The Commercial Exploitation of Personality Features in Germany from the Personality Rights and Trademark Perspectives
Anne Lauber-Rönsberg

Catalog of Trademark Causes of Action (with Groupings by Foundational Objectives)
Tony Bortolin

Commentary: “Change Is Constant”
Pamela S. Chestek

Neil Wilkof
THE COMMERCIAL EXPLOITATION OF PERSONALITY FEATURES IN GERMANY FROM THE PERSONALITY RIGHTS AND TRADEMARK PERSPECTIVES

By Anne Lauber-Rönsberg

CONTENTS

I. Introduction ..........................................................................806

II. The Framework Set by Personality Rights ...............................806
   A. The Protection of Privacy by Personality Rights ..........806
       1. Historical Development ...........................................806
       2. Current Legal Framework .......................................809
           a. Privacy Protection Achieved by a Set of Personality Rights ...........................................809
           b. Finding a Fair Balance with Freedom of Speech .........................................................810
   B. The Right to Commercially Exploit One’s Personality Features .................................................813
       1. Expansion of the Pre-Existing Personality Rights in Germany .............................................814
           a. Recognition of Commercial Aspects as Part of Personality Rights .....................................814
           b. Criticism by Academia ...........................................817
       2. Scope of Protection with Regard to Commercial Exploitation .................................................818
       3. Balancing with Freedom of Speech ..................821

* Dr. iur., Juniorprofessor for Civil Law, Intellectual Property Law, Media and Data Protection Law, Faculty of Law, Technische Universität Dresden, Germany.
4. The Test for Interference with Personality Rights .................................................................822

C. Transferability and Assignments Inter Vivos ..........823

D. Post-Mortem Protection ................................................824

E. Interim Summary .........................................................825

III. Registration of Personality Trademarks .........................825

A. Personality Features as a Trademark .....................825

B. Prerequisites for Registration ........................................826

1. General Capacity of a Sign to Constitute a Trademark .........................................................827

2. Graphic Representation ..........................................827

3. Absolute Grounds for Refusal or Invalidity ...........828

   a. Trademark Protection of Names ......................830

   b. Celebrity Portraits ............................................831

   c. Historical Personalities and Public Domain Considerations ...........................................833

C. Scope of Trademark Protection .....................................837

IV. Differences and Tensions Between Personality Rights and Trademarks in Personality Features ...........................838

A. Differences .....................................................................838

1. Subject of Protection ...............................................839

2. Test of Infringement ...............................................839

3. Term of Protection ...................................................840

4. Degree of International Harmonization .................840

B. Overlaps and Tensions Between Personality Rights and Trademarks .........................................840

1. Consent of the Person to the Trademark Registration ..............................................................841

   a. European Union Trademark Regulation ........841

   b. Germany ............................................................842

2. Divergence of Right Holders ........................................843
a. Right to Continue Using One’s Own Name in the Course of Trade ...........................................844

b. Trademark Use in Conflict with the Interests of the Name Holder ...........................................845

V. Conclusion .............................................................................847
I. INTRODUCTION

The legal framework for controlling the commercial use of a person’s identity and persona is principally set by personality rights and trademark law. In order to analyze the legal framework for commercializing personality features, the article will first give an overview of the development of personality rights, focusing on the legal situation in Germany. It will show that personality rights under German law cover both the right of privacy as well as the right to commercially exploit one’s persona. Special attention will be given to these rights with respect to celebrities.

Trademark issues arising with regard to trademarks registered in personality features will then be discussed, focusing on German and European Union trademark law. Finally, the paper will discuss some overlaps and tensions between trademark law and personality rights when commercializing one’s identity and persona. In this regard, it will consider potential frictions that may arise when the personality rights and trademark rights are allocated to different parties.

II. THE FRAMEWORK SET BY PERSONALITY RIGHTS

A. The Protection of Privacy by Personality Rights

The need for a legal framework in order to protect the individual’s privacy was triggered by technological factors, especially the invention of photography and the emergence of mass media, particularly the so-called yellow press in the nineteenth century. These technological developments led to the evolution of a legal framework aimed at the protection of privacy and reputation, which under German law is achieved by so-called personality rights.

1. Historical Development

In Germany, in the course of the extensive legal research preceding the drafting of the German Civil Code in the nineteenth century, there was a lively debate as to whether the law should acknowledge personality rights. The proposition to introduce personality rights was finally rejected, because the legislator considered the provisions on the crimes of libel and slander in sections 185–187 of the Criminal Code\(^1\) as sufficient to protect honor and reputation. According to section 823 (2) of the Bürgerliches Gesetzbuch (Civil Code of 1900 – BGB), the violation of these statutory provisions could also give rise to an action for damages. One major objection against the introduction of comprehensive personality rights was that an action based on tort law protecting honor and reputation would not only be directed against intentional

---

violations, but also against violations caused by negligence and, as such, would have been in contradiction to the provisions on libel and slander in the Criminal Code requiring willful intent. Another argument was the legal uncertainty implied by the protection of personality rights, as the infringement test always requires a careful balancing of the privacy interests of the person concerned and of the freedom of speech.

However, although the German legislator decided not to introduce an all-embracing personality right, he provided for two limited personality rights. Section 12 of the Bürgerliches Gesetzbuch (Civil Code of 1900 – BGB) provided for the right to one’s own name by prohibiting the unauthorized use of another person’s name. Seven years later, sections 22–24 of the Kunsturheberrechtsgesetz (Act on Copyright in Works of Visual Arts and of Photography of 1907 – KUG) provided that a person’s portrait may only be publicly disseminated and exhibited with the consent of the depicted person.

This right to one’s own image was introduced after the lack of legal protection had become obvious in a case involving the former German chancellor, Otto von Bismarck. Two photographers had unlawfully entered the room where the corpse of Otto von Bismarck had been laid out and had photographed the corpse. Bismarck’s heirs successfully applied for an order for destruction of the photographs. As the German law at that time did not provide for a right to one’s own image, the Court based its reasoning on the crime of trespass to land and argued that there had to be restitution to the landowner of every benefit obtained as a consequence of a trespass. While the result was welcomed by most commentators, the reasoning that trespass gave rise to a restitution claim was considered to be not convincing. This case law provided the impetus for creating a statutory right to one’s own picture.

On the basis of these two specific personality rights, namely, the right to one’s own name and the right to one’s own image, the famous aviator Count Zeppelin successfully applied, as early as 1910, for cancellation of a trademark featuring his name and portrait in connection with tobacco, which had been registered without his consent. The Court based its reasoning on moral grounds, arguing that it was not compatible with the interests of a “sensitive person” to see one’s image or name on traded goods.

---

2. Case No. I 287/25, RGZ 113, at 413 (German Supreme Court until 1945 (RG), May 12, 1926).
3. See infra II.A.2.b.
6. Case No. II 688/09, RGZ 74, at 308 (German Supreme Court until 1945 (RG), Oct. 28, 1910) (Count Zeppelin).
Furthermore, the Court acknowledged the aviator’s right to exploit his name and image in a commercial context. The aviator indeed had granted the right to other companies to register his name as a trademark in order to enable him to raise financial resources for his aviation-related ambitions.

As such, the German courts were willing to acknowledge in principle the need for a legal remedy against the unauthorized exploitation of one’s persona. However, some years later, the Court, for no apparent reason, scaled back on the protection granted. In a case concerning the exploitation of cards depicting a famous soccer player, the Court held that the sportsman was considered to be a public figure and thus could not object to the publication of his likeness in this context. This decision shows that there was still a significant degree of uncertainty about the interpretation of the statutory right to one’s own image.

Apart from the right to one’s own name and image, the German law did not provide generally for the protection of personality rights. However, in 1954, the Bundesgerichtshof (BGH), the Federal Court of Justice, in a landmark decision, created a “general personality right,” based on human rights, in those cases in which the rights to one’s own name and image are not applicable. The case concerned a letter to a newspaper, in which a lawyer demanded on behalf of his client, a politician, that the newspaper should correct an allegedly false statement that it had published. The newspaper published the lawyer’s letter as a “letter to the editor,” without clarifying that the letter did not express the lawyer’s own opinion but was written on behalf of his client in the exercise of his professional duties. The Court held that this manner of publishing the lawyer’s letter showed the lawyer in a false light. The Court reasoned that fundamental rights guaranteeing human dignity and the free development of personality, as set out in Art. 1 and Art. 2 of the Grundgesetz (GG—German Constitution of 1949), required the general protection of personality rights where one was cast in false light. Therefore, the Court interpreted German tort law (Section 823 (1) BGB) as including a “general personality right.”

Shortly after this first decision, the Federal Court of Justice issued another landmark judgment in 1958, holding that the unauthorized use of an amateur horseman’s picture in an advertising campaign for a sexual stimulant was an infringement of the newly created “general personality right,” entitling the claimant

---

7. Case No. I 97/29, RGZ 125, at 80 (German Supreme Court until 1945, June 26, 1929) (Tull Harder).
to compensation for mental distress.\(^9\) In 1964, the Federal Court of Justice awarded compensation for mental distress to Soraya, the former empress of Persia, for the publication of an alleged interview that in fact had largely been made up by the tabloid.\(^10\) The German Constitutional Court (Bundesverfassungsgericht – BVerfG) approved of the creation of a general personality right by judge-made law, which it called a “creative reasoning in search of justice” in order to remedy the shortcomings in the effective protection of personality.\(^11\) In the absence of a general personality right, there would not have been a legal remedy to prevent unauthorized publications about a person’s private life or false information outside the scope of application of the rights to one’s name and to one’s image.

2. Current Legal Framework

\textit{a. Privacy Protection Achieved by a Set of Personality Rights}

As a result of the historic development, protection of personality rights is currently achieved in part by legislation, which provides for explicit protection with regard to one’s own name and image, and in part by the judge-made “general personality right,” which covers other aspects of personality, such as one’s interest to keep details of her private life secret and the right to one’s own voice. This means that there is no comprehensive personality right covering all aspects of one’s persona. Instead, it depends on the nature of the infringement and whether one of the statute-specific rights or the “general personality right,” or both, are applicable. Thus, when information on a person’s private life relating to her marriage is released without authorization in a newspaper article, supplemented by a photo of the wedding ceremony, there is an infringement of the person’s right to her own image as well as her “general personality right.” As such, privacy protection is achieved by a patchwork of limited statutory personality rights and a supplementary “general personality right,” which is applicable in those cases which are not covered by the statutory rights.


\(^10\) Case No. VI ZR 201/63, GRUR 254 (1965) (German Federal Court of Justice, Dec. 8, 1964) (Exclusive Interview).

