



Conflicts Between Trade Mark Rights and Freedom of Expression Under EU Trade Mark Law: Reality or Illusion?

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Abstract The issue of reconciling trade mark rights and freedom of expression is a classic question discussed by European scholars which has recently been re-opened because of the express reference to “fundamental rights and freedoms, and in particular the freedom of expression” in the preambles of Directive 2015/2436 and of Regulation 2017/1001. In this article, the author argues that, in the light of the EU legislation, conflicts between the freedom of expression and trade mark rights are often illusory. Indeed, in this debate we focus too quickly on the question of resolving a potential conflict, while EU trade mark law itself provides for limits that guarantee respect of the freedom of expression. It should also be borne in mind that commercial expressions enjoy a more restricted freedom since they serve private economic interests and not the interests of society as a whole. The freedom of commercial expression therefore needs to be limited by trade mark rights which are also fundamental rights, having equivalent value. Consequently, it seems unnecessary to envisage use related to the freedom of expression, of a sign reproducing or imitating a trade mark, as a specific limitation of trade mark rights, either in the speciality or in the field of enhanced protection of trade marks with a reputation.

Keywords Trade mark · Freedom of expression · Reputation · Due cause · Trade mark limitations

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1 Introduction

By their very nature, trade mark rights, which confer exclusivity of use of a sign on its proprietor, based on the concept of property rights to tangible objects, limit the freedom of trade and industry and the related freedom of competition of others. The monopoly resulting from registration¹ is nevertheless relative. Trade mark rights do not confer exclusivity on the sign per se, but only in so far as it designates the goods or services concerned.² In trade mark law, the freedom of trade and industry (freedom of competition) is reflected in the so-called principle of “speciality” which traditionally governs this area of law. In the light of this rule, the protection of a trade mark is restricted to the industry concerned. However, the scope of this protection is broader vis-à-vis third parties who use similar signs in relation to similar goods or services. The rule of speciality is mitigated with respect to trade marks with a reputation which enjoy a special regime of protection, providing for specific conditions for trade mark infringement irrespective of the similarity of the goods or services concerned. A third party should not therefore use a trade mark if such use falls within the monopoly conferred on the proprietor. There is, however, no doubt that such limitations of the freedom of trade and industry are justified since trade mark rights are at the same time necessary for all undertakings to carry on their economic activity. Indeed, trade marks ensure the proper functioning of the market and make progress possible, by encouraging their owners to invest in the quality of goods or services in order to satisfy the consumer.³ Hence, trade mark rights protect the sign to the extent that its reservation constitutes a necessary and justified limitation of the freedom of trade and industry (freedom of competition).

Insofar as the trade mark owner has, within some limits, a monopoly over the use of its sign, a conflict may also potentially occur with the freedom of expression of others who wish to refer to a registered mark. This may concern use made in the context of freedom of artistic creation and public information. The most controversial aspect of the conflict between trade mark rights and the freedom of expression appears to be the so-called “trade mark parody”. The question whether the user of a trade mark can avoid liability for trade mark infringement because of the humorous or critical nature of its use, relying on the freedom of expression, has long been a matter of concern in doctrine and case law in many European countries.⁴ Since the freedom of expression is one of the fundamental freedoms of constitutional value, many authors, often influenced by copyright provisions or American trade mark law, plead to consider the use of another’s mark which falls within the freedom of expression as a fair defence which could be invoked by the alleged infringer. The discussion has recently been reopened since Recital 27 *in fine* of Directive 2015/2426 and Recital 21 *in fine* of Regulation 2017/1001 oblige their provisions to be applied “in a way that ensures full respect for fundamental rights and freedoms, and in particular the freedom of expression”. It seems, however, that

¹ Exceptionally, from the fact that a mark is well known, in accordance with Art. 6^{bis} Paris Convention.

² Cf. Jacq (1955), p. 232.

³ Cf. Passa (2009), p. 9.

⁴ Cf., in French doctrine, Canlorbe (2008), pp. 400–403.

in this discussion we tend to resolve conflicts between trade mark rights and freedom of expression as if trade mark law confers an almost unlimited exclusivity over the sign. Arguably, on the one hand, the conflict between trade mark rights and the freedom of expression is often illusory, and, on the other hand, the commercial freedom of expression needs to be limited by trade mark rights which also constitute fundamental constitutional rights of equivalent value. Indeed, a balance between trade mark rights and freedom of expression is therefore struck by trade mark law itself which, by imposing general necessary prerequisites for infringement, provides for clear limits to the exclusivity of the sign (Sect. 2). Thus, we believe that there is no need to envisage the use of a trade mark which falls within the freedom of expression as a specific limitation to trade mark rights (Sect. 3).

2 General Conditions for Trade Mark Infringement

Pursuant to Art. 9(2) of Regulation 2017/1001 and Art. 10(2) of Directive 2015/2436, any infringing use must be made “in the course of trade” (Sect. 2.1), and “in relation to goods or services”, hence as a trade mark (Sect. 2.2). The examination of possible conflicts between the freedom of expression and trade mark rights is therefore pointless when the use of the disputed sign is not made in the course of trade or to designate goods or services, since these two conditions delimit the scope of exclusivity granted to trade mark proprietors.⁵ In the light of these requirements for infringement, the concerns that trade mark rights may prevent engaging in some forms of free speech, such as parody or criticism,⁶ seem excessive. In most cases in which authors seek use relating to the freedom of expression, there is no infringement of the trade mark constituted a priori, since the sign in question is not used in the course of trade or as a trade mark. Indeed, as some scholars rightly point out, in this debate we focus too quickly on the issue of resolving a conflict between the trade mark rights and the freedom of expression. It is better to settle this question in the field of trade mark law, avoiding considering the use covered by the freedom of expression as an infringement of trade mark rights.⁷

2.1 Condition of Use in the Course of Trade

Pursuant to Art. 10(2) of Directive 2015/2436 and Art. 9(2) of Regulation 2017/1001, the scope of trade mark rights is limited to acts of use performed “in the course of trade”. The solution is justified because a mark that is not commercially exploited cannot fulfil its functions⁸ and the role assigned to the mark is exclusively of an economic nature.⁹ According to the *Arsenal* judgment, “the use of the sign identical to the mark is indeed use in the course of trade, since it takes place in the

⁵ Szczepanowska-Kozłowska (2013), p. 9.

⁶ Cf. Senftleben (2016), p. 376.

⁷ Cf. Burrell and Gangjee (2010), p. 544 *et seq.*

⁸ Passa (2005a), para. 3.

⁹ Canlorbe (2010), p. 109.

context of commercial activity with a view to economic advantage and not as a private matter”.¹⁰ The Court of Justice referred to this definition on several occasions in its subsequent case law.¹¹ Thus, the act of use must be performed in an economic context. It should be noted that the interpretation of the notion of use in the course of trade must be broad.¹² The search for profit is not decisive for the qualification of use in the course of trade.¹³ By contrast, the demonstration of economic damage is not sufficient to consider that the act at issue was committed in the course of trade. It should be specified that use in the course of trade must be related to the marketing of a good or the provision of a service, in accordance with the purpose of the trade mark, which is to indicate the origin of a good or service. Indeed, as already noted, the trade mark is protected as an indicator of the commercial origin and not as a value in itself;¹⁴ in other words, as a distinctive sign and not as a sign as such.¹⁵ There are cases in which use of a mark is clearly not related to the marketing of a good or the provision of a service. Infringement is then excluded even if the right holder suffers economic damage.¹⁶ That being said, it is not necessary for the disputed act to consist in putting the sign in contact with customers, to exploit it outside the private sphere of the company, in order to be accomplished in the course of trade. Acts of reproduction or imitation performed in the phase of manufacturing or promotion of the disputed goods before their offer to the public, or the preparation of services, are already performed in the course of trade, as is the use of the sign in a relationship between two professionals without a public offer of goods or services under this sign.¹⁷ Thus, acts preparatory to the placing of a good on the market may constitute acts of trade mark infringement. Article 10(3) of Directive 2015/2436 and Art. 9(3) of Regulation 2017/1001, which provide an illustrative list of prohibited acts likely to amount to infringement,¹⁸

¹⁰ CJEC, 12 November 2002, case C-206/01, *Arsenal*, para. 40. On this formula, see Passa (2015), p. 595.

