# A Parody Exception - Why trade mark owners should get the joke

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*Recent reforms saw the introduction of a parody exception into UK copyright law, and current debate calls for a similar parody exception in EU trade mark law. This article evaluates why there is a need for such specific exception and why recital 25 of the recast Trade Marks Directive might be insufficient. Despite the generally commercial nature of trade marks, a closer analysis reveals that trade marks owners’ rights have expanded to cover expressive uses of signs, including parody. The introduction of an exception allowing registered trade marks to be parodied would re-balance the protection afforded to signs to ensure that trade marks owners may still exercise their rights, but without causing disproportionate harm to the exercise of freedom of expression.*

# 1. Introduction

Troublesome to define[[2]](#footnote-2), trade mark parody refers to the reproduction of a protected sign, either to comment upon the trade mark, or to rely upon the values encapsulated by the sign for comic or critical intent. Parody is multivalent[[3]](#footnote-3), but in essence, it is a close adaptation of an existing (usually famous) sign which simultaneously is distanced enough from it, whether by distortion or by an unexpected change of context, to be recognised as a new sign. A successful parody requires the public to recognise the underlying sign through the ciphers provided by the parodist.

Although parodies might be most closely associated with copyright works, trade marks, including logos or words, are also a source of creative inspiration for parodists. Relying on the communicative, social and cultural functions of trade marks[[4]](#footnote-4), parodists reproduce these signs to enable them to comment more persuasively upon the trade mark’s values, to create new artistic works or simply to entertain. Campaign groups often use parody to good effect. *Greenpeace*, for example, use trade marks to highlight the negative environment effect of the brand owner’s activities[[5]](#footnote-5). In a different genre, artist *Tom Sach* is known for incorporating protected marks into his artistic creations, including a model death camp fashioned from *Prada* shoe boxes[[6]](#footnote-6). While these particular uses constitute non-commercial expressions, trade marks can also be parodied in commercial expressions. Commonly, variations of well-known marks appear on the front of t-shirts, posters, mugs etc, intended for commercial sale[[7]](#footnote-7).

In contrast with copyright[[8]](#footnote-8), neither the Trade Marks Directive nor the Trade Marks Regulation enshrines a specific exception for the purposes of parody. Hence, copyright owners may be lured into protecting their works under trade mark law in order to benefit from a wider scope of protection, and to circumvent copyright law’s exceptions, including parody[[9]](#footnote-9). For example, *Hergé’s* estate has protected the cartoon character, *Tintin*, as well as many of the cartoon titles as trade marks to broaden their control over third party uses[[10]](#footnote-10).

The result is a complicated canvas. Firstly, trade mark law’s lack of a parody defence enables those trade mark copyright owners who have secured trade mark registrations of their works to block what may be a permissible parody under copyright law. Instead of relying upon the rights protecting their artistic, literary or musical creation, they may rely instead upon trade mark protection afforded to the distinctiveness and repute of their mark. Secondly, where the subject of the parody is the protected sign itself, three scenarios are possible. A parody which is a non-commercial expression is likely to be permitted because trade mark infringement requires use ‘*in the course of trade*’[[11]](#footnote-11). Difficulties arise with mixed expressions, where the use is neither wholly commercial nor wholly non-commercial (e.g. the t-shirt example above). Finally, the most problematic are trade mark parodies made in a purely commercial context.

While some trade mark owners are flattered and even encourage creative uses of their signs, more often, trade mark owners take a defensive stance, and seek to prevent any parody of their mark, fearing this could negatively impact on the image which the company has worked hard to create based around the registered mark.

This article proposes that trade mark law should provide more room for the creation of trade mark parodies. By adapting the current legal regime to resolve tensions between the marketing and expressive spheres, it is believed that trade mark legislation will continue to provide effective protection for the other trade mark functions, while reinforcing stakeholders’ faith in the system. This article first explores the legal issues and policies behind the creation of trade mark parodies under UK law, before critically evaluating how this current legal framework balances the rights of trade mark owners and the interest of the wider public. By studying the provisions relating to infringement and existing defences, this article analyses whether importing the copyright parody exception into trade mark law is desirable, or whether the more commercial nature of these rights trade mark necessitates a bespoke exception. Given the potentially international reach of modern parodies and the lack of authorities applying new UK exception under copyright law, the article, while inherently speculative, draws upon comparative analysis with France where courts progressively recognised the existence of a parody exception under trade mark legislation.

# Legal issues over the recognition of parody uses

The manipulation of protected trade marks in parodies brings policy and legal concerns surrounding the tension which exists between the rights of mark owners to protect their image and the public’s right to freedom of expression to the fore[[12]](#footnote-12). Generally, trade mark law is confined within a commercial context. Although trade mark law recognises that trade marks have a number of market functions, it does not seek to regulate *all* third party use of the mark; permitting, for example referential use[[13]](#footnote-13), descriptive use[[14]](#footnote-14) and comparative advertising[[15]](#footnote-15).

For example, Arnold, J. considered this in a UK dispute relating unauthorised use an image of the protected *MARMITE* jar. This was used by the BNP, a far-right political party, during an election campaign along with the slogan: ‘*Love Britain Vote BNP’*[[16]](#footnote-16)(see Figure 1). The Act requires the use to be made ‘in the course of trade’[[17]](#footnote-17). Subsequently, Arnold, J. specified that this criterion must be interpreted as requiring the sign to be used to offer goods or services on the market and involves the pursuit of an economic advantage directly in relation to competitors[[18]](#footnote-18). Therefore, Arnold, J. concluded that uses of trade marks in political contexts should remain outside the scope of trade mark protection[[19]](#footnote-19).

*Figure 1*



Justified by the fact that trade mark law should preserve the essential source identification and product differentiation functions of a sign, the current interpretation of a trade mark’s goodwill function stretches beyond purely commercial uses. This affords trade mark owners the possibility of preventing *any* unauthorised use of their trade mark, irrespective of whether that use results from exercise of one’s right to freedom of expression[[20]](#footnote-20). Granting such exhaustive control of the use of signs seems unreasonable and inequitable, given that trade marks only morph into popular brands because they are adopted and endorsed by the public. Thus, the public is a significant contributor to the generation of goodwill and creation of a brand’s social context.

In light of such concerns, the Max Planck Institute’s study on the functioning of the EU trade mark regime has recommended that the referential use defence be expanded to encompass parody which was followed up by the Commission, the Council and the Parliament[[21]](#footnote-21). This proposal to revise the EU legislation in this area is appealing, not least because it would further harmonise trade mark law throughout the EU.

But where should the line be drawn between the hold trade mark owners have over the public’s mind relating to their protected trade mark signs and the right of individuals to refer to the values carried by signs to express themselves[[22]](#footnote-22)? While it is agreed that often these uses will fall outside the scope of trade mark legislation, any use having a commercial character is likely to fall under the trade mark owner’s control trade mark[[23]](#footnote-23). But why should this type of expression be treated differently? Or should the trade mark owners be the only ones who determine whether their marks may provide the basis for new works? How do we balance the interests in conflict?

If parodists are free to use registered marks to create parodies which might impair the image of goods and services they cover, would trade mark owners have sufficient means to protect their investment, since trade marks are used to communicate their message to the public which create credibility? Based upon utilitarian and *Lockean* theories, trade mark legislation mainly protects commercial interests of trade mark owners[[24]](#footnote-24). Over the last three decades, trade mark owners have understood the power of trade marks in their dialogue with the public. Consumers do not buy goods and services to merely satisfy their needs, but they *consume* trade marks for the messages they convey. Businesses develop new advertising techniques and invest considerable resources in developing the image of a company through its trade marks. Given these marketing and advertising costs, trade mark owners feel entitled to some security in their investments. This has led to the expansion of trade mark rights to protect the communicative function of trade signs against dilution, blurring and tarnishment. Unfair competition and passing off issues also arise, since parodies can benefit from a trade mark’s image, by seeking to build upon it to convey a certain message.

