Conflicts between trademark protection and freedom of expression

Questions

1) Analysis of current legislation and case law

1.1) a) What instrument of your law (eg. Constitution) guarantees the right to freedom of speech?

The right to freedom of expression is guaranteed in art. 5, para. 1, line 1, 1st alternative of the Basic Constitutional Law. Sec. 5, para. 1, sentence 1 of the Basic Constitutional Law states:

“Every person shall have the right freely to express and disseminate his opinions in speech, writing, and pictures and to inform himself without hindrance from generally accessible sources.”

According to the jurisprudence of the Federal Constitutional Court, freedom of expression is of particular significance as it is a “direct expression of the human personality in society” (BVerfGE 97, 398) and is also one of the “basic functional elements of a democratic body politic” (BVerfGE 69, 344).

b) What does the right to freedom of speech include? Is both artistic and commercial speech protected? If so, does commercial speech have a different degree of protection?

The protective scope of art. 5, para. 1, line 1 of the Basic Constitutional Law encompasses the expression and dissemination of any opinion in speech, writing and pictures. In this context, “opinion” is any subjective value judgement that is the product of rational thought, not merely the relation of facts. Opinions are “characterised by the subjective stance of the opinionator on the subject addressed and by any judgements thereby made concerning facts, ideas or persons.” (BVerfGE 93, 266, 289; BVerfGE 90, 241, 247). In order to effectively express an opinion, the use of memorable, pithy and precise statements is admissible (e.g. BVerfGE 24, 278, 286). Defamatory, pitiless or even abusive criticism, excessive polemics or ironic wording are also admissible (BGH NJW 1994, 124, 126). Even penal provisions, for example the defamatory offences under sec. 185 et seq. Criminal Code (StGB), do not exclude the protection of freedom of expression a priori, although the necessary balance of interests does usually lead to inadmissibility (e.g. BVerfG NJW 1993, 14, 62; BGH NJW 2000, 1036 – Verdachtsberichterstattung). The freedom of expression also protects statements made in business dealings, e.g. in advertising, at least where it assists in the forming of an opinion (BVerfG GRUR 2001, 170, 172 – Benetton Werbung I; BVerfG GRUR 2003, 455 – Tier- und Artenschutz).

Pursuant to art. 5, para. 2 of the Basic Constitutional Law, the expression of opinions, both commercial and otherwise, is subject to general legislation, general provisions on the protection of young persons and the law of personal honour. The general legislation
also includes the Trademarks Act. However, any constraint placed by an individual piece of legislation and its interpretation upon the freedom of expression must be measured by the courts against art. 5, para. 1 of the Basic Constitutional Law, thereby further limiting the effect of said constraint. This reciprocity causes constitutional legislation under art. 5, para. 1 of the Basic Constitutional Law to be considered against the interests protected under general legislation (established case law of Federal Constitutional Court since BVerfGE 7, 198, 208 – Lüth). Purely commercial interests usually weigh less heavily in this consideration than statements of opinion that serve the purpose of political decision-making (BVerfG NJW 1969, 1161 – Blinkfuer).

Artistic expression enjoys the protection of more specific provisions of art. 5, para. 3 of the Basic Constitutional Law. This covers creative compositions which directly express the artist's individual personality (BVerfG NJW 1985, 261, 262 – Anachronistischer Zug). If the artistic freedom is appropriate, a barrier to limitations may only be established once the fundamental rights of third parties have been considered; there is no restriction under general legislation (BGH GRUR 1995, 750, 751 – Feuer, Eis & Dynamit II).

c) Are also corporations or only individuals entitled to invoke freedom-of-speech arguments?

Pursuant to art. 19, para. 3 of the Basic Constitutional Law, legal persons or entities may also plead fundamental rights if the essence of these rights means that they can be applied to the legal persons and entities. The term “legal persons and entities” is to be given a broad interpretation and, in practice, comprises all private-sector undertakings but not public-sector undertakings. The freedom of expression per se can also be asserted by legal persons or entities as it is of significant importance to them also.

d) Is free speech only protected from unwarranted governmental interference, or is it also implicated when a private party calls upon a court to enforce rules of law whose effect would be to restrict or penalise expression?

Although fundamental rights are first and foremost rights which enable a citizen to defend himself against the state (art. 20, para. 3, art. 1, para. 3 of the Basic Constitutional Law) – which is why the fundamental rights have no direct effect against third parties (BVerfGE 7, 198, 204 – Lüth) – private-law standards, as an objective system of values, are also to be interpreted by the courts in the light of the Basic Constitutional Law (e.g. BVerfGE 18, 85, 92). The concretisation of non-specific legal concepts, in particular, becomes the weakest point of evaluations under the Basic Constitutional Law. These are to be found, for example, in sec. 23 of the Trademarks Act (MarkenG) (“where this use is necessary… provided such use is not contrary to the accepted principles of morality”).

1.2) a) How are free speech interests invoked in trademark litigation?

