



# TRADEMARKS & FREEDOM OF SPEECH

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## Freedom of Speech

- Preliminary remarks
- Different forms of speech
- Unauthorised trademark use in public speech
- Unauthorised trademark use in commercial speech
- Conclusion



# Freedom of Speech

Recognised legal principle in Europe

- Art. 10.- European Convention on Human Rights (Council of Europe)
- *Everyone has the right to freedom of expression. This right shall include freedom to hold opinions and to receive and impart information and ideas without interference by public authority and regardless of frontiers*
- Art. 6.2.- Lisbon treaty (EU)
- *The Union shall accede to the European Convention for the Protection of Human Rights and Fundamental Freedoms.*
- Constitutions of Member States (Spanish, German, Dutch...)



## Trade Mark Rights

- Article 1 of the First Protocol to the ECHR preserves the right to peaceful enjoyment of possessions ( i.e. property).
- Intellectual property falls within the concept of property, so it deserves to be respected equally to freedom of speech, neither ranking above the other.



## Commercial speech / Non-commercial speech

- Political speech: essential component of a democratic and pluralist society (higher level of constitutional protection)
- Commercial speech: less deserving of protection (wider margin of appreciation)
- Not always easy to differentiate: blogs, product placement, youtube.com, ambush marketing
- Commercial speech: the provision of information, expression of ideas or communication of images as part of the promotion of a commercial activity



## Commercial Speech - Art. 10 ECHR

- Guarantees the right to receive information
- Restrictions: prescribed by law and only if necessary in a democratic society
- European Court of Human Rights:
  - 24.02.1994 *Casado Coca v. Spain*
  - 17.10.2002 *Stambuk v. Germany*
  - 11.12.2003 *Krone Verlag GmbH & Co. KG v. Austria*



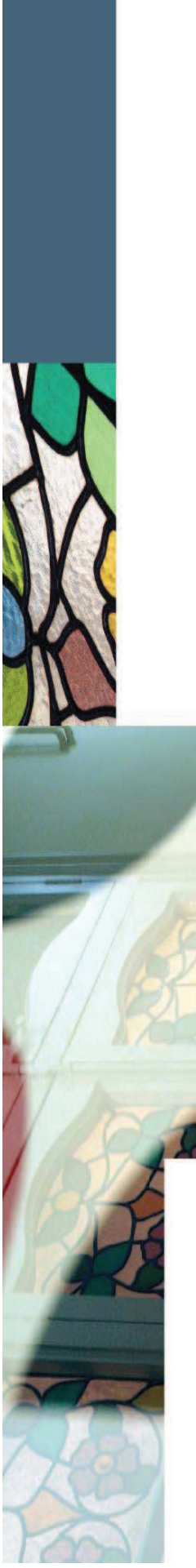
## Commercial Speech





## Protest - Criticism

- Interplay between trade marks and freedom of speech
- Internet: protest sites, “sucks” sites
- [lakaixa.com](http://lakaixa.com)
- [putasgae.org](http://putasgae.org)
- *Esso v. Greenpeace / Areva v. Greenpeace*
- Brief reference to political speech



## lakaixa.com (WIPO Case No. D2001-0360)

*“when a protest domain name has been registered for the main purpose of making money, it has been registered in bad faith, while when the purpose was really to provide criticism, political or otherwise, a finding of bad faith would not be appropriate”*

*“Although converting “c”s into “k”s is a way of expressing feelings similar to those expressed by the word “sucks” in English, this practice is part of a countercultural Latin jargon and is unlikely to be understood by most Internet users throughout the world”*

*Other decisions: [accorsucks.com](http://accorsucks.com), [peta.org](http://peta.org)  
[jeboycottedanone.com](http://jeboycottedanone.com)*