Consequently, trade mark owners push for further exclusive rights to protect these new emerging trade mark roles. Meanwhile, parodists seek a rebalancing between those functions of trade marks which ought to be protected and uses which should remain beyond a mark owner’s control. The result is that commercial and expressive spheres merge within trade mark legislation.

Against this backdrop, the Parliament and the Council of the European Union support the expansion of trade mark functions as developed through the Court of Justice European Union’s (‘CJEU’) jurisprudence. Although Council’s proposal for the recast of the Directive does not extend referential uses such as to include parody expressively, recital 25 recasts the TMDir such as to allow courts to apply trade mark provisions in accordance with the maximisation of all human rights in play, including freedom of expression[[25]](#footnote-25). Ultimately, this recital could enable the judicial to preserve the creation of trade mark parodies.

# Why is a trade mark parody trade mark infringement?

Trade mark legislation is largely harmonised within the EU. The two provisions which are most likely to impact on trade mark parodies are articles 5(1)(b) and 5(2) TMDir[[26]](#footnote-26).

## Trade mark parodies as an infringement of article 5(1)(b) TMDir

Articles 5(1)(b) afford trade mark owners the exclusive right trade mark to control any use of an identical or similar sign made in the course of trade in relation to identical or similar goods which is likely to confuse an average consumer as to the origin of those goods:

1. The registered trade mark shall confer on the proprietor exclusive rights therein. The proprietor shall be entitled to prevent all third parties not having his consent from using in the course of trade:

(…)

|  |  |
| --- | --- |
| (b) |  any sign where, because of its identity with, or similarity to, the trade mark and the identity or similarity of the goods or services covered by the trade mark and the sign, there exists a likelihood of confusion on the part of the public; the likelihood of confusion includes the likelihood of association between the sign and the trade mark. |
|  |  |

Firstly, based upon current interpretation of this provision, parodies produced for purely non-commercial purposes will avoid infringement because the use of the registered mark, or a similar sign will not take place ‘*in the course of trade*’. The Court of Justice of the European Union, having considered what was meant by this term in the *Arsenal* case[[27]](#footnote-27), interpreted it to encompass any ‘*commercial activity with a view to economic advantage and not as a private matter*’[[28]](#footnote-28). Thus, a parody which is exploited for any commercial purpose is likely to be considered use ‘in the course of trade’ for the purposes of article 5(1)(b). Originally, it was believed to be implicit that to be caught by the provision any use the sign would also need to be use ‘*as a trade mark*’ (i.e. used to indicate the source of the goods or services[[29]](#footnote-29)). But, in *L’Oréal*[[30]](#footnote-30), the CJEU held that the exclusive rights extended beyond a trade mark’s ‘*origin function*’. It is also necessary to take account of other functions of a trade mark, particularly those relating to communication[[31]](#footnote-31), investment[[32]](#footnote-32) or advertising[[33]](#footnote-33).

Secondly, infringement only arises if unauthorised use is of the same/similar signs in relation to the same or similar goods/services covered by the registration[[34]](#footnote-34). Identity or similarity of sign is at the very heart of parody, since a parody will fail unless the sign used is similar enough to the protected mark that the public is able to recognise that a reference is being made to that particular trade mark. As established for the test of likelihood confusion, similarity may be visual, phonetic or conceptual[[35]](#footnote-35). Given that this is assessed from the perspective of the notional ‘*average consumer*’, a finding of similarity is derived from an imperfect recollection. Nevertheless, any similar sign must be in also be used in relation to the same or similar goods/services covered by the registration. Reproducing a protected mark in a parody in relation to other goods or services will avoid trade mark infringement, at least pursuant to article 5(1)(b)[[36]](#footnote-36).

Thirdly, the use must create a likelihood of confusion, which includes a likelihood of association. This latter does is not an alternative to likely confusion, but rather it serves to define its scope[[37]](#footnote-37). Trade mark law’s primary concern is to avoid consumer confusion relating to origin. Therefore, infringement requires there to be a risk that because of the identity or similarity of the sign *and* the products, the average consumer is likely to assume that products bearing the unauthorised sign are commercially linked in some way to the trade mark owner. This link may include a belief that they come from the same source, or that they are endorsed by the owner[[38]](#footnote-38). Trade mark parodists will need to demonstrate that their use will not give rise to a likelihood of confusion.

This should be a possible feat for parodists. A successful parody will not want to be confused with the original. On the contrary, parodies rely upon the public’s recognition that only a reference is being made to the original. Consumers faced with a trade mark parody will identify this reference to the protected mark, but realise that this is only for humorous or critical effect. There should be no likelihood of confusion, since the average consumer will not believe that the parody is commercially linked to the trade mark owner. Yet, a ‘bad’ parody which does not distinguish itself sufficiently from the original protected mark could give rise to confusion, such that the use could amount to trade mark infringement[[39]](#footnote-39).

Whereas the need to demonstrate likelihood of confusion pursuant to article 5(1)(b) TMD tends favour trade mark parodies, we shall see in the next section that the converse is true in respect of article 5(2) TMD, which relates to trade marks which have acquired a reputation.

## Trade mark parodies as an infringement to article 5(2) TMD

Given the lack of a specific exception, and irrespective of whether a trade mark is parodied in the course of trade or not[[40]](#footnote-40), and even without any consumer confusion, it is still open for a court to determine that a parody has infringed a trade mark owner’s exclusive rights pursuant to article 5(2) TMD, because it has encroached on the trade mark’s goodwill and reputation[[41]](#footnote-41):

2.   Any Member State may also provide that 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.

Designed to protect the inherent value of trade marks, these ‘*anti-dilution*’ provisions apply to artistic or other non-commercial uses of trade marks, including parody. To succeed, first, the trade mark owner must prove that the mark has an established reputation. Second, the nature of the unauthorised use must be such that the average consumer connects the use to the trade mark owner, although origin confusion is not required[[42]](#footnote-42). Third, the owner must demonstrate that they have suffered damage[[43]](#footnote-43), or are likely to do so[[44]](#footnote-44). Finally, the owner must establish that the use of the trade mark was made ‘*without due cause*’ and ‘*takes unfair advantage of, or is detrimental to, the distinctive character or the repute*’ of the trade mark.

This requirement creates two problems for parodies. First, the directive does not define ‘due cause’. Some commentators have argued that since parodies are an embodiment of freedom of expression, parodic use should be seen as due cause[[45]](#footnote-45). Yet others suggest a narrower interpretation; ‘due cause’ referring to use of a protected mark by a market operator to indicate that they have a particular skill related to the trade marked goods or services[[46]](#footnote-46). Second, it is necessary to appreciate when use takes ‘unfair advantage’[[47]](#footnote-47) of or is to ‘detrimental’ a protected mark. The CJEU has held that this includes: ‘*in particular, cases where, by reason of a* ***transfer of the image*** *of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation’*[[48]](#footnote-48). In this definition, the Court makes no distinction between taking unfair advantage of the mark’s reputation or of its distinctive character. Instead, the CJEU refers to free-riding, or parasitism, rather than focusing on whether the unfair advantage results from the transfer of the image of the mark[[49]](#footnote-49).

