

Trade mark protection after the expiration of copyright: The municipality of Oslo's controversial way to protect the work of Gustav Vigeland

Judgment of the EFTA Court of 6 April 2017 in Case E-5/16
"Municipality of Oslo" E-5/16

1. The registration as a trade mark of a sign that consists of works for which the copyright protection period has expired is not in itself contrary to public policy or the accepted principles of morality within the meaning of art. 3(1)(f) of Directive 2008/95/EC.
2. Whether registration for signs that consist of works of art as a trade mark is refused based on accepted principles of morality within the meaning of art. 3(1)(f) of Directive 2008/95/EC depends, in particular, on the status or perception of the artwork in the relevant EEA State. The risk of the misappropriation or desecration of a work could be relevant in this assessment.
3. The registration of a sign can only be refused based on the public policy exception provided for in art. 3(1)(f) of Directive 2008/95/EC if the sign consists exclusively of a work pertaining to the public domain and registration of this sign would constitute a genuine, sufficiently serious threat to a fundamental interest of society.
4. Article 3(1)(e)(iii) of Directive 2008/95/EC can apply to two-dimensional representations of three-dimensional shapes, including sculptures.
5. Article 3(1)(c) of Directive 2008/95/EC must be interpreted as being applicable to two-dimensional and three-dimensional representations of the shape of a good.
6. Article 3(1)(b) of Directive 2008/95/EC must be interpreted as meaning that where a sign is descriptive within the meaning of art. 3(1)(c) that sign necessarily lacks distinctiveness under art. 3(1)(b). Should the referring body find that the sign at issue is not descriptive, it can assess its distinctiveness for the purposes of art. 3(1)(b) in relation to the goods and services covered by that mark and to the presumed expectations of an average consumer of the category of goods and services in question, who is reasonably well-informed, observant, and circumspect.

Ewelina Szatkowska

University of Gdańsk

ewelina.szatkowska@prawo.ug.edu.pl

ORCID: 0000-0001-6449-4204

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Commentary

The municipality of Oslo applied for trade mark protection for a number of the works of art by Gustav Vigeland, one of the most eminent of Norwegian sculptors. The judgment mentions six works by the artist, including *Sinnataggen* (The Angry Boy), *Monolitten* (The Monolith), and the statue *Egil Skallagrimsson*. The municipality obtained the copyright to these works from Vigeland before his death. With the copyright protection period about to expire and anxious not to lose control over the artist's work, the municipality applied to the Norwegian Intellectual Property Office (NIPO) to register the works as trade marks. NIPO refused to register most of them on the grounds of the lack of distinctiveness and their being determined by shape. The municipality of Oslo appealed to the NIPO Board of Appeal, which in turn addressed the EFTA Court¹ with six questions; the following three are the most relevant to this analysis: 1) Can the trade mark registration of works, for which the copyright protection period has expired, under certain circumstances, conflict with the prohibition in art. 3(1)(f) of the Trade Marks Directive on registering trade marks that are contrary to "public policy or (...) accepted principles of morality"? 2) If Question 1 is answered in the affirmative, will it have an impact on the assessment that the work is well-known and of great cultural value? 3) If Question 1 is answered in the affirmative, do factors or criteria other than those mentioned in Question 2 have a bearing on the assessment, and, if so, which ones?

The other questions concern registration obstacles that are determined by shape, signs that consist only of elements that can serve in trade to designate the characteristics of goods or services, and the descriptive nature of a sign and the relationship between a descriptive sign and the lack of any distinctive character (articles 3(1)(e) (iii), 3(1)(c), and 3(1)(b), respectively, of Directive 2008/95/EC). Because of the limited

¹ The CJEU could not judge this particular case, because Norway is not a Member State of the EU, but, it is a member of the European Free Trade Association (EFTA). The Member States of EFTA (Iceland, Liechtenstein, Norway, Switzerland) were obliged to implement Directive 2008/95/EC of 22 October 2008 for the purpose of the approximation of the laws of the Member States relating to trade marks. A relevant agreement between the EFTA Member States gave the EFTA Court jurisdiction over the case. Since the judgment concerns institutions that apply to all EU Member States, it is of vital, practical importance and could set standards of behavior in the registration of works from the public domain as trade marks; nonetheless, because of the gravity of the issues in question, the judgment of the CJEU is awaited impatiently.

