Chapter 1
Introduction

1.1. TRADEMARK PROTECTION VERSUS FREEDOM OF EXPRESSION: INTRODUCTION TO A POSSIBLE CONFLICT

This book analyses the legal conflict between the protection of trademarks rooted in national and European trademark laws[1] and norms protecting freedom of expression. In particular, it will focus on the conflict between the exclusive trademark rights granted to right holders and the use of their trademarks by third parties as part of their freedom of expression.

This conflict arises because trademark law grants right holders exclusive, albeit limited, rights to use their trademarks, such as the right to prevent use of identical signs on identical goods, the right to prevent confusing uses of trademarks on similar and non-similar goods and, in the case of trademarks that have gained a reputation, the right to prevent detriment to, or the taking of unfair advantage of, the repute and distinctive character of the trademark.[2]

On the other hand, freedom of expression, as protected by Article 10 of the European Convention on Human Rights (ECHR) and Fundamental Freedoms grants all individuals a right to express themselves freely. As such, this fundamental right is deemed essential for the self-development of the speaker,

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1. These are the national trademark rights that are extensively harmonized by the First 89/104/EEC of the Council of 21 Dec. 1988, to Approximate the Laws of the Member States Relating to Trade Marks, OJ 1989, L 40/1 recently re-codified as Directive 2008/95/EC (hereinafter European Trademark or TMDir), and the largely identical trademark rights contained in the Council Regulation (EC) No. 40/94 of 20 Dec. 1993 on the Community trade mark [1994] OJ L-11/1 (hereinafter European Trademark Regulation or TMReg).
2. Article 5 TMDir, as implemented in § 14 of the Gemran Markengesetz (hereinafter MarkenG) and Art. 2.20.1 Benelux Convention on Intellectual Property (hereinafter BVIE); equal rights are contained in Art. 7 TMReg.

but also essential for furthering cultural and political processes in society. In recent years, Article 10 ECHR has been expanded to include the freedom of commercial parties to spread commercial information – in addition to the classical notion of citizens expressing their non-commercial, that is, political, cultural, and social views vis-à-vis the state, a move deemed important for its beneficial (i.e., informative) effect on consumers. In practical terms, the freedom of commercial and non-commercial expression[3] may include the freedom to use trademarks of third parties, in particular in artistic and political expression, but also in commercial expression, such as comparative advertising, use as a reference, or use as a descriptive indication. Freedom of expression may thus conflict with the rights of the trademark holder to prohibit the use of his trademarks.

Until recently, this conflict did not feature prominently in legal debate, as trademarks played only a commercial rather than a social, political, or cultural role. Besides, the protection of trademarks, focussing on forestalling confusing use, had been uncontroversial, with freedom of expression failing to feature in discourse on commercial communication.

In the commercial sphere, trademarks have always been of major importance as identifiers of the product source and product qualities. The Coca-Cola logo on a bottle, for instance, primarily discloses by which company the bottle has been produced and tells people who have consumed the soft drink before how the contents of the bottle taste. Without that trademark, such information could not be provided to consumers and, without the legal protection of trademarks, third parties could use identical or similar signs and confuse consumers, thereby destroying the information benefits of the trademark.

In this field, conflict between trademark protection and freedom of commercial expression may arise, where trademark law protects more than solely confusing use or third-party traders need to use protected trademarks in their commercial communications, for instance: in the context of comparative advertising or in other commercial communications that are aimed at informing or communicating with consumers. This type of conflict is of a purely commercial character, that is to say, it is all about providing information and gaining access to consumers. While trademark law already addresses this issue by striking a balance between the exclusive right to use a trademark and the access of other commercial parties to the same sign by restricting, for example, the grant of trademark rights over descriptive signs; and allowing for

3. The term 'freedom of commercial expression' is used throughout this book as referring to purely commercial expression, i.e. expression that does no more than proposing a commercial transaction. Such expression is subject to a lower level of protection under Art. 10 ECHR. The term 'freedom of non-commercial expression' refers to expression that 'is of public interest'. Such expression may be purely non-commercial, or it may entail an element of commerciality (e.g. expression that is contained in a news paper or in a film). What matters is that the expression entails an element that is of public interest triggering a higher level of protection under Art. 10 ECHR. See further ss 3.2.1 and 3.5.

referential use, descriptive use, and comparative advertising; it remains to be seen whether freedom of commercial expression may provide third parties with an additional right to use trademarks in order to provide vital information to consumers.