This approach is well-illustrated by a case involving the US pop star, Lady Gaga[[50]](#footnote-50). Here, Lady Gaga succeeded in obtaining an interim injunction preventing release of a song, featuring a cartoon *Moshi Monster* figure called Lady Goo Goo (see Figure 2), which was a clear caricature of the singer[[51]](#footnote-51). When considering if the use would also create a likelihood of confusion, having made a global assessment which took account of the surrounding circumstances, Vos, J. concluded the average consumer would be confused[[52]](#footnote-52). In this case, the average consumer was a child aged between 6 to 12 years, consumers likely to encounter the song on online sharing platforms[[53]](#footnote-53).

*Figure 2*



When considering dilution, although Vos, J. accepted the parodic purpose was obvious but he considered the particular use went beyond the genre, because the defendant was using the mark to enhance the commercial success of their own business[[54]](#footnote-54). The necessary ‘link’ between the use and the *LADY GAGA* trade mark was readily established by the tags used by the defendants on online sharing platforms. These, the court held would blur the registered trade mark in the public’s mind[[55]](#footnote-55). In assessing dilution[[56]](#footnote-56), the judge distinguished from *Interflora*[[57]](#footnote-57), a case also involving internet use, on the facts. In that case, consumers consulting the defendant’s website would be aware that the products displayed did not originate from the owner of the *INTERFLORA* trade mark. The same clarity was not in evidence here, since a search on an online platform, such as *YouTube*, using the keyword ‘Lady Gaga’ would also bring up the *Lady Goo Goo* parody in the results. Additionally, they intend to get in the charts just as the original[[58]](#footnote-58). In the judge’s view, this could damage to the distinctive character of the LADY GAGA mark[[59]](#footnote-59). Similarly, tarnishment was also possible[[60]](#footnote-60), since there was a risk is that consumers would believe that the parody originated, or was endorsed by Lady Gaga[[61]](#footnote-61). Finally, Vos, J. also found the use took unfair advantage[[62]](#footnote-62).

The commercial nature of the parody, together with the possibility that both parties were competing in the same market were central to the Court’s findings, since, taken together, these factors were likely to create consumer confusion. These facts were also present in an earlier passing off case involving a parody of a politician’s published diaries[[63]](#footnote-63). Again, the decision stressed that the term ‘parody’ implies the absence of confusion, and without confusion, the claimant should not succeed under passing off.

Similarly, the French Courts have also upheld the trade mark owner’s rights in respect of commercial trade mark parodies. In *Petit Navire*[[64]](#footnote-64), the defendant was selling t-shirts printed with a parody which incorporated both the word and device trade marks registered by a company selling sea themed products. Specifically citing the lack of a parody exception in trade mark law, the Court of Appeal dismissed the defendant’s argument that the dealing in the goods was merely exercise of their right to freedom of expression, since their intent was to profit from the power of attraction associated with the registered trade mark. Further, as the parody implied the trade mark owner had been responsible for environmental pollution, the defendant’s use tarnished the marks’ reputation.

To conclude, article 5(2) TMDir provides even greater protection for trade mark owners to control parody uses because most of these alleged infringing uses will be found as diluting the trade mark.

# A possible defence reliant on freedom of expression

Given trade mark law’s ambivalence to accommodate parody, some parodists have sought to rely upon freedom of expression arguments directly to avoid trade mark infringement[[65]](#footnote-65).

Enshrined in most legal instruments[[66]](#footnote-66), freedom of expression constitutes one of the primary rationales for a parody exception[[67]](#footnote-67). The right to freedom of expression is accepted as having an essential function in any democratic society, and this resulted in the right being afforded a broad scope. Yet, it is not absolute. Equally, article 1 of Protocol 1 of the ECHR recognises property rights as human rights. Despite some debate whether intellectual property rights qualify as *real* property rights[[68]](#footnote-68), the European Court of Human Rights (‘ECtHR’) has held that trade marks are a possession protected under article 1 of Protocol 1 of the European Convention of Human Rights (‘ECHR’)[[69]](#footnote-69). This position is reflected in UK legislation. Section 22 TMA 1994 expressly states: ‘*A registered trade mark is personal property*’. Again, recognition of trade mark registrations as personal property, and protected as a fundamental right does not render these rights absolute either. As with other fundamental rights, property rights can be limited where the State needs to ‘*control the use of property in accordance with the general interest*’[[70]](#footnote-70). Hence, trade mark rights must be weighed against the public interest, which includes the protection of public discourse.

Given that the UK is a signatory to the ECHR, UK legislators are obliged to comply with the content of the Convention. While many countries, such as France, protect these fundamental freedoms through constitutional warrantees, the UK has implemented the ECHR via the Human Rights Act (‘HRA’) 1998[[71]](#footnote-71). Section 3 HRA requires primary legislation, including UK TMA 1994, to be interpreted in a manner which is compatible with the HRA. This has emboldened defendants to attempt to rely on freedom of expression to safeguard their right to parody registered marks. Courts are thus asked to balance freedom of expression with property rights, both protected as fundamental freedoms.

Consequently, not all parodies should be permitted, but freedom of expression provides a basis to ensure that parodists are free to choose the vehicle for conveying their message, which might include reproduction of a registered mark[[72]](#footnote-72). Although the CJEU has yet to provide guidance on weighing freedom of expression against trade mark rights in the context an infringement action, some cases have come before national courts, and on occasion, freedom of expression arguments have prevailed to allow parodists to use protected trade marks without the owners’ consent.

The English courts, however, appear indisposed to accept freedom of expression arguments to justify the use of a trade mark for parody purposes. In *Miss World Ltd. v Channel 4 Television Corp*, the defendant modified the well-known *MISS WORLD* trade mark into ‘*Mr Miss World*’ as the title of a TV beauty contest for transsexuals. The defendant argued the programme championed equal rights for transsexuals. Despite recognising that such use falls within freedom of expression[[73]](#footnote-73), the court ultimately decided that in this case this right did not override the trade mark owner’s right to prevent dilution of its protected mark[[74]](#footnote-74). Pumfrey, J. considered the defendant’s use aimed to take unfair advantage of the distinctive character and reputation of the claimant’s trade mark. Fhima criticises this decision[[75]](#footnote-75) for confusing application of the right to freedom of expression with the infringement regime of article 5.2 TMDir. Yet, this decision appears to reflect the general reluctance of national courts to apply freedom of expression in trade mark cases, in order to preserve the internal balance intended by the legislator within the TMDir.

The legality of trade mark parodies in the context of political speech has been tested by French courts in several cases.

The first case from 1992 concerned *Marlboro* and other well-known cigarette mark[[76]](#footnote-76) (Figure 3), which objected to the defendant’s parody of their packaging. The modified images included the phrase ‘*adverts kill*’ and associated the brands with dreadful events, such as death and oil spills. The Court of Appeal held that although the use did imply an association between these negative events and the cigarette brand, the parody did not go beyond what the right to freedom of expression permits. By this decision, the court opened the door for trade mark parodies to be recognised as a legitimate exercise of freedom of expression[[77]](#footnote-77).

*Figure 3*





This decision was further developed in *Michelin*[[78]](#footnote-78), a case involving the unauthorised use of a cowboy figure, well-known from the trade mark owner’s adverts, in an anti-tobacco campaign. The Court of Appeal held here that since the parody use was in the exact opposite context as the trade mark owner’s own use, there would be no likelihood of confusion. Having concluded that the use did not dilute the mark either, the court considered the use of the trade mark as a lawful criticism of the trade mark owner’s social policy. This decision constitutes a real turning point in French jurisprudence, and marked the start of the recognition of the legality of trade mark parodies[[79]](#footnote-79).

Since *Michelin*, trade mark parody in a political or social context is generally allowed in France. This is illustrated by the *Danone*[[80]](#footnote-80), *Esso* and *Areva* cases. *Danone* dealt with the creation of a website using the domain name: ‘jeboycottedanone.com’ (i.e. ‘Iboycottdanone.com’) and use of a modified *DANONE* logo (figure 4). These signs were used by the defendant to support a campaign calling for a boycott of Danone’s products – a reaction to the announcement of a major restructuring of the French-based multi-national food company.

