

Court of Justice of the European Union

Cour de Justice de l'Union Européenne

L – 2925 Luxembourg

Re: C-298/23 *Inter IKEA Systems BV v. Algemeen Vlaams Belang* vzw

September 05, 2023

***Amicus* Submission – International Trademark Association**

This brief (also referred to as the “Submission”) is filed on behalf of **International Trademark Association (INTA)**, established at: 675 Third Avenue, 3rd Floor, New York, NY 10017-5646, United States of America and herein represented by the lawyers: Ms. Noemi Parrotta of the law firm Spheriens, piazza della Libertà No. 13 - viale Don Minzoni No. 1, Florence, Italy; Ms. Marina Perraki of the law firm Tsibanoulis & Partners, Omirou St. No. 18, 10672 Athens, Greece; Mr. Andreas Lubberger of the law firm Lubberger Lehment, Meinekestraße No. 4, 10719 Berlin, Germany; and Ms. Micheline Don of the law firm Parker Advocaten, Willemsparkweg 84, 1071HL Amsterdam, the Netherlands, acting jointly or severally, domiciled at the firm of the former at piazza della Libertà No. 13 - viale Don Minzoni No. 1, Florence, Italy, email address info@spheriens.com and fax No. 0039-055-2633800, **who agree that service be effected on them by the e-Curia accounts of Noemi Parrotta, Marina Perraki and Andreas Lubberger.**

PRELIMINARY REMARKS

1. INTA has prepared this brief in relation to Case C-298/23 *Inter IKEA Systems BV v. Algemeen Vlaams Belang* vzw pending before the Court of Justice of the European Union (also referred to as the “Court” or the “CJEU”), request for a preliminary ruling under Article 267 of the Treaty on the Functioning of the European Union (the “TFEU”) referred by the

Nederlandstalige Ondernemingsrechtbank Brussel (Belgium) **published in the Official Journal of the European Union, C 286/21, on 14 August 2023.**

2. This Submission was drafted by INTA independently of the parties in the case at issue. Indeed, this brief was prepared by INTA's International Amicus Committee – Europe Amicus Subcommittee, under the direct supervision of INTA's Executive Committee of the Board of Directors, following a strictly independent procedure. In particular, and in order to maintain INTA's independence, the preparation of this Submission took place confidentially. INTA did not disclose its deliberations to either of the parties and did not consult with the parties on the issues in the case.

3. INTA submits this Submission in its capacity as a stakeholder-organization raising its voice in matters of public interest. INTA is well aware that neither Article 23 nor Article 40 of the Statute of the Court nor Article 96 of the Procedural Rules of the Court provide for a right to be involved or heard. References to the CJEU under Article 267 of TFEU, however, are made available to the public by the Court at an early stage. They sometimes capture issues with connotations beyond the mere interpretation of the laws of the European Union. INTA considers the reference in case C-298/23 to have such a quality.

4. Indeed, the case at issue concerns the scope of EU trademark law and its reach into the protection of free speech. In particular, this honorable Court is called to decide whether and in what circumstances freedom of expression – including the freedom to express political opinions and political parody, as guaranteed by Article 10 of the European Convention for the Protection of Human Rights (the “ECHR”) – and Article 11 of the Charter of Fundamental Rights of the European Union (the “European Charter”) may amount to a viable defense in trademark infringement cases by relying on the “due cause” exception under Article 9(2)(c) of Regulation (EU) 2017/1001 of 4 June 2017 as to the European Union Trademark (hereafter referred to as “EUTMR” or the “Regulation”) or Article 10(2)(c) and Article 10(6) of Directive (EU) 2015/2436 of 16 December 2015 approximating the trademark laws of EU member States as to national trademarks (hereafter referred to as “EUTMDR” or the “Directive”). It follows that the outcome of this case may broaden the viable fair use defenses under EU trademark law and have a significant impact on the proprietors of European Union marks and/or national marks in EU Member States leading to INTA's interest in this case, as we will better see here below.

5. INTA contends that, although nothing in the procedural laws of the Court expressly allows third parties' interventions in preliminary ruling cases, on the other hand there is nothing in these laws which prohibits this honorable Court to take this Submission, at least, as a source of information. With all due respect INTA submits this brief in the hope and belief that it may serve as a valuable source of information for this honorable Court to decide on the referral in case C-298/23.

INTA AND ITS INTEREST IN THE RESULT OF THE CASE

A. About INTA

6. INTA is a global association of brand owners and professionals dedicated to supporting trademarks and complementary intellectual property (IP) to foster consumer trust, economic growth, and innovation, and committed to building a better society through brands. Members include nearly 6,500 organizations, representing more than 34,350 individuals (trademark owners, professionals, and academics) from 185 countries, who benefit from the Association's global trademark resources, policy development, education and training, and international network. Founded in 1878, INTA, a not-for-profit organization, is headquartered in New York City, with offices in Beijing, Brussels, Santiago, Singapore, and Washington, D.C. Metro Area, and a representative in New Delhi. For more information, visit "inta.org".

7. INTA represents a wide range of users worldwide of trademark systems, including the European trademark system.

8. INTA's membership includes over 6,000 organizations, across all industry lines, including manufacturers and retailers ranging from aerospace to consumer goods and to service providers in the field of trademark law in the broadest sense such as law firms, trademark attorneys and business sector associations in all 27 Member States of the European Union.

9. An important objective of INTA is to protect the interests of the public by the proper use of trademarks. In this regard, INTA strives to advance the development of trademarks, related IP and unfair competition laws and treaties throughout the world, based on the global public interest in avoiding deception and confusion. INTA has been an official non-governmental observer to the World Intellectual Property Organization ("WIPO") since 1979 and actively

participates in all trademarks-related WIPO proposals. INTA has influenced WIPO trademark initiatives such as the Trademark Law Treaty and is active in other international arenas, including the Asia Pacific Economic Cooperation Forum (“APEC”), the Association of Southeast Asia Nations (“ASEAN”), the European Union (EU) and the World Trade Organization (“WTO”).

10. INTA provides expertise concerning trademark and other IP-related laws to courts and intellectual property offices around the world through the submission of *amicus curiae* (“friend of the court”) briefs or similar filings, playing a neutral role and addressing only the legal issues. Since 1916, INTA has intervened as *amicus curiae* (“friend of the court”) in the US and in other jurisdictions, including before European courts.