¹¹ See CJEC, 16 November 2004, case C-245/02, *Anheuser-Busch*, para. 62; CJEC, 25 January 2007, case C-48/05, *Opel*, para. 18; CJEC, 11 September 2007, case C-17/06, *Celine*, para. 17; CJEC, 12 June 2008, case C-533/06, *02 Holdings*, para. 60.

¹² The test of use in the course of trade is therefore a low threshold. Senfleben (2017b), p. 279.

¹³ A non-profit association may commit trade mark infringement. Passa (2015), p. 596; cf. Canlorbe (2010), p. 111. Regarding the condition of genuine use, cf. CJEC, 9 December 2008, C-442/07, *Verein Radetzky-Orden*.

¹⁴ See Pollaud-Dulian (2006), p. 10195.

¹⁵ Cf. Geiger (2004), pp. 271–272; Geiger (2007a), p. 884; Geiger (2007b), pp. 323–324. The author seems to agree that the condition of use in the course of trade allows infringement to be ruled out in many cases related to the freedom of expression. Nevertheless, according to the author, the notion of use in the course of trade is not clear in European case law. Consequently, invoking freedom of expression may be necessary.

¹⁶ See Canlorbe (2010), pp. 111–112. Cf. opinion of Advocate General Ruiz-Jarabo Colomer in case C-206/01, *Arsenal*, para. 62, according to which: “The use which the proprietor of the trade mark may prevent is not any that might constitute a material advantage for the user, or even a use which is capable of being expressed in economic terms, but only ... use which occurs in the world of business, in trade, the subject of which is, precisely, the distribution of goods and services in the market”.

¹⁷ Passa (2005a), para. 7.

¹⁸ Cf. Senfleben (2017b), p. 368 *et seq.* There is no doubt that the list is not exhaustive. CJEC, 12 November 2002, case C-206/01, *Arsenal*, para. 38.

show that this general condition for bringing an action for trade mark infringement applies both to acts involving contact between the trade mark and customers and to acts which do not involve any communication of the sign to the public, such as the mere affixing of the sign or stocking of the goods bearing the mark.¹⁹ There is, however, no doubt that the use likely to be qualified as infringement refers exclusively to active behaviour on the part of the third party.²⁰

French jurisprudence shows very well how the condition of use in the course of trade delimits the scope of trade mark rights and, as a result, guarantees the freedom of expression. Indeed, since the 1990s, some French courts have highlighted the absence of a commercial purpose of the use of the trade mark in relation to the freedom of expression, in particular of the parodic use.²¹ In the famous cases concerning the trade marks *Esso* and *Areva*, in which Greenpeace was accused of pasting the said trade marks to highlight the harmful influence of the activities of their owners on the environment, the Paris Court of Appeal dismissed the plaintiffs in the field of trade mark law on the grounds that the use of the trade marks in question clearly did not aim to promote the marketing of competing products or services but was purely polemical use made outside the course of trade.²² French case law has finally established itself in favour of excluding trade mark infringement in cases of use related to the freedom of expression, for information or criticism purposes. Indeed, the Court of Cassation has ruled on several occasions²³ that condemning the use of a trade mark for polemical purposes is, where applicable, a matter of general tort liability and not of trade mark infringement. The decisions are based on the absence of use in the course of trade.²⁴

There is no doubt that the condition of use in the course of trade applies to any type of infringement, including infringement of trade marks with a reputation under the special regime of extended protection. Therefore, outside the economic context, the use of a trade mark, including a reputed mark, is allowed. Consequently, in principle, any use of a sign for personal purposes within the company, for information purposes, artistic, educational or scientific purposes, parody, satire or polemic, etc., does not fall within the monopoly of the trade mark owner.²⁵ It is not

¹⁹ Canlorbe (2010), p. 110. Cf. also Passa (2008), para. 1.

²⁰ CJEU, 3 March 2016, case C-179/15, *Mercedes-Benz*, para. 40.

²¹ See Baud and Colombet (1998), p. 227 *et seq.* Nevertheless, the solutions adopted by French courts at the time were various. See Ruzek (2005), paras. 11–15. For example, in a judgment concerning the publication by anti-smoking associations of posters presenting graphic diversions of five marks of cigarettes, the Court of Cassation ruled that the use made on the disputed posters, for information and criticism purposes, was infringing. Court of Cassation, 21 February 1995, case 92-13.688.

²² Paris Court of Appeal, 26 February 2003, *Propriété industrielle* – Bulletin documentaire 2003, No. 766, III, p. 323, *Recueil Dalloz* 2003, p. 1831, comment by Edelman, *Communication – Commerce électronique* 2003, comment 38, by Caron, *Revue propriétés intellectuelles* 2003, No. 3, p. 322, comment by Laure Bénabou, *Revue propriétés intellectuelles* 2003, No. 9, p. 458, comment by Vivant, *Revue propriété industrielle* 2003, comment 40, by Tréfigny. On the *Esso* and *Areva* cases, see also Geiger (2011), pp. 169–171.

²³ Court of Cassation, 8 April 2008, case 07-11.251, *Bulletin civil I*, No. 104, *Areva*; Court of Cassation, 8 April 2008, case 06-10.961, *Bulletin civil IV*, No. 79, *Esso*.

²⁴ Canlorbe (2010), p. 114.

²⁵ See Pollaud-Dulian (2011), p. 903; Senftleben (2017b), p. 279; Żelechowski (2018), p. 118.

then a question of arbitrating a conflict between the trade mark rights and the freedom of expression.²⁶

2.2 Condition of Use as a Trade Mark

Use of a trade mark covered by the freedom of expression may of course take place in the context of the marketing of goods or services. In particular, parody often contains a commercial element in the sense that the parodist derives an economic benefit from it.²⁷ Consequently, use of trade marks relating to the freedom of expression may be qualified as use made in the course of trade.²⁸ However, in the light of Art. 10(2) of Directive 2015/2436 and Art. 9(2) of Regulation 2017/1001, even when used in the course of trade, a sign is only likely to infringe a trade mark right if it is exploited “in relation to goods or services”, hence as a trade mark. This means that the sign must be used to designate goods or services and to link them to a commercial origin by distinguishing them from other goods or services.²⁹ For the first time, this condition for trade mark infringement was formulated by the Court of Justice in the *BMW* judgment, according to which the use of a sign likely to infringe a trade mark must be made “for the purpose of distinguishing the goods or services in question as originating from a particular undertaking, that is to say, as a trade mark as such, or whether it is used for other purposes”.³⁰ The Court of Justice reaffirmed that use as a trade mark is a prerequisite for infringement in several subsequent decisions.³¹ The sign is therefore used as a trade mark when it identifies goods or services by linking them to a commercial origin and when it is used in connection with their current or future offer to customers.³²

It should be stressed that the requirement of use as a trade mark applies to any form of infringement, including infringement of trade marks with a reputation

²⁶ See Passa (2009), pp. 292–293; Szczepanowska-Kozłowska (2013), pp. 11–12; Basire (2014), p. 211.

