The Trademark Reporter®

International Trademark Association

The Law Journal of the International Trademark Association

May–June, 2026 **Vol. 116 No. 3**

INTERNATIONAL TRADEMARK ASSOCIATION

733 Third Avenue, 19th Floor, Suite 1950, New York, NY 10017
Telephone: +1 (212) 642-1700 email: wknox@inta.org

OFFICERS OF THE ASSOCIATION

DEBORAH A. HAMPTON ..... *President*
MARLOU VAN DE BRAAK ..... *President-Elect*
SERGIO BARRAGAN ..... *Vice President*
DEBRA Y. HUGHES ..... *Vice President*
MICHAEL MOORE ..... *Treasurer*
PROF. DR. AXEL NORDEMANN ..... *Secretary*
RACHELLE A. DUBOW ..... *Counsel*
ETIENNE SANZ DE ACEDO ..... *Chief Executive Officer*

***The Trademark Reporter* Committee**

EDITORIAL BOARD

EDITOR-IN-CHIEF, CHAIR
ANDREW J. GRAY

STAFF EDITOR-IN-CHIEF
WILLARD KNOX

VICE CHAIR
KAREN L. ELBURG

Senior Editors

LESLEY MCCALL GROSSBERG
VERENA VON BOMHARD
DÉSIRÉE FIELDS
BARRY R. HORWITZ
MANAVI JAIN
TYLER HALL

Managing Director, Legal Resources
LIZ HANELLIN

Senior Staff Editor
BEVERLY HARRIS

Senior Staff Editor
ELIZABETH VENTURO

Editor-in-Chief, Practice Guides and Legal Resources
ROSEMARY DESTEFANO

Compositor
BARBARA MOTTER

Editors

DR. JUSTIN ANDERSON
DOUG BANIA
DANIEL R. BERESKIN, CM, KC
KATHLEEN E. BRENNAN
ALESSIO BROTTO
LANNING G. BRYER
EMILIA F. CANNELLA
STEPHANIE CHILD, PHD
THEODORE H. DAVIS JR.
DERRICK DAVIS
ALESSANDRA LORENZA DEIORIO
MICHAEL S. DENNISTON
LISBETH DEPYPERE
JOE DOYLE-WARD
ANDREAS EBERT-WEIDENFELLER
CLAIRE HAGAN ELLER
J. KEVIN FEE
REED E. FRYAR CLANCY
MARY GRACE GALLAGHER
REBECCAH GAN
VERA GLONINA
TAYLAR E. GREEN
STUART GREEN
JORDI GÜELL
CHEZANNE HAIGH
MATTHEW HARTZLER
JOHN C. HEINBOCKEL
DANIEL S. HESS
JENNIFER INSLEY-PRUITT
DR. BRUCE ISAACSON
RÉMI JAFFRÉ
ELISABETH KASZNAR FEKETE
ANDREA CARLO KLEIN
STEVEN E. LAURIDSEN
ERAN LISS
STEPHEN D. LOTT
BRYCE J. MAYNARD
J. THOMAS MCCARTHY
MELVIN MEI
RANDY MICHELS
GLENN MITCHELL
AISHA O. OTORI
NEAL ROBERT PLATT
GREG M. POPOWITZ
CRISTÓBAL PORZIO
OMESH PURI
DR. RAJ SACHDEV
LEIGHA R. SANTORO
DANIEL I. SCHLOSS
TOM SCOURFIELD
BRIAN SOWERS
KELU SULLIVAN
SAMANTHA SIEW THOMAS
RYAN M. VAN OLST
TOM VANDERBLOEMEN
VERENA VON BOMHARD
JOHN L. WELCH
DRAEKE H. WESEMAN
BRYAN WHEELOCK
HEALEY WHITSETT
AMELIA WIDJAJA
LAILA SENGUPTA WOLFGRAM
LINDA XU

Advisory Board

WILLIAM M. BORCHARD
LANNING G. BRYER
JESSICA ELLIOTT CARDON
PAMELA CHESTEK
SANDRA EDELMAN
ANTHONY L. FLETCHER
ROBERT M. KUNSTADT
THEODORE C. MAX
KATHLEEN E. MCCARTHY
GLENN MITCHELL
JONATHAN E. MOSKIN
JOHN B. PEGRAM
ROBERT L. RASKOPF
PASQUALE A. RAZZANO
PIER LUIGI RONCAGLIA
HOWARD SHIRE
RAFFI V. ZEROUNIAN

The Trademark Reporter (TMR) is published by the International Trademark Association (INTA). Views expressed in the TMR are those of the authors and do not necessarily reflect the views of INTA, its members, leadership, or staff, or of the TMR's Editorial Board.

Publication does not imply endorsement by INTA, its members, leadership, or staff, or by the TMR's Editorial Board.

The TMR (ISSN 0041-056X) is published electronically six times a year by INTA, 733 Third Avenue, 19th Floor, Suite 1950, New York, NY 10017 USA. INTA, the INTA logo, INTERNATIONAL TRADEMARK ASSOCIATION, THE TRADEMARK REPORTER, and inta.org are trademarks, service marks, and/or registered trademarks of the International Trademark Association in the United States and certain other jurisdictions.

The Trademark Reporter®

(USPS 636-080)

Vol. 116 May–June, 2026 No. 3

TABLE OF CONTENTS

This issue of *The Trademark Reporter* (TMR) should be cited as 116 Trademark Rep. __ (2026).

The Trademark Reporter®

BRANDS AS SPEECH, SPEECH AS BRANDS: MAPPING THE TWO-WAY STREET BETWEEN TRADEMARK LAW AND FREEDOM OF EXPRESSION*

*By Alvaro Fernandez-Mora***[1]

TABLE OF CONTENTS

---

* This article should be cited as Alvaro Fernandez-Mora, *Brands as Speech, Speech as Brands: Mapping the Two-Way Street Between Trademark Law and Freedom of Expression*, 116 Trademark Rep. 501 (2026).

** Lecturer in Intellectual Property Law, King's College London; Member, King's Information and Intellectual Property Hub (KiiPH); DPhil (Oxford); LLM (Harvard).

1 Thanks to Tanya Aplin, Eden Sarid, and Marta Arisi for their comments at KiiPH's 2025 research seminar; and Graeme Dinwoodie, Dev Gangjee, and Jonathan Griffiths for their feedback on earlier versions of this work. I am also grateful to the anonymous reviewers.

ABSTRACT

Trademarks today serve as more than source identifiers and quality signalers. They are important expressive artifacts through which individuals pursue their identity and self-expression. This development has given rise to a greater focus on free speech considerations in trademark law in both the United States and Europe. Yet judicial decisions and academic writings addressing the intersection of trademarks and free speech are numerous and inconsistent, producing confusion and uncertainty.

This article contends that the prevailing approach to the interaction between trademarks and speech is hindered by an incomplete conceptualization of their relationship, for two reasons. First, courts typically treat freedom of expression as a limiting constraint on trademark rights and fail to recognize its dual role in validating and not only limiting them. Acknowledging this duality allows reconceptualizing the interaction between trademarks and freedom of expression as competing forms of speech. Second, the prevailing approach fails to account for the diversity of expressive users of trademarks in the contemporary marketplace, with the result that adjudication tends to consider only one category of expressive users at a time and overlooks other expressive interests deserving of constitutional protection.

To bridge these gaps, this article: (a) proposes a typology of expressive users of trademarks and (b) shows how accounting for this diversity in trademark litigation can produce better balanced, more consistent outcomes. This is a worthwhile endeavor that will result in greater doctrinal clarity and more faithful enforcement of human rights guarantees in trademark disputes.

INTRODUCTION

Trademarks have evolved in recent decades from devices that identify a commercial source into vehicles that convey quality, reputation, and complex meanings that individuals can rely upon for expressive purposes.[2] The expansion of trademarks' expressive

---

[2] Trademarks' ability to perform functions beyond source-signaling has been widely acknowledged by courts and commentators on both sides of the Atlantic. *See*, in the United States: Mattel, Inc. v. MCA Records, Inc., 296 F.3d 894, 900 (9th Cir. 2002); Alex Kozinski, *Trademarks Unplugged*, 68 N.Y.U. L. Rev. 960, 977-78 (1993); Jerre B. Swann Sr., David A. Aaker & Matt Reback, *Trademarks and Marketing*, 91 Trademark Rep. 787, 799 (2001); Rochelle Cooper Dreyfuss, *Expressive Genericity: Trademarks as Language In the Pepsi Generation*, 65 Notre Dame L. Rev. 397, 397-98 (1990). In Europe, the recognition that marks can perform additional functions to that of origin is often framed within the broader debate on the "functions theory" as developed by the Court of Justice of the European Union ("CJEU") in, inter alia, Case C-487/07, L'Oréal SA v. Bellure NV, ECLI:EU:C:2009:378 (June 18, 2009). *See also*, Annette Kur, *Trade Marks Function, Don't They? CJEU Jurisprudence and Unfair Competition Principles*, 45 Int'l Rev. Intell. Prop. & Competition L. 434 (2014); Lisa P. Ramsey & Jens Schovsbo, *Mechanisms for Limiting Trade Mark Rights to Further Competition and Free Speech*,

capabilities has brought new opportunities and challenges to trademark law, and courts in the United States and Europe have been grappling with how trademarks and freedom of expression should be balanced.[3] The resulting body of case law and scholarship, particularly voluminous in the United States, has produced a cacophony of competing voices, approaches, and conceptual frameworks, and a corresponding inconsistency in outcomes that has left the field riddled with uncertainty.[4] This comes at a time when expressive uses of marks are on the rise.

I suggest that much of this confusion stems from an incomplete conceptualization of the relationship between trademarks and free speech. There are two ways in which our prevailing understanding of this interaction is incomplete.

First, courts hearing *interaction cases* (i.e., cases in which one of the parties invokes freedom of speech either to limit or to validate trademark rights) on both sides of the Atlantic tend to treat such disputes as unidirectional. In so doing, they advance the speech interests of one subset of *expressive users* (i.e., individuals who make use of a trademark to communicate a message beyond, or in addition to, commercial source) at a time, depending on the type of litigation.

---

44 Int'l Rev. Intell. Prop. & Competition L. 671 (2013); Dev S. Gangjee, *Property in Brands*, *in* Property Concepts in Intellectual Property Law 29 (Helena Howe & Jonathan Griffiths eds., 2013); Tobias Cohen Jehoram, *The Function Theory in European Trade Mark Law and the Holistic Approach of the CJEU*, 102 Trademark Rep. 1243 (2012); Alvaro Fernandez-Mora, *Trade Mark Functions in Business Practice: Mapping the Law Through the Search for Economic Content*, 52 Int'l Rev. Intell. Prop. & Competition L. 1370 (2021).

3 The volume of case law and literature addressing this topic is overwhelming, especially in the United States. Relevant sources will be cited systematically to facilitate the readers' task of locating sources.

4 *In Re* Tam, 808 F.3d 1321, 1341-42 (Fed. Cir. 2015); Stacey L. Dogan & Mark A. Lemley, *Parody as Brand*, 105 Trademark Rep. 1177, 1178 (2015); Andreas Rahmatian, *Trade Marks and Human Rights, in Intellectual Property & Human Rights*, 352-53 (Paul Torremans ed., 2008); Dima Basma, *Trade Mark Protection Versus Freedom of Expression: Towards an Expressive Use Defence in European Trade Mark Law*, 3 Intell. Prop. Q. 206, 226 (2021); Sabine Jacques, *The EU Trade Mark System's Lost Sense of Humour*, 1 Intell. Prop. Q. 1, 26 (2024); Sonia K. Katyal, *Brands Behaving Badly*, 109 Trademark Rep. 819, 822 (2019); Anne Gilson LaLonde & Jerome Gilson, *Trademarks Laid Bare: Marks That May Be Scandalous or Immoral*, 101 Trademark Rep. 1476, 1515, 1528 (2011) (reprinted with permission from Matthew Bender & Company, Inc., a member of the LexisNexis Group); Jennifer S. Davis & Łukasz Żelechowski, *Bad Faith, Public Policy and Morality: How Open Concepts Shape Trade Mark Protection*, 54 Int'l Rev. Intell. Prop. & Competition L. 859, 881 (2023); Martin Senftleben, *Robustness Check: Evaluating and Strengthening Artistic Use Defences in EU Trademark Law*, 53 Int'l Rev. Intell. Prop. & Competition L. 567, 580 (2022); Alvaro Fernandez-Mora, *Inconsistencies in European Trade Mark Law: The Public Policy and Morality Exclusions*, 4 Intell. Prop. Q. 271 (2020).

U.S. and European case law reflect three recurring forms of interaction:[5]

i. In *infringement* cases, defendants can invoke free speech to shield their unauthorized use of the plaintiff's *recoded* mark (i.e., a modified version of the mark—by removing, replacing, and/or adding material—to imbue it with new meaning) for expressive purposes.[6]

ii. In *registration* cases, unsuccessful applicants rely on free speech to challenge refusals. In the United States, this has led to the provisions relating to immoral, disparaging, and scandalous marks being struck down from the Lanham Act, while in the EU signs that are contrary to public policy or morality continue to be refused.[7]

iii. In *brand restriction* cases, trademark owners invoke free speech to strike down measures that restrict trademark use in relation to goods posing a risk to public health, such as plain packaging rules or mandatory health warnings for tobacco products.[8]

A review of U.S. and European case law reveals that, in infringement litigation, courts have considered solely the expressive interests of defendants when assessing whether unauthorized recoded uses of trademarks are compatible with plaintiffs' exclusive rights. By contrast, in cases where applicants or owners invoke freedom of expression to obtain or maintain trademark rights, the analysis has been limited to their respective expressive interests. The recognition of applicants' or owners' free speech has not permeated to the infringement context, nor are defendants' expressive interests factored into registration or brand restriction cases. In previous work, I relied on this finding to suggest that courts should move away from this unidirectional approach and instead understand the interaction as a two-way street, where speech can simultaneously limit and validate trademark rights.[9]

---

5 Alvaro Fernandez-Mora, *A Counterintuitive Approach to the Interaction Between Trademarks and Freedom of Expression in the US and Europe: A Two-Way Relationship*, 39.2 Berkeley J. Int'l L. 293, 327-344 (2021).

6 *See* case law cited in note 31 *infra*. The term "recoding" as used in intellectual property literature is drawn from the cultural-studies scholarship of Rosemary Coombe, who used it to describe the practices by which individuals and communities appropriate and rework the meanings of commercial signs—including trademarks—to express identities, values and political commitments that diverge from those intended by the rightsholder. Rosemary J. Coombe, *Objects of Property and Subjects to Politics: Intellectual Property Laws and Democratic Dialogue*, 69 Texas L. Rev. 1853 (1991). *See also* Justin Hughes, "'Recoding" Intellectual Property and Overlooked Audience Interests' [1999] 77 Texas L. Rev. 923.

7 *See* case law cited in note 37 *infra*.

8 *See* case law cited in note 41 *infra*.

9 Fernandez-Mora, *supra* note 5.

Applying this view, trademark disputes are better reconceptualized as *competing forms of speech*.

Second, courts fail to account for the diversity of expressive users of trademarks in today's marketplace. Decision makers in interaction cases have not simply overlooked the expressive interests of defendants, applicants, and rightsholders, but also those of additional expressive users of trademarks. This is surprising given the widespread recognition that trademarks are routinely used expressively by a wider range of users to communicate who they are and what they stand for.[10]

This article bridges that gap by proposing a typology of expressive users of marks comprising five categories: (a) *trademark owners*, who express themselves through use of their marks in relation to goods and services; (b) *consumers of branded goods*, who communicate their values through everyday acts of consumption; (c) *recoders*, who use recoded versions of marks for expressive purposes; (d) *consumers of goods bearing recoded marks*, who, in turn, use those marks to communicate their worldview; and (e) the *public*, who employ marks that have permeated language, art, and culture more broadly in their everyday conversations and creative endeavors.

The article then draws on this typology to explore how recognizing the full range of expressive interests at stake can enrich our analysis of interaction cases. In infringement litigation, the rebalancing draws in the expressive interests of all users implicated in recoding disputes (not merely the defendant's), and from this proposes a theory of (expressive) harm that can assist courts in defining the scope of protection afforded to trademarks with greater precision. In registration and brand restriction cases, the rebalancing exercise requires decision-makers to reckon with the expressive interests of users beyond applicants and rightsholders—including, notably, the reinforced protection owed to political and artistic speech where applicants seek to reclaim offensive signs through registration, or where brand restriction measures erode meanings on which a wide range of individuals rely for self-expression. The payoff is twofold: clearer, more consistent adjudication, and stronger protection of human rights guarantees in trademark disputes.

This article is structured in three parts. Part I examines the expressive function of trademarks and offers an overview of the three forms of interaction between marks and speech, drawing out

---

[10] This is particularly the case in relation to the categories of expressive users of marks that I term consumers of branded goods and the public in Part II *infra*. Evidence of courts and scholars' engagement with these types of expressive users of marks can be found in, inter alia, notes 25–30 *infra*, as well as in Part III *infra* (upon discussion of the monolithic approach to the concept of the expressive user in existing literature and case law, *see* notes 72-73 and accompanying text *infra*).

the lessons that may be extracted from this diversity. Part II proposes the typology of expressive users of marks, going beyond those identified to date in the case law and literature. Part III considers how taking account of this diversity can enhance our understanding of interaction cases and support improved adjudication in this area of law. Concluding remarks follow.

PART I. THE INTERACTION BETWEEN TRADEMARKS AND SPEECH

A. Trademarks as Expressive Artifacts

Trademarks are signs. Signs, in turn, convey information and, through their use, enable communication between two or more people. The words that I am typing right now are signs that allow me to communicate with you, the reader. The same is true of trademarks: they convey information and, through their use, enable communication in the marketplace and in society at large.

The fundamental information conveyed by a trademark is, naturally, the commercial origin of goods or services.[11] For instance, the LOUIS VUITTON mark denotes a particular commercial origin: Louis Vuitton Malletier S.A. Used in the course of trade, it allows its owner to distinguish its high-end trunks, leather goods, and ready-to-wear clothing from those of its competitors. Yet contemporary trademarks can also convey a wide range of meanings beyond indicating origin, ranging from signals about quality or reputation—what trademark law has long captured under goodwill—to lifestyle preferences or values on which individuals can rely for expressive purposes.[12] The LOUIS VUITTON mark and its iconic interlocking "LV" monogram are rich with these additional meanings: they are associated with heritage, craftsmanship, luxury, and a long tradition of travel and adventure dating back to the founding of the house as a Parisian trunk-maker in 1854.[13] Over time, the brand has come to symbolize a set of values centered on

---

[11] Hanover Star Milling Co. v. Metcalf, 240 U.S. 403, 412 (1916); Robert C. Denicola, *Trademarks as Speech: Constitutional Implications of the Emerging Rationales for the Protection of Trade Symbols*, 2 Wis. L. Rev. 158, 158-59 (1982); Keith Aoki, *How the World Dreams Itself to Be American: Reflections on the Relationship between the Expanding Scope of Trademark Protection and Free Speech Norms*, 17 Loy. L.A. Ent. L. Rev. 523, 531 (1997).

[12] For further exploration of the range of functions performed by trademarks in the contemporary marketplace, *see* note 2 *supra*.

[13] An overview of Louis Vuitton's history can be found on its website, https://uk.louisvuitton.com/eng-gb/magazine/articles/a-legendary-history (last visited Apr. 29, 2026). *See also*, discussing the brand's strong connection to travel and adventure, Jean-Noël Kapferer & Vincent Bastien, The Luxury Strategy: Break the Rules of Marketing to Build Luxury Brands 269 (2d ed. 2012).

exclusivity, refinement, and the signaling of affluence.[14] Because these added meanings provide consumers with a wealth of useful information about the goods to which marks are affixed, they are extremely valuable to rightsholders.[15] Indeed, firms are often willing to devote vast resources to develop and maintain them, typically through costly promotional activities and carefully curated distribution channels.[16]

How can signs, including trademarks, develop such complex meanings? The meaning of a sign emerges from social consensus: individuals collectively agree that sign "x" will carry meaning "y."[17] The word "sea," for instance, symbolizes the "expanse of salt water that covers most of the earth's surface and surrounds its land masses" only insofar as English speakers have agreed as much.[18] There is no necessary correlation between the word and that meaning—their relationship is one of social convention, and therefore arbitrary. Because social consensus is not static, the meanings of signs are subject to constant transformation.[19] Until the late nineteenth century, for instance, "queer" functioned solely as an adjective meaning "strange" or "odd."[20] It subsequently acquired an additional, offensive meaning as a noun referring to a gay man. By the late 1980s, however, efforts within the gay community to reclaim the term led to the gradual loss of its negative connotations and an expansion of its meaning to encompass broader notions of sexuality and gender identity beyond cisgender,

---

14 The ability of the LOUIS VUITTON marks to convey this diverse range of meanings is explored in further detail in Part II *infra*.

15 Swann et al. have described in very persuasive terms the diverse ways in which the additional meanings conveyed by contemporary brands serve rightsholders' interests. In their own words: "For their owners, therefore, strong brands are far more than a simple 'investment.' Rather, as a consequence of their bond with consumers, they: (i) allow access to consumers' minds; (ii) make advertising less expensive or more impactful (or both); (iii) enable a manufacturer to communicate more directly with a consumer, cushioning any vagaries of distribution; (iv) assist in attaining channel power; (v) provide a more efficient and credible means of extending into related goods, and give rise to licensing opportunities; (vi) serve as certificates of 'authenticity'; (vii) afford resilience; and (viii) constitute an asset-brand equity that is frequently a company's most valuable single property." Swann, *supra* note 2, at 807.

16 Reza Motameni & Manuchehr Shahrokhi, *Brand equity valuation: a global perspective*, 7 J. of Prod. & Brand Mgmt. 275, 275 (1998); Jerre B. Swann, *An Interdisciplinary Approach to Brand Strength*, 96 Trademark Rep. 943, 957, 969 (2006). This has also been acknowledged by the U.S. Supreme Court in Matal v. Tam, 582 U.S. 218, 239 (2017).

17 *See*, discussing Saussure's view on the arbitrariness of meaning in symbols, Barton Beebe, *The Semiotic Analysis of Trademark Law*, 51 U.C.L.A. L. Rev. 621, 634 (2004) (quoting Ferdinand De Saussure, Course in General Linguistics, 74 (Charles Bally & Albert Sechehaye eds., Roy Harris trans. 1990) (1916)).

18 *Oxford English Dictionary*, www.oxforddictionaries.com (last visited Apr. 9, 2026).

19 Douglas Raber & John M. Budd, *Information as sign: semiotics and information science*, 59,5 J. of Documentation 507, 512 (2003); Megan Richardson, *Trade Marks and Language*, 26 Syd. L. Rev. 193, 200 (2004).

20 *Oxford English Dictionary*, *supra* note 18.

heterosexual norms.[21] Today, the meaning conveyed by "queer" shifts depending on context.

The same is true of trademarks. Their meanings may evolve over time depending on how they are used.[22] Returning to the previous example, the LOUIS VUITTON mark performs a source-identifying function when it is used to differentiate goods originating from the French house Louis Vuitton Malletier S.A. from those of its Italian competitor Prada S.p.A., marketed under the PRADA mark. Trademarks also perform an advertising function when they are used to "convey[] a particular image to the . . . consumer of the goods or services in question."[23] For instance, Louis Vuitton may use its "LV" monogram in campaigns shot by leading photographers and featuring high-profile public figures in evocative travel settings, conveying an image of timeless elegance, refinement, and international sophistication.[24] And marks perform an expressive function when they are used to express allegiance to a certain idea, value, or lifestyle.[25] Thus, the LOUIS VUITTON mark performs an expressive function when consumers who identify with values of luxury, status, and refined taste wear LOUIS VUITTON–branded goods in order to express their adherence to such values—and, in many cases, their membership in a community defined by access to objects whose acquisition is itself a marker of cultural and social capital. The capacity of trademark meaning to evolve is not new. The same social-convention basis that allows marks to acquire

---

21 *Id*.

22 Jason Bosland, *The Culture of Trade Marks: An Alternative Cultural Theory Perspective*, 10 Media & Arts L. Rev. 99, 108 (2005); Deven R. Desai, *From Trademarks to Brands*, 64 Fla. L. Rev. 981, 986,1041-42; Gangjee, *supra* note 2, at 58.

23 Datacard Corp. v. Eagle Technologies Ltd., [2011] EWHC 244 Pat [272] (emphasis omitted). At EU level, the CJEU has defined the advertising function of marks as "that of using a mark for advertising purposes designed to inform and persuade consumers." Case C-129/17, Mitsubishi Shoji Kaisha Ltd. v. Duma Forklifts NV, ECLI:EU:C:2018:594, ¶ 37 (July 25, 2018). *See also* Joined Cases C-236/08 to C-238/08, Google France SARL v. Louis Vuitton Malletier SA, ECLI:EU:C:2010:159, ¶¶ 91-92 (Mar. 23, 2010). According to Fhima, "contemporary trade marks . . . have a wider range of functions. In particular, their use in advertising allows their owners to build a reputation and image around the mark." Ilanah Simon Fhima, *Trade Marks and Free Speech*, 44 Int'l Rev. Intell. Prop. & Competition L. 293, 293 (2013).

24 Examples of such campaigns include: Rafael Nadal and Roger Federer's mountain expedition captured by Anne Leibovitz, https://uk.louisvuitton.com/eng-gb/stories/core-values-campaign (last visited Apr. 29, 2026); or the evocative campaign "Towards a Dream," captured by Viviane Sassen across different countries and landscapes, https://uk.louisvuitton.com/eng-gb/magazine/articles/towards-a-dream (last visited Apr. 29, 2026).

25 Michael Spence, *The Mark as Expression/The Mark as Property*, 58 Current Legal Problems 491, 504 (2005) ("[There is] a recognition that a mark is a form of speech. Trade mark owners work hard to ensure that their mark communicates, not only the trade origin of goods, but also a whole range of associated values."); Marco Ricolfi, *Trademarks and Human Rights*, *in* Intellectual Property & Human Rights, at 470 (Paul Torremans ed., 3d ed. 2015).

expressive associations also underpins genericide, whereby a mark loses its source-identifying capacity through common use and comes to denote the product category itself. Both phenomena reflect the capacity of marks to acquire—and shed—meanings through patterns of social use.

That trademarks can perform an expressive function has been widely acknowledged by courts and commentators.[26] Dreyfuss, for example, famously argued as early as 1990 that "ideograms that once functioned solely as signals denoting the source, origin, and quality of goods, have become . . . indicators of the status, preferences, and aspirations of those who use them. Some trademarks have worked their way into the English language; others provide bases for vibrant, evocative metaphors."[27] McGeveran similarly observes that "[m]any uses of trademarks in today's culture go far beyond the boundaries of . . . commerc[e] . . . They can involve political expression, artistic works, parodies, or criticism."[28] Richardson has advanced that "[n]ow trade marks do more than 'sell' goods and services, let alone distinguish their 'origin' . . . Like them or not, trade marks tell stories. Their expressiveness is the basis of commercial activity."[29] In its landmark decision in *Tam*, the United States Supreme Court held that "trademarks often have an expressive content. Companies spend huge amounts to create and publicize trademarks that convey a message. It is true that the necessary brevity of trademarks limits what they can say. But powerful messages can sometimes be conveyed in just a few words. Trademarks are . . . speech."[30]

B. Rethinking the Interaction Between Trademarks and Speech: Two Counterintuitive Suggestions

The above examples illustrate just how widespread the consensus is that trademarks can convey expressive meaning. Their expressive capabilities give rise to unprecedented challenges for trademark law, as a growing range of expressive users seek to invoke the protection afforded by the fundamental right to freedom of expression in trademark litigation. As briefly explained in the Introduction, three different scenarios in which trademark rights and speech rights interact can be identified.

---

26 Mattel, Inc. v. MCA Records, Inc., 296 F.3d 894, 900 (9th Cir. 2002) ("[T]rademarks [can] transcend their identifying purpose. Some trademarks enter our public discourse and become an integral part of our vocabulary."); Kozinski, *supra* note 2, at 966; Jacques, *supra* note 4, at 3; Dogan & Lemley, *supra* note 4, at 1196.

27 Dreyfuss, *supra* note 2, at 397 (citations omitted).

28 William McGeveran, *Four Free Speech Goals for Trademark Law*, 18 Fordham Intell. Prop. Media & Ent. L.J. 1205, 1211 (2008) (citations omitted).

29 Richardson, *supra* note 19, at 196.

30 Matal v. Tam, 582 U.S. 218, 239 (2017).

First, in infringement litigation involving the unauthorized use of recoded marks for expressive purposes (typically parody or commentary),[31] a defendant's appeal to freedom of expression often leads courts to balance the owner's proprietary interests against the defendant's speech interests.[32] In such cases, freedom of speech operates as a defense to the exclusive rights granted to trademark owners,[33] shielding many unauthorized expressive uses from

---

[31] A comprehensive list of infringement cases would be overwhelmingly long. Relevant examples include, in the United States: Punchbowl, Inc. v. AJ Press, Inc., 90 F.4th 1022 (9th Cir. 2024); Jack Daniel's Props., Inc. v. VIP Prods. LLC, 599 U.S. 140 (2023); Ebony Media Operations LLC v. Univision Commc'ns Inc., No. 18-cv-11434-AKH, 2019 WL 8405265 (S.D.N.Y. June 3, 2019); Louis Vuitton Malletier, S.A. v. My Other Bag, Inc., 156 F. Supp. 3d 425 (S.D.N.Y. 2016); Univ. of Ala. Bd. of Trs. v. New Life Art, Inc., 683 F.3d 1266 (11th Cir. 2012); Starbucks Corp. v. Wolfe's Borough Coffee, Inc., 588 F.3d 97 (2d Cir. 2009); Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC, 507 F.3d 252 (4th Cir. 2007); Tommy Hilfiger Licensing, Inc. v. Nature Labs, LLC, 221 F. Supp. 2d 410 (S.D.N.Y. 2002); Planned Parenthood Fed'n of Am., Inc. v. Bucci, 42 U.S.P.Q.2d (BNA) 1430 (S.D.N.Y. 1997); Dr. Seuss Enters., L.P. v. Penguin Books USA, Inc., 109 F.3d 1394 (9th Cir. 1997); Hormel Foods Corp. v. Jim Henson Prods., Inc., 73 F.3d 497 (2d Cir. 1996); Anheuser-Busch, Inc. v. Balducci Publ'ns, 28 F.3d 769 (8th Cir. 1994); Hard Rock Cafe Licensing Corp. v. Pac. Graphics, Inc., 776 F. Supp. 1454 (W.D. Wash. 1991); Cliffs Notes, Inc. v. Bantam Doubleday Dell Publ'g Grp., Inc., 886 F.2d 490 (2d Cir. 1989); Rogers v. Grimaldi, 875 F.2d 994 (2d Cir. 1989); Mut. of Omaha Ins. Co. v. Novak, 836 F.2d 397 (8th Cir. 1987); L.L. Bean Inc. v. Drake Publishers, Inc., 811 F.2d 26 (1st Cir. 1987); Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd., 604 F.2d 200 (2d Cir. 1979); Gucci Shops, Inc. v. R. H. Macy & Co., 446 F. Supp. 838 (S.D.N.Y. 1977); Coca-Cola Co. v. Gemini Rising, Inc., 346 F. Supp. 1183, 1193 (E.D.N.Y. 1972). In Europe: Cour d'Appel [CA] Paris, 4 ch., Nov. 16, 2005, 04/12417 (Fr.) (for an English translation, *see* Esso Plc v. Greenpeace France, [2006] E.T.M.R. 53); Cour d'Appel [CA] Paris, 14 ch., Feb. 26, 2003, 02/16307 (Fr.) (for an English translation, *see* Association Greenpeace France v. SA Société ESSO, [2003] E.T.M.R. 66); Tribunal de grande instance [TGI] Paris, May 14, 2001, 01/55088 (Fr.) (for an English translation, *see* Société Gervais Danone v. Société Le Réseau Voltaire, [2003] E.T.M.R. 26); Ate My Heart Inc. v. Mind Candy Ltd. [2011] EWHC 2741 (Ch); Miss World Ltd. v. Channel 4 Television Corp. [2007] EWHC 982 (Pat); Rb.'s-Gravenhage 4 mei 2011, NJF 2011, 264 (Nadia Plesner Joensen/Louis Vuitton Malletier SA) (Neth.); Bundesgerichtshof [BGH] [Federal Court of Justice] Apr. 7, 2005, NJW 2856 (2005) (Ger.) (for an English translation, *see Violet Postcard*, 38 Int'l Rev. of Intell. Prop. & Competition L. 119 (2007)).

[32] Jonathan Moskin, *Frankenlaw: The Supreme Court's Fair and Balanced Look at Fair Use*, 95 Trademark Rep. 848, 871 (2005) ("[C]ourts have employed a balancing approach, weighing fair use concerns and First Amendment rights of expression, on the one hand, against the trademark owner's claimed proprietary interests—at least for some parodic fair use cases.") (citations omitted). *See also* case law cited in note 33 *infra*.