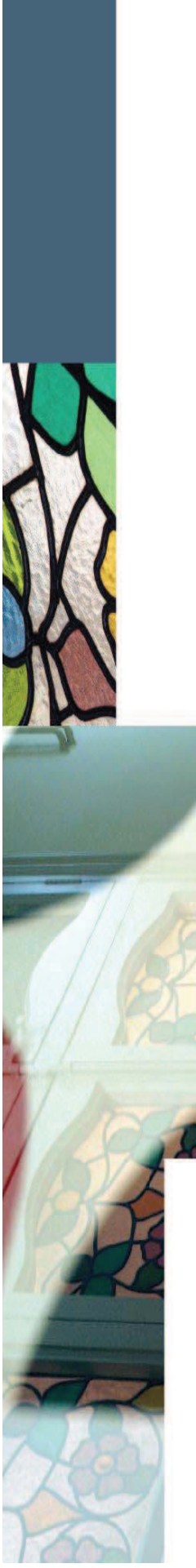


## Putasgae.org (Appeal Court of Madrid 06.02.2006)

*“Rights, no matter how important they may be, can never be absolute and unlimited as this would blur the idea of freedom and democracy”.*

*“Freedom of expression is not absolute and may be subject to restrictions so as to achieve certain objectives of relevance for the common good or to secure the rights of others”.*

*“Law protects freedom of expression provided the terms of the exteriorised critical attitude are not disproportionate and as long as they do not include unnecessary insulting expressions”*



## Esso v. Greenpeace / Areva v. Greenpeace

- ESSO: acceptable transformative use, based on freedom of expression.
- AREVA: not a violation of trademark law, but transformative use illicit (denigrating character). Decision revoked.
- French Cour de Cassation 08.04.08 considered that “Greenpeace was acting pursuant to its aim, in a public interest and public health purpose, and by means that were proportionate to this aim without having abused its right to freedom of speech”.





## Non-commercial speech conclusions

Freedom of speech may be validly invoked against non-commercial use in criticism and protest sites as long as:

- the use is not “in the course of trade”
- the fact that it is a critical web site or protest is clear
- the right to criticise freely is exercised with prudence
- the unauthorised trade mark use is not defamatory



## Political speech



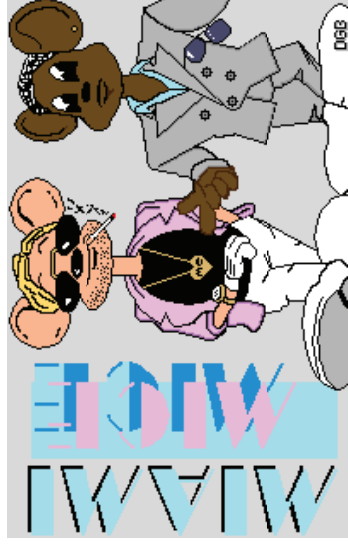
- health warning text: *Geert Wilders.... Extremist.... Harms You and Society Seriously*
- No use as a trademark
  - No use in the course of trade
  - Philip Morris opposes this undesired association with extremists



## Commercial speech - Parodies



**Genital Electric**  
*We bring good wars to life.*





## Parodies

A parody must convey two simultaneous - and contradictory - messages: that it is the original, but also that it is not the original and is instead a parody.

A parody is impossible without using a logo and/or name similar to a famous mark.



## EC Directive (art. 5.2)

... the proprietor shall be entitled to prevent all third parties not having his consent from using in the course of trade any sign which is identical with, or similar to, the trade mark in relation to goods or services which are not similar to those for which the trade mark is registered, where the latter has a reputation in the Member State and 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.