\(^11\) Case No. 1 BvR 112/65, NJW 1221, at 1225 (1973) (German Federal Constitutional Court (BVerfG), Feb. 14, 1973).
In contrast to the statutory rights to one’s own name and the right to one’s own image, which are explicitly provided for by legislation, the “general personality right” is judge-made law. It has been deduced from fundamental rights. Since there is no explicit statutory provision granting and defining the preconditions, the period of protection of the personality right and the scope and precise contents of the right need to be defined by case law.

According to established jurisprudence, in the event of infringement, remedies arise under German tort law, thus giving inter alia claims for injunctive relief and for compensation for mental distress.

b. Finding a Fair Balance with Freedom of Speech

It has been and remains a major challenge under German law to strike an adequate balance between personality rights, on the one hand, and the freedom of speech and the freedom of information, as guaranteed by Art. 5 (1) of the German Constitution, on the other. Freedom of expression constitutes one of the essential foundations of a democratic society. Beyond that, the press also plays an essential role in a democratic society, acting as a “watchdog.” Therefore, the freedom of the press has to be balanced carefully against the protection of personality rights.

As for the right to one’s own image, the legal provision of section 23 (1) KUG provides certain guidelines, by listing circumstances in which publication of a person’s image is permitted without the consent of the depicted person. According to section 23 KUG, pictures may be published and disseminated with the authorization of the person concerned, if (i) they reflect the sphere of contemporary history; (ii) a person has been portrayed only incidentally as a part of a picture of a landscape or any other physical location; (iii) the pictures show a gathering, procession or similar activity taking place in public; or (iv) the artistic freedom of the photographer prevails over the personality right of the depicted person. However, the existence of statutory provisions does not eliminate the

---

12. See section 12 Civil Code (Bürgerliches Gesetzbuch – BGB) and section 22 KUG (Kunsturheberrechtsgesetz – Act on Copyright in Works of Visual Arts and of Photography of 1907).
13. The German tort law provides in section 823 (1) of the Civil Code (BGB) that anyone who intentionally or negligently injures the life, body, health, freedom and property or another right is liable to compensation.
necessity of balancing the other interest at stake, namely freedom of speech. The balancing requirement is applicable both within the context of the right to one’s own image as well as within the “general personality right.”17 Thus, when interpreting these statutory provisions, a fair balance must still be established on a case-by-case basis.

The so-called “Caroline saga” is instructive to show which criteria have to be considered when balancing privacy interests and the freedom of speech. At the same time, these cases show the impact that the European Convention on Human Rights (ECHR) and the case law of the European Court of Human Rights (EChTR) have on the German legal system. Princess Caroline of Hanover, née Princess of Monaco, tried to prevent intrusions by the press into her private sphere by bringing action against certain press publications.18 In particular, she sued one publishing house for the publication of photographs showing her engaged in private activities taking place in public places, such as shopping, cycling or dining in a garden restaurant.

The German Federal Court of Justice and, on an constitutional complaint,19 the German Federal Constitutional Court, both held that the publication of photos taken in places secluded from public sight, such as a garden restaurant, was a violation of personality rights. However, since they considered Caroline of Hanover to be a public figure (even though she did not hold public office), they approved the publication of photographs taken on the street.20

On appeal by Caroline of Hanover, the European Court of Human Rights (EChTR), in the first Caroline-decision, held that this result was not in line with the protection of privacy guaranteed by Art. 8 of the European Convention on Human Rights (ECHR).21

---

18. See, e.g., Case No. VI ZR 56/94, GRUR 224 (1995) (German Federal Court of Justice, Nov. 15, 1994) on a fictitious interview fabricated by a tabloid; Case No. VI ZR 15/95, GRUR 923 (1996) (German Federal Court of Justice, Dec. 19, 1995) (Caroline of Monaco II) on the publication of photographs showing Caroline of Monaco during private activities in public places, such as shopping or cycling; Case No. 1 BvR 653/96, GRUR 446 (2000) (German Constitutional Court (BVerfG), Dec. 15, 1999) (Caroline of Monaco).
19. A constitutional complaint to the German Federal Constitutional Court (Bundesverfassungsgericht) may be lodged by any natural or legal person if they assume that their fundamental rights (according to the German Constitution) have been violated by a public authority, including courts. The constitutional complaint is an extraordinary remedy in the course of which the Federal Constitutional Court only examines whether constitutional law was violated (see Art. 93 (1) no. 4a and no. 4b of the German Constitution and sec. 90-91 of the Federal Constitutional Court Act (Bundesverfassungsgerichtsgesetz – BVerfGG).
According to the ECtHR, the question of whether the press publication in question contributes to a debate of general interest is a decisive factor in achieving an adequate balance between the rights of privacy according to Art. 8 ECHR and the freedom of expression according to Art. 10 ECHR.

In this context, the Court distinguished between reporting on facts capable of contributing to debate in a democratic society, for example, to the words and deeds of politicians in the exercise of their functions, on the one hand, and reporting on details of the private life of a private individual, on the other hand. The Court concluded that the photos and articles at issue did not make a contribution to a debate of general interest, since Princess Caroline did not exercise any official function and the photos and articles related exclusively to details of her private life.

This landmark decision came, at least from a German perspective, as a surprise, given that firstly, there was no uniform standard for privacy protection within Europe. Secondly, German privacy law until then had been considered to be carefully balanced by providing a relatively high level of privacy protection on the one hand, but at the same time respecting the freedom of the press, on the other hand. Thirdly, the ECtHR has always accorded a “margin of appreciation” to the contracting states in balancing these conflicting interests.

In its decisions that followed the first Caroline of Hanover case, the ECtHR further elaborated on the relevant criteria for finding a fair balance between privacy protection and the freedom of expression. Besides the question of whether a publication contributed to a debate of public interest, the court also considers the following: the degree to which the person affected is well known; the subject of the news report; the prior conduct of the person concerned; the content, form, and consequences of the publication;

24. For further analysis, see Beverley-Smith, Ohly & Lucas-Schloetter, Privacy, Property and Personality, at p. 220 (2005); Lauber-Rönsberg, Völkerrecht in: Götting, Schertz & Seitz, Handbuch des Persönlichkeitsrechts § 61 para. 60-68 (2008).
and, where appropriate, the circumstances in which the photographs were taken.\textsuperscript{27}

In reaction to its first \textit{Caroline} decision, the German courts have modified their jurisdiction in privacy cases. As a result, the courts pay close attention as to whether the publication at issue touches upon questions of significance to contemporary history and thus contributes to a debate of general interest. These terms are construed very broadly by the courts, encompassing not only events of historical or political importance, but also other questions that arouse social interest, including contributions aimed at the readers’ entertainment. Thus, the German Federal Court of Justice held that the publication of pictures showing Caroline of Hanover and her husband during their winter skiing holidays, in the context of an article on how the family dealt with the illness of the princess’s father, Prince Rainier of Monaco, did not violate the right of privacy. It reasoned that the publication contributed to a debate of general interest.\textsuperscript{28} This decision has been upheld by the European Court of Human Rights in its more recent \textit{Caroline} decisions.\textsuperscript{29} However, one can legitimately question whether these decisions are still in line with the first \textit{Caroline} decision and whether these matters really are of legitimate public interest. It seems, rather, that the European Court of Human Rights has scaled down the high level of protection established by the first decision.\textsuperscript{30}

\section*{B. The Right to Commercially Exploit One’s Personality Features}

In spite of the early twentieth century development of personality rights protecting privacy,\textsuperscript{31} there were still difficulties and inconsistencies arising from the desire to accommodate the various interests that are connected with such commercial


\textsuperscript{28} Case No. VI ZR 51/06, paras. 29 GRUR 527 (2007) (German Federal Court of Justice, March 6, 2007) (Winter Holiday); Case No. VI ZR 13/06, GRUR 523 (2007) (German Federal Court of Justice, March 6, 2007); Case No. 1 BvR 1602/07, NJW 1793 (2008) (German Federal Constitutional Court (BVerfG), Feb. 26, 2008) (Caroline von Hannover).

\textsuperscript{29} Von Hannover v. Germany no. 2, Case Nos. 40660/08, 60641/08 (ECtHR, Feb. 7, 2012); Von Hannover v. Germany no. 3, Case No. 8772/10, NJW 1645 (2014) (ECtHR, Sept. 19, 2013).


\textsuperscript{31} See supra Part II.A.1.
exploitation. Judgments and academic discussion alike were characterized by a moralistic approach. The commercial exploitation of a celebrity’s reputation was held to be immoral and thus regarded as violating the celebrity’s non-material interests.32

However, when celebrities began to commercialize their fame and reputation, the orientation focusing on preventing unauthorized use of personality rights was simply not appropriate to provide a legal framework for the commercial use of such features. In particular, it is difficult to accept a public figure’s claim that unauthorized commercial use of her identity is somehow violating the right to be let alone. As Professor McCarthy has put it with respect to U.S. law: “Their complaint was not that they wanted no one to commercialize their identity, but rather that they wanted the right to control when, where and how their identity was so used. Their real complaint was damage to their ‘pocketbook’, not to their ‘psyche.’”33

1. Expansion of the Pre-Existing Personality Rights in Germany

Against this background, German courts have adapted the legal framework to the commercial exploitation of personality features by expanding the personality rights via case law.

a. Recognition of Commercial Aspects as Part of Personality Rights

In 1956, the German Federal Court of Justice held in the Paul Dahlke case that the right to one’s own image not only includes a personality right aimed at protecting legitimate privacy expectations, but also encompasses the right to decide on the commercial exploitation of those elements of the personality which possess a market value. Dahlke was a famous actor who had consented to be photographed on his scooter by a photographer for the purpose of press publications. However, the photographer passed on the photos to the manufacturer of the scooter, which used the photos for its own advertising purposes. During the proceedings, the trial court requested expert evidence as to whether it was common practice to use a celebrity’s picture in an advertising campaign—a fact that is undisputed today. After establishing that Dahlke’s personality right had been violated by the unauthorized use of the actor’s photo in an advertisement, the Federal Court of

32. Case No. II 688/09, RGZ 74, at 308 (German Supreme Court until 1945 (RG), Oct. 28, 1910) (Count Zeppelin).
Justice awarded a reasonable license fee to the plaintiff, based on tort law and on the law of unjust enrichment.34

The *Dahlke* case concerned the rights to one’s own image. Subsequently, the German courts have also applied this reasoning to the other personality rights recognized by the German law, that is, the right to one’s own name and the “general personality right.” For example, in the 1999 *Marlene Dietrich* case,35 the Federal Court of Justice held that the “general personality right” includes not only the protection of privacy, but also the disposition right with regard to the commercial use of one’s personal features. The heir of the late actress successfully applied for an injunction and damages against the producer of a musical about the life of Marlene Dietrich. The defendant had in addition sold various items of merchandise bearing her name and image.

