Free speech and trademarks. Could it happen here?

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Sara Parrello, Fabio Angelini (Bugnion S.p.A)

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Some (among whom, the truly yours) wondered, when in late June the US Supreme Court held unconstitutional the Lanham Act provision (15 U. S. C. §1052(a)) prohibiting registration of trademarks consisting of or comprising immoral or scandalous matter because it discriminates on the basis of viewpoint and therefore violates the free speech clause[1], whether freedom of speech could have the same treatment this side of the pond.
This question might soon have an answer, when the CJEU will decide Constantin Film Produktion v EUIPO, case C-240/18P[2]. Meanwhile, Advocate General Bobek (AG) has issued his opinion and although, truth to be told, the AG did not have the guts to go all the way, as he could have, still if the CJEU follows him, free speech might play a more important role in trademark matters.

The AG's opinion can be summarized as follows: the central question is the test to be applied in the assessment of the absolute ground for refusal under Article 7(1)(f) of Regulation No 207/2009, and to answer this question, he first addresses the issue of fundamental rights protection, in particular freedom of expression and its role in trade mark law. Then he discusses the distinction between the concepts of public policy and accepted principles of morality and the consequences in terms of evidence and standards of reasoning of the choice to rely on one or the other in refusing to register a trade mark.

Remarkably, for the AG freedom of expression does indeed play a role in trade mark law, and the GC had thus been incorrect to rule this out (cf. §29,

“Furthermore, as EUIPO points out in its briefs, the protection of freedom of expression, which does not exist in the area of trade mark law, is always pursued in the field of art, culture and literature” emphasis added).

In the AG’s opinion, respect for fundamental rights constitutes a condition of the lawfulness of any EU measure so that the Charter of Fundamental Rights of the European Union and the fundamental rights guaranteed therein extend to any activity or omission of EU institutions and bodies, including EUIPO. In addition, the commercial nature of a potential activity is no reason to limit or even exclude fundamental rights protection. The European Court of Human Rights (‘ECtHR’) has stated that freedom of expression, guaranteed in Article 10 ECHR, applies independently of the type of message, including when a commercial advertisement is concerned, and it has applied freedom of expression specifically to evaluating restrictions imposed by national legislation on trade marks or other forms of advertisement.

Finally, the applicability of freedom of expression in the field of trade marks was explicitly confirmed in Recital 21 of Regulation 2017/1001 and is also consistent with the previous case-law of the General Court.

Thus, freedom of expression clearly applies in the field of trade mark, and EUIPO’s position that fundamental rights and the balancing of them have already been taken into account by the legislature when drafting Article 7(1)(f) of Regulation No 207/2009 is “*difficult to defend*” (AG opinion, §53). In view of the multifaceted rights and interests at stake, dismissing this issue by saying that it is adequately addressed by merely inserting the concepts of public policy and accepted principles of morality into Article 7(1) is simply “*untenable*” (ibid).

That said, the AG concluded that although freedom of expression, as well as other fundamental rights potentially at stake, must be taken into account in the overall balancing exercise, the protection of freedom of expression is not the primary goal of trade mark protection. So, we are still far from the sweeping language of the Supreme Court. Still, it seems a step ahead; had EUIPO taken the freedom of expression into account in the balancing of the interests at stake, would it have come to a different conclusion? Possibly. We’ll see.

[1] (Iancu v. Brunetti, No. 18–302, 588 U.S. ___ (2019). In Brunetti, the US Supreme

Court overruled the refusal of the mark FUCT, and already in a prior case, (Matal v. Tam (582_US (2017)), the US Supreme Court had declared the ban on disparaging trademarks (in that case the mark was THE SLANT) unconstitutional on a similar basis.

[2] EUIPO refused the trademark FACK JU GÖHTE (title of a German movie) because in light of the vulgar and offensive meaning of “fuck you Goethe” it was deem to be contrary to public policy or to accepted principles of morality. The EUIPO refusal was upheld by the General Court (case T-69/17, here)