²⁷ On the different types of parodies, see Naser (2009), p. 193 *et seq.* Cf. also Paesan (2011), p. 118 *et seq.*

²⁸ In some cases, the assessment may be complicated. For example, it could be considered that use of a trade mark for information purposes by a journalist in a press article is not made in the course of trade, since the use of the mark should itself have a commercial purpose, *i.e.* the mark should be used to promote the marketing of goods or services to the consumer. See Canlorbe (2016), para. 37. Nevertheless, one could argue that the publication of a press article for information or criticism is done in the course of trade. See Szczepanowska-Kozłowska (2013), p. 11. Such use is not indeed unrelated to the economic activity, since the mark is used in the context of the marketing of a product, in this case a newspaper. Cf. Canlorbe (2008), pp. 401–402.

²⁹ See Passa (2005a), para. 11; Schmidt-Szalewski (2007b), p. 243; Passa (2009), pp. 531–532; Pollaud-Dulian (2011), p. 948.

³⁰ CJEC, 23 February 1999, case C-63/97, *BMW*, para. 38. See Schmidt-Szalewski (2007b), p. 243.

³¹ See in particular CJEC, 16 November 2004, case C-245/02, *Anheuser Busch*, para. 60; CJEC, 11 September 2007, case C-17/06, *Celine*, para. 27; CJEC, 19 February 2009, case C-62/08, *UDV North America*, para. 42.

³² Passa (2009), p. 295.

which benefit from enhanced protection.³³ Indeed, pursuant to Art. 10(6) of Directive 2015/2436, corresponding to Art. 5(5) of Directives 89/104 and 2008/95:

Paragraphs 1, 2, 3 and 5 shall not affect provisions in any Member State relating to the protection against the use of a sign other than use for the purposes of distinguishing goods or services, where use of that sign without due cause takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the trade mark.

Article 10(6) therefore makes it possible to protect a reputed trade mark against its use for purposes other than to distinguish goods or services.³⁴ It thus clearly follows from Art. 10(6) that the acts infringing the trade mark rights referred to in Art. 10(2) must be carried out in order to distinguish goods or services, hence as a trade mark.³⁵ The importance of the condition of use as a trade mark in the field of enhanced protection is confirmed by abundant jurisprudence of the Court of Justice. Already in the *BMW* judgment, the Court noted that the infringing use must be made as a trade mark and that this allows distinguishing the scope of application of Art. 5(1) and (2) of Directive 89/104, on the one hand, and Art. 5(5), on the other.³⁶ Moreover, in the *Adidas* judgment, rendered precisely under Art. 5(2) of Directive 89/104, the Court of Justice ruled that it is only when the relevant section of the public views the sign purely as an embellishment that infringement cannot be established.³⁷ A sign may nevertheless be considered at the same time as indicating the commercial origin of a good or service. This means that the regime of trade mark protection is applicable even though the disputed sign is perceived as a decoration if it is also perceived as an indication of a commercial origin.³⁸ Thus, it follows from the judgment that use as a trade mark is indeed a condition for infringement of a trade mark with a reputation.³⁹

³³ See Yap (2007), p. 425; Canlorbe (2008), pp. 136, 143; Passa (2009), p. 531; Pollaud-Dulian (2011), p. 1076; Basire (2014), p. 285.

³⁴ Schmidt-Szalewski (2007a), p. 119. This provision was, in particular, transposed in Benelux law. See Art. 2.20(2)(d) of the Benelux Convention on Intellectual Property. Under Italian law, cf. Ricolfi (2015), p. 1143.

³⁵ Cf. Galli (2004), p. 140; Monteiro and Ruzek (2007), para. 57; Yap (2007), p. 425.

³⁶ CJEC, 23 February 1999, case C-63/97, *BMW*, para. 38. See also CJEC, 11 September 2007, case C-17/06, *Celine*, para. 20.

³⁷ CJEC, 23 October 2003, case C-408/01, *Adidas*, para. 40. Cf. CJEC, 10 April 2008, case C-102/07, *Adidas*.

³⁸ Passa (2009), p. 535. Cf. Bonet (2004), p. 706.

³⁹ Yap (2007), p. 425; Yap (2009), p. 84. *Contra* Simon (2006), pp. 324–328; Gielen (2014), p. 709. The authors point out that the Court does not make explicit reference to the use of the sign as a trade mark as a condition of trade mark infringement. Cf. also Sironi (2013), p. 307. The requirement of use as a trade mark under the regime of enhanced protection of reputed trade marks is applied, in accordance with the jurisprudence of the Court of Justice, by the French Court of Cassation. Court of Cassation, 20 February 2007, case 05-10.319, Communication – Commerce électronique 2007, comment 93, by Caron, *Décathlon*; Court of Cassation, 11 March 2008, case 06-15.594, Bulletin civil IV, No. 60, Recueil Dalloz 2008, p. 917, comment by Daleau, *Revue propriétés intellectuelles* 2008, No. 28, p. 360, comment by Passa, *Revue propriété industrielle* 2008, comment 39, by Tréfigny-Goy, *Louis Vuitton*. Cf. Azéma (2014), p. 795.

Although, most authors and courts agree that use as a trade mark is a *sine qua non* prerequisite for any infringement, the interpretation of this condition varies and therefore its implementation may pose difficulties. Some scholars consider that this requirement does not constitute a barrier to excessive trade mark protection because the Court of Justice understands it in a wider way than it was traditionally perceived in some European countries.⁴⁰ It seems, however, that this is because the condition of use as a trade mark resulting from the jurisprudence of the Court of Justice is interpreted by some commentators too broadly. Some authors suggest that it would be sufficient for the sign to be perceived as an “allusion” to a trade mark of another undertaking.⁴¹ It was observed that, in the view of the *Celine* judgment, according to which use is made in relation to goods or services where the third party uses the sign in such a way that a link is established between the sign and the goods marketed or the services provided by the third party,⁴² a sign is used as a trade mark when the public associates the sign with the owner’s goods or services. In most cases, the mark would remind customers of the goods or services designated by them. Consequently, the use of signs which would not be made in relation to goods or services would be very rare.⁴³ This interpretation of the *Celine* decision seems too liberal. The link referred to by the Court of Justice means that a sign can be perceived by the consumer as a trade mark even if it is not affixed to the goods. However, it is explicitly stated in the judgment that this needs to be a link between the sign and “the goods marketed or the services provided by the third party”.⁴⁴ The public must therefore perceive the disputed sign as designating the commercial origin of the goods marketed or the services provided *by the infringer*.⁴⁵ This interpretation was recently reaffirmed by the Court of Justice which stated that the wording “in relation to goods or services” relates, in principle, to goods or services *of a third party* who uses a sign identical (or similar) to the mark.⁴⁶ Thus, it is not sufficient that the sign simply reminds the consumer of the goods or services of the trade mark’s proprietor or that it is perceived by the public as an “allusion” to the trade mark.

That said, it should be noted that, in the light of the *O2 Holdings* decision, the disputed sign may be used to designate goods or services of the trade mark owner. Such use may characterise use as a trade mark.⁴⁷ However, this is a particular solution adopted in the field of comparative advertising.⁴⁸ The particularity of this

⁴⁰ Cf. Żelechowski (2018), pp. 119–120.

⁴¹ See de Candé (2004), chronique 7. The author made this remark with respect to the infringement of the reputed trade mark, but, as we have established, the condition of use as a trade mark also applies in the field of the special regime.

