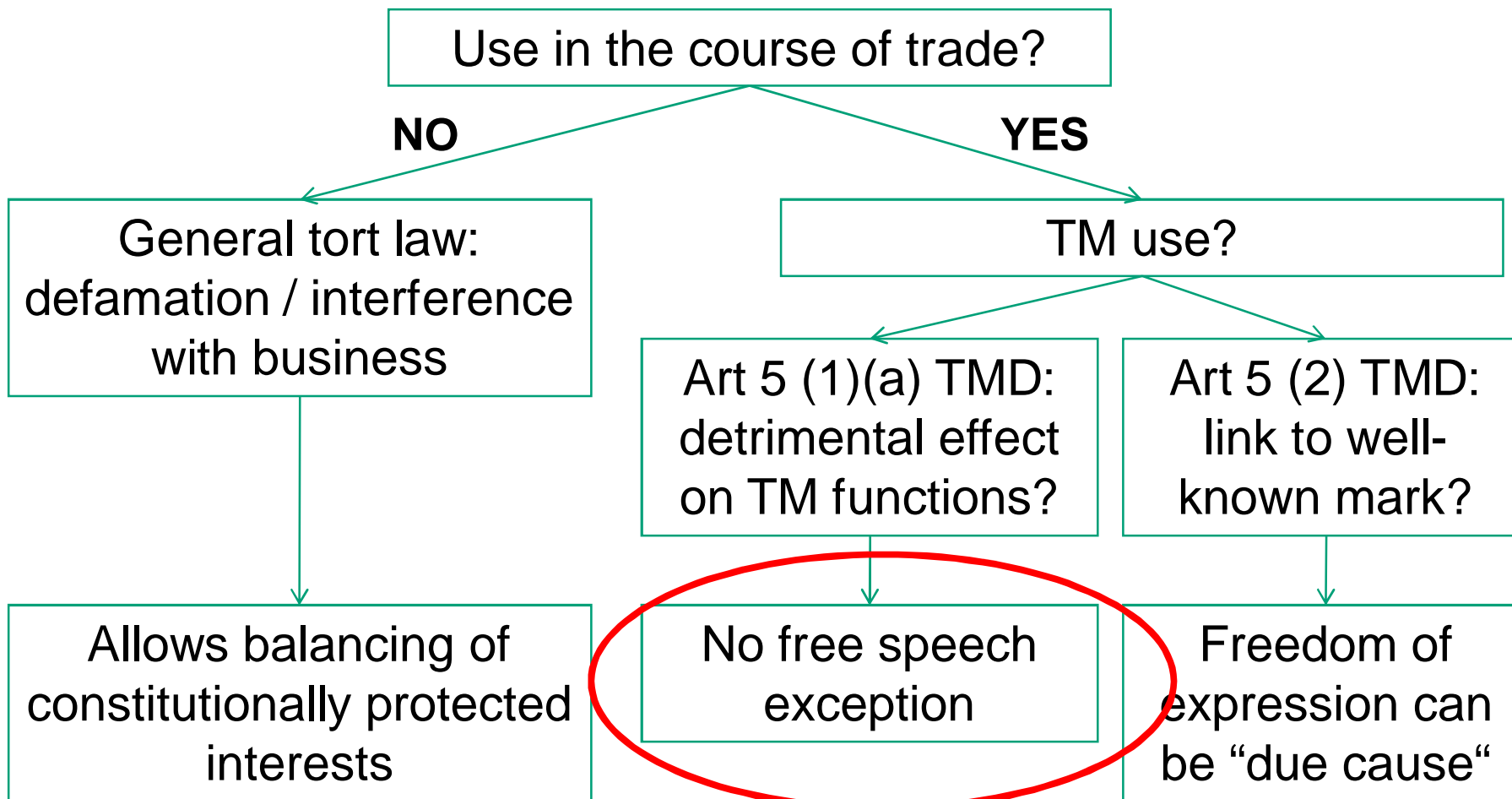


AUS NICHTRAUCHERS BASTELKISTE

März

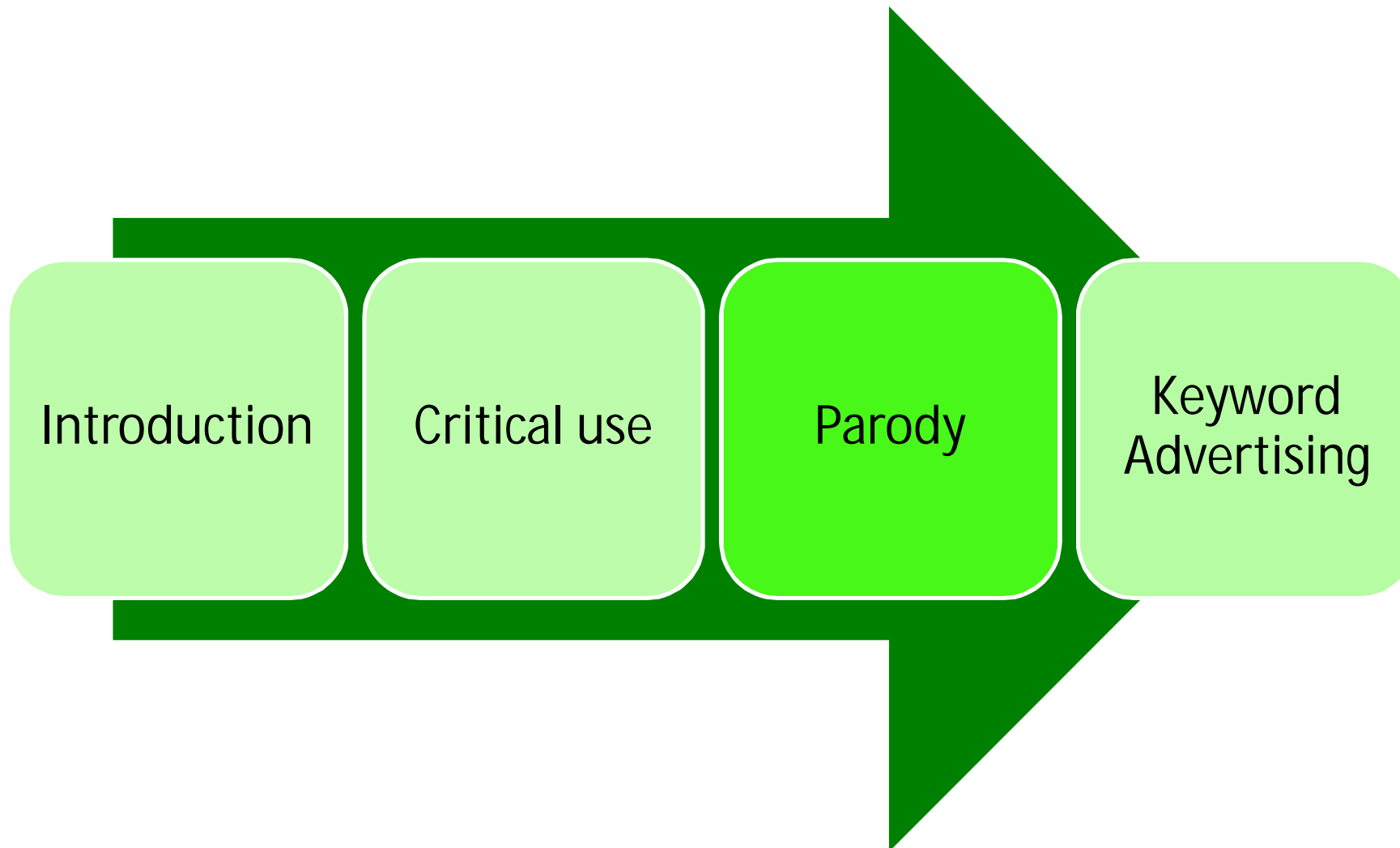


## 2. Critical use: analysis





# Outline





### 3. Parody: three categories



Category 1: parodies for  
purpose of political discussion



... see above



### 3. Parody: three categories



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## Category 2: fun articles



Frankfurt Court of Appeal,  
GRUR 1982, 319 – *Lusthansa*

Federal Supreme Court  
(D), GRUR 1994, 808 –  
*Mars / Markenverun-  
glimpfung I*





### 3. Parody: three categories



## Category 2 (cont'd)



US Court of Appeals (4th Cir),  
*Louis Vuitton v Haute Diggity Dog*,  
507 F.3d 252 (4th Cir 2007)