[33] The ability of freedom of speech to insulate defendants' unauthorized use of marks for expressive purposes has been explicitly recognized by U.S. and European courts on numerous occasions. *See, e.g.*, in the United States: Yankee Publ'g Inc. v. News Am. Publ'g Inc., 809 F. Supp. 267, 275-76 (S.D.N.Y. 1992); Mut. of Omaha Ins. Co. v. Novak, 648 F. Supp. 905, 911 (D. Neb. 1986); Reddy Commc'ns, Inc. v. Env't Action Found., Inc., 199 U.S.P.Q. (BNA) 630, 634 (D.D.C. 1977); Cliffs Notes, Inc. v. Bantam Doubleday Dell Publ'g Grp., Inc., 886 F.2d 490, 494 (2d Cir. 1989); Rogers v. Grimaldi, 875 F.2d 994, 999 (2d Cir. 1989); Planned Parenthood Fed'n of Am., Inc. v. Bucci, 42 U.S.P.Q.2d (BNA) 1430, 1440 (S.D.N.Y. 1997); Anheuser-Busch, Inc. v. Balducci Publ'ns, 28 F.3d 769, 776 (8th Cir. 1994); Mattel, Inc. v. MCA Recs., Inc., 296 F.3d 894, 906 (9th Cir. 2002). In Europe: Bundesgerichtshof [BGH] Apr. 7, 2005, NJW 2856 (2005) (Ger.) (in English: *Violet Postcard*, *supra* note 29, at 121 (2007)); Rb.'s-Gravenhage 4 mei 2011, NJF 2011, 264 (Nadia Plesner Joensen/Louis Vuitton Malletier SA) (Neth.), para. 4.6; Cour d'Appel

liability.[34] Challenging the conventional wisdom that defendants rarely succeed in U.S. courts, McGeveran observed in 2015 that "plausible claims of parody almost always prevail over trademark rights in judicial rulings."[35] Whether this remains the case is now an open question following the Supreme Court's recent decision in *Jack Daniel's*, which has narrowed the protective reach of the First Amendment where defendants use recoded marks for source-identifying purposes, even if the use is also expressive in nature.[36]

Second, in recent years, refusals to register signs on the statutory ground that they are immoral, disparaging, or scandalous (in the United States), or contrary to public policy or morality (in Europe), have increasingly been challenged on the basis that they violate the applicants' speech rights, with varying success.[37] In the United States, this line of argument has been remarkably successful. In *Matal* and *Brunetti*, the Supreme Court struck down the Lanham Act's bars on the registration of disparaging, immoral, and scandalous marks as impermissibly viewpoint-based restrictions on speech, significantly expanding the range of signs eligible for federal registration.[38] The position in Europe is markedly different. In *Constantin Film Produktion*, the Court of

---

[CA] Paris, 4 ch., Nov. 16, 2005, 04/12417 (Fr.) (for an English translation, see Esso Plc v. Greenpeace France, [2006] E.T.M.R. 53).

34 William McGeveran, *The Imaginary Trademark Parody Crisis (and the Real One)*, 90 Wash. L. Rev. 713 (2015); Sonia K. Katyal, *Trademark Cosmopolitanism*, 47 U.C. Davis L. Rev. 875, 927 (2013). See, in slightly less positive terms, Dogan & Lemley, *supra* note 4, at 1194.

35 McGeveran, *supra* note 34, at 713.

36 Jack Daniel's Props., Inc. v. VIP Prods. LLC, 599 U.S. 140 (2023).

37 In the United States: Iancu v. Brunetti, 588 U.S. 388 (2019); Matal v. Tam, 582 U.S. 218 (2017); Pro-Football, Inc. v. Blackhorse, 112 F. Supp. 3d 439 (E.D. Va. 2015); *In Re* Fox, 702 F.3d 633 (Fed. Cir. 2012); *In re* Boulevard Entertainment, Inc., 334 F.3d 1336 (Fed. Cir. 2003); Pro-Football, Inc. v. Harjo, 57 U.S.P.Q.2d 1140 (D.D.C. 2000); Ritchie v. Simpson, 170 F.3d 1092 (Fed. Cir. 1999); Harjo v. Pro Football, Inc., 30 U.S.P.Q.2d 1828 (T.T.A.B. 1994); *In re* Mavety Media Grp. Ltd., 33 F.3d 1367 (Fed. Cir. 1994); *In re* McGinley, 660 F.2d 481 (C.C.P.A. 1981). In Europe: R 260/2021-G, Application of Matthias Zirnsack (COVIDIOT) (May 16, 2024); R 1364/2022-5, Application of Escobar Inc. (PABLO ESCOBAR) (Feb. 21, 2023); CSIBI v. Romania, App. No. 16632/12 (ECtHR, June 4, 2019); Case C-240/18, Constantin Film Produktion GmbH (FACK JU GÖHTE) v. EUIPO, ECLI:EU:C:2020:118 (Feb. 27, 2020); R 2244/2016-2, Application of Brexit Drinks Ltd. (BREXIT) (June 28, 2017); Dor v. Romania, App. No. 55153/12 (ECtHR, Aug. 25, 2015); R 519/2015-4, Application of Josef Reich (JEWISH MONKEYS) (Sept. 2, 2015); R-793/2014-2, Application of Ung Cancer (FUCK CANCER) (Feb. 23, 2015); R 2804/2014-5, Application of Square Enix Ltd. (MECHANICAL APARTHEID) (Feb. 6, 2015); R 2889/2014-4, Case T-417/10, Federico Cortés del Valle López (¡Que buenu ye! HIJOPUTA) v. OHIM, ECLI:EU:T:2012:120 (Mar. 9, 2012); Case T-232/10, Couture Tech Ltd. v. OHIM, ECLI:EU:T:2011:498 (Sep. 20, 2011); R 495/2005-G, Application of Jebaraj Kenneth (SCREW YOU) (July 6, 2006); French Connection Ltd.'s Trademark Application (FCUK) [2007] E.T.M.R. 8; Basic Trademark SA's Trademark Application (JESUS) [2006] E.T.M.R. 24; Ghazilian's Trademark Application (TINY PENIS) [2002] E.T.M.R. 57.

38 Matal v. Tam, 582 U.S. 218 (2017); Iancu v. Brunetti, 588 U.S. 388 (2019).

Justice of the European Union ("CJEU") acknowledged freedom of expression as a relevant consideration in the assessment of morality-based refusals to registration, but without allowing speech to override the morality bar.[39] Signs contrary to public policy or morality therefore continue to be refused in the EU in a way that their U.S. counterparts no longer are.

Third, restrictions on trademark use that impact marks' expressive function arise not only from trademark statutes, but also, at times, from public measures regulating the consumption of certain goods. This is most apparent in legislation designed to prevent the use of marks that may mislead consumers about the characteristics of the goods or that—through the positive images marks convey—encourage the purchase of goods posing health risks. Examples include restrictions on the use of marks for tobacco products, such as mandatory health warnings, advertising bans, and, more recently, standardized packaging.[40] Rightsholders have challenged these measures, arguing, inter alia, that they constitute an unjustified interference with their right to freedom of expression.[41] Once again, an Atlantic divide emerges. European courts tend to apply a deferential proportionality test under which the pursuit of public health is largely sufficient to validate such measures, whereas U.S. courts apply more demanding scrutiny to restrictions on commercial speech under the First Amendment—an

---

39 Case C-240/18, Constantin Film Produktion GmbH (FACK JU GÖHTE) v. EUIPO, ECLI:EU:C:2020:118 (Feb. 27, 2020).

40 Regulations requiring that tobacco products bear health warnings have been in effect since 1965 in the United States (The Cigarette Labelling and Advertising Act of 1965, Pub. L. No. 89-92), 1976 in France (Loi 76-616 du 9 Juillet 1976 Relative à la Lutte Contre le Tabagisme), and 2001 in the EU (Directive 2001/37, of the European Parliament and of the Council of 5 June 2001 on the Approximation of the Laws, Regulations and Administrative Provisions of the Member States Concerning the Manufacture, Presentation and Sale of Tobacco Products, 2001 O.J. (L194) 26). Advertising bans have been regulated in the EU by means of several instruments, including Directive 98/43, of the European Parliament and of the Council of 6 July 1998 on the Approximation of the Laws, Regulations and Administrative Provisions of the Member States Relating to the Advertising and Sponsorship of Tobacco Products, 1998 O.J. (L213) 9. Some European countries have recently adopted plain packaging legislation, such as France (Loi 2016-41 du 26 janvier 2016 de modernisation de notre système de santé), Ireland (Public Health (Standardised Packaging of Tobacco) Act 2015), and the UK (Standardised Packaging of Tobacco Products Regulations 2015).

41 That government-imposed restrictions on trademark use can impinge on rightsholders' freedom of expression has been recognized by both U.S. and European courts. *See*, in the United States: Cigar Assoc. of Am. v. FDA, 315 F. Supp. 3d 143 (D.D.C. 2018); R.J. Reynolds Tobacco Co. v. FDA, 696 F.3d 1205 (D.C. Cir. 2012); Lorillard Tobacco Co. v. Reilly, 533 U.S. 525 (2001). In Europe: Case C-547/14, Philip Morris Brands SARL v. Secretary of State for Health, ECLI:EU:C:2016:325 (2016); Opinion of Advocate General Kokott in Case C-547/14, Philip Morris Brands SARL v. Secretary of State for Health, ECLI:EU:C:2015:853 (2015); R. (on the application of British American Tobacco UK Ltd.) v. Secretary of State for Health [2004] EWHC 2493 (Admin.); Opinion of Advocate General Fennelly in Case C-376/98, Germany v. European Parliament, ECLI:EU:C:2000:324 (2000).

approach that has, in several instances, led to such measures being struck down.

Taken together, these three scenarios reveal an important pattern. In infringement cases, freedom of expression is invoked by defendants to *limit* trademark rights; in registration and brand restriction cases, it is invoked by applicants or rightsholders to *validate* them. Yet neither decision-makers nor scholars have previously engaged with the interaction between trademarks and speech in a holistic manner.[42] Their analyses have, instead, been systematically focused on one form of interaction at a time, producing a common misconception in the field: that the interaction between trademarks and speech is unidirectional, advancing the speech interests of only one subset of expressive users at a time, depending on the type of litigation involved.[43] This is, I argue, one of two ways in which the prevailing conceptualization of the interaction between marks and speech is incomplete. A joint analysis of the three main contexts in which trademarks and speech interact reveals that the relationship, in fact, operates as a two-way street, in which free speech can simultaneously validate and limit trademark rights. Recognizing this two-way dynamic provides a more solid foundation for reconceptualizing the interaction between trademarks and free speech as competing forms of speech.

A possible explanation for the misconception that the interaction is unidirectional may be historical: until the more recent wave of litigation mobilizing freedom of expression to challenge refusals of registration, free speech arguments were, for the most part, confined to infringement litigation.[44] Another may be that free speech operates as a reactive tool to safeguard the status quo, keeping in check the unintended consequences of (a) ever-expanding trademark rights (as a result of the progressive broadening of the likelihood of confusion cause of action,[45] as well as the adoption of

---

42 I have explored this further elsewhere: Fernandez-Mora, *supra* note 5.

43 *Id.* at note 18.

44 Compare the vast volume of infringement cases (especially in the United States, which date all the way back to the early 1970s) cited in note 31 *supra* with the more reduced number of registration and brand restriction cases in notes 37 and 41 *supra*, respectively.

45 Likelihood of confusion has expanded particularly through the recognition of protection against initial interest confusion, post-sale confusion, and sponsorship confusion. Beebe's contributions are particularly noteworthy in this regard. As he explains, the expansion of the confusion cause of action is doing much of the heavy lifting to protect trademarks against dilutive harms. He goes as far as to argue that "the antidilution cause of action is itself a failure," adding that "courts have adapted other areas of trademark law [notably protection against confusion] to do the regulatory work that antidilution law was originally intended to do." Barton Beebe, *Intellectual Property and the Sumptuary Code*, 123 Harv. L. Rev. 809, 851 (2010). *See also*: Barton Beebe, *The Continuing Debacle of U.S. Antidilution Law: Evidence from the First Year of Trademark Dilution Revision Act Case Law*, 24 Santa Clara High Tech. L.J. 449 (2007); Mark Lemley and Mark McKenna, *Owning Mark(et)s*, 109 Mich L. Rev. 137 (2010); Mark McKenna, *Testing Modern Trademark Law's Theory of Harm,* 95 Iowa L. Rev. 63 (2010).

anti-dilution provisions),[46] and (b) increasingly restrictive public law measures targeting trademark use and registration.[47] As the case law shows, different parties invoke freedom of expression to pursue very different agendas: defendants seek to shield their unauthorized uses of recoded marks from infringement liability, while rightsholders and applicants seek to continue unobstructed use of their marks in trade or to secure access to the register. Put differently, the opportunistic nature of free speech claims in trademark law may also help explain the apparent lack of communication between courts deciding corresponding cases.

This lack of communication is the second reason, I argue, that decision-makers are adjudicating interaction disputes in suboptimal conditions: they fail to recognize the diversity of expressive users of trademarks. Awareness of the full range of scenarios in which trademarks and speech interact highlights the spillover effect that judicial findings in one setting can have in the others. Recognition of the expressive interests of rightsholders and applicants in registration and brand restriction litigation ought to permeate the infringement context, and vice versa. This is not to say that trademarks and free speech interact identically across all three contexts, but rather that certain core principles apply across interaction disputes, as mandated by human rights instruments. Honoring those principles requires courts to resolve interaction disputes with a view to protecting the full diversity of expressive rights at stake—not just those of the subset of expressive users that happens to be before the court. It also requires courts to identify the full range of expressive users impacted by interaction disputes, moving beyond those traditionally identified in the case law and scholarship (i.e., defendants, rightsholders, and applicants). The result would be improved enforcement of constitutional guarantees in trademark disputes.

We now turn to the diversity of ways in which individuals can use trademarks for expressive purposes.

---

[46] Federal Trademark Dilution Act of 1995, Pub. L. No. 104-98, 109 Stat 985 (1996) (U.S.); First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (EU).

[47] This is particularly noticeable in the context of trademark-restrictive measures, which have expanded both in terms of the intensity of the restrictions imposed on trademark use (from advertising bans dating back to the 1960s to ever-larger health warnings and even plain packaging requirements in a wide range of jurisdictions in the last decade) and the industries targeted (from tobacco products to alcoholic drinks and even foods high in fat, sugar, and salt in recent years). I have explored this topic further elsewhere: Alvaro Fernandez-Mora, *Trade Marks and the Right to Health: A Growing Tension*, *in* Justice in Global Health: New Perspectives and Current Issues (Himani Bhakuni & Lucas Miotto eds., 2023).

PART II. SPEAKING IN BRANDS: A TYPOLOGY OF EXPRESSIVE USERS OF TRADEMARKS

Much has been written on the interaction between trademarks and speech, whether in the context of infringement,[48] registration,[49] or brand restriction cases.[50] Yet case law and scholarship have made

---

[48] Among others: Martin Senftleben, *The Unproductive "Overconstitutionalization" of EU Copyright and Trademark Law—Fundamental Rights Rhetoric and Reality in CJEU Jurisprudence*, 55 Int'l Rev. Intell. Prop. & Competition L. 1471 (2024); Martin Senftleben, *supra* note 4; Basma, *supra* note 4, at 226; Michal Bohaczewski, *Conflicts Between Trade Mark Rights and Freedom of Expression Under EU Trade Mark Law: Reality or Illusion?*, 51 Int'l Rev. Intell. Prop. & Competition L. 856 (2020); Kathleen E. McCarthy, *Free Ride or Free Speech: Predicting Results and Providing Advice for Trademark Disputes Involving Parody*, 109 Trademark Rep. 691 (2019); Sabine Jacques, *supra* note 4; Katyal, *supra* note 4; Stacey L. Dogan & Mark A. Lemley, *supra* note 4; McGeveran, *supra* note 34; Christine Haight Farley & Kavita DeVaney, *Considering Trademark and Speech Rights through the Lens of Regulating Tobacco*, 43 AIPLA Q.J. 289 (2015); Rebecca Tushnet, *More than a Feeling: Emotion and the First Amendment*, 127 Harv. L. Rev. 2392 (2014); Rt. Hon. Sir Robin Jacob, *Parody and IP Claims: A Defence?—A Right to Parody?*, *in* Intellectual Property at the Edge—The Contested Contours of IP, 427 (Rochelle Cooper Dreyfuss & Jane C. Ginsburg eds., 2014); David A. Simon, *The Confusion Trap: Rethinking Parody in Trademark Law*, 88 Wash. L. Rev. 1021 (2013).

[49] Among others: Margaret Chon & Robert S. Chang, *The Indians Who Were Not Heard and the Band That Must Not Be Named: Racial Formation and Social Justice in Intellectual Property Law, in* The Cambridge Handbook of Intellectual Property & Social Justice (Steven D. Jamar & Lateef Mtima eds., 2024); Mariana Bernal Fandiño, *Controversial Trademarks: A Comparative Analysis, in* The Cambridge Handbook of Intellectual Property & Social Justice (Steven D. Jamar & Lateef Mtima eds., 2024); Davis & Żelechowski, *supra* note 4; Elena Izyumenko, *A Freedom of Expression Right to Register "Immoral" Trademarks and Trademarks Contrary to Public Order*, 52 Int'l Rev. Intell. Prop. & Competition L. 893 (2021); Ned Snow, *Immoral Trademarks after Brunetti*, 58 Hous. L. Rev. 401 (2020); Gary Myers, *It's Scandalous!—Limiting Profane Trademark Registrations after "Tam" and "Brunetti*," 27 J. Intell. Prop. L. 1 (2020); Katyal, *supra* note 4; Vicenc Feliu, *The F Word—An Early Empirical Study of Trademark Registration of Scandalous and Immoral Marks in the Aftermath of the* In Re Brunetti *Decision*, 18 J. Marshall Rev. Intell. Prop. L. 404 (2019); Barton Beebe & Jeanne C. Fromer, *Immoral or Scandalous Marks: An Empirical Analysis*, 8 N.Y.U. J. Intell. Prop. & Ent. L. 169 (2019); Susan Snedden, *Immoral Trade Marks in the UK and at OHIM: How Would the Redskins Dispute Be Decided There?*, 11 J. Intell. Prop. L. & Prac. 270 (2016); Enrico Bonadio, *Brands, Morality and Public Policy: Some Reflections on the Ban on Registration of Controversial Trademarks*, 19 Marq. Intell. Prop. L. Rev. 39 (2015); Fhima, *supra* note 23.

[50] Fernandez-Mora, *supra* note 47; Sunil S. Gu, *Plain Tobacco Packaging's Impact on International Trade and the Family Smoking Prevention and Tobacco Control Act in the U.S. and Drafting Suggestions*, 16 Wash. U. Global Stud. L. Rev. 197 (2017); Matthew J. Elsmore, *Trademarks, Tobacco, Health: Brokerage by Fundamental Rights*?, *in* The New Intellectual Property of Health (Alberto Alemanno & Enrico Bonadio eds., 2016); Sergio Puig, *Tobacco Litigation in International Courts*, 57 Harv. Int'l L.J. 383 (2016); Jonathan Griffiths, "*On the Back of a Cigarette Packet"—Standardised Packaging Legislation and the Tobacco Industry's Fundamental Right to (Intellectual) Property*, Intell. Prop. Q. 343 (2015); Richard J. Bonnie, *The Impending Collision Between First Amendment Protection for Commercial Speech and the Public Health: The Case of Tobacco Control*, 29 J. L. & Pol. 599 (2014); Nathan Cortez, *Do Graphic Tobacco Warnings Violate the First Amendment?*, 64 Hastings L.J. 1467 (2013).

few attempts to classify the full range of expressive users of marks.[51] This section addresses that gap by proposing a typology that can help courts and scholars better account for the expressive richness of trademark use. I suggest five categories: (a) trademark owners; (b) consumers of branded goods; (c) recoders; (d) consumers of goods bearing recoded marks; and (e) the public. Each is explored, with examples, below.

The first category of expressive user that I have identified is *trademark owners*, who express themselves through use of their marks in relation to the offer of goods or services, including in advertising.[52] For instance, in the luxury goods sector, the LOUIS VUITTON mark has come to communicate a wealth of information beyond signaling the commercial origin of its owner, Louis Vuitton Malletier S.A. It now also conveys an image of heritage, craftsmanship, and aspirational luxury. This is the result of a conscious effort by its rightsholder, whose brand strategy seeks to transcend more conventional meanings such as commercial origin and product quality. Louis Vuitton is well known for its commitment to artisanal production in its dedicated ateliers, for the long history of its monogram canvas (introduced in 1896 by Georges Vuitton in part as an anti-counterfeiting measure),[53] and for a series of high-profile collaborations with artists ranging from Yayoi Kusama to Jeff Koons.[54] The concepts of heritage, craftsmanship, and exclusivity are, therefore, firmly rooted in the house's ethos. They tap into broader social values, such as refinement, sophistication, and the cultural capital that comes with discerning consumption—all of which the LOUIS VUITTON mark is able to convey. How? First, by maintaining production processes that emphasize traditional leather-working techniques.[55] Second, by informing consumers, through elaborate advertising and editorial coverage, that its high-end products are the heirs of a long-standing tradition

---

51 Although she did not attempt to define or classify the different categories of expressive users of marks, Katyal noted the diversity of expressive interests involved in trademark use in Katyal, *supra* note 34, at 878 ("Each of these audiences—whether consumers of luxury goods, political actors, or artist/activists . . .—oppositional or otherwise, all integrate and respond to particular brands as part of their process of self-expression.").

52 *See* Spence, *supra* note 25.

53 A timeline of Louis Vuitton's history is available on its website, https://uk.louisvuitton.com/eng-gb/magazine/articles/heritage (last visited Apr. 29, 2026).

54 Erin-Atlanta Argun, *Creating Infinity: Yayoi Kusama & Louis Vuitton*, My Art Broker (Aug. 5, 2025), https://www.myartbroker.com/artist-yayoi-kusama/articles/creating-infinity-yayoi-kusama-louis-vuitton (last visited Apr. 29, 2026); Katie Berrington, *Louis Vuitton Launches Collaboration With Jeff Koons*, British Vogue (Apr. 11, 2017), https://www.vogue.co.uk/gallery/louis-vuitton-collaboration-with-jeff-koons (last visited Apr. 29, 2026).

55 Matilde Stadager, *The art and precision of Louis Vuitton's craftsmanship*, Collector's Cage (Jan. 5, 2024), https://collectorscage.com/blogs/guides/louis-vuitton-craftmanship (last visited Apr. 29, 2026).

of luxury travel and refinement.[56] This information allows Louis Vuitton to attract consumers who value heritage and brand prestige above other features. And third, by building a brand image that revolves around aspirational luxury and global sophistication. As a result, the LOUIS VUITTON mark allows the house to: (a) distinguish its goods from those of other luxury houses; (b) inform—and persuade—consumers that its products combine superior quality with a sense of heritage, craftsmanship, and exclusivity; and (c) express its allegiance to values of luxury, lasting quality, and refined taste. The ability of contemporary trademarks to convey such complex meanings is extremely valuable for firms wishing to attract consumers who identify with the values and lifestyle preferences conveyed by expressive marks.

This brings us to the second category of expressive users of marks: *consumers of branded goods*. Purchasing and using branded goods allows consumers not only to meet their material needs but also to project an identity, the goods serving as vehicles for self-expression. As Belk observes, "we regard our possessions as parts of ourselves."[57] Such expressive uses are commonplace in our brand-oriented, image-driven society. Returning to the luxury goods example, a consumer who identifies with the heritage and luxury values conveyed by the LOUIS VUITTON marks will use them expressively through the acts of acquiring and carrying a monogram-canvas handbag, wallet, or piece of luggage with the aim of communicating his or her adherence to such values. In this scenario, it is easy to imagine the "LV" monogram communicating the consumer's identity project as a person of established taste and means when he or she carries a LOUIS VUITTON–branded handbag at a fashion event, business meeting, or while travelling internationally—signaling membership in a community that values the public display of luxury consumption. There is evidence of this type of expressive use in the considerable cultural commentary that the brand attracts: lifestyle journalism and academic writing on luxury consumption have long treated Louis Vuitton as a paradigmatic example of how individuals deploy branded goods to communicate social position.[58] Interestingly, in presenting himself or herself as someone who carries a LOUIS VUITTON–branded good, the consumer may also be communicating that he or she is not, say, someone who carries an HERMÈS-branded handbag (i.e., someone who might be read as preferring more discreet, quiet

---

[56] See marketing campaigns cited in note 24 *supra*.

[57] Russell W. Belk, *Possessions and the Extended Self*, 15 J. Consumer Rsch. 139, 139 (1988).

[58] Kapferer & Bastien, *supra* note 13; Elizabeth Currid-Halkett, The Sum of Small Things: A Theory of the Aspirational Class (Princeton University Press, 2017); Dana Thomas, Deluxe: How Luxury Lost Its Lustre (Penguin Press, 2007).

luxury signals).[59] The two consumption choices express different aesthetic and social commitments, even though both brands operate at the very top of the luxury market.

The third category of expressive user of trademarks is *recoders*, who use modified versions of marks—by removing, replacing, and/or adding material—to imbue them with new meaning. Often, the point of recoding is to comment on the meanings that the mark already carries, whether by criticizing or parodying them. At other times, the recoded mark is less about the brand or its owner than about deploying the mark as a vehicle for a broader sociopolitical message. Importantly, while defendants in infringement actions involving expressive uses of marks will commonly qualify as recoders, the opposite is not true: recoders will be deemed defendants only where their unauthorized use of a recoded mark has given rise to an infringement suit. Indeed, many expressive uses of recoded marks fall outside the scope of trademark law altogether, notably where the recoder does not use the mark as a designation of source for goods or services—a threshold requirement for trademark liability in most jurisdictions.

The LOUIS VUITTON mark and its associated monogram pattern have been recoded on numerous occasions to critique the values of exclusivity and conspicuous consumption on which the house's image rests, and Louis Vuitton Malletier S.A. has been among the most zealous defenders of its marks against such uses on both sides of the Atlantic.[60] A particularly powerful example is the Danish artist Nadia Plesner's *Simple Living* and *Darfurnica* artworks, in which an emaciated child is depicted carrying a handbag bearing the unmistakable pattern of Louis Vuitton's multicolored monogram.[61] The artist's aim was to draw attention to the disproportionate share of public attention devoted to celebrity consumption—in particular to luxury accessories of the kind in question—while a humanitarian catastrophe unfolded in Darfur. Louis Vuitton sued Plesner for infringement of its EU design rights in the multicolored monogram pattern, but the District Court of The Hague ultimately ruled that Plesner's freedom of artistic expression prevailed over the claimant's exclusive rights (design rather than trademark rights, though the constitutional balancing principles

---

59 Priya Bhamra, Quiet Luxury and Timeless Desire: How Hermès Mastered Luxury, Vogue College of Fashion (Jan. 13, 2026), https://www.voguecollege.com/articles/london/quiet-luxury-and-timeless-desire-how-hermes-mastered-luxury/ (last visited Apr. 29, 2026).

60 Noteworthy examples include: Rb.'s-Gravenhage 4 mei 2011, NJF 2011, 264 (Nadia Plesner Joensen/Louis Vuitton Malletier SA) (Neth.); Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC, 507 F.3d 252, 261 (4th Cir. 2007); Louis Vuitton Malletier, S.A. v. My Other Bag, Inc., 156 F. Supp. 3d 425 (S.D.N.Y. 2016).

61 Rb.'s-Gravenhage 4 mei 2011, NJF 2011, 264 (Nadia Plesner Joensen/Louis Vuitton Malletier SA) (Neth.).

apply with equal force). Recoding allowed Plesner to harness the communicative potential of the "LV" monogram as a conveyor of conspicuous luxury and to steer it toward expressing her preferred message—one that interrogates the moral disproportion between media saturation around such goods and indifference to mass atrocity.

We find other examples of recoding the LOUIS VUITTON marks. The American company Haute Diggity Dog, LLC markets plush chew toys for dogs bearing the name "Chewy Vuiton" and a "CV" monogram in colors and configuration evocative of Louis Vuitton's "LV" monogram.[62] The U.S. Court of Appeals for the Fourth Circuit found this to be a successful parody, observing that "[t]he dog toy irreverently presents haute couture as an object for casual canine destruction. The satire is unmistakable. The dog toy is a comment on the rich and famous, on the LOUIS VUITTON name and related marks, and on conspicuous consumption in general."[63] Similarly, My Other Bag, Inc. markets inexpensive canvas tote bags featuring cartoonish drawings of luxury handbags—including one of Louis Vuitton's signature handbags in simplified form, with "MOB" (i.e., "My Other Bag") replacing the claimant's "LV" monogram—alongside "My Other Bag . . . ," riffing on the bumper-sticker convention "my other car . . ." to lampoon the very status hierarchy that the original mark embodies.[64] The Second Circuit found this to be a successful parody too and, thus, shielded from liability.[65]

Recoding allows the defendants in these examples to harness the communicative power of the LOUIS VUITTON marks and redirect it toward a critique of the consumerist and status-driven values the mark is taken to embody. This kind of expressive use sits far from Louis Vuitton's own use of its mark. So far that, as we have seen, recoders have found themselves on the receiving end of infringement actions brought by the rightsholder—"by its own description, an 'active[ ] and aggressive[ ]' enforcer of its trademark rights."[66] But recoders sometimes go on to affix their recoded marks to goods that are later offered for sale in the marketplace, as Plesner did when offering for sale T-shirts bearing her *Simple Living* artwork (the proceeds of which were donated to humanitarian relief in Darfur), and as Haute Diggity Dog, LLC and My Other Bag, Inc. continue to do. Their aim in doing so is

---

62 Available on Haute Diggity Dog, LLC's online store, https://www.hautediggitydog.com/collections/chewy-vuiton (last visited Apr. 29, 2026).

63 Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC, 507 F.3d 252, 261 (4th Cir. 2007).

64 Available on My Other Bag, Inc.'s online store: https://www.myotherbags.com/shop (last visited Apr. 29, 2026).

65 Louis Vuitton Malletier, S.A. v. My Other Bag, Inc., 156 F. Supp. 3d 425 (S.D.N.Y. 2016).

66 *Id.* at 445.

twofold. First, to express themselves through use of the recoded marks. And second, to enable those individuals who identify with the critical or parodic message conveyed by the recoded marks to use them expressively too, by purchasing and using goods bearing recoded marks.[67] While this form of use by recoders may resemble the form in which trademark owners make expressive use of their (non-recoded) marks, the content of the respective messages conveyed is very different.

This leads us to the fourth category of expressive user of marks: *consumers of goods bearing recoded marks*. To illustrate this type of expressive use, one can think of consumers who purchase and wear Plesner's *Simple Living* T-shirts to express their solidarity with the victims of the Darfur conflict and their unease at the disproportion between popular attention to celebrity consumption and indifference to human suffering. Or of consumers who buy "Chewy Vuiton" toys for their pets as a knowing nod to the absurdities of conspicuous consumption, or who carry "My Other Bag" canvas totes both to mock the luxury status hierarchy and, perhaps, to signal a more egalitarian set of consumption values. Similarly to what we saw with recoders and rightsholders, although consumers of goods bearing recoded marks express their worldview in much the same manner as consumers of branded goods, the ideas conveyed by both types of consumers are very different.

In the final category of expressive user of marks, we find individuals who employ expressive marks that have permeated language, art, and culture more broadly in their everyday conversations and creative endeavors—what I have dubbed the *public*. This is, of course, only possible of trademarks that have made their way into the language, in the sense that they can convey meaning irrespective of any underlying goods or services. Perhaps the most popular example of this type of mark is BARBIE, which has entered the English language to describe "a young woman who is glossily attractive but apparently characterless or unintelligent."[68] Dreyfuss was the first scholar to draw attention to this type of expressive use of trademarks as early as 1990, when she relied precisely on the famous doll's trademark to explain Joan Kennedy's use of the word "Barbie" in conversation as a way "to indicate that she was treated like a beautiful but empty-headed accessory, . . . exploit[ing] a set of meanings that are quite different from the ones invoked by [the trademark owner] Mattel."[69]

---

67 Dogan & Lemley, *supra* note 4, at 1186.

68 *Oxford English Dictionary*, *supra* note 22.

69 Dreyfuss, *supra* note 2, at 400. The quote from Joan Kennedy that Dreyfuss was commenting on, as recounted by Marcia Chellis, was as follows: "When I campaign alone I'm approachable. Women talk to me, complain, but when I'm with Ted I'm a Barbie doll." Marcia Chellis, The Joan Kennedy Story: Living with the Kennedys, 191 (Jove ed., 1986).

The luxury sector offers further illustrations of this phenomenon. The words "Louis Vuitton" have long since outgrown their function as a mere product identifier and now circulate in everyday language as shorthand for a particular form of aspirational luxury—and, indeed, for the kind of social positioning that owning such goods is taken to signify. References to "Louis Vuitton" abound across literature,[70] film, and music, with the last offering especially rich examples of luxury marks permeating into the language. In hip-hop in particular, "Louis Vuitton" and "LV" recur as cultural shorthand for achievement and success—a tradition that arguably reached a peak with Kanye West's self-styling as "the Louis Vuitton Don" on his debut album *The College Dropout* (2004).[71]

As we have seen, the expressive dimension of marks allows a wide range of individuals to express themselves through their use, and the same mark may serve very different expressive interests in different hands. This should come as no surprise, given the fundamental role expression plays in allowing individuals to convey their ideas and values to others—and, in so doing, to develop their autonomy. Adopting the typology of expressive users proposed here refines our understanding of the interaction between trademarks and free speech. The following section explores how it does so, and what implications this shift carries for the discipline.

PART III. BRINGING SPEECH TO CHAOS: A WAY FORWARD FOR THE INTERACTION BETWEEN TRADEMARKS AND SPEECH

A note is in order at this stage regarding the kinds of trademarks typically implicated in interaction cases. As the examples discussed throughout this article illustrate, recoding efforts overwhelmingly target marks that enjoy a significant degree of public recognition. This is no accident. The communicative force of a recoded mark depends on the audience's ability to recognize the original sign and to perceive the gap between its conventional meaning and the modified message the recoder seeks to convey. Where the underlying mark is unknown, the recoded version cannot perform

---

[70] In relation to the use of trademarks in literature, Monroe Friedman conducted an empirical study back in 1985 that showed a remarkable increase in the number and variety of marks used in mainstream novels published in the United States in the period from 1946 to 1972. Monroe Friedman, *The Changing Language of a Consumer Society: Brand Name Usage in Popular American Novels in the Postwar Era*, 11 J. Consumer Rsch. 927, 931–34 (1985).

[71] Kanye West, The College Dropout (Roc-A-Fella Records/Def Jam Recordings 2004). *See also*, discussing West's fashion style evolution, including his Louis Vuitton Don phase, Nate Erickson, Ren McKnight and Stelios Phili, *Style Evolution: Kanye West*, GQ (June 18, 2013), https://www.gq.com/gallery/kanye-west-celebrity-style-evolution (last visited Apr. 29, 2026).

this expressive function: the reference is lost on the viewer. In such cases, the dispute is more naturally resolved through ordinary trademark doctrines than through the more complex free speech considerations explored here. The same logic extends to consumers of goods bearing recoded marks, whose ability to communicate their worldview through the consumption of such goods presupposes that the wider public can decode the reference to the original mark.