⁴² CJEC, 11 September 2007, case C-17/06, *Celine*, para. 23.

⁴³ Szczepanowska-Kozłowska (2013), p. 12. In this respect, cf. also Senftleben (2017b), pp. 290–291; and Żelechowski (2018), pp. 119–120, who seem to adopt a broad interpretation of the condition of a link resulting from the *Celine* decision.

⁴⁴ CJEC, 11 September 2007, case C-17/06, *Celine*, para. 23.

⁴⁵ In this direction, Passa (2015), p. 597.

⁴⁶ CJEU, 11 April 2019, case C-690/17, *ÖKO-Test*, para. 29. See also para. 35 of the judgment.

⁴⁷ Cf. also regarding the judgment, CJEC, 14 May 2002, case C-2/00, *Höfnerhoff*; Passa (2002), p. 3137.

⁴⁸ CJEC, 12 June 2008, case C-533/06, *O2 Holdings*, para. 33.

form of trade mark exploitation is that a third party uses another's trade mark to designate the owner's goods but at the same time, indirectly, also to promote his own products, identical goods, marketed by himself.⁴⁹ It is therefore not a question of establishing a simple association between the trade mark and the goods of the owner designated by that trade mark in the mind of the public.

Another particular situation was the subject of the *BMW* judgment, according to which the use of a mark designating goods to identify their source by an advertiser providing services related to those goods characterises use as a trade mark. The Court of Justice noted that the use of the trade mark in question was "undoubtedly intended to distinguish the subject of the services provided".⁵⁰ In such case, there exists a specific link between the service provided by the third party and the proprietor's goods which are the subject of that service, as the Court of Justice specified in the *Opel* judgment.⁵¹ Thus, as the Court recently reaffirmed in the *ÖKO-Test* decision, use of the sign by a third party to identify the goods of the trade mark proprietor can only "exceptionally" constitute infringement.⁵²

Therefore, apart from the specific cases mentioned above, in which there is a particular relationship between the goods or services of the proprietor and of the third party, in accordance with the *Opel* and *Céline* judgments, the use of a sign likely to infringe a trade mark must be made for the goods marketed or the services provided by the third party.⁵³ In principle, the condition of use as a trade mark is therefore met when the infringer uses a sign reproducing or imitating another person's trade mark to distinguish a good marketed or a service provided by himself. Indeed, either this is an identical good, as in particular in the case of comparative advertising, or a service the subject of which is the right holder's good. However, when, for example, a journalist cites a trade mark in a press article, that trade mark may, of course, remind the public of the goods of its proprietor, but the sign is in no way used as a trade mark, since it is not used to designate the goods marketed by the third party, in this case a newspaper, or for goods of the proprietor that would be related to the latter. Likewise, when a trade mark is presented in a work, such as a book, a film, a painting, etc., that is intended to be marketed (one may therefore argue that is not outside the course of trade), it is the condition of use as a trade mark that allows ruling out infringement. It was, for example, rightly

⁴⁹ In this direction, see also Passa (2015), p. 597. Cf. further Chavanne (1990), p. 106.

⁵⁰ CJEC, 23 February 1999, case C-63/97, *BMW*, para. 39.

⁵¹ CJEC, 25 January 2007, case C-48/05, *Opel*, para. 27: "the vehicles marketed under the BMW trade mark by the proprietor of that mark constituted the subject-matter of the services – the repairing of vehicles – supplied by the third party, so that it was essential to identify the origin of the BMW cars, the subject-matter of those services. It was having regard to that specific link between the products bearing the trade mark and the services provided by the third party that the Court of Justice held that, in the specific circumstances of the BMW case, use by the third party of the sign identical to the trade mark in respect of goods marketed not by the third party but by the holder of the trade mark fell within Article 5(1)(a) of the directive".

⁵² CJEU, 11 April 2019, case C-690/17, *ÖKO-Test*, para. 31.

⁵³ CJEC, 25 January 2007, case C-48/05, *Opel*, para. 28; CJEC, 11 September 2007, case C-17/06, *Céline*, para. 23.

decided by the Paris court that use of the trade mark *Dolce Gabbana* in a film, presented on a T-shirt worn by one of the characters, did not constitute infringement.⁵⁴ Similarly, in a case regarding use of the trade mark *Mocio* in relation to care products for which the mark was registered in the Hollywood film “Joy”, the Milan court ruled that, even if the disputed use was made in the course of trade, since the production of a film is an economic operation, the mark was not exploited to designate the product. According to the court, the sign was used in a descriptive function, as an element of communication.⁵⁵

Moreover, the condition of use as a trade mark leads to excluding infringement in some situations where the sign is used by a third party in an economic context and prima facie in relation to his own goods or services, but the sign is not perceived by the public as indicating the commercial origin of those goods or services.⁵⁶ This is the case, for example, when the mark is used exclusively as a decoration,⁵⁷ in its common sense,⁵⁸ or as a trade name if such use is not likely to characterise at the same time use as a trade mark.⁵⁹ There should also be no doubt that use of a mark in the title of a work is not made as a trade mark.⁶⁰ In this regard, the Paris Court of Appeal ruled that a trade mark registered for films and digital media was not infringed by its use in the title of a film marketed on a DVD. By reference to the case law of the Court of Justice, the Paris court held that the title of the disputed DVD designated the cinematographic work but not a product or service. According to the court, it was irrelevant that the title appeared on the cover of the DVD since it was intended to identify the work itself.⁶¹ This reasoning was shared by the French Court of Cassation in another matter, concerning use of a mark registered for printing products, newspapers and periodicals in the title of a book.⁶² The court approved the analysis made by the court of appeal⁶³ that there was no use as a trade

⁵⁴ Paris District Court (*Tribunal de grande instance*), 10 November 2011, case 10/09164, *Dolce Gabbana*. According to the court, the use of the mark was not linked to the marketing of any good and, consequently, was not made in the course of trade. We can admit that, for the same reason and due to the perception of the sign, the use was not made as a trade mark either. This conclusion should also have allowed the court to reject the claims based on enhanced protection of reputed trade marks since the conditions of use in the course of trade and as a trade mark apply in the field of special protection in the same way. In this respect, the court preferred to emphasise the absence of affecting the advertising function, hence of a detriment, and of an unfair advantage taken by the defendant.

⁵⁵ Milan District Court (*Tribunale ordinario*), 18 May 2016, case 2016/16628, *Mocio*. Regarding the reputation of the mark, the court ruled that the contested use was neither parasitic nor detrimental, although, as noted above, the condition of use as a trade mark also applies to reputed marks.

⁵⁶ See Passa (2009), p. 534.

⁵⁷ Paris Court of Appeal, 17 May 2013, case 11/22637, *Moulin rouge*.

⁵⁸ Strasbourg District Court (*Tribunal de grande instance*), 15 December 2003, case 02/03781, *Maman je t'aime*.

⁵⁹ Paris District Court (*Tribunal de grande instance*), 25 September 2014, case 14/00145, *Vip Room*.

⁶⁰ Passa (2009), p. 317. With respect to press articles, see also Passa (2005b), paras. 17–19.

⁶¹ Paris Court of Appeal, 28 May 2008, case 07/03947, *Propriété industrielle – Bulletin documentaire* 2008, No. 880, III, p. 504, *Choristes*.

⁶² Court of Cassation, 12 July 2011, case 10-22.739, *Propriété industrielle – Bulletin documentaire* 2011, No. 946, III, p. 556, *Lui*.