length of this paper and the precedential effect of the judgment stating that conflict with public policy or accepted principles of morality could serve as a basis to refuse registering works from the public domain as trade marks, only the first three questions will be analyzed here. The judgment is based on the provisions of Directive 2008/95/EC, a text with European Economic Area (EEA) relevance. It should be noted that, although the above directive was fully replaced with Directive 2015/2436,² the judgment in question remains valid, since both directives set forth the same grounds for the refusal to register trade marks. In the part of the judgment discussed in this paper, the NIPO Board of Appeal intended to determine whether the registration as trade marks of works of which the copyright protection period has expired could conflict with public policy or accepted principles of morality, and if so, what criteria and circumstances could have an impact on negative decisions.

The Court stated that the protection of copyright and the protection of trade marks pursue different aims, apply under distinct legal conditions, and entail different legal consequences. Directive 2008/95/EC does not make any distinctions as to the legal nature of a sign of which a trade mark consists³. Thus, in principle, nothing prevents a sign from being protected under both trade mark and copyright law. Meanwhile, the expiry of the copyright protection period serves the principle of legal certainty by establishing a specific time framework, after which it is possible to legally profit from the creations of others. In this way, creative works previously protected by individual copyright enter the public domain.

The Court claimed that the basic function of a trade mark is to enable a consumer to distinguish goods supplied by one entrepreneur from goods supplied by another entrepreneur. Thus, the protection of trade marks ensures market transparency and assumes an essential role in a system of undistorted competition. In the case of trade marks, the period of protection is indefinite, since, even though it is granted for 10 years from application, compliance with certain formalities makes it possible to endlessly extend protection for subsequent 10-year periods, which, given the brand building process, is fully justified. Thus, given the potentially perpetual exclusivity granted to trade mark proprietors, there are certain conditions regarding absolute obstacles to registration or invalidation of trade marks. Concerning conflict with public policy or accepted principles of morality as the grounds to refuse registration as trade marks of works of art the copyright protection of which has expired, the Court quoted the opinion of Advocate General Ruiz-Járabo Colomer in the Shield Mark case. The opinion rightly observed that a trade mark based entirely on copyright protected work carries a certain risk of monopolization of the sign for a specific purpose, as it grants the mark's proprietor such exclusivity and permanence of exploitation that not even the author of the work or his estate enjoyed.

² Directive (EU) 2015/2436 of the European Parliament and Council of 16 December 2015 to approximate the laws of the Member States relating to trade marks, OJ L 336, 23.12.2015, p. 1.

³ The same in Directive 2015/2436.

As to the refusal to register trade marks on the grounds of a lack of distinctiveness and descriptiveness (art. 3(1)(b) and (c)), the Court rightly observed that they are not permanent. The Court stated that they are an initial obstacle that could be subsequently overcome through use. A sign can acquire secondary distinctiveness through appropriate targeted marketing campaigns and the creation of a strong link between a work and goods (services), then an averagely informed, reasonably aware, perceptive consumer would recognize the work not as an expression of the creativity of the author or as part of the public domain common to all mankind, but merely as an indication of commercial origin. Furthermore, considering the above circumstances, it should be noted that a trade mark can be refused registration with regard to one category of goods or services, while being granted registration for another category.⁴ Consequently, the refusal to register on the grounds of these circumstances does not guarantee that the work remains within the public domain.

Considering conflict with public policy or accepted principles of morality (art. 3(1)(f)), the Court observed that this provision covers two alternatives, each of which can serve as grounds for refusal. In some cases the two alternatives overlap. According to the Court, refusal based on grounds of conflict with public policy must be based on objective criteria whereas “accepted principles of morality” concern subjective values. Undoubtedly, the fact that a work used to be protected under copyright cannot in itself serve as grounds for refusal of registration. The Court noted that art. 3(1)(f) applies to marks that are considered offensive by consumers with average sensitivity and tolerance thresholds. Meanwhile, certain works of art enjoy a particular status as parts of a nation’s cultural heritage. Moreover, the registration of such trade marks can even be considered a misappropriation or a desecration, in particular if it is granted for goods (services) that contradict the values of the artist or the message communicated through their artwork. Therefore, the Court stated that the possibility cannot be ruled out that registration of such a trade mark could be perceived by the average consumer in the EEA State in question as offensive and therefore as contrary to the accepted principles of morality. However, such an assessment must be carried out on a case-by-case basis and it must take into account the status or perception of the artwork in the relevant State, considering the risk of misappropriation and desecration. Meanwhile, as regards contradiction with public policy, the principles and standards that are of fundamental concern to the state and the whole of society must be considered. These circumstances can only be relied on if there is a genuine and sufficiently serious threat to a fundamental interest of society. Meanwhile, it is necessary to grant the competent national authorities some discretion since standards and principles differ among countries.