In the past, courts have regarded freedom of expression or artistic freedom differently in trademark infringement litigation. In many cases, there was no direct recourse to the Basic Constitutional Law, but the factual components of the legal infringement (sec. 14 MarkenG) were interpreted restrictively. Commercial dealings and use in a trademark context were both denied (BGH GRUR 1982, 319, 320 – Lusthansa; OLG Hamburg NJW–RR 1999, 1060, 1061 – Bild Dir keine Meinung.) Conversely, the use of a designation in a trademark context is not intended to be covered by the protective scope of article 5, para. 1 of the Basic Constitutional Law (BVerfG NJW 1994, 342 – Marskandom). Only relatively infrequently have the courts had direct recourse to the evaluations of art. 5 of the Basic Constitutional Law and denied illegality or the lack of authorisation (e.g. OLG Cologne NJW–WettbR 2000, 242 – Kampagne gegen die
Jagd). As a result of the fact that non-commercial activities are excluded from the scope of application of MarkenG, political or scientific statements, or activities by non-profit associations are not covered by MarkenG from the outset (e.g. KG MMR 2002, 686 – oil–of–elf).

b) Is there a provision in your trademark law which specifically concerns the admissibility of e.g.:
– criticism of another’s mark or derogatory reference to another’s mark;
– parody, satire or irony;
– artist’s use of another’s mark;
– using another’s mark as a badge of loyalty or allegiance;
– using another’s mark for the purposes of comparison, point of reference, description, identification, or to convey information about the characteristics of defendant’s own product

to the extent that such use may be considered as an exercise of the constitutional right of freedom of speech? (Please specify in case use is understood as involving a non–trademark use in which case the question of freedom of speech does not arise).

There is no specific trademark–law provision with regard to the first four questions. Sec. 23, nos. 2 and 3 MarkenG provides for use as a description of characteristics. The matter of which circumstances are covered by these provisions is disputed. Owing to the descriptive and referential character of the restriction of protective scope, the provision at least does not expressly govern the cases for discussion here on use in the context of an opinion. References to third–party signs with the aim of identifying the legal proprietor within the scope of criticism or artistic statements has yet to be discussed by established case law in the context of sec. 23 MarkenG.

Comparative advertising is regulated by sec. 6 of the Act against Unfair Competition (UWG). The provision corresponds to directive 97/55/EG. In accordance with the established case law of the European Court of Justice (ECJ), the use of comparative advertising under this directive takes precedence over trademark–law provisions (ECJ GRUR 2ßß2. 354. 355 – Toshiba/Katun).

An express provision governing trademark–related use is lacking in the German Trademarks Act (MarkenG). The limits, which also refer to use in a satirical or critical context, have been developed by established case law. In this context, previous jurisprudence denied the utilisation of a trademark even where it was evident to the viewer that the trademark was not being used by the proprietor itself but by a third party with satirical or critical intentions (BGH GRUR 1982, 319, 320 – Lusthansa). However, with regard to the very broad concept of utilisation in the more recent jurisprudence of the European Court of Justice (ECJ GRUR Int. 1999, 438 – BMW/Deenik), there is a great deal to support the idea that the use of trademarks for satirical and critical purposes must be seen as utilisation within the meaning of sec. 14 MarkenG. In order to remain consistent, a correction would then either have to be made via the unwritten constituent fact of illegality in sec. 14 MarkenG, taking into consideration the assessment of art. 5 of the Basic Constitutional Law, or sec. 23 no. 2 MarkenG would have to be interpreted in such a way that it also covers satirical and critical use.

The following are examples of incidences where trademark–related or, at least, designation–related use was acknowledged in the area described above:
The use of the slogan “MARS macht mobil bei Sex–Sport und Spiel” [a humorous adaptation of the German advertising slogan for the chocolate bar, Mars] used to sell a joke condom (BGH GRUR 1994, 808 – Markenverunglimpfung I); the use of the famous brand NIVEA in a jokily adapted form (e.g. “Es tut NIVEA als das erste Mal” ["It never
The use of "die Tagesschau" [the established name of the regular news bulletins on public German television] as the name of a newspaper column (OLG Hamburg GRUR–RR 2002, 389); the use of the brand "Milka" and the colour purple to sell an artistic postcard containing a poem (OLG Hamm AfP 2002, 442, according to which, in case of doubt, designatory use is assumed); the use of the printed slogan "adihash gives you speed" on a T-shirt (use of the brand, adidas, OLG Hamburg GRUR 1992, 58); the use of a trademark in a domain "scheiss–t–online.de" ["t–online.de" is the Deutsche Telekom’s internet service provider] (LG Düsseldorf, judgement of 30 January 2002 – 2a O 245/01); concerning a yellow [colour of the German post office, Deutsche Post] van belonging to a trade-fair construction company bearing the words "Deutsche Pest" [Pest = pest/plague] (LG Hamburg GRUR 2000, 514);

