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Vigeland and Cyclic Cultural Innovation

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Contents

- What’s the problem?
- Why does it matter?
- How to solve it?
- Why the Vigeland case helps.

The problem

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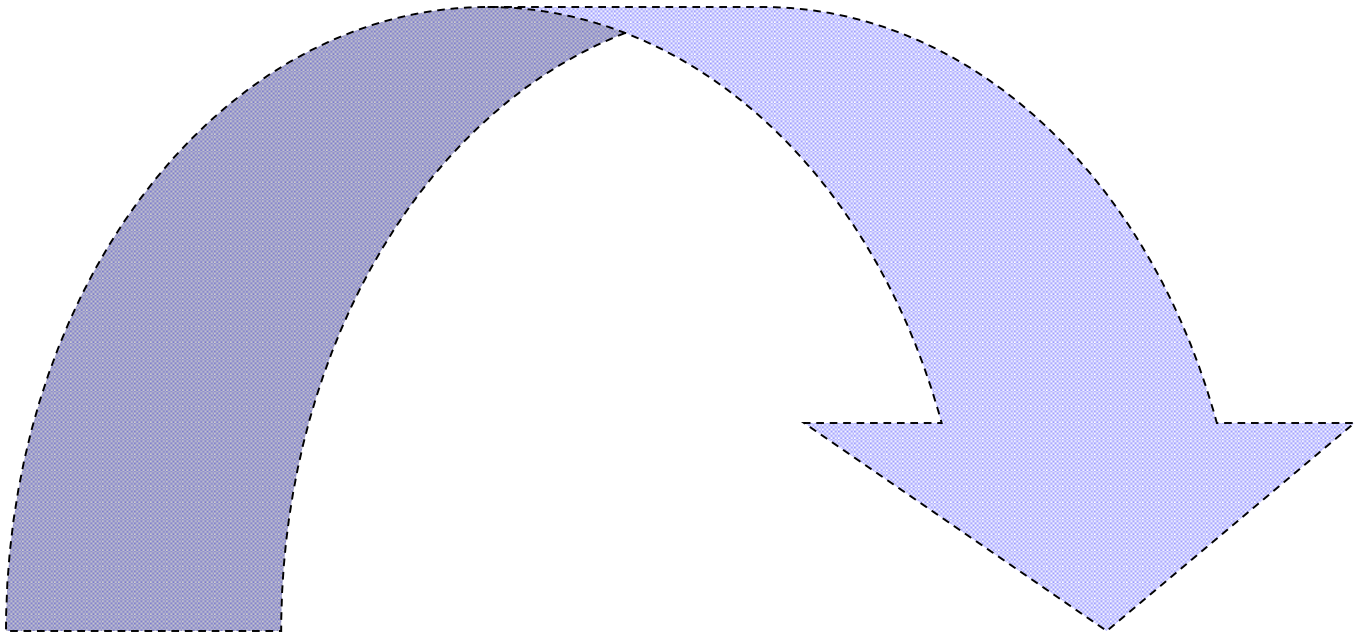
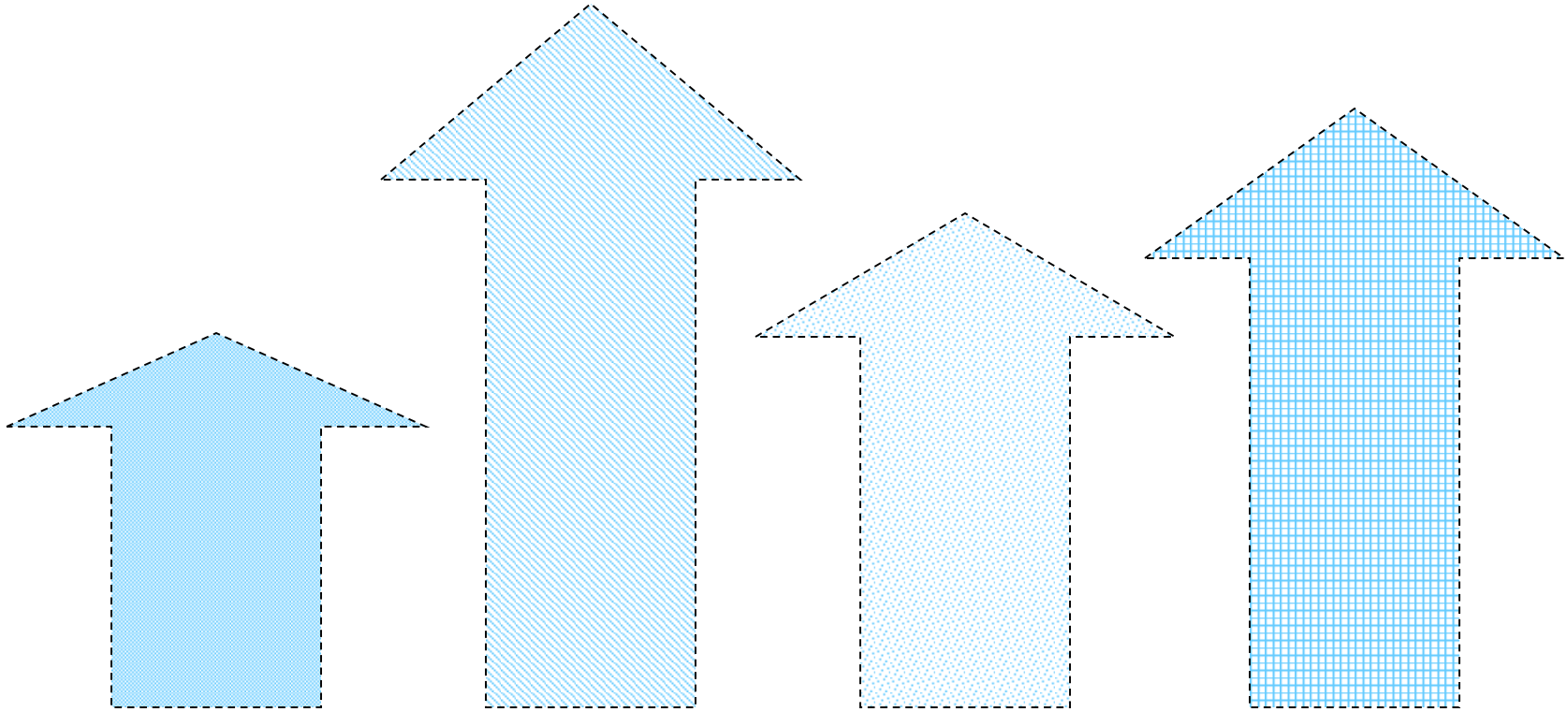
Copyright law: an inspiration system



public domain of cultural expression (cultural heritage)