That said, the relevant threshold is not strictly one of fame or reputation in the technical trademark law sense. What matters is that the mark carries sufficient expressive content for its recoding to be legible to a relevant audience—and expressive content does not invariably track consumer following. Marks with strong environmental credentials, subcultural cachet, or other forms of social or political resonance may convey complex meanings to a discrete community of readers despite commanding only a modest market share. Recoding such marks can be just as expressively rich for that community as recoding a household name is for the general public. The examples deployed throughout this article are drawn predominantly from reputed marks because they most readily communicate the analysis to a broad readership, and because the bulk of interaction litigation does indeed concern such marks. But the framework proposed here is not confined to them: the relevant question in any given interaction case is not whether the mark is famous, but whether it has acquired the kind of expressive content that supports the speech interests of the diverse users identified in the typology above.

This typology illustrates the variety of ways in which individuals communicate their values and ideas through expressive marks. But it also exposes a core assumption underpinning this area of law: the perceived uniformity of the expressive user. Rarely does the case law or scholarship distinguish between different types of expressive user, let alone offer a typology such as the one advanced here. The likely explanation is a tendency to treat the (expressive) user as monolithic. Scholars across both jurisdictions have written extensively about the self-expressive acts of purchasing and using branded goods, typically by reference to a "consumer" who is rarely, if ever, defined with precision.[72] These accounts capture an important feature of contemporary trademark use, but they do not distinguish between the two categories of expressive consumer identified in the typology above: consumers of branded goods and consumers of goods bearing recoded marks. The same indeterminacy persists even where authors gesture toward a wider

---

[72] Desai, *supra* note 22, at 986; Elsmore, *supra* note 50, at 101; Gangjee, *supra* note 2, at 35; Sabine Jacques, *A Parody Exception: Why Trade Mark Owners Should Get the Joke*, 38 Eur. Intell. Prop. Rev. 471, 473 (2016*);* Wolfgang Sakulin, Trademark Protection and Freedom of Expression: An Inquiry into the Conflict Between Trademark Rights and Freedom of Expression under European, German, and Dutch Law, at 9 (2010).

range of expressive users (referring, for instance, to "market participants" beyond the rightsholder, or to "members of the public" who use marks to communicate with one another), but without specifying who these users are or how their expressive engagement differs from that of consumers.[73]

This is not a matter of mere academic rigor; it has fundamental implications for how trademark law is interpreted and applied.[74] Where the "consumer," "market participant," or "member of the public" is left undefined, courts may privilege one subset of expressive users—those whose interests happen to be recognized—at the expense of others, whose speech interests go overlooked. The typology proposed here addresses this by enabling decision-makers to identify, with greater precision, the full range of expressive interests at stake in any given interaction, and to assess which of them merit protection under the right to freedom of expression.

This is precisely what Grynberg had in mind when he criticized the prevailing monolithic approach to the consumer in likelihood of confusion cases, where courts and scholars tend to give disproportionate weight to the interests of confused consumers.[75] In his view, this comes at the expense of non-confused consumers, whose interest in accessing the defendant's goods is insufficiently considered,[76] and the result is a balancing exercise that tilts too readily toward the plaintiff. The plaintiff effectively fights "two-against-one": the interests of both the plaintiff and confused consumers in preventing the unauthorized use are weighed against only the defendant's interest in using a similar sign for its (similar) goods or services.[77] This imbalance, Grynberg argues, "skews analysis of trademark claims and abets the heavily criticized

---

73 Chon & Chang, *supra* note 49, at 59; Dogan & Lemley, *supra* note 4, at 1196.

74 Marlan has explored the consequences of overreliance on the term "consumer" in trademark law for purposes of sustaining unconscious biases, arguing that "the biasing effects of *consumer* may be contributing to trademark law defining the public in a manner that is patronizing, biased, insulting, and indulgent of likelihood-of-confusion claims." Dustin Marlan, *Is the Word "Consumer" Biasing Trademark Law?*, 8 Tex. A&M L. Rev. 367, 373 (2021) (emphasis in original). Heymann has also argued in favor of a more expansive understanding of the consumer in trademark law that can adequately factor in the interests of "[d]isadvantaged consumers—such as those not literate in the English language, those with lower socioeconomic status, and those who face both constraints." Laura A. Heymann, *Trademark Law and Consumer Constraints*, 64 Arizona L. Rev. 339, 339 (2022).

75 Michael Grynberg, *Trademark Litigation as Consumer Conflict*, 83 N.Y.U. L. Rev. 60 (2008).

76 Grynberg acknowledges that the interests of non-confused consumers are sometimes taken into consideration, for instance, when courts seek to promote competition. However, in his view, this is rarely the case, and even when they are factored in, the privileged consideration given to the interests of confused consumers tends to prevail. *Id.*

77 *Id.* at 62.

expansion of trademark's scope beyond its traditional boundaries."[78] Abandoning the monolithic understanding of the consumer would, therefore, not only improve adjudication in likelihood of confusion cases but also help rein in the expanding scope of protection afforded to trademark owners.

Grynberg's proposition opens the door to more nuanced adjudication by attuning trademark enforcement to the diversity of users and interests involved in trademark use, and so to better balanced and fairer outcomes. His contribution is arguably more relevant still in disputes involving expressive uses of marks, where, as we have seen, the interests of a wide range of users are at stake.[79] There is support for this in the case law. In its recent decision in *COVIDIOT*, the EUIPO Grand Board of Appeal relied on the Advocate General's opinion in *Constantin Film Produktion* to recognize the "'different multi[faceted rights and] interests' at stake in the protection of freedom of expression."[80] Yet its application of that recognition remained conventional in two respects. First, it diminished the applicant's expressive interest on grounds that registration is not a precondition of use, overlooking the genuine expressive value of registration itself.[81] Second, the third-party interests it weighed against the applicant's speech were moral rather than expressive: the public's interest in not seeing a sign that trivializes a public health tragedy endorsed through registration, rather than the expressive interests of the other users identified in Part II.[82] For all these shortcomings, *COVIDIOT* takes a useful first step toward recognizing the multiplicity of interests at stake in interaction cases, opening the door to the typology proposed here—which goes further, recognizing that those third-party interests include not only the moral concerns of the wider public but also the expressive interests of the additional categories of users identified in Part II.

Improved adjudication in interaction cases will therefore require expanding the range of expressive interests considered. The recognition of those interests on the part of applicants and rightsholders in registration and brand restriction cases ought to permeate the recoding context, and vice versa. But this is only the

---

78 *Id.* at 62.

79 *See* Part II *supra.*

80 R 260/2021-G, Application of Matthias Zirnsack (COVIDIOT), ¶ 143 (May 16, 2024), quoting Opinion of AG Bobek in Case C-240/18, Constantin Film Produktion GmbH (FACK JU GÖHTE) v. EUIPO, ECLI:EU:C:2019:553, ¶ 53 (July 2, 2019) (the AG's quote has been amended to reflect the actual language employed by the AG in the English version of its Opinion in *Constantin Film Produktion*, which does not match the one employed by the EUIPO Grand Board of Appeal in the English version of its decision in *COVIDIOT*).

81 *Id.* at ¶ 143 and 148.

82 *Id.* at ¶ 146-49.

first step. Proper enforcement of the human rights guarantees safeguarding freedom of expression requires decision-makers to consider the interests of all the expressive users of marks identified in Part II.

Admittedly, this is a counterintuitive approach to resolving interaction disputes, and critics may dismiss it as overcomplicated or far-fetched. Yet trademark law is, in fact, particularly adept at factoring in a wide range of interests through the efforts of an individual party with standing to litigate. Core trademark doctrines are designed precisely to protect the interests of third parties who have no legal standing in the dispute. In infringement proceedings, for instance, actions are brought by trademark owners not simply to protect their proprietary and commercial interests, but, more fundamentally, the interest of (confused, following Grynberg's proposition) consumers in avoiding confusion as to the source of the goods or services bearing the allegedly infringing sign.[83] Or, in the registration context, the absolute ground for refusal of descriptive marks safeguards the interests of competitors in retaining access to signs that ought to remain available for all traders to use—which, in turn, protects consumers through the welfare gains generated by a competitive marketplace. Trademark law even safeguards third-party interests vicariously in interaction cases themselves: the absolute ground for refusal of marks contrary to public policy or morality (and, in the United States until the Supreme Court's decisions in *Tam* and *Brunetti*, of immoral, disparaging, or scandalous marks) requires trademark offices and courts to routinely protect the wider public's interest in a marketplace free of offensive signs registered as trademarks.[84]

---

[83] Curtin v. United Trademark Holdings, Inc., 137 F.4th 1359, 1369-70 (emphasis in the original) ("[. . . T]he Supreme Court has explained that th[e] goal [of protecting consumers' ability to distinguish among products of competitors] may be served by conferring rights that only commercial actors have statutory standing to exercise."). *See* POM Wonderful LLC v. Coca-Cola Co., 573 U.S. 102, 107 (2014) ("Though in the end consumers also benefit from the [Lanham] Act's proper enforcement, the cause of action [for false advertising] is for competitors, not consumers."). It is interesting to note that this has not always been the case. In the early days of the discipline, English courts very clearly rejected the consumer protection rationale underpinning trademark infringement. In the late nineteenth century, for instance, the court in *Levy v. Walker* held that: "The Court interferes solely for the purpose of protecting the owner of a trade or business from a fraudulent invasion of that business by somebody else. It does not interfere to prevent the world outside from being misled into anything." (1878) 10 Ch. D. 436, 438. See, discussing this early line of cases, Mark P. McKenna, *The Normative Foundations of Trademark Law*, 82 Notre Dame L. Rev. 1839, 1854-55 (2007).

[84] In Europe, for instance, and according to the EUIPO Grand Board of Appeal:

> The purpose of Article 7(1)(f) EUTMR is . . . [to ensure] that the privileges of trade mark registration should not be granted in favour of signs that are contrary to public policy or to accepted principles of morality. The organs of government and public administration should not positively assist people who wish to further their business aims by means of trade marks that offend against certain basic values of civilised society.

The U.S. Court of Appeals for the Federal Circuit's recent decision in *Curtin* illustrates this vicarious protection of third-party interests.[85] The court affirmed the dismissal of a consumer's opposition to the registration of RAPUNZEL for dolls and toy figures. Because the grounds on which she relied—genericness, descriptiveness, and failure to function—concern commercial interests, the court held that only commercial actors are entitled to oppose registration on those grounds.[86] Consumer interests in such oppositions must, on this view, be protected through competitors' litigation efforts rather than by consumers themselves. The decision does not deny that consumer interests matter to the trademark system; it simply channels their protection through commercial parties with standing on those particular grounds. *Curtin* also leaves intact an important earlier line of authority: in *Ritchie*, the same court recognized consumer standing to oppose registration on disparagement grounds (now struck down from the Lanham Act).[87] The *Curtin* court distinguished *Ritchie* on the basis that the grounds at issue there—disparagement and reputational harm—were unrelated to the protection of any commercial interest, whereas Curtin's were rooted in commercial interests.[88] What determines standing, in other words, is whether the ground for opposition is commercial or non-commercial: where the basis is commercial, standing is reserved to commercial parties; where it is not, consumers retain standing in their own right. The implication for the present argument is significant: U.S. trademark law already accepts that consumers' non-commercial interests—including, arguably, their expressive interests on the *Ritchie* logic—can warrant direct judicial protection. The typology proposed in this article identifies, and gives content to, the expressive interests that this opening implicitly accommodates.

With these considerations in mind, it is worth exploring what expressive interests courts should consider when hearing interaction cases, and how this will reshape the judicial inquiry. The analysis is best undertaken in relation to each of the three instances where marks and speech interact: infringement, registration, and brand restriction cases.

A. Infringement

In infringement litigation, the approach proposed here would require courts to look beyond the defendant's speech rights and

---

R 260/2021-G, Application of Matthias Zirnsack (COVIDIOT), ¶ 30 (May 16, 2024).

85 Curtin v. United Trademark Holdings, Inc., 137 F.4th 1359, 1369-70.

86 *Id.* at 1370.

87 *Id.* discussing Ritchie v. Simpson, 170 F.3d 1092 (Fed. Cir. 1999).

88 *Id.* at 1366-67.

consider the expressive interests of the plaintiff and consumers of branded goods alongside those of the defendant and consumers of goods bearing recoded marks. The aim is not to advocate a quantitative assessment whereby infringement decisions would turn on a numerical comparison of expressive users on either side. Such an approach would almost invariably favor plaintiffs on the strength of their larger customer base—a result at odds with the protection freedom of expression affords all expressive users, regardless of their numbers. The proposed (re)balancing instead makes three principal contributions.

1. Extending Speech Protection to Commercial Uses of Recoded Marks

Recognizing that the commercial use of recoded marks can serve the expressive interests of users beyond the defendant—in particular, consumers of goods bearing recoded marks—calls into question the prevailing treatment of such uses. On both sides of the Atlantic, courts have approached defendants' speech claims by distinguishing between recoded uses that can trigger protection under freedom of expression and uses that do not.

In the United States, this distinction turns on whether the defendant has used the plaintiff's recoded mark "as a trademark"—that is, to designate the source of its own goods or services. The Supreme Court recently reaffirmed this distinction in *Jack Daniel's* across both likelihood of confusion and dilution analyses,[89] but the distinction itself has run through the case law since the early 1970s.[90] In doing so, the decision brought welcome clarity to this area of law, albeit at the expense of robust speech protection in infringement litigation: as decades of case law suggest, a finding that the First Amendment is not triggered in a recoding case usually leads to a finding of infringement, more often than not on dilution grounds.[91] Lower courts are, indeed, already narrowing the

---

89 Jack Daniel's Props., Inc. v. VIP Prods. LLC, 599 U.S. 140, 145 (2023).

90 Tommy Hilfiger Licensing, Inc. v. Nature Labs, LLC, 221 F. Supp. 2d 410, 414 (S.D.N.Y. 2002); Charles Atlas, Ltd., v. DC Comics, Inc., 112 F. Supp. 2d 330, 336 (S.D.N.Y. 2000); Planned Parenthood Fed'n of Am. Inc. v. Bucci, 42 U.S.P.Q. 2d (BNA) 1430, 1440-41 (S.D.N.Y. 1997); Yankee Publ'g Inc. v. News Am. Publ'g Inc., 809 F. Supp. 267, 276 (S.D.N.Y. 1992); Punchbowl, Inc. v. AJ Press, Inc., 90 F.4th 1022, 1028-29 (9th Cir. 2024); Hard Rock Cafe Licensing Corp. v. Pac. Graphics, Inc., 776 F. Supp. 1454, 1462 (W.D. Wash. 1991); Schieffelin & Co. v. Jack Co. of Boca, Inc., 725 F. Supp. 1314, 1323-24 (S.D.N.Y. 1989); Mut. of Omaha Ins. Co. v. Novak, 836 F.2d 397, 402-03 (8th Cir. 1987); Tetley, Inc. v. Topps Chewing Gum, Inc., 556 F. Supp. 785, 793 (E.D.N.Y. 1983); Gucci Shops, Inc. v. R. H. Macy & Co., Inc., 446 F. Supp. 838, 839-40 (S.D.N.Y. 1977); Coca-Cola Co. v. Gemini Rising, Inc., 346 F. Supp. 1183, 1192-93 (E.D.N.Y. 1972).

91 Schieffelin & Co. v. Jack Co. of Boca, Inc., 725 F. Supp. 1314, 1323-24 (S.D.N.Y. 1989); Coca-Cola Co. v. Gemini Rising, Inc., 346 F. Supp. 1183, 1192-93 (E.D.N.Y. 1972); Hard Rock Cafe Licensing Corp. v. Pac. Graphics, Inc., 776 F. Supp. 1454, 1462-63 (W.D. Wash. 1991); Mut. of Omaha Ins. Co. v. Novak, 836 F.2d 397, 402-03 (8th Cir. 1987); Gucci

protection afforded to recoders whose uses are source-identifying in the wake of *Jack Daniel's*.[92] The District Court of Arizona's recent decision on remand is illustrative: the court found that the defendant's parodic "Bad Spaniels" pet toy tarnished Jack Daniel's marks (the parody no longer shielded on First Amendment grounds), yet held that the very success of that parody made consumer confusion unlikely.[93]

The European picture is more complex and considerably more uncertain. Two distinct problems can be identified, pulling in opposite directions. The first is a conceptual confusion surrounding the role of speech in infringement litigation. Some domestic courts have invoked freedom of expression as a shield in cases where there is no use in the course of trade, no use as a trademark, or no use in relation to goods or services.[94] In these cases, speech has no work to do, because trademark law is not triggered in the first place: the threshold requirements for infringement are simply not met.[95] Reliance on freedom of expression in this context therefore rests on a misconception, and it generates conceptual confusion about what speech is doing in the analysis. This problem is compounded by additional factors. The commercial character of a use is not always easy to determine. Some activities, such as those of artists, broadcasters, and political parties, can occupy a grey zone in which

---

Shops, Inc. v. R. H. Macy & Co., Inc., 446 F. Supp. 838, 840 (S.D.N.Y. 1977); Harley-Davidson, Inc. v. Grottanelli, 164 F.3d 806, 812-13 (2d Cir. 1999); Wendy's Int'l, Inc. v. Big Bite, Inc., 576 F. Supp. 816, 818-19 (S.D. Ohio 1983); Parks v. LaFace Recs., 329 F.3d 437, 448-452 (6th Cir. 2003); Am. Dairy Queen Corp. v. New Line Prods., Inc., 35 F. Supp. 2d 727, 733-35 (D. Minn. 1998); Planned Parenthood Fed'n of Am., Inc. v. Bucci, 42 U.S.P.Q.2d (BNA) 1430, 1440-41 (S.D.N.Y. 1997); Dr. Seuss Enters., L.P. v. Penguin Books USA, Inc., 109 F.3d 1394, 1400-01 (9th Cir. 1997); Gen. Foods Corp. v. Mellis, 203 U.S.P.Q. 261, 262 (S.D.N.Y. 1979); Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd., 604 F.2d 200, 205-06 (2d Cir. 1979).

92 See, notably, the recent decision of the Court of Appeals for the Ninth Circuit in *Punchbowl*, where the court withdrew and reversed its previous decision shielding defendant from infringement on free speech grounds. Punchbowl, Inc. v. AJ Press, Inc., 90 F.4th 1022, 1031 (9th Cir. 2024). *See also* VIP Prods. LLC v. Jack Daniel's Props., Inc., 2025 WL 275909 (D. Ariz. Jan. 23, 2025).

93 VIP Prods. LLC v. Jack Daniel's Props., Inc., 2025 WL 275909 (D. Ariz. Jan. 23, 2025).

94 Cour d'Appel [CA] [regional court of appeal] Paris, 4 ch., Nov. 16, 2005, 04/12417 (Fr.) (for an English translation, see Esso Plc v. Greenpeace France, [2006] 53 E.T.M.R. 665, 670) (shielding defendant's unauthorized recoded use on grounds that the defendant "has [. . .] kept its activities within the limits of freedom of expression, in such a way that the trade mark infringement suit brought against it [. . .] must be rejected [as it did] not manifestly seek to promote the marketing of products or services . . . for the profit of [defendant], but rather fall within purely controversial use which is alien to business life and competition between commercial enterprises"); Cour d'Appel [CA] Paris, 14 ch., Feb. 26, 2003, 02/16307 (Fr.) (for an English translation, see Association Greenpeace France v. SA Société ESSO, [2003] E.T.M.R. 66).

95 We do find precedents of courts correctly applying these threshold requirements to infringement claims: Kammergericht Hamburg [KG] [Berlin Court of Appeal] Aug. 20, 1996 5 U 4311/96 (1996) (Ger.) (for an English translation, see *Alles wird teurer*, [1999] E.T.M.R. 49).

the commercial character of the use is genuinely contestable.[96] The threshold has also been eroded by the CJEU's decision in *L'Oréal v. Bellure*, which extended the protection of reputed marks beyond the origin function to their quality, investment, advertising, and communication functions,[97] opening the door to infringement even absent use as a trademark or in relation to goods or services.[98] And in some jurisdictions—most notably the Benelux—trademark statutes expressly provide that, for dilution claims, the use of the possibly infringing sign need not be for the purpose of distinguishing goods or services.[99] This explains the two Belgian decisions in which the use of a mark by a political party has given rise to a dilution action, both of which should be understood as departures from the rule rather than as instances of it.[100] This includes notably the pending reference for a preliminary ruling before the CJEU in *IKEA*, where the Flemish nationalist party Vlaams Belang used IKEA's marks in a political campaign branded "IKEA-PLAN—*Immigratie Kan Echt Anders*" ("IKEA plan—Immigration really can be different") to advance an unrelated message on immigration policy.[101] The use was plainly non-commercial and, on the orthodox approach, would fall outside the reach of trademark law altogether.

The second problem runs in the opposite direction: in many cases involving genuinely commercial uses, freedom of expression is not taken into account at all or,[102] where it is, its protective reach is very

---

96 *Les Guignols de l'Info*, CA Reims, Feb. 9, 1999, D., 1999, p. 449, Obs B. Edelman (Fr.); International-Compagnia Generale Distribuzione s.p.a. v. Zorro Prods. Inc. (No. 38165/2022) (It.); Unilever Plc v. Griffin [2010] EWHC 899 (Ch) (Eng.).

97 Case C-487/07, L'Oréal SA v. Bellure NV, ECLI:EU:C:2009:378 (June 18, 2009).

98 International-Compagnia Generale Distribuzione s.p.a. v. Zorro Prods. Inc. (No. 38165/2022) ¶ 5.6 (It.) ("In the matter of trade marks, [. . .] the exploitation of another's trade mark, if notorious, is to be considered prohibited when the use of the sign without due cause, carried out in economic activity, allows undue advantage to be gained from the distinctive character or renown of the trade mark or causes harm to them, regardless of whether the trade mark is used to distinguish the products or services of the author of the use, as can occur in the case of the parodic representation of the trade mark in question.").

99 Art. 2.20(1)(d) of the Benelux Convention on Intellectual Property (Trade Marks and Designs).

100 Case C-298/23, Inter IKEA Systems BV v. Algemeen Vlaams Belang VZW, EU:C:2025:886, Opinion of AG Szpunar; Bpost NV v. Algemeen Vlaams Belang VZW et feitelijke vereniging Vlaams Belang, Judgment of the President of the Dutch-speaking Business Court of Brussels, June 22, 2020 (Bel.).

101 C-298/23, Inter IKEA Systems BV v. Vlaams Belang. For an in-depth discussion of the case, *see* Elena Izyumenko, *Trademark "Law and Political Expression: The Case of* Inter IKEA Systems BV v. Vlaams Belang *and Beyond*, Int'l Rev. Intell. Prop. & Competition L. (2026), https://doi.org/10.1007/s40319-026-01719-4 (last visited: May 22, 2026).

102 Cour d'Appel [CA] [regional court of appeal] Paris, 5 ch., Dec. 11, 2015, 14/32109 (Fr.) ("as regards the right to parody and freedom of expression invoked by the appellants, . . . trademark law . . . do[es] not recognize [an] exception to . . . [plaintiff's] monopoly [– unlike copyright law]. Furthermore, it cannot be disputed that the litigious signs are used [by appellant] in business life and serve, not for commentary purposes . . . , but to

limited.[103] This sometimes follows from a court's conclusion that the defendant's expressive use is unsuccessful and therefore undeserving of speech protection—a determination that has itself bred inconsistency, as courts adopt differing thresholds for what counts as expressive.[104] As Jacques' empirical study demonstrates, courts become markedly more cautious about prioritizing freedom of expression as soon as the use has a commercial dimension, even where the defendant does not compete with the rightsholder.[105] This is the inverse of the first problem, and it is the more troubling of the two. It is in the commercial context—where trademark law *is* triggered—that the constitutionally mandated protection of freedom of expression ought to permeate the infringement analysis and inform a genuine balancing of the interests at stake. Where speech is not engaged in these cases, courts find themselves in a position analogous to that of the U.S. courts after *Jack Daniel's*, in which the expressive intent underlying the defendant's recoded use is reduced to one factor among many.[106] This is an outcome to be avoided. As we have seen, marks are increasingly deployed expressively by a wide range of users, and an approach that withholds meaningful speech protection from commercial recoded uses risks chilling valuable forms of expression. Tellingly, clear examples of European courts protecting a genuinely commercial recoded use on free speech grounds are difficult to find.[107] Germany is the notable exception. In *Lila Postkarte*, the defendant produced and sold satirical postcards reproducing the distinctive lilac color and visual idiom of Milka's chocolate packaging alongside a satirical verse playing on the

promote products marketed by the appellant companies, so that the alleged facts fall within the scope of the exclusive right conferred by the trademarks owned by the appellee." (author's translation)).

103 Rechtbank van Koophandel Brussel (Brussels Commercial Court), Moët Hennessy Champagne Services v. BVBA CEDRIC.ART, No. A/17/02627, Apr. 12, 2018 (Belgium) (the court easily found the sale of T-shirts bearing the recoded mark to infringe the plaintiff's DOM PÉRIGNON marks, even if their use on paintings called for a balancing exercise under due cause that ought to factor in the defendant's freedom of expression, as mandated by the Benelux Court of Justice in the same case; *see* Moët Hennessy Champagne Service (MHCS) v. Cedric Art, No. A 2018/1/8, Oct. 14, 2019); Der Oberste Gerichtshof [OGH] [Supreme Court of Justice of the Republic of Austria], Sept. 22, 2009, 17Ob15/09v (Austria).

104 Oberlandesgericht Hamburg [OLG] [Hamburg Higher Regional Court] Aug. 9, 2010 [GRUR-RR] 382 (2010) (Ger); Ate My Heart, Inc. v. Mind Candy Ltd. [2011] EWHC 2741 (Ch) (Engl.); Miss World Ltd. v. Channel 4 Television Corp. [2007] EWHC 982 (Pat) (Eng.)

105 Jacques, *supra* note 4, at 16.

106 Jack Daniel's Props., Inc. v. VIP Prods. LLC, 599 U.S. 140, 145 (2023).

107 Agreeing with this claim, Jacques's empirical study of parody cases across Europe found that "when a trade mark parody is used on merchandise and gifts, such as T-shirts, stickers, tote bags, badges, mugs, and other message-bearing items [. . .] only cases where the trade mark parody took place in a context of a satirical show were given favourable outcome for parodists." Jacques, *supra* note 4, at 16 and note 75.

brand's mountain-pasture imagery.[108] The German Federal Court of Justice held that the use was protected by freedom of artistic expression and did not infringe Milka's trademark rights, notwithstanding the commercial sale of the postcards—and lower courts have since followed this precedent in comparable cases.[109] Beyond Germany, the examples are scattered and thin[110] and tend to depend on additional features that take the use outside the ordinary commercial case, as with *Nadia Plesner* (which arose in the context of EU design rights) and *Miffy* (where the defendant's use was not as a trademark but was nonetheless captured by the Benelux Convention's robust protection against dilution), both in the Netherlands.[111] That such examples are so scarce, and that the clearest of them is now two decades old, is itself revealing. It suggests that European courts, when confronted with a recoded use that crosses the commercial threshold, have largely failed to give freedom of expression the weight it is due—precisely in the category of cases where the balancing of fundamental rights matters most.

Taken together, these factors give rise to a rather complex picture on both sides of the Atlantic. Yet for all the doctrinal disorder, the practical effect is much the same: a commercial recoded use will rarely attract robust speech protection, and decision-makers regularly side with plaintiffs once they find such a use confusing, dilutive, or both. The framework proposed here unsettles that result at its root. If commercial uses of recoded marks can themselves further the expressive interests of both defendants and consumers of goods bearing recoded marks, the categorical exclusion of such uses from the protection of free speech can no longer be sustained. The commercial character of a recoded use thus ceases to be a threshold that forecloses speech protection and becomes merely one feature of a richer inquiry into the expressive stakes on both sides.

---

108 Bundesgerichtshof [BGH] [Federal Court of Justice] Apr. 7, 2005, NJW 2856 (2005) (Ger.) (for an English translation, see *Violet Postcard*, 38 Int'l Rev. of Intell. Prop. & Competition L. 119 (2007)).

109 Oberlandesgericht Hamburg [OLG] [Hamburg Higher Regional Court], Jan. 5, 2006, GRUR-RR 231 (2006) (Ger.).

110 *Les Guignols de l'Info*, CA Reims, Feb. 9, 1999, D., 1999, p. 449, Obs B. Edelman (Fr.); Rb.'s-Gravenhage, May 4, 2011, NJF 2011, 264 (Nadia Plesner Joensen/Louis Vuitton Malletier SA) (Neth.); Gerechtshof Amsterdam, Sept. 13, 2011, IES 2012, 15 m.nt. Herman MH Speyart (Mercis BV/Punt.nl BV) (Neth.).

111 Respectively: Rb.'s-Gravenhage, May 4, 2011, NJF 2011, 264 (Nadia Plesner Joensen/Louis Vuitton Malletier SA) (Neth.); Gerechtshof Amsterdam, Sept. 13 2011, IES 2012, 15 m.nt. Herman MH Speyart (Mercis BV/Punt.nl BV) (Neth.).

2. Speech vs. Speech: A Commensurable (Re)Balancing Exercise

Pitting the expressive interests of rightsholders and consumers of branded goods against those of defendants and consumers of goods bearing recoded marks renders the (re)balancing exercise commensurable. This goes to the core of the contribution advanced here. A common objection to free speech analysis in trademark cases is that it requires courts to weigh apples against oranges: the economic and proprietary interests protected by trademark law on one side, and the speech interests asserted by defendants on the other. The resulting analysis is doctrinally awkward because it imports constitutional reasoning into what is, at its core, a private law dispute. It also tends toward reductionist outcomes, in which defendants' expressive interests are either too easily dismissed once their use is deemed commercial (at odds, as we have seen, with the protection that free speech affords defendants and consumers of goods bearing recoded marks), or automatically privileged once their use is deemed expressive (which fails to safeguard the expressive interests of the rightsholder and consumers of branded goods).[112] The latter approach has been particularly prevalent in the United States, both in the application of the *Rogers* test to likelihood of confusion inquiries and in the noncommercial-use defense to dilution claims—though both have been considerably narrowed in the wake of *Jack Daniel's*.[113]

Recognizing the expressive function of trademarks—and the fact that both parties in an infringement dispute can claim expressive stakes in the mark, both directly and vicariously through the other expressive users they represent—corrects this asymmetry. The economic content of trademark rights, on this view, is itself a form of speech: it secures the rightsholder's ability to communicate the meanings the mark has come to embody. Spence has argued, in a related vein, that the mark is best understood as both expression and property—the property right protecting the rightsholder's expressive stake in the mark.[114] The framework proposed here builds on that insight, extending it from the rightsholder to the wider range of expressive users identified. The exercise then

---

[112] Rogers v. Grimaldi, 875 F.2d 994, 999 (2d Cir. 1989); Mattel, Inc. v. MCA Recs., Inc., 296 F.3d 894, 906 (9th Cir. 2002); Planned Parenthood Fed'n of Am., Inc. v. Bucci, 42 U.S.P.Q.2d (BNA) 1430, 1440 (S.D.N.Y. 1997); Yankee Publ'g Inc. v. News Am. Publ'g Inc., 809 F. Supp. 267, 275-76 (S.D.N.Y. 1992); Bundesgerichtshof [BGH] [Federal Court of Justice] Apr. 7, 2005, NJW 2856 (2005) (Ger.) (for an English translation, see *Violet Postcard*, 38 Int'l Rev. Intell. Prop. & Competition L. 119 (2007)); Oberlandesgericht Hamburg [OLG] [Hamburg Higher Regional Court] Jan. 5, 2006, GRUR-RR 231 (2006) (Ger.).

[113] Jack Daniel's Props., Inc. v. VIP Prods. LLC, 599 U.S. 140 (2023).

[114] Spence, *supra* note 25.

becomes one of speech against speech, conducted within trademark law itself.

3. Proposing a Theory of (Expressive) Harm

The commensurability of the (re)balancing exercise proposed here is what allows the articulation of a doctrinal theory of harm. Once the inquiry is reframed as speech against speech, the question in any given case becomes whether the defendant's unauthorized use is liable to cause *expressive harm* to the mark—that is, to fragment its expressive function so severely as to impair its capacity to convey the complex meanings the rightsholder has cultivated and that consumers of branded goods rely on for self-expression.[115] This imposes a high evidentiary burden on plaintiffs and will rarely be satisfied where the defendant's recoded use is genuinely expressive in nature. At the same time, it gives courts a doctrinal test that can be applied consistently across recoding disputes, without invoking constitutional balancing in every case.

One caveat is in order. Beyond harm to the expressive function of marks, harm to the source-identifying function remains relevant to the likelihood of confusion analysis. The reconceptualization proposed here assists rather than displaces that analysis: where there is no harm to the expressive function, the protection afforded by the source-identifying function should be narrowly construed. Even then, the expressive content of the defendant's use bears on the confusion inquiry. As the U.S. Supreme Court made clear in *Jack Daniel's*, "a trademark's expressive message—particularly a parodic one [. . .]—may properly figure in assessing the likelihood of confusion."[116] Courts should accordingly find infringement only where the defendant's unauthorized use is evidently likely to confuse consumers—a finding rarely made, the Supreme Court observed, where the parody is successful, since "a parody is not often likely to create confusion."[117]

The operation of this theory of harm is best illustrated through a worked example. The dispute in *Jack Daniel's* concerns the defendant's unauthorized use of the "Bad Spaniels" dog toy, which mimics the shape, label, and trade dress of a JACK DANIEL'S whiskey bottle while substituting scatological references ("The Old

---

115 In the European context, the expressive function of trademarks as defined here would allow giving content to the communication function provided for by the CJEU since its landmark decision in Case C-487/07, L'Oréal SA v. Bellure NV, ECLI:EU:C:2009:378 (June 18, 2009), which remains the least explored function to date—the court has yet to define it and provide a theory of harm. I have explored the potential for the communication function to be conceived of as a mark's ability to convey expressive meaning in further detail elsewhere, including an exploration of the advantages that would derive from such an interpretation. Fernandez-Mora, *supra* note 2, at 1400-01.

116 Jack Daniel's Props., Inc. v. VIP Prods. LLC, 599 U.S. 140, 161 (2023).

117 *Id.* at 161 (emphasis in the original).

No. 2 On Your Tennessee Carpet" replaces "Old No. 7 Tennessee Sour Mash Whiskey"; "43% poo by vol." and "100% smelly" replace "40% alc. by vol. (80 proof)").[118] The dispute remains live as the appeal continues to work its way through the federal courts, making this hypothetical all the more relevant.