⁶³ Paris Court of Appeal, 26 May 2010, case 08/15425, *Lui*.

mark, since a distinction should be made between the intellectual work, on the one hand, and the good which constitutes its material support, on the other hand. Indeed, the title is perceived by the public as identifying the work but does not indicate the commercial origin of a good, allowing it to be distinguished from goods marketed by other undertakings (contrary to the sign of the publisher, film company, etc.). Regarding the enhanced protection of trade marks with a reputation, it is worth quoting a judgment of the French Court of Cassation concerning a conflict between the trade mark *Décathlon* and a domain name identifying a website whose purpose was to make fun of the sporting activity of decathlon.⁶⁴ The mark was clearly used in the course of trade. Nevertheless, the Court of Cassation refused to condemn the contested use in the field of extended protection of trade marks with a reputation, since it had not been made as a trade mark. According to the decision, ownership of a trade mark, even of a reputed one, consisting of a common name, does not prohibit the use of this name in its usual sense. As observed by one author, the judgment proves that trade mark law does not disregard the freedom of expression, and that balances between the freedoms and property rights do exist.⁶⁵

Moreover, there are situations in which use of a sign is manifestly not made either in the course of trade or as a trade mark, for example the parodic use of a sign for militant purposes. Not only is such use foreign to the business activity, but, in addition, in many cases, it is not intended to designate, directly or indirectly, goods or services but rather the company itself, known under the name corresponding to the trade mark, as in the *Areva* and *Esso* cases.⁶⁶

Thus, trade mark law itself, thanks to the general prerequisites for trade mark infringement, ensures the freedom of expression. As the trade mark right is unenforceable, the qualification of infringement of the trade mark right is necessarily excluded, without the defendant even having to invoke the freedom of expression in the field of trade mark law, since this defence assumes that an infringement of the trade mark right is a priori established.⁶⁷ In this respect, we should, however, make two additional remarks.

Firstly, the approach may be different in the national legislations which transposed Art. 10(6) of Directive 2015/2436, former Art. 5(5) of Directives 89/104 and 2008/95, allowing for enhanced protection to be provided against the use of a sign other than use for the purpose of distinguishing goods or services, as is the case, in particular, in Benelux law.⁶⁸ In this legislation, use that is not made as a trade mark may qualify as a priori infringing. This very broad trade mark protection against any form of communication involving the mark, including artistic expression, gives rise to legitimate concerns about an encroachment upon freedom of expression.⁶⁹ Hence, invoking the due cause exception provided by the provisions implementing Art. 10(6) of Directive 2015/2436, in order to assure

⁶⁴ Court of Cassation, 20 February 2007, case 05-10.319, *Décathlon*.

⁶⁵ Caron (2007), para. 4.

⁶⁶ Passa (2005a), para. 18.

⁶⁷ Passa (2005a), para. 10.

⁶⁸ See Art. 2.20(2)(d) of the Benelux Convention on Intellectual Property.

⁶⁹ See Senftleben (2017b), p. 402.

freedom of expression, may be necessary and justified.⁷⁰ Under harmonised EU trade mark legislation, however, use of a mark which is not made as a trade mark shall never qualify as infringing.

Secondly, the absence of trade mark infringement, pursuant to Art. 9(2) of Regulation 2017/1001 or national provisions interpreted in the light of Art. 10(2) of Directive 2015/2436, does not exclude that, for instance, a parodic use cannot be condemned on the basis of national provisions related to general tort liability, if such use is considered unlawful since it consists in an abuse of the freedom of expression and in particular a denigration of the product or service designated by the trade mark or of its proprietor.⁷¹

3 Exceptions to Trade Mark Rights

In view of the general prerequisites for trade mark infringement, it seems that the negative conditions, i.e. limitations of trade mark rights, shall not be interpreted as allowing use related to the freedom of expression to be considered as an independent exception. In the light of the case law of the Court of Justice, as Georges Bonet observed, the idea is that a third party, only exceptionally authorised by law to use another's mark, must be particularly cautious.⁷² Indeed, the limitations should be interpreted strictly,⁷³ although their interpretation must enable the effectiveness of the exceptions to be safeguarded and their purpose to be observed.⁷⁴ This observation is not affected by the fact that Recital 27 *in fine* of Directive 2015/2426 and Recital 21 *in fine* of Regulation 2017/1001 oblige their provisions to be applied "in a way that ensures full respect for fundamental rights and freedoms, and in particular the freedom of expression". Some authors attach much importance to the last sentences of Recital 27 of Directive 2015/2426 and Recital 21 of Regulation 2017/1001, suggesting that they could justify further limitations of trade mark rights.⁷⁵ Arguably, however, this is merely general guidance for the interpretation of the provisions and the objective expressed therein can be fully achieved by a balanced interpretation of the basic conditions for trade mark infringement – use of the sign in the course of trade and as a trade mark. It shall not

⁷⁰ Cf. Benelux Court of Justice, 14 October 2019, case A 2018/1/8, *Moët Hennessy v. Cedric Art*.

⁷¹ Geiger (2004), p. 279; Passa (2005a), para. 10; Passa (2009), p. 293; Pollaud-Dulian (2011), p. 978; Canlorbe (2016), para. 33. For example, tort liability for abuse of freedom of expression was discussed in a case between a producer of tobacco and a French association for combatting respiratory disease and tuberculosis, due to the use of stamps and posters by the latter. According to the judgment, by using elements of the packaging of *Camel* cigarettes, in a humorous manner, in posters and stamps distributed as part of a general prevention campaign aimed at adolescents, denouncing the dangers of tobacco consumption, a product harmful to health, the association, acting in accordance with its purpose related to public health, by means proportionate to that purpose, did not abuse its right of free expression. Court of Cassation, 19 October 2006, case 05-13.489, Bulletin civil II, No. 282.

⁷² Bonet (2005), p. 283.

⁷³ Regarding limitations of copyright, cf. CJEC, 16 July 2009, case C-5/08, *Infopaq*, para. 56. *Contra* Żelechowski (2018), p. 128.

⁷⁴ Still in relation to copyright, cf. CJEU, 4 October 2011, case C-403/08 and 429/08, *Football Association Premier League*, paras. 162–163; CJEU, 1 December 2011, case 145/10, *Painer*, para. 133.

⁷⁵ Cf. Schovsbo (2018), p. 574 *et seq.*; Żelechowski (2018), p. 117 *et seq.*

allow a general limitation of trade mark rights to be adopted either in the speciality (Sect. 3.1), or in the field of the special regime of enhanced protection of trade marks with a reputation, as a due cause exception (Sect. 3.2).

3.1 Exceptions to Trade Mark Rights Applicable Within the Speciality

The exceptions provided for by trade mark law are referred to in Art. 14 of Directive 2015/2436 and, analogously, Art. 14 of Regulation 2017/1001, entitled: “Limitation of the effects of a trade mark”. Under Art. 14(1) of these provisions, a trade mark shall not entitle its proprietor to prohibit a third party from using: its name or address, non-distinctive signs and the trade mark as a reference, in particular in order to indicate the purpose of a product or service,⁷⁶ provided that such use is made “in accordance with honest practices in industrial or commercial matters”.⁷⁷ Other specific exceptions are: trade mark exhaustion provided by Art. 15 of Directive 2015/2436 and Art. 15 of Regulation 2017/1001, and prior local rights which, pursuant to Art. 14(3) of Directive 2015/2436, can be recognised by national provisions of Member States and which constitute a limitation of the rights to national trade marks, as well as EU trade marks.⁷⁸ Given the subject of this study, we will further consider the exceptions provided by Art. 14(1) of Directive 2015/2436 and of Regulation 2017/1001.