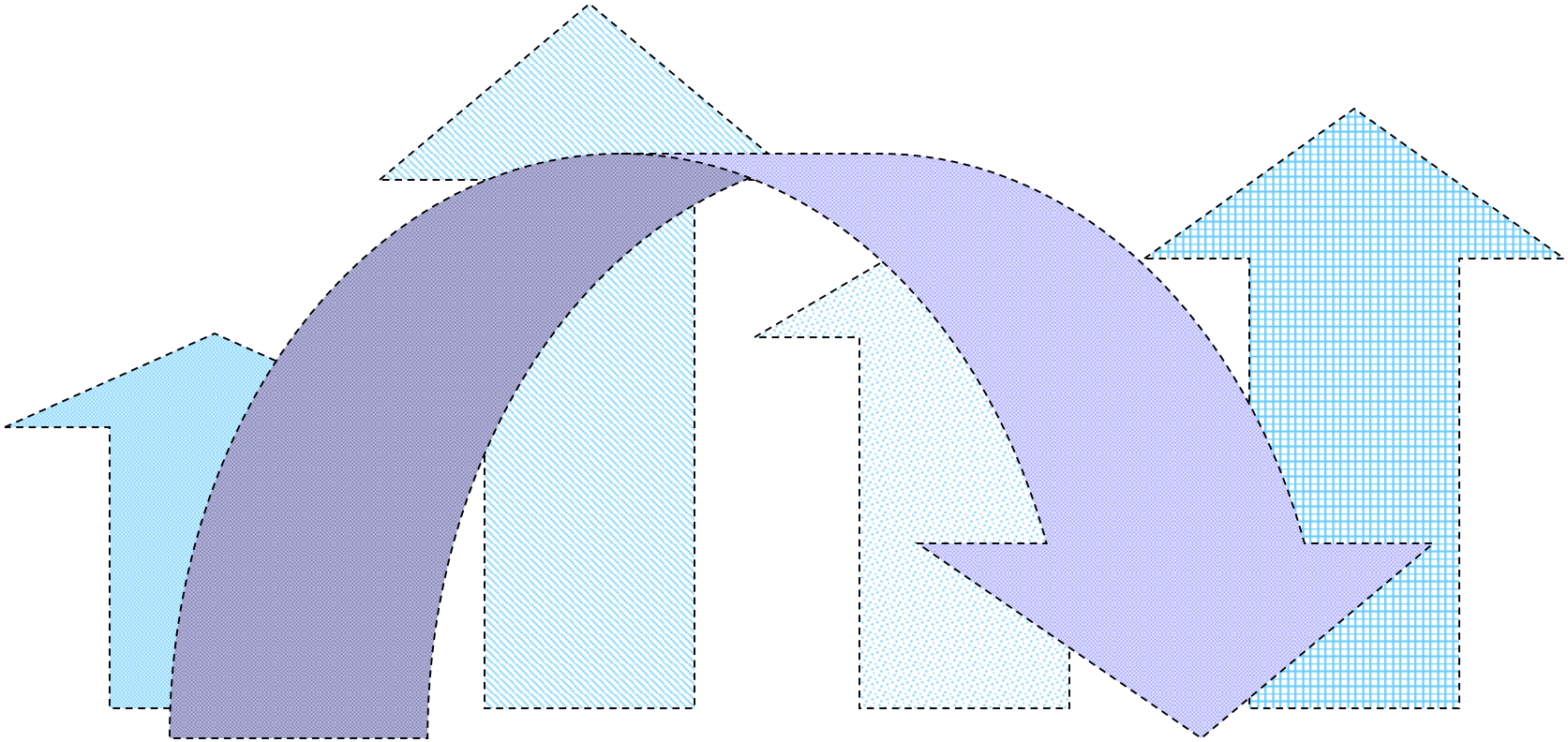
Trademark law: a transparency system



public domain of distinctive signs

(source identifiers)

Conflict between the protection systems

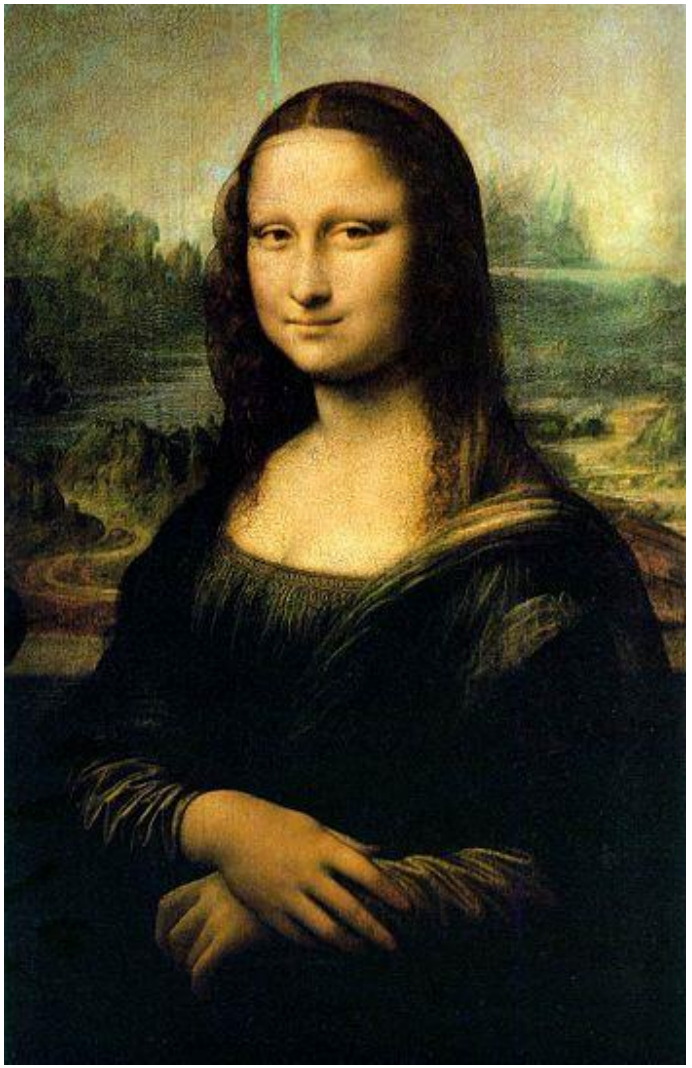


static trademark protection vs.