*Figure 4*

 

The court recognised the defendant’s use of the protected mark *DANONE* resulted from an exercise of the freedom of expression, but the court distinguished between the two uses. In relation to the infringement of the DANONE mark, the court held that the use of ‘Danone’ within the domain name was legitimate referential use, necessary to express the controversial and political nature of the website. But regarding the DANONE logo, the court took a more severe line, considering that the alteration of the logo was not essential for the defendant’s purpose[[81]](#footnote-81). Surprisingly, despite rejecting the use on freedom of expression grounds, the court then evaluated whether a parody exception applied, but concluded that it failed for lack of humorous character. While it is difficult to follow the order of the court’s reasoning, it seems that they may have reached a different conclusion had the re-worked logo included more humour. Yet even this interpretation falls short, as reliance upon potentially subjective determinations of ‘humour’ may result in arbitrary court decisions, and too restrictive an interpretation of parody.

In *Esso*[[82]](#footnote-82), Greenpeace used an altered *ESSO* logo, E$$O (Figure 5) to criticise the trade mark owner’s environmental policy, and inform individuals on the means used by the business to provoke failure of the Kyoto Protocol on climate change.

*Figure 5*

 

Despite initial summary judgment in the trade mark owner’s favour, this was overturned on appeal, based upon *Danone*. By denouncing environmental damage, Greenpeace was merely exercising its freedom of expression and this justified their use of the protected mark. The Court acknowledged that freedom of expression was not an absolute right, and set the limit where the defendant’s use harmed other’s rights. Here, the Court held that the particular use made did not create confusion with the company’s own activities: the use of the altered logo located debate outside any commercial activity and, most significantly, the defendant did not use the logo in respect of identical or similar products as the trade mark owner. For this reason, the Court considered that the use in no way denigrated the trade mark owner’s products.

Ultimately, the French Supreme Court[[83]](#footnote-83) put an end to at least some uncertainties by confirming the decision from the appeal court. Taking as its starting point the nature of Greenpeace as an organisation, and then analysing the purpose behind its use of the alternated logo, the Court concluded that taken in context, the use of the trade mark constituted a proportionate means to the expression sought. Interestingly, the Supreme Court did not comment upon the relevance of the non-commercial nature of the use. Some deduce from this silence that the controversial character excludes the competitive sphere.

*Esso* can be compared with *Areva*[[84]](#footnote-84). In *Areva*, Greenpeace’s target was the nuclear industry and it picked upon the trade mark *AREVA*, a French multi-national specialising in nuclear energy, as its exemplar (Figure 6).

*Figure 6*

 

The trial judge found in favour of Greenpeace, and refused to extend the scope of the trade mark owner’s exclusive rights to cover parodic use[[85]](#footnote-85). On appeal, the court again refused to find for the trade mark owner, considering that the use created no confusion in the mind of the public, and that the use did not occur ‘in the course of trade’: another favourable judgment in favour of Greenpeace[[86]](#footnote-86). Yet the court did recognise that the use made denigrated the protected logo, and as such, constituted an abuse of freedom of expression and amounting to the engagement of Greenpeace’s civil responsibility[[87]](#footnote-87). Greenpeace appealed this finding to the Supreme Court of France. Here, the Court reversed the finding that the use was an abuse of freedom of expression, considering the use was proportionate given the public interest goal which Greenpeace sought[[88]](#footnote-88). Ultimately, this decision confirms that (at least French) courts should decline to enforce trade mark rights where to do so would conflict with a proportionate exercise of freedom of expression[[89]](#footnote-89).

There is an important caveat in respect of the French courts’ position[[90]](#footnote-90). In each of the cases discussed, the protected mark in question coincides with the trade mark owner’s company name. Therefore, the parodic use of the protected mark has been taken as a comment on that company’s particular policy or actions. French courts might reach a different outcome if the trade mark parodied was not a corporate house mark, as the use is more likely to be seen as illegitimate dilution which denigrates the products covered by the registration[[91]](#footnote-91).

As this analysis shows, courts are more inclined to accept an argument based on freedom of expression for parodies with a political or public interest character and outside of the commercial sphere.

# A specific exception for parody uses

Inasmuch as *some* trade mark parodies might avoid infringement, introducing a specific parody exception would offer greater legal certainty for parodists.

According to a recent CJEU decision relating to EU copyright law’s parody exception[[92]](#footnote-92), a parody comprises two essential elements: first, it must ‘*evoke an existing work while being noticeably different from it,’* and second, it must ‘*constitute an expression of humour or mockery*’. It would seem logical for trade mark parodies to follow the same definition. Hence, two requirements should prevail: a humorous intent and absence of confusion[[93]](#footnote-93). Incorporating the second aspect should be straightforward, since this is the function of trade mark law. Demonstrating humorous intent may be slightly more problematic. So that the numerous facets of parody may be preserved, this requirement should be interpreted broadly as an absence of malice.[[94]](#footnote-94) It is not unreasonable to require a parodist to refrain from disparaging the trade mark owner or the goods protected by the parodied trade mark[[95]](#footnote-95). Yet, trade mark owners will argue that *any* parody of their protected mark will denigrate it[[96]](#footnote-96), and indeed it is reasonable that a trade mark owner should retain a right to redress against a parody which damages a trade mark’s reputation to the extent that it impacts on consumer behaviour. This might not be a conscious shift, but rather that it is likely because of the parody, that current and future consumer are less inclined to buy the trade marked products.

To consider a few French examples, where a defendant parodied a newspaper’s logo on a CD album cover, together with rude and deliberately provocative comments, the court held that the defendant’s intent was not humorous, but simply offensive[[97]](#footnote-97). The French courts confirmed their view that humorous intent is not limited to what is funny, and extends to irony too[[98]](#footnote-98). Here, the court acknowledged that different sectors of the public will receive the parody in different ways, and for this reason, confirmed that the focus should be on the intent, rather than the result of the parody.

Turning to the absence of harm, courts should evaluate whether the use harms the reputation of the mark, i.e. the brand image. This will always depend upon the facts of the particular case. Take, for example, the use of the registered mark *LADA* as the target of a joke in a movie[[99]](#footnote-99): ‘*What’s* *the difference between a LADA car and AIDS? Try passing your Lada on to someone else!*’ (author’s own translation). Adjudicating a claim for trade mark infringement, the French court refused to accept the trade mark owner’s claim that the ‘joke’ went too far. The court was satisfied that the line was intended to entertain the film’s audience, rather than to harm the image of the protected mark.

While France applies a parody exception in trade mark law, this appears to be limited to those cases where the parody lacks a commercial motive[[100]](#footnote-100). This is seen by some as an additional requirement for the parody defence to apply in trade mark law[[101]](#footnote-101).

Yet, since the exception is justified by the freedom of expression, it is difficult to rationalise why commercial motives should fall outside the scope of the exception.[[102]](#footnote-102) It is uncontroversial that registered marks are becoming increasingly used in ‘mixed’ expressions: whereby the parody relates to products other than the goods or services covered by the registration. Arguably, if such parodies meet the requirements of the exception, and if there is not intent to denigrate the trade mark owner or their goods, then these should be protected as well.

Thus, the harm factor seems to afford the trade mark owner sufficient redress, permitting them to enforce their registration where the parody is likely to depreciate the value of their own goods or to enhance the value of the parodist’s goods[[103]](#footnote-103). In short, the brand *image* must remain unscathed. Nevertheless, this does not preclude a direct competitor from parodying a registered mark. Despite the current resistance of French courts to authorise such parody uses[[104]](#footnote-104), it is considered that the freedom of expression should be preserved between direct competitors too, provided the main requirement i.e. absence of harm to the brand image is respected. In today’s world which values free competition, there is no reason for *carte blanche* exclusion of competitor parodies.