B. INTA’s interest in the case

11. As mentioned above, INTA is not a party in the case and is aware of the fact that the CJEU does not have a procedure for accepting an *amicus curiae* intervention *stricto sensu* in preliminary ruling cases. INTA, however, believes that the case is significant to the development of trademark law and presents itself as a “friend of the court” in this matter and as done in the past (a list of INTA’s submissions before European courts and bodies is attached as “Annex A” to this Submission).

12. It is noteworthy that over the past years INTA has intervened in IP-related cases before the CJEU, as well as before the General Court of the European Union (“GCEU”), according to Article 40(2) of the Statute of the Court (in cases in which the relevant Rules of Procedures expressly allowed so), being able to “*establish an interest in the result of a case submitted to the Court*”.

13. In particular, by order of 25 March 2014 the CJEU granted INTA’s leave to intervene in case C-445/13P, *Voss of Norway ASA / Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) (now EUIPO)*, EU:C:2014: 202; by order of 23 November 2015, the GCEU granted INTA’s leave to intervene in case T-142/15, *DHL Express (France) SAS v European Union Intellectual Property Office*, EU:T:2015:908; by order of 17 April 2023, the CJEU granted INTA’s leave to intervene in case C-337/22P, *EUIPO v Nowhere*, EU:C:2023:409; by order of 28 July 2023, the GCEU granted INTA’s

leave to intervene in case T-105/23, *Iceland Foods v EUIPO - Icelandic Trademark (Iceland)* (not published); and by order of 28 July 2023, the GCEU granted INTA's leave to intervene in case T-106/23, *Iceland Foods v EUIPO - Icelandic Trademark (Iceland)* (not published).

14. It is worth stressing that in the *Voss* case the CJEU pointed out: “[i]n particular, the Court allows intervention by representative associations whose object is to protect the interests of their members in cases raising questions of principle liable to affect those members. It must be noted in that regard that INTA is a not-for-profit association of more than 6000 undertakings in all the Member States and worldwide. Further, it is apparent from its statutes that the object of INTA – which has, inter alia, observer status at the World Intellectual Property Organisation (WIPO) and with the Administrative Board of OHIM – is, in particular, to promote the interests of its members in the uses of their trade marks. It must also be noted that **some of the questions raised in the present case, [...] may be considered to be questions of principle concerning the assessment of the validity of three-dimensional trade marks, and thus liable to affect the interests of INTA's members who are proprietors of such Community trade marks**” (see, to that effect, paragraphs 7-9 of the relevant order; emphasis added).

15. If it were possible to intervene according to Article 40(2) of the Statute of the Court in this case, the above reasons would apply *mutatis mutandis* in the present proceedings. Indeed, the questions raised in this case are **questions of principles**, *i.e.*: whether and, in the affirmative, in what circumstances the user of a third party trademark may invoke free speech and claims of parody/political speech as a defense to trademark infringement, even if that use takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the EU trademark. It follows that the outcome of this case may affect the interests of INTA's members who are proprietors of European Union marks and/or national marks in EU Member States.

16. INTA has recently expressed views on parody as a defense under US law (see for example the Supreme Court Decision in *Case No. 22-148, Jack Daniel's Properties, Inc. v. VIP Products LLC*.¹). Further, INTA has submitted an “amicus brief” (Third Party Observations) in the “Covidiot” case, which is pending before the Grand Board of Appeal of the European

¹ See the brief available at: <https://www.inta.org/wp-content/uploads/public-files/advocacy/amicus-briefs/INTA-Amicus-Brief-Jack-Daniels-v.-VIP-Products-Jan-2023.pdf>.

Union Intellectual Property Office, and which raises the question on the impact of free speech in registration proceedings and in particular in the context of absolute grounds of refusal (see Case R-260/2021-G, *Matthias Zirnsack v. EUIPO*²).

17. With specific regard to the issue at stake in this case, it is also worth recalling that INTA – which was on the front line during the legislative process of the EU Trademark Reform leading to the adoption of both the current Regulation and Directive – vigorously opposed the European Parliament and the Max Planck Institute’s³ proposals to include among the fair use exceptions a provision allowing use of the protected trademark for purposes of parody, artistic expression, criticism and comment. In particular, INTA stressed that *“the reference to ‘parody’ and ‘comments’ would have permitted such uses in the course of trade. It would have opened the way even for use of famous trademarks for goods in a manner which could have been detrimental to the reputation of a trademark. Such uses should continue to constitute a trademark infringement, even if the defendant claims this to be a ‘joke’”*⁴ (emphasis added). As a consequence of INTA’s as well as other stakeholders’ objections, the amendment proposed by the European Parliament and the Max Planck Study was not eventually adopted. The EU legislator kept the reference to possible legitimate uses by a third party of a trademark for artistic/freedom of expression purposes only in Recital 21 of the Regulation and Recital 27 of the Directive, which must assist in the interpretation of the provisions of the Regulation and the Directive in a manner that does not leave the door open to possible changes, adopted through case-law, regarding the fair use exceptions in trademark infringement proceedings in the EU.

18. Trademarks, in particular well-known marks, appear to be quoted in the public from time

² Namely as a means of broadening trademark rights, not restricting them, as is the case at hand <https://www.inta.org/amicus-brief/case-r-260-2021-g-matthias-zirnsack-vs-euipo>.

³ In October 2009 the Commission entrusted the Max Planck Institute for Intellectual Property and Competition Law of Munich with the task of carrying out *“an in-depth assessment of the overall functioning of the trademark system in Europe as a whole including both at the Community and at the national level. The aim is to analyze current performances and to identify potential areas for improvement, streamlining and future development of this overall system to the benefit of users and the society as a whole”*. This study (available at: <https://op.europa.eu/en/publication-detail/-/publication/5f878564-9b8d-4624-ba68-72531215967> and hereinafter referred to as the “Max Planck Study”) is the basis of the EU Trademark Reform.

⁴ GRÜNDIG-SCHNELLE, EU Trademark Law Reform Series: New Fair Use Provisions, INTA Bulletin, December 15, 2015.

to time not to denominate the origin of goods and services, but for other purposes. Such cases call for defining the limits of the scope of trademark protection and – if trademark laws apply – for a demarcation of trademark protection against other third-party rights or public interests. The IKEA-referral falls exactly into this category. Moreover, and in line with the interests INTA outlined above, the IKEA-referral calls for a closer analysis of parody as a possible “excuse” for the harmful use of a famous and/or well-known trademark.