cyclic innovation in copyright

Two scenarios

MICKEY MOUSE

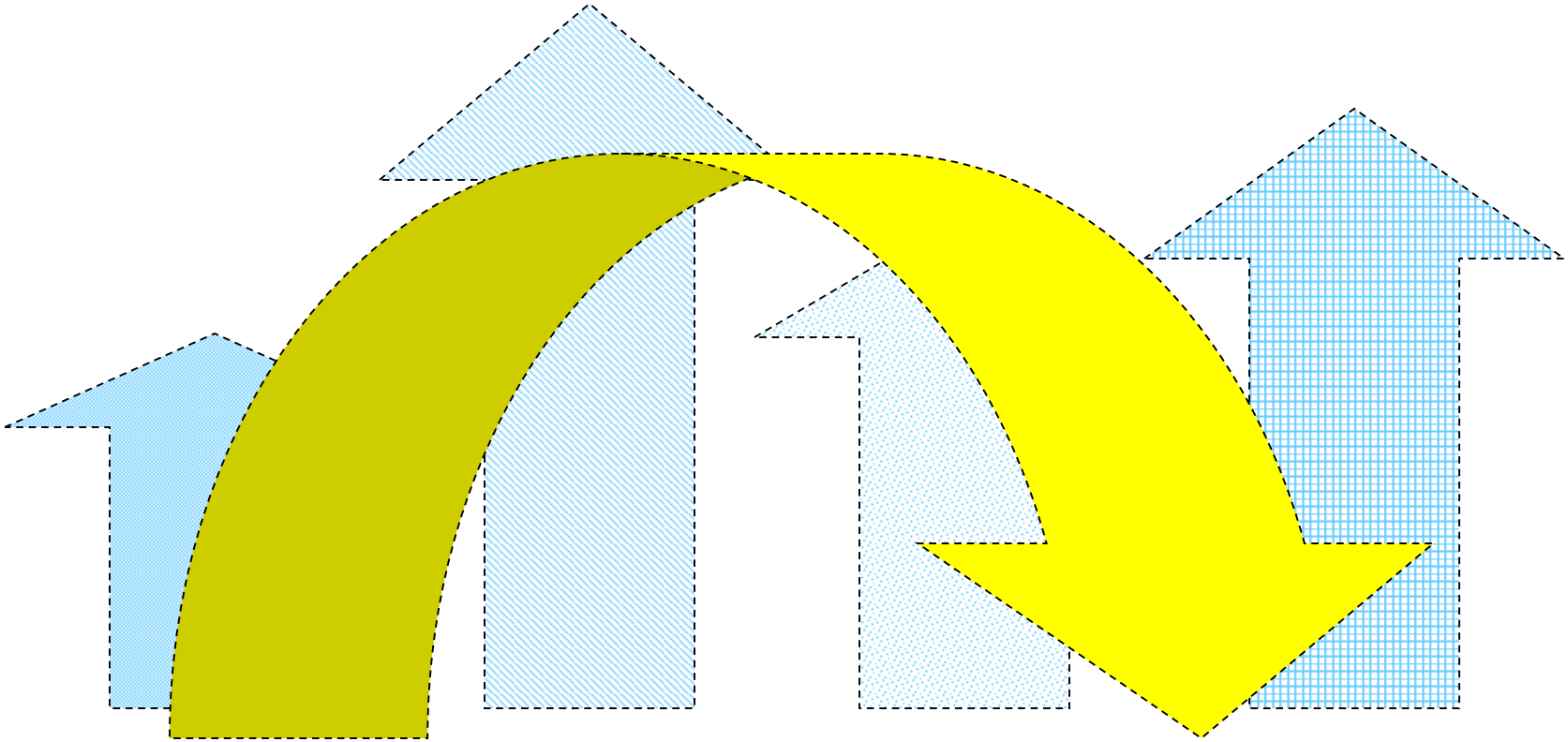


Risks

- loss of sources of inspiration
- monopolisation and *redefinition* of building blocks of new creations

= impediment of the cultural inspiration cycle

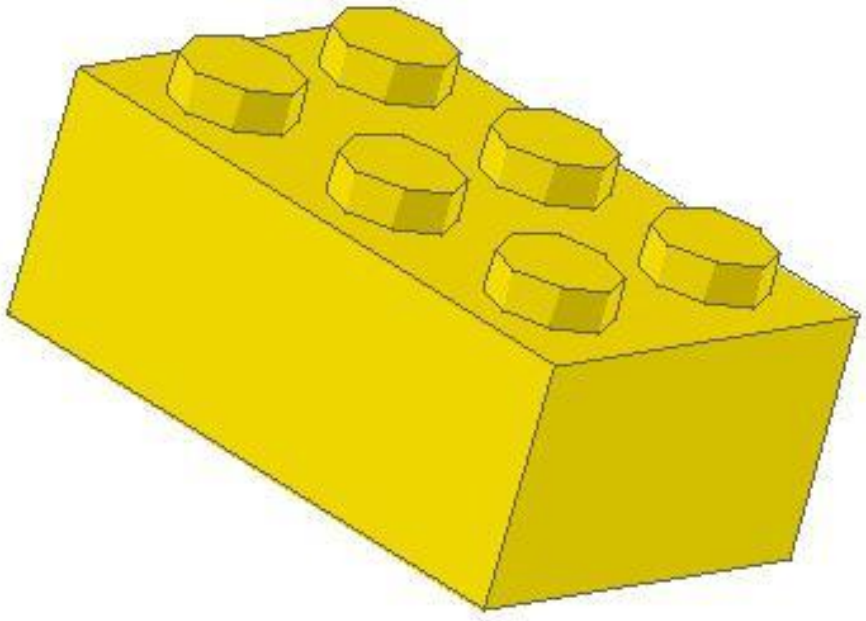
Problem not unknown



static trademark protection vs.

cyclic innovation in patent law

Exclusion of technical subject matter



Functionality doctrine

...signs consisting of a shape or another characteristic

- resulting from the nature of the goods themselves
- necessary to obtain a technical result
- giving substantial value to the goods (amended Art. 4(1)(e) TMD)