STYRIAGRA®

Austrian Supreme Court,  
22/9/2009, 17 Ob 15/09v –  
*Viagra/Styriagra*



### 3. Parody: three categories



## Category 3: literary and artistic parody



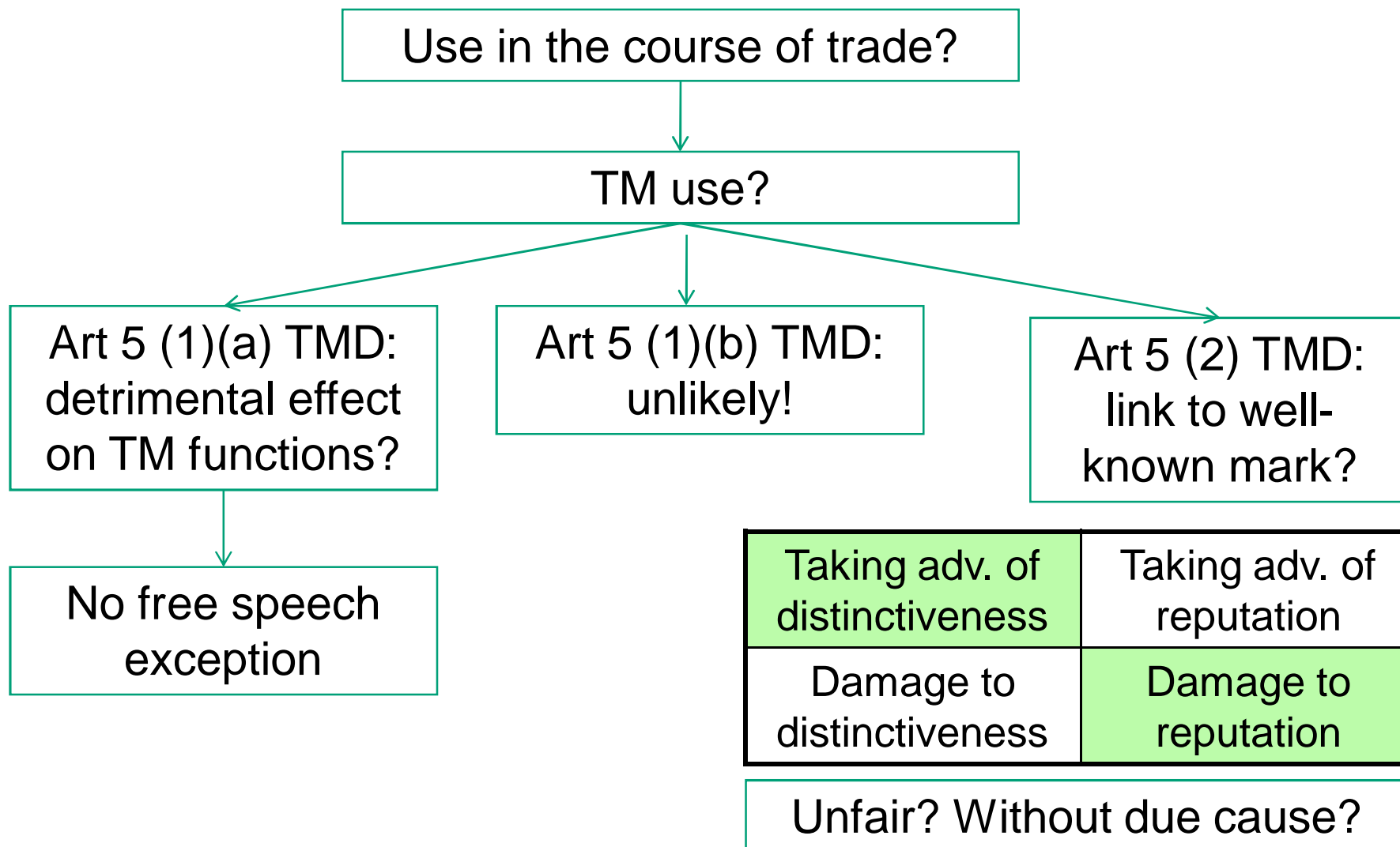
District Court of Amsterdam,  
[2003] ECDR 23 – *Tanja  
Grotter*