19. Lastly, Article 10(6) of the Directive allows Member States to provide that the use of a national mark may be infringing even if the alleged infringing sign is not used in the course of trade, if that use is “*without due cause*” and takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the relevant trademark⁵.

20. The Benelux Court of Justice (A2018/L18) recently found that the interpretation of the wording “*without due cause*” in the context of Article 10(6) of the Directive shall be the same as in the context of Article 10(2) of the Directive, namely the dilution provision, which also refers to use “*without due cause*”. INTA agrees that both under Article 10(6) or under Article 10(2) of the Directive or the equivalent Article 9(2) of the Regulation, the interpretation of the wording “*without due cause*” must be the same. Furthermore, given that the same wording exists in the context of registrability, namely Article 5(3)(a) of the Directive and Article 8(5)

⁵ What typically falls within this provision is the use of company/trade names – see the Max Planck Study page 14; see also CJEU decision dated 21 November 2002, case C-23/01, *Robeco v. Robelco*, [2002] ECR I-10913 – or non-distinctive uses. For instance, in Italy this provision was implemented in the context of the protection of well-known marks, by providing that even uses of said marks other than uses for the purposes of distinguishing goods or services might amount to trademark infringement, where the use of the relevant sign without due cause takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the trade mark; the Italian Supreme Court was recently called to interpret this provision with respect to a parody/freedom of expression defense relied on in a case involving the mark “Zorro” and held that “*the exploitation of a third-party’s mark, if well-known, is forbidden [under Italian trademark law (ed)] where the use of the relevant sign without due cause, made in the course of trade, takes unfair advantage of, or is detrimental to the distinctive character or the repute of the trademark, regardless of whether the trademark is used to distinguish the goods or services of the author of the use, as may be the case with the parody representation of the trademark in question*” (see, Italian Supreme Court, October 11, 2022, decision 38165/2022, *CO.GE.DI. International – Compagnia Generale Distribuzione s.p.a. v Zorro Productions Inc.*; for a brief comment in English of this decision see: ELEONORA ROSATI, *Parody under copyright and trademark law: key guidance from Zorro and the Italian Supreme Court*, published on the IPKat blog on January 5, 2023: <https://ipkitten.blogspot.com/2023/01/parody-under-copyright-and-trade-mark.html>).

of the Regulation, the same interpretation would apply there too.

21. INTA believes that the outcome of this case may have a significant impact on the proprietors of European Union marks and/or national marks in EU Member States as the interpretation of the wording “*without due cause*” affects a very broad scope of cases and consequently the scope of rights (limitations) of trademark owners, in the context of registrability /relative grounds but also in the context of use, for national but also for EU trademarks, in the context of EU provisions but also in the context of national provisions implementing the Directive or falling within Article 10(6) of the Directive, such as the above mentioned provision of the Benelux law. Furthermore, there is limited CJEU case law on “*due cause*”⁶.

22. As regards the interplay between trademark rights and freedom of expression, it is important that a harmonized approach be applied throughout the EU Member States. The CJEU case-law on this issue is limited, whereas national case law in various Member States presents fluctuations.

23. In light of the above INTA has a strong interest to prevent a broad interpretation of the “without due cause” concept, as such a broad interpretation would allow what was previously excluded in the fair use provisions of the Regulation/Directive when the EU Trademark Reform was adopted, namely the possibility that parody, artistic expression, criticism and comment, would amount to fair use of a trademark. In this respect, INTA takes the view that although both free speech and parody might, under certain circumstances, provide a defense to a claim of infringement (risk of confusion/dilution), it is a matter of importance to right

⁶ See CJEU, September 22, 2011, case C-323/09, *Interflora and Interflora British Unit v Marks & Spencer plc and Flowers Direct Online Ltd.*, EU:C:2011:604 where the CJEU held that the use of keywords of competitors in online advertising so as to display advertisements to offering competing goods fell within the ambit of fair competition was not without “due cause” and was therefore permitted. See also CJEU, February 6, 2014, case C-65/12, *Leidseplein Beheer BV e Hendrikus de Vries v Red Bull GmbH e Red Bull Nederland BV*, EU: C:2014:49 on the issue of whether there can also be due cause, within the meaning of Article 5(2) of the Trademarks Directive, in the case where the sign that is identical or similar to the trademark with a reputation was already being used in good faith by the third party or parties before that trademark was filed.

holders that those circumstances be carefully circumscribed⁷.

ON THE SUBSTANCE OF THE CASE

A. Background

24. At issue are Benelux and European Union word marks for IKEA as well as a semi-figurative Benelux mark for IKEA in respect of a broad range of goods and services. It is accepted by all parties that IKEA is “*one of the most well-known brands in the world*”.

25. On 14 November 2022, Vlaams Belang, a Flemish nationalist political party operating in Belgium, presented its “IKEA” plan to the press and public. “IKEA” was said to be an abbreviation of “Immigratie Kan Echt Anders” (which translates as “*Immigration Really Can Be Different*”). The party proposed a “Swedish package” of immigration measures through what it contended was a playful and parodying reference to the IKEA brand. The “plan” was presented as an IKEA construction kit or manual, by analogy with IKEA’s well-known manuals, with 15 policy proposals for use by the Belgian government.

26. An example of the materials used in this respect is below:

⁷ See MICHAL BOHACZEWSKI, *Special Protection of Trademarks with Reputation under European Union Law*, 1st ed 2020, Chapter 2 paragraph 200 who complains about the sometimes “excessive” concerns about parody and free speech in legal doctrine and the failing to understand the specialty of trademark protection which in itself significantly limits the scope of trademark rights.



27. The plan was publicized and disseminated at a half-hour press conference in which the speaker of Vlaams Belang declared an oral disclaimer as follows:

Our IKEA PLAN does not stand for Ingvar Kamprad Elmtaryd and Agunnaryd (...) – that is what IKEA actually stands for. For us, IKEA does not stand for the Swedish manufacturer of handsome furniture; no, for us, IKEA stands for: “Immigratie Kan Echt Anders”.