Application of this approach is demonstrated in the French case *La Vache qui rit v. La Vache serieuse*[[105]](#footnote-105)(figure 7). Here, the first instance tribunal found in favour of the defendant, despite the fact that the two parties were in direct competition. This early decision is interesting for several reasons. First, the tribunal identified that given the importance of free competition, individual interests – such a trade mark rights - are not absolute. Thus, a trade mark owner cannot expect to have a monopoly over the idea or concept behind its registered mark. Therefore, where a competitor alters the protected logo so as to create a mark having the opposite meaning of the protecting mark (in this case, using a serious cow, rather than a laughing one, to promote processed cheese), there is no trade mark infringement. The fact that the trade mark owner was the first to have the idea of assigning a human facial expression to a cow did not permit him to control all possible bovine facial expressions.

*Figure 7*

 

This decision was overturned on appeal, although, the Court of Appeal agreed that the interests of right-holders are not absolute. However, based upon the nature of the two marks in issue, the appellant court considered that the defendant’s parody mark, an imitation by contrast, would lead consumer’s to believe that the two cheese products shared a common origin[[106]](#footnote-106).

More recently, the court of appeal of Versailles held legitimate the parody use of a trade mark in a song released on a music album[[107]](#footnote-107). Interestingly, the court does not question the existence of a parody exception under trade mark law and refers to the exception provided by copyright law[[108]](#footnote-108). Therefore, the use of a trade mark by a professional who is not in direct competition with the trade mark owner is legitimised where the parody use does not denigrate the protected mark and satisfies the requirements attached to the parody exception.

Hence, this brief analysis of a selection of French trade mark parody decisions illustrate that it is possible for trade mark law to respect a trade mark owner’s rights and still preserve freedom of expression. The CJEU’s recent findings in *Deckmyn* provide a promising starting point for the introduction of a parody exception into EU trade mark law.

# Conclusion

Current trade mark law already affords *some* space to accommodate parody. However, as EU trade mark law moves towards stronger protection for trade mark owners to protect the investment, communication and advertising functions of their marks, a more robust EU framework is necessary to best preserve freedom of expression. Guarantee of the right to exercise this fundamental right requires a specific exception to be introduced, but this would also protect fair competition. Without adequate legislative limitations, there is a real risk that trade mark protection against dilution becomes ‘absolute’. Neither trade mark rights nor freedom of expression are absolute, and so a balancing is needed between the interests at stake. It is within this context that a specific parody exception comes into play.

*Deckmyn* supplies guidance for the interpretation of the exception to ensure an adequate balance between a trade mark owner’s rights and the free speech interests of a parodist. The most important requirement lies in the absence of confusion. Consumers should be under no doubt that the parody has no association or endorsement from the trade mark owner. Requiring a parodist to have humorous intent, will further preclude any malicious actions from being covered by the exception. Concurrently, the parody exception should not be absolute. Given that the exception is justified by, amongst others, the right to freedom of expression, it is reasonable to require it to respect the limits inherent in its own justification.

Finally, the jury is out on whether the recast of the recitals of the recast trade marks directive will provide sufficient grounds for courts to legitimise parody uses of protected marks in the absence of a specific parody exception.