The expressive harm test proposed would require the court to undertake a two-stage inquiry. The first stage involves identifying the expressive content of the JACK DANIEL'S mark, which carries a rich set of meanings beyond source-identification: Tennessee whiskey heritage, masculinity, rugged authenticity, and a particular kind of Americana. Its owner has cultivated these meanings over more than a century and a half, and consumers of JACK DANIEL'S–branded whiskey draw on them to express their adherence to the values and lifestyle the mark embodies. The second stage asks whether the defendant's recoded use causes a substantial loss of the mark's communicative capacity through the severe fragmentation of those meanings. On the facts of *Jack Daniel's*, the answer is almost certainly no. The defendant's toy is a single product in a niche market—squeaky dog toys—sold at limited volumes relative to the global scale of JACK DANIEL'S whiskey sales. The recoded use is unlikely to displace or fragment the mark's expressive content in any meaningful or durable way: consumers encountering the parody remain perfectly able to identify the mark with the meanings its rightsholder has long cultivated. No finding of expressive harm could be sustained on these facts, and the case would not be resolved in the plaintiff's favor on that basis.

As we have seen, harm to the source-identifying function of the mark remains relevant to the likelihood of confusion analysis. The heavy comedic framing of the "Bad Spaniels" toy makes a finding of confusion unlikely—which is, as noted above, precisely the conclusion the District Court of Arizona reached on remand.[119]

The framework advanced in this article would also resolve cases like *IKEA* differently from the approach proposed by Advocate General Szpunar in his recent opinion.[120] The AG accepted that freedom of expression is relevant to the "due cause" analysis under Article 9(2)(c) EUTMR, but only where the expressive use targets the trademark proprietor or its goods and services—a restriction that would exclude many of the most expressively rich recoded uses, including those at issue in *Plesner* and *Lila Postkarte*.[121] The

---

118 *Id.*

119 VIP Prods. LLC v. Jack Daniel's Props., Inc., 2025 WL 275909 (D. Ariz. Jan. 23, 2025).

120 Case C-298/23, Inter IKEA Systems BV v. Algemeen Vlaams Belang VZW, EU:C:2025:886, Opinion of AG Szpunar. For an in-depth discussion of this decision, *see* Izyumenko, *supra* note 101.

121 Rb.'s-Gravenhage, May 4, 2011, NJF 2011, 264 (Nadia Plesner Joensen/Louis Vuitton Malletier SA) (Neth.): Bundesgerichtshof [BGH] [Federal Court of Justice] Apr. 7, 2005,

expressive harm test asks a different question: not whether the expression targets the rightsholder, but whether the recoded use is liable to cause expressive harm to the mark. Methodologically, however, the AG's opinion is broadly aligned with the doctrinal emphasis advocated here: it treats freedom of expression as an internal component of the trademark analysis (as part of the "due cause" inquiry in *IKEA*), rather than as an external constitutional override.

B. Registration

In the registration context, the expressive interests of the unsuccessful applicant would be best assessed alongside those of the other categories of expressive users identified above—especially those of potential consumers of branded goods and the broader public. After all, the potential for signs to journey from source-signaling devices to expressive artifacts that a wide range of individuals can draw on for self-expressive purposes depends to a large extent on their ability to access the register in the first place (i.e., to be used by one trader on an exclusive basis). This is particularly true in Europe, where protection for non-registered marks is limited.[122] The proposed approach would, thus, require a rebalancing exercise when assessing refusals of registration whereby the interests of the wider population in a marketplace free of offensive signs must be pitted against the expressive interests of a wide range of individuals—not merely those of the unsuccessful applicant, as has been the case to date.

Admittedly, the impact of this shift will be limited in most instances. In the United States, and in the wake of the Supreme Court decisions in *Tam* and *Brunetti*,[123] it is highly unlikely that the suggested line of reasoning will be relevant in the future.[124] This is regrettable, however. The Supreme Court's categorical approach to the First Amendment in these cases prevents the government from differentiating between socially beneficial and socially harmful rationales for seeking registration of immoral, disparaging, or scandalous marks. *Tam* is a good example of a socially beneficial trademark application insofar as the dance-rock band's justification

---

NJW, 2856 (2005) (Ger.) (for an English translation, see *Violet Postcard*, 38 Int'l Rev. Intell. Prop. & Competition L. 119 (2007)).

122 I explore the link between exclusive trademark use and the development of expressive meanings in signs in further detail below; *see* text to footnotes 137-141 *infra*.

123 Matal v. Tam, 582 U.S. 218 (2017); Iancu v. Brunetti, 588 U.S. 388 (2019).

124 Some authors have argued that, after *Tam* and *Brunetti*, the last frontier in challenges to the validity of refusals of registration on First Amendment grounds lies in the systematic rejection by the U.S. Patent and Trademark Office ("USPTO") of applied-for marks in relation to goods the sale of which is forbidden at federal level (but allowed in certain states, notably cannabis products). *See* Robert L. Greenberg, *Cannabis Trademarks and the First Amendment*, 51 Tex. Tech. L. Rev. 525, 556 (2020).

for seeking registration of the racial slur THE SLANTS was "to 'reclaim' and 'take ownership' of stereotypes about people of Asian ethnicity."[125] In sharp contrast, the unsuccessful request, by members of the affected racial minority, to cancel the disparaging "REDSKINS" trademarks owned by the Washington-based football team in *Pro-Football* is illustrative of a socially harmful registration.[126] The decision not to remove these disparaging marks from the register was the direct—and regrettable—consequence of the Supreme Court's unconstitutionality finding in *Tam*. Several authors working at the intersection of intellectual property rights and social justice have also voiced their criticisms of the Supreme Court's categorical approach to Section 2(a) of the Lanham Act, arguing that "[a]pplied in such a formally symmetrical fashion, the First Amendment not only protects minorities eager to engage in controversial expression (*Tam*), but protects market-dominant actors as well from the consequences of their socially harmful expression (*Pro-Football*)."[127] The Court's blanket approach to the interaction between trademarks and speech in the registration context thus fails to acknowledge that minority interests will, in some instances, be best protected through the grant of registration (e.g., *Tam*) while, in others, they will be best protected precisely through the refusal to register a mark (e.g., *Pro-Football*). The reconceptualization advanced here is particularly well suited to addressing the asymmetries that beset the U.S. register, since it ensures that decision-makers take account of the diversity of expressive interests involved in trademark use. As the following discussion explores, it makes it possible to infuse proportionality

---

125 Matal v. Tam, 582 U.S. 218, 228 (2017).

126 Blackhorse v. Pro-Football, Inc., 111 U.S.P.Q.2d (BNA) 1080 (T.T.A.B. 2014); Pro-Football, Inc. v. Blackhorse, 112 F. Supp. 3d 439 (E.D. Va. 2015), vacated in light of *Tam* in Pro-Football, Inc. v. Blackhorse, 709 F. App'x 182 (4th Cir. 2018).

127 Chon and Chang, *supra* note 49, at 66. It is worth quoting another excerpt from their work, where they explore the implications of this asymmetry in further detail:

> Compare Blackhorse's premise that Section 2(a) of the Lanham Act was a legitimate regulation of speech providing an important legal basis to recognize the harmfulness of Pro-Football's marks to her and the communities she represented with Tam's ardent perspective that the government's decision to deny federal registration of his mark violated his speech rights. Both Blackhorse and Tam were plausibly fighting for the rights of minority groups to exert some form of representational sovereignty, that is, to control the use of racially derogatory symbols directed at their communities and to place power back in the hands of those people who have traditionally been harmed by the racist language in question. These competing narratives of freedom from harm raise complex questions of how antiracist activists and scholars engage in coalitional strategies that speak back against dominant frameworks. They also bring into question the role of IP legal doctrines in framing these challenges, especially when the affected stakeholders may disagree on strategies.

Id. at 58 (citations omitted). *See also* Fandiño, *supra* note 49.

into the registrability analysis—in line with Justice Breyer's separate opinion in *Brunetti*.[128]

In Europe, equivalent provisions preventing the registration of signs that are immoral or contrary to public policy remain in force. They have survived where their U.S. analogues did not because the European Convention on Human Rights ("ECHR") and the EU Charter afford public authorities a broader margin of appreciation to restrict freedom of expression than the First Amendment allows. In its landmark decision in *Constantin Film Produktion*, however, the CJEU admitted the sign FACK JU GÖHTE into the register, holding that "freedom of expression . . . must . . . be taken into account" when applying the public policy and morality exclusions.[129] This led the Court away from an abstract assessment of morality and toward an evidence-based inquiry into whether the applied-for sign is genuinely liable to outrage the relevant public.[130] The EUIPO's Boards of Appeal, however, appear to be failing to apply that mandate with the required rigor.[131]

The proposed reconceptualization can, however, be particularly significant where applicants seek to register an offensive sign as a trademark to reclaim its meaning through ownership and sustained exclusive use in the course of trade.[132] Consumers of branded goods

---

128 Iancu v. Brunetti, 588 U.S. 388, 401-405 (2019) (Breyer, J., concurring and dissenting) ("In short, the trademark statute does not clearly fit within any of the existing outcome-determinative categories. Why, then, should we rigidly adhere to these categories? Rather than puzzling over categorization, I believe we should focus on the interests the First Amendment protects and ask a more basic proportionality question: Does 'the regulation at issue wor[k] harm to First Amendment interests that is disproportionate in light of the relevant regulatory objectives'?") (quoting Reed v. Town of Gilbert, 576 U.S. 155, 179 (2015) (Opinion of Breyer, J.)).

129 Case C-240/18, Constantin Film Produktion GmbH (FACK JU GÖHTE) v. EUIPO, ECLI:EU:C:2020:118, ¶ 56 (Feb. 27, 2020).

130 *Id.* at ¶ 43.

131 R 260/2021-G, Application of Matthias Zirnsack (COVIDIOT), ¶ 91 (May 16, 2024) (the Grand Board rejected the applicant's free-speech challenge on grounds that the sign "trivialises the serious harm done by [the COVID] disease to the fundamental values of the European Union [and is] therefore *likely* to shock or offend . . . any person who . . . encounters that mark and has average sensitivity and tolerance thresholds." (emphasis added)). *See also* R 1364/2022-5, Application of Escobar Inc. (PABLO ESCOBAR) (Feb. 21, 2023). *Compare* R0006/2026-5, Application of Katjes Fassin GmbH + Co. KG (TOUCH YOUR BOOBS) (May 7, 2026).

132 I explored this argument briefly in Fernandez-Mora, *supra* note 4, at 290. The role that the protection afforded under freedom of expression ought to play in meaning-reclaiming processes in trademark registration has also been discussed by Ilanah Fhima, *Trade Mark Law and Diversity*, in Research Agendas in Trade Mark Law (Anke Moerland & Ilanah Fhima eds., forthcoming), https://ssrn.com/abstract=5306942 (last visited Apr. 29, 2026); Ilanah Fhima, *Reappropriation of Slurs and the Implications for Trade Mark Registration: A Policy Proposal*, https://www.ucl.ac.uk/laws/ibil/research/trade-marks-and-social-justice-series/reappropriation-slurs-and-implications-trade-mark-registration (last visited Apr. 20, 2026); Izyumenko, *supra* note 49, at 898-900. *See also*, for empirical studies exploring the rates of meaning-reclaiming driven registrations of disparaging trademarks before the USPTO both before and after the decision of the

who wish to contribute to the rightsholder's reclaiming efforts would be able to do so through their expressive uses of the mark. Furthermore, the public could also contribute to, and benefit from, the shift in meaning to which registration (and subsequent exclusive use) of an offensive trademark can lead, notably through the progressive proliferation of non-offensive, inclusive signs.

The reappropriation of meaning in offensive signs is, however, an aspect of registration (and use) that trademark law has thus far not been very receptive to.[133] This was recently acknowledged by the EUIPO Grand Board of Appeal in its decision in *Application of Turner Broadcasting System Europe Ltd.*, concerning the unsuccessful attempt to register the mark MARICON PERDIDO ("hopeless faggot" in Spanish), where it:

> [N]ote[d] that reappropriation, in the sense that a term which once was offensive could be cured of its offensiveness by the target group filing the word in question as a trade mark, is a notion that is, at present, untested in EU trade mark law. Reappropriation through trade mark registration by the target group disparaged by the particular word or words at issue, is a concept that has come from the US. . . . Both trade marks ["DYKES ON BIKES" and "THE SLANTS"] ultimately obtained registration based on the overriding principle of freedom of speech, enshrined in the US Constitution . . . .[134]

Unfortunately, the Grand Board failed to explore the role that trademark registration can (and should) play in reappropriation to any meaningful extent. Instead, it went on to circumscribe its assessment of registrability to whether, on the evidence available, the offensive meaning of the applied-for signed had *already been reappropriated* within Spanish society.[135] In so doing, the Grand Board missed an opportunity to explore whether the *potential for reappropriation through* trademark registration should be factored in when assessing registrability.

Supreme Court in *Matal v. Tam*, Vicki Huang, *Trademarks, Race and Slur-Appropriation: An Inter-Disciplinary and Empirical Study*, 2021 U. Ill. L. Rev. 1605 (2021); Michael P. Goodyear, *Queer Trademarks*, 2024 U. Ill. L. Rev. 163 (2024).

133 This is true on both sides of the Atlantic, even if more prominently so in European trademark law. *See*, agreeing with this observation: Katyal, *supra* note 4, at 821 ("[W]hen it comes to reappropriated symbols or terms, trademark law has often provided a far less protective response for such semiotic disobedience than one might imagine."); Fhima, *Trade Mark Law and Diversity*, *supra* note 132, at 19 ("the [EUIPO] Grand Board [of Appeal] appears to doubt reappropriation as a concept at all").

134 R 2307/2020-G, Application of Turner Broadcasting System Europe Ltd. (MARICON PERDIDO), ¶ 54-55 (Nov. 25, 2024).

135 *Id.* at ¶ 69-70.

This should not come as a surprise. Arguments advancing the expressive interests of trademark applicants on speech grounds are often dismissed on the basis that the applied-for sign remains available to the unsuccessful applicant (including as a badge of origin to identify its goods) and, by extension, to consumers of those goods.[136] On this view, the applicant remains free to pursue even uses that seek to reclaim the meaning of an offensive sign, through its own marketing efforts and through the consumption choices of consumers of the (non-registered) sign. This argument is, however, too simplistic. It overlooks the fundamental role that registration and ownership can play in furthering the expressive interests of rightsholders, and in turn of consumers—in three respects.

First, a refusal of registration encumbers the applicant's ability to use the sign exclusively in relation to its goods (as we saw earlier, unregistered marks enjoy very limited protection in Europe, so a refusal effectively denies the applicant exclusive use of the sign).[137] Exclusivity is, in turn, fundamental to the communicative work a mark performs—most importantly, its capacity to signal commercial origin clearly.[138] Were several traders to brand competing goods with the same sign, consumers would likely be confused as to their source. Second, the applicant's advertising strategy would be severely impaired by the loss of exclusivity. Promoting a mark across advertising campaigns and other marketing channels is often so costly that applicants may have little incentive to invest in a refused sign if competitors remain free to use it. As the EUIPO Grand Board of Appeal observed in *Jebaraj Kenneth*:

> While it is true to say that a refusal to register does not amount to a gross intrusion on the right of freedom of expression, since traders can still use trade marks without registering them, it does represent a restriction on freedom of expression in the sense that businesses may be unwilling to invest in large-scale promotional campaigns for trade marks which do not enjoy protection through registration

---

136 This has been noted by, inter alia, the EUIPO Grand Board of Appeal in R 2307/2020-G, Application of Turner Broadcasting System Europe Ltd. (MARICON PERDIDO), ¶ 84 (Nov. 25, 2024) ("it is not necessary to register a sign for it to be used for commercial purposes") and in R 495/2005-G, Application of Jebaraj Kenneth (SCREW YOU), ¶ 13 (July 6, 2006).

137 The expressive constraints imposed on applicants by refusals of registration are more stringent in Europe than in the United States, where common law marks (i.e., unregistered) are deserving of a substantial degree of protection as a result of use.

138 There is wide support for this proposition in the literature. *See, e.g.*, Dreyfuss, *supra* note 2, at 400 ("[E]xclusivity is essential to an efficient marketplace. Without an unambiguous signal for goods, consumers would have no way to apply their past experience to future purchasing decisions."); Gangjee, *supra* note 2, at 29 ("Granting exclusive rights to control the use of a mark preserves its ability to reliably signal origin. This ability reduces consumer search costs and protects producer goodwill.").

because the Office regards them as immoral or offensive in the eyes of the public.[139]

Third, without exclusive use, the applicant cannot build a brand image around the sign.[140] The sign will not evolve over time in the way that would allow it to acquire and convey the further meanings, expressive and otherwise, that the applicant wishes to communicate in the marketplace, including those that seek to reclaim its original offensive sense.[141]

To sum up, so long as traders cannot use a sign exclusively, they are unlikely to make the investments required to shift its social perception. Processes of reclaiming the meaning of morally objectionable signs should therefore be incentivized through registration.[142] Where applicants (and consumers of branded goods) can reasonably be expected to use morally objectionable signs in socially valuable ways, it is difficult to see how refusals to grant trademark registration could comply with free speech principles. Society would benefit if free speech guarantees were implemented with a view to enlarging the stock of signs that conform to democratic principles—signs on which the public can then draw in their reclaimed form. MARICON PERDIDO is a good example of a slur ripe for reappropriation by the Spanish-speaking LGBTQ+ community in the EU, and one where, had the application succeeded, exclusive use through registration could have

---

139 R 495/2005-G, Application of Jebaraj Kenneth (SCREW YOU), ¶ 15 (July 6, 2006). *See*, in similar terms, Bonadio, *supra* note 49, at 56; Teresa Scassa, *Antisocial Trademarks*, 103 Trademark Rep. 1172, 1190-92 (2013). By contrast, Kapff, Griffiths, and Ricolfi have argued that free speech can hardly be said to be curtailed as a result of refusals of registration, since applicants are still able to market their goods using the contentious sign. Philipp von Kapff, *Fundamental Rights in the Practice of the European Trade Mark and Designs Office (OHIM)*, *in* Research Handbook on Human Rights & Intellectual Property, 303 (Christophe Geiger ed., 2015); Jonathan Griffiths, *Is there a right to an immoral mark?*, *in* Intellectual Property & Human Rights, 448-49 (Paul Torremans ed., 3d ed. 2015); Ricolfi, *supra* note 25, at 471.

140 According to Dreyfuss: "Th[e] absence [of exclusivity in the use of a mark] would reduce suppliers' incentives to invest in quality-producing and brand-differentiating activities as the benefits of the investment could not be captured through repeat sales to loyal customers." Dreyfuss, *supra* note 2, at 400-01.

141 I have explored in further detail the rationale for invoking speech protection in refusals of registration elsewhere: Alvaro Fernandez-Mora, *supra* note 4, at 284-85.

142 As the following discussion acknowledges, this proposition faces substantial hurdles in Europe, where offices have not been receptive to meaning-reclaiming arguments via trademark registration. An early example includes the decision of the EUIPO BoA in *FICKEN*: "[w]ords or acts which are contrary to the accepted principles of morality today can also be morally acceptable tomorrow. But such changes should not be promoted by trade mark law." R 493/2012-1, Application of EFAG Trade Mark Company GmbH & Co. KG (FICKEN), ¶ 28 (Oct. 18, 2012) (EUIPO Board of Appeal). Authors have also been critical of the views advanced here. *See, e.g.,* Fady J.G. Aoun, *The Belated Awakening of the Public Sphere to Racist Branding and Racist Stereotypes in Trademarks*, 61 IDEA 545, at 561 (2021) ("I remain unconvinced that reclamation require[s] registration.").

contributed significantly to the reclamation of its meaning. This argument echoes the one advanced by the appellant in *Square Enix*, whose speech-based challenge rested, inter alia, on the contention that the EUIPO's refusal to register the sign MECHANICAL APARTHEID would prevent it "from commenting on (the abhorrent policy of) racial segregation in the context of its work"—a fundamental form of reclaiming a sign's meaning.[143] The Board of Appeal, unfortunately, failed to address this claim.

In any event, and judging from the many cases in which decision-makers have given little weight to the way the applicant intends to use the sign, it is difficult to see how the meaning-reclaiming argument proposed here could ever be successful. For instance, the General Court has held that the assessment of the absolute grounds for refusal contained in Article 7(1) EUTMR (including the public policy and morality bars) must be undertaken on the basis of "the intrinsic qualities of the mark applied for and not [of] circumstances relating to the conduct of the person applying for the trade mark."[144] The EUIPO has consistently followed this finding.[145] In concluding that MARICON PERDIDO had not been successfully reclaimed by the disparaged group in Spain at the time of application, the Grand Board of Appeal made it clear that:

> The intentions of the applicant have no bearing on the outcome of the case. It is not relevant in the assessment of the facts whether the applicant is part of the group that is potentially offended or disparaged by the registered term or whether the applicant, as a legal entity, has dedicated itself to the fight against homophobia. The test is whether the term is offensive to persons of normal levels of tolerance and sensitivity who come into contact with the sign. Consequently, the characteristics or personal circumstances of the trade mark applicant have no impact on the applicability of Article 7 absolute grounds objections to the

---

143 R 2804/2014-5, Application of Square Enix Ltd. (MECHANICAL APARTHEID) (Feb. 6, 2015), ¶ 3.

144 Case T-1/17 La Mafia Franchises, SL (LA MAFIA SE SIENTA A LA MESA) v. EUIPO, ECLI:EU:T:2018:146, ¶ 40 (2018); Case T-140/02 Sportwetten GmbH Gera v. OHIM, ECLI:EU:T:2005:312, ¶ 28 (2005). In another example, Arnold QC, sitting as the Appointed Person, held that:

> A mark is only objectionable under [the exclusion] if its use would contravene a generally accepted moral principle by reason of its intrinsic qualities. The reason for this is that, even if the applicant intends to use it in a particular way, his intention may change. Furthermore, the application or registration may be assigned to someone else. Thus the manner in which the mark is subsequently used can neither infect the mark with, nor immunise it from, objectionability.

French Connection Ltd.'s Trade Mark Application (FCUK), [2006] 5 WLUK 432, ¶ 88.

145 R 2307/2020-G, Application of Turner Broadcasting System Europe Ltd. (MARICON PERDIDO), ¶ 65-66 (Nov. 25, 2024); R 2244/2016-2, Application of Brexit Drinks Ltd. (BREXIT), ¶ 13 (June 28, 2017).

> sign at issue. It is the sign itself that must be assessed, not the applicant.[146]

There is, however, at least one precedent where the EUIPO Boards of Appeal have been willing to factor in the personal characteristics of the applicant and the type of use to which it allegedly intends to subject the mark when assessing the morality of an applied-for sign.[147] In *Application of Josef Reich*, a case involving registration of the sign JEWISH MONKEYS by a member of an eponymous klezmer music band who is of Jewish faith and uses the sign for satirical purposes, the Board of Appeal granted registration to the applied-for sign after finding that:

> The *identity* of the *applicant* must certainly be taken into account in the context of Article 7(1)(f) [EUTMR] . . . . According to the overall content of the case file, it can be ruled out that in the *manner* in which the sign applied for is *likely* to be *used* (i.e. not in the context of anti-Israeli political propaganda), the recipients of the goods and services will feel personally targeted and therefore insulted by the designation 'Jewish Monkeys'.[148]

Accounting for the expressive interests of potential consumers of branded goods (and even the wider public) would lend further weight to the meaning-reclaiming argument advanced here. The suggested approach would, thus, open the door to fairer outcomes in the registration context by protecting the rights and interests of minorities who mobilize trademark law to reclaim oppressive language—an endeavor that highlights trademarks' potential as tools of political and cultural change in our brand-driven society. The reasoning of Judge Dyk from the U.S. Court of Appeals in his partially dissenting/partially concurring opinion in *Tam* (later appealed before the Supreme Court) lends support to this characterization of contemporary trademarks.[149] Although he disagreed that the disparagement clause of the Lanham Act should be struck down on First Amendment grounds, he sided with the majority on the need to allow registration of THE SLANTS to respect the applicant's speech rights, stating:

> Here there can be no doubt that [appellant's] speech is both *political* and commercial. . . . [Appellant's] choice of mark reflects a clear desire to *editorialize* on cultural and political subjects. Mr. Tam chose THE SLANTS at least in part to *reclaim* the negative racial stereotype it embodies . . . .

---

146 *Id.* at ¶ 65-66 (citations omitted).

147 R 519/2015-4, Application of Josef Reich (JEWISH MONKEYS) (Sept. 2, 2015).

148 *Id.* at ¶ 17 (emphasis added).

149 *In re* Tam, 808 F.3d 1321, 1363-74 (Fed. Cir. 2015).

> Given the indisputably *expressive* character of Mr. Tam's trademark in this case, the government's recognized interests in protecting citizens from targeted, demeaning advertising and proscribing intrusive formats of commercial expression [. . .] are insufficient to justify [the refusal to register the mark].[150]

Judge Dyk's reasoning is particularly valuable because it acknowledges that trademarks can carry expressive content that goes beyond the commercial sphere and conveys political messages—which deserve heightened protection under free speech guarantees on both sides of the Atlantic.[151] Unfortunately, the Supreme Court chose to remain silent on this point.[152] Judge Dyk's reasoning is also consistent with this article's recognition of the diversity of expressive interests involved in trademark use. As previously noted, the analysis cannot be siloed: the treatment of expressive interests in registration and brand restriction cases ought to inform the infringement analysis, and vice versa. None of this is to deny that speech interests may legitimately be weighed differently across the two contexts: refusing registration of a trademark is not the same act as enjoining a defendant's use, and the doctrines through which the two arise serve distinct purposes. What cannot be sustained, however, is an inconsistency at a more basic level: in the *characterization* of the expressive content itself. If a recoder's use of a mark in infringement litigation can be recognized as artistic or political speech deserving of reinforced protection under freedom of expression, it is difficult to see how the same sign, in the hands of an applicant, can be dismissed as purely commercial in a refusal of registration. The expressive potential of

---

150 *Id.* at 1373 (emphasis added).

151 In the United States: Bolger v. Youngs Drug Prods. Corp., 463 U.S. 60, 64-65 (1983) ("[T]he Constitution accords less protection to commercial speech than to other constitutionally safeguarded forms of expression"). In Europe: Mouvement Raëlien Suisse v. Switzerland, App. No. 16354/06, ¶ 61 (July 13, 2012) (citations omitted) ("Whilst there is little scope under Article 10 § 2 of the Convention for restrictions on political speech . . . , States have a broad margin of appreciation in the regulation of speech in commercial matters or advertising.").

152 In *Tam,* the Supreme Court was asked to rule on whether marks ought to be characterized as commercial speech in all instances, or whether some marks, if not all, have an expressive component allowing to convey meaning beyond source identification, in which case they would be deserving of reinforced protection under the First Amendment. In dodging a bullet, however, the Court saw no need to answer this question in the case at hand since the disparagement exclusion could not even withstand the lower level of scrutiny that applies to commercial speech. Matal v. Tam, 582 U.S. 218, 245-46 (2017). *See*, disagreeing with the views advanced here, Meaghan Annett, *When Trademark Law Met Constitutional Law: How a Commercial Speech Theory Can Save the Lanham Act*, 61 B.C. L. Rev. 253, at 253 (2020) ("[T]he law should treat trademarks as commercial speech. The *Central Hudson* test for intermediate scrutiny is appropriate for identifying a compelling government interest that is related to trademark restrictions at issue.").

a sign does not depend on the procedural setting in which a court encounters it. An applied-for mark can be put to use by its would-be owner (and, in turn, by consumers of goods bearing the mark, and even by the public, should it permeate the language) for any and all purposes, including the conveyance of artistic or political messages.[153] Regrettably, however, the EUIPO Grand Board of Appeal rejected this proposition outright in its recent decision in *COVIDIOT*:

> The fact that a trade mark applied for may contain political content does not entitle it to a greater protection in so far as freedom of expression is concerned, because a trade mark is not essential to the expression of that political opinion. The registration of an opinion as a trade mark does not bring any advantage to political debate.[154]

The Grand Board of Appeal went even further in its rejection of the views advanced here. Upon discussion of different instances where trademarks and speech interact (more precisely, infringement litigation and refusals of registration), it held that:

---

[153] This can occur where the rightsholder uses its mark not only to distinguish or promote its goods or services, but also to express its view on a broader topic and engage in public debate. This was the case, for instance, in the *Benetton* advertisements saga decided by the Federal Constitutional Court of Germany. *See* Bundesverfassungsgericht [BverfGE] [Federal Constitutional Court] Dec. 12, 2000, 102 Entscheidungen des Bundesverfassungsgerichts [BVERFGE] 347; Bundesverfassungsgericht [BverfGE] [Federal Constitutional Court] Mar. 11, 2003, 107 Entscheidungen des Bundesverfassungsgerichts [BVERFGE] 275. The contentious ads showed different images dealing with issues of environmental, social, and health concern, for instance, a picture of a person's naked behind with the words "HIV Positive" stamped on the skin, or a dying AIDS patient surrounded by his grieving family. The apparel company's reputed mark consisting of the words "UNITED COLORS OF BENETTON" contained in a green square was featured in a corner of the ads. In overturning the decision of the Federal Court of Justice upholding a ban on the publication of these ads pursuant to the Unfair Competition Act, the Federal Constitutional Court gave much weight to the robust protection afforded to political expression under the German Constitution. According to the Court, this degree of protection is in no way affected by the fact that the socially relevant message is conveyed in an advertising context where the aim is not only to engage in public debate, but also to further the company's commercial interest in attracting consumers by building a particular brand image. In the words of the Court:

> > The advertisements draw the attention to socially and politically relevant issues and are also suitable for gaining public attention for these issues. The special protection that [the right to freedom of expression] provides particularly for this form of expression is not diminished by the fact that [the ads] . . . do not make any substantial contribution to the debate on the deplorable situations that they depict. The (mere) denouncement of an injustice can also be an important contribution to the free exchange of ideas. . . . The denouncing effect of the advertisements, which are critical of society, is not called into question by the advertising context.
>
> Bundesverfassungsgericht [BverfGE] [Federal Constitutional Court] Dec. 12, 2000, 102 Entscheidungen des Bundesverfassungsgerichts [BVERFGE] 347, ¶ 62-63 (Ger.).

[154] R 260/2021-G, Application of Matthias Zirnsack (COVIDIOT), ¶ 138 (May 16, 2024).

> The need to protect the freedom of expression is necessarily higher where the use of a certain expression in the context of actual commercial or even political activities is concerned, as opposed to the mere registration, in particular because failure to register a mark does not prohibit the applicant from using the sign.[155]

This constitutes a missed opportunity for EU trademark law to recognize the broader role that registration can play in furthering the expressive interests of a wide range of individuals beyond trademark applicants. This finding is, however, consistent with previous EUIPO decisions and—more worryingly—the case law of the European Court of Human Rights, where speech restrictions resulting from refusals of registration have been consistently scrutinized under the narrower scope of protection afforded to commercial expression.[156] This is difficult to reconcile with the findings of several German courts, for instance, which (as we saw earlier) have permitted recoders' unauthorized uses of reputed marks under the broader scope of protection accorded to artistic expression.[157] If adopted, the approach to interaction cases suggested here would eliminate this inconsistency between infringement and registration disputes, while also ensuring better enforcement of the freedom of expression guarantee under human rights instruments.

C. Brand Restriction

There are precedents on both sides of the Atlantic in which courts have acknowledged that brand restriction measures, notably health warnings and plain packaging requirements, interfere with rightsholders' freedom of expression.[158] In the United States, these arguments have, for the most part, led courts to side with trademark owners after finding that the challenged measure is incompatible

---

155 *Id*. at ¶ 143.

156 In the words of the EUIPO Grand Board of Appeal in *COVIDIOT*:

> The case-law of the ECtHR shows that there is categorisation of expression of an opinion according to the importance of its content in order to determine the extent of the protection granted. This hierarchical model of expression puts commercial expression at a lower level than others, especially when compared to political forms of expression. An expression containing a commercial message may be subject to different restrictions than a political speech.

R 260/2021-G, Application of Matthias Zirnsack (COVIDIOT), ¶ 136 (May 16, 2024). *See also* CSIBI v. Romania, App. No. 16632/12 (ECtHR, June 4, 2019); Dor v. Romania, App. No. 55153/12 (ECtHR, Aug. 25, 2015).

157 Bundesgerichtshof [BGH] [Federal Court of Justice] Apr. 7, 2005, NJW 2856 (2005) (Ger.) (for an English translation, *see Violet Postcard*, 38 Int'l Rev. of Intell. Prop. & Competition L. 119 (2007)); Oberlandesgericht Hamburg [OLG] [Hamburg Higher Regional Court] Jan. 5, 2006, GRUR-RR 231 (2006) (Ger.).

158 See case law cited in note 41 *supra*.

with the broad protection the First Amendment affords to speech.[159] This is in contrast with European courts, which have consistently ruled in favor of the legislature under the wider margin of appreciation afforded to domestic decision-makers under the ECHR and EU Charter.[160] Their approach to the balancing exercise has often been cursory, opting for a hierarchical resolution of the clash of rights in which the governmental interest in advancing the right to (public) health readily trumps rightsholders' freedom of commercial expression—which, as discussed, warrants less protection than political or artistic speech.[161]

Against this backdrop, the refined approach suggested here would require courts hearing challenges to brand restriction measures to factor the expressive interests of consumers of branded goods into their analysis, alongside those of the rightsholder. This reconceptualization has profound implications for how courts approach this form of interaction. Brand restriction mandates are often adopted in conjunction with other measures (notably combined health warnings using images and text to alert consumers to the risks of the goods concerned) that, over time, erode the expressive meanings conveyed by the targeted marks—meanings on which consumers may have come to rely for self-expression. Furthermore, where a mark has become a cultural symbol or permeated everyday language, courts should also factor in the expressive interests of the public (and even those of potential recoders who draw on the mark for parody or commentary) since the mark's role as an expressive artifact may be lost over time. The MARLBORO mark is an obvious example: the masculinity and rugged independence with which it was long associated—meanings vivid enough to lodge the "Marlboro Man" in our cultural vocabulary—are being steadily eroded by these measures.