To sum up, the Court concluded that: 1) the registration of works pertaining to the public domain as trade marks is not in itself contrary to public policy or accepted principles of morality; 2) whether registration for signs that consist of works of art as

⁴ Cf. Nice Classification (<https://euipo.europa.eu/ohimportal/pl/nice-classification>) (accessed: 31.12.2020).

trade marks is refused based on accepted principles of morality depends, in particular, on the status or perception of the artwork in the relevant EEA State, and the assessment can be influenced by the risk of misappropriation or desecration of a work of art; 3) the registration of signs can only be refused based on the public policy exception if the signs consist exclusively of works pertaining to the public domain and if the registration of these signs would constitute genuine, sufficiently serious threats to the fundamental interests of society.

As concerns this conclusion, it should be noted that, as the Court rightly observed, the refusal to register a trade mark on the grounds of a lack of distinctiveness or descriptiveness does not guarantee that a work will remain in the public domain. Both the EU and national legislations⁵ have the institution of secondary distinctiveness that enables the registration of marks that were not originally eligible for protection. Thus, if distinctiveness can be acquired by color *per se*,⁶ then, undoubtedly, through effective marketing, the work of time can also, over time, become associated with a specific product (service). Note should be taken of the risk associated with a growing number of trade mark applications concerning works of art that enable the unique visual identification of goods or services offered for sale. On the one hand, museums, or other entities that own works of art, try to register them as trade marks in order to protect them from being used in an unauthorized or improper manner or in a manner that does not harmonize with the person of the creator (or their creation).⁷ On the other hand, entrepreneurs use recognizable works of art as trade marks for *stricta* marketing purposes.⁸ The key question is the legal evaluation of such endeavors. Undoubtedly, intellectual property laws offer cumulative protection of intellectual creations, which is the case with works of art and trade marks. However, Martin Senftleben notes that Vigeland's case and the prejudicial questions that it triggered differed markedly from typical cases of copyright and trade mark rights cumulation.⁹ The practice of regis-

⁵ Cf. art. 130 of the Polish Industrial Property Law Act of 20 June 2000 (consolidated text: *Journal of Laws* 2021, item 324), art. 4(4) of Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trade marks and art. 7(3) of the Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark (OJ L 154, 16.06.2017, p. 1).

⁶ Cf., for example, a European Union trade mark consisting solely of the color black, registered to a Portuguese toilet paper manufacturing company (004899233), and Polish trade marks of the color purple registered to Play3GNS sp. z o.o. s.k. (R.310678), and the color orange registered to Orange Brand Services Ltd. (R.271601).

⁷ Cf. the following patent application numbers in the Patent Office of the Republic of Poland: Z.236052 (*Czwórka* [Team of Four] by Józef Chelmoński), Z.235061 (*Pochodnie Nerona* [Nero's Torch] by Henryk Siemiradzki), Z.236957 and Z.403998 (*Dama con l'ermellino* [Lady with an Ermine] by Leonardo da Vinci).

⁸ Cf. EU trade marks: 010625143 (*Het melkmeisje* [The Milkmaid] by Jan Vermeer registered for Nestle S.A) and 01136364 (*Meisje met de parel* [Girl with a Pearl Earring] by Jan Vermeer registered for Food Investments Group B.V.).

⁹ M. Senftleben, "Vigeland and the Status of Cultural Concerns in Trade Mark Law – The EFTA Court Develops More Effective Tools for the Preservation of the Public Domain," *IIC – International Review of Intellectual Property and Competition Law* 2017, vol. 48, issue 6, pp. 683–720.

tering as trade marks works of art the copyright of which has expired purportedly in order to protect them from unauthorized use as well as *stricte* marketing registrations intended to build positive associations raises serious concerns.