The limitation related to the use of the name or address of the third party, nowadays expressly limited to natural persons,⁷⁹ serves to protect personal rights of third parties. The practical importance of this exception is very limited since natural persons rarely need to rely on it. A name used as such does not infringe trade mark rights.⁸⁰ Use of names by natural persons is, in principle, not made in the course of trade and does not constitute use as a trade mark. The new provisions will thus continue to apply above all to individual entrepreneurs who use their names in the course of trade to designate their businesses.⁸¹ The purpose of the address exception is very difficult to identify, since the use of a sign in an address does not constitute use as a trade mark.⁸² Consequently, this limitation seems redundant. Similarly, use

⁷⁶ Pursuant to Art. 14(1): “A trade mark shall not entitle the proprietor to prohibit a third party from using, in the course of trade: (a) the name or address of the third party, where that third party is a natural person; (b) signs or indications which are not distinctive or 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 goods or services; (c) the trade mark for the purpose of identifying or referring to goods or services as those of the proprietor of that trade mark, in particular, where the use of the trade mark is necessary to indicate the intended purpose of a product or service, in particular as accessories or spare parts”.

⁷⁷ Art. 14(2) of Directive 2015/2436 and of Regulation 2017/1001.

⁷⁸ In accordance with Art. 138(3) of Regulation 2017/1001.

⁷⁹ Under Art. 6(1)(a) of the previous Directives and Art. 12(1)(a) of the previous Regulations, the Court of Justice ruled that the term “name” was not limited to the names of natural persons but also covered trade names. CJEC, 16 November 2004, case C-245/02, *Anheuser-Busch*, para. 81.

⁸⁰ de Candé and Phiquepal d’Arusmont (2008), p. 292; Bohaczewski (2015), p. 84.

⁸¹ Cf. Gielen (2006), p. 130.

⁸² de Candé and Phiquepal d’Arusmont (2008), p. 292; Passa (2009), p. 429; Basire (2014), p. 214. See CFI, 13 July 2005, case T-40/03, *Murua*.

of a non-distinctive sign, for instance an exclusively descriptive sign, cannot characterise use in the distinctive function of a trade mark. Indeed, the use of an element that does not perform the origin function is not capable of constituting infringement of the trade mark right.⁸³ Use of a sign that is not perceived as a trade mark is therefore already a priori not covered by the trade mark right. A trade mark may of course be composed of elements that are not distinctive if the whole composition of the sign is distinctive. However, such a registration does not allow the use of the elements of the mark that are devoid of distinctiveness to be prohibited with respect to the goods or services concerned.⁸⁴

The referential use exception could also be called into question since such use may be regarded as made for information purposes, and therefore not use as a trade mark.⁸⁵ However, as we have seen, the condition of use as a trade mark is now interpreted broadly, and is not necessarily limited to the use of a trade mark for goods or services of the infringer. The *O2 Holdings* judgment⁸⁶ and the current wording of the provision, modified as a result of that decision,⁸⁷ confirm that use of a sign to indicate goods as coming from the right holder may lead to trade mark infringement. The current referential use formula is wider than the one provided before by Directive 2008/95 and Regulation 207/2009, since it is not limited to use necessary to indicate the intended purpose of a product or service. In this regard, it was observed that the broad referential use exception should be of particular importance in cases of mixed commercial and non-commercial (artistic, polemical, satirical) use related to the freedom of expression.⁸⁸ However, although, the lawfulness of referential use is no longer conditioned upon being necessary, it does not seem that this broader formula is likely to apply in cases of commercial use related to the freedom of expression, such as trade mark parody. As will be seen further below, the European legislature rejected the idea that such use could constitute a limitation of trade mark rights. Thus, arguing that the referential use exception may have a scope of application covering this type of use appears contrary to the intention expressed by the legislature. Moreover, provided that the use at issue is indeed made as a trade mark, it needs to be stressed that, in order to rely on all the exceptions provided by Art. 14 of Directive 2015/2436 and Art. 14 of Regulation 2017/1001, the contested use must be “in accordance with honest

⁸³ Passa (2009), pp. 314 and 446; Ebert-Weidenfeller (2015), p. 383; Szczepanowska-Kozłowska (2015), p. 705. See CJEC, 18 June 2009, case C-487/07, *L'Oréal*, para. 61. Cf. Cohen Jehoram, Van Nispen and Huydecoper (2010), pp. 245, 265.

⁸⁴ Cf. Passa (2017), p. 40 – regarding the assessment of the likelihood of confusion in cases where the signs coincide in non-distinctive elements, taking into account the jurisprudence of the Court of Justice providing that it is necessary to acknowledge a certain degree of distinctiveness of a registered mark (CJEU, 24 May 2012, case C-196/11 P, *FI*, para. 47), which should not however apply in infringement proceedings.

⁸⁵ de Candé and Phiquepal d'Arusmont (2008), p. 292.

⁸⁶ CJEC, 12 June 2008, case C-533/06, *O2 Holdings*, para. 33. See para. 172 *supra*.

⁸⁷ Arts. 14(1)(c) of Directive 2015/2436 and of Regulation 2017/1001 now specify that the use must be made in relation to goods or services “as those of the proprietor” of the trade mark.

⁸⁸ Żelechowski (2018), p. 127.

practices in industrial and commercial matters”.⁸⁹ According to the *Gillette* judgment, use of the trade mark will not be in accordance with honest practices in industrial and commercial matters, in particular, if: 1) 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;⁹⁰ 2) it affects the value of the trade mark by taking unfair advantage of its distinctive character or repute; 3) it entails the discrediting or denigration of that mark.⁹¹ And, in the light of the *Anheuser-Busch* and *Céline* decisions:

In assessing whether the condition of honest practice is satisfied, account must be taken first of the extent to which the use of the third party’s trade name is understood by the relevant public, or at least a significant section of that public, as indicating a link between the third party’s goods and the trade mark proprietor or a person authorised to use the trade mark, and secondly of the extent to which the third party ought to have been aware of that.⁹²

In the view of this jurisprudence, the requirement of honest practices is very difficult to meet since the conditions for limiting the right to the trade mark are assessed after having established infringement a priori under Art. 10(2) of Directive 2015/2436 or Art. 9(2) of Regulation 2017/1001.⁹³ It should also be noted that Recital 21 of Directive 2015/2436 and Recital 27 of Regulation 2017/1001 provide that: “Use 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”. This only confirms that, pursuant to Art. 14 of Directive 2015/2436 and Art. 14 of Regulation 2017/1001, any contested use covered by the freedom of expression needs to meet the requirements resulting from the above-mentioned case law, in order to be qualified as a justification of a limitation of trade mark rights.

The limitations analysed above, in particular the referential use exception, may be considered as exceptions justified by the need to guarantee the freedom of commercial expression. Apart from those exceptions, listed in an exhaustive manner, which need to comply with the condition of honest practices, there is no other exception which could be raised by the third party making use of a sign within the freedom of expression. Some scholars argued for the recognition of an

⁸⁹ The burden of proof is on the third party raising the defence. *Contra* Ebert-Weidenfeller (2015), pp. 384, 389; Kur and Senftleben (2017), p. 434. Arguably, the wording of the provisions does not provide any grounds for reversing the burden of proof.

⁹⁰ This criterion was already provided for in the judgment of CJEC, 23 February 1999, case C-63/97, *BMW*, para. 64.

⁹¹ CJEC, 17 March 2005, case C-228/03, *Gillette*, para. 49. Moreover, the third party must not present its product as an imitation or replica of the product bearing the trade mark of which it is not the owner. This criterion applies only to the use of the trade mark to indicate the destination of a good or service.