The proposed rebalancing would widen the range of expressive interests recognized as affected by brand restriction measures, leading courts to weigh the legislature's interest in advancing the

---

159 Rightsholders' challenges to trademark-restrictive measures have been successful in the following cases: R.J. Reynolds Tobacco Co. v. FDA, 696 F.3d 1205, 1212 (D.C. Cir. 2012); Lorillard Tobacco Co. v. Reilly, 533 U.S. 525, 569-71 (2001). *See*, in contrast, Cigar Assoc. of Am. v. FDA, 315 F. Supp. 3d 143, 164 (D.D.C. 2018).

160 Case C-547/14, Philip Morris Brands SARL v. Secretary of State for Health, ECLI:EU:C:2016:325 (2016); Opinion of Advocate General Kokott in Case C-547/14, Philip Morris Brands SARL v. Secretary of State for Health, ECLI:EU:C:2015:853 (2015); R. (on the application of British American Tobacco UK Ltd.) v. Secretary of State for Health [2004] EWHC 2493 (Admin). The only precedent where trademark-restrictive measures have been found to constitute a disproportionate encroachment on tobacco manufacturers' freedom of expression is the Opinion of Advocate General Fennelly in Case C-376/98, Germany v. European Parliament, ECLI:EU:C:2000:324 (2000).

161 Case C-547/14, Philip Morris Brands SARL v. Secretary of State for Health, ECLI:EU:C:2016:325, ¶ 152 (2016); Opinion of Advocate General Kokott in Case C-547/14, Philip Morris Brands SARL v. Secretary of State for Health, ECLI:EU:C:2015:853, ¶ 233 (2015).

right to public health against the political and artistic expression of a broad range of individuals, rather than against the rightsholder's commercial speech alone.[162] Support for this proposition can be found in the European Court of Human Rights' case law on mixed expression. The Court has consistently held that forms of expression usually characterized as commercial, such as advertising, must be reviewed under a stricter standard—that is, with a narrower margin of appreciation—where the aim and content of the message are fundamentally non-commercial.[163] So it held, for instance, in the case of an animal-welfare association's broadcast urging viewers to reduce their meat consumption, where the message did not seek to attract custom but to contribute to a broader public debate.[164] In the words of the Court:

> [T]he applicant association's film fell outside the regular commercial context inciting the public to purchase a particular product. Rather, it reflected controversial opinions pertaining to modern society in general. . . .
>
> As a result, in the present case the extent of the margin of appreciation is reduced, since what is at stake is not a given individual's purely "commercial" interests, but his participation in a debate affecting the general interest.[165]

---

[162] This approach is also in keeping with the consistent enforcement of the guarantees provided to speech under human rights instruments across different forms of interaction. As we saw upon study of infringement cases, trademark use by recoders has often been found deserving of protection under the broader scope of protection afforded to artistic speech—including in cases involving recoded use of renowned tobacco trademarks in anti-smoking campaigns, notably: Bundesgerichtshof [BGH] [Federal Court of Justice] Apr. 17, 1984, NJW 1956 (1984) (Ger.) (for an English translation of the decision, see Re Parodying of Cigarette Advertising (VI ZR 246/82) [1986] E.C.C. 1); Cour de cassation [Cass.] [supreme court for judicial matters] 2e civ., Oct. 19, 2006, Bull. civ. II, No. 282 (Fr.) (for an English translation of the decision, *see* Comité National contre les Maladies Respiratoires et la Tuberculose v. Société JT International GmbH, 38 Int'l Rev. Intell. Prop. & Competition L. 357 (2007)).

[163] Although they carry special weight, the aim and content of the expression are not the only factors that the ECtHR has taken into consideration when assessing the margin of appreciation that must be afforded in cases of mixed expression. This has been noted by Sakulin. As he points out, in *Barthold v. Germany*, for instance, the ECtHR's finding that the veterinarian's mixed speech was deserving of robust protection under Article 10 also took into consideration: (a) the degree of influence that the appellant had on the means of communication; (b) whether the appellant had paid for the advertisement; or (c) the effect that the expression was bound to have on the public. Barthold v. Germany, App. No. 8734/79 (ECtHR, March 25, 1985). Sakulin relies on this, and other cases, to make an interesting point: courts must detach the definition of commerciality that applies in the context of Article 10 from that which usually applies in other areas of law, notably trademark law or unfair competition law. Otherwise, courts risk adopting an overreaching definition of commerciality that can lead to most instances of mixed speech being categorized as commercial speech. Sakulin, *supra* note 72, at 169-74.

[164] VgT Verein Gegen Tierfabriken v. Switzerland, App. No. 24699/94 (ECtHR, June 28, 2001).

[165] *Id.* ¶ 70-71 (citations omitted).

The Court has reached similar conclusions in cases involving television advertisements by political and religious organizations.[166] Under the stricter tests applied to political and artistic expression, the proposed rebalancing would require courts adjudicating challenges to brand restriction measures to assess their compatibility with freedom of expression against a higher burden of proof than applies to commercial speech. The European Court of Human Rights has held that, on strict scrutiny, "the need for any restrictions must be established *convincingly*."[167] This is a markedly higher threshold than the one applied to commercial expression, where the Court has held that a measure need only be "justifiable in principle and proportionate,"[168] or justified on "reasonable grounds."[169]

On this view, "convincing" evidence would require public authorities to show that the causal link between the restrictive measure and the intended effect (in the tobacco context, a reduction in smoking prevalence) rests on more than coherence or plausibility. Where the quantitative evidence remains inconclusive, there is room to argue that this higher threshold cannot be met by inference alone.

CONCLUSION

This paper has argued that courts on both sides of the Atlantic adjudicate interaction cases under an impoverished conception of who actually speaks through a trademark. Once the full range of expressive users (owners, consumers of branded goods, recoders, consumers of goods bearing recoded marks, and the public) is brought into view, the standard ways of resolving these disputes begin to look not merely incomplete but, in places, incoherent. The practical payoff of the typology lies in what it asks courts to do differently in each of the three interaction contexts.

In infringement litigation, the move is to stop treating the commercial character of a recoded use as a threshold that forecloses speech protection, and to ask instead whether the use causes expressive harm to the mark—a question that, by pitting speech against speech, makes the balancing not only commensurable, but also internal to trademark law rather than importing constitutional

---

166 TV Vest As & Rogaland Pensjonistparti v. Norway, App. No. 21132/05, ¶ 64 (ECtHR, Dec. 11, 2008); Murphy v. Ireland, App. No. 44179/98, ¶ 70 (ECtHR, July 10, 2003).

167 VgT Verein Gegen Tierfabriken v. Switzerland, App. No. 24699/94, ¶ 66 (ECtHR, June 28, 2001); Hertel v. Switzerland, App. No. 25181/94, ¶ 46 (ECtHR, Aug. 25, 1998); Handyside v. The United Kingdom, App. No. 5493/72, ¶ 49 (ECtHR, Dec. 7, 1976) (emphasis added).

168 Markt Intern Verlag GmbH & Klaus Beermann v. Germany, App. No. 10572/83, ¶ 33 (ECtHR, Nov. 20, 1989).

169 *Id.* at ¶ 37.

reasoning from outside it. In registration cases, the proposal is to abandon the assumption that an applicant's interest in a sign is purely commercial: the same sign that a court would recognize as carrying political or artistic meaning in a recoder's hands cannot coherently be dismissed as commercial in an applicant's. This narrows the proper scope of the morality exclusion—and, in particular, brings into view the role that registration can play in efforts to reappropriate an offensive sign. In challenges to brand restriction measures, the suggestion is to recognize that the interests on the speech side of the scale extend well beyond the rightsholder's commercial expression to the political and artistic interests of consumers of branded goods and the public. Such interests should weigh genuinely in the balancing, not be treated as readily outweighed by the legislature's objectives (especially in Europe).

None of this will eliminate inconsistency. The U.S. Supreme Court and the CJEU will continue to play an indispensable role in providing guidance. The balancing exercises proposed here are demanding ones that will not always yield clear answers, and the approach generates frictions of its own. The contribution of this paper is not to eliminate that complexity but to give courts a more accurate map of it. Recognizing the diversity of expressive users, and replacing categorical proxies with a substantive inquiry into the expressive interests genuinely at stake, is the most promising route to outcomes that are at once fairer, more consistent, and more faithful to the human rights guarantees that freedom of expression demands. That is a modest claim in one sense and an urgent one in another: modest, because it refines rather than replaces existing doctrine; urgent, because the cost of the present disorder is borne by the speech it quietly chills.

CAST FROM THE SAFE HARBOR INTO OPEN WATERS OF ACTIVE DUTIES: THE DIGITAL SERVICES ACT ALTERS THE COURSE OF INTERMEDIARY LIABILITY IN THE EU*

*By Anthonia Ghalamkarizadeh,** Florian Richter,*** Janis Beckedorf,**** and Marvin Jäschke*****

TABLE OF CONTENTS

---

* This article should be cited as Anthonia Ghalamkarizadeh, Florian Richter, Janis Beckedorf & Marvin Jäschke, *Cast from the Safe Harbor into Open Waters of Active Duties: The Digital Services Act Alters the Course of Intermediary Liability in the EU*, 116 Trademark Rep. 550 (2026).

** M.Jur. (Oxford), Attorney-at-law and Partner at Hogan Lovells International LLP, Hamburg, Germany, Member, International Trademark Association (INTA). Anthonia is a member of the INTA Technology Transformation Committee. She and her team specialize in advising on IP litigation and on EU online platform compliance.

*** LL.M. (Edinburgh), Attorney-at-law and Counsel at Hogan Lovells International LLP, Hamburg, Germany, Member, INTA.

**** Dr.iur., Attorney-at-law and Associate at Hogan Lovells International LLP, Hamburg, Germany, Member, INTA.

***** Dr.jur., Attorney-at-law and Associate at Hogan Lovells International LLP, Hamburg, Germany, Member, INTA.

ABSTRACT

February 2024 saw the implementation of a marked shift in Europe's intermediary regulation. The Digital Services Act navigated rules for online web hosts, also known as intermediaries, away from the familiar "safe harbor" concept and toward more open seas of a structured, tiered system of active obligations. Where the Electronic Commerce Directive allowed online services to float with limited interference—leaving a great deal to national case law developments, with resulting fragmentation—the Digital Services Act now charts a more deliberate course with transparent content moderation, balanced liability provisions, and layered due diligence requirements. Digital Services Act enforcement follows a two-tier system with national authorities patrolling domestic waters, while the European Commission itself oversees the Very Large Online Platforms. Alongside public oversight, private enforcement is steeply on the rise, with resulting clashes between outcomes. Adding to the ever-denser sets of obligations, recent European Union and national case law has been narrowing the channel between a provider's own and third-party content, exposing hosting services, and particularly online platforms, to primary liability. And with integrating artificial intelligence functionalities into platform environments, those that actively shape third-party content may find themselves navigating away from the safe confines of the harbor and into uncharted territories.

I. INTRODUCTION

The Digital Services Act ("DSA"),[1] which became effective on February 17, 2024, establishes a harmonized framework for online intermediary services active in the European Union ("EU" or "Union"). Before it, the Electronic Commerce Directive ("eCD"),[2] enacted in 2000, provided only fundamental secondary liability concepts for intermediaries. Building on that liability framework, the DSA now establishes clear rules for intermediaries, emphasizing transparent content moderation procedures and a balanced liability system that protects platforms while ensuring swift action against illegal content on these platforms. As such, the DSA takes its place as a pioneer regulation among global efforts to regulate intermediary services and, in particular, large, globally active platforms. Among other countries, the United Kingdom ("UK"), Australia, and India have also implemented online safety

---

1 Regulation (EU) 2022/2065 of the European Parliament and of the Council of 19 October 2022 on a Single Market for Digital Services and amending Directive 2000/31/EC (Digital Services Act), 2022 O.J. (L277) 1.

2 Directive 2000/31/EC of the European Parliament and of the Council of 8 June 2000 on certain legal aspects of information society services, in particular electronic commerce, in the Internal Market ("Directive on electronic commerce"), 2000 O.J. (L178) 1.

regulations, while their nuances differ.[3] As the first holistic and horizontal regulation of intermediary liability, online safety, and content moderation, the DSA will likely be considered and emulated across many other jurisdictions seeking to enhance the level of protection for online users on their territory. Section II of this article provides a condensed overview of the liability principles and sets of obligations under the DSA. We then put the spotlight on public and private enforcement trends in Section III. Section IV examines the development from secondary toward primary liability of intermediaries, and Section V discusses the impact on liability of artificial intelligence ("AI") functionalities integrated into online platform environments.

II. SPOTLIGHT ON: INTERMEDIATE LIABILITY IN THE EU

A. Liability of Intermediary Services

In addition to providing new rules for online intermediary services, the DSA is also the first major legislative update on the intermediary liability regime in the EU since its introduction by the eCD in 2000. The eCD was the first EU law to set harmonized liability rules for online intermediaries, introducing two cornerstones of the EU's Internet law: the country-of-origin principle[4] and a tiered system of liability privileges for third-party content, differentiating between the different types of intermediary services and prohibiting general monitoring obligations. Under the eCD, EU Member States had to implement these rules into their respective national laws.

The DSA now retains the system of extensive liability privileges from the previously applicable eCD but also layers on a range of proactive compliance obligations and transparency requirements, the intensity of which depend on the type of regulated intermediary.

Following from this, intermediary service providers are—in principle—privileged where it comes to illegal third-party content. The law differentiates between three groups of intermediary services with different safe harbor rules that acknowledge the varying roles of these services regarding third-party content.

---

[3] For an overview of regulations across jurisdictions, see Rosenblat, Agrawal, Barrett, Online Safety Regulations Around The World: The State of Play and The Way Forward—A Resource Guide, https://bhr.stern.nyu.edu/wp-content/uploads/2025/04/NYU-CBHR-Online-Regulations_Updated-Apr-23.pdf (last accessed May 26, 2026).

[4] The country-of-origin principle states that online services operating lawfully under the rules of their country of establishment can operate across the EU without having to comply with other Member States' national laws in the same coordinated field. *See* eCD, *supra* note 2, Art. 3(1) and (2).

1. The Three Fundamental Types of Intermediary Services and Safe Harbor

Mere conduit services transmit information provided by a user in a communication network or provide access to a communication network. Pursuant to Art. 4(1) DSA, the provider of such a conduit service shall not be liable for the third-party information transmitted or accessed by its users if it (cumulatively):

- did not initiate the transmission,
- did not select the receiver of the transmission, and
- did not select or modify the information transmitted or accessed.

Caching services transmit information provided by a user in a communication network, involving the automatic, intermediate, and temporary storage of that information, performed for the sole purpose of making its onward transmission to other users more efficient. Pursuant to Art. 5(1) DSA, the provider of such a caching service shall not be liable if it (cumulatively):

- did not modify the information,
- complies with conditions on access to the information,
- complies with rules regarding updating of the information,
- does not interfere with the lawful use of the information, and
- acts expeditiously to remove or to disable access to the information upon obtaining actual knowledge that the information at the initial source of the transmission has been removed or the access to it has been disabled.

Hosting services store information provided by, and on the request of, a user. According to Art. 6(1) DSA, the provider of a hosting service shall not be liable, if it (alternatively):

- does not have actual knowledge of the illegality of the content or circumstances from which the illegality is apparent, or
- upon obtaining such knowledge/awareness acts expeditiously to remove or to disable access to such content.

2. Sub-forms of Hosting Services Under the DSA

In the eyes of the DSA, **online platforms** and **B2C e-commerce platforms** (online marketplaces, app stores, and other business models) **are specific types of hosting service providers**. Under the legal definition in Art. 3(i) DSA, "online platform" means "a hosting service that, at the request of a recipient of the service, stores and disseminates information to the public." In consequence, the hosting provider liability privilege applies to all forms of online platforms, including very large online platforms

("VLOPs") and B2C e-commerce platforms. The below image illustrates the interrelationship of various scopes used by the DSA.

3. The Hosting Provider Liability Privilege: A Safe Harbor for Online Platforms in the EU and Its Limits

As previously described, the hosting provider liability privilege of Art. 6 DSA prescribes that hosting providers (including all forms of online platforms) in principle are not liable for any third-party content provided by its users.

This hosting privilege applies horizontally to all sources of liability—including civil, administrative, and even criminal law, but it is still debated whether the hosting privilege also applies to liability to cease and desist and injunctive relief, in particular because Art. 6(4) DSA and its predecessor under the eCD set out that the hosting privilege "shall not affect the possibility for a judicial or administrative authority [. . .] to require the service provider to terminate or prevent an infringement."

That said, it is commonly accepted also for injunctive relief in civil liability cases that the requirements of the hosting privilege at least indirectly apply—in the sense that a liability to cease and desist from hosting (and publicly disseminating) illegal third-party content also requires the provider's actual knowledge of the illegal content in question.

The element of "**actual knowledge**" plays the key role for the applicability of the privilege. In its leading opinion on this issue, in the combined cases *YouTube and Cyando* (C-682/18),[5] the Court of Justice of the European Union ("CJEU") clarified that actual knowledge means knowledge of the specific illegal content in question. Conversely, general knowledge of a hosting provider that its service is also used for the storage of illegal content is not sufficient to trigger liability. However, positive knowledge is not required either. Instead, it is sufficient that the illegality is readily (prima facie) identifiable on the basis of the information presented to the hosting provider.

Actual knowledge in the context of IP infringements typically comes from notices submitted by rights owners but can also result from the hosting provider's voluntary own-initiative investigations. The DSA draws two lines in the sand (and as is the way of sand, it shifts) on liability resulting from monitoring:

First, where a hosting provider proactively engages in voluntary own-initiative monitoring and content moderation, this activity will not, in and by itself, affect the availability of the hosting privilege. While the contrary was argued by some plaintiffs in the past, Art. 7 DSA now establishes that providers are not penalized for such voluntary investigations—and in fact, disincentivizing providers from voluntarily removing illegal content on their services would be a disservice to the objectives of online safety. In other words, only where a provider identifies illegal content in the course of its monitoring will it need to take moderation action to avoid liability in relation to that specific piece of content.

And second, the **ban on general monitoring** under Art. 8 DSA clarifies that a hosting provider is not legally required to generally screen and investigate third-party content on its service for potential infringements. It would therefore be unlawful for a national law, court, or authority to require a hosting provider to implement extensive filtering systems that

(i) apply indiscriminately to all users and their content,

(ii) as a preventive measure,

(iii) exclusively at the provider's expense, and

(iv) must be put in place for an unlimited period of time.

(See the CJEU cases *SABAM v. Netlog* (C-360/10)[6] and *Scarlet Extended* (C-70/10).[7]) Conversely, the CJEU more recently held in

---

[5] Case C-682/18 and C-683/18, YouTube Inc. v. Cyando AG, Judgment of the Court, June 22, 2021.

[6] Case C-360/10, Belgische Vereniging van Auteurs, Componisten en Uitgevers CVBA (SABAM) v. Netlog NV, Judgment of the Court, Feb. 16, 2012.

[7] Case C-70/10, Scarlet Extended SA v. Société Belge des Auteurs, Compositeurs et Editeurs SCRL (SABAM), Judgment of the Court, Nov. 24, 2011 (finding such general monitoring to be a violation of Article 15 of the eCD and fundamental rights).

Eva Glawischnig-Piesczek v. Facebook (C-18/18)[8] that it does not amount to a prohibited general monitoring obligation where a court orders a hosting provider to identify and block access to content that is essentially the same, in terms of its illegal quality, as another piece of content that triggered the initial finding of illegality. While issued under the eCD and before the DSA was enacted, these key precedents on hosting provider liability continue to be good law, given that the DSA took over the liability framework of the eCD. Where exactly to draw the fine line between prohibited general monitoring obligations and permissible monitoring and stay-down obligations in each given case remains a blurry battleground in intermediary enforcement cases, and guidance from case law on the distinction is still surprisingly scarce, such that national courts have largely been left to navigate proportionality on a case-by-case basis.

The safe harbor liability privilege under the DSA is not unlimited, however, and providers may become *ineligible* if certain conditions are met:

"Active Role." The hosting privilege wants to benefit intermediaries that provide services of a mere technical, automated, and passive nature (see Recital 42 eCD / Recital 18 DSA). Once a hosting provider leaves this role of an online infrastructure provider and moves into a more active role by interfering with content uploaded by its users, it is at risk of forfeiting the liability privilege. The "active role" exception was developed by the CJEU in *L'Oréal v. eBay* (C-324/09), where the court ruled that

> [when] the operator has **provided assistance** which entails, in particular, **optimising the presentation of the offers for sale in question or promoting those offers**, it must be considered not to have taken a neutral position between the customer-seller concerned and potential buyers but to have played an **active role** of such a kind as to give it knowledge of, or control over, the data relating to those offers for sale.[9]

Examples of behavior that involves a degree of editorial control of the provider and therefore might trigger an active role are where a provider enriches third-party content by adding images or text or advertises the content on its own initiative and in its own name. In contrast, where a provider's contributions remain structural—such as offering a search functionality, making automated content recommendations or indexing content to create a better user

---

[8] Case C-18/18, Eva Glawischnig-Piesczek v. Facebook Ireland Limited, Judgment of the Court, Oct. 3, 2019.

[9] Case C-324/09, L'Oréal SA v. eBay International AG, Judgment of the Court, July 12, 2011.

experience—all stay below the "active role" threshold, as clarified in *YouTube and Cyando* (C-682/18).[10]

B. Due Diligence Obligations

Benefits rarely come without duties, and the DSA combines the liability privileges for intermediary services with a suite of due diligence obligations in a layered approach, depending on the abstract risk levels attributable to the different types of intermediary services:

1. Layered Approach to Intermediary Due Diligence

While all intermediary service providers are obliged to cooperate with authorities and to ensure transparency through a range of measures (including transparency reports and transparent terms and conditions), hosting providers (including online platforms) must also meet specific content moderation obligations.

All hosting providers must implement a notice and takedown mechanism, referred to in the DSA as "notice and action," allowing users to report specific pieces of content that are illegal under EU laws (Art. 16 DSA). The process must ensure that submission of sufficiently substantiated notices is possible for any entity and person, irrespective of a contractual relationship with the service provider. Whether or not this requirement clashes with a requirement to register before submitting a notice, or whether such a requirement is a beneficial safety gate to filter out abusive notices, is one of the many questions not yet answered under case law on the DSA. Providers must provide the affected users (i.e., the uploader and/or the notice submitter) with a statement of reasons for making every content moderation decision as well as inform authorities of certain suspected criminal offenses.

More advanced content moderation, governance, and transparency obligations apply to the group of online platforms, with the exception of micro or small enterprises (see Art. 19 DSA).

Online platforms are required to provide two additional redress options for users affected by a content moderation decision: an internal complaint-handling mechanism (Art. 20 DSA) and alternative dispute resolution (Art. 21 DSA). Additionally, online platforms must ensure that reports by trusted flaggers are prioritized (Art. 22 DSA). Trusted flagger status can be awarded to independent entities with particular expertise and competence in tackling illegal content. The designation is made by the competent DSA authority of the Member State in which the entity is established, the Digital Services Coordinator ("DSC").

---

[10] YouTube Inc. v. Cyando AG, *supra* note 5.

Other measures include the prohibition of manipulative or deceptive interface designs (so-called "dark patterns"), transparency rules for advertising, commercial communications and recommender systems on the platform and, critically, rules for the protection of minors under Art. 28 DSA. While the Article contains only a vague intention statement of ensuring a safe online environment for minors, the recently published Guidelines on the protection of minors of the European Commission ("EC") of July 14, 2025, set out a detailed playbook of granular measures from which online platforms must now choose their individual compliance menu and identify any remaining compliance gaps they may need to close.

Finally, even further, highly intensive obligations on transparency and risk mitigation are in place for very large online platforms and search engines ("VLOPs" and "VLOSEs"). These are online platforms and search engines with an average monthly user-base in the EU of at least 45 million, roughly translating to 10% of the EU's population. VLOP and VLOSE obligations kick in only after a designation decision by the European Commission, which maintains a central list of the designated entities—26 to date.[11]

The following chart gives a high-level overview on the different obligations and their applicability to intermediary service providers ("ISP"), hosting service providers ("HP"), and online platform providers ("OP") in the EU. VLOP and VLOSE obligations are excluded.

DSA OBLIGATIONS	ISP	HP	OP
Arts. 9 and 10—Orders from national authorities Intermediary service providers ("ISP") must comply with orders by national authorities to remove illegal content or disclose user information and must inform the issuing authority of the steps taken.			
Art. 11—Single electronic POC for authorities ISPs must designate a single electronic point of contact for communication with authorities.			

[11] *See* https://digital-strategy.ec.europa.eu/en/policies/list-designated-vlops-and-vloses (last accessed May 26, 2026).

DSA OBLIGATIONS	ISP	HP	OP
Art. 12—Single electronic POC for users ISPs must designate a single electronic point of contact for communication with users.			
Art. 14—Terms and conditions ISPs must clearly state in their terms and conditions ("T&C") any restrictions they place on users' content. This includes details about their content moderation practices such as policies, tools, algorithmic decisions, human review, and internal complaint procedures. (VLOPS and VLOSEs must additionally publish summaries and translations.)			
Art. 15—Transparency reporting ISPs must publish an annual transparency report on their content moderation activities. Scope of the reports depends on a service's specific obligations based on its intermediary category scoping. Reports must make use of the ***dedicated templates*** published by the European Commission in its Implementing Regulation.			
Art. 16—Notice and action mechanism Hosting service providers ("HP") must provide an electronic system to report alleged illegal content. The provision details the formal requirements for such reports as well as procedural steps. Sufficiently substantiated notices establish actual knowledge of illegality that can result in loss of the hosting privilege under Art. 6 DSA if the appropriate moderation action is not promptly taken.			

DSA OBLIGATIONS	ISP	HP	OP
Art. 17—Statement of reasons If content is removed, restricted, or demoted or accounts or payments are suspended or terminated due to illegality or T&C violations, HP must inform affected users with a clear explanation and redress options.			
Art. 18—Notification of criminal offenses If HP become aware of content suggesting serious crimes, they must promptly notify the relevant law enforcement authority.			
Art. 20—Internal complaint-handling system Online platform providers ("OP," including B2C e-commerce platforms) must offer electronic complaint-handling, allowing users to challenge moderation decisions for up to 6 months.			
Art. 21—Out-of-court dispute settlement OP must clearly and accessibly inform users, through their interface, of the option to use certified out-of-court dispute settlement bodies ("OOCDSB") to resolve disputes.			
Art. 22—Trusted flaggers OP must quickly process reports from trusted flaggers ("TF") with priority. The TF status is granted by the national Digital Service Coordinator upon application to selected experts.			
Art. 23—Protection against misuse OP, after a prior warning, must suspend users or TFs who frequently publish manifestly illegal content or submit unfounded reports or complaints.			

DSA OBLIGATIONS	ISP	HP	OP
Art. 24—Transparency reporting In addition to the information in **Art. 15**, OP must provide a more detailed transparency report with additional information. OP must also provide to the EC decisions and statements of reasons under **Art. 17** for inclusion in a public database operated by the EC.			
Art. 24(2), (3)—Publish average monthly active user numbers OPs must publish every 6 months the average monthly active EU user numbers, calculated under the EC's methodology guidance and covering all users who engage with the service at least once a month. Upon request from a DSC or the EC, they must promptly provide this information.			
Art. 25—Prohibition of dark patterns Using deceptive or manipulative user interface design features ("dark patterns") that impair users' ability to make free and informed decisions is prohibited.			

DSA OBLIGATIONS	ISP	HP	OP
Art. 26—Advertising and commercial communications transparency OP must clearly label ads and disclose that the information is an advertisement, its beneficiary and payor, why the ad was presented to the individual user (targeting parameters) and how users can change targeting preferences. No ads may be shown based on profiling with sensitive personal data under Art. 4 No. 4, Art. 9(1) of the General Data Protection Regulation ("GDPR"). Users must be able to mark commercial communications (compliance by design obligation).			
Art. 27—Recommender system transparency OP must explain in the T&C, how their recommender systems work (including most significant criteria to determine information suggested to users and reasons for the relative importance of those parameters). Where multiple parameters are available, users must have directly and easily accessible options for selecting and modifying them.			
Art. 28—Protection of minors OP must ensure a high level of privacy and safety for minors. On July 14, 2025, the EC published extensive ***guidelines on the protection of minors***, which all OP must closely follow (depending on the degree of exposure of minors to their services and associated risks).[12]			

[12] *See* https://digital-strategy.ec.europa.eu/en/library/commission-publishes-guidelines-protection-minors (last accessed May 26, 2026).

2. The Notice and Action Mechanism in the Hosting Privilege Logic

The hosting privilege and underlying logic that hosting providers must only react once they become aware of illegal third-party content on their services forms the basis for the "notice and action" mechanisms set forth at Art. 16 DSA (also referred to as "notice and takedown"). This has now been fully harmonized under the DSA, and Art. 16 DSA sets out in detail how notices are to be submitted and processed. The process is structured in three mandatory steps:

1. **Notice submission.** Many hosting providers offer several notice submission channels for different purposes and typically provide a dedicated IP infringement submission channel for IP rights holders. Notably, under national case law, a cease-and-desist letter or a statement of claims can also constitute a valid infringement notice. Consequently, it can be strategically advisable for a hosting provider to act against pieces of content brought to its attention through such channels even if prior notices against the same content had been rejected.
2. **Assessment** of the notice in a timely, diligent, non-arbitrary, and objective fashion (Art. 16(6) DSA). What is "timely" can vary from case to case. The more pressing and obvious the illegality is, the quicker a hosting provider will need to react. As a rule of thumb, in the authors' experience, **three working days** may be considered acceptable in routine cases. Statutory deadlines exist only for some specific types of infringement (e.g., Art. 22(8) EU General Product Safety Regulation ("GPSR")[13]—three working days; Art. 3(3) Terrorist Content Regulation ("TCOR")[14]—one hour upon authority order). When reviewing a notice, the DSA does not require a hosting provider to conduct a detailed legal examination (Art. 16(3) DSA) or go on a factfinding expedition. Such an insufficiently substantiated notice can, by the letter of the law, be rejected and ignored without loss of the hosting privilege. That said, national courts often tend to apply more permissive notice standards, finding in favor of notice submitters even where the exchange of many submissions is necessary to determine an infringement—which would make it far from clear and manifestly obvious.

---

13 Regulation (EU) 2023/988 of the European Parliament and of the Council of 10 May 2023 on general product safety and repealing Directive 2001/95/EC, 2023 O.J. (L135) 1.

14 Regulation (EU) 2021/784 of the European Parliament and of the Council of 29 April 2021 on addressing the dissemination of terrorist content online, 2021 O.J. (L172) 79.

3. **Action** to be taken if the notice is sufficiently substantiated. What action needs to be taken depends on the specific circumstances of each case, and in particular on: (i) the gravity of the infringement, and (ii) how easy it is for a hosting provider to identify and prevent the notified (and potential future) infringements. We can distinguish between:
   a. **takedown** of the reported third-party content (always required);
   b. **extended takedown** of other hosted pieces of third-party content that were not directly reported, but are essentially identical to the reported content;
   c. **stay down**, i.e., filtering and monitoring measures to prevent the upload of essentially identical infringing content in the future.

Whether and to which extent stay-down obligations must be part of an intermediary's actions following a sufficiently substantiated infringement notice under the DSA is still unclear to date; the DSA provides no clear guidance. Under the previous liability regime of the eCD, it was generally accepted in Germany, for instance, that stay down was part of the hosting provider obligations following a sufficiently substantiated notice.

Under the DSA, this can be disputed. On the one hand, Art. 16 DSA does not address stay down as a potential (re)action to an infringement notice. A far-reaching stay-down obligation can also quickly conflict with the general monitoring prohibition under Art. 8 DSA. On the other hand, it is generally accepted that national authorities can issue stay-down orders—but only in relation to specific pieces of content—under Art. 9 DSA in conjunction with national law. It is to be expected that courts will continue to apply national principles developed under case law in the same way as before the DSA—resulting in a continuation of the fractured regulatory environment the DSA sought to eliminate, until the CJEU will issue a definitive ruling on the question of stay down.

C. B2C e-Commerce Platform Obligations

Even though B2C e-commerce platforms are just one of several online platform business models, the DSA explicitly provides additional obligations for such "online platforms allowing consumers to conclude distance contracts with traders." The exact scope of those obligations remains unclear to date. It is debated whether it is a requirement of the definition that the contracts between traders and consumers must be concluded on the platform, or whether users can also be sent off platform to conclude checkout.

The latter business model suffices to bring a B2C e-commerce platform in scope of the Platform-to-Business Regulation ("P2B").[15]

These additional DSA obligations aim to ensure a high level of consumer protection for distance sales: B2C platform providers are required to collect "know your business customer" ("KYBC") information for all traders prior to allowing them to engage with consumers on the platform. They must also make best efforts to assess whether the information is complete and reliable, by using public databases and supporting documents, Art. 30 DSA. B2C providers must also meet "compliance by design" requirements, so that traders on their service can, in turn, comply with their own obligations for mandatory pre-contractual information, compliance, and product safety information under applicable Union law, Art. 31 DSA. Here as well, B2C providers must check the provided information for reliability and completeness and conduct best effort checks.

The assessment obligations, in particular, go far beyond the pre-existing checks under EU product safety law using databases for unsafe products ("Safety Gate Portal," see Art. 22(6) GPSR). In practice, they also prove to be extensive and burdensome, particularly in their interplay with the EU's various product safety and consumer protection laws.

Finally, alongside the DSA, EU law also provides for further detailed obligations for B2C platforms in their relationship with the traders using their services to contract with consumers: The P2B[16] has significant overlaps with the DSA both in its scope and with respect to its detailed obligations. At the same time, there is legal uncertainty with respect to whether the P2B applies concurrently with the DSA or prevails over it. There are relevant overlaps, for instance, in relation to recommender systems transparency, alternative dispute resolution and restricting third-party content.

The following chart gives a comprehensive overview of the obligations under the DSA and P2B applying to B2C e-commerce platforms active in the EU:

---

15 Regulation (EU) 2019/1150 of the European Parliament and of the Council of 20 June 2019 on promoting fairness and transparency for business users of online intermediation services, 2019 O.J. (L186) 57.