Federal Supreme Court (D),  
GRUR 2005, 583 – *Milka / Lila  
Postkarte*

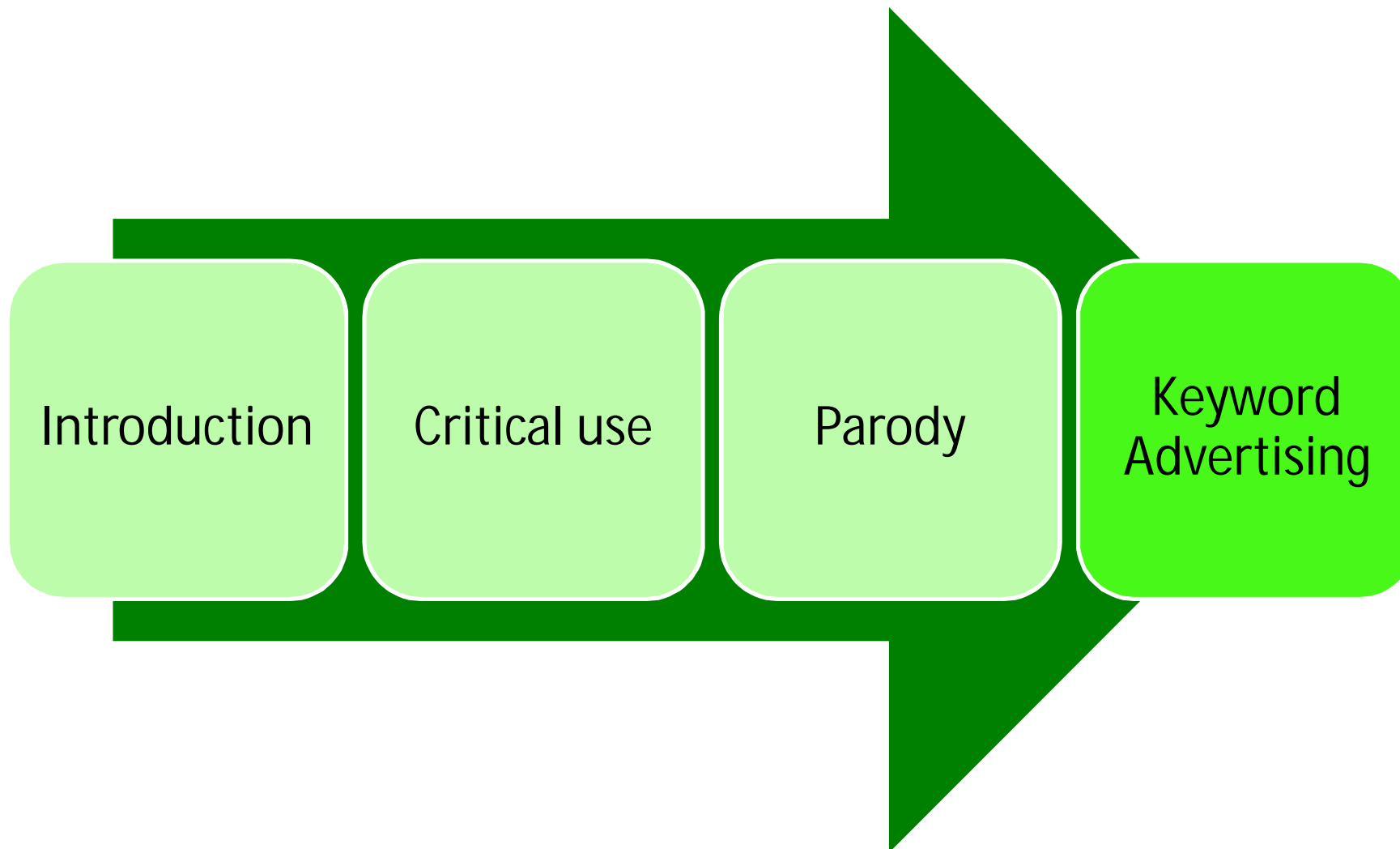


### 3. Parody: analysis





# Outline







## 4. Keyword advertising: analysis



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### A free speech issue?

- AG Maduro, opinion in C-236-238/08, *Google France*, at para 102

“Nevertheless, whatever the protection afforded to innovation and investment, it is never absolute. It must always be balanced against other interests, in the same way as trade mark protection itself is balanced against them. I believe that the present cases call for such a balance as regards freedom of expression and freedom of commerce.”

- But predominantly commercial expression



## 4. Keyword advertising: analysis



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ECJ, cases C-236 to 238/08 – *Google France* and case C-278/08 – *BergSpechte* (advertiser's liability)

- Art 5 (1)(a) TMD (“double identity”)
  - Infringing use only if protected TM functions affected
  - Protected TM functions: origin function, but also advertising, investment etc. functions (*L'Oréal*)
  - Origin function affected when risk of confusion
  - Advertising function remains unaffected
- Art 5 (1)(b) TMD (“risk of confusion”)
  - (+) if advertising does not enable consumer to ascertain whether advertiser and TM owner are economically connected
- Art 5 (2) TMD (“well-known marks”): ??



## 5. Conclusions



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- Extension of TM law has made conflicts more likely
  - Relevance of constitutional law?
    - commercial speech = internal balancing factor
    - political/artistic expression = external balancing factor
  - “Use in the course of trade” = important threshold requirement
  - “TM use” has lost its filter function under art 5 (1)(a)
    - specific regime for “nominative use” desirable
  - Art 5 (2) allows balancing, but “unfairness” must be determined in every case



Thank you very much for your attention!



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