Underlying considerations

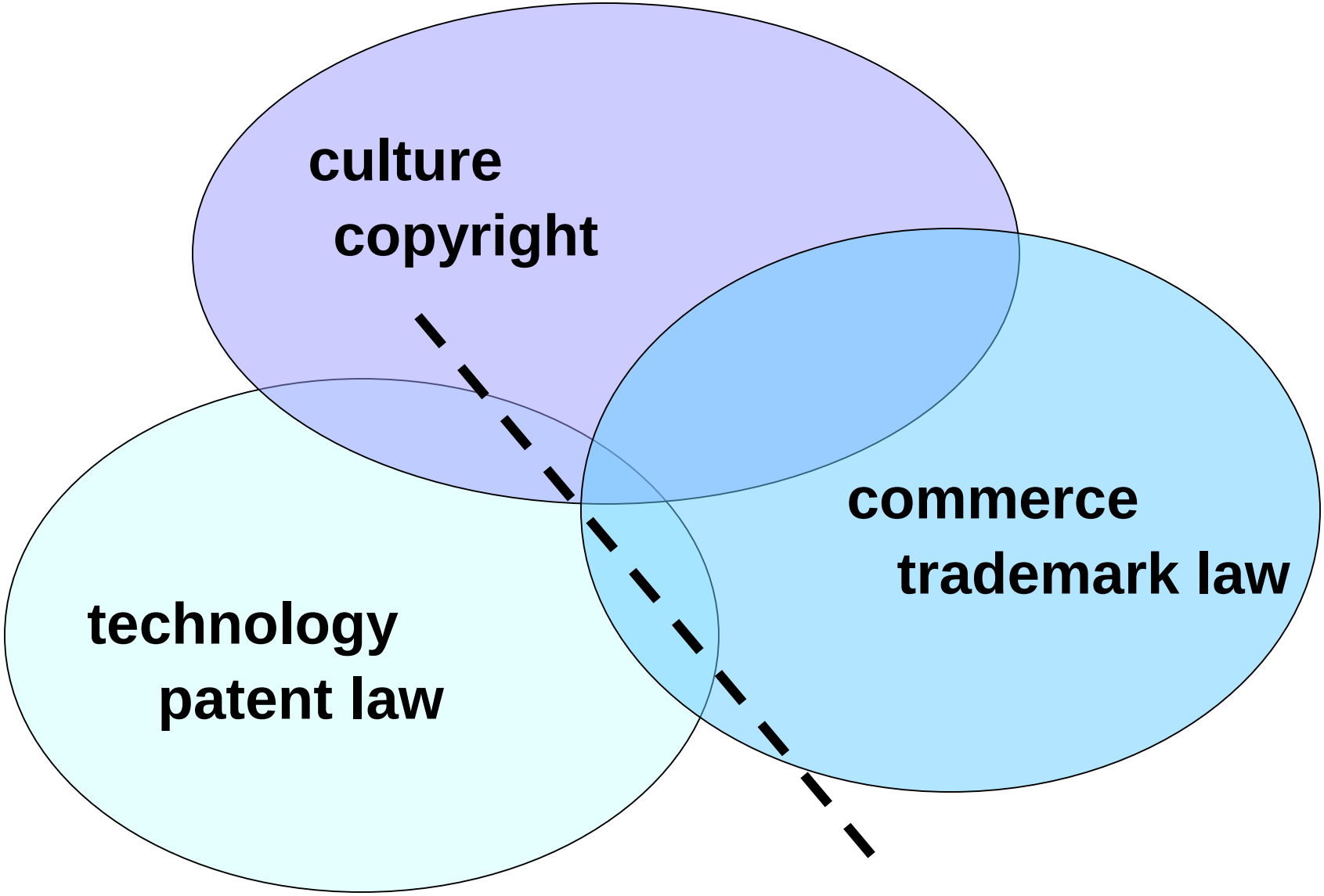
- fundamental distinction between the trademark and the product
- freedom of competition (need to keep product features free)
- preservation of the public domain (no conflict with cyclic innovation)

CJEU, 14 September 2010, case C-48/09 P, Lego/OHIM (Mega Brands)

- result: technical know-how remains free after patent expiry
- costs: risk of confusion/unfair free riding?

  'In the present case, it has not been disputed that the shape of the Lego brick has become distinctive in consequence of the use which has been made of it and is therefore a sign capable of distinguishing the appellant's goods from others which have another origin.' (para. 40)