28. Further, the plan is available in an extended version on the website of Vlaams Belang; possibly without any disclaimer (the referring Court is not entirely clear in that regard). In its record of facts, the referring Court gives no indication of additional formats of use. In particular, there is nothing in the record of facts which suggests that Vlaams Belang is making use of the IKEA name and marks to generate income (for example by the sale of stickers) or to collect donations.

29. By writ of summons of 22 November 2022 IKEA sued the political party before the Nederlandstalige Ondernemingsrechtbank Brussel (Dutch Enterprise Court, Brussels, Belgium), seeking: (1) a declaration that the defendants, by using the sign IKEA in their material, are unlawfully infringing the applicant’s trademark rights; (2) an order that the defendants cease using the IKEA trademarks and/or the IKEA house style, on pain of a penalty

payment; (3) publication of the judgment to be handed down in the Dutch-language and French-language press, on the applicant's website and on the defendants' websites; and (4) destruction of the material used, all this with damages.

B. Question referred

30. The Dutch Enterprise Court, Brussels, Belgium stayed the proceedings and referred the following question to this honorable Court:

- *Can freedom of expression, including the freedom to express political opinions and political parody, as guaranteed by Article 10 of the [ECHR] and Article 11 of the [European Charter], constitute 'due cause' for using a sign identical or similar to a well-known trademark within the meaning of Article 9(2)(c) of [European Trademark Regulation] as well as Article 10(2)(c) and Article 10(6) of [European Trademark Directive]?*
- *If so, what are the criteria to be taken into account by the national court in assessing the balance between those fundamental rights, and the importance to be attached to each of them?*
- *In particular, can the national court take into account the following criteria, and/or are there additional criteria:*
 - *the extent to which the expression has a commercial character or purpose;*
 - *the extent to which competitive motives are at play between parties;*
 - *the extent to which the expression has a public interest, is socially relevant or opens a debate;*
 - *the relationship between the above criteria;*
 - *the degree of reputation of the trademark invoked;*
 - *the extent of the infringing use, its intensity and systematic nature and the extent of its distribution, by territory, time and volume, also taking into account the extent to which this is proportionate to the message that the expression is intended to convey;*
 - *the extent to which the expression, and circumstances accompanying that expression, such as the name of the expression and its promotion, are*

detrimental to the reputation, distinctive character and image of the trademarks invoked (the ‘advertising function’);

- *the extent to which the expression exhibits its own original contribution and the extent to which an attempt has been made to avoid confusion or association with the trademarks invoked, or the impression that there is a commercial or other connection between the expression and the trademark proprietor (the ‘origin function’), also taking into account the manner in which the trademark proprietor has built up a certain image and reputation in advertising and communication?*

31. For the sake of clarity and concision, the relevant legal provisions are attached hereto as Annex “B”.

C. INTA’s analysis

Language of the Directive – use “in the course of trade” and “in relation to goods and services”

32. IKEA based its action *inter alia* on its EU word mark “IKEA”, which was registered in 1998 for a broad variety of goods and services. The available protection for this mark conferred under Article 10(2) Directive and Article 9 (2) Regulation for all forms of trademark infringement requires as a **common prerequisite** a

“...use in the course of trade, in relation to goods and services...”.

33. The phrase “*use in the course of trade*” had previously been interpreted by the CJEU as “*use in the context of a commercial activity with a view to economic advantage, and not as a private matter*”.⁸

34. Subsequent cases have made it clear that there can be use of a mark in the course of trade even where the alleged use takes place outside of the context of interactions between a trader

⁸ See CJEU, November 12, 2002, case C-206/01, *Arsenal Football Club plc v Matthew Reed*, EU:C:2002:651, paragraph 40.

and its customer.⁹ Recently the CJEU has also held that a private individual who imported and stored a commercial quantity of goods that bore a trademark, and who only received remuneration for these services by a carton of cigarettes and a bottle of cognac, might still be acting in the course of trade.¹⁰

35. Most recently the CJEU has adopted an even broader approach by reference to the mere need of a use in the framework of commercial communication.¹¹

36. As a consequence, the scope of trademark protection has been expanded in comparison to the somewhat narrow language of the written law. It is however still obvious that there is a demarcation of trademark law against use for private purposes, against the field of science¹², against the field of expression (artworks) and against the field of free speech (parody). Indeed, **purely satirical/parodistic uses are often made outside the economic context** and, consequently, would not even amount to “use in the course of trade”¹³.

37. On the other hand, use of a trademark potentially covered by the freedom of expression may well take place in the context of the marketing of goods or services. In particular, parody

⁹ See CJEU, July 16, 2015, case C-379/14 *TOP Logistics BV and Van Caem International BV v Bacardi Co. Ltd and Bacardi International Ltd – Bacardi & Company Ltd and Bacardi International Ltd v TOP Logistics BV and Van Caem International*, EU:C:2015:497 and CJEU, July 25, 2018, case C-129/17, *Mitsubishi Shoji Kaisha Ltd and Mitsubishi Caterpillar Forklift Europe BV v Duma Forklifts NV and G.S. International BVBA*, EU:C:2018:594.

¹⁰ See CJEU, April 30, 2020, case C-772/18, *A v B*, EU:C:2020:341. But in that case the key factor appears to be that the nature and volume of the goods concerned was such that the activities nevertheless potentially fell within the scope of a trading business.

¹¹ See CJEU, December 22, 2022, in joined cases C-148/21 and C-184/21, *Louboutin*, EU:C:2022:1016, paragraphs 28, 29; CJEU, April 2, 2020, case C-567/18, *Coty Germany GmbH v Amazon Services Europe Sàrl e a.*, EU:C:2020:267, paragraph 40^o; CJEU, July 12, 2011, case C-324/09, *L’Oréal SA and Others v eBay International AG and Others*, EU:C:2011:474 paragraphs 102 and 103.

¹² See GCEU, May 10, 2006, case T-279/03, *Galileo International Technology LLC and Others v European Commission*, EU:T:2006:121, paragraphs 107 et. seq.