Thus, while there is no distinct right of publicity under German law, the personality right is all-embracing insofar as it provides for the protection of privacy interests, such as the right to be left alone in one’s private sphere and the individual’s autonomy to decide on the commercial use of her identity.36 This concept is called *monistic* (in German *monistisch*), signifying one single, comprehensive right that protects both privacy interests and exploitation interests. The opposite would be a *dualistic* (in German *dualistisch*) concept, providing for a right of privacy and a separate right of commercial exploitation of one’s persona, as can be found, for example, in the legal system of the United States, which provides separately for a right of privacy and for a distinct right of publicity.37 The *monistic* concept is not only of theoretical importance, but is of practical significance, as it leads to the inalienability of personality rights.38

However, there are also differences between privacy rights and exploitation interests, despite both being part of unitary personality rights under German law. In particular is the matter of available remedies, which differ significantly with regard to a claim for damages. If the personality rights have been infringed with regard to the aspect of privacy protection, the person is entitled to compensation for mental distress.39 However, compensation for mental distress is only awarded by the courts in case of serious

---

38. For further details, see infra II.C.
violations of the personality right and if the infringement cannot be remedied by other means, such as the publication of a correcting statement in case of false allegations.\textsuperscript{40} If, on the other hand, an infringing action interferes with the right to decide on the commercial use of one’s personality features, the person concerned can claim compensation for unjust enrichment or damages, which often are calculated on the basis of a reasonable license fee.\textsuperscript{41}

Therefore, the court has to specify whether a tortious act interferes with the protection of privacy or exploitation interests. Only in exceptional cases is it possible that the protection of both non-material and material interests is relevant—for example, when a celebrity’s identity is used commercially, without authorization, in an offensive manner that causes both mental distress and pecuniary damage. This was affirmed in a case when an actress’s photo, without her authorization, had been used for advertising phone sex services.\textsuperscript{42}

Furthermore, one has to distinguish between the two rights with regard to the constitutional law foundations. Whereas the issue of privacy is not only protected by tort law, but is also based on fundamental rights, the right to control the commercial exploitation of one’s publicity only derives from judge-made tort law and it has no constitutional foundation.\textsuperscript{43} Intriguingly, issues of privacy and of personality rights fall within the ambit of different senates within the Federal Court of Justice (Bundesgerichtshof – BGH). According to the Court’s Schedule of Jurisdiction, the competence to decide privacy cases lies with the VIth Civil Panel, which has jurisdiction over tort law matters, while the jurisdiction for violation of personality rights, which are “exploited commercially

\textsuperscript{40} Case No. 1 BvR 2194/15, BeckRS 109308 (2017) (German Constitutional Court, April 2, 2017); Case No. VI ZR 496/15, NJW-RR 1136 (2016) (German Federal Court of Justice, May 24, 2016).

\textsuperscript{41} Beverley-Smith, Ohly & Lucas-Schloetter, \textit{Privacy, Property and Personality} at p. 140-144 (2005).

\textsuperscript{42} Case No. 29 U 3903/94, NJW-RR 539 (1996) (Higher Regional Court Munich, March 9, 1995) (Telephone-Sex-Photo).

\textsuperscript{43} Case No. I ZR 234/10, GRUR 196, at 198 para. 30 (2013) (German Federal Court of Justice, May 31, 2012) (Playboy on Sunday); Case No. VI ZR 123/11, NJW 1728, at para. 29 (2012) (German Federal Court of Justice, March 20, 2012) (Photo of Accident Victim); Case No. I ZR 119/08, GRUR 647, at para. 34 (2011) (German Federal Court of Justice, Nov. 18, 2010) (Markt & Leute); Case No. I ZR 65/07, GRUR 546, at para. 21 (2010) (German Federal Court of Justice, Oct. 29, 2009) (Stumbling Darling); Case No. I ZR 182/04, GRUR 139 (2007) (German Federal Court of Justice, Oct. 26, 2006) (Resignation of the Finance Minister); Case No. 1 BvR 1168/04, GRUR 1049, at 1050 (2006) (German Constitutional Court BVerfG), Aug. 22, 2006) (Marketing Campaign with Blue Angel); see also Bohlen v. Germany, Case No. 53495/09, at para. 61-62 (ECtHR, Feb. 19, 2015); see also Case No. 1 BvR 653/96, NJW 1021, at 1023 (2000) (German Constitutional Court, Dec. 15, 1999) holding that the general personality right guaranteed by Art. 1 (1) and Art. 2 (1) of the German Constitution does not serve the interest of promoting the commercialization of one’s personality features.
(like an IP right), lies with the Ist Civil Panel, which is also in charge of intellectual property cases.

**b. Criticism by Academia**

However, voices within German academia have heavily criticized the Federal Court of Justice for acknowledging that the personality rights include not only the protection of privacy, but also the right to commercially exploit one’s personal features. The claim is made that the merchandising of personality is undesirable from a social perspective. When personality rights provide for a legal framework for personality merchandising, it will encourage persons to do so.  

In support of this view, reference is made to the U.S. *Zacchini* case. There, the U.S. Supreme Court held that recognition of a right of publicity serves the purpose of “protecting the proprietary interest of the individual in his act in part to encourage such entertainment,” which is “closely analogous to the goals of patent and copyright law, focusing on the right of the individual to reap the reward of his endeavors.” Thus, the protection of the right of publicity “provides an economic incentive [...] to make the investment required to produce a performance of interest to the public. This same consideration underlies the patent and copyright laws long enforced” by the U.S. Supreme Court.

These critics argue that the commercial exploitation of personality features is undesirable, because it makes persons behave in a manner that seeks to conform to the fans’ expectations and, due to this incentive for market conformity, hampers the person’s individual development. Therefore, the commercial use of a person’s individual features should not be protected by the law. According to this view, personality rights should protect only non-material interests and should only encompass the right to protect oneself against the unauthorized use of one’s personality for advertisement or other commercial purposes. Under this approach, the personality rights should not include a right of disposition with regard to the commercial exploitation of one’s persona, such as via licensing.

---


As such, it has been suggested that only trademark law should be applicable to the commercial exploitation of personality features, as it provides a suitable legal framework. As will be demonstrated below, however, the nature of trademarks as an alienable intellectual property right entails a loss of control by the person concerned regarding the commercial exploitation of his personality features, particularly when the trademark right is assigned to a third party. Thus, if the merchandising of personality features would be governed only by trademark law, it might promote the commercial exploitation of personality features at the expense of personality rights protection.

2. Scope of Protection with Regard to Commercial Exploitation

Due to their expansion by the case law, personality rights protect not only privacy interests, but also exploitation rights with regard to the commercial use of one’s personal characteristics. According to the German courts, this exploitation aspect of the personality rights is violated only if the infringer appropriates the inherent commercial value that can be attributed to the holder of the personality right. As a general rule, this is the case when a celebrity’s personality features are exploited for purposes of merchandising or advertising. In the absence of any precedent, one can only speculate whether the German courts would apply the same reasoning to non-celebrities as well. In the author's view, this question should be answered in the affirmative when an unknown person’s photo is used for clearly commercial purposes—for example, for advertising. Depending upon the circumstances, the personal characteristics of an unknown person may also possess commercial value. This is even more true in our time, when “everyone will be world-famous for fifteen minutes,” as Andy Warhol predicted, since fame has become relative and sometimes accidental.

49. See infra IV.B.2.b.
An individual’s personality rights are violated when her reputation is exploited without consent for advertising purposes.\textsuperscript{53} However, when the media is involved, it can be difficult to draw the line between a prohibited advertising use and a legitimate use for informative or journalistic purposes. Advertisements for press publications, like any other type of advertising use, infringe the commercial part of personality rights. A recent example is the unauthorized publication of a photo on the front page of a newspaper, which showed a celebrity reading this newspaper, without providing any further information or news reporting. The German courts held this to be a violation of the celebrity’s personality rights and awarded a reasonable license fee.\textsuperscript{54}

By contrast, journalistic uses are considered to violate only privacy interests. Thus, in case of editorial uses, claims for financial compensation for the unauthorized appropriation of the commercial value protected by personality rights are generally denied because of the freedom of speech guaranteed by Art. 5 (1) of the German Constitution.\textsuperscript{55} The Federal Court of Justice rejected a claim against a publishing house for financial compensation by the parents of a young woman who had died in a car accident. The newspaper had used a portrait photo of the victim in order to illustrate a news article about the accident. Although the Court assumed that there had been a violation of the victim’s right to her own image, which according to section 22 KUG\textsuperscript{56} exists for a period of ten years post mortem, the Court declined any financial compensation, either in the form of damages or compensation for unjust enrichment, since the picture did not have any market value during the deceased’s lifetime.\textsuperscript{57} The Court argued that the newspaper intended to provide media coverage of the event and did not intend to commercially exploit the unknown person’s publicity value, even though the


\textsuperscript{56} Kunsturheberrechtsgesetz (Act on Copyright in Works of Visual Arts and of Photography of 1907).

\textsuperscript{57} Case No. VI ZR 123/11, NJW 1728, at paras. 28, 32-33 (2012) (German Federal Court of Justice, March 20, 2012) (Photo of Accident Victim); \textit{see also} Case No. VI ZR 265/04, NJW 605 (2006) (German Federal Court of Justice, Dec. 6, 2005).
picture and the paper’s lurid manner of reporting might arouse additional attention and thus lead to additional profit.\textsuperscript{58}

Also, the parents were not entitled to compensation for mental distress. They could not claim such compensation as their daughter’s heirs, since it is meant to compensate for the distress incurred by the person whose personality right has been infringed, and is thus not granted post mortem.\textsuperscript{59} Nor were they entitled to compensation for mental distress in their own right, since the publication of the picture did not violate the parents’ personality rights.\textsuperscript{60}

Even where celebrities are concerned, the German courts routinely reject claims for reasonable license fees in cases of unlawful media reporting, granting only compensation for mental distress.\textsuperscript{61} Thus, a famous talk show host claimed that both his privacy and his exploitation interests had been violated by the publication of a human-interest story, since the information concerning his private affairs had considerable publicity value. The courts\textsuperscript{62} disagreed, deciding that the press reporting did not infringe the claimant’s personality rights and that the claimant, even if there had been a violation of his personality rights, would not be entitled to claim a reasonable license fee in the case of media reporting. The main argument was that such a sanction might lead to intimidation of the media, which would not be compatible with freedom of the press.

This privilege accorded to journalistic uses has provoked criticism. Voices in academia claim that this interpretation amounts to tolerating the unauthorized commercial exploitation of personality features by the media even in those cases where the press tries to maximize profits by lurid and overly sensational


\textsuperscript{59} Case No. VI ZR 246/12, GRUR 702 (2014) (German Federal Court of Justice, April 29, 2014) (Peter Alexander).