What is groundbreaking about the judgment in question is that it protects the public domain from being diminished by the registration of said trade marks by analyzing possible conflict with public policy or accepted principles of morality.¹⁰ It should be noted that the judgment concerned works of art that have only just entered or were about to enter the public domain. Nonetheless, it is of no relevance here whether we discuss works of art that have only just entered the public domain or belonged to the public domain before there were copyright regulations. Having determined that the registration of works pertaining to the public domain as trade marks is not in itself contrary to public policy or accepted principles of morality, the Court simultaneously admitted that this could possibly be an obstacle for registration in such cases, making a distinction between the contradiction with public policy as objective grounds for refusal because of a serious threat to the public interest, and, in contradiction with accepted principles of morality as subjective grounds, measured by the average sensitivity of consumers.¹¹ The clear distinction made by the Court between the two circumstances is seen as positive. A mark is contrary to public policy if it is in conflict with legal norms or principles that are fundamental and crucial for a society in a given territory to be able to function in a way that ensures its maintenance and development. Meanwhile, a trade mark is contrary to principles of morality if it is in conflict with the overall accepted and preserved principles of morality practiced in a given society, including customs that exist both in the public sphere and among members of a society that are considered to be positive and desirable.¹² Insofar as conflict with public policy has its origin in a mark itself and concerns its content, conflict with accepted principles of morality can involve not only the form of the mark but also the consequences it triggers in legal transactions in the broad meaning of the term, which includes the consequences of its exploitation.¹³ In this particular case, the consequences are reduced public domain and limited access to cultural heritage.

The Court's analysis does not state explicitly that the registration of works of art pertaining to the public domain by entities that possess them cannot be seen as the protection of cultural heritage. Insofar as the intention is right – to protect a work of art from private commercial exploitation – the means to that end are wrong as they

¹⁰ S. Stanisławska-Kloc, "Rejestrowanie utworów jako znaków towarowych" [in:] *100 lat ochrony własności przemysłowej w Polsce. Księga jubileuszowa Urzędu Patentowego Rzeczypospolitej Polskiej*, ed. A. Adamczak, Warszawa 2018.

¹¹ The Government of the United Kingdom claims to the contrary that this provision cannot be relied upon to prevent the registration of works pertaining to the public domain and adds that registration can be denied on the grounds of a lack of distinctiveness or bad faith if the registration is sought merely to obtain a monopoly.

¹² M. Trzebiatowski, "Znaki towarowe i prawa ochronne" [in:] *Prawo własności przemysłowej. Komentarz*, ed. J. Sieńczyło-Chłabczyk, Warszawa 2020, pp. 757–758.

¹³ *Ibidem*; cf. Judgment of the Polish Supreme Administrative Court of 13 September 2006, II GSK 113/06.

limit access to cultural heritage. The Court failed to analyse this issue even though the municipality of Oslo claimed it needed to control Vigeland's heritage because of its efforts to protect and promote his work.

It should be noted that the registration obstacle of contradiction with public policy or accepted principles of morality is founded on general clauses, which are imprecise and open-ended. They are supposed to enable case-based decision making. General clauses leave some room for discretion in decision making to enable the competent authority to make the best decision. The argument of contradiction with public policy or accepted principles of morality constitutes, the same as the argument of bad faith, *quasi* open grounds for the refusal to grant trade mark protection. This could be seen as an attempt to make limitations on exclusive rights more flexible.¹⁴ The final question is whether the argument is proper and acceptable in the international forum, or perhaps, considering attempts to register works of art pertaining to the public domain as trade marks, the catalog of registration obstacles should be revised and a new obstacle directly addressing this type of registration should be added.¹⁵ It is worth mentioning here the decision of the Patent Office of the Republic of Poland (UPRP) rejecting the application of the National Museum in Krakow to register Jan Matejko's painting *Bitwa pod Raclawicami* (Battle of Raclawice) as a trade mark.¹⁶ The decision was justified by the fact that the work constitutes national heritage and as such, it should not be used for commercial purposes; national heritage must not be appropriated by a single entity as this is against public interest and contrary to social standards.