Imbalance within the IP system



Exclusion of industrial design

Tripp Trapp®

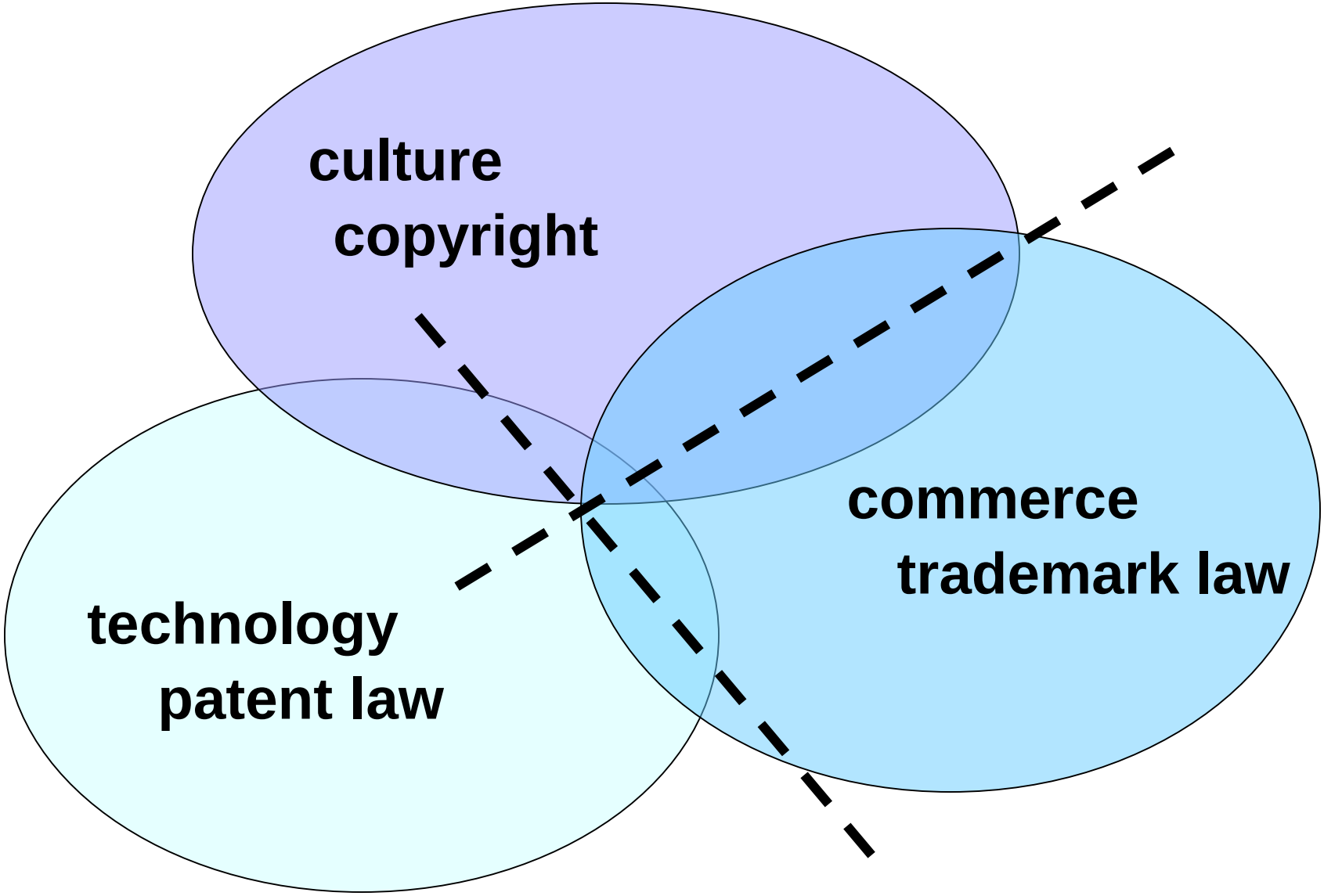
STOKKE®

CJEU, 18 September 2014, case C-205/13, Hauck/Stokke

- no artificial extension of limited protection in the case of substantial value shapes
- catalogue of essential characteristics
  - nature of the category of goods concerned
  - artistic value of the shape in question
  - dissimilarity from other shapes on the market
  - substantial price difference
  - promotion strategy accentuating aesthetic characteristics (para. 35)