\textsuperscript{60} Case No. VI ZR 123/11, NJW, 1728, at para. 16 (2012) (German Federal Court of Justice, March 20, 2012) (Photo of Accident Victim).


\textsuperscript{62} Case No. 7 U 11/08, ZUM 65 (2009) (Higher Regional Court Hamburg, Oct. 21, 2008) (Wedding Pictures); Case No. 324 O 126/07, ZUM 801 (2008) (District Court Hamburg, Jan. 11, 2008); the ECtHR held that the publication was lawful and therefore did not discuss any sanctions (Sihler-Jauch v. Germany and Jauch v. Germany, Case Nos. 68273/10 and 34194/11, para. 33 (ECtHR, June 16, 2016)). \textit{See also} the recent \textit{Peter Alexander}-decision, in which the German Federal Court of Justice did not even discuss whether the unauthorized disclosure of health details of a famous singer was an infringement of the right to control one’s commercial exploitation (Case No. VI ZR 246/12, GRUR 702 (2014) (German Federal Court of Justice, April 29, 2014) (Peter Alexander)). \textit{See the discussion of this issue by Götting, \textit{Privatsphäre als Vermögensrecht}, in: Götting, Schertz & Seitz, \textit{Handbuch des Persönlichkeitsrecht}, § 45 (2008).}
reporting. It is claimed that in these cases, the relatively small sums awarded by the German courts as compensation for mental distress do not have a sufficiently deterrent effect. Therefore, it is claimed, the persons concerned should be entitled to a reasonable license fee. However, taking into account the complexity and legal uncertainty of balancing personality rights with the freedom of speech, the courts’ reasoning that unlawful media reporting only gives rise to claims for compensation for mental distress is convincing and avoids the “chilling effect” caused by risk of liability.

3. Balancing with Freedom of Speech

The right to control the commercial exploitation of personality features also has to be fairly balanced against the freedom of speech guaranteed by Art. 5 of the German Constitution. According to settled case law, a balancing of the interests involved, on a case-by-case basis, is required, in the same way as it is required for the protection of privacy interests. Generally speaking, the use of the image of a politician or a celebrity image for advertising purposes without consent is prohibited. However, when the advertisement conveys an ironical comment on topical issues of public interest, freedom of speech may prevail according to German jurisprudence. In this case, there is no violation of the commercial components of the “general personality right.”


64. See also Case No. 7 U 11/08, ZUM 65 at 68 (2009) (Higher Regional Court Hamburg, Oct. 21, 2008) (Wedding Pictures).


67. Bohlen v. Germany, Case No. 53495/09, at paras. 45 and 65 (ECtHR, Feb. 19, 2015); Ernst August von Hannover v. Germany, Case No. 53649/09 paras. 44 and 64 (ECtHR, Feb. 19, 2015).
4. The Test for Interference with Personality Rights

The examination of whether there has been an interference with personality rights is based on the issue of identifiability. When aspects revealing the person’s identity—for example, the name or nickname, a photo showing the facial features or a typical gesture, are used in an identifiable manner, the representation interferes with a person’s personality rights.68 However, the need to clearly define the line between an identifying use, on the one hand, and a non-infringing evocation, on the other hand, remains an unresolved problem.69 Whereas, according to U.S. case law, it is possible for a person to be identifiable by a physical object closely associated with him, for instance, the distinctive markings of his race car can identify a famous racecar driver,70 the German courts have been reluctant to accept this proposition.71

However, this may be about to change, as shown by a recent decision by the Cologne Court of Appeal. The judgment there concerns a television commercial by a furniture store, drawing on the quiz show “Who Wants to Be a Millionaire?,” which in Germany is presented by the very well-known presenter, Günther Jauch. Jauch claimed that the commercial violated his personality rights, although its presenter resembled Jauch only insofar as he also had short brownish hair and wore glasses, a suit, and a tie. Apart from that, the man in the commercial did not bear much resemblance to the plaintiff. Nevertheless, although the commercial did not feature a real look-alike but merely evoked associations with the plaintiff and his TV show, the court held that the commercial, by referring to the TV show’s distinctive setting, sufficiently identified Jauch and violated the plaintiff’s right to his own image by unauthorized exploitation. The court allowed the plaintiff a claim for a reasonable license fee.72

68. See, e.g., Case No. VI ZR 108/78, GRUR 732, at 733 (1979) (German Federal Court of Justice, June 26, 1979) (soccer goal).


71. See Case No. VI ZR 108/78, GRUR 732, at 733 (1979) (German Federal Court of Justice, June 26, 1979) (soccer goal).

C. Transferability and Assignments Inter Vivos

As pointed out above,\(^{73}\) the German concept of personality protection is based on a set of several personality rights, that is, the right to one's own image, the right to one's name, and the "general personality right "based on judge-made law, each of which protects both privacy and exploitation interests. The underlying monistic concept, as opposed to, for example, the dualistic structure of personality rights under the U.S. legal system, is not only of theoretical importance, but has a practical significance regarding the transferability of personality rights.

Under German law, the protection of privacy and exploitation interests are intrinsically tied to each other under the roof of monistic personality rights. According to this approach, any transaction concerning the commercial exploitation of one's identity will at the same time also touch upon the protection of privacy interests. Therefore, the personality right as a whole has been determined to be unalienable.\(^{74}\) By preventing the transfer of personality rights, the German law seeks to protect the person from any harmful disposition—for example, the irrevocable assignment or transfer of personality rights to a third party.\(^{75}\) According to the German view, if a person could assign the right to commercially exploit her personality features to a third party, such person would be bound by this contract and thereby lose all rights of disposition in her personality. In order to protect the person's autonomy in this regard, the right to commercial exploitation also cannot be transferred during the lifetime of such person, despite its commercial value.\(^{76}\)

However, it is generally accepted that a person can give assent to specific commercial uses by third parties. The legal nature of such permission is still unclear and disputed. Some authors characterise it as a "waiver," others as a "consent" and some even as a "license."\(^{77}\) Therefore, it is uncertain whether such permission or license can be deemed as an act in rem, thus entitling the licensee to sue infringers in her own right,\(^{78}\) a question of great relevance to licensees.\(^{79}\) Such permission is only valid if it is based on informed consent, that is, if

---

73. See supra Part II.B.1.a).
74. Case No. VI ZR 246/12, GRUR 702, at 703 (2014) (German Federal Court of Justice, April 29, 2014) (Peter Alexander).
77. See discussion by Ohly, Volenti non fit iniuria, p. 167 (2002).
the licensor has been informed in advance of the purpose, mode, and extent of the planned uses.\textsuperscript{80}

Beyond that, under German law, even if a celebrity has consented to certain commercial uses, she may revoke the consent if she can prove that her convictions and beliefs have changed and that it would thus be an unreasonable hardship on her to be bound by the license in the future. This right of revocation for such “changed conviction” derives from German copyright law, and it is an exception to the general rule of \textit{pacta sunt servanda}, implying that contracts are binding upon the contracting parties. It has been applied by German courts, for example, in cases concerning the license to publish nude photos.\textsuperscript{81}

\textbf{D. Post-Mortem Protection}

According to the groundbreaking \textit{Mephisto} case, decided by the German Federal Court of Justice in 1968, a person is protected post mortem against grave distortions of her biography. Posthumous protection is justified by the argument that the fundamental guarantee of human dignity in Art. 1 of the German Constitution has to be respected not only during one’s lifetime, but also post mortem. According to this principle, close relatives may bring an action against a serious violation of the “surviving dignity” of a dead person.\textsuperscript{82} However, the efficacy of such post-mortem protection is restricted because the remedies are traditionally limited to injunctive relief. Damages for pain and suffering are not available because they are designed to remedy the losses incurred by living persons.\textsuperscript{83} The term of protection is not fixed; rather it depends on the extent to which the memory of the person in the public is still “alive” or his memory has already “faded.” Thus, the term of protection with regard to painters, who leave an enduring legacy to posterity, is usually considered to be longer than with regard to actors, who are usually remembered only by near-contemporaries.\textsuperscript{84}

The right to control commercial exploitation continues post mortem and it is an inheritable right that can be passed on to one’s heirs. However, the German Federal Court of Justice restricted the duration of such post-mortem protection to a period of ten years.

\begin{itemize}
\item \textsuperscript{81} Case No. 21 U 4729/88, NJW-RR 999 (1990) (Higher Regional Court Munich, March 17, 1989), for the right to one’s image see Götting, in Schricker & Loewenheim, \textit{Urheberrecht}, § 22 KUG, at para. 41 (5th ed. 2017).
\item \textsuperscript{82} Case No. I ZR 44/66, GRUR 552 (1968) (German Federal Court of Justice, March 20, 1968) (\textit{Mephisto}).
\item \textsuperscript{83} Case No. VI ZR 246/12, GRUR 702 (2014) (German Federal Court of Justice, April 29, 2014) (Peter Alexander).
\item \textsuperscript{84} Case No. I ZR 135/87, GRUR 668 at 670-671 (German Federal Court of Justice, June 8, 1995) (Emil Nolde).
\end{itemize}
after the death of a deceased person. The right to one’s own image exists for a period of ten years post mortem.

**E. Interim Summary**

Personality protection under German law is achieved by a set of personality rights, namely the right to one’s own name (section 12 BGB), the right to one’s own image (section 22 KUG) and the judge-made so-called “general personality right.” Thus, personality rights provide for protection of both privacy interests and the interests to commercially exploit personality features. However, the scope of protection is weakened by the relatively short period of protection to control commercial exploitation, which lasts for only ten years post mortem (compared with copyright, which grants seventy years of protection post mortem auctoris). As described below, the short term of legal protection for personality rights may be a motivation to opt for extendable trademark protection as an additional way of safeguarding the commercial exploitation of personality features. An additional shortcoming lies in the fact that personality rights have not yet been harmonized on a European level, so within the European Union the standard of protection of personality rights may differ significantly, due to diverging national laws.

**III. REGISTRATION OF PERSONALITY TRADEMARKS**

**A. Personality Features as a Trademark**

As an alternative to personality rights, the registration of a trademark may provide an additional legal framework for safeguarding the commercial exploitation of personality features. Before taking a closer look at some issues arising in the context of celebrity trademarks, it is worth recalling the main principles of trademark protection within Germany and the European Union (EU).