¹³ See BOHACZEWSKI, *Conflicts Between Trademark Rights and Freedom of Expression Under EU Trademark Law: Reality or Illusion?*. IIC 51, 856-877 (2020), whereby the Author stresses that “*outside the economic context, the use of a trademark, including a reputed mark, is allowed. Consequently, in principle, any use of a sign for personal purposes within the company, for information purposes, artistic, educational or scientific purposes, parody, satire or polemic, etc., does not fall within the monopoly of the trademark owner*”.

often contains a commercial element in the sense that the parodist derives an economic benefit from it. Consequently, use of trademarks within the freedom of expression may qualify as use in the course of trade. In light of Article 10(2) Directive and Article 9(2) Regulation, when used in the course of trade, a sign is likely to infringe a trademark right if it is exploited “*in relation to goods or services*”, hence as if it is used “as a trademark”^{14 15}.

38. The rationale behind the additional application of trademark protection even in cases that do not meet the stricter requirements of “use in the course of trade” appears to follow from the function theory. A strict limitation to a use for the purpose of indicating the origin of goods and services would only satisfy the origin function of trademark protection. The other established functions of a trademark (communication function, advertising function, investment function and quality function)¹⁶ would just exist as a hollow frame if trademark law did not acknowledge the existence of other formats of use than the denomination of origin of goods and services. EU case-law has clarified that in the assessment of trademark infringement claims, it is necessary to consider the potentially negative effects that use of a third-party mark may have on any of the **legally protected functions of a trademark**, with the consequence that, in addition to the traditional function of indication of origin, it is important to take into consideration the advertising, the investment and the communication functions.

39. The EU legislative texts (Regulation and Directive) in their preambles, on the one hand, recognize that although artistic expression typically is not use in the course of trade or use distinguishing the goods or services of the proprietor from those of others, it may well infringe trademark rights and, on the other hand, point to the general need to possibly introduce an

¹⁴ See in this regard the the Max Planck Study page 80, whereby “[t]he mark must be used as a mark, i.e. as a sign distinguishing the goods or services of the proprietor from those of others. It is therefore necessary to make a distinction between “trademark use” and other forms of use”.

¹⁵ See BOHACZEWSKI, *Conflicts Between Trademark Rights and Freedom of Expression Under EU Trademark Law: Reality or Illusion?*. IIC 51, 856-877 (2020), whereby the “use as a trademark” condition would require that the sign must be used to designate goods or services and to link them to a commercial origin by distinguishing them from other goods or services.

¹⁶ See CJEU March 23, 2020, in joined cases C-236/08-238/08, *Google France SARL and Google Inc. V Louis Vuitton Malletier SA* (C-236/08), *Google France SARL v Viaticum SA and Luteciel SARL* (C-237/08) and *Google France SARL v Centre national de recherche en relations humaines (CNRRH) SARL and Others* (C-238/08), EU:C:2010:159, paragraph 77.

exception to this infringement, not in all cases of artistic expression, but only to such artistic expressions that are fair and in accordance with honest practices in industrial and commercial matters. In other words, per the preambles, use of a trademark in art, shall not be infringing only if such use is in accordance with honest practices in industrial and commercial matters. The mere fact that use takes place in the context of art is not sufficient.

40. From all the various restrictions enumerated in Recitals 27 Directive and 21 Regulation, it is only the artistic expression and freedom of expression that are not explicitly incorporated in the legal provisions of the Directive and the Regulation:¹⁷ no mention of artistic or any other form of expression (such as political speech or criticism) is included in any of the Directive or Regulation’s legal provisions.¹⁸

Benelux Law and the interaction with European Law

41. Article 10(6) of the Directive allows the laws of Member State to provide for infringement of national marks where there is use of those marks “*other than for the purposes of distinguishing goods or services*”. Article 2.20 paragraph 2(d) Benelux Convention on Intellectual Property (see the full text of the provision reported in Annex “B”), which has been traditionally interpreted as providing that **use other than in the course of trade** may amount to trademark infringement “*where use of the sign without due cause, would take unfair advantage of or be detrimental to the distinctive character or the repute of the trademark*”, falls within Article 10(6) Directive.

¹⁷ There is no relevant wording in Article 14 “Limitation of the effects of a trademark” and all other articles of the Directive and the equivalent Article 14 “Limitation of the effects of an EU trademark” of the Regulation and all other articles of the Regulation. As mentioned above, this is a consequence of the many objections – including INTA’s – to the introduction of a specific fair use exception in this kind of cases.

¹⁸ As opposed to the US law, which provides (§ 43 (15 U.S.C. § 1125)) that: “(3) *Exclusions.—The following shall not be actionable as dilution by blurring or dilution by tarnishment under this subsection: (A) Any fair use, including a nominative or descriptive fair use, or facilitation of such fair use, of a famous mark by another person other than as a designation of source for the person’s own goods or services, including use in connection with— (i) advertising or promotion that permits consumers to compare goods or services; or (ii) identifying and parodying, criticizing, or commenting upon the famous mark owner or the goods or services of the famous mark owner* (emphasis added).(B) All forms of news reporting and news commentary. (C) Any noncommercial use of a mark”.

42. Therefore, even if the CJEU accepts that there is no trademark infringement under the Regulation for a possible lack of use in the course of trade in the case at issue, it should nonetheless take a closer look into the interpretation of Article 2.20 paragraph 2(d) Benelux Convention on Intellectual Property.

43. The CJEU has already confirmed in a case under the old trademark Directive involving these provisions of Benelux trademark law, that *“Article 5(5) of the Directive must be interpreted as meaning that a Member State may, if it sees fit, and subject to such conditions as it may determine, protect a trademark against use of a sign other than for the purposes of distinguishing goods or services, where use of that sign without due cause takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the trademark”*¹⁹. Therefore, these provisions have already been affirmed to be compatible with EU law.

Approach as regards free speech

44. The referring Court is not asking for guidance on the exemption of “due cause” as such, but only in regard to parody and free speech. The specification of its question in that regard however provides a list of eight factors which, in INTA’s view, may play a certain role in the assessment of the specifics of an individual case but fail to provide general guidance which is the purpose of proceedings under Article 267 TFEU.