Outside of this area of purely commercial communication, the conflict between trademark protection and freedom of expression has gained momentum, as the role and use of trademarks has changed, due to economic, social, political, and corresponding legal changes, over the past 25 to 30 years.

First, the commercial role of trademarks has changed from that of an identifier to that of a communicator; as such, trademarks become part, if not the essence, of the advertising message by lending credibility and lasting effect to it. Without trademarks, advertising messages would not be convincing, not least because they may be unrelated to the underlying product. Coca-Cola, for instance, advertises with images of youth, positive spirit, and freedom. Without the Coca-Cola logo prominently employed, it is less likely that anybody would believe these advertisements and associate these properties with the product in question. Trademark law has, by now, embraced the protection of trademarks as communicators by shielding them not just against confusing use, but by protecting the distinctive character and repute of trademarks against free-riding, tarnishment, and blurring.

Second, the new role of trademarks as communicators goes hand in hand with the rise of consumerism. This has, for one thing, resulted in people satisfying some of their unconscious needs by consuming trademarks rather than the goods and services covered by them. What is more, trademarks, through pervasive use in mass media, have assumed the role of political, societal, and cultural symbols. Traditional mass media, such as newspapers, commercial television, and the Internet, which are sometimes referred to as the new mass media, ensure that advertising messages, including trademarks, pervade spheres of life that were previously untouched, thus leaving people exposed to literally thousands of commercial messages every day. As a result, in today's society trademarks have come to play important roles in signalling status and defining membership of groups. Such social functions of trademarks have been actively shaped and promoted by right holders through advertising. While trademark law partly grants right holders control over such uses of trademarks by protecting the distinctive character and repute of trademarks, this has, in turn, triggered criticism, satire, and parody, all of which are protected by freedom of expression.

Third, politically speaking, trademarks, more than people, have come to represent the power, influence, and attitudes of companies in our age. It is therefore not surprising that criticism and commentary have been directed toward trademarks. Coca-Cola, for instance, is seen by some as one of the key symbols of American cultural imperialism, while Greenpeace actively tries to target the logos of oil companies rather than naming and shaming the top managers of these companies.

Fourth, on a cultural level, some artists, both professionals and amateurs, creatively use and transform trademarks and their messages into works of art, often with the help of new technology. Examples of this development include Andy Warhol's painting of Campbell's soup cans, Tom Sachs with his creation of a 'Chanel Guillotine' and a 'Prada concentration Camp', and a German artist who creatively combined a poem by Goethe, the name 'Rainer Maria Rilke', and the trademark Milka on a purple postcard. Trademark right holders may fear this kind of art, because it takes a certain amount of control over the meaning of trademarks out of their hands. By contrast, artists may be entitled to claim the protection of freedom of expression when using trademarks of third parties to influence and shape culture.

Taken together, many of the social, cultural, and political uses of trademarks can be referred to as a process of 'social, cultural, and political ''meaning making''',[4] whereby individuals use, shape, and influence the meaning contained in those signs which they deem to be of great influence over their lives or over society. The ability to exert such influence may greatly influence the perceptions of a person's place in society, as well as political and social processes.

Finally, the emergence of new media has created new and easy ways for third parties to use trademarks commercially and non-commercially and has enabled individuals to transmit their expression to a large audience. These new uses of trademarks may inherently conflict with the protection of the distinctiveness and repute of trademarks, which gives control over the meaning of signs to trademark right holders.

In the light of all the developments and changes briefly addressed above, this book aims to explore whether the current national and European trademark laws are compatible with the freedom of expression as enshrined in Article 10 of the European Convention on Human Rights and corresponding provisions of various national laws. In analysing this question, it will be argued that adopting a freedom of expression perspective is necessary as it allows us to shift the focus of courts and legislators from the interests of trademark right holders, who seemingly are granted ever more protection, to the justified interests of third parties. In taking this perspective, the book attempts to resolve the conflict described above by suggesting ways to establish an adequate balance between the legitimate interests of trademark right holders and the freedom of expression of third parties using their trademarks. This involves a critical analysis and re-interpretation of existing trademark law and proposals for certain legislative amendments. The new insights and imperatives provided by this book may prove useful to both courts interpreting existing provisions of trademark laws and legislators who are faced with the challenges of drafting new rules or revising existing laws.

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4. For further elaboration on the use of trademarks in social, cultural, and political meaning making, see ss 1.2.5 and 3.4.2.