---


86. See section 22 KUG (Kunsturheberrechtsgesetz – Act on Copyright in Works of Visual Arts and of Photography of 1907).

87. See infra IV.A.3.

88. It is briefly noted that many other European countries, e.g., France (Beverley-Smith, Ohly & Lucas-Schloetter, *Privacy, Property and Personality*, at p. 156 (2005)) and Poland (Targosz, *Polen*, § 66 para. 46, in: Götting, Schertz & Seitz, *Handbuch des Persönlichkeitsrechts* (2008)), do not appear to have recognized an intellectual property right to the commercial exploitation of one’s own persona. However, these legal systems do provide for a high level of personality rights protection against an unauthorized exploitation of personality features, if this amounts to a violation of the right of privacy.
Within the EU, there are two levels of trademark protection coexisting alongside each other: on the European level, there is the European Union trademark, which, until March 2016 was called the Community Trademark (CTM), after which it was renamed European Union Trade Mark (EUTM) in the process of reforming the EU trademark system. The EU trademark is governed by the European Union Trademark Regulation (EUTMR) and provides for Union-wide protection, since it has a unitary character and equal effect throughout the Union (Art. 1 EUTMR). EU trademarks are granted and managed by the European Union Intellectual Property Office (EUIPO), formerly called the Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) (until March 2016).

Alongside the trademark regime on the European level, the national trademark regimes of the Member States still continue to exist. These national laws have been harmonized by and large by the EU Trademark Directive (EUTMD) 2008/95, which will be replaced by Directive 2015/2436, requiring the Member States to bring into force the laws, regulations, and administrative provisions necessary to comply with the new provisions of the Directive by January 14, 2019. Since there is a congruency among the German Trademark Act (Markengesetz), the EU Trade Mark Regulation, and the EU Trade Mark Directive in many aspects, for the purpose of this article no differentiation will be made among them.

B. Prerequisites for Registration

Personality features can be protected as a trademark only if they are a sign which is distinctive—that is, capable of identifying and distinguishing particular goods as emanating from one producer or origin and not from another, and if the sign is capable


93. For an overview of the concept and structure underlying the EU and national trademark systems, see Aaron & Nordermann, The Concepts of Use of a Trademark Under European Union and United States Trademark Law, 104 TMR 1186, 1187 (2014).
of being represented graphically. Furthermore, EU trademarks require registration (Art. 6 EUTMR), either with the EUIPO or via an international registration with the WIPO. However, national laws of the member States may also provide for unregistered trademarks, since in this respect national trademark laws have not been harmonized by the EU Trademark Directives. Therefore, the national laws relating to unregistered trademarks vary significantly within the EU. This article will focus on registered trademarks.

1. General Capacity of a Sign to Constitute a Trademark

European legislation lists a number of signs capable of being registered as a trademark and refers, inter alia, to words, including personal names, designs and sounds. Thus, names, portraits and signatures of persons are, as a general principle, capable of constituting a trademark, as they are potentially—irrespective of specific goods or services—suitable for distinguishing goods and services offered by one company from those originating from another company. Sounds, such as an oral utterance, can be registered as a sound mark. As the list provided by the legislation is non-exhaustive, other signs may also constitute a trademark—for example, typified gestures, which may be protected as movement marks.

2. Graphic Representation

In the case of unconventional trademarks, such as sound and movement marks, it is sometimes difficult to overcome the obstacle of graphic representation. According to the current legal situation within the European Union, the sign has to be capable of being represented graphically (Art. 4 EUTMR and Art. 3 EUTMD 2008/95). The European Court of Justice (CJEU) requires the representation to be “clear, precise, self-contained, easily accessible, intelligible, durable and objective.” For example, in order to register a movement mark, the prerequisite of graphic

---

95. For further information, see Verena von Bomhard & Artur Geier, Unregistered Trademarks in EU Trademark Law, 107 TMR 679 (2017).
96. See Art. 4 EUTMR, Art. 3 EUTMD 2008/95.
97. Shield Mark BV v. Joost Kist, Case C-283/01, para. 37 (CJEU, Nov. 27, 2003) (Shield Mark).
99. Shield Mark BV v. Joost Kist, Case C-283/01, para. 62 (CJEU, Nov. 27, 2003) (Shield Mark); Ralf Sieckmann v. DPMA, Case C-273/00, para. 55 (CJEU, Dec. 12, 2002).
representation requires the movement to be represented by a series of still images and a written description.  

Because of the requirement of graphic representation, it is not possible to register the sound of a celebrity's voice as such, but only a specific sound (e.g., the sound of a phrase spoken by a celebrity). That said, there is no uniform manner for handling this issue. The EUIPO (formerly OHIM) accepts sonograms—instead of musical notation—as a sufficient graphical representation, whereas the German Patent and Trademark Office (DPMA), has, to date, not considered sonograms to be sufficient.  

It is important to note that as part of EU trademark reform, the graphical representation requirement will be replaced from October 1, 2017. The new provision, in accordance with the formulation by the CJEU in the Siekmann decision, requires a sign to “be capable of being represented on the Register of European Union trademarks in a manner, which enables the competent authorities and the public to determine the clear and precise subject matter of the protection afforded to its proprietor.” Art. 3 lit. b) EUTMD 2015/2436 provides a parallel provision, which must be transposed into the national laws of the Member States by January 14, 2019. In the future, under European trademark law, signs will be allowed to be represented in any appropriate form, not necessarily by graphic means, thus including sonograms as a means of graphic representation. This is expected to give some more leeway to the registration of non-conventional trademarks.  

3. Absolute Grounds for Refusal or Invalidity  

Trademarks serve the purpose of identifying and guaranteeing commercial origin. In accordance with this function, trademark applications will be rejected if the sign lacks distinctiveness or if there is a need to preserve its availability, as set out in Art. 7 (1) lit.
b) to d) EUTMR and Art. 3 (1) lit. b) to d) EUTMD 2008/95. These provisions come into play when the sign is used to designate certain characteristics of the goods or services in question, or when it has become customary in the current language or in the bona fide and established practices of the relevant trade. As the CJEU has recognized, there is a clear overlap between these various absolute grounds for refusal. Nevertheless, the Court considers each of these provisions to be independent of the others. It thus requires separate examination of each absolute ground for refusal, taking into account the public interest underlying each of them.

During the examination of the trademark application, attention must be given to whether the relevant consumers perceive the sign as an indication of origin of certain goods or services or whether the sign is only used in a descriptive fashion—for example, relating to the product, the celebrity, or to her activities. Generally speaking, a minimal level of distinctiveness suffices for rejection based on absolute grounds not to apply. According to the CJEU, a sign must be refused protection if there is even the possibility that it is being used in a descriptive manner. Thus, the German Trademark Office dismissed an application to register the family name of the famous engineer Felix Heinrich Wankel as a trademark for engines, especially rotary piston engines, and the repair and maintenance of engines. Wankel, who died in 1902, invented the Wankel rotary piston engine, which was named after him. The Court held that the name of Wankel was perceived to be a description of technical features of engines and not an indication of commercial origin.

With regard to celebrity trademarks, the focus is usually not on the trademark’s capability of indicating the product’s origin, but rather on the sign’s advertising function. In addition to the sign’s


109. Audi v. EUIPO, Case C-398/08 P para. 39 (CJEU, Jan 21, 2010) (Vorsprung durch Technik); Case No. I ZB 61/13 para. 9 (German Federal Court of Justice, Oct. 23, 2014) (Langenscheidt-Gelb); Case No. I ZB 21/06 para. 13 (German Federal Court of Justice, April 24, 2008) (Marlene-Dietrich-Portrait).


111. Case No. 28 W (pat) 103/05 (German Federal Patent Court (BPatG), April 4, 2007) (Wankel).
essential function of indicating the identity of origin of goods or services,\textsuperscript{112} the CJEU has acknowledged additional trademark functions, that is, guaranteeing the quality of the goods or services as well as the functions of communication, investment, and advertising.\textsuperscript{113} As celebrity trademarks are often eye-catching and highly associative, they can serve an advertising purpose. Furthermore, the rationale for using a celebrity’s characteristics may also be the right owner’s expectation that the celebrity’s fame will favorably reflect on the products or services. In that sense, the use of the celebrity’s characteristics aim at an image transfer: The reputation of the goods or services will be enhanced by the positive associations evoked by the celebrity.\textsuperscript{114} In particular, under what circumstances will such signs have a distinctive character in that sense that they serve to identify the product and/or services in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish that product from those of other undertakings?

In summary, despite the wide range of potential circumstances, to date there has been very little European case law dealing with trademark protection of personality characteristics, such as names and portraits.

\textit{a. Trademark Protection of Names}

It appears that the CJEU only recently had to consider trademark protection in celebrity names. In many product areas, most notably in fashion and perfumes, the use of designers’ names is well established as an indication of commercial origin. A name, by its nature and purpose, designates the person bearing this name. However, it has been disputed whether this speaks in favor of or against attributing a distinctive character to the name. The German Federal Patent Court has taken the position that a name is automatically distinctive as a matter of legal principle.\textsuperscript{115} However, this view is not convincing, as the distinctive character of a sign in the context of trademark registration has to be assessed not with regard to the name holder, but with regard to the sign’s ability to indicate the origin of a product or service. This prerequisite has to be assessed in relation to the goods or services for which registration is applied, as well as in relation to the perception of the relevant consumers.\textsuperscript{116}

\textsuperscript{112} Arsenal v. Reed, Case C-206/01 para. 48-50 (CJEU, Nov. 12, 2002).
\textsuperscript{113} L’Oréal SA v. Bellure, Case C-487/07 para. 58 (CJEU, June 18, 2009).
\textsuperscript{114} Von Bassewitz, 	extit{Prominenz und Celebrity}, 141 (2008).
\textsuperscript{115} Case No. 27 W (pat) 83/11, GRUR 1148, at 1149 (2012) (German Federal Patent Court, March 27, 2012) (Robert Enke).
\textsuperscript{116} See Nichols plc v. Registrar of Trade Marks, Case C-404/02 para. 23 with further references (CJEU, Sept. 16, 2004).
The parameters by which to understand the registration of a name can be seen in the following. In the *Nichols* judgment, the CJEU rejected the argument that names, even common surnames, were a priori devoid of distinctive character. As the EU legislation\textsuperscript{117} does not draw a distinction between different categories of trademarks with regard to the assessment of distinctiveness, the Court concluded that the criteria for assessing the distinctive character of trademarks consisting of a personal name are therefore the same as those applicable to other categories of trademarks. Thus, the CJEU rejected arguments in favor of applying stricter criteria of assessment with regard to common surnames.\textsuperscript{118}

The *Mozart* decision of the EU General Court is a good example of the need to preserve the availability of a sign, as intended by Art. 7 (1) lit. c) and d) EUTMR and Art. 3 (1) lit. c) and d) EUTMD 2008/95. According to these provisions, an application for the registration of a name as a trademark is refused when the sign is used to designate certain characteristics of the goods or services in question. Thus, the EU General Court refused to register the name of the composer Mozart for confectionery, since German speakers would regard that term as a reference to the characteristic recipe for the confectionary called *Mozartkugeln*, rather than an indication of the commercial origin of the goods concerned.\textsuperscript{119}

**b. Celebrity Portraits**

Until recently, German courts have granted broad trademark protection for celebrity portraits. In a judgment concerning a figurative trademark consisting of a portrait of the famous race driver Michael Schumacher for services falling in International Class 41 of the Nice Classification,\textsuperscript{120} the German Federal Patent Court held that a portrait allows for the unmistakable identification of a person and thus was even more distinctive than merely a person’s name.\textsuperscript{121} Thus, the Court held the portrait to be able to

\textsuperscript{117} See Art. 2 Directive 2008/95/EC; Art. 3 2015/2436; Art. 4 EUTMR.