45. Recitals 27 Directive/21 Regulation read: *“[f]urthermore, [this Directive]/[this Regulation] should be applied in a way that ensures **full respect for fundamental rights and freedoms, and in particular the freedom of expression**”* (emphasis added). This wording provides for applicability of the right of freedom of expression throughout the provisions (of *“this Directive”*, *“this Regulation”*), without differentiating between registrability (absolute/relative grounds) and use. This would suggest that limiting the freedom of expression to a “due cause” which is applicable only to the dilution provisions of the Directive and the Regulation would not be the appropriate means to introduce it in the context of trademark law. This right is in any case directly applicable through the ECHR and the European Charter.

¹⁹ Namely of First Council Directive 89/104/EEC of 21 December 1988. This provision is identical to the current provision of 10(6). See CJEU, November 21, 2002, case C-23/01, *Robeco v. Robelco*, EU:C:2002:706 [2002] ECR I-10913.

46. INTA submits that **freedom of expression does not automatically secure non-infringement**. The following considerations are to be taken into account when balancing the right of freedom of expression to the (intellectual) property right on trademarks.

i) Fairness: causing unnecessary harm and purpose of use

47. An important factor when balancing the right of freedom of expression to the (intellectual) property right on trademarks is fairness.

48. Indeed, the first line of Recital 27 of the Directive reads: “[t]he exclusive rights conferred by a trademark should not entitle the proprietor to prohibit the use of signs or indications by third parties which are **used fairly**” (emphasis added). Consistently, Recital 21 of the Regulation reads: “[t]he exclusive rights conferred by an EU trademark should not entitle the proprietor to prohibit the use of signs or indications by third parties **which are used fairly and thus in accordance with honest practices in industrial and commercial matters**. ... Use of a trademark by third parties for the purpose of **artistic expression** should be considered as being fair as long as it is **at the same time** in accordance with **honest practices in industrial and commercial matters**. Furthermore, this Regulation should be applied in a way that ensures full respect for fundamental rights and freedoms, and in particular the **freedom of expression**”.

49. INTA maintains that there is no reason why the above should not play a part in assessing what is “due cause” for the purposes of Article 10(6) of the Directive.

50. In this regard, INTA proposes to first look into conflicts of a similar structure as they appear under the regimes of exhaustion and/or fair (referential) use where fairness plays a key role. In particular, from the case-law of the CJEU, a potential infringer should, in any case, **avoid causing unnecessary harm** to the trademark concerned.²⁰ Such harm may arise if the

²⁰ In regard to exhaustion and the legitimate reasons of a trademark owner to oppose further commercialization the CJEU has held already in Dior/Evora that a harm to the trademark image may in general qualify for a legitimate reason to oppose further commercialization which, particularly confers a right of opposition in the case of premium

addressed public comes to the **false belief of a connection** between the user and the owner of the trademark concerned. Turning to the underlying case, INTA takes the view that providing an oral disclaimer solely on the occasion of a press conference and not – as would be feasible, necessary and appropriate – on all related written materials, ensuring thus that the waiver is displayed in connection with every use, does not satisfy the above criterion.

51. Furthermore, INTA takes the view that the distinction between parasitism and criticism serves also to distinguish between acts that take a fair advantage and those that take unfair advantage of the renown and image of the trademark concerned. The test to be applied in that regard is whether or not the use in dispute is related to the topic addressed by the user, or whether or not the specific mark was chosen arbitrarily for the sole **purpose of creating extra attraction** for and attention of the public which otherwise would not occur.

Applying this test to the factual scenario of the IKEA dispute, the title “Immigratie Kan Echt Anders” seems unnecessary, as a different title for the program of Vlaams Belang would have equally served the purpose without requiring a reference to the IKEA brand.

ii) Parody

52. With specific regard to the existence of an alleged “due cause” of parody, INTA is hesitant to fully apply the guidance from the copyright CJEU-ruling on *Deckmyn*.²¹ Firstly, parody is a legal term found within EU Copyright Law²², however not in EU Trademark Law. Secondly, under national copyright laws, parody may have the potential to in itself justify a

or luxury goods; see CJEU, November 4, 1997, case C-337/95, *Parfums Christian Dior SA and Parfums Christian Dior BV v Evora BV*, EU:C:1997:517, paragraphs 39 et. seq.

In regard to referential (fair) use, the CJEU has held already in *BMR/Deenik* that any fair use would require to avoid the false impression of a relationship between the user and the owner of the mark concerned as this would violate the general obligation to protect the interests of the owner in the course of fair trade practices; CJEU, February 23, 1999, case C-63/97, *Bayerische Motorenwerke AG (BMW) and BMW Nederland BV v Ronald Karel Deenik*, EU:C:1998 :160, paragraphs 51 and 52.

²¹ See CJEU, September 3, 2014 case C-201/13, *Johan Deckmyn and Vrijheidsfonds VZW v Helena Vandersteen and Others*, EU:C:2014:2132.

²² Article 22(1) of the Law of 30 June 1994 on copyright and related rights (Belgisch Staatsblad of 27 July 1994, p. 19297) states: “Once a work has been lawfully published, its author may not prohibit: ... 6. caricature, parody and pastiche, observing fair practice”.

restriction of copyright protection because it necessarily is directly related to the concerned copyright and because it can be attributed to an expressive use. Under trademark law however, parody may occur without any specific reason or linkage to the trademark concerned. In order to qualify as non-infringing use, parody in trademark law should therefore serve to convey a message or express an opinion which generally falls under the protection of free speech.

53. In any case, transferring the guidance from the headings of the *Deckmyn* judgment into trademark law would result in three elements to evaluate a parody-defense: firstly, it must evoke a protected trademark, secondly it must be notably different from it and thirdly it should constitute an expression of humor or mockery.

54. No doubt that for the IKEA trademark the first condition is met. However, it is already unclear if the second condition is met, namely that written material produced by Vlaams Belang is notably different. At least a relevant part of the public which notices the particular “closeness” of association with the elements of IKEA’s corporate identity may well come to the false conclusion that IKEA is cooperating with Vlaams Belang and endorses its political aims. In that regard, INTA considers that such a linkage is not only supported by the very manner in which Vlaams Belang is seeking to create a visible association with the IKEA brand, but also follows from the principles of neuroscience which teach that trademarks are often perceived and processed unconsciously.