16 *Id.*

DSA OBLIGATIONS	B2C
Art. 30 – Traceability of traders / KYBC B2C = OP allowing consumers to conclude distance contracts with traders (i.e., B2C e-commerce online platform). B2C must collect and verify (through freely accessible official databases) KYBC information on all traders (including ID / business register, contact and address details, account information, compliance declaration) prior to allowing them to use the services.	
Art. 31 – Compliance by design B2C must design their interface in a way that ensures that traders can provide legally required product, safety, and pre-contractual information and clearly identify themselves. B2C must make best efforts to assess whether all necessary data is provided and randomly check product compliance information through freely accessible official databases.	
Art. 32 – Right to information If a B2C becomes aware that a product/service is illegal, it must inform all affected consumer buyers (within 6 months of purchase) about the illegality, the trader's identity, and redress options; If contact data are missing, the B2C must publish the information.	
Under the Platform-to-Business Regulation ("P2B"): The P2B complements and sometimes prevails over certain DSA provisions in relation to B2C. It sets out the following **key requirements for B2C:**[17] Terms and conditions: • Specific mandatory content must be included in the T&C (Art. 3)	

[17] The B2C definition under Art. 30–32 DSA and under the P2B is not necessarily identical.

DSA OBLIGATIONS	B2C
• Compliance with notice period in case of T&C change (Art. 3) • Reasons for suspending, terminating or restricting accounts must be clear and user must generally be given 30-days' notice before full termination/ suspension (Art. 4) • No retroactive changes to T&C, inclusion of termination conditions for businesses (Art. 8) • Disclosing the extent of data access (Art. 9) Ranking parameters transparency (Art. 5) • Ancillary goods and differentiated treatment • Disclose if and how own or affiliated products/ services are offered (Art. 6) • Disclose any differential treatment for products/ services (Art. 7) Internal complaint-handling (Art. 11) and mediation (Art. 12)—**replaces Art. 20, 21 DSA** in relation to business users • Provide a free and easily accessible internal complaint-handling system • Engage in out-of-court settlement with at least 2 appointed mediators Restrictions for traders on offering better deals elsewhere must be justified in T&C (Art. 10)	

D. Territorial Scope

It is important to note that both the DSA and the P2B apply a broad extraterritorial understanding to their scope of application and do not provide for any integration with conflicts of laws provisions.

The DSA covers any intermediary service—irrespective of its place of establishment—that is *offered to users in the EU* ***and*** *has a "substantial connection to the EU."*[18]

---

[18] Art. 3(e) DSA defines "substantial connection to the Union" to mean "a connection of a provider of intermediary services with the Union resulting either from its establishment in the Union or from specific factual criteria," such as a significant number of recipients

Similarly, the P2B applies irrespective of a provider's place of establishment, as long as it (also) *provides its service to traders that are both established in the EU* ***and*** *offer goods or services to consumers in the EU.*

III. SPOTLIGHT ON: TWO-TIER ENFORCEMENT

The DSA is enforced both through dedicated authorities empowered to ensure that providers comply with their due diligence obligations, and in the civil courts. Public enforcement is divided between actions taken by authorities at the EU Member State level and those of the European Commission ("EC"). Meanwhile, private enforcement is split into individual and collective/representative actions. Each enforcement mechanism plays a distinct role within the comprehensive framework envisioned by the legislator, designed to hold service providers of all sizes fully accountable.

A. Public Enforcement

The DSA introduced a system of public enforcement with many parallels to antitrust regulation: Traditionally, European regulations, such as the General Data Protection Regulation ("GDPR") are primarily enforced on Member State level. While this concept pays heed to the principle of subsidiarity of EU competencies, such national enforcement of online activities, essentially multi-jurisdictional in nature, also revealed insufficiencies. To remedy the gaps stemming from national enforcement of issues with broader EU impact, the DSA provides for enforcement both at the national level and, for very large online platforms and very large online search engines (Art. 65 DSA), also at the EU level.

1. National Enforcement

Art. 53 DSA assigns primary jurisdiction for public enforcement to the Member State in which a given service provider has its EU establishment. Each Member State has a dedicated DSA authority, the Digital Services Coordinator ("DSC"). Several Member States have appointed existing authorities to fulfil this role: In Ireland, for instance—EU home jurisdiction for many global tech companies—the Coimisiún na Meán ("CnaM") acts as DSC, alongside its role as overseeing national compliance with the Audiovisual Media

---

of the service being located in one or more Member States in relation to their population, or the targeting of activities towards one or more Member States. "Targeting of activities" can include, e.g., prices shown in Euro, customer support being offered in EU languages, or ads targeted toward populations in EU member states.

Services Directive ("AVMSD")[19]. Meanwhile, Germany and Belgium have adopted different models: while they each have one DSC that takes a central role and acts as a gateway for coordination with the European Commission and other Member States, competences to enforce the DSA are split between several national authorities depending on language, region, or subject-area—such as the protection of minors.

If service providers have no establishment in the European Union, Art. 13 DSA requires them to designate a legal representative. In those cases, the country of establishment of the representative determines the EU home jurisdiction for DSA purposes. While this allows service providers to cherry-pick the DSC that supervises them, many services have nonetheless opted to stay on familiar territory, designating the same entity that represents them for privacy purposes under Art. 27 GDPR,[20] or at least have both representatives in the same jurisdiction—often Ireland (also convenient for linguistic ease) or the Netherlands. That Germany and France are far less popular choices is no surprise, given the reputation of their national courts for strong-handed enforcement.

While the DSA sets out the due diligence obligations that services must meet, it is again the task of the Member States to lay down national rules on penalties for DSA infringements. Here again, some national differences emerge, and zooming in on the existing national implementations of penalties reveals some interesting insights on the different views of the national legislators. The German implementation of the DSA, for example, provides a legal basis for fines only in relation to selected DSA obligations. The German legislator apparently considered some of the obligations to be insufficiently drafted for serving as a solid legal basis for sanctions. This limits the competence of German authorities to issue fines—and can also serve as a persuasive indicator across Europe that some DSA obligations are too vague as to present a suitable basis for fines.[21] Some examples are the measures providers must take against misuse of their services under Art. 23 DSA, and efforts required from B2C e-commerce

---

19 Directive 2010/13/EU of the European Parliament and of the Council of 10 March 2010 on the coordination of certain provisions laid down by law, regulation or administrative action in Member States concerning the provision of audiovisual media services (Audiovisual Media Services Directive), 2010 O.J. (L95) 1.

20 Regulation (EU) 2016/679 of the European Parliament and of the Council of 27 April 2016 on the protection of natural persons with regard to the processing of personal data and on the free movement of such data, and repealing Directive 95/46/EC (General Data Protection Regulation), 2016 O.J. (L119) 1, Art. 27.

21 Section 33 of the German Digital Services Act (Digitale-Dienste-Gesetz, DDG), BGBl. I 2024, 186 (Ger.).

platforms to verify certain pieces of trader information according to Art. 30(2) and 31(3) DSA.[22]

The level of activity of the national DSCs also greatly differs between Member States. The Irish CnaM is currently the most active among its peers.[23] Notably, the authority began sending requests for information to eighteen service providers in 2024, including several very large online platforms, as CnaM was concerned that these providers may have failed to establish an electronic point of contact for communication with their users under Art. 12 DSA, and channels to report illegal content under Art. 16 DSA.

The German DSC has also not been idle.[24] While no fines have been issued to date, the German authority opened approximately thirty administrative proceedings against service providers concerning their notice and action mechanisms under Art. 16 and 17 DSA, internal complaint-handling under Art. 20 DSA, designating a legal representative according to Art. 13 DSA, and traceability of traders under Art. 30 DSA.

Pursuant to Art. 53 DSA, users as well as private and public organizations have the right to lodge complaints against service providers. Such complaints are typically filed with the DSC where the complainant resides but are forwarded to, and actioned by, the DSC in charge of overseeing the services provider in question. DSCs have already received numerous complaints, and Germans are particularly litigious, submitting more than 800 complaints in 2024 and more than 2000 complaints in 2025.[25] While the sheer number of complaints can only give an initial impression of the level of enforcement that affected stakeholders request from authorities, it is notable that well-established consumer protection organizations have also issued multiple complaints under the DSA already.[26]

2. Enforcement at EU Level

While we are starting to see first patterns emerge for DSA enforcement at the Member States level, enforcement at the EU

---

22 *See* Section II.C, *supra*.

23 Coimisiún na Meán, *Annual Activity Report pursuant to art. 55 of the Digital Services Act*, at 7-10, https://www.cnam.ie/app/uploads/2025/04/20250319_Art-55-DSA-report_VFinal.pdf (last visited May 29, 2026).

24 Koordinierungsstelle für digitale Dienste (DSC), *Tätigkeitsbericht 2024 der Koordinierungsstelle für Digitale Dienste (DSC)* nach § 17 DDG, Art. 55 Verordnung (EU) 2065/2022, https://www.dsc.bund.de/DE/Fachthemen/DSC/3_Aktuell/Downloads/Taetigkeitsberichte/DSC_Bericht2024.pdf?__blob=publicationFile&v=1 (last visited May 29, 2026); *Koordinierungsstelle für digitale Dienste (DSC)*, Tätigkeitsbericht nach § 17 DDG, Art. 55 Verordnung (EU) 2065/2022, www.dsc.bund.de/1103924 (last visited May 29, 2026).

25 *Id.*

26 For additional details, see Section III.B *infra*.

level is already in full swing. The EC is tasked with an additional layer of public enforcement for the Very Large Online Platforms ("VLOPs") and Very Large Search Engines ("VLOSEs"), to effectively manage those services that, due to their size and systemic relevance, can also pose particular systemic risks.

Where national and EU enforcement coincide, the DSA gives priority to the EC. So if the Irish CnaM were to initiate proceedings against a VLOP, it would lose its competence over the matter if the EC were to step in and open its own proceedings on the same subject-matter, pursuant to Art. 56 DSA. The DSA also introduced a range of obligations that exclusively apply to VLOPs and VLOSEs, and for which the EC has the exclusive competence to supervise and enforce compliance. For a service to be categorized as a very large provider, it must have at least 45 million average monthly active users in the European Union. Art. 33 DSA. The active user statistics that online platforms and search engines must regularly publish according to Art. 24(2) DSA serve as a first indicator, but are not the final word: in several pending court cases, including appeals at the Court of Justice of the European Union, providers are battling the EC over the correct methodology to calculate their user numbers.

The EC has so far included twenty-six services from twenty-one providers in the first rounds of designations, including Facebook, Instagram, Snapchat, several Google services, the Apple App Store, TikTok, Twitter/X, AliExpress, Temu, Amazon, Pornhub, LinkedIn, and Wikipedia.[27] When, after designation, the EC moves on to enforcement, it will typically issue a request for information ("RFI") to the service provider concerned. To date, the Commission has issued numerous RFIs, including on risks related to AI, recommender systems, protection of minors and age verification, data access for researchers, advertising transparency, dark patterns, risks for elections and illegal products.

Should the EC not be satisfied with the response, and the resulting implications on the existence of insufficiently addressed systemic risks and other DSA violations, it can formally open enforcement proceedings against the provider under Art. 66 DSA. Representative proceedings[28] have addressed allegations in relation to:

- the dissemination of illegal content on X, along with information manipulation, deceptive design choices, and data access for researchers;

---

[27] Directorate-General for Communications Networks, Content and Technology, *Supervision of the designated very large online platforms and search engines under the DSA*, https://digital-strategy.ec.europa.eu/en/policies/list-designated-vlops-and-vloses (last visited May 26, 2026).

[28] *Id.*

- the content moderation systems of AliExpress, as well as illegal products, transparency information on sellers, recommender system and advertising transparency, and data access for researchers;
- protection of minors and age verification on adult content platforms;
- deceptive advertisements and disinformation on Facebook and Instagram, as well as visibility of political content, monitoring tools, the mechanism to flag illegal content, as well as addictive effects and protection of minors;
- addictive effects and protection of minors on TikTok, as well as advertising and recommender systems transparency, political advertisements, data access for researchers as well as a feature that would have allowed users to earn points for using the app;
- the sale of non-compliant products on Temu, together with addictive user interface design and recommender systems transparency.

To end such proceedings, providers can make binding commitments to address the objections raised by the EC, and to date, both TikTok and AliExpress have made use of this option provided for by Art. 71 DSA.[29]

The EC has also issued the first fines under the DSA that allows for fines up to 6% of a provider's global annual turnover.[30] In December 2025, X was fined EUR 120 million for deceptive design of its blue checkmark, lack of transparency of its advertising repository, and failure to provide access to public data for researchers. X has appealed this decision. In May 2026, Temu was fined EUR 200 million for failing to properly assess systemic risks related to illegal products. This decision is still appealable.

---

[29] *See* https://digital-strategy.ec.europa.eu/en/news/commission-makes-aliexpress-commitments-under-digital-services-act-binding (last visited May 26, 2026); Commission accepts TikTok's commitments on advertising transparency under the Digital Services Act, Press Release dated Dec. 5, 2025, available at https://digital-strategy.ec.europa.eu/en/news/commission-accepts-tiktoks-commitments-advertising-transparency-under-digital-services-act (last visited May 26, 2026).

[30] European Commission, *Commission fines X €120 million under the Digital Services Act*, Press Release dated Dec. 5, 2025, https://ec.europa.eu/commission/presscorner/detail/en/ip_25_2934 (last visited May 29, 2026); European Commission, *Commission fines Temu €200 million for breaching the Digital Services Act*, Press Release dated May 28, 2026, https://ec.europa.eu/commission/presscorner/detail/en/ip_26_1178 (last visited May 29, 2026).

B. Private Enforcement

Alongside the sophisticated and robust public enforcement system, private enforcement also plays a crucial role in the overall architecture of the DSA.

Private enforcement complements public enforcement by offering affected parties a direct means to protect their rights, challenge unlawful conduct, and press for accountability. The potential of private enforcement lies not only in providing remedies in individual cases, but also in shaping platform behavior systemically, particularly where the Digital Services Coordinators or even the European Commission as public regulators may be overburdened, under-resourced, or politically constrained. By giving private actors the ability to challenge intermediary service providers in the courts, the DSA embeds a multi-tiered system of legal accountability into the digital sphere.

1. Avenues for DSA Private Enforcement

DSA private enforcement can take several distinct forms, differing in their subject-matter, eligible claimants, and legal basis. Some routes are explicitly set out; others arise indirectly.

a. Individual User Claims

The first route for private enforcement is the DSA's mechanism for individual users to assert that a provider's conduct amounts to a violation of rights conferred by the DSA. Under Art. 86 DSA, users of intermediary services shall "at least have the right to mandate certain bodies, organizations or associations to exercise the rights conferred by this Regulation on their behalf." But it is unclear what this right is, exactly. The DSA primarily imposes obligations onto providers but does not explicitly spell out which of these correspond with enforceable user rights. Some guidance is provided in Recital 149, which indicates that the rights for which representation shall be possible "may include the rights related to the submission of notices, the challenging of the decisions taken by providers of intermediary services." This corresponds with the obligations under Art. 16, 20, and 21 DSA. However, Recital 149 is not exhaustive, and it can be argued for various other obligations as well that they at least imply enforceable user rights.

As far as damages are concerned, Art. 54 DSA further implies that *any* obligation is suitable to be invoked by individual users whenever they suffer any damage or loss due to an infringement. Thus, users have an express far-reaching right to compensation—which arguably indicates that their possibility to seek injunctive relief runs in parallel and is equally broad. Areas where such private claims will be tested most likely include transparency

requirements for terms and conditions (Art. 14 DSA), notice-and-action (Art. 16 DSA) and statements of reasons (Art. 17 DSA), complaint-handling (Art. 20 DSA), measures and protection against abuse (Art. 23 DSA) and dark patterns (Art. 25 DSA), as well as the protection of minors (Art. 28 DSA), traceability of traders (Art. 30), and compliance by design requirements (Art. 31 DSA). As Art. 54 DSA essentially refers to the national laws of the Member States for the material and procedural details of enforcement, it remains to be seen in the upcoming years to which extent and under which conditions individual user claims can be a driver for meaningful DSA private enforcement.

The right to data access for researchers from VLOPs and VLOSEs pursuant to Art. 40(12) DSA can also be considered as a means for private individual enforcement. In fact, this right has already been invoked successfully by Democracy Reporting International ("DRI") against social media platform X in preliminary injunction proceedings before the Berlin Regional Court (Case No. 41 O 140/25 EV).[31] DRI sought access to data from X to research the influence of social media platforms on the 2025 federal election in Germany, hoping to disclose potential efforts of undue influence in the run-up to the election. The Berlin Regional Court granted the injunction in February 2025 on the basis of Art. 40(12) and 54 DSA, however, and lifted it in May—but only for procedural reasons.

b. Collective Private Enforcement

The second avenue of private enforcement under the DSA is collective in nature. Art. 90 DSA includes the DSA in the list of EU laws that are covered by, and enforceable under, the Representative Actions Directive ("RAD").[32]

The RAD establishes a harmonized EU framework for collective redress, allowing so-called qualified entities (e.g., consumer organizations, industry associations) to bring actions to protect the collective interests of consumers. The Directive aims to ensure a minimum standard of access to representative actions throughout the EU, while allowing Member States to provide for more generous protections. It covers both injunctive relief for stopping an unlawful practice (Art. 8) and redress measures (Art. 9). The Member States were required to make way for such actions beginning June 25, 2023.

It did not take long until the first representative actions with respect to alleged DSA violations were brought, and various

---

31 Berlin Regional Court (*Landgericht Berlin*), Case 41 O 140/25 EV (May 13, 2025) (Ger.).

32 Directive (EU) 2020/1828 of the European Parliament and of the Council of 25 November 2020 on representative actions for the protection of the collective interests of consumers and repealing Directive 2009/22/EC, 2020 O.J. (L409) 1.

associations were already waiting in the wings to make a name for themselves with DSA enforcement—particularly before German courts:

- German competition watchdog *Wettbewerbszentrale* brought two actions in April and May 2024 before the Frankfurt Higher Regional Court against two online marketplaces, claiming a violation of Art. 30 DSA with respect to allegedly missing seller information. One of the actions was withdrawn; the other lawsuit ended with the provider submitting corresponding cease-and-desist undertakings.
- In March 2025, *Wettbewerbszentrale* sued Microsoft before the Hamm Higher Regional Court for alleged violations of Art. 14(5) DSA with respect to the summary of the terms and conditions for BING. Microsoft acknowledged the claim for injunctive relief in July 2025.
- *Vzbv,* the leading German consumer protection organization, sued CTS Eventim in 2024 before for alleged "dark patterns" as per Art. 25 DSA relating to the sales of event ticket insurances. While the Bamberg Higher Regional Court denied a violation of the DSA, it considered Art. 25 DSA for the interpretation of Art. 5(2) of the Unfair Commercial Practices Directive ("UCPD")[33] and partially granted the sought injunction on that basis.[34]
- In April 2025, *Verbraucherzentrale Bayern* brought an action before the Bamberg Higher Regional Court against a social media VLOP alleging non-compliance with the DSA obligation in Art. 38 DSA to providers with an option to use recommender systems without profiling.

This non-exhaustive list of examples already shows that qualified entities are more than ready to bring representative actions against all sorts of platforms for a broad range of alleged DSA violations believed to adversely affect consumers. This trend will undoubtedly continue in the years to come. While it can turn out a welcome development to close existing enforcement gaps, it also comes with the risk of fragmentation.[35]

---

[33] Directive 2005/29/EC of the European Parliament and of the Council of 11 May 2005 concerning unfair business-to-consumer commercial practices in the internal market, 2005 O.J. (L149) 22, Art. 5(2).

[34] Bamberg Higher Regional Court (*Oberlandesgericht Bamberg*), Judgment of the Court, Feb. 5, 2025, 3 UKI 11/24 e (Ger.).

[35] *See also* Section III.B.2 *infra*.

c. Additional Pathways Under National Laws

Further angles for private enforcement may yet arise under the national laws of the Member States. For instance, German unfair competition law provides for the option to seek injunctive relief and other remedies against the violation of "market conduct rules." This broad concept covers statutory provisions that are, at least to some extent, also intended to regulate market behavior. As the DSA is explicitly meant to improve the functioning of the digital internal market (Recital 4), one can rather easily make the case that a large share of the obligations imposed onto providers with the DSA qualify as "market conduct rules" suitable for private enforcement. And in deviation from collective enforcement through representative actions, this option would be available not only for consumer organizations and industry associations as qualified entities, but also by competitors—thus technically allowing providers to sue rivals for DSA non-compliance.

Whether such national enforcement peculiarities are compatible with the harmonized public and private enforcement scheme that the DSA provides on EU level is debated. Privacy enthusiasts will know that the exact same question was rather recently referred to and decided on by the Court of Justice of the European Union ("CJEU") with respect to the EU's GDPR. In its landmark decision of October 4, 2024 (Case No. C-21/23),[36] the CJEU approved this option, holding that the GDPR does *not* preclude national legislation that allows competitors to bring proceedings against a non-compliant entity for unfair commercial practices.

This recent decision readily suggests a corresponding approach for the DSA as well. That said, any additional pathways for enforcement under national law ultimately will not replace, but only complement, the remedies and means of enforcement that are directly provided for under the DSA.

d. Indirect DSA Enforcement

Finally, there will be instances of indirect DSA enforcement where the non-compliance of a provider is not the primary focus but still a relevant factor of a lawsuit. This will typically concern disputes regarding the liability of the provider for illegal content uploaded by its users and, relatedly, the provider's notice-and-action processes.

For instance, IP rights holders could argue, when trying to hold an intermediary service provider liable, that the provider repeatedly failed to process notices in a timely and diligent manner as required under Art. 16(6) DSA, or that a given repeat infringer should have been suspended by the provider in accordance with

---

[36] Case C-21/23, ND v. DR, Judgment of the Court, Oct. 4, 2024.

Art. 23(1) DSA. Such lines of arguments are, of course, not new—they are frequently made in proceedings on intermediary liability. What has changed is that the misconduct of providers as discussed in such proceedings for the purpose of establishing liability also indicates that the provider has breached its regulatory obligations under the DSA, which may in turn give rise to scrutiny by the DSCs and the EC.

The following table summarizes the different avenues for DSA private enforcement as discussed above.

Private Enforcement Avenue	Who	Against	Main Remedies	Exp. Focus
Individual User Claims	Users; representative bodies (Art. 86); researchers (Art. 40)	User rights violations; restricted data access	Injunctions, reinstatement, damages / compensation (Art. 54)	T&Cs, N&A processes, complaint-handling, data access
Collective Enforcement (RAD)	"Qualified entities," e.g., CPOs	Infringements harming collective interests of consumers	Injunctions, performance, damages ("collective amount")	T&Cs, N&A processes, dark patterns, ads, recommender systems, protection of minors, KYBC
Additional Pathways Under National Law	CPOs, industry associations, competitors	Depending on national laws, e.g., violation of "market conduct rules" in Germany	Injunctions, information, damages, penalties	T&Cs, dark patterns, ads, recommender systems, KYBC
Indirect DSA Enforcement	Right owners, individuals, CPOs, industry associations	Illegal content, e.g., for IP infringements, personality rights violations or non-compliant products	Injunctions, information, damages	N&A processes

2. Potential Conflict with Public Enforcement

Although the DSA clearly envisages an important role for private enforcement in the overall oversight and enforcement system, it is equally clear that conflicts may arise when public and private enforcement run in parallel on the same aspects.

The DSA acknowledges this potential conflict but addresses it only partially in Art. 82(3) DSA. According to this provision, which is inspired by its competition law equivalent in Art. 16(1)

Regulation (EC) No. 1/2003,[37] national courts are barred from taking any decision that would run counter to a decision already adopted or at least contemplated by the EC. In such a scenario, public enforcement by the EC shall prevail.

That said, there is no equivalent provision that accords the decisions of DSC the same priority. Likewise, situations in which the EC or the DSCs have reviewed a provider's solution and informally indicated that it complies are also not addressed. It is in these situations that private and public enforcement can clash the most, resulting in legal uncertainty. Providers may believe they are compliant based on regulator feedback and may yet still face challenges through private enforcement. Considering that the main benefit of private enforcement lies in closing the enforcement gaps left by the supervisory authorities, it is difficult to justify the admissibility of private enforcement in areas that the supervisory authorities have already dealt with.

Where it overlaps with ongoing or concluded public enforcement, private enforcement also entails the risk of fragmentation and of undermining the harmonizing effect that the DSA aims to achieve according to its Recital 9. In particular, injunctions ordered as a result of private enforcement will often have only a domestic effect. Technically, this may force the provider to develop separate and country-specific compliance solutions for adhering to an injunction—which would obviously thwart the DSA's goal of creating a single unified digital market.

Against this background, there are very good reasons in favor of public enforcement taking precedence over overlapping private enforcement whenever the latter entails the risk that the positions of the primarily responsible supervisory authorities—the EC and the DSCs—could be disregarded or even frustrated. This view finds further support in the principles of loyal cooperation and legal certainty as enshrined in Art. 4(3) and Art. 2 of the Treaty on European Union.[38] The latter entails that individuals and businesses must be able to foresee the legal consequences of their actions, while the former requires the Member States to refrain from any measure that could jeopardize the attainment of the Union's objectives, also horizontally between Member States. Both principles are weakened if private enforcement threatens to disregard the assessments of the EC or of the DSCs.

---

[37] Council Regulation (EC) No. 1/2003 of 16 December 2002 on the implementation of the rules on competition laid down in Articles 81 and 82 of the Treaty, 2003 O.J. (L1) 1, Art. 16 (1).

[38] Treaty on European Union, Oct. 26, 2012, 2012 O.J. (C326) 13.

IV. SPOTLIGHT ON: PRIMARY LIABILITY—A TURNING POINT?

The clear distinction between a platform's own content (for which a hosting provider is primarily liable) and third-party content (for which a hosting provider is only secondarily liable where it, despite actual knowledge, does not act expeditiously) is increasingly challenged in EU and national case law, marking a significant shift toward holding hosting providers *directly and primarily liable* for illegal third-party content by finding them, as well as the uploading user, to be perpetrating acts of infringement. This shift—inconsistent with the liability system provided for the last twenty-five years, by the DSA and by the eCD before it—is particularly notable where IP rights are affected.

The starting point toward direct primary liability came with the expansion of copyright law, specifically the author's right to communicate works to the public under Art. 3(1) InfoSoc-Directive ("InfoSoc").[39] Several CJEU cases have resulted in the scope of the right to communicate works to the public being significantly broadened, relating to hyperlinks to illegal content (*GS Media*)[40] and facilitating access to illegal content by providing software (*Filmspeler*)[41] or a torrent index (*The Pirate Bay*).[42] Most notably, the CJEU found that video-sharing platforms like *YouTube* may, under certain conditions, be held directly liable for copyright infringements,[43] a ruling that was later also transferred into statute through Art. 17 of Directive (EU) 2019/790 ("DSM Directive").[44]

The CJEU's *YouTube v. Cyando* (C-682/18)[45] decision has also already been leveraged in German case law up to the German Federal Court of Justice: In the *Manhattan Bridge* case (I ZR 112/23),[46] an online marketplace was sued by a photographer who held copyrights in a certain image depicting the Manhattan Bridge. That image was used by a seller on the marketplace as part of a product image for a TV without the photographer's consent. Upon

---

39 Directive 2001/29/EC of the European Parliament and of the Council of 22 May 2001 on the harmonization of certain aspects of copyright and related rights in the information society (Information Society Directive), 2001 O.J. (L167) 10.

40 Case C-160/15, GS Media BV v. Sanoma Media Netherlands BV, Judgment of the Court, Sep. 8, 2016.

41 Case C-527/15, Stichting Brein v. Jack Frederik Wullems, Judgment of the Court, Apr. 26, 2017.

42 Case C-610/15, Stichting Brein v. Ziggo BV, Judgment of the Court, June 14, 2017.

43 YouTube Inc. v. Cyando AG, *supra* note 5.

44 Directive (EU) 2019/790 of the European Parliament and of the Council of 17 April 2019 on copyright and related rights in the Digital Single Market, 2019 O.J. (L130) 92.

45 *YouTube Inc. v. Cyando AG*, *supra* note 5.

46 Manhattan Bridge v. Rakuten, Bundesgerichtshof (Federal Court of Justice), Case I ZR 112/23, Judgment of the Court, Oct. 23, 2024.

notice from the photographer, the marketplace operator failed to remove the reported listing as well as other existing, as well as subsequent, listings using the same image. In deviation from earlier (German) case law for online marketplace liability, the Federal Court of Justice held that the provider was primarily liable for the copyright-infringing image uploaded by the third-party seller.

Similarly to *YouTube v. Cyando*,[47] the CJEU expanded liability concepts under European trademark law in its *Louboutin decision* (judgment of December 22, 2022, C-148/21 and C-184/21).[48] In that case, the French fashion designer Christian Louboutin claimed injunctive relief and damages with respect to third-party offers on the Amazon EU Store for red-soled high heels which infringed Louboutin's trademark rights. The CJEU's approach diverges from the Advocate General's careful analysis of marketplace operation, where he emphasized that the mere presence of Amazon's logo may help consumers understand they are dealing with a marketplace platform rather than with direct sales, given that Amazon is well known for both activities. However, focusing on the protective objectives of trademark law, the CJEU ruled that hosting of trademark-infringing third-party content may give rise to a hybrid marketplace's primary liability, subject to the perception consumers have of the way third-party listings are presented on a hybrid marketplace, and of ancillary services provided by the marketplace operator.

This imposition of liability, solely based on the subjective perspective of third parties (the public active on the Amazon EU Stores), is not just highly questionable and alien to the intermediary liability system. It also conflicts with the diverging opinion of Advocate General Szpunar in this case, who rejected the notion of primary liability of a hybrid marketplace for trademark infringing third-party listings on the basis of misconceptions of the public about the responsible party, confirming that the public can correctly identify the third-party sellers as solely responsible for listings content. Trademark infringement traditionally focuses on whether the defendant actively uses the mark to indicate origin, but not on what the average user might think. The current approach appears to unduly conflate consumer protection principles with the objectives of trademark law.

It is not yet clear how exactly the findings of the *Louboutin* decision will correspond with the hosting privilege of Art. 6(1) DSA. The CJEU did not elaborate on this question in its ruling. In principle, it would be possible to apply the hosting privilege also to providers who are found primarily liable for third-party

---

47 YouTube Inc. v. Cyando AG, *supra* note 5.

48 Joined Cases C-148/21 and C-184/21, Christian Louboutin v. Amazon Europe Core Sàrl, Judgment of the Court Dec. 22, 2022.

infringements. This was the approach of Advocate General Saugmandsgaard Øe in his Opinion of July 16, 2020 (para 138),[49] in the *YouTube and Cyando* case, though it was later rejected by the CJEU in relation to copyright liability doctrine (para 107 of the judgment).[50] That said, the courts tend to refuse applying the hosting privilege in cases of primary liability, arguing that the provider in such cases plays an "active role" that excludes reliance on the hosting privilege.

In any case, *Louboutin* (C-148/21 and C-184/21)[51] must be seen as a ruling specific to trademark protection doctrines and tied to hybrid marketplaces with significant branding overlap. It cannot be transferred to other IP regimes such as design or patent law. Even more striking is the fact that all CJEU cases mentioned above are driven by the same motivation: cases that traditionally fell under the secondary liability regime for intermediaries are being reassigned to primary liability by the CJEU because secondary law is not harmonized across the EU. While this trend may be subject to valid criticism, the solution does not fall within the competence of the CJEU. It can be driven forward only by the EU Member States and would fall under the exclusive competence of the European legislatures.

V. SPOTLIGHT ON: AI—CHALLENGES AND CHANCES

The fast rise and impact of AI and its use also pervades online platform services. AI features are increasingly deployed in a wide range of use-cases throughout the Internet, and provide useful tools for automation-prone tasks such as:

- safety controls, including proactive monitoring, content moderation, and service restrictions;
- enhancing user experiences, ranging from improved recommendations to personalized customer support;
- generating and enhancing content, such as summarized reviews or AI-supported creation of content and promotional activities.

In the EU, AI currently is only partially regulated with the EU's cornerstone legislation, the AI Act ("AIA").[52] The act promotes human-centric and trustworthy AI, while ensuring a high level of

---

49 Opinion of Advocate General Saugmandsgaard Øe, 16 July 2020, Joined Cases C-682/18 & C-683/18, ECLI:EU:C:2020:586, *para.* 138.

50 YouTube Inc. v. Cyando AG, *supra* note 5, para. 107.

51 Christian Louboutin v. Amazon Europe Sàrl, *supra* note 48.

52 Regulation (EU) 2024/1689 of the European Parliament and of the Council of 13 June 2024 laying down harmonized rules on artificial intelligence (Artificial Intelligence Act), 2024 O.J. (L1689).

protection of safety and fundamental rights against harmful effects of AI systems. To achieve these objectives, the AIA adopts a particularly broad definition of AI and determines the applicable obligations under a risk-based approach. First AIA obligations are already applicable, including a ban of unacceptable forms of AI and broad AI literacy requirements, and further obligations kick in from August 2, 2026, and 2027, respectively.

Where intermediary services are concerned, the AI Act has significant overlaps both in relation to their liability and their due diligence obligations. These include transparency obligations for the recommender systems of online platforms as well as transparency obligations for certain AI systems under Art. 50 AIA, to ensure that AI systems for interaction with users and generated content are identifiable as such.

The fast-increasing use of AI also gives rise to significantly increased liability risks—and here, the "active role" concept kicks in once again. Under CJEU case law, and reflected in Recital 18 DSA, the liability privilege for third-party content is forfeited where a hosting provider assumes an "active role" that goes beyond mere technical, automated and passive processing of content as an intermediary.[53]

The more actively a hosting provider becomes involved with third-party content in an editorial capacity, including through AI and automation, the higher the risk that it could forfeit the hosting provider privilege, either for specific third-party content with which the provider becomes involved, or ultimately even for all third-party content it hosts—if the intensity of its active involvement would result in the provider assuming full editorial control. This risk is most obvious, and most pronounced, for any AI-powered modifications which a provider makes and which in and by themselves render the modified third-party content illegal, such as where trademark infringing keywords are added by automation.

But the risk also extends to other AI-generated (or human) activities where editorial contributions cross the threshold of an active role. In such cases, a provider could become liable for the illegality of a piece of third-party content to which it has actively contributed, even if the provider's contribution itself is fully lawful and the illegality was already inherent in the content before. An example for this could be a marketplace offer for a counterfeit product, where the provider has auto-added compliant safety information. And ultimately, the risk remains that excessive involvement of a provider in the content creation process could result in its full primary liability for all third-party content on its service altogether. In that scenario, the risks of which have been amplified through the case law developments we have examined in

---

[53] *See* Sections II.A.3 and IV, *supra*.