\textsuperscript{118} Nichols plc v. Registrar of Trade Marks, Case C-404/02 para. 25-26 (CJEU, July 23, 2003); see from the German jurisdiction Case No. 32 W (pat) 165/04, GRUR 591 (2006) (German Federal Patent Court, Nov. 30, 2005) (Georg-Simon-Ohm); Case No. 27 W (pat) 162/09, GRUR 421, at 422 (2010) (German Federal Patent Court, Oct. 5, 2009) (Egon Erwin Kisch-Preis). Previously, British courts were reluctant to grant trademark protection to common surnames in order to ensure that no unfair advantage is given to the first applicant for such a name, see Jacobs J. in *Re Nichols*, (EWHC 1424 (Ch). See also von Bassewitz, *Prominenz und Celebrity*, at p. 159-160 (2008).

\textsuperscript{119} Reber v. EUIPO, Case T-304/06, paras. 94-95 (GC, July 9, 2008).

\textsuperscript{120} Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks (as amended on September 28, 1979), retrievable at http://www.wipo.int/treaties/en/classification/nice/.

\textsuperscript{121} See, e.g., Case No. 29 W (pat) 81/98, NJWE-WettbR 153 (1999) (German Federal Patent Court, April 29, 1998) (Michael Schumacher).
indicate commercial origin, without, however, examining whether the sign actually was indicating the commercial origin of the claimed goods and services in this case.122

However, in two widely discussed decisions, given in 2008 and 2010, respectively, on the registration of a portrait of the late Marlene Dietrich as a figurative mark, the German Federal Court of Justice took a more restrictive line. Marlene Dietrich, who died in 1992, was a famous actress, singer, and fashion icon. The applicant sought to register the portrait for goods and services in numerous classes of the Nice Agreement. Trademark registration was finally rejected for the goods and services falling within Classes 9, 16, and 41, such as CDs, DVDs, movies, books, brochures, magazines, posters, photos, and film production. The German Federal Court of Justice argued that the relevant consumers perceive her portrait as descriptive with regard to her oeuvre and performances.

According to the Court, the public perceives the photo as descriptive with regard to those goods and services that deal with Marlene Dietrich’s movies, songs, and her life.123 Furthermore, the Court rejected the argument that the portrait can also be used in a non-descriptive way as a label, for example, for music of the Golden 1920s, as performed by other artists, since it considered such use as unusual and purely hypothetical.124 To the contrary, use as a non-descriptive label for music by other artists would well be conceivable. However, one also has to bear in mind that according to the ECJ’s jurisdiction, trademark registration cannot be limited to goods and services not related to Marlene Dietrich’s oeuvre. Trademark registration is not granted for goods or services under the condition that they do not possess a particular characteristic, since such a practice would lead to legal uncertainty as to the extent of the protection afforded by the trademark.125

With regard to posters and other merchandising articles, this decision has faced criticism by German scholars. Under German law, the right to one’s own image is granted for ten years post mortem on the basis of personality right.126 Therefore, the manufacturer of the goods would need a license from Marlene

126. See supra Part II.D.
Dietrich or her heirs. Thus, it is claimed, it would be obvious to the public that the poster originates from a licensee.\(^{127}\) However, this reasoning is based on the assumption that consumers are aware of the necessity of acquiring a license and also have some knowledge of the relevant legal time limits, which is difficult to imagine. Furthermore, if distinctiveness was to be inferred from the need to obtain a license, in theory one would have to conclude that distinctiveness of the portrait would terminate upon the expiry of the personality right, namely ten years after the celebrity’s death.

Furthermore, the applicant also sought to have the portrait of Marlene Dietrich registered as a trademark for clothing. The Federal Court of Justice entertained some doubts as to whether an ornamental use of a portrait (e.g., on a shirt) can be considered distinctive. Nevertheless, the Court ultimately took the position that the portrait could be used in a distinctive way, for example, on a clothes label.\(^{128}\) Although at the time of the relevant decisions in 2008 and 2010, use of portraits in this way were not widespread, it might become so in the future.\(^{129}\) This case illustrates that the assessment of whether a sign is used in a distinctive fashion or may be prospectively be used so in the future, depends to a great extent on what is accepted as customary use of a sign.

In summary, the German jurisprudence took quite a restrictive stance in the Marlene Dietrich decisions when examining the registration of trademarks in portraits for goods and services relating to the oeuvre, achievements, and reputation of a celebrity. Nevertheless, pursuant to Art. 7 (3) EUTMR / Art. 3 (3) EUTMD 2008/95, the absolute grounds for refusal set out in Art. 7 (1) b)-d) EUTMR and Art. 3 (1) b)-d) EUTMD 2008/95 can be overcome, if the sign has acquired distinctiveness through use. Distinctive character acquired through use means that although the sign initially lacked distinctiveness with regard to the claimed goods and services, because of its use on the market, a significant proportion of the relevant public now perceives the sign as identifying the goods and services as originating from a particular commercial origin.

c. Historical Personalities and Public Domain Considerations

During the lifetime of a person who has gained notoriety, the decision on the protection of one’s persona by trademarks rests, of


\(^{129}\) \textit{See also} Haarhoff, Prominenten-Porträts als Marke?, GRUR 183 at 184 (2011).
course, with that person. However, after the person’s death and the expiry of all personality rights, so-called historical persons, such as Leonardo da Vinci, become part of the cultural heritage. The commercial use of their persona falls within the public domain, and it may be freely used. There has been widespread discussion as to what extent these considerations affect the registration of such celebrity trademarks with regard to deceased historical personalities.

In many cases, the problem will not arise because that reference to an historical personality will often be made in an iconic sense. For example, the photo of Albert Einstein sticking out his tongue, which is often printed on shirts, has become emblematic of his unconventionality. Furthermore, reference to historical personalities may often lack the capability of indicating the commercial origin of a service or product.\textsuperscript{130} For instance, the German Federal Patent Court cancelled the trademark “Mark Twain” for writing utensils, obviously referring to the name of the famous American writer, because of a lack of distinctive character.\textsuperscript{131} According to the Court, the public perceives the names of historic personalities, when used for writing utensils, as a tribute to these celebrities and their lifework, not as an indication of commercial origin.

In another case, the Court refused to register “Richard-Wagner-Barren” (“Richard-Wagner-bar”) for soaps and sweets because of lack of distinctiveness, since it is common practice to offer chocolate or soaps shaped in the form of a bar. The combination of the word “bar” with the name of the famous German composer Richard Wagner, who died in 1883, is perceived by the relevant consumers as referring to merchandising articles, which are sold, for example, in the context of music festivals celebrating Richard Wagner, but not as an indication of any commercial origin.\textsuperscript{132}

However, when a sign referring to a historical personality actually is perceived as indicating the commercial origin of a product or service, the fundamental question arises whether the grant of a trademark as a monopoly right with respect to the historical figure is compatible with the public interest in the free use of the cultural heritage. Is there a general need to preserve the free availability of use of historical personalities? Some argue that personalities of notable historical importance should not be eligible


\textsuperscript{131} Case No. 29 W (pat) 75/12, GRUR 79 (2014) (German Federal Patent Court, May 15, 2013).

for trademark protection in order to preclude individuals from monopolizing the personality’s market value\textsuperscript{133} and “in order to safeguard their work from trivialization.”\textsuperscript{134}

More recent court rulings of the German Federal Patent Court, however, take the view that it would unduly restrict trademark protection if historical personalities could not be registered at all, or could be registered only if the trademark fulfils a commemorative function.\textsuperscript{135} In support of this position, it can be argued that the monopoly granted by trademark protection—except perhaps in the case of dilution, is limited in scope, as the monopoly granted is restricted to the classes of goods and services for which the trademark has been registered.\textsuperscript{136}

However, the deterrent effect of a trademark may go beyond its actual scope of protection and also prevent uses of the sign in a manner exceeding the scope of the exclusive right.\textsuperscript{137} For example, a trademark in a portrait of a famous composer like J. S. Bach, registered with regard to textiles, would only encompass the exclusive right to use the sign with regard to identical or similar products. However, it has been observed that registered trademarks may deter a third party (e.g., a music festival) from using the same portrait for other goods or services, although this use, strictly speaking, cannot be prohibited by the trademark owner. Such a deterrent effect may arise as a result of a sense of uncertainty as to whether the use of this portrait may be likely to cause confusion and thus constitutes a trademark infringement, or simply because of a lack of information on the scope of protection of trademarks.\textsuperscript{138}

\begin{itemize}
\item \textsuperscript{134} Advocate General at the CJEU, Ruiz-Jarabo Colomer, Opinion in the case Claude Ruiz-Picasso v. EUIPO, C-361/04 at para. 69 (GA, Sept. 8, 2005);
\item \textsuperscript{136} See § 14 (2) no. 1 and 2 MarkenG (German Trademark Act).
\item \textsuperscript{138} Haarhoff, Prominenten-Porträts als Marke?, GRUR 183 at 186 (2011); Sahr, Die Marken- und Eintragungsfähigkeit von Persönlichkeitsmerkmalen, GRUR 461 at 470 (2008); Wandtke/Bullinger, Die Marke als urheberrechtlich schutzfähiges Werk, GRUR 573 at 578
\end{itemize}
These concerns are especially relevant for trademarks in historical personalities because of the need to preserve the public domain.

The potentially harmful effects of trademarks on the availability of the public domain are furthermore increased by the fact that the EU trademark system does not require bona fide intent or actual use before registering a trademark. Instead, there is a grace period of five years after registration of the trademark, during which the non-use of the trademark does not constitute a ground for cancellation. These provisions level the playing field and remove a market barrier to entry for emerging companies that have not yet established a commercial presence. In exchange, the European legislator accepts that there may be an “over-claiming” by virtue of the registration, since some trademarks are registered for goods and services that will never be brought to market.