55. As regards the third element, one may find some humor in the manner in which Vlaams Belang has presented its political proposals in the format of a DIY-manual while using the typical IKEA graphics. However, INTA is hesitant to accept this as a sufficient element of humour or mockery as it is something extra which is not directly related to the core of trademark use. The IKEA trademark itself is depicted first in an identical format and then in the second line with a new subtext. This format presents the IKEA trademark as an acronym which a larger part of the addressed public may not have been aware of. However, changing the words represented by the acronyms as such and replacing them with completely new content does not show any trace of mockery or humour. It is a usurpation for different purposes.

56. Consequently, even assuming that test set forth in the *Deckmyn* judgment for copyright cases were applicable also to trademark infringement cases, a **parody defense cannot come**

into play here since the use of the IKEA mark stems not from a “notably” different source and because the traces of humor which one may find in the design of the brochure do not extend to the use of the trademarks.

iii) Relevant Case Law

57. There would appear to be no previous CJEU case law as to what is and what is not “due cause” where there is non-commercial use.²³

58. However, some limited guidance is perhaps to be found from national law and in particular the decision of *Association Greenpeace France v SA Société Esso* [2003]. ETMR 867 (Cour d’appel de Paris). In this case Esso sought an interim injunction to prevent Greenpeace from reproducing on its website the ESSO trademark in the form E££O. The public was not misled as to who was the author of that communication and Greenpeace’s intention was to expose the activities of Esso which were said to cause harm to the environment. The French court refused to grant an injunction on the basis that to do so would be contrary to the constitutional principle of free speech.²⁴

59. This judgment is in line with the approach suggested by INTA. The Greenpeace case clearly falls into the category of criticism which might amount to “due cause” under the principle of free speech.

60. With the above in mind, INTA suggests that, if use of a mark as part of political expression may as a matter of European law be potentially prohibited by national trademark law, the relevant court should carry out an assessment of the fairness of the alleged infringer

²³ Contrast for example the analysis of due cause in *Interflora* (C-323/09) where the CJEU held that the use of keywords of competitors in online advertising so as to display advertisements to offering competing goods fell within the ambit of fair competition was not without “due cause” and was therefore permitted. See also case C-65/12 *Leidseplein Beheer BV H.J.M. de Vries* on the issue of whether there can also be due cause, within the meaning of Article 5(2) of the Trademarks Directive, in the case where the sign that is identical or similar to the trademark with a reputation was already being used in good faith by the third party or parties before that trademark was filed.

²⁴ ESSO’s case also failed at trial: [2004] ETMR. 90.

behavior, taking into account the following:

- whether the form in which the mark is being used in any way misleads the public as to who is actually using that mark, with or without consent of the trademark owner, causing an unnecessary harm to the trademark;
- whether there is a connection between the mark being used and the relevant expression. For example, where the use of the mark involves some form of criticism or comment on the activities of the trademark holder (such as in the Greenpeace/Esso case mentioned above), that use is more likely to be with “due cause”. Conversely, where there is no connection between the mark holder and the relevant speech, and the reason why the mark is being used is to take advantage of the reputation of the mark holder or is detrimental to the distinctiveness or the repute of the mark, such use would most likely be “without due cause”.

CONCLUSION

61. INTA maintains that free speech and parody might, under certain circumstances, amount to “due cause” and, as such, provide a defense to a claim of infringement, but said circumstances must be carefully circumscribed.

62. Therefore, INTA suggests that, in answering the questions referred to it, this honorable Court take into account the specific circumstances of this case, and avoid making broad statements as to what is or is not “without due cause”, which might potentially allow that parody, artistic expression, criticism and comment, *as such*, could be considered fair uses of a trademark, which would be contrary to the EU Legislator’s decision not to include them in the fair use provisions of the Regulation/Directive when the EU Trademark Reform was adopted.

63. In this respect INTA’s position is that as a matter of European law:

- national trademark law is entitled to prohibit use of a trademark in the context of political expression by a political party if it is “without due cause”, and
- the assessment of “due cause” would call for a fairness assessment taking into consideration various factors, such as: whether the alleged parodistic use is misleading as to its source and on whether there is a connection between the mark

- holder and the relevant parody. Whether there is no connection between the mark holder and the relevant speech, and the reason why the mark is being used is to take advantage of the reputation of the mark holder or is detrimental to the distinctiveness or the repute of the mark, such use would most likely be “without due cause”;
- the proposed assessment as regards freedom of speech in the context of trademark law is the following: to the extent the use occurs in the course of trade and might affect one or more trademark functions (be it the origin, the guarantee, the advertising and so on²⁵), and to the extent such use does not fall within any of the other limitations of trademark rights expressly provided in the EU legislation, INTA proposes that freedom of expression – stemming from ECHR and the European Charter – may, under certain circumstances, amount to “due cause”. However, in order to succeed in this defense, the alleged infringer would also need to claim and prove that such expressive (artistic, political and so on) use is fair and in accordance with honest practices in commercial and industrial matters. INTA proposes the above mentioned factors to be weighed by the national court in that evaluation.

64. INTA submits that parasitic use, namely use that aims at capitalizing the attraction that the reputation of a third-party mark enjoys, for own non-private interests, would not be fair and in accordance with honest practices in commercial and industrial matters. A balance between trademark rights on the one hand and the right of freedom of expression on the other, much each time be evaluated on the basis of the facts and circumstances at hand, by applying the proposed criteria. A finding in favor of one or the other right is not predetermined and should not be made *in abstracto*.

Florence, 5 September 2023

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²⁵ Per Judgment of the CJEU of 18 June 2009, Case C-487/07, L'Oréal SA v. Bellure NV., EU:C:2009:378, paragraph 58.