Functionality doctrine insufficient

Need for stricter boundary line

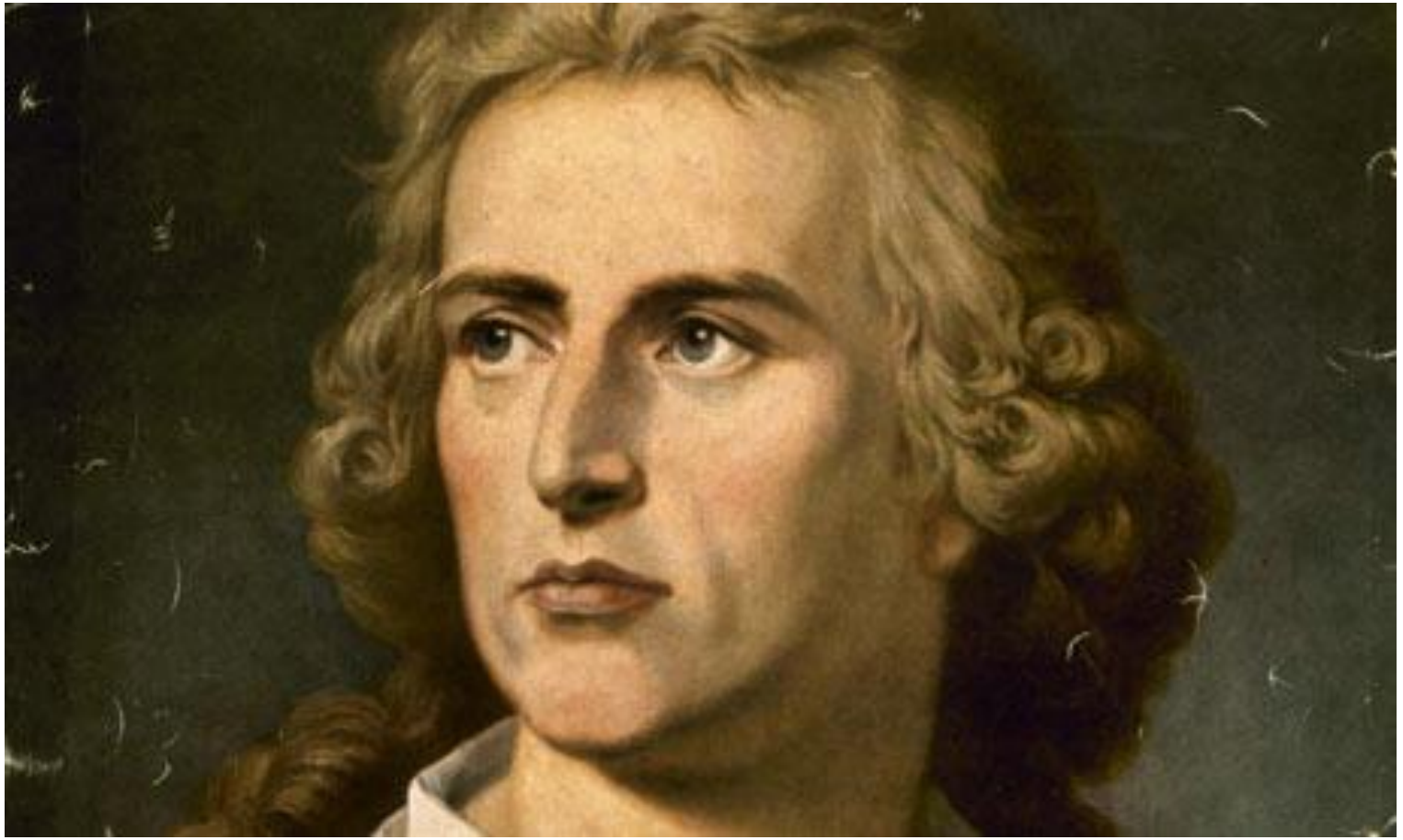


Policy

CJEU, C-283/01, Shield Mark/Kist

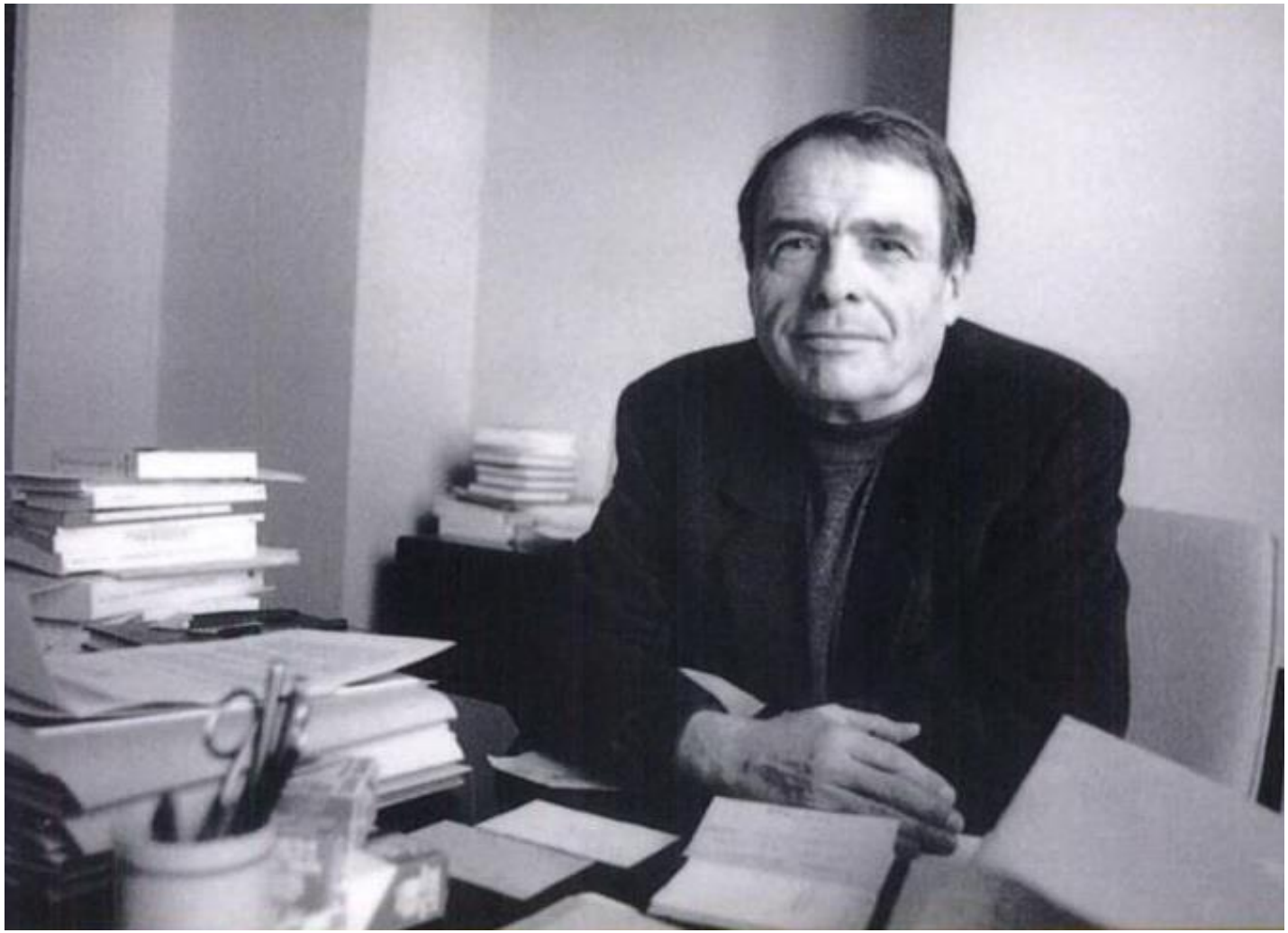
‘I find it more difficult to accept […] that a creation of the mind, which forms part of the universal cultural heritage, should be appropriated indefinitely by a person to be used on the market in order to distinguish the goods he produces or the services he provides with an exclusivity which not even its author's estate enjoys.’ (Opinion A-G Colomer, 3 April 2003, para. 52)

Importance for society



Importance for society

Cultural works non-substitutable



Traditional reliance on distinctiveness

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Different functions, different rights