On the other hand, there are also substantial arguments in favor of the view that historical personalities should be eligible for trademark protection. First, advocates of the opposite view have not yet been able to refute the argument that if personality rights and trademarks in historical personalities are to be synchronized, this should also apply to trademarks acquired during the lifetime of a celebrity. This would, however, lead to the result that a celebrity trademark would have to be cancelled after the celebrity’s death, when the right of publicity expires. Thought through to its logical conclusion, this reasoning would disrupt the system of trademarks, which is without limitation of time, subject to payment of renewal fees. Secondly, it would be difficult to define who should be considered a historical person eligible for such trademark protection.

Having regard to the respective claims, it seems that these counterarguments outweigh the concerns related to the reestablishing a monopoly right in a historical person by means of granting celebrity trademarks. If distinctive, personality features of celebrities can be protected as trademarks.

However, in order to preserve the public’s right of free access to cultural heritage, trademarks in personality features of historical personalities are acceptable only subject to careful examination of the conditions for protection, especially whether the sign has a distinctive character.
distinctive character. In line with the Marlene Dietrich decisions by the German Federal Court of Justice,\textsuperscript{143} personality features of celebrities lack any distinctive character with regard to goods and services that involve a thematic reference to the celebrity’s life and oeuvre, and thus are not perceived as indicating the commercial origin of goods and services.\textsuperscript{144} Furthermore, these public domain concerns should not only be taken into account with regard to whether protection exists, but also when interpreting the scope of protection, as will be demonstrated below.\textsuperscript{145}

\textbf{C. Scope of Trademark Protection}

Trademarks do not confer an exclusive right to use the sign in any context, but only give the owner the exclusive right to use the sign with regard to certain products or services, especially in order to indicate their origin. The scope of protection is thus closely linked to the functions of the trademark.\textsuperscript{146} However, the CJEU has embraced a very broad concept of acts that fall within the scope of protection. Besides its essential function of guaranteeing the origin of goods or services,\textsuperscript{147} the CJEU has acknowledged additional trademark functions, covering the guaranteeing of the quality of the goods or services as well as the communication, investment, and advertising functions.\textsuperscript{148}

A trademark owner can thus prevent third-party use of the sign when it is done in the course of trade for the purpose of distinguishing goods or services. When a designer has acquired trademark protection in her name for clothing, a third-party use of the sign in relation to similar or identical products obviously jeopardizes the sign’s function as an indication of origin and constitutes trademark infringement.

Especially in those cases where a celebrity’s portrait or signature is protected as a figurative mark, the relevant question becomes whether a decorative use of the sign by third parties, for example, on a shirt, may be prohibited by the trademark owner. The issue of whether an ornamental use overlaps or supersedes the scope of protection provided for by a trademark has been widely discussed.\textsuperscript{149} The CJEU has acknowledged that the decorative use of a sign can constitute trademark infringement when the relevant

\begin{itemize}
\item \textsuperscript{143} See \textit{supra} Part III.B.3.b).
\item \textsuperscript{144} Case No. I ZB 21/06, GRUR 1093 (2008) (German Federal Court of Justice, April 24, 2008) (Marlene-Dietrich-Portrait).
\item \textsuperscript{145} See \textit{infra} Part II.C.
\item \textsuperscript{146} See, e.g., Arsenal v. Reed, Case C-206/01 para. 51 (CJEU, Nov. 12, 2002).
\item \textsuperscript{147} See, e.g., Arsenal v. Reed, Case C-206/01 para. 48-50 (CJEU, Nov. 12, 2002).
\item \textsuperscript{148} L’Oréal SA v. Bellure, Case C-487/07 para. 58 (CJEU, June 18, 2009).
\item \textsuperscript{149} See, e.g., von Bassewitz, \textit{Prominenz und Celebrity}, at p. 237-238 (2008) for further references.
\end{itemize}
public is likely to perceive the sign as an indication of the origin of the products or services.  

The CJEU thus held that the sale of merchandise and memorabilia bearing the symbol of Arsenal FC, a well-known football club in the English Premier League, was infringing use, but only when it created “the impression that there was a material link in the course of trade between the goods concerned and the trademark proprietor.” With regard to trademarks in personality features of living celebrities, however, it may happen that the public perceives the sign not only as an embellishment, but also as an indicator of the product’s origin. This has to be examined on a case-by-case-basis.

This means that there is no trademark infringement when the decorative use of the sign is not perceived as an indication of source. Arguably, this may be the case when an historical person’s portrait or signature is used for decorative purposes. In such situations, the relevant public is not likely to perceive the sign as an indication that those products originate from the trademark proprietor. Therefore, the German Higher Regional Court of Dresden was correct in holding that an ornamental use of Bach’s portrait on a porcelain service did not infringe the trademark in this portrait registered for porcelain and glass products.

IV. DIFFERENCES AND TENSIONS BETWEEN PERSONALITY RIGHTS AND TRADEMARKS IN PERSONALITY FEATURES

A. Differences

As can be seen from the above, both personality rights and trademarks provide a legal framework for commercializing personality features. Even when personality features are protected as trademarks, they do not cease to identify the persona of that person and thus continue to be protectable by personality rights. Thus, both rights might be applicable in a given situation. However, there are some striking differences between these two rights.

150. CJEU, judgment of April 10, 2008, Case C-102/07, GRUR 2008, 503 at para. 34 (adidas und adidas Benelux); see also German Federal Court of Justice, judgment of March 5, 1998, Case No. I ZR 13/96, GRUR 1998, 830, 834 (Les-Paul-Guitars).

151. Arsenal v. Reed, Case C-206/01 para. 56 (CJEU, Nov. 12, 2002). See also Adam Opel AG/Autec AG, Case C-48/05 para. 24 (CJEU, Jan. 25, 2007).


153. See also Haarhoff, Prominenten-Porträts als Marken?, GRUR 183 at 187-188 (2011).

1. Subject of Protection

An obvious difference between trademarks and personality rights relates to the subject of protection. Trademark law does not grant an exclusive right to every use of a sign, but confers upon the owner only the exclusive right to use the sign with regard to the specified products or services in order to indicate their commercial origin. Thus, the scope of trademark protection encompasses only the registered sign—for example, a person’s portrait or a confusingly similar photo—but does not extend to another portrait of the same person that has been taken at another day, when there is no likelihood of confusion. This means that trademarks protect only the specific aspects of the personality that have been registered, not the commercial value of a celebrity’s persona as such. In contrast, personality rights encompass the exclusive right to control the commercialization of the persona in every respect—for example, any portrait of a person.

2. Test of Infringement

Furthermore, the test for infringement for the two types of right rests on different criteria. Whether the use of a sign is an infringement of a trademark has to be assessed by the likelihood of confusion test. There is trademark infringement when the public might believe that the goods or services in question come from the same undertaking or, as the case may be, from economically linked undertakings. However, the mere association that the public might make between two trademarks is not sufficient indication of a likelihood of confusion.

From a personality rights perspective, however, the infringement test focuses on the issue of “identifiability” of the person concerned. Arguably, the identifiability test sets a lower threshold. Although there may be no likelihood of confusion as to the source of goods, if the person concerned is still identifiable, there may be an infringement of personality rights. As has been pointed out, even evoking an association with a celebrity has been considered an infringement of personality rights.


156. SABEL v. Puma AG, Rudolf Dassler Sport, Case C-251/95, para. 26 (CJEU, Nov. 11, 1997).


158. See supra Part II.B.4.
3. Term of Protection

Another striking dissimilarity between these rights is in the terms of protection. Trademarks are registered for a period of ten years (e.g., Art. 46 EUTMR), but may be renewed for further periods of ten years without limitation.159 In contrast, the right of publicity expires a fixed period of time following the person’s death, as defined by national laws. As discussed above,160 under German law, this period is ten years post mortem.161

4. Degree of International Harmonization

A further difference is the degree of international harmonization within the European Union. Personality rights are not part of the legislative competency of the EU, with the result that they are governed by national laws.162 Trademark law, on the other hand, has been harmonized at the European Union level. Accordingly, when personality features are exploited throughout the European Union, it may be recommendable to opt for the uniform legal framework of trademark protection instead of relying on the national personality rights of the various EU Member States, which differ significantly.

B. Overlaps and Tensions Between Personality Rights and Trademarks

The final part of this article examines the question of the overlap between trademarks in personality features and the personality rights of the persons concerned, and the tensions created by this overlap. The first question concerns the extent to which consent to the registration of the trademark is required. The second question is whether personality rights may have the effect of limiting the exploitation of a trademark.


160. See supra Part II.B.2. and II.D.


1. Consent of the Person to the Trademark Registration

A possible conflict may arise between a celebrity trademark and personality rights when the trademark is registered by a third party rather than by the celebrity. In accordance with the principle of personal autonomy protected by fundamental rights, the competence to determine the commercial exploitation of oneself lies with such person. As such, the question arises as to under what circumstances the registration of personality features as a trademark require the consent of the person concerned.

a. European Union Trademark Regulation

Before registering a trademark in a personality feature, the EUIPO does not examine whether the person concerned has given her consent. This is so because only absolute grounds for refusal listed in Art. 7 EUTMR are examined. One could argue that a trademark application lacking such consent is of such a nature as to deceive the public and thus caught by the absolute ground for refusal provided by Art. 7 1) lit. g) EUTMR. However, the CJEU rejected this argument, as this provision covers only those grounds that prevent a trademark from being registered for reasons of the public interest.