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1. I am truly grateful to Lynne Chave (PhD student at the University of Nottingham) for her comments on an earlier draft. Remaining errors and omissions are my own. The author can be contacted at sabine.jacques6@gmail.com. [↑](#footnote-ref-1)
2. For more on the definition of parody see M. Spence, ‘Intellectual Property and the Problem of Parody’ (1998) 114 *Law Quarterly Review* 594. [↑](#footnote-ref-2)
3. Given the multi-faceted character of the term, ‘parody’ is used in this article to cover also related terms such as caricature, pastiche and satire. [↑](#footnote-ref-3)
4. M. Spence, ‘An Alternative Approach to Dilution Protection: A Response to Scott, Oliver and Ley-Pineda’ in Lionel Bently, Jennifer Davis and Jane C Ginsburg (eds), *Trade marks and brands: an interdisciplinary critique* (Cambridge University Press 2008) p.315 revisiting the ‘*Barbie*’ case. [↑](#footnote-ref-4)
5. For more on this campaign using *Coca-Cola* signs visit <http://mumbrella.com.au/greenpeace-launches-confront-print-campaign-on-back-of-court-loss-143933> [↑](#footnote-ref-5)
6. *Tom Sach* is famous for creating works utilising packages of goods bearing well-known trade marks to invite the audience to reflect on amongst other things, consumerism. See <http://www.tomsachs.org/work/prada-deathcamp> and for the author’s thoughts on his work, see <http://www.tomsachs.org/pictures/PradaDeathCampEssay.jpg> [↑](#footnote-ref-6)
7. For examples of parodies of famous signs on t-shirt see <http://www.teevault.com/roundups/logo-parody-tees-t-shirts-based-on-famous-logos/> and the decision held by the Constitutional Court of South Africa in *Laugh it off Promotions CC v. South African Breweries (Finance) B.V. t/a Sabmark International*, Case CCT 42-04 (27 May 2005). [↑](#footnote-ref-7)
8. Article 5.3(k) of the Directive 2001/29 on the harmonisation of certain aspects of copyright and related rights in the information society [2001] OJ L167 (‘the InfoSoc Directive’). [↑](#footnote-ref-8)
9. See the French case *Bibi Fricotin* whereby the court found the comics non-infringing under copyright law given the application of the parody exception to then render the use infringing under trade mark law. TGI Paris, 30 October 1991 (1992) 45 RDPI, 98; confirmed by CA Paris (4th ch), 12 July 1993 (inedit) similar outcome in TGI Nanterre (1st ch.), 6 April 1994 in relation to *Asterix* and *Isterix*. [↑](#footnote-ref-9)
10. CA Paris *Paul B. v. Moulinsart & others* [2005] available at <http://www.legalis.net/jurisprudence-decision.php3?idartide=1781> ; this overlapping intellectual property rights protections is even more attractive for copyright holders whose work is about to enter the public domain. By successful registration of their work under trade mark law, this offers them a certain control over the uses made of their work after copyright has lapsed. [↑](#footnote-ref-10)
11. Article 5 Directive 2008/95/EC of the European Parliament and of the Council of 22 October 2008 to approximate the laws of the Member States relating to trade marks (Codified version), O.J. L 299, 25-33 (‘TMDir’); section 10 UK Trade Mark Act 1994. [↑](#footnote-ref-11)
12. Article 19 Universal Declaration of Human Rights (‘UDHR’); article 19 International Covenant on Civil and Political Rights (‘ICCPR’); article 10 European Convention on Human Rights (‘ECHR’); article 11 Charter of Fundamental Rights of the European Union (‘Charter’). [↑](#footnote-ref-12)
13. Current proposed amendment to EU Law to enable the use of trade marks ‘for the purpose of identifying or referring to goods or services as those of the proprietor of the trade mark’ European Commission, *Proposal for a Directive of the European Parliament and of the Council to Approximate the Laws of the Member States Relating to Trade marks* (March 2013) COM(2013)0162 final, proposed article 14(1)(c) p. 21*.* [↑](#footnote-ref-13)
14. *Hölterhoff v Freiesleben* (C-2/00) ECLI:EU:C:2002:287 [2002] at [16]. [↑](#footnote-ref-14)
15. Section 10(6) UK TM Act. [↑](#footnote-ref-15)
16. *Unilever Plc v Griffin & Anor* [2010] EWCH 899 (Chy). [↑](#footnote-ref-16)
17. *Ibid* at [11]. [↑](#footnote-ref-17)
18. Joined Cases *Google France SARL v Louis Vuitton Malletier SA* (C-236/08 to C-238/08) ECLI:EU:C:2010:159 [2010] at [50]; *Galileo International Technology LLC and Others v Commission of the European Communities*(**T-279/03)** ECLI:EU:T:2006:121 [2006] at[114]-[117]; *Arsenal Football Club Plc v Reed* (C-206/01) ECLI:EU:C:2002:651 [2002] at [40]. [↑](#footnote-ref-18)
19. *Unilever PLc v Griffin & Anor* [2010] EWCH 899 (Chy) at [12]. Yet according *Kean v McGivan* political parties do not carry out commercial activities that benefit from protectable goodwill. [1982] F.S.R 119. [↑](#footnote-ref-19)
20. See the expansion of trade mark protection in *L’Oréal SA v. Bellure NV* (C-487/07) ECLI:EU:C:2009:378 [2009] at [58]; M. Vivant, ‘Revisiting Trade Marks’ (2013) 3(4) *Queen Mary Journal of Intellectual Property* 309. [↑](#footnote-ref-20)
21. Max Planck Institute for Intellectual Property and Competition Law, study on the overall functioning of the European trade mark system (Munich, 2011) 122 at 2.262 available at <http://ec.europa.eu/internal_market/indprop/docs/tm/20110308_allensbach-study_en.pdf>; Additionally the European Parliament adds expressly to the European Commission’s proposal for the amendment of the TMDir article 14(1)(c);European Parliament, *Report on the Proposal for a* *Directive of the European Parliament and of the Council to Approximate the Laws of the Member States Relating to Trade Marks* (16 January 2014) available at <http://www.europarl.europa.eu/sides/getDoc.do?pubRef=-//EP//TEXT+REPORT+A7-2014-0032+0+DOC+XML+V0//EN>*;* Senftleben, Martin and Bently, Lionel A. F. and Dinwoodie, Graeme B. and Geiger, Christophe and Griffiths, Jonathan and Kur, Annette and Ohly, Ansgar and Peukert, Alexander and Ricolfi, Marco and Schovsbo, Jens and (Lindroos), Katja Weckstrom and Zelechowski, Lukasz, *Recommendation on Measures to Safeguard Freedom of Expression and Undistorted Competition in EU Trade Mark Law* (September 15, 2014). Available at SSRN: [http://ssrn.com/abstract=2496351](http://ssrn.com/abstract%3D2496351); also Smith-Anthony A. & Groom J, ‘Brandalism and Subvertising: Hoisting Brands with Their Own Petard?’ (2015) 10 *Journal of Intellectual Property Law & Practice* p.32; the recommendation for legislation in this area by the scholarly community on Measures to Safeguard Freedom of Expression and Undistorted Competition in EU Trade Mark Law (2014) available at <http://papers.ssrn.com/sol3/papers.cfm?abstract_id=2496351> [↑](#footnote-ref-21)
22. G. Dinwoodie, Lewis & Clark College of Law Ninth Distinguished IP Lecture: Developing Defenses in Trade mark Law (February 11, 2009). Lewis & Clark Law Review, Vol. 13, 2009; Chicago-Kent Intellectual Property, Science & Technology Research Paper No. 09-009; Oxford Legal Studies Research Paper No. 53/2009. Available at SSRN: [http://ssrn.com/abstract=1341176](http://ssrn.com/abstract%3D1341176) providing an in depth analysis on the how to develop defences under trade mark legislation. [↑](#footnote-ref-22)
23. M. Spence ‘An Alternative Approach to Dilution Protection: A Response to Scott, Oliver and Ley-Pineda’ in Lionel Bently, Jennifer Davis and Jane C Ginsburg (eds), *Trade marks and brands: an interdisciplinary critique* (Cambridge University Press 2008) p.313; Rochelle Cooper Dreyfuss, ‘Expressive Genericity: Trade marks as Language in the Pepsi Generation’ (1990) 65 *Notre Dame L. Rev.* 397. [↑](#footnote-ref-23)
24. *Arsenal Football Club Plc v Reed* (C-206/01) ECLI:EU:C:2002:651 [2002] at [40]. [↑](#footnote-ref-24)
25. Recital 25 reads as: ‘*The exclusive rights conferred by a trade mark should not entitle the proprietor to prohibit the use of signs or indications by third parties which are used fairly and thus in accordance with honest practices in industrial and commercial matters. In order to create equal conditions for trade names and trade marks against the background that trade names are regularly granted unrestricted protection against later trade marks, such use should only be considered to include the use of the personal name of the third party. It should further permit the use of descriptive or non-distinctive signs or indications in general. Furthermore, the proprietor should not be entitled to prevent the general fair and honest use of the mark for identifying or referring to the goods or services as those of the proprietor. Uses made by third parties to draw the consumer`s attention to the resale of genuine goods that have originally been sold by or with the consent of the proprietor of the trade mark in the European Union should be considered as being* ***fair as long as they are at the same time in accordance with honest practices in industrial and commercial matters****. Uses made by third parties for the purpose of artistic expression should be considered as being fair as long as they are at the same time in accordance with honest practices in industrial and commercial matters. Furthermore, the provisions of the present Directive should be applied in a way that* ***ensures the full respect of fundamental rights and freedoms, and in particular the freedom of expression****.*’ Council of the European Union, Revision of the European Trade Mark system Proposal for a Regulation of the European Parliament and of the Council amending Council Regulation (EC) No 207/2009 on the Community Trade Mark and Proposal for a Directiveof the European Parliament and of the Council to approximate the laws of the Member States relating to trade marks (Recast) (8 June 2015) available at <http://data.consilium.europa.eu/doc/document/ST-9547-2015-ADD-2/en/pdf> [↑](#footnote-ref-25)
26. Sections 10(2)(b) and 10(3) UK TM Act 1994. [↑](#footnote-ref-26)
27. *Arsenal Football Club Plc v Reed* (C-206/01) ECLI:EU:C:2002:651 [2002]. [↑](#footnote-ref-27)
28. At [40]. Repeated in *Céline* (C-17/06) ECR I-7041 [16]; Joined Cases C-236/08 to C-238/08 *Google France SARL v Louis Vuitton Malletier SA* [2010] ECLI:EU:C:2010:159 at [50]. [↑](#footnote-ref-28)
29. *Arsenal Football Club Plc v Reed* (C-206/01) ECLI:EU:C:2002:651 [2002] at [51]. [↑](#footnote-ref-29)