In these kinds of cases, the argument of contradiction with public policy or accepted principles of morality can be based on evaluating the status of a work of art and its public reception. While this should not be problematic for famous works that are important for cultural heritage and are of historical, patriotic, or religious significance, there can be some doubt as to less popular or unknown works that are important, for example, for a local community. The question is then whether it is up to patent office experts to evaluate how famous a work is in a given country and to analyse the potential risk to the fundamental public interest of registering that work as a trade mark. The municipality of Oslo commented on this problem in its appeals. I believe that, insofar as the evaluation of works of major cultural significance and the refusal to register on the grounds of contradiction with public policy should not be particularly problematic, contradiction with the principles of morality and the sensitivity of an average person may be quite difficult to evaluate. The open question is then whether contradiction is supposed to concern only the content of a trade mark or also the consequences of

¹⁴ For example, Łukasz Żelechowski presented this opinion in a talk entitled "Conflict with Public Policy or Accepted Principles of Morality as an Obstacle to Trade Mark Registration" delivered at an academic meeting of the Department of Intellectual Property Rights, Faculty of Law and Administration, Jagiellonian University on 4 December 2020.

¹⁵ An example of contradictory decisions concerning the same form of a trade mark is the registration of Rembrandt's painting *De Nachtwacht* (The Night Watch), which was denied by the Benelux Organization for Intellectual Property but successfully completed before the EUIPO; cf. Filing number: 016613903.

¹⁶ Decision of the UPRP of 23 November 2005, case DT – 8/05.

its presence in legal trade. Thus, the judgment of the EFTA, although extremely valuable and precedential, triggers numerous questions and doubts, and the way we solve them will have serious practical consequences for both trade mark law and cultural heritage protection.

Conclusions

- 1) Contradiction with public policy or accepted principles of morality can constitute an effective registration obstacle for works in the public domain.
- 2) Contradiction with public policy as objective grounds for refusal due to a serious threat to the public interest should be distinguished from contradiction with the accepted principles of morality as subjective grounds measured by the average sensitivity of consumers, and it should be noted that the former basically relates to the content (form) of a trade mark, while the latter concerns not only the content (form) of the mark but also the consequences of its use in trade.
- 3) The registration of works of art pertaining to the public domain as trade marks by museums and other entities under the authority of which these works remain cannot be regarded as a form of cultural heritage protection and should be unacceptable.
- 4) The registration of works pertaining to the public domain diminishes the public domain and limits free access to art that is supposed to inspire future generations.

Literature

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Summary

Ewelina Szatkowska

Trade mark protection after the expiration of copyright:

The municipality of Oslo's controversial way to protect the work of Gustav Vigeland

This commentary analyzes the judgment of the European Free Trade Association (EFTA) Court of 6 April 2017 in Case E-5/16 concerning trade mark protection of works pertaining to the public domain. The judgment relates to the intention of the municipality of Oslo to register multiple works of art by Gustav Vigeland, one of the most eminent of Norwegian sculptors, as trade marks. The Court thoroughly analyzed the grounds for refusing the registration and focused on the contradiction with public policy or accepted principles of morality and the issue of cultural heritage.

Keywords: Copyright, principles of morality, public domain, public policy, trade mark

Streszczenie

Ewelina Szatkowska

Prawna ochrona znaku towarowego po wygaśnięciu autorskich praw majątkowych – kontrowersyjny sposób miasta Oslo na ochronę twórczości Gustawa Vigelanda

W głosie poddano analizie orzeczenie Trybunału Europejskiego Stowarzyszenia Wolnego Handlu z dnia 6 kwietnia 2017 r. w sprawie E-5/16 (EFTA Court), które dotyczy uzyskania prawnej ochrony znaków towarowych, obejmującej utwory znajdujące się w domenie publicznej. Głosowane rozstrzygnięcie odnosi się do zamiaru rejestracji przez miasto Oslo wielu dzieł Gustava Vigelanda, jednego z najsłynniejszych norweskich rzeźbiarzy, jako znaków towarowych. Trybunał dokonał bardzo szczegółowej analizy podstaw odmowy takiej rejestracji, biorąc pod uwagę przede wszystkim sprzeczność z porządkiem publicznym lub dobrymi obyczajami oraz kwestie związane z dziedzictwem kultury.

Słowa kluczowe: dobre obyczaje, domena publiczna, porządek publiczny, prawo autorskie, znak towarowy