ANNEX A

**INTA has filed the following *amicus*-type submissions
before European courts and bodies:**

- Statement in Intervention of June 7, 2023, in case C-337/22P, *EUIPO v Nowhere*
- Letter of Submission of September 29, 2022, in case C-361/22, *Industria de Diseno Textil, S.A. (Inditex) v. Buongiorno Myalert, S.A.*,
- Letter of Submission of September 1, 2022, in case C-334/22, *Audi AG v. GQ*
- Letter of submission of January 10, 2022, in the case C-175/21, *Harman International Industries*
- Letter of submission of December 2, 2021 in the case C-472/21, *Monz Handelsgesellschaft International mbH & Co. KG vs. Büchel GmbH & Co. Fahrzeugtechnik KG*
- Letter of submission of August 16, 2021, in case C-112/21, *X BV v Classic Coach Company and Others*
- Third Party Observations on July 2, 2021 in the cases R 1613/2019-G, *Iceland Foods Limited v. Icelandic Trademark Holding ehf* and R 1238/2019-G *Iceland Foods Limited v. Islandsstofa (Promote Iceland), The Icelandic Ministry for Foreign Affairs and SA - Business Iceland*
- Letter of submission of June 28, 2021, in case C-62/21, *Leinfelder Uhren München*
- Third Party Observations on April 1, 2021 in case R 964/2020-G, *EUROMADI IBERICA, S.A./ Zorka Gerdzhikova*
- Third Party Observations on March 3, 2021 in the cases R 1719/2019-G and R 1922/2019-G, *The Estate of the Late Sonia Brownell Orwell ./ EUIPO*
- Third Party Observations on February 24, 2021 in case R 2248/2019-G, *The Estate of the Late Sonia Brownell Orwell ./ EUIPO*
- Letter of submission of December 23, 2020, in case C-421/20, *Acacia*
- Third Party Observations on December 1, 2020 in case R 1304/2020-G, *Der Grüne Punkt Duales System Deutschland GmbH ./ Halston Properties, s.r.o. GmbH*
- Letter of submission of September 28, 2020, in joined Cases C-253/20 and C-254/20, *Novartis AG v. Impexco NV and Novartis AG v. PI Pharma NV*
- Letter of submission of August 27, 2020, in joined cases C-147/20 and C-224/20, *Novartis Pharma GmbH v. Abacus Medicine A/S and Merck Sharp & Dohme B.V. et al. v. Abacus Medicine A/S et al.*
- Statement in Intervention of January 6, 2016, in case T-142/15, *DHL Express (France) v EUIPO*
- Statement in Intervention of April 25, 2014, in case C-445/13P, *Voss of Norway v OHIM*

- Written Observations of March 16, 2010, in case C-495/09, *Nokia*
- Letter of submission of August 23, 2012, in case C-252/12, *Specsavers International Healthcare Limited & others vs Asda*
- Letter of submission of September 5, 2007, in case C-252/07, *Intel Corporation*
- Letter of submission of June 12, 2007, in case C-102/07, *Adidas and adidas Benelux*
- Letter of submission of April 25, 2006, in case C-17/06, *Céline*
- Submission as intervener to the English Court of Appeals on October 16, 2006, in case *Special Effects v L'Oreal SA* (HC 05C012224, Court of Appeal 2006 0744)
- Letter of submission of June 17, 2005, in case C-108/05, *Bovemij Verzekeringen*
- Letter of submission to of December 5, 2003, in case T-133/03, *Schering-Plough v Commission and EMEA*
- Letter of submission of April 4, 2003, in case EFTA Court E-3/02, *Paranova A/S v. Merck & Co., Inc, Merck, Sharp & Dohme B. V. and MSD (Norge) A/S*
- Letter of submission of March 20, 2003, in case C-418/02, *Prakiker Bau- und Heimwerkermärkte*
- Letter of submission of November 1, 2001, in case C-283/01, *Shield Mark*
- Letter of submission of July 6, 2001, in case C-104/01, *Libertel*
- Letter of submission of October 10, 2000, in case C-143/00, *Boehringer Ingelheim and Others*

ANNEX B**Relevant Provisions****Relevant provisions of international law:**Article 10 ECHR:

'1. 1. Everyone has the right to freedom of expression. This right shall include freedom to hold opinions and to receive and impart information and ideas without interference by public authority and regardless of frontiers. ...

2. The exercise of these freedoms, since it carries with it duties and responsibilities, may be subject to such formalities, conditions, restrictions or penalties as are prescribed by law and are necessary in a democratic society, in the interests of national security, territorial integrity or public safety, for the prevention of disorder or crime, for the protection of health or morals, for the protection of the reputation or rights of others, for preventing the disclosure of information received in confidence, or for maintaining the authority and impartiality of the judiciary.

Article 11 European Charter:

1. Everyone has the right to freedom of expression. This right shall include freedom to hold opinions and to receive and impart information and ideas without interference by public authority and regardless of frontiers.

2. The freedom and pluralism of the media shall be respected.

Relevant provisions of European trademark law:European Trademark Regulation*Recital 21:*

*The exclusive rights conferred by an EU trademark should not entitle the proprietor to prohibit the use of signs or indications by third parties **which are used fairly and thus in accordance with honest practices in industrial and commercial matters.** ... Use of a trademark by third*

*parties for the purpose of **artistic expression** should be considered as being fair as long as it is **at the same time** in accordance with **honest practices in industrial and commercial matters**. Furthermore, this Regulation should be applied in a way that ensures full respect for fundamental rights and freedoms, and in particular the **freedom of expression**.*

(emphasis added)

Article 9(2):

2. ... the proprietor of that EU trademark shall be entitled to prevent all third parties not having his consent from using **in the course of trade, in relation to goods or services**, any sign where:

...

(c) the sign is identical with, or similar to, the EU trademark irrespective of whether it is used in relation to goods or services which are identical with, similar to or not similar to those for which the EU trademark is registered, where the latter has a reputation in the Union and where use of that sign **without due cause** takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the EU trademark.

(emphasis added)

European Trademark Directive

Recital 27

The language used is no different from Recital 21 of the European Trademark Regulation as set out above.

Article 10(2)(c)

The language used is no different from Article 9(2) of the European Trademark Regulation as set out above.

Article 10(6)

*Paragraphs 1, 2, 3 and 5 shall not affect provisions in any Member State relating to the protection against the use of a sign other than use for the purposes of distinguishing goods or services, where use of that sign **without due cause** takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the trademark.*

(emphasis added)

Benelux Trademark Law

Article 2.20 paragraph 2(d) Benelux Convention on Intellectual Property:

2.20 Paragraph 2:

Without prejudice to the rights of proprietors acquired before the filing date or the priority date of the registered trademark, and without prejudice to the possible application of ordinary law in matters of civil liability, the proprietor of that registered trademark shall be entitled to prevent all third parties not having his consent from using any sign where such sign:

a) -c) (.....)

*d) is used for purposes other than those of distinguishing goods or services, where use of the sign **without due cause**, would take unfair advantage of or be detrimental to the distinctive character or the repute of the trademark.*

(emphasis added)