30. *L’Oréal SA v. Bellure NV* (C-487/07) [2009] ECLI:EU:C:2009:378 at [58]. Repeated in Joined Cases C-236/08 to C-238/08 *Google France SARL v Louis Vuitton Malletier SA* [2010] ECLI:EU:C:2010:159 at [77]. [↑](#footnote-ref-30)
31. AG in *L’Oréal SA v. Bellure NV* (C-487/07) ECLI:EU:C:2009:70 [2009] at [54]. [↑](#footnote-ref-31)
32. *Interflora v. Marks & Spencer* case (C-323/09) ECLI:EU:C:2011:604 [2001] at [39]. [↑](#footnote-ref-32)
33. Joined Cases C-236/08 to C-238/08 *Google France SARL v Louis Vuitton Malletier SA* [2010] ECLI:EU:C:2010:159. [↑](#footnote-ref-33)
34. P. Torremans, Holyoak & Torremans Intellectual Property Law (Oxford, 7th ed, 2013) p.485. [↑](#footnote-ref-34)
35. *Sabel v. Puma* (C-251/95) E.C.R. 1-6191 [1997] at [23]. [↑](#footnote-ref-35)
36. Yet the current trend is for big brand owners to register a sign as a trade mark for more classes of goods than the core classes initially intended to encompass classes which are most likely of interest for parodists. [↑](#footnote-ref-36)
37. *Sabel v. Puma* (C-251/95) E.C.R. 1-6191 [1997] at [26] repeated in *Marca Mode CV v. Adidas AG and Adidas Benelux BV* (C-425/98) E.C.R. 1-4861 [2000] at [19]. [↑](#footnote-ref-37)
38. *Canon* (C‑39/97) ECR I‑5507 [1998] at [29]; *Lloyd Schuhfabrik Meyer* (C‑342/97) ECR I‑3819 [1999] at [17]. [↑](#footnote-ref-38)
39. This requirement offers some leeway for parodists. See G. Dinwoodie and Janis, *Trade Mark Law and Theory* (Edward Elgar Publishing 2008) p.273. [↑](#footnote-ref-39)
40. Section 10(3) UK TMA 1994 requires the use to be in the course of trade as explained earlier. [↑](#footnote-ref-40)
41. With reputation means that it is known by a significant part of the relevant public. C-375/97 at [26]-[27]. [↑](#footnote-ref-41)
42. *Intel Corporation v. CPM United Kingdom Ltd.* (C-252/07) RPC 15 [2009]. [↑](#footnote-ref-42)
43. Types of damages: *Interflora v. Marks & Spencer* case (case C-323/09) ECLI:EU:C:2011:604 [2011] at [72-74]. [↑](#footnote-ref-43)
44. *Adidas-Salomon AG and Adidas Benelux BV v Fitnessworld Trading Ltd.* (C-408/01) ECLI:EU:C:2003:582 [2003] at [27]-[29]. [↑](#footnote-ref-44)
45. A. Ramalho, ‘Parody in Trade marks and Copyright: Has Humour Gone Too Far?’ (2009) 5 *Cambridge Student Law Review* 63. [↑](#footnote-ref-45)
46. P. Torremans, Holyoak & Torremans Intellectual Property Law (Oxford, 7th ed, 2013) p. 500. [↑](#footnote-ref-46)
47. It is not enough to take an advantage, that advantage must be unfair. R 308/2003-1 in *Mango Sport System Srl Socio Unico Mangone Antonio Vincenzo v Diknak* [2005] EMTR 5 at [19]. [↑](#footnote-ref-47)
48. *L’Oréal SA v. Bellure NV* (C-487/07) ECLI:EU:C:2009:378 [2009] at [41]. [↑](#footnote-ref-48)
49. *Dior v. Evora* (C-337/95) ECLI:EU:C:1997:517 [1997] at [45]; Sakulin Wolfgang, *Trade mark protection and freedom of expression: an inquiry into the conflict between trade mark rights and freedom of expression under European Law* (Wolters Kluwer, 2011) p. 92. [↑](#footnote-ref-49)
50. *Ate My Heart Inc v Mind Candy Ltd* [2011] EWHC 2741 (Ch). [↑](#footnote-ref-50)
51. The defendant company created a popular an online game ‘The Moshi Monsters’ aimed at children aged between 6-14 years. It was not disputed that Lady Gaga was the inspiration for Lady Goo Goo character, and indeed Lady Gaga did not seek an injunction to prevent use of the character in the game. Rather, the claim lay only in the release of a song (‘Let’s do the Moshi Dance’) and its video which both borrowed heavily from La Gaga’s hit - ‘Bad Romance’ performed by Lady Gaga, see <https://www.youtube.com/watch?v=-gyYopuGcCc> [↑](#footnote-ref-51)
52. For the notional test see *Och-Ziff Management Europe Ltd. v. OCH Capital LLP* [2010] EWHC 2599 (Ch). [↑](#footnote-ref-52)
53. *Ate My Heart Inc v Mind Candy Ltd* 2011] EWHC 2741 (Ch) at [54-60]. [↑](#footnote-ref-53)
54. At [45]-[47]. [↑](#footnote-ref-54)
55. At [65]. [↑](#footnote-ref-55)
56. *Intel Corporation v. CPM United Kingdom Ltd.* (C-252/07) RPC 15 [2009] at [67]; *Interflora v. Marks & Spencer* (*C-*323/09) ECLI:EU:C:2011:604 [2011] at [76]-[82]. [↑](#footnote-ref-56)
57. *Interflora v. Marks & Spencer* (C-323/09) ECLI:EU:C:2011:604 [2011] at [81]. [↑](#footnote-ref-57)
58. *Ate My Heart Inc v Mind Candy Ltd* [2011] EWHC 2741 (Ch) at [68]. [↑](#footnote-ref-58)
59. *Ibid* at [69]. [↑](#footnote-ref-59)
60. *L’Oréal SA v. Bellure NV* (C-487/07) ECLI:EU:C:2009:378 [2009] at [40]. [↑](#footnote-ref-60)
61. At [74]. [↑](#footnote-ref-61)
62. At [78]; *Interflora v. Marks & Spencer* (C-323/09) ECLI:EU:C:2011:604 [2011] at [84-91]. [↑](#footnote-ref-62)
63. *Alan Clark v. Associated Newspapers Ltd*. [1998] 1 WLR 1558. [↑](#footnote-ref-63)
64. CA Rennes, 27 April 2010, *Sté JBC Holding c/ Éts Paul Paulet et a.* PIBD 2010, n° 922, III, p. 493. [↑](#footnote-ref-64)
65. Section 10(6) TMA. [↑](#footnote-ref-65)
66. Article 19 UDHR, article 19 ICCPR, article 5(d)(viii) ICERD, article 10 ECHR, article 11 Charter of fundamental rights of the European Union, Article 11 DRMC 1789 protects freedom of expression; section 3 HRA 1998. [↑](#footnote-ref-66)
67. Commercial expression falls under the protection of the fundamental right to freedom of expression but because of its commercial nature, wider margin of appreciation is granted to domestic authorities in their appreciation of the need to restrict the exercise of freedom of expression of the parodist. [↑](#footnote-ref-67)
68. Given that copyright compared to real property is non-rivalrous. [↑](#footnote-ref-68)
69. *Anheuser-Busch Inc v. Portugal* [2007] ETMR 24; (2007) 45 EHRR 36. Similarly protected under the EU Charter in article 17(1)-(2). [↑](#footnote-ref-69)
70. Article 1(2) of Protocol 1 of the ECHR. [↑](#footnote-ref-70)
71. Freedom of expression is enshrined in section 12 HRA. [↑](#footnote-ref-71)
72. M. Spence, ‘An Alternative Approach to Dilution Protection: A Response to Scott, Oliver and Ley-Pineda’ in Lionel Bently, Jennifer Davis and Jane C Ginsburg (eds), *Trade marks and brands: an interdisciplinary critique* (Cambridge University Press 2008) p. 308. [↑](#footnote-ref-72)
73. Pumfrey, J. notes that the use could be apolitical expression at [47]. [↑](#footnote-ref-73)
74. At [43]. [↑](#footnote-ref-74)
75. Fhima, ‘Trade Marks and Free Speech’ (2013) 44(3) *International Review of Intellectual Property and Competition Law* 315. [↑](#footnote-ref-75)
76. Court of appeal 17/03/1992 in der, ‘Le droit à l’humour’ (1994) 3 *Legicom* 63. [↑](#footnote-ref-76)
77. Additionally, the use was not held as denigrating the mark given that the reference to oil spills merely served as a means to attract the attention of consumers which was held as being a common practice in advertising by the court. Yet, the Supreme Court quashed the decision. While the appeal decision is interesting as to its outcome, the reference to ‘excess’ is criticised as being a potentially slippery slope for arbitrary decision by using this notion to assess the humoristic quality of the use. Ccass 21 February 1995, pourvoi n° 92-13688, Bull. Civ 1995, IV, n° 55, p. 52. [↑](#footnote-ref-77)
78. Cap Versailles 17 March 1994, Michelin, D. 1995, somm. p. 56, obs. Colombet. [↑](#footnote-ref-78)
79. *Peugeot v. Canal+,* Cass 12/07/2000, D. 2001, n°3, jur, 259, note B. Edelman. [↑](#footnote-ref-79)
80. TGI Paris 04 July 2001, *Société Compagnie Gervais Danone et Société Groupe Danone v. Olivier M., Réseau Voltaire et autres*, [www.legalis.net](http://www.legalis.net) ,upheld on appeal CA Paris, 30 April 2003, *M. Olivier (jeboycottedanone.com) v. Société Compagnie Gervais Danone et Société Groupe Danone*, [www.forum.internet.org](http://www.forum.internet.org). [↑](#footnote-ref-80)
81. This reasoning has been criticised as ambiguous. Bernard Edelman, Droit des marques et liberté d’expression, *Recueil Dalloz* 2003, p. 1831. [↑](#footnote-ref-81)
82. TGI Paris 8 July 2002; TGI Paris 30 January 2004, *Esso v. Greenpeace*, *Internet Fr.,* [www.legalis.net](http://www.legalis.net); confirmed on appeal Paris, 16 November 2005. [↑](#footnote-ref-82)
83. Ccass comm 8 April 2008 (Dalloz actualite 21 April 2008) note J. Daleau. [↑](#footnote-ref-83)
84. TGI Paris, 2 August 2002, Propr. ind. 2002, Comm. n° 68, note P. Tréfigny; CA Paris, 26 February 2003, D. 2003. Jur. 1831, note B. Edelman; CCE 2003, Comm. n° 38, note C. Caron; Propr. intell. 2003, p. 322, note V.-L. Bénabou. [↑](#footnote-ref-84)
85. TGI Paris, 2 August 2002, Propr. ind. 2002, Comm. n° 68, note P. Tréfigny. It is interesting to note the partial contradiction between the two decisions of the tribunal in relation to similar facts (ESSO – AREVA). Yet the decision of the Court of appeal restores some consistency by deciding that Greenpeace had rightly exercised its freedom of expression in both cases. [↑](#footnote-ref-85)
86. TGI Paris, 9 July 2004, CCE 2004, Comm. n° 110, note C. Caron; Paris, 17 November 2006, D. 2007. Pan. 1991, obs. C. Le Stanc et P. Tréfigny; CCE 2007, Comm. n° 8, note C. Caron. [↑](#footnote-ref-86)
87. The damages to be paid amounted to a symbolic €1. [↑](#footnote-ref-87)
88. Cass com, 8 April 2008(Dalloz actualité 21 April 2008) note J. Daleau. [↑](#footnote-ref-88)
89. Bernard Edelman, Droit des marques et liberte d’expression, *Receuil Dalloz* 2003, p 1831. [↑](#footnote-ref-89)
90. Proposed by Schahl and Bresson (Receuil Dalloz 2004), p.556. [↑](#footnote-ref-90)
91. CA Paris 27 March 2002, *Sté Free c/ M. Sebilleau et Mme Robriquet*, CCE, October 2002, p. 31 s., obs. L. Grynbaum. [↑](#footnote-ref-91)
92. *Johan Deckmyn and Vrijheidsfonds VZW v Helena Vandersteen and Others* (C-201/13) ECLI:EU:C:2014:2132 [2014] at [20]. [↑](#footnote-ref-92)
93. Such as recognised in the French decisions *Peugeot v. Canal+* decision, (on referral from the Supreme Court) the Court of appeal of Reims held that parodies of trade marks are lawful as long as there is no confusion. *In casu*, it is derived from the grotesque character of the puppet and the satirical nature of the show that the TV channel never intended to become an automobile magazine excluding all confusion possible in the public’s view. [↑](#footnote-ref-93)
94. S. Jacques, ‘Are the new ‘fair dealing’ provisions an improvement on the previous law, and why?’ (2015) 10(9) *Journal of Intellectual Property Law and Practice* 699. [↑](#footnote-ref-94)
95. Defamation Act 2013. [↑](#footnote-ref-95)
96. #  Mouffe, *Le Droit À L’humour* (Larcier, 2011), p. 423.