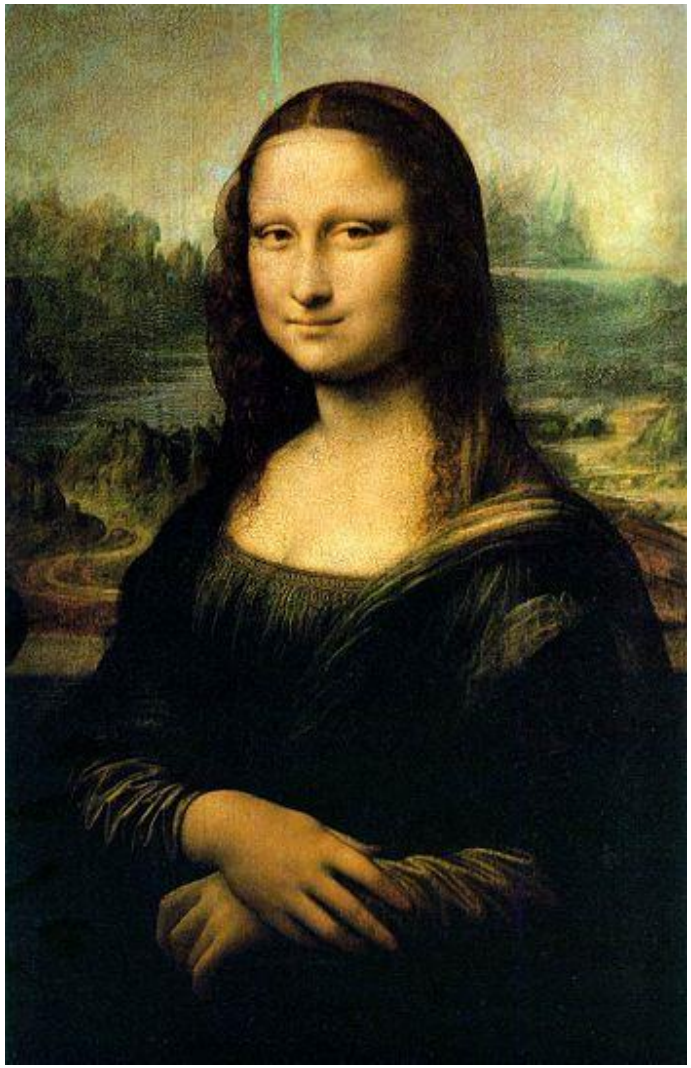
MICKEY MOUSE

DONALD DUCK

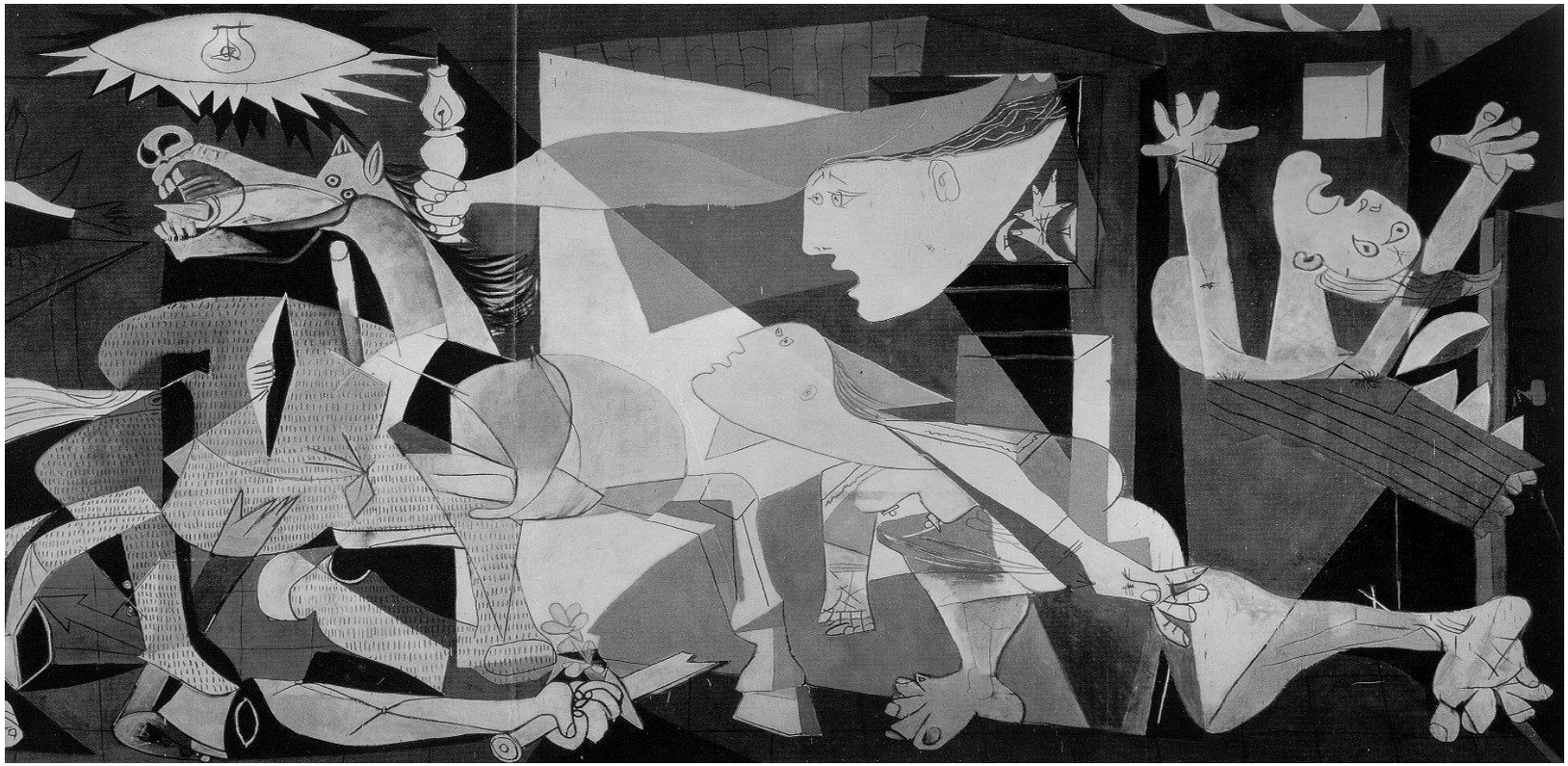
- copyright protection concerns drawing as such
- trademark protection concerns function of indicating origin of goods/services

Federal Patent Court of Germany, 25 November 1997, ‘Mona Lisa’

- The Mona Lisa is not distinctive.
- The Mona Lisa has become customary in trade practices.
- But there is no conflict with morality or public order.



Guernica for weapons?



- distinctive?
- customary in trade practices?

Solveig's song for beer?

- distinctive?
- customary in trade practices?

Distinctiveness a sufficient safeguard?

- leaving the issue to the marketing efforts of the industry (self-service mechanism)
- undesirable commercial redefinition of important cultural expressions
- risk of privatising (re-monopolising) parts of the cultural heritage
- encouragement of ‘cultural heritage grabbing’

Wrong incentives

positive image of cultural symbols

Different functions, different rights

- question of ‘double belonging’
  - might be a valid point as long as trademark protection is confined to origin function
  - but even then risk of commercial redefinition

- expansion of trademark rights
  - trademark constitutes product in its own right
  - protection of communication, investment and advertising functions fully recognized
  - in fact ‘mutant copyright’ (=exploitation right)

Vermeer's Milkmaid = well-known mark

- distinctive?
- customary in trade practices?

Sufficient checks and balances

‘It is calm above the tree tops/Somewhere a cow is bellowing/Moo.’

(Rainer Maria Milka)

- German Federal Court of Justice, 3 February 2005, Lila Postkarte
- ornamental trademark use taking advantage of the distinctive character of the Milka mark
- but: defence of due cause (freedom of art)

Sufficient checks and balances

deterrent effect of potential trademark infringement

EFTA Court, 6 April 2017, case E-5/16, Vigeland

- applicant: city of Oslo
- argument: investment in reputation

Distinctiveness a sufficient safeguard?

- registration activities of cultural heritage institutions desirable?
- preservation of the genuine cultural meaning of artworks (custodians)?
- public money well spent if invested in portfolio management?
- discourse about artworks as free as without trademark protection?

Better solution: outright exclusion

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Potential statutory basis

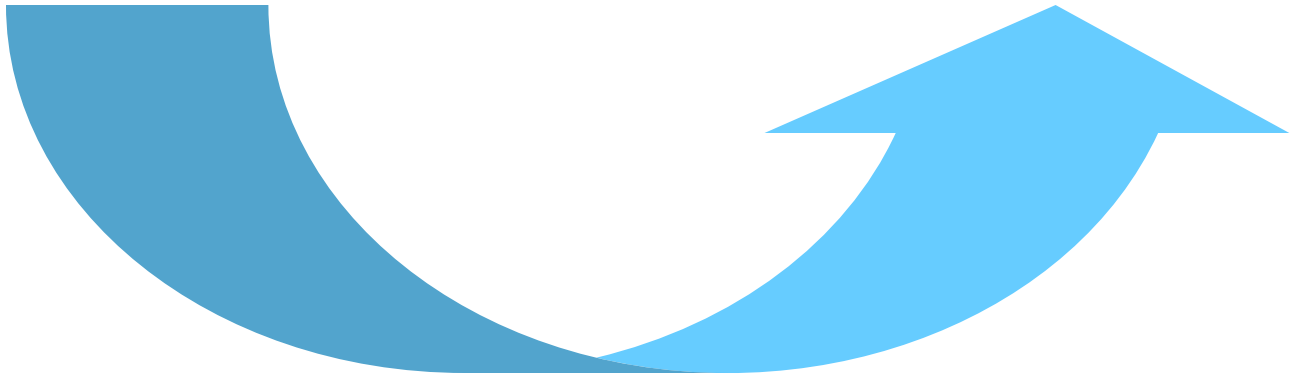
The following shall not be registered or, if registered, shall be liable to be declared invalid:

f) trade marks which are contrary to public policy or to accepted principles of morality;... (Art. 4(1) TMD)