Section IV, a court could ultimately find that significant contributions to the creation of third-party content move a hosting provider from an intermediary to an operator with full-blown editorial control and primary liability.

VI. CONCLUSION

The DSA, now fully in effect, marks a pivotal transformation of EU online intermediary regulation, moving from a system of essential safe harbor rules to a tiered system of increasingly intensive active obligations. The DSA establishes a harmonized framework that has positioned the EU as a global pioneer in the regulation of intermediaries, and of (large) online platforms in particular.

While the DSA preserves the eCD's liability privileges (safe harbors) in principle, these can be lost if a service assumes an "active role" regarding third-party content. This "active role" concept, solidified by CJEU case law like *L'Oréal v. eBay,* has become a critical determinant of liability. In tandem with the (increasingly diluted) liability exemptions, the DSA now imposes a layered set of due diligence obligations, ranging from universal notice and takedown mechanisms for all hosting providers to more stringent requirements for online platforms, such as appeals processes, extensive rules on the protection of minors and additional transparency obligations for advertising and recommender systems. Specific provisions for B2C e-commerce online platforms introduce further burdensome obligations to ensure a high level of consumer protection, ranging from traceability of traders (KYBC) to compliance by design requirements for product safety and mandatory pre-contractual information.

DSA enforcement is structured in a two-tier system. On the public side, the oversight of national Digital Services Coordinators goes side by side with the European Commission's competences for VLOPs and VLOSEs. And in addition to public enforcement, private avenues, including individual user claims and collective actions by consumer protection organizations, are gaining increasing relevance, at the immanent risk of reintroducing legal fragmentation through the backdoor.

A significant trend of EU case law is the challenging of the clear distinction between primary and secondary liability of providers, particularly in IP infringement cases like *YouTube and Cyando* and *Louboutin.* Finally, the growing integration of AI by online platforms adds a further layer of complexity. The more actively an intermediary uses AI to manage or enhance third-party content on its service, the greater the risk that it could forfeit its hosting privilege and incur direct primary liability.

COMMENTARY

ZOMBIES ONLINE: U.S. COPYRIGHT INFRINGEMENT CLAIMS THAT NEVER DIE, AND WHAT WE SHOULD DO ABOUT THEM[*] [**]

By Rodrick J. Enns[***]

I. INTRODUCTION

Web sites, social media pages, and other online platforms often feature feeds: continuously updating streams of content that provide immediacy and sustain user interest. They may display a wide variety of copyrightable subject matter, such as text, images, videos, music, and other original content. Rather than regularly purging these accumulating files, data storage is so inexpensive that those who manage the feeds often choose to allow this content to aggregate indefinitely. Over time it forms a useful and searchable archive of brand activity and history.

There is, however, a potential liability lurking in those troves of online data: copyright infringement. The advances in technology that have made digital storage cheap and ubiquitous have also led to the development of powerful tools that allow copyright owners to search for and identify files on the Internet that match the digital "signature" of their copyrighted works.

And that's generally a good thing. Copyright owners should be fairly compensated for the use, display, or copying of their creations. But if the original poster had a license or other permission to use the work at the time of posting, the passing years could make that challenging to prove. Employees leave, license agreements are mislaid, files are re-named, and an entire site may be transferred to new ownership. Given the speed with which change takes place on the Internet, after just a few years it can be difficult for those currently managing a site to document the provenance of one particular work among the hundreds, thousands, or tens of thousands of media files and content that were posted in years gone by.

---

[*] This commentary should be cited as Rodrick J. Enns, *Zombies Online: U.S. Copyright Infringement Claims That Never Die, and What We Should Do About Them*, 116 Trademark Rep. 584 (2026).

[**] © Rodrick J. Enns 2025.

[***] Partner, Enns & Archer LLP, Winston-Salem, North Carolina, USA, Member, International Trademark Association. The author has practiced intellectual property law for more than forty years, with an emphasis on trademarks and copyrights.

The U.S. Copyright Act has a tool to balance the competing interests in these situations: the three-year statute of limitations, which on its face bars claims asserted more than three years after the cause of action accrued. A number of judicial doctrines mitigate the effect of a strict application of the statute, but one doctrine in particular, known as the "discovery rule," can reduce the statute to irrelevance in the online environment. That rule posits that a claim does not "accrue" until the copyright owner discovers or should have discovered the infringement. But despite the wide availability of search tools to discover online infringements, most courts have held that there is no duty to use them. As a result, unless there is proof that the content actually came to the attention of the copyright owner at some point in the past, the limitations period simply never begins to run until the copyright owner chooses to look. At that point, a long-dead issue springs back to life, and the current host of the content is suddenly required to defend "zombie" claims: allegations of infringement based on the use of content that may have been posted years or even decades before.

This commentary surveys the checkered history and current status of the discovery rule in copyright jurisprudence in the United States and describes some of the practical issues that those hosting online content may face from the discovery rule's application. It then considers possible measures that might better accommodate the various interests involved.

II. LIMITATIONS AND THEIR LIMITATIONS

The problem of stale claims is not a new one, nor is it unique to the copyright realm. To address that issue, statutes of limitation specify a time frame within which a claim must be asserted or thereafter be barred. Limitations statutes "are designed to promote justice by preventing surprises through the revival of claims that have been allowed to slumber until evidence has been lost, memories have faded, and witnesses have disappeared."[1] The underlying premise is that at some point a plaintiff's interest in pursuing a claim should yield because the passage of time has unreasonably compromised the ability to defend it. For more than a century, the U.S. Supreme Court has described the balancing of interests struck by statutes of limitations as "vital to the welfare of society."[2]

The statute of limitations for the U.S. Copyright Act, Section 507(b) of Title 17, reads in full, "No civil action shall be maintained under the provisions of this title unless it is commenced within three

---

1 Order of R. Telegraphers v. Ry. Express Agency, Inc., 321 U.S. 342, 348-49 (1944).

2 Gabelli v. SEC, 568 U.S. 442, 449 (2013) (quoting Wood v. Carpenter, 101 U.S. 135, 139 (1879)).

years after the claim accrued."[3] While that sentence may seem straightforward, a great deal of ambiguity is packed into the question of when an infringement claim "accrues" and thereby causes the three-year limitations period to start running.

Statutory interpretation questions such as this one turn primarily on the specific wording of the statute.[4] The "standard rule," however, absent explicit statutory language otherwise, is that for the purposes of accrual "the limitations period commences when the plaintiff has 'a complete and present cause of action.'"[5]

In the 2014 decision *Petrella v. Metro-Goldwyn-Mayer, Inc.*,[6] the Supreme Court interpreted Section 507(b) by applying this standard rule, also known as the "incident of injury rule,"[7] and held that a "copyright claim thus arises or 'accrue[s]' when an infringing act occurs."[8] But exactly when does an infringing act "occur" if the work continues to be displayed to and accessed by the public over an extended period of time?

The *Petrella* Court explained that "[e]ach time an infringing work is reproduced or distributed, the infringer commits a new wrong," and "the statute of limitations [for such act] runs from each violation."[9] This means that a copyright plaintiff can recover for affirmative acts of infringement occurring within the three years preceding the filing of suit, but claims for acts of infringement that took place earlier than that are barred. Such successive discrete infringements, however, "should not be confused with harm from past violations that are continuing."[10] The ongoing effect of a single act of infringement does not give rise to a new claim, and if the act was undertaken more than three years before suit, all relief will be barred even if the effects of the infringement continue into the limitation period.[11]

In the online context, every court to have looked at the issue since *Petrella* has held that posting content on the Internet is a single discrete infringement under the Copyright Act, and the continued availability of the content thereafter without change is not a series of infringing acts even if users continue to access or

---

3 17 U.S.C. § 507(b) (2024).

4 Rotkiske v. Klemm, 589 U.S. 8, 13 (2019) ("When interpreting limitations provisions, as always, 'we begin by analyzing the statutory language.'") (quoting Hardt v. Reliance Standard Life Ins. Co., 560 U. S. 242, 251 (2010)).

5 Bay Area Laundry & Dry Cleaning Pension Tr. Fund v. Ferbar Corp., 522 U.S. 192, 201 (1997) (quoting Rawlings v. Ray, 312 U.S. 96, 98 (1941)).

6 572 U.S. 663 (2014).

7 *Id.* at 670 n.4.

8 *Id.*

9 *Id.* at 671.

10 *Id.* at 671 n.6.

11 *Id.*

download the content.[12] As a result, a claim must be brought within three years of the original posting (or of any later re-posting, revision, or other affirmative act of infringement), or it will be barred unless equity intervenes.

The doctrine provides important protection for those who host an online archive of content. After the passage of years, personnel responsible for maintaining the site will often have turned over, and records of content licenses may not have been preserved. This is a particularly high risk when a site changes hands. As one court observed, "If every access of a copyrighted work on a website establishes a new claim for infringement, as Plaintiff contends, the statute of limitations becomes obsolete for the internet. . . . Given the express purpose of the statute of limitations—'to render uniform and certain the time within which copyright claims could be pursued,'—this Court declines to read out the statute of limitations and interpret digital infringement this way."[13]

So far, so good. These policies strike a balance, giving copyright owners a meaningful opportunity to pursue claims for online infringing activity within a reasonable time, while protecting defendants from stale claims arising from conduct going back many years. This seems consistent with the expressed intent of Congress when the predecessor to Section 507(b) was first enacted, which was to provide "a 3-year uniform period" that "would provide an

---

[12] *See, e.g.,* Wolf v. Travolta, 167 F. Supp. 3d 1077, 1099 n.13 (C.D. Cal. 2016) (where infringing work was originally posted in 2010, more than three years before the filing of suit in 2014, its "continued presence on defendants' website through 2014 at best constitutes 'harm from [a] past violation[] that [was] continuing' through 2014, and not a 'new wrong' that gave rise to '[s]eparately accruing harm' within the limitations period," *quoting Petrella*, 134 S. Ct. at 1969 note 6 (edits in district court opinion)); Alfa Laval, Inc. v. Flowtrend, Inc., 2016 U.S. Dist. LEXIS 60742, at *15-16 (S.D. Tex. 2016); Chelko v. Does JF Rest., LLC, 2019 U.S. Dist. LEXIS 121590, at *11 (W.D.N.C. 2019); Bell v. Oakland Cmty. Pools Project, 2020 U.S. Dist. LEXIS 140008, at *14 (N.D. Cal. 2020); Minden Pictures, Inc. v. Complex Media, Inc., 2023 U.S. Dist. LEXIS 52070 (S.D.N.Y. 2023); Bolano v. Grant, 2023 U.S. Dist. LEXIS 85844, at *2-3 (C.D. Cal. 2023); Dermansky v. Young Turks, Inc., 2023 U.S. Dist. LEXIS 199258, at *9 (C.D. Cal. 2023). *See also* Foss v. E. States Exposition, 149 F.4th 102, 109 (1st Cir. 2025) (argument that defendant's posts "'constitute[d] infringing displays . . . until they were taken down'" was waived, but it "would seem to identify a continuing harm from [defendant]'s original decision to post the videos—not a string of new violations that might implicate the separate-accrual rule"). *But see* APL Microscopic, LLC v. United States, 144 Fed. Cl. 489, 498-99 (2019) (holding for purposes of copyright infringement claim against U.S. government under 28 U.S.C. § 1498(b) that "each time a user viewed" the infringing content was "a separate infringement"). The Court of Claims cited only pre-*Petrella* case law, and its reasoning has not been followed by courts interpreting § 507(b). *See Minden Pictures*, 2023 U.S. Dist. LEXIS 52070 at *11 ("No district court has followed *APL's* logic. . ."); *see also* Comet v. United States, 173 Fed. Cl. 257, 266 (2024) (rejecting *APL*, and holding that even under § 1498(b), "the mere fact that a particular photo remained online does not trigger a separate act from which a new limitations period begins to run," *citing Petrella*).

[13] Chelko v. Does JF Rest., LLC, No. 3:18-cv-00536, 2019 U.S. Dist. LEXIS 121590 at *12-13 (W.D.N.C. 2019).

adequate opportunity for the injured party to commence his action," and that, in Congress's view, represented "the best balance attainable to this type of action."[14]

III. ENTER THE DISCOVERY RULE

The balance that Congress envisioned with its "3-year uniform period" can be upset, however, when copyright plaintiffs invoke the "discovery rule," pursuant to which "an infringement claim does not 'accrue' until the copyright holder discovers, or with due diligence should have discovered, the infringement."[15] Historically, that equitable doctrine emanated from cases "where a plaintiff has been injured by fraud and 'remains in ignorance of it without any fault or want of diligence or care on his part . . . .'"[16] By the 1990s, however, the lower federal courts had evolved a general presumption that the discovery rule applied to all statutes of limitations unless Congress had explicitly declared otherwise.[17]

The Supreme Court disavowed that approach in 2001, saying that its prior decisions held only that "equity tolls the statute of limitations in cases of fraud or concealment," but did not "establish a general presumption applicable across all contexts."[18] Instead, the Court directed that if the statute is not explicit, whether a discovery rule was intended should be inferred "from the structure or text of the particular statute."[19]

While there are reasonable—some would say persuasive—arguments that the injury rule and not the discovery rule should apply to Section 507(b),[20] every court of appeals to have weighed in on the question to date has come down in favor of applying the discovery rule to copyright infringement claims. The Third Circuit's

---

14 S. Rep. No. 85-1014, at 2 (1957).

15 Psihoyos v. John Wiley & Sons, Inc., 748 F.3d 120, 124 (2d Cir. 2014).

16 Holmberg v. Armbrecht, 327 U.S. 392, 397 (1946), quoting Bailey v. Glover, 88 U.S. (21 Wall.) 342, 348 (1875).

17 *See, e.g.*, Cada v. Baxter Healthcare Corp., 920 F.2d 446, 450 (7th Cir. 1990), *cert. denied*, 501 U.S. 1261 (1991).

18 TRW Inc. v. Andrews, 534 U.S. 19, 27 (2001). The Court acknowledged the presumption of a discovery rule by the lower federal courts but said "we have not adopted that position as our own." *Id.*

19 *Id.* at 28.

20 *See* Auscape Int'l v. Nat'l Geographic Soc'y, 409 F. Supp. 2d 235, 247 (S.D.N.Y. 2004) ("the legislative history of Section 507(b) makes it strikingly clear that Congress intended to adopt a three-year limitations period running from the date of the infringement," and "Supreme Court precedent concerning statutes of limitations in other contexts also supports the application of an injury rule here"); 3 Nimmer on Copyright § 12.05[B][2][b] (2025) (noting that the Second Circuit in *Psihoyos* rejected Judge Kaplan's *Auscape* ruling, but "fail[ed] to grapple with his logic," which "leaves the rationale undergirding *Auscape* unassailed.").

decision in *William A. Graham Co. v. Haughey*[21] is representative.[22] The court analyzed the legislative history of Section 507(b), noted that Congress "provided no 'directive' mandating use of the injury rule in that legislative history,"[23] and concluded that "the text and structure of the Copyright Act actually favor use of the discovery rule."[24] In terms of policy, it made the puzzling observation that "[t]echnological advances such as personal computing and the internet have 'ma[de] it more difficult for rights holders to stridently police and protect their copyrights,'"[25] but did not mention how technology may have made discovery of infringement easier, nor any need to balance this with the interest of defendants in being protected from stale claims. Most circuits have adopted similar reasoning, often with even less discussion.[26]

On its face, reliance on a judge-made rule of equity to postpone the date when an infringement claim accrues under Section 507(b) is hard to reconcile with the declaration in *Petrella* that such a claim "arises or 'accrue[s]' when an infringing act occurs."[27] But, as the Supreme Court is often wont to do, the *Petrella* Court qualified that seemingly absolute statement with a footnote: "Although we have not passed on the question, nine Courts of Appeals have adopted, as an alternative to the incident of injury rule, a 'discovery rule,' which starts the limitations period when 'the plaintiff discovers, or with due diligence should have discovered, the injury that forms the basis for the claim.'"[28] With this footnote, the Court thus managed simultaneously to both imply and disavow approval of the discovery rule for copyright infringement claims. This has left the lower courts free to continue to follow their pre-*Petrella* precedent applying the discovery rule, often without articulating any rationale other than that the Supreme Court has not expressly disapproved it.[29]

---

21 568 F.3d 425 (3d Cir.), *cert. denied*, 558 U.S. 91 (2009).

22 572 U.S. at 670 n.4.

23 568 F.3d at 435.

24 *Id.* at 434.

25 *Id.* at 437, quoting John Ramirez, Note, *Discovering Injury? The Confused State of the Statute of Limitations for Federal Copyright Infringement*, 17 Fordham Intell. Prop. Media & Ent. L.J. 1125, 1158 (2007).

26 *See, e.g.*, *Psihoyos*, 748 F.3d at 125 (adopting discovery rule for "substantially the reasons articulated by other Circuits that have grappled with this issue. . ."); Graper v. Mid-Continent Cas. Co., 756 F.3d 388, 393 n.5 (5th Cir. 2014) (applying discovery rule saying, "Other circuits agree that this is the proper inquiry."); Diversey v. Schmidly, 738 F.3d 1196, 1200 (10th Cir. 2013) (stating without discussion that the discovery rule is "the majority view," citing only pre-*TRW* cases).

27 *Petrella*, 572 U.S. at 670.

28 *Id.* at 670 n.4 (quoting *William A. Graham Co.*, 568 F.3d at 433 (internal quotation marks omitted by Supreme Court)).

29 *See, e.g.*, Martinelli v. Hearst Newspapers, L.L.C., 65 F.4th 231, 235, 245 (5th Cir. 2023), *cert. denied*, 144 S. Ct. 2561 (2024) (no prior circuit precedent "explains why the discovery rule applies to a copyright infringement claim," but it is nonetheless controlling

Since *Petrella,* the Supreme Court's treatment of the issue has done nothing to add clarity. In *SCA Hygiene Products Aktiebolag v. First Quality Baby Prods., LLC*,[30] a 2017 patent decision, the Court noted that it "is not ordinarily true" that accrual of a claim "occurs when 'a plaintiff knows of a cause of action'," citing *Petrella.*[31] The Court continued, "While some claims are subject to a 'discovery rule,'" that rule "is not a universal feature of statutes of limitations."[32] It then called out that "in *Petrella*, we specifically noted that 'we have not passed on the question' whether the Copyright Act's statute of limitations is governed by such a rule."[33]

Most recently, in 2024, Section 507(b) was squarely before the Court in *Warner Chappell Music, Inc. v. Nealy*.[34] There, the plaintiff had relied on the discovery rule to sue for acts of copyright infringement going back ten years before he filed suit.[35] The district court had found the claim timely based on the discovery rule, but nonetheless held that the plaintiff could recover damages for only the three years immediately preceding the filing of the lawsuit, relying on Second Circuit precedent[36] that grounded such a damages limitation in *Petrella*'s statement that Section 507(b) allows plaintiffs "to gain retrospective relief running only three years back from the date the complaint was filed."[37]

Many hoped that *Nealy* would finally provide a definitive pronouncement from the Supreme Court about whether the discovery rule applies to copyright infringement claims. But no. Because the defendant had, in the Court's view, not preserved an objection to the discovery rule in the courts below, the grant of certiorari had been explicitly premised on an "assumption" that "the discovery rule governs the timeliness of copyright claims."[38] The *Nealy* majority made clear that "[w]e have never decided whether

---

because *Petrella* did not "unequivocally overrule" it); Sohm v. Scholastic Inc., 959 F.3d 39, 50 (2d Cir. 2020) (adhering to the discovery rule as announced in *Psihoyos* because the Supreme Court "has not overruled *Psihoyos*, either implicitly or explicitly"); Starz Ent., LLC v. MGM Domestic TV Distrib., LLC, 39 F.4th 1236, 1242 (9th Cir. 2022), *rehearing en banc denied,* 2022 U.S. App. LEXIS 26291 (2022) ("Our circuit has continued to apply the discovery rule post *Petrella,*" and the "overwhelming majority of courts" do so). For a comprehensive survey of the evolution of the case law, *see* 3 Nimmer on Copyright § 12.05 (2025).

30 580 U.S. 328 (2017).

31 *Id.* at 337.

32 *Id.*

33 *Id.* at 337-38 (quoting *Petrella*, 572 U.S. at 670 n.4.

34 601 U.S. 366 (2024).

35 *Id.* at 369.

36 Sohm v. Scholastic Inc., 959 F.3d 39 (2d Cir. 2020).

37 *Petrella,* 572 U.S. at 672.

38 *Nealy*, 601 U.S. at 371.

that assumption is valid,"[39] and that it wasn't about to do so, explicitly "excluding consideration of the discovery rule [from review] and asking only whether a plaintiff with a timely claim under the rule can get damages going back more than three years."[40]

The Court had little difficulty resolving that artificially narrow issue. It said that its "three years back" statement in *Petrella* "merely described how the limitations provision works when a plaintiff has no timely claims for infringing acts more than three years old,"[41] and held that when a plaintiff does have a claim based on an older infringement (because of the assumed but still undecided application of the discovery rule), the text of the Copyright Act leaves no room for a separate time limit on monetary recovery apart from the stated limitations period.[42] But the language of the majority opinion seems calculated to reinforce the mystery surrounding the Court's views on the discovery rule itself, saying that "one understanding" of Section 507(b) is that "a copyright claim 'accrue[s]' when 'an infringing act occurs,'" while an "alternative view" is that the claim accrues "when 'the plaintiff discovers, or with due diligence should have discovered,' the infringing act," citing *Petrella* for both propositions.[43]

Among those exasperated by the Court's vacillation was Justice Gorsuch, who, in a dissent joined by Justices Thomas and Alito, opined that the Copyright Act "almost certainly does not tolerate a discovery rule,"[44] and chided the majority for choosing to "expound on the details of a rule of law" that "very likely does not exist."[45]

Given the studied absence of guidance from the Supreme Court, the lower federal courts will surely continue to apply the discovery rule in copyright cases,[46] the *Nealy* Court having noted that eleven courts of appeal had subscribed to the doctrine "at last count."[47]

IV. THE CONSEQUENCES FOR THOSE WHO HOST CONTENT ONLINE

Many areas of the law must balance a plaintiff's interest in having a fair opportunity to learn of and assert a claim with a

---

39 *Id.*

40 *Id.*

41 *Id.* at 373.

42 *Id.* at 372.

43 *Id.* at 369.

44 *Id.* at 374 (Gorsuch, J., dissenting).

45 *Id.* at 376 (Gorsuch, J., dissenting).

46 *See, e.g.*, Motorola Sols., Inc. v. Hytera Commc'ns Corp. Ltd., 108 F.4th 458, 479 (7th Cir. 2024) (saying, somewhat disingenuously, that *Nealy* was "careful to leave the discovery rule intact," and declining to abandon the rule "[w]ithout a Supreme Court mandate to do so"); *see also* cases cited at note 29, *supra.*

47 *Nealy,* 601 U.S. at 371.

defendant's interest in not being forced to defend claims so old that witnesses and documentation are no longer available. What skews the balance in the context of online content is the availability of powerful and cost-effective tools to search for and identify copies of specific works based on their unique digital "fingerprint."

Many companies offer such capabilities. For example, Pixsy[48] provides an "advanced image scanner and AI" that it says "finds accurate matches of your images online . . . so you can take action against copyright infringement."[49] It allows any user to "monitor 500 images for free (forever)!"[50] If the user so chooses, Pixsy will "work[] hard to recover fees and damages for the unauthorized use of your work. No win, no fee!"[51] TuneSat[52] offers similar tools for digital music. Its "audio recognition technology will scan TV channels and websites around the globe to discover where your music is being played—so you can get paid."[53] Up to fifty tracks can be monitored for free, and a "Premium" subscription starts at $35 a month.[54] For video files, nablet Video Search[55] invites you to "[m]onitor TV channels and media content platforms for your content usage live or on demand," to detect "if your content is used only by authorized customers."[56] Even if video content "has been altered or embedded within other videos," the service claims that its "powerful algorithms can pinpoint and match these fragments, ensuring comprehensive protection and reliable identification."[57]

These are only a few examples of the many policing tools that are available to copyright owners. Their ubiquity, affordability, and effectiveness should only increase as technology continues to improve. And they are needed and beneficial. They empower copyright owners to better and more quickly detect and remedy possible infringements of their works.

But such tools also make it possible, often at little or no initial cost, to discover long-forgotten files that may have lingered in publicly available archives for many years. The copyright owner who uncovers such a buried use has little incentive, and often no

---

48 Pixsy Inc., https://www.pixsy.com (last visited June 5, 2026).

49 *Id.*

50 *Id.*

51 *Id.* Pixsy explains: "When you submit a case to Pixsy, you authorize us as your licensing agent. Pixsy has a network of local law firms and attorneys that will represent you in each jurisdiction when needed." It also assures that "[s]ubmitting a case for resolution is free—we only charge a fee if we can successfully resolve your case (50% of the recovery)." *Id.*

52 Tunesat, LLC, https://tunesat.com/tunesatportal/home (last visited June 5, 2026).

53 *Id.*

54 *Id.*, https://tunesat.com/tunesatportal/home/pricing.

55 nablet GmbH, https://nablet.com/video-search (last visited June 5, 2026).

56 *Id.*

57 *Id.*

realistic means, of determining whether the work was originally licensed. The work might have been part of a digital library acquired by the current owner as a collective asset, and such bulk transfers do not always preserve older licensing information. Or the license may be in the name of a predecessor licensee that no longer owns the site where the work is displayed, or of an independent contractor whose association with the site ended long ago.

In short, the passage of time can compromise the records of a licensor just as easily as those of a licensee. When the current copyright owner turns up a years-old file in a scan, then, it is much easier to simply send a demand letter to whomever currently owns the server where the file has long been interred. This places the onus on the recipient to locate the witnesses and documentation needed to defend the claim, no matter how many years may have intervened. And that is precisely what a limitations statute is intended to limit: it "reflects a value judgment concerning the point at which the interests in favor of protecting valid claims are outweighed by the interests in prohibiting the prosecution of stale ones."[58]

To get a sense of how this plays out in practice, consider the facts of *Minden Pictures, Inc. v. Complex Media, Inc.*[59] The plaintiff, a photography licensing agency, filed a lawsuit in 2022 against the operator of a website alleging that the site was displaying one of the plaintiff's licensed images without permission. The image had been uploaded in 2012,[60] and the plaintiff did not allege that the image had been viewed by anyone (other than the plaintiff itself) in the ten years since.[61] The plaintiff "engages technology companies which can detect online infringement 'by crawling the internet,'"[62] and was a "frequent litigant" who had "filed more than 100 cases against purported copyright infringers."[63] Despite the ten-year delay, the plaintiff argued that its suit was timely under the discovery rule because it did not actually discover the infringement until 2022. The district court concluded that "it is not plausible that Plaintiff, in exercising reasonable diligence, would not have discovered the alleged infringing use here until nearly ten years after the infringement occurred,"[64] and dismissed the claim as untimely.

---

58 Johnson v. Ry. Express Agency, Inc., 421 U. S. 454, 463-464 (1975).

59 No. 22-CV-4069 (RA), 2023 WL 2648027 (S.D.N.Y. Mar. 27, 2023).

60 *Id.* at *1.

61 *Id.* at *5 n.4.

62 *Id.* at *1.

63 *Id.*

64 *Id.* at *3.

While that decision was not appealed, it has since been abrogated by the Second Circuit.[65]

Several added factors make the problem particularly acute in the copyright realm. One is the duration of copyrights, whose term extends well beyond lives in being.[66] When the owner of a portfolio of digital works compiled over an extended period of time decides to implement a scanning and enforcement service, then, the initial scan could very well detect online copies that were first posted and last thought about many years before. By the time zombie claims over such long-dormant files are resurrected, licensing documentation and the identity of knowledgeable witnesses may have been lost to history.

A further accelerant is the fact that the Copyright Act authorizes monetary remedies that are theoretically unmoored from any requirement to show actual damages. In other areas of the law, claims typically include as an essential element that a plaintiff must have been damaged by the wrong, damage that is more likely to be felt immediately. That damage will often prompt investigation, which tends to mitigate the problem of stale claims as a practical matter. For most torts, if a wrong lingers for ten or twenty years without causing enough harm to come to the attention of the plaintiff, then even if it is eventually discovered it is less likely that the plaintiff will have sufficient provable damages to make the claim worth pursuing. And the same passage of time that can cause defense evidence to dissipate may also compromise a plaintiff's evidence of causation and damages.

That's not always true, of course,[67] but with copyright infringement it *never* is. As long as copyright in the work was timely registered, the plaintiff always has a monetary remedy in the form of statutory damages,[68] where recovery requires no proof that the infringement caused any actual damage at all.[69] Although courts

---

65 In Michael Grecco Prods., Inc. v. RADesign, Inc., 112 F.4th 144 (2d Cir. 2024), *cert. denied*, 145 S. Ct. 2792 (2025), the Second Circuit held that a "plaintiff's 'sophisticated' nature does not automatically relieve a defendant of her burden to plead and prove a Copyright Act limitations defense," and "a likelihood, even a high one, that claims are untimely is not enough to make it 'clear' that they are." *See* text accompanying notes 75–82, *infra*.

66 The copyright term under U.S. law varies depending on when the work was published and other circumstances, but works published by an individual author on or after January 1, 1978, have an initial term of the author's lifetime plus 70 years, 17 U.S.C. § 302(a), while copyrights in works made for hire endure for 95 years from first publication or 120 years from creation, whichever is shorter. 17 U.S.C. § 302(c).

67 *See* text accompanying notes 86 and 87, *infra*, discussing the Supreme Court's recognition of the discovery rule for claims of fraud, latent disease, and medical malpractice, where injury may not manifest for a long time.

68 17 U.S.C. § 504(c).

69 Statutory damages may be awarded within the authorized range "[e]ven for uninjurious and unprofitable invasions of copyright. . . ." Getaped.com, Inc. v. Cangemi, 188 F. Supp.

have discretion to award much less, the amount can range up to $30,000 per work infringed,[70] or up to $150,000 if the infringement is found to be willful.[71] Even the prospect of an award at the minimum of $750 may do little to discourage otherwise incentivized plaintiffs from pursuing a claim when they also have an opportunity to recover attorney fees if they prevail.[72]

All these factors combine to make the pursuit of zombie claims an especially prevalent phenomenon in the copyright realm,[73] and an intractable problem for brand owners and others who display content online.

V. WHY DUE DILIGENCE WON'T DO

In its traditional formulation, the discovery rule doesn't allow plaintiffs to simply close their eyes to potential infringements for as long as they wish without consequence. As already noted, a claim accrues under the rule when the plaintiff discovers "or with due diligence should have discovered" the injury that forms the basis for the claim.[74] But this "due diligence" requirement really doesn't address the zombie claims problem.

This is because the duty of diligence doesn't arise until a copyright owner has been put on "inquiry notice" of a potential infringement, which "must be triggered by some event or series of

---

2d 398, 403 (S.D.N.Y. 2002) (quoting F.W. Woolworth Co. v. Contemporary Arts, Inc., 344 U.S. 228, 233 (1952)).

70 17 U.S.C. § 504(c)(1).

71 *Id.* § 504(c)(2).

72 *Id.* § 505. A fee award is discretionary and often turns on whether the defendant's position was reasonable, even if ultimately unsuccessful. Kirtsaeng v. John Wiley & Sons, Inc., 579 U.S. 197, 136 S. Ct. 1979 (2016). But "in any given case, a court may award fees even though the losing party offered reasonable arguments. . . ." *Id.*, 579 U.S. at 208-09.

73 *See* P. Levy, *Higbee Threatens Copyright Enforcement of Stale Claims (and Other Turns for the Worse)*, Consumer Law & Policy Blog, https://clpblog.citizen.org/higbee-threatens-copyright-enforcement-of-stale-claims-and-other-turns-for-the-worse/ (posted Sept. 25, 2023) (describing "a persistent tendency" by law firms representing copyright owners "to send demand letters claiming infringements that allegedly took place several years ago, even a decade ago or more," that were only discovered "in recent months by running reverse image searches," and noting that "there is no reason why those image searches could not have been conducted years ago"). PACER records of filings in U.S. District Courts, available at https://pacer.uscourts.gov/, reflect that Mathew Higbee, the copyright plaintiff's lawyer referenced in the Levy article, has filed 390 copyright infringement cases in federal courts in the last ten years. Daniel DeSousa, another prolific copyright plaintiff's lawyer, has filed more than 650. Of course, there is no record of how many demand letters were initiated by these and other lawyers that did not result in formal litigation.

74 William A. Graham Co. v. Haughey, 568 F.3d 425, 433 (3d Cir. 2009) (quoting Disabled in Action of Penn. v. Southeastern Penn. Transp. Auth., 539 F.3d 199, 209 (3d Cir. 2008)) (quoting in turn Romero v. Allstate Corp., 404 F.3d 212, 222 (3d Cir. 2005)).

events that comes to the attention of the aggrieved party."[75] And the triggering information must be specific to the particular infringement at issue.[76] Awareness that a work is popular, that people are interested in using it, and that the copyright owner's other similar works are being infringed do not, even collectively, give rise to a duty to investigate.[77] That remains true even if the use at issue was openly and publicly displayed for an extended period of time, and so should not have been difficult to find if the owner chose to look.[78]

Even where there are facts sufficient to trigger a duty to search for infringement, the court must conduct a "fact-intensive inquiry of the copyright holder's efforts to discover the infringement."[79] In such an inquiry, even if a plaintiff ignored early "storm warnings," how

---

75 Warren Freedenfeld Assocs. v. McTigue, 531 F.3d 38, 45 (1st Cir. 2008) ("The familiar aphorism teaches that where there is smoke there is fire; but smoke, or something tantamount to it, is necessary to put a person on inquiry notice that a fire has started."). *See also, e.g.*, William A. Graham Co., 568 F.3d at 438 (under the discovery rule, a claim accrues when plaintiff "should have known of the basis for [its] claims [, which] depends on whether [it] had sufficient information of possible wrongdoing to place [it] on inquiry notice or to excite storm warnings of culpable activity") (quoting Benak ex rel. Alliance Premier Growth Fund v. Alliance Capital Mgmt. L.P., 435 F.3d 396, 400 (3d Cir. 2006)) (quoting in turn *In re* NAHC, Inc. Sec. Litig., 306 F.3d 1314, 1325 (3d Cir. 2002)) (edits by *William A. Graham Co.* court).

