
Kluwer Trademark Blog

Trade mark Parody: a trade mark infringement?

João Leitão Figueiredo (CMS) · Wednesday, July 13th, 2016

Parody, in its utmost simplistic notion, has been an integral part of society and social relationships. The southern European countries, such as Portugal, have long embraced the notion of parody and accepted satire and irony in the context of arts.

The parody has, however, evolved to new sectors of society and, in particular, to the commercial activities, questioning social, business standards and beliefs.

The most conservative and strict Portuguese companies have been faced with a new type of trade mark parodies which directly collided with the commercial practices and the Portuguese legal framework offered no clear solution or limits for parody. Several cases were taken to Court and contradictory decisions were issued concerning trade mark parody, however, in the vast majority the acts were not reprimanded by the courts.

In fact, the Portuguese courts have commonly accepted the idea that the use of parody in the scope of trade marks doesn't fulfil the legal criteria of trade mark infringement, thus sanctioning the use of parody in more intense and sometimes abusive manner.

The enforcement of trade mark rights have since been limited by fundamental rights and freedoms and in particular the freedom of expression.

As stated in Case C-201/13 Deckmyn of 3 September 2014, by the Court of Justice of the European Union, there is no definition in the EU Law of the meaning and scope of a parody.

Regulation (EU) No. 2015/2424 of the European Parliament and of the Council of December 16, 2015, now provides, for the first time a reference to parody in its Recital 21 that: "Use of a trade mark by third parties for the purpose of artistic expression should be considered as being fair as long as it is at the same time in accordance with honest practices in industrial and commercial matters."

For security and certainty purposes, parody-exception regulation is expected in the future (hopefully not so distant), however and for the time being, trade mark parody will continue to be considered on the basis of "fair dealing" between the right holders' interests and the rights of those who intend to use of protected works, by taking into account all the circumstances of the case, among others, the fact that the parody may convey a discriminatory/biased or even abusive message, which may have the effect of associating the protected work with such a message.

As mentioned, courts in Portugal mainly consider that trade mark parody usually doesn't give cause to likelihood of confusion or association, consideration clearly lacking the in depth analysis and critical reflection the case need. The situation may change in the future, considering that the European legislation on trademarks has for the first time – although only in the recitals – mentioned the fair use of a trade mark by third parties for the purpose of artistic expression and the freedom of expression.

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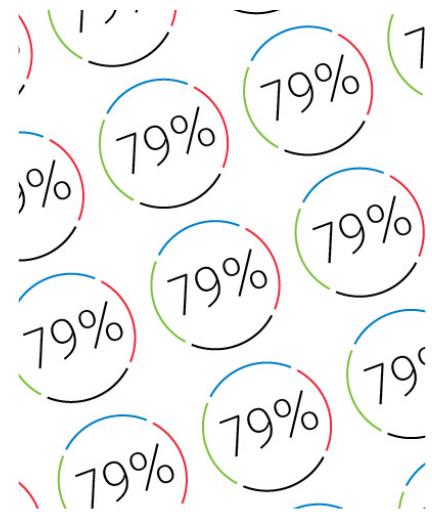
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