⁹² CJEC, 16 November 2004, case C-245/02, *Anheuser Busch*, para. 83; CJEC, 11 September 2007, case C-17/06, *Céline*, para. 34. *See also* CJEU, 8 July 2010, case C-558/08, *Portakabin*, para. 67.

⁹³ *See* Yap (2009), p. 82; Loiseau (2011), p. 954; Bohaczewski (2015), p. 86. On the awareness of the third party of the possibility of infringing an earlier trade mark which could constitute the essential criterion of honest practices, *cf.* Yap (2008), p. 292; Bohaczewski (2015), pp. 90–93.

additional specific limitation of trade marks rights related to parody, artistic expression, etc.⁹⁴ Introduction of such a limitation was discussed during the work on the last trade mark law reform in the European Union but this suggestion was not pursued.⁹⁵ Arguably, the European legislature was right not to provide for such an additional exception.⁹⁶ The interests of third parties justified by the freedom of commercial expression, which may legitimise the use of another's trade mark, are already taken into account by the legislature, in the provisions related to the general prerequisites for trade mark infringement and in Art. 14 of Directive 2015/2436 and of Regulation 2017/1001. The freedom of expression should not therefore allow third parties to interfere with the trade mark rights of others beyond those limitations deriving from the law.⁹⁷ Even if certain forms of trade mark use can be covered by the freedom of expression, commercial expressions should enjoy a more restricted freedom than expressions made for public or artistic purposes, since they serve private economic interests and not the interests of society as a whole.⁹⁸ Use of another's trade mark in the course of trade and in order to indicate the commercial origin of goods or services, in principle of the third party, made in the individual interest of the user with the intention of obtaining a financial advantage, should not be considered as fair. Consequently, the trade mark right cannot be limited by the use of that mark by third parties, even if such use falls within the widely understood freedom of expression.⁹⁹

In the light of the complete harmonisation of the scope of the trade mark right, a third party should not be entitled to rely on any external ground to trade mark law in its defence. This reasoning seems confirmed by the Court of Justice. According to a judgment rendered in the light of the Directive 2008/95,

save for the specific cases governed by Article 8 *et seq.* of that directive, a national court may not, in a dispute relating to the exercise of the exclusive right conferred by a trade mark, limit that exclusive right in a manner which exceeds the limitations arising from Articles 5 to 7 of the directive.¹⁰⁰

The defendant cannot therefore invoke a basis external to trade mark law, for instance resulting from unfair competition law, in order to avoid liability for infringement. The solution has been criticised.¹⁰¹ It seems justified, however, because otherwise the objective of complete harmonisation would be impossible to

⁹⁴ Ruzek (2005), paras. 6–10; Geiger (2007a), p. 884; Geiger (2007b), pp. 324–325. *See also* Senftleben et al. (2015), p. 337.

⁹⁵ *See* Schovsbo (2018), pp. 568–569.

⁹⁶ *Cf.* also Basire (2014), p. 211, who points out that it is unnecessary to consider any additional exception to the trade mark rights.

⁹⁷ *See* Szczepanowska-Kozłowska (2013), pp. 24–25.

⁹⁸ Szczepanowska-Kozłowska (2019), p. 690.

⁹⁹ *Contra* Jacques (2016), p. 480. *Cf.* also Marino (2011), p. 1. The author argues in favour of the freedom of commercial expression, which could allow, as it seems, unlimited use of trade marks in comparative advertising.

¹⁰⁰ CJEU, 19 September 2013, case C-661/11, *Nathan*, para. 55.

¹⁰¹ *Cf.* Senftleben (2017b), pp. 495–496; Żelechowski (2018), pp. 132–133.

achieve. Furthermore, it is in line with the jurisprudence of the Court of Justice in copyright matters, in the light of which other fundamental freedoms cannot justify a derogation from the holder's exclusive rights beyond the exceptions or limitations provided by the European legislation.¹⁰² It seems perfectly accurate to state that, *mutatis mutandis* in trade mark law, the mechanisms allowing the different rights and interests of right holders and third parties to be balanced are contained in the provisions of Directive 2015/2436 and Regulation 2017/1001.¹⁰³

3.2 Due Cause Exception Applicable Outside the Speciality

The debate on the conflicts between trade mark rights and the freedom of expression concern above all reputed (famous) marks that are particularly likely to be the subject of polemical or satirical use¹⁰⁴ and constitute the main target for parodists.¹⁰⁵ Since, in most cases, such use does not cause any likelihood of confusion as to origin, the problem is situated under the special regime applicable to trade marks with a reputation provided by Art. 10(2)(c) of Directive 2015/2436 and Art. 9(2)(c) of Regulation 2017/1001. As a result, the extended protection of reputed trade marks is sometimes opposed to the freedom of expression.¹⁰⁶ Many European authors thus consider the use of trade marks relating to the freedom of expression as “due cause”, which is a limitation of trade mark protection specific to the special regime.¹⁰⁷ It should be noted that use of a mark covered by the freedom of expression was expressly qualified as due cause in German jurisprudence, in the famous *Lila Postkarte* case, which was decided on 3 February 2005 by the Federal Supreme Court.¹⁰⁸

As noted above, the general prerequisites for infringement exclude from the scope of the trade mark right any use which is purely artistic, polemical, satirical,

¹⁰² CJEU, 29 July 2019, case C-469/17, *Funke Medien*; CJEU, 29 July 2019, case C-516/17, *Spiegel Online v. Volker Beck*.

¹⁰³ Cf. CJEU, 29 July 2019, case C-469/17, *Funke Medien*, para. 58; CJEU, 29 July 2019, case C-516/17, *Spiegel Online v. Volker Beck*, para. 43. Otherwise, the effectiveness of the harmonisation of the trade mark rights effected by the Directive would be endangered. Cf. CJEU, 29 July 2019, case C-469/17, *Funke Medien*, paras. 62–63; CJEU, 29 July 2019, case C-516/17, *Spiegel Online v. Volker Beck*, paras. 47–48.

¹⁰⁴ Paesan (2011), p. 64; Simon Fhima (2013), p. 294.

¹⁰⁵ Ruzek (2005), para. 24; Camus (2015), p. 241.

¹⁰⁶ Naser (2009), p. 196; Burrell and Gangjee (2010), p. 545 *et seq.*

¹⁰⁷ See Gredley and Maniatis (1997), p. 419; Senftleben (2009), p. 63; Senftleben (2017a), pp. 262–263; Paesan (2011), p. 156 *et seq.*; Szczepanowska-Kozłowska (2013), p. 17; Caselli (2014), p. 132; Gielen (2014), p. 728; Jacques (2016), p. 475; Schovsbo (2018), p. 577 *et seq.*; Żelechowski (2018), p. 128 *et seq.*

¹⁰⁸ The case concerned marketing of postcards referring to the marks and an advertising campaign by the chocolate manufacturer of *Milka*. On a purple background, the purple colour being a registered trade mark of the plaintiff, the postcard showed, by ridiculing elements used in the *Milka* advertising campaign, an idyllic landscape with mountains and cows accompanied by a poem attributed to a certain *Rainer Maria Milka*. The German Court admitted due cause in this case, in the light of the fundamental freedom of artistic creation. German Federal Supreme Court, 3 February 2005, case I ZR 159/02, GRUR 2005, p. 583, *see* Senftleben (2017a), p. 262; Żelechowski (2018), p. 119.