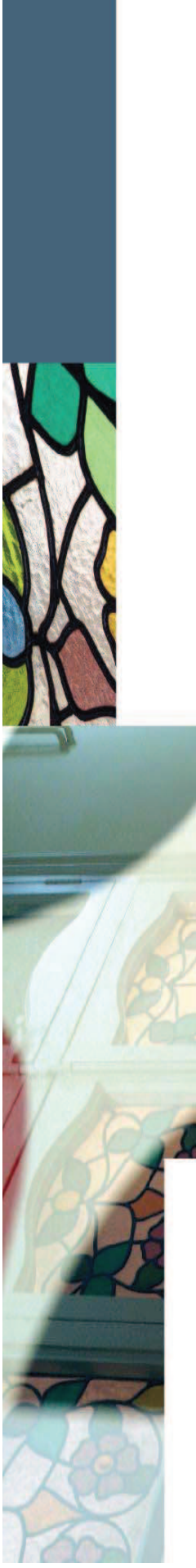
## ECJ Decision 09.01.2003 (Case C-292/00 - Davidoff)

- *Articles 4(4)(a) and 5(2) of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks are to be interpreted as entitling the Member States to provide specific protection for registered trade marks with a reputation in cases where a later mark or sign, which is identical with or similar to the registered mark, is intended to be used or is used for goods or services identical with or similar to those covered by the registered mark*



## ECJ Decision 23.10.2003 (Case C-408/01 - Adidas v. Fitnessworld)

- 2. The protection conferred by Article 5(2) of Directive 89/104 is not conditional on a finding of a degree of similarity between the mark with a reputation and the sign such that there exists a likelihood of confusion between them on the part of the relevant section of the public. It is sufficient for the degree of similarity between the mark with a reputation and the sign to have the effect that the relevant section of the public establishes a link between the sign and the mark.*



## ECJ Decision 18.06.2009 (Case C-487/07 - L'Oréal v. Bellure)

1. Article 5(2) of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks must be interpreted as meaning that the taking of unfair advantage of the distinctive character or the repute of a mark, within the meaning of that provision, does not require that there be a likelihood of confusion or a likelihood of detriment to the distinctive character or the repute of the mark or, more generally, to its proprietor. The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an advantage taken unfairly by that third party of the distinctive character or the repute of that mark where that party seeks by that use to ride on the coat-tails of the mark with a reputation in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image.



## US Approach



Louis Vuitton Malletier v. Haute Diggity Dog LLC  
(4th Circuit, 2007, 03.11.2006)



# Louis Vuitton Malletier v. Haute Diggity Dog LLC

*While it is undisputed that Plaintiff possesses a strong and widely recognized mark, the name "Chewy Vuitton" is an obvious parody of a famous brand name. The fact that the real Vuitton name, marks, and dress are strong and recognizable makes it unlikely that a parody-particularly one involving a pet chew toy and bed will be confused with the real product.*

*The marks and dress are similar enough for the average consumer to recognize a humorous association with the Vuitton mark, without likely confusing that same customer that it really is a Vuitton product. The similarities do exist, but they are necessary as part of the parody, for without them, no parody exists.*

*An intent to parody is not an intent to confuse the public. There is no showing of bad faith on the part of the Defendants*

*Defendants do not dispute that the Plaintiffs mark is strong and famous. Nonetheless, this Court finds no likelihood that the parody of Plaintiff's mark by Defendants will result in dilution of Plaintiff's mark. This Court finds that the mark continues to be associated with the true owner, Louis Vuitton*

*Tarnishment occurs when the plaintiff's trademark is likened to products of low quality, or is portrayed in a negative context. When the association is made through harmless or clean puns and parodies, however, tarnishment is unlikely. Plaintiff's assertions that Chewy Vuitton products tarnish LVM's marks by associating "inferior products" with the Vuitton name are baseless, and without merit. Plaintiff provides neither examples of actual tarnishment, nor any evidence that shows likely tarnishment.*

*In this case, the name "Chewy Vuitton" is an obvious wordplay on the name Louis Vuitton, and the superimposed C and V on the logo are intended to "conjure up" enough of the Louis Vuitton logo in order to make the object of its wit—a humorous play on Louis Vuitton's high-end image in the form of dog toys recognizable. The parody is not possible unless the logo and name are similar to those of Plaintiff, and therefore such parody constitutes a fair use in this respect.*

Thank you!