 [↑](#footnote-ref-96)
97. CA Paris 25 October 1990, D. 1991, IR p. 18. [↑](#footnote-ref-97)
98. CA Paris, 11 March 1991 and 1 February 1992, Legipresse 1992, n°95 p. 112. [↑](#footnote-ref-98)
99. TGI Paris 19 September 1990, PIBD 1991, III, 57; CA Paris 14 March 1995, D 1996, Somm. P. 252, obs M.-L. Izorche the decision rejected by the Supreme Court, Cassation, 02 April 1997. [↑](#footnote-ref-99)
100. Early decisions do not incorporate this requirement. The first milestone decision introducing this supplementary requirement I the *Marlboro* case decided by the CA Versailles, 17th March 1994, *Michelin*, D. 1995, somm. P.56, obs. Colombet. [↑](#footnote-ref-100)
101. CA Riom, 5 September 1994, D. 1995, Jur. p.429, note B. Edelman; CA Versailles, 13 March 1994 D. 1995, Somm. p.56, obs. Colombet; E. Baud & S. Colombet, ‘La parodie de marque: vers une érosion du caractère absolu des signes distinctifs’ (Chroniques 1998) 23eme cahier *Receuil Dalloz*, A23. [↑](#footnote-ref-101)
102. The ECtHR has recognised the right to freedom of expression to apply to commercial expressions. Yet, the Court grant a greater margin of appreciation to the national courts. [↑](#footnote-ref-102)
103. Mouffe, *Le Droit À L’humour* (Larcier, 2011) p. 425; E. Baud & S. Colombet, ‘La parodie de marque: vers une érosion du caractère absolu des signes distinctifs’ (Chroniques 1998) 23eme cahier *Receuil Dalloz*, A23, p. 230. [↑](#footnote-ref-103)
104. Ccass. fr., 9 December 2003 available at [www.legifrance.gouv.fr](http://www.legifrance.gouv.fr); Paris (4e ch., sect. A), 27 November 1990, aff. *Jacobs. Suchard Franc c. Antenne 2*, inédit. [↑](#footnote-ref-104)
105. TGI Seine, 11 April 1956, Ann. Prop. Litt. Art. Ind., 1956, p. 161, obs. P.M.; J.C.P., 1957, II, n° 9869, obs. CHAVANNE. Comp. avec ses obs. in RTDcom., 1957, p. 381, n° 11 overturned on appeal on unfair competition law CA Paris, 4 March 1959, D., 1960, p. 26, obs. Desbois. Confirmed by the Supreme Court in Cass. Fr. (ch. Com.), 5 January 1966, J.C.P., 1966, II, n° 14796, obs. Plaisant. [↑](#footnote-ref-105)
106. The Supreme Court added that similarities by contrast contribute to confusion as it suggests a comparison of the two contrasting signs. [↑](#footnote-ref-106)
107. Court of appeal of Versailles (ch. 12, sect. 2), 5 March 2009, N° 07/07569; similar reasoning in relation to the commercial exploitation of a magazine pastiching another magazine, CA Paris, 21 September 2012 N° 10/11630. [↑](#footnote-ref-107)
108. L. 122-5 French intellectual property code. [↑](#footnote-ref-108)