76 Michael Grecco Prods., Inc. v. RADesign, Inc., 112 F.4th 144, 148 (2d Cir. 2024) ("a copyright holder's *general* diligence or allegations of diligence in seeking out and litigating infringements, alone, are insufficient to make it clear that the holder's *particular* claims in any given case should have been discovered more than three years before the action's commencement") (emphasis in original); Global Weather Prods., LLC v. Wood Projections, Inc., 2026 U.S. Dist. LEXIS 50207, at *16 (S.D. Fla. Jan. 5, 2026) (plaintiff's "awareness that another entity was infringing" the same work was not a "storm-warning concerning this Defendant").

77 For example, in Masi v. Moguldom Media Grp. LLC, 2019 U.S. Dist. LEXIS 121733, at *15 (S.D.N.Y. 2019), plaintiff knew that there was intense interest in his photos of a murder site and was prompted to register copyrights in the photos when he learned that others of his works had been infringed. The court nonetheless granted summary judgment to the plaintiff rejecting a statute of limitations defense because, without actual knowledge of infringement of those particular works, "there was no reason for him to think, or duty for him to scour the internet to find out if, anyone was using his photographs without his consent.").

78 *See, e.g.,* Sohm v. Scholastic Inc., 959 F.3d 39, 51 (2d Cir. 2020) ("[W]ithout identifying facts or circumstances that would have prompted such an inquiry, Scholastic cannot rely on the passage of time alone to establish that Sohm should have discovered the alleged copyright infringements at issue in this case."); Design Basics, LLC v. Chelsea Lumber Co., 977 F. Supp. 2d 714, 725 (E.D. Mich. 2013) ("the fact that evidence of the claimed infringement was publicly accessible does not suffice to put Plaintiff on inquiry notice, without evidence that Plaintiff became aware of storm warnings that would have suggested reason to investigate").

79 Michael Grecco Prods., Inc. v. RADesign, Inc., 112 F.4th 144, 152 (2d Cir. 2024). The issue usually will not be disposed of, and likely will not even arise, at the pleadings stage. The statute of limitations is an affirmative defense, so a plaintiff has no obligation to plead facts relevant to the timeliness of the claim such as the plaintiff's knowledge or diligence. *See id.* at 153-54 ("the complaint did not need to allege, plausibly or otherwise, that the claim was timely").

is a defendant to prove that a search that didn't happen necessarily would have uncovered the alleged infringement? Internet scanning tools are powerful, but not infallible.[80] Courts may be reluctant to conclude that a plaintiff *should* have discovered an infringement when there is no guarantee that the use of scanning tools *would* have discovered it.[81]

For all these reasons, despite the wide availability of detection tools, courts have generally been unwilling to find that plaintiffs have any duty to use them.[82] The practical result is that under the discovery rule, an infringement claim for the display of content online will likely not accrue until the copyright owner chooses to look for it, even if that choice is made many years after the content was posted. This creates a perverse incentive: the longer a copyright owner waits to launch an inquiry, the better the odds that any claims discovered will succeed, because evidence needed to defend them will be that much more likely to have been lost.

VI. WHAT SHOULD BE DONE

There are a number of ways this imbalance could be addressed. The most straightforward would be for the Supreme Court to adopt the position advocated by the dissent in *Nealy*,[83] holding in an appropriate case that Section 507(b) is governed by the incident of injury rule, and the discovery rule simply does not apply.

---

80 The CEO of one prominent Internet image scanning service, ImageRights, testified that "even the most sophisticated crawler software cannot capture all copyright infringement on the internet," and his clients "often report examples of copyright infringement that the company's software did not capture." Affordable Aerial Photography, Inc. v. Prop. Matters United States, LLC, 2023 U.S. Dist. LEXIS 82962, at *4-5 (S.D. Fla. 2023).

81 *See* McDermott v. This Dog's Life Corp., 730 F. Supp. 3d 73, 80 (S.D.N.Y. 2024) ("While McDermott theoretically 'could' have found the infringement, the relevant 'test is not whether a plaintiff could have learned of their injury; rather, it is whether, . . . they should have known of their injury'" (quoting Parisienne v. Scripps Media, Inc., 2021 U.S. Dist. LEXIS 154960, at *11 (S.D.N.Y. 2021)). *See also* Michael Grecco Prods. v. BDG Media, Inc., 834 F. App'x 353, 354 (9th Cir. 2021) (noting "the difficulty of detecting online infringements, even when plaintiffs like Grecco invest in both in-house infringement detection using Google image search as well as third-party reverse image search software. At what time these search processes would or should have captured alleged infringements is a question of fact. . .").

82 An illustrative case is *Mavrix Photo, Inc. v. Rant Media Network, LLC,* 2020 U.S. Dist. LEXIS 248485, at *8-9 (C.D. Cal. 2020), where the accused image was posted in 2011, but plaintiff said it did not discover the infringement until hiring the ImageRights service in 2016. The court acknowledged that "services such as ImageRights have existed since 2002," but declined "to further probe the reasonableness of Plaintiff's choice not to hire a third-party service earlier on a motion to dismiss."). *See also, e.g.,* Minden Pictures, Inc. v. Conversation Prints, LLC, 2022 U.S. Dist. LEXIS 179602, at *9 (E.D. Mich. 2022) ("Copyright holders do not have a general duty to scour or police the internet to determine if their work has been infringed.").

83 601 U.S. 366, 374-76 (2024) (Gorsuch, J., dissenting).

There is ample jurisprudential support for such an outcome. Despite occasional *dicta* implying otherwise,[84] for at least twenty-five years the Supreme Court has in various contexts refused to subscribe to a presumptive general discovery rule.[85] Instead, the Court has emphasized the discovery rule's origin in fraud cases as an "exception" to "the general limitations rule that a cause of action accrues once a plaintiff has a 'complete and present cause of action,'"[86] and has limited the discovery rule to a narrow class of cases—fraud, latent disease, and medical malpractice—"'where the cry for [such a] rule is loudest.'"[87]

It is difficult to see how copyright infringement, which often involves the public (or publicly available) display of allegedly infringing works, "cries out for application of a discovery rule."[88] While there will certainly be cases where infringements do not come to the attention of a copyright owner within the three-year statutory period, that possibility has always been inherent in the very concept of a limitations statute: "The theory is that even if one has a just claim it is unjust not to put the adversary on notice to defend within the period of limitation and that the right to be free of stale claims in time comes to prevail over the right to prosecute them."[89]

It is also worth noting that federal statutes of limitations are in any event presumptively subject to equitable tolling.[90] Tolling extends the limitations period if the circumstances make it inequitable for it to expire, typically because of some incapacity on the part of the plaintiff or fraudulent concealment by the defendant.[91] The discovery rule therefore has practical effect only in the absence of such circumstances. If the Supreme Court were to put a stake in the heart of the discovery rule for Section 507(b), courts

---

84 *E.g.,* Rotella v. Wood, 528 U.S. 549, 555 (2000) (commenting that federal courts "generally apply a discovery accrual rule when a statute is silent on the issue.").

85 *See* TRW Inc. v. Andrews, 534 U.S. 19, 27 (2001) (*Rotella* and other cases have suggested that "federal courts generally apply [a] discovery accrual rule," but "we have not adopted that position as our own.").

86 Merck & Co. v. Reynolds, 559 U.S. 633, 644 (2010) (quoting Bay Area Laundry and Dry Cleaning Pension Tr. Fund v. Ferbar Corp. of Cal., 522 U.S. 192, 201 (1997)).

87 *TRW Inc.*, 534 U.S. at 27 (2001) (quoting Rotella v. Wood, 528 U.S. 549, 555 (2000) (edits by *TRW Inc.* court)).

88 *Id.* at 28.

89 Order of R. Telegraphers v. Ry. Express Agency, Inc., 321 U.S. 342, 348-49 (1944).

90 Equitable tolling applies unless Congress has clearly and unambiguously stated that a limitation is jurisdictional in nature. Boechler, P.C. v. Comm'r, 596 U.S. 199, 204 (2022). Section 507(b) lacks any jurisdictional language.

91 Equitable tolling "pauses the running of, or 'tolls,' a statute of limitations when a litigant has pursued his rights diligently, but some extraordinary circumstance prevents him from bringing a timely action." Lozano v. Montoya Alvarez, 572 U.S. 1, 10 (2014). The *Petrella* Court gave as examples "a party's infancy or mental disability, absence of the defendant from the jurisdiction, [or] fraudulent concealment." *Petrella*, 572 U.S. at 681 n.17.

would nonetheless continue to have tools to deal with defendants who conceal their culpable conduct or mislead the copyright owner into not pursuing an infringement claim.

Unfortunately, the current Supreme Court appears to be singularly unmotivated to take up the issue, leaving little prospect for judicial intervention in the foreseeable future. The same result could be achieved, however, by Congress amending Section 507(b) to clearly exclude the discovery rule. For example, the statute governing copyright infringement claims against the federal government states in relevant part that "no recovery shall be had for any infringement of a copyright covered by this subsection committed more than three years prior to the filing of the complaint."[92] Omitting any reference to when the claim "accrued" or "arose," and instead invoking the date when the infringement was "committed," leaves no ambiguity.[93]

Legislation could also implement more nuanced solutions. Congress could allow the discovery rule to extend the three-year limitations period, but not beyond an outside boundary set by a statute of repose, such as five or seven years from the last act of infringement.[94] That would preserve some flexibility in the limitations period if a diligent plaintiff had no reason to know of the infringement, but neither the discovery rule nor equitable tolling would extend the life of the claim beyond the statute of repose's "outer limit."[95]

Yet another option would be for Congress to foreclose the discovery rule for damages claims but permit copyright owners to seek injunctive relief at any time.[96] That would allow diligent

---

92 28 U.S.C. § 1498(b).

93 The Supreme Court has held that similar language in the Fair Debt Collection Practices Act (an action may be brought "within one year from the date on which the violation occurs," 15 U.S.C.S. § 1692k(d)) "unambiguously sets the date of the violation as the event that starts the one-year limitations period," and forecloses any interpretation that might import a discovery rule. Rotkiske v. Klemm, 589 U.S. 8, 13 (2019).

94 For an explanation of the distinctions between statutes of repose and statutes of limitation, *see* CTS Corp. v. Waldburger, 573 U.S. 1, 7-9 (2014). The North Carolina law at issue in *CTS Corp.* provides an example of how such a blended measure might be drafted: a claim "shall not accrue until [damage to the claimant] becomes apparent or ought reasonably to have become apparent to the claimant, whichever event first occurs," but "no cause of action shall accrue more than 10 years from the last act or omission of the defendant giving rise to the cause of action." N.C. Gen. Stat. § 1-52(16). At the federal level, the Fair Credit Reporting Act, 15 U.S.C. § 1681p, utilizes a similar construction.

95 *Waldburger*, 573 U.S. at 9 (a statute of repose "puts an outer limit on the right to bring a civil action" and "may not be tolled, even in cases of extraordinary circumstances beyond a plaintiff's control").

96 It is not unusual for statutes of limitations to distinguish between claims for monetary recovery and injunctive relief. Historically, statutes of limitations were interpreted to apply only to legal claims, while claims sounding in equity were governed by more flexible equitable doctrines such as laches. *See* Holmberg v. Armbrecht, 327 U.S. 392, 396 (1946) ("Traditionally and for good reasons, statutes of limitation are not controlling measures of equitable relief. Such statutes have been drawn upon by equity solely for

copyright owners to halt online infringements whenever they were discovered, and defendants are unlikely to resist taking down years-old content in order to resolve a claim.

VII. CONCLUSION

No one likes to deal with zombies. Copyright owners and their attorneys resurrect zombie infringement claims for damages because the discovery rule makes it possible, but courts and litigants are then forced to reckon with nuanced factual issues of knowledge, diligence, and intent guided only by stale and incomplete factual records.

However it might be realized, a definitive rejection of the discovery rule, or at least the implementation of precise parameters around its operation, would bring much needed clarity to a field where ambiguity is too often exploited. Copyright owners would then have a well-defined time horizon for bringing infringement claims, providing motivation to employ available detection tools within a reasonable time, and those who host online content would have a clear time frame for maintaining documentation of their legitimate use. As a result, infringements would be more likely to be pursued at a time when both plaintiff and defendant should have relatively fresh records to consult in order to verify whether the use was licensed or otherwise authorized. And everyone could spend their time and resources in creating and distributing innovative new content instead of wrestling zombies.

---

the light they may shed in determining that which is decisive for the chancellor's intervention, namely, whether the plaintiff has inexcusably slept on his rights so as to make a decree against the defendant unfair."). The Clayton Act, for example, includes a four-year statute of limitations, 15 U.S.C. § 15b, which applies to claims for damages under 15 U.S.C. §§ 15 and 15a, but imposes no limitation on suits for injunctive relief under 15 U.S.C. § 26, which are governed only by laches. *See* Solo v. SD-3C LLC, 751 F.3d 1081 (9th Cir. 2014), *cert. denied*, 575 U.S. 950 (2015).

BOOK REVIEW*

*By Tom Rammer***

Advanced Introduction to International Patent Law. Margo A. Bagley and Rochelle C. Dreyfuss, 2025. Pp 152. $120.00 (hardback); $28.95 (paperback); $23.16 (eBook). Edward Elgar Publishing Ltd, 15 Lansdown Road, Cheltenham, Glos GL50 2JA UK.

Patent law can intimidate the uninitiated, given both its technical subject matter and the dense, often-shifting details of substantive doctrine. The global nature of modern markets adds yet another layer of complexity, as patent rights are shaped by the interaction of national laws with a web of regional and international agreements. In this book, the acclaimed authors—Margo A. Bagley, Asa Griggs Candler Professor of Law at Emory University School of Law, and Rochelle C. Dreyfuss, Pauline Newman Professor of Law Emerita at New York University School of Law—offer a comprehensive survey of patent law across jurisdictions and explain how trade agreements have reshaped the field over the past century.

The book is written for a broad audience that includes students, economists, policymakers, and practitioners. In the Preface, the authors set out their central thesis: that patent law can play an important role in encouraging beneficial innovation when used thoughtfully, but that excessively stringent protection can limit governments' ability to meet the needs of their populations, particularly in low- and middle-income countries. Throughout the book, the authors draw on examples from the COVID-19 pandemic to illustrate how the international patent system affects countries at different levels of economic development, often highlighting the limits of humanitarian, policy-driven approaches embedded in existing treaties.

Chapter One ("International Patent Law: Background and Overview") provides a clear and thorough introduction to the development of international patent law. It traces the evolution of treaties and institutions that have shaped national systems, beginning with the Paris Convention of 1884 and the Berne Convention of 1886, continuing through the creation of the World Intellectual Property Organization and the World Trade

---

* This book review should be cited as Tom Rammer, Book Review, 116 Trademark Rep. 601 (2026) (reviewing Advanced Introduction to International Patent Law (Margo A. Bagley & Rochelle C. Dreyfuss, 2025)).

** Of Counsel, Ice Miller LLP, Member, International Trademark Association.

Organization ("WTO"), and concluding with the 2024 Treaty on Intellectual Property, Genetic Resources, Traditional Knowledge and Folklore, and Associated Traditional Knowledge. The chapter outlines the structure of these agreements and institutions, examines regional frameworks such as the European Patent Convention, and explains why substantive harmonization of patent law has lagged behind developments in copyright and trademark law. It also explores persistent tensions within the system, particularly those arising from disparities in technological capacity between high-income countries and low- and middle-income nations.

Chapter Two ("Procedural Convergence") explains how the Paris Convention promotes greater consistency in patent procedures across countries. It surveys ongoing efforts to simplify the process of obtaining and maintaining patents, with the goal of making international protection more accessible for inventors. The chapter also reviews regional agreements and other initiatives aimed at harmonizing patent examination and prosecution practices.

Chapter Three ("Substantive Convergence") shifts the focus to efforts to harmonize the underlying rules of patent law. It discusses why earlier attempts within the World Intellectual Property Organization failed and explains why negotiations proved more successful after moving to the World Trade Organization. The chapter then examines the patent provisions of the Agreement on Trade-Related Aspects of Intellectual Property Rights ("TRIPS Agreement"), describing both the minimum standards of protection that member states must observe and the flexibility they retain in implementing those standards. It concludes by considering newer agreements that exceed TRIPS requirements and further expand protection for technological innovation.

Chapter Four ("Enforcement") addresses how international patent rights are enforced. It begins with an overview of the TRIPS enforcement provisions, which require member countries to provide fair and effective procedures for resolving intellectual property disputes within their own legal systems. The chapter then discusses later agreements that have raised enforcement expectations and explains why a system built around territorial, country-by-country adjudication has become increasingly strained in a global economy. It closes by examining emerging approaches to enforcing patent rights across borders.

Chapter Five ("Compliance") examines how the international system encourages countries to meet their patent-related obligations. Although the Paris and Berne Conventions technically permit disputes to be brought before the International Court of Justice, that mechanism has never been used. In contrast, more recent agreements rely on more practical

tools, most notably the WTO's dispute settlement system. Because the TRIPS Agreement incorporates key obligations from the Paris and Berne Conventions, the WTO's dispute settlement system also plays an indirect role in enforcing those earlier commitments. This chapter examines the small number of patent cases decided through the WTO, along with related intellectual property disputes that have influenced how the patent system functions. It also considers an additional compliance mechanism found outside the WTO: investor–state dispute settlement under bilateral and regional investment agreements that allow private investors to challenge state actions affecting patent rights.

Chapter Six ("Emerging Issues and Future Directions") concludes the book by addressing new challenges confronting the international patent regime. It highlights the tensions between efforts to expand patent protection and efforts to preserve national authority over public-interest concerns, particularly with respect to genetic resources and associated traditional knowledge. The chapter also considers how the system may evolve in response to technological developments such as artificial intelligence.

Margo A. Bagley's and Rochelle C. Dreyfuss's *Advanced Introduction to International Patent Law* offers a comprehensive summary of international patent law and its ongoing evolution. Chapters Two and Three are valuable and practical surveys of procedural and substantive patent law around the world. The remaining chapters reflect the (sometimes intentionally) weaker and more ambiguous portions of international patent agreements and the implications for practitioners, patent holders, and governments. The result is a valuable resource for readers seeking both a foundational understanding and a thoughtful critique of the global patent system.

BOOK REVIEW*

*By Zvi Rosen***

Branding Trust: Advertising and Trademarks in Nineteenth-Century America. Jennifer M. Black, 2023. Pp. 320. $49.95 (hardcover, eBook). University of Pennsylvania Press, 3810 Chestnut Street, Suite 300, Philadelphia, PA 19104-3171.

American trademark law came of age in the nineteenth century. Although trademark law would not yet reach maturity until the Lanham Act decades later, the first state trademark statute was enacted in 1847, followed by many others, and a federal trademark statute was enacted in 1870. The lack of a firm constitutional tie to commerce led to the fall of the federal laws with the *Trade-Mark Cases* in 1879.[1] A new federal law limited to international commerce came in 1881, but after the Supreme Court made clear in 1903 that this new law did not protect against domestic infringements of such marks,[2] the 1905 Trademark Act was passed, which was based on use of a mark in interstate commerce. All this time, the common law of trademarks was developing simultaneously and in tandem with the federal law.

Stated above is the history of trademarks, through a purely legal lens. There are relatively few legal histories of trademarks to begin with—Frank Schechter's 1925 work *The Historical Foundations of the Law Relating to Trade-Marks*[3] is frequently pointed to, although the bulk of the work focuses on trademarks before (often well before) 1776. Scholars including myself have written longer articles on the history of American trademark law, but there hasn't been a major monograph on the subject[4]—and there are even fewer, if any, histories of trademarks that ground the legal development of trademarks within a broader cultural context.

---

* This book review should be cited as Zvi Rosen, Book Review, 116 Trademark Rep. 604 (2026) (reviewing Jennifer M. Black, Branding Trust: Advertising and Trademarks in Nineteenth-Century America (2023)).

** Associate Professor of Law, Faculty Director of the Franklin Pierce Center for Intellectual Property, University of Pierce School of Law, University of New Hampshire.

1 100 U.S. 82 (1879).

2 Warner v. Searle & Hereth Co., 191 U.S. 195 (1903).

3 Frank I. Schechter, The Historical Foundations of the Law Relating to Trade-Marks (1925).

4 *See* Zvi S. Rosen, *In Search of the* Trade-Mark Cases*: The Nascent Treaty Power and the Turbulent Origins of Federal Trademark Law*, 83 St. John's L. Rev. 827 (2009); Zvi S. Rosen, *In the shadow of the* Trade-Mark Cases*: the 1881 Trademark Act and the Supreme Court, in* Forgotten Intellectual Property Lore 256 (Shuba Ghosh ed., 2020).

Now we have one, from an unexpected place: Jennifer M. Black, an Associate Professor of History and Government at Misericordia College. Professor Black is not a lawyer, instead coming from an academic history background, focusing on visual studies, advertising, and material culture. The result is the book *Branding Trust: Advertising and Trademarks in Nineteenth-Century America*, offering a fresh perspective on an intersection of law, business, and culture that we perhaps acknowledge but rarely interrogate. The author "integrates the study of legal history, cultural history, economic history, and visual culture"[5] to analyze "the visual rhetoric of trust and legitimacy"[6] that trademarks and advertising represent. The book is arranged in six chapters that culminate in the review of the early twentieth century and the passage of the 1905 Trademark Act.

This synthesis of disciplines has a great deal to tell us and can enrich our understanding of the history of trademark law. It's easy enough to talk about the early common-law cases and state statutes regarding trademark law, but the connection between these legal developments, the development of standards of commercial morality, and the aftermath of the Panic of 1837 is not nearly as obvious without this interdisciplinary focus. The first chapter's exploration of the importance of testimonials in promotion of goods connects the "material culture of gentility" of the era directly to the development of trademark law happening at that time.[7]

The book's second chapter dips deeper into legal history, exploring the litigation involving passing off and counterfeiting in the mid-nineteenth century, and the evolution of moral norms regarding authenticity that accompanied this litigation. The chapter culminates with the passage of the 1870 Act, and speaking as someone who has written a history of the 1870 Act, I find it fascinating to see how a historian approaches it, looking less to diplomatic maneuvers, and more to evolving conceptions of appropriate commercial behavior. Of course, diplomacy and commercial mores often intersect, but Professor Black's expertise allows her to illuminate this intersection in a way that combines nonlegal and legal considerations in a uniquely skillful way.

Moving forward, the next chapters gravitate further away from legal history, with the third and fourth chapters, respectively, focused on uses of type (setting and faces) in newspaper advertising and in trade cards. Although they don't dive into legal history, these

---

5 Jennifer M. Black**,** *Branding Trust: Advertising and Trademarks in Nineteenth-Century America* (interview by H-Net), H-Net: Humanities & Social Sciences Online (May 6, 2026), https://networks.h-net.org/group/discussions/20150838/jennifer-blacks-branding-trust-advertising-and-trademarks-nineteenth.

6 Jennifer M. Black, Branding Trust: Advertising and Trademarks in Nineteenth-Century America 17 (2023).

7 *Id.* at 28.

chapters add understanding to the milieu of trademark law at the time and inform legal precedents from that period. For instance, the Supreme Court case of *Higgins v. Keuffel*, finding that an unadorned product label for ink simply describing the contents was not protectible under the copyright-adjacent 1874 Print and Label Law, is given additional context when we learn that advertising was becoming creative through the use of various typefaces.[8] The book's fifth chapter looks at the shift from testimonials in advertising to the rise of fictional characters associated with a corporation who would embody the brand's goodwill in advertising. Obviously, such characters are still used extensively, and understanding their rise is to understand the commercial considerations underpinning trademark law.

The final chapter returns to legal history, looking at the increased importance of goodwill and trademarks in advertising, as these legal considerations became less incidental and more central to branding and marketing-positioning strategy. A substantial portion of this chapter is focused on Nabisco, offering a valuable study of trademark strategy in the era. Nabisco built a trademark portfolio that not only generated strong marks but created associations of those marks and their owner with quality. This was complemented by an aggressive litigation strategy to ensure that Nabisco's marks retained their association. Black estimates that within sixteen years of its founding, Nabisco had been successful in about 830 trademark disputes in and out of court as part of building its brands.[9] The passage of the 1905 Act marks the culmination of the book, although the 1905 Act was famously insufficient—as an epilogue notes. It would not be until 1946 and the enactment of the Lanham Act that the United States had a truly effective federal trademark law.

The book is printed in black and white and is extensively illustrated in a way that enriches the narrative, showing us examples of the advertising being discussed. Color would have been nice when chromolithographs were discussed, but it would have doubtless added to the cost, and most of the advertisements discussed had originally appeared in black and white newspapers anyway.

I enjoyed reading *Branding Trust: Advertising and Trademarks in Nineteenth-Century America*, and I'm certain others would find it enjoyable as well. It makes an important contribution to our understanding of how trademark law became what it is today.

---

[8] 140 U.S. 428 (1891).

[9] Black, *supra* note 6 at 232.

BOOK REVIEW*

*By Lesley McCall Grossberg*** *and Gavin Canzanese****

Research Handbook on the History of Trademark Law. Lionel Bently and Robert G. Bone, eds. 2024. Pp. 488. $332.00 (hardback); from $65.00 (eBook). Edward Elgar Publishing Limited, The Lypiatts, 15 Lansdown Road, Cheltenham Glos., GL50 2JA, UK; Edward Elgar Publishing, Inc., William Pratt House, 9 Dewey Court, Northampton, Massachusetts 01060, USA.

Trademarks are everywhere—yet the depth and richness of their history can go unnoticed. In *Research Handbook on the History of Trademark Law*, editors Lionel Bently (University of Cambridge) and Robert G. Bone (University of Texas) put forward a collection of scholarly essays by sixteen contributors, many of whom have made significant contributions to the field of trademark law or advanced the historical study of intellectual property. The essays explore intellectual history, regulatory choices, and the social, economic, cultural, and political factors that shape trademark use, registration, and enforcement. Together, they represent an important contribution to the field of trademark legal history.

The book is organized into three parts. Part I explores the "Ideas, Beliefs, and Concepts" that influenced the shape and development of trademark law from a largely comparative perspective. "A distinctive absence: registrable trade marks in 1875," by Dev S. Gangjee, offers insight into how registrable trademarks were born in the United Kingdom, looking at Britain's initial trademark registration system and analyzing its origins and shortcomings. "Brand property from below," by Oren Bracha, explores the role of social practices in elevating trademarks from simple tools of communication to valuable commercial assets. Tracing a U.S. textile company's evolving use and registration of trademarks in the early twentieth century, it offers a compelling real-world example of how the meaning and function of trademarks have shifted over time and under different statutory schemes, revealing "the emergence of the brand property experience out of ordinary trademark practices"

---

* This book review should be cited as Lesley Grossberg & Gavin Canzanese, 116 Trademark Rep. 607 (2026) (reviewing Research Handbook on the History of Trademark Law (Lionel Bently & Robert G. Bone eds. (2024)).

** Partner, Ice Miller LLP, Member, International Trademark Association.

*** Incoming Associate, Ice Miller LLP, Member, International Trademark Association.

through a record of communication between company executives and their intellectual property lawyers.

"Designing goodwill: from graphic design to trademarks," by Jose Bellido, discusses goodwill in the context of shifting focus from the product to the packaging itself— highlighting its role in eliciting consumer responses even before product use. Bellido argues that emotional connections matter in branding, and that the ability to think like a consumer is a defining characteristic of effective brand management. This chapter highlights defining moments in branding history, such as the dawn of color television, which revolutionized visual advertising, and the start of efforts to develop a brand name so original that it bore no resemblance to any word in known languages. The conclusion notes that the content of articles published in *The Trademark Reporter* and other United States Trademark Association[1] publications in the 1960s and 1970s mirrors this "effervescent" period in which branding specialists emerged to advise on graphic design and marketing in the mass media age. The next chapter "Commercial marks and signs in European jurisprudence, 1300–1600," moves from the "Mad Men" era to late medieval and Renaissance Italy. Authors Robert Fredona and Teresa da Silva Lopes demonstrate how the existence and value of marks and seals for indicating quality or origin was acknowledged in Roman and canon law between 1300 and 1600. And in "Beyond the brand: trademarks through the lens of information," Paul Duguid traces how the rise of information theory has affected trademark law in the United States and the United Kingdom, considering conflict between the traditional focus on goodwill and the contemporary law and economics approach to consumer decision-making theory.

Part II delves into "Regulatory Models and Rule Choices." The essay by Robert Burrell and Michael Handler ("The garden path and the road not taken: the Australian approach to trade mark ownership and its connection with a lost model of trade mark registration") looks at Australia's approach to trademark ownership, specifically the history of its development and how it diverged from the United Kingdom's model. Next, "Secondary liability in U.S. trademark law: the ambivalent legacy of *Warner v Eli Lilly & Co.*," by Mark D. Janis, offers an in-depth analysis of how trademark secondary liability jurisprudence evolved through the U.S. Supreme Court's 1924 decision, with particular focus on how the decision's ambiguity regarding induced or contributory infringement shaped subsequent judicial decisions. In the third and final chapter of Part II, N.M. Dawson explores in "Colour in trade mark law" the history of colors as trademarks in the United

---

[1] In 1993, the United States Trademark Association renamed itself as the International Trademark Association.

Kingdom, European Union, and United States. Like many contributions in the book, this one traces the historical roots of the concept under consideration through these comparative jurisdictions, gradually guiding the reader to a contemporary understanding by its conclusion.

Part III focuses on the "Social, Economic, and Political Context" of trademarks, examining how each factor has affected the field of trademarks and how best to protect them. This part comprises four historical case studies and two broader inquiries into the development of U.K. and U.S. trademark law.

David M. Higgins's case study on GUINNESS beer, "'Pure genius?' Guinness and trade mark protection, c. 1890–1914," examines the trademark challenges the company faced in the early twentieth century and its resulting successes and setbacks. This chapter includes reproductions of public apologies issued by publicans who had misleadingly sold GUINNESS porter in bottles labeled "Extra Stout," as well as a thorough discussion of Guinness's then-innovative Trade Mark Label Agreement, which regulated the use of the GUINNESS trademarks by beer bottlers and provided Guinness a viable alternative to tying its products to particular public houses as a means of ensuring quality and protecting goodwill. Next, Elena Cooper's "The nineteenth-century history of the Jaeger trade mark in Britain" reviews the complex branding strategies of the British clothing brand JAEGER in the late nineteenth and early twentieth century, highlighting how non-geographical trademarks can evoke specific places—and the consequences that arise when those associations are challenged.

In the third case study, "Emergence of a brand: a case of Jaffa Oranges from Mandate Palestine," Michael Birnhack draws upon his reconstructed trademark registry of Mandate Palestine[2] to examine how "Shamouti" oranges became known as "Jaffa" oranges, showing how the term came to represent an entire region, even while the law did not technically provide for protection of geographical indications. Finally, Amanda Scardamaglia (in "Historical trade mark form and function: Seidsh Match labels") considers the history of SWEDISH MATCH matchbox labels—specifically how their matchbox labels promoting the ideas and values of the British Empire were registered for protection in Sweden to serve a purpose other than the typical source-identifying function of a trademark, as the matchboxes were distributed throughout the British colonies. Together, these case studies reveal how trademarks not only protect commercial interests but also reflect broader cultural, political, and historical dynamics.

---

[2] *See* Michael Birnhack, *Reconstructing the Trademark Registry of Mandate Palestine and What Historical Data Can Reveal*, 113 Trademark Rep. 815 (2023).

Next, Jennifer Davis analyzes British labor history through the lens of trademark law in "Trade marks and truth telling: sweated labour and the marking of goods in Britain, 1860–1920." As U.K. trademark law developed in the late nineteenth century, production of goods largely relied on the "sweating system" that paid workers by the piece, which incentivized long hours and minimal earnings. Trademark laws at the time failed to require transparency about how or where goods were made, especially in relation to labor conditions. A company would put their reputable mark on products, conveying a different reality from the fact that the product was subcontracted at least once and produced by underpaid workers in poor and unregulated conditions. These realities have not disappeared with time, and these injustices still exist in the modern era.

The final chapter of Part III, "Edward S. Rogers, the Lanham Act, and the common law," written by Jessica Litman and recently reprinted in full in *The Trademark Reporter*,[3] sheds light on the career and contributions of U.S. lawyer Edward S. Rogers (1875–1949), the principal drafter of the Lanham Act. It begins by exploring Rogers's background and the legal landscape of his time when trademark law was largely governed by common law and federal involvement was minimal. The author then traces Rogers's efforts to establish a unified federal registration system for trademarks, while still preserving the protections offered by common law. Rogers helped lay the foundation for the modern framework of U.S. trademark law: drafting, revising, and drumming up support for the Lanham Act. The discussion details his pivotal role in that legacy.

The *Research Handbook on the History of Trademarks* offers a rich and nuanced exploration of how historical developments have shaped trademark law as we know it today. Through its varied contributions of case studies and historical discourses, this book is especially valuable for readers interested in the deeper context—the "how" and "why" behind modern trademark principles. It is ideally suited for those who seek to understand trademarks not just as legal tools, but as evolving cultural and commercial phenomena. And finally, it represents an important and welcome addition to the growing body of scholarship on intellectual property in a historical context.

---

[3] Jessica Litman, *Edward S. Rogers, the Lanham Act, and the Common Law*, 115 Trademark Rep. 718 (2025).

GUIDELINES FOR SUBMISSIONS TO *THE TRADEMARK REPORTER*

The Trademark Reporter (TMR) welcomes submissions at wknox@inta.org.

The complete TMR Submission Guidelines are available at https://www.inta.org/resources/the-trademark-reporter/tmr-submission-guidelines/.

THE TMR ONLINE

International Trademark Association: Issues of the TMR beginning with Volume 105, Number 1, 2015, are available to the public at https://www.inta.org/TMR; INTA members may log in for complimentary access to the complete archive.

HeinOnline: Issues of the TMR beginning with Volume 1, Number 1, 1911, are available through HeinOnline.

LexisNexis: Issues of the TMR beginning with Volume 31, Number 1, 1941, are available through LexisNexis.

Westlaw: Issues of the TMR beginning with Volume 80, Number 1, 1990, are available through Westlaw.

PRINTED COPIES

Printed copies of the TMR can be ordered from William S. Hein & Co., Inc. (order@wshein.com).