EFTA Court, 6 April 2017, case E-5/16, Vigeland

free communication process is the rule

copyright protection is the exception



EFTA Court, 6 April 2017, case E-5/16, Vigeland

- refusal based on grounds of public policy (objective criterion)

= genuine and sufficiently serious threat to a fundamental interest of society

‘An artwork may be refused registration, for example, under the circumstances that its registration is regarded as a genuine and serious threat to certain fundamental values or where the need to safeguard the public domain, itself, is considered a fundamental interest of society.’ (para. 96)

EFTA Court, 6 April 2017, case E-5/16, Vigeland

- refusal based on accepted principles of morality (subjective criterion)

= assessment of perception by reasonable consumers with average sensitivity and tolerance thresholds

'...certain pieces of art may enjoy a particular status as prominent parts of a nation's cultural heritage, an emblem of sovereignty or of the nation's foundations and values. A trade mark registration may even be considered a misappropriation or a desecration of the artist's work...'

EFTA Court, 6 April 2017, case E-5/16, Vigeland

‘Therefore, the possibility cannot be ruled out that trade mark registration of an artwork may be perceived by the average consumer in the EEA State in question as offensive and therefore as contrary to accepted principles of morality.’ (para. 92)

EFTA Court, 6 April 2017, case E-5/16, Vigeland

from assessment of scandalous nature of the sign itself

to assessment of problematic nature of the registration as a trademark

KFIR, 13 November 2017, Vigeland

- potential conflict with public order for two reasons
- '...due to the signs depicting works of art which hold considerable cultural value to Norwegian society, and partly because the temporal limitation of the copyright protection period pursuant to the Copyrights Act is meant to safeguard fundamental societal considerations...' (para. 14)

KFIR, 13 November 2017, Vigeland

- free-riding on reputation already acquired during copyright protection ('spin-off')
- '…a significant competitive advantage will be gained over other enterprises. Not only are there no costs in connection with development of a trademark, but the sign is in itself already known as a work of art and connected to something positive. As a result, there is no need to build consumer recognition of the mark or to generate the positive associations required for reoccurring purchases...' (para. 23)

KFIR, 13 November 2017, Vigeland

- art investment and custodianship not sufficient to outweigh costs for society
- '…such a wish does not safeguard any legitimate interest protected by the Trade Marks Act. On the contrary, the Board finds that trade mark registration on these grounds would contradict the considerations and fundamental societal interests justifying the limitation of the term of copyright protection of Vigeland's works.' (para. 24)

Rembrandt's Nightwatch for strontium?

- distinctive?
- customary in trade practices?

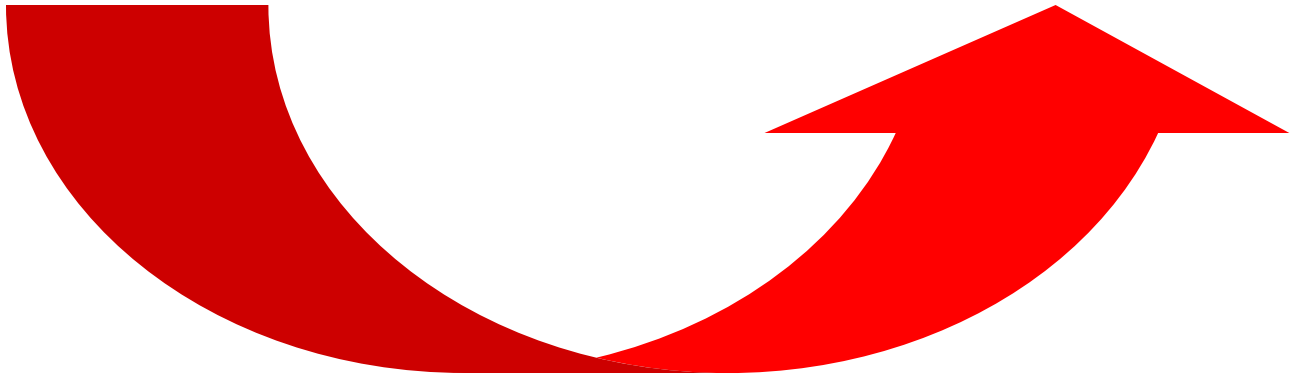
Court of Appeals The Hague, 29 August 2017, ECLI:NL:GHDHA:2017:2446, 'Nachtwacht'

- recognition of outstanding importance to Dutch society
- '...carved in the collective memory of the inhabitants of the Benelux.' (para. 12)
- nonetheless: traditional approach
  - frequent use in commerce
  - decorative character
  - lack of distinctiveness (para. 12)
- missed opportunity to pose prejudicial questions to the CJEU

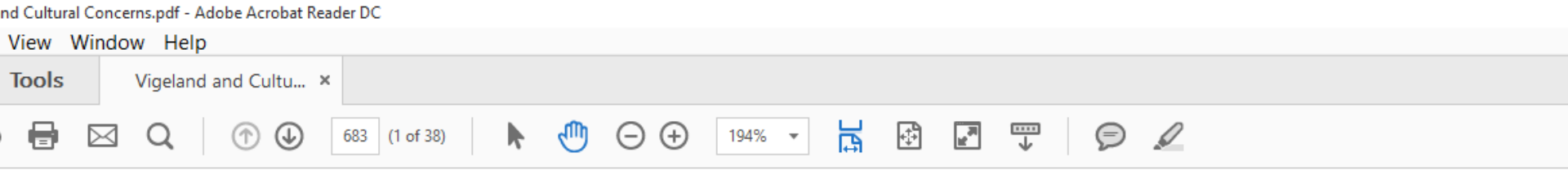
But where to draw the line?

exceptional circumstances justifying outright exclusion

standard cases of overlapping rights (including accidental overlap)



First research output:
https://ssrn.com/abstract=3058482



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CrossMark

ARTICLE

Vigeland and the Status of Cultural Concerns in Trade Mark Law – The EFTA Court Develops More Effective Tools for the Preservation of the Public Domain

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The end. Thank you!

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