However, the lack of consent may constitute a relative ground for refusal, if raised by a third party in an opposition or cancellation proceeding after registration of the EU trademark. According to Art. 53 (2) EUTMR, an EU trademark shall be declared invalid on application to the EUIPO or on the basis of a counterclaim to an infringement claim, where the use of such trademark may be prohibited pursuant to the national law of a Member State governing the protection of the right to a name (lit. a) or the right of personal portrayal (lit. b). The prerequisites for this relative ground for invalidity are governed by national law. Thus, the party opposing the trademark has to prove that she is entitled to the right in the name or the portrait and that there is a conflict with these personality rights. For example, the EU General Court held that the registration of the trademark ELIO FIORUCCI in respect of a series of goods falling within Classes 3, 18, and 25 of the Nice Agreement should be cancelled because it violated the rights of the Italian designer Elio Fiorucci in his name according to Art. 8 (3) of the Codice della Proprietà Industriale (Italian Industrial Property

163. Art. 1 and 2 (1) of the German Constitution (Grundgesetz – GG).
164. Elio Fiorucci v. EUIPO, Case T-165/06 para. 28 (GC, May 14, 2009); Elizabeth Florence Emanuel v. Continental Shelf 128 Ltd, Case C-259/04 paras. 46 (CJEU, March 30, 2006).
Code). The Court reasoned that his name was well known and there was no evidence of explicit, clear, and unequivocal consent to registration of the name as a Community trademark.166

Furthermore, when a sign is filed with the intention of "trademark grabbing," this has been found to constitute bad faith within the meaning of Art. 52 (1) lit. b) EUTMR.167

b. Germany

In contrast to, for example, Art. 8 (3) of the Italian Industrial Property Code, as described above, the German Trademark Act does not contain a provision stipulating that a person’s personality features may only be registered as a trademark with such person’s consent. However, the German Trademark Act provides in Section 13 (2) no. 1 and 2 that the registration of a trademark may be cancelled if another person has acquired an opposing right prior to the registration of the trademark. This provision explicitly includes the right to one’s name and the right of one’s own image. Still, since Section 13 of the German Trademark Act is, as is Art. 53 (2) EUTMR, a relative ground for refusal, it will be considered only if raised by an opposing party.168

In the absence of any third-party opposition, the application for a celebrity trademark is usually rejected only in exceptional circumstances, most notably when the application was made in bad faith, which, according to Section 8 (2) no. 10 of the Trademark Act, constitutes an absolute ground for refusal. An interesting case in this regard involved the filing of a trademark in the name of Lady Di, the late Princess of Wales, only one day after her death. The mark was registered by the German Patent and Trademark Office, only to later be cancelled on application by the executor of the estate Princess Diana, on the ground that it has been registered in bad faith contrary to Section 8 (2) no. 10 of the German Trademark Act.169

This example shows that the German Patent and Trademark Office is reluctant to apply the ground of bad faith in refusing registration when there is a conflict between personality rights and a trademark application. Only in exceptional circumstances might an application for a trademark without the consent of the person concerned fall within the ambit to Section 8 (2) no. 10 of the Trademark Act. Except for those rare cases that are caught by an absolute ground for refusal, the German legislator has placed the burden of preventing or cancelling a trademark registration upon

166. Elio Fiorucci v. EUIPO, Case T-165/06 (GC, May 14, 2009).
169. Case No. 24 W (pat) 36/02 (German Federal Patent Court, March 2, 2004) (Lady Di).
the person whose personality rights are violated by the trademark. This person has to submit an application or a counterclaim in order to have the trademark cancelled.

It is questionable whether these principles give sufficient consideration to the fundamental importance of personality rights. It may be true that a comprehensive examination regarding whether the person concerned has authorized the registration of the trademark would likely overburden the Trademark Office. However, at least in obvious cases, where a party (who is not the celebrity) applies for the registration of a celebrity’s persona, the trademark office should demand proof of authorization from the person concerned in order to dispel the suspicion of bad faith.

2. Divergence of Right Holders

When a name or other personal features are registered as a trademark, the question remains as to what extent the trademark is deemed detached from the personality right and thereby stands independently. This question becomes relevant when the right in the trademark and the personality rights are allocated to different persons. Whereas personality rights, at least under German law, are inalienable, trademarks can be transferred freely. The transfer of a trademark requires neither a transfer of the undertaking nor the assignment of any accompanying goodwill symbolized by the mark (see, e.g., Section 27 of the Trademark Act, Art. 17 EUTMR).

Furthermore, trademarks can also be freely licensed to third parties. European trademark law does not require the licensor to exercise control over the use of the trademark in order to ensure the quality of the goods or services in question. It is the common view that the right in a celebrity trademark can be assigned to a third party. This raises the question as to how far the person is still permitted to use her name without infringing the trademark, and whether there are any limitations on the use of the trademark when it is used contrary to the interests of the celebrity, for example, in a derogatory context.

171. See Götting, Der Mensch als Marke, MarkenR 229 at 233 (2014).
172. See supra Part II.C.
173. Wilkof and Burkitt, Trade Mark Licensing, 2d ed.
a. Right to Continue Using One’s Own Name in the Course of Trade

When a trademark in a name has been assigned to a third party, but the name holder still wishes to use her name in the course of trade, Art. 12 (1) lit. a) EUTMR achieves a certain balance between the holder of the personality right and the trademark owner. According to this provision, the scope of trademark protection is limited: the trademark proprietor cannot prohibit a natural person from using her name in the course of trade, if the use is in accordance with honest practices in industrial or commercial matters. This provision achieves a balance between the trademark owner and the name holder bearing the same name.

Another example is a case that was recently decided by the Danish Supreme Court on the basis of the harmonized trademark law. When setting up her business, a Danish designer used her own name as a trademark. When her company went bankrupt, another company bought the main part of her company’s assets, including the trademark rights to her name, and from then on prevented her from using her own name to establish a new business. As the use of the Danish designer’s name caused a risk of confusion with the trademark, the Danish Supreme Court held it to be an infringement of the trademark.

This case demonstrates the potential friction that may exist between personality rights, on the one hand, and trademark rights, on the other. It also illustrates the importance of the requirement that the use of the name only be permitted if it is in accordance with bona fide trade practices. As the CJEU pointed out with regard to the previous version of Art. 14 (1) lit. c) EUTMD 2015/2436, the condition of “honest use” relates to the duty to act fairly in relation to the legitimate interests of the trademark owner. As has been stated by the EU Court of Justice, this condition is not met, for example, if the use of the name gives the impression of a commercial connection between the third party and the trademark owner, if it affects the value of the trademark by taking unfair advantage of its distinctive character or reputation, or if it entails the discrediting of the trademark.

175. See also Art. 14 (1) lit. a) EUTMD 2015/2436, § 23 no. 1 of the German Trademark Act.
176. Case No. I ZR 41/08 para. 35 (German Federal Court of Justice, April 14, 2011) (PEEK & CLOPPENBURG II); Ingerl/Rohnke, Markengesetz, § 23 para. 30 (3d ed. 2010).
177. Benedikte Utzon/Topbrands, Case No. 262/2015 (Danish Supreme Court (Højesterets Dom), Dec. 20, 2016).
178. Gillette v. LA-Laboratories, Case C-228/03 para. 49 (CJEU, March 17, 2005).
b. Trademark Use in Conflict with the Interests of the Name Holder

If the trademark right has been assigned to a third party, this raises the question whether personality rights set limits on the exploitation of the trademark, where the trademark is used contrary to the interests of the celebrity. For example, assume that a celebrity has consented to the use of his name and portrait in advertising for goods in a pornographic context and if the name also has been registered as a trademark with regard to these goods. Might the celebrity be entitled to revoke the consent if his ethical standards change and she perceives the use of her personality features with regard to these goods as derogatory? In this case, the person may be entitled to revoke the consent with regard to his personality rights for a change of conviction.\textsuperscript{179} The question then arises whether this would have any impact on the licensee’s or assignee’s right to use the trademark.

Similar questions can be asked when creditors enforce the levy of execution against the person concerned. The right of publicity is not subject to execution, at least not without the concerned person’s consent.\textsuperscript{180} In contrast, trademarks, as a general rule, may be levied in execution (see, e.g., Art. 20 EUTMR). However, if person has registered her personality features as a trademark, is this personality trademarks subject to execution and, in this context, may it be licensed or assigned to a third party without the need for the person’s consent?

These examples point to the complex relationship between personality rights and personality trademarks. Some scholars take the view that the trademark is completely emancipated and detached from the person concerned as well as from her personality rights.\textsuperscript{181} According to this position, even if the person is entitled to revoke her consent for changed conviction under the personality rights regime, the use of the protected sign as a trademark cannot be prohibited by the person, as long as it remains within the scope of the license or assignment.

In contrast, other scholars take the view that a complete detachment is incompatible with the inalienability of personality rights, and thus argue that the assignee’s or licensee’s right to use the trademark law should be limited by personality rights. This would require, for example, the person’s consent if the trademark is

\textsuperscript{179} See supra Part II.C. at the end of the section.

\textsuperscript{180} Sosnitza, Die Zwangsvollstreckung in Persönlichkeitsrechte – Plädoyer für eine Neuorientierung, JZ 992 (2004).

\textsuperscript{181} Beverly-Smith/Ohly/Lucas-Schloetter, Privacy, Property and Personality, p. 199 (2005).
assigned to a third party in the event of execution or insolvency proceedings.\textsuperscript{182}

A celebrity registering a trademark in her own personality features or consenting to the registration of a trademark by a third party has to be aware of the fact that the trademark, albeit relating to a personality feature, becomes an alienable intellectual property right. Particularly when the trademark owner assigns the trademark right to a third party, this transfer entails a loss of control with regard to the commercial exploitation of the personality feature as a trademark. Such a situation may also occur when the trademark is seized during execution or in insolvency proceedings. To a certain extent, the loss of control with regard to the personality features is a necessary and logical consequence of the decision to protect personality features as a trademark. This risk is borne by the celebrity, even if she may not have been aware of these consequences when consenting to the registration of the trademark.\textsuperscript{183}

Furthermore, the loss of control inherent in the registration of the trademark is mitigated by the fact that the scope of the trademark is confined to the use of the sign with regard to the specified classes of goods or services. Thus, it is much more limited than the protection granted by the personality rights to commercially exploit the persona. This reduces the risk that the reputation of the celebrity concerned may be jeopardized by the exploitation of the trademark.

However, some concerns remain, since trademarks may be registered for a wide range of goods and services and they can be freely transferred. Thus, it might happen that a celebrity trademark registered for DVDs is used by the transferee in a disparaging context—for example, for pornographic content. In such circumstances, the use of the trademark in personality features should be restricted by the person's personality rights. As pointed out above,\textsuperscript{184} personality rights are considered to be inalienable in order to prevent a relinquishment of the right and thus to protect the person's autonomy. A complete emancipation of the trademark right from the person and her personality rights would be inconsistent with the fundamental concerns underlying the inalienability of personality rights. The celebrity should have the right to prevent such derogatory uses by virtue of his personality rights, even if such a use is within the scope of the agreement on the


\textsuperscript{183} To the contrary, von Bassewitz, \textit{Prominenz und Celebrity}, at p. 292 (2008), takes the view that when a celebrity acquires trademark protection for her persona and then becomes insolvent, the insolvency administrator may not assign the trademark to a third party without the celebrity's consent.

\textsuperscript{184} See infra Part II.C.
use of the trademark. However, the right to oppose the use of the trademark will only become relevant in exceptional cases, such as use in a disparaging context, and its impact will need to be determined by a balancing of interests on a case-by-case basis.\textsuperscript{185}

\textbf{V. CONCLUSION}

This article has outlined the scope of protection for commercial exploitation of personality features provided by personality rights and trademarks, and the overlap between these rights, with a focus on German (and EU) IP law. It remains an open question whether trademark law can define the limits of the commercial exploitation of a sign, or whether some personality right restrictions should be read into trademark law in order to more appropriately align it with the personality rights regime. As such, fundamental questions about the interrelation between personality rights and celebrity trademarks have yet to be satisfactorily answered.

\footnote{\textit{See also} von Bassewitz, \textit{Prominenz und Celebrity}, at p. 290-291 (2008).}