etc., since it is not made in the course of trade. Commercial use of marks which falls within the freedom of expression is also outside the trade mark right where a third party does not use the sign as a trade mark;¹⁰⁹ hence, in principle, in order to indicate the origin of its own goods or services, unless there is a specific link between the goods or services designated by the signs in dispute. Having said that, admittedly, there may be cases where a message related to the exercise of the freedom of expression is situated in the course of trade and constitutes use as a trade mark.¹¹⁰ Such use may, in addition to its commercial nature, in particular be humorous. For example, a mark may be mocked and exploited as an indication of origin of a good in the context of its marketing, as was the case in Italy of the mark *Diesel*, renowned in the field of clothing and ridiculed by a sign *Porco Diesel*, affixed to identical products;¹¹¹ in France of the mark *Ricard*, renowned for alcohol beverages and registered for clothing, caricatured by the signs *Ringard* and *Smicard* affixed to T-shirts;¹¹² or in Switzerland because of the use of the sign *Harry Popper*, referring to the mark *Harry Potter*, for condoms.¹¹³ However, in such cases, it is difficult to understand why the use made by the defendant should be considered lawful. The third party cannot claim to have been motivated by a humorous intention in order to avoid liability. The parodic effect per se cannot serve as a criterion to legitimise unauthorised use of a trade mark for commercial purposes made in the mere particular interest of the user.¹¹⁴ In such cases, the third party may not benefit from any special treatment. Indeed, the fact of presenting another person's trade mark in a parodic manner shall in no way exclude liability.¹¹⁵

Likewise, it cannot be sufficient to qualify an expression as artistic for it to be lawful.¹¹⁶ When a use is of a commercial nature and can be considered as use as a trade mark, it is likely to infringe a trade mark right. In fact, is it really possible to claim the "freedom of expression" when a third party markets goods or provides services using a modified version of another person's trade mark? In order to invoke

¹⁰⁹ As noted above, this is not the case under national legislations which implemented Art. 10(6) of Directive 2015/2436, in particular under Benelux law.

¹¹⁰ Canlorbe (2010), p. 114.

¹¹¹ Turin District Court (*Tribunale ordinario*), 9 March 2006, *Diesel*. On this case, see Paesan (2011), pp. 136–137.

¹¹² Paris Court of Appeal, 11 May 2007, case 05/21446, *Ricard*. Provided that the signs have actually been used as trade marks. Cf. Passa (2009), p. 534.

¹¹³ Cited by Alberini (2015), p. 426.

¹¹⁴ Canlorbe (2008), pp. 407–408; Canlorbe (2010), p. 114; Szczepanowska-Kozłowska (2013), p. 26. The Court of Rennes rightly observed that if the constitutional principle of freedom of expression allows, within certain limits, the use of elements diverted from a reputed trade mark to express in parodic form criticism of the goods designated by that trade mark or of the activity of the right holder, the use of such a mark by an economic operator in the course of trade, for the sole purpose of exploiting its repute, to market its own goods, constitutes infringement of the trade mark with a reputation. Rennes Court of Appeal, 27 April 2010, case 09/00413, *Petit Navire*.

¹¹⁵ In French jurisprudence, see Paris Court of Appeal, 21 November 1989, *Propriété industrielle* – Bulletin documentaire 1990, No. 481, III, p. 422, *Calèche*. According to the decision, the fact that the contested sign *Ça lèche* was a "mockery mark" did not exclude infringement.

¹¹⁶ Szczepanowska-Kozłowska (2013), p. 26.

the freedom of expression, the third party should pursue a goal of general interest.¹¹⁷ As observed, a broad implementation of the freedom of expression may lead to its trivialisation.¹¹⁸ By pushing the debate to the point of absurdity, any modification of a mark could be considered as made within the freedom of artistic expression. When a third party uses a mark applied to goods in such a way as to enable the public to distinguish the origin of those goods, it is no longer the freedom of expression that is at stake, it is freedom of trade and industry (freedom of competition). There is no doubt, however, that, as established above, trade mark rights constitute a legitimate limit to the latter. Nobody may invoke the freedom of trade and industry when infringing a trade mark right of another person. In such cases, claiming the freedom of expression should be regarded as abusive.

Admittedly, it needs to be noted that the freedom of expression referred to in Art. 10 of the European Convention on Human Rights is interpreted broadly and the term “expression” covers any form of communication of information or ideas regardless of their content or manner of communication,¹¹⁹ including information of a commercial nature.¹²⁰ Consequently, in certain cases, use made even as a trade mark and in the course of trade is likely to fall within the scope of the freedom of expression, since it can be considered as “expression” within the meaning of Art. 10 ECHR. Apart from the situation of use of a mark which is at the same time humorous or artistic, this may include use of a mark in advertising or comparative advertising. Indeed, commercial advertising is a matter of freedom of expression.¹²¹ However, in the light of Art. 10 ECHR, advertising may be subject to several restrictions intended to prevent unfair competition and to ensure respect for the rights of others. Trade mark rights therefore constitute a justified restriction of the freedom of expression in advertising.

Furthermore, it needs to be stressed that intellectual property rights are also fundamental rights whose value is, in addition, constitutional. In the light of the case law of the European Court of Human Rights, the trade mark constitutes “possession” within the meaning of Art. 1 of Protocol No. 1 to the European Convention on Human Rights. Consequently, intellectual property is a fundamental right.¹²² This also results clearly from Art. 17(2) of the Charter of Fundamental Rights of the European Union. Thus, even if the freedom of expression in some situations is truly affected, this fundamental freedom also has its limits and must give way to other fundamental rights. As has been rightly observed by several authors, it would be wrong to assume that, in the hierarchy of norms, the freedom of expression prevails over trade mark rights. They both have equivalent value, neither of them is superior to the other.¹²³

¹¹⁷ See, in French jurisprudence, Paris Court of Appeal, 11 December 2015, case 14/23109, *Ricard*.

¹¹⁸ Cf. Canlorbe (2008), p. 392.

¹¹⁹ Szczepanowska-Kozłowska (2013), p. 7.

¹²⁰ See ECHR, 20 November 1989, case 10572/83, *Markt Intern Verlag GmbH and Klaus Beermann v. Germany*, para. 26.

¹²¹ See ECHR, 24 February 1994, case 15450/89, *Casado Coca v. Spain*, para. 35.

¹²² ECHR, 11 January 2007, case 73049/01, *Anheuser-Busch Inc. v. Portugal*.

¹²³ Caron (2004), para. 3; Szczepanowska-Kozłowska (2019), p. 674.

We therefore fully agree with the authors who point out that the conflict between trade mark protection and the freedom of expression is less acute than it seems, since the balance between the two can be found within the general prerequisites for trade mark infringement.¹²⁴ Consequently, pursuant to Art. 9(2)(c) of Regulation 2017/1001 or national provisions interpreted in the light of Art. 10(2)(c) of Directive 2015/2436, it seems inappropriate to invoke the freedom of expression as due cause. Indeed, use of a mark which is made in the course of trade and in order to indicate the commercial origin of goods or services, in principle of the third party, should not be considered as a fair use falling under the due cause exception. The interpretation delimitating the scope of trade mark rights as enforceable only against use made in an economic context and as a trade mark constitutes an application of trade mark law provisions in a way that ensures full respect for the freedom of expression, in accordance with Recital 27 *in fine* of Directive 2015/2436 and Recital 21 *in fine* of Regulation 2017/1001.

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¹²⁴ Canlorbe (2008), p. 447. See also Gredley and Maniatis (1997), p. 419; Caron (2004), para. 3. *Contra* Senftleben (2013), p. 146 *et seq.*

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