Trademark-related use was rejected in the following cases: for the sale of stickers bearing the words “Bumms mal Wieder” [= “Have it off more often”] designed to fit into the BMW logo (BGH GRUR 1986, 759 – without recourse to art. 5 Basic Constitutional Law); in the use of a satirically altered cigarette advertisement in a non-smokers’ calendar with the heading “Grosses Mordoro–Poker!” (BGH GRUR 1984, 684 – sec. 823 I BGB “Encroachment upon established and practised business operations” rejected on the grounds of art. 5 I Basic Constitutional Law); in the use of a domain "awd–aussteiger.de" as a forum for former employees of the financial service provider AWD (OLG Hamburg MMR 2004, 415 – without recourse to art. 5 Basic Constitutional Law); the use of a pro–hunting association’s emblem in order to highlight criticism of hunting practices – in the illustration, a stickman with his trousers down is urinating on the emblem (OLG Cologne NJW WettbR 2000, 242 – damnification of the trademark justified on the basis of art. 5 I Basic Constitutional Law); the use of a trademark–protected magazine title “fit for fun”, adapted to read “fick for fun” [“fuck for fun”] on a postcard (OLG Hamburg AIP 1999, 287 – [also] no unfair act because art. 5 I Basic Constitutional Law argued in favour of the defendant) or the use of postcard featuring the “Bild” [newspaper] trademark and an adapted form of Bild’s slogan "Bild Dir eine Meinung" ["Form an opinion"] changed to “Bild Dir keine Meinung” ["Form no opinion"] (OLG Hamburg NJW–RR 1999, 1060 – also: unfairness on the basis of art. 5 I Basic Constitutional Law rejected); the sale of a postcard bearing the words “Toll! Alles wird teurer” [Great! Everything’s getting more expensive”] formatted in a way that is reminiscent of various registered trademarks of Deutsche Telekom AG (KG GRUR 1997, 295 – also not unfair under Art. 5 I Basic Constitutional Law); the sale of joke items including stickers printed with the word “Lufthansa” instead of “Lufthansa” (OLG Frankfurt am Main, NJW” 1982, 648 – without recourse to Art. 5 I Basic Constitutional Law); the use of an internet domain “stoppesso.de” (LG Hamburg MMR 2003, 53 – also no trademark infringement on the basis of Art. 5 I Basic Constitutional Law).

c) If no such provisions exist, how are free speech interests invoked in trademark litigation? Is there an “open end clause” or “fair use clause” in your trademark law which permits taking into account freedom–of–speech–arguments? If not, are there any other gateways in your trademark law to permeate free speech concerns? Or do courts apply freedom–of–speech arguments directly with reference to the constitution?

As stated above, under German legislation a correction has hitherto been made, particularly where trademark–related use is concerned. Only in exceptional cases has there been recourse to the constitutionally guaranteed freedom of expression.

German law has no general exception for “fair use”. Only sec. 23 MarkenG goes some way towards this, but its wording is restricted to certain specific cases of application.
d) How much discretion do the courts have in applying free speech concerns?

The effect of the right of freedom of expression is a legal question. Under the constitution, the courts must consider the effect of the constitutional civil rights on third parties and interpret basic law in the light of the Basic Constitutional Law (BVerfGE 7, 198, 208 – Lüdt). There is no discretionary scope insofar as there can theoretically only be one right decision. However, within the interpretation of particular legal concepts, the court does of course have scope for interpretation in which, from a constitutional perspective, it is only possible to verify errors of interpretation that ignore the significance of the Basic Constitutional Law and infringements of the prohibition of arbitrary decision-making (BVerfGE 85, 248, 257 – Ärztliches Werbeverbot). The question of the assessment of basic statutory law is not the subject of verification under constitutional law (BVerfGE 18, 85, 92 – Künstliche Bräunung). Ultimately, therefore, it is only possible to effect limited verification of the constituent facts of sec. 14 and sec. 23 MarkenG in the light of constitutional law is possible.

1.3) If there are trademark infringement cases in your country where defendant primarily sought to attack a company’s ecological or employment policy, commercial practices and the like, do these cases also address the application of rules prohibiting defamation such as libel and slander or do they focus on the tarnishment of plaintiff’s trademarks only? (The National Groups are not expected to elaborate on their country’s laws prohibiting defamation.)

In Germany in recent years, there has been a series of trademark infringement proceedings in which the defendant primarily attacked the relevant undertaking’s environmental policy or its business practices, but seemingly not its employment policy.

Mordoro, BGH GRUR 1994, 684
Oil–of-Elf, KG MMR 2002, 686
Shell–Muschel, LG Hamburg NJW–RR 1998, 1121
Alles wird teuer, KG GRUR 1997, 295
stop–esso.de, LG Hamburg MMR 2003, 53
Castor.de, LG Essen GRUR 2002, 920
scheiss–t–online.de, LG Düsseldorf judgement of 30 January 2002 – 2a O 245/01
Deutsche Pest, LG Hamburg GRUR 2000, 514
AWD–Aussteiger, LG Hamburg MMR 2004, 415

In these cases, general tort law provisions, particularly legal protection against defamation – which companies are also able to plead – was relevant.

1.4) a) If you consider the trademark infringement cases in your country in which freedom of speech–arguments were invoked what are the criteria applied by courts for determining whether a freedom–of–speech argument is justified? How important is the reputation of the trademark in question? Does it matter whether the use of the trademark in question is non–commercial or may free speech–arguments also be invoked if the trademark use is mainly commercial in nature? Does it matter whether the use of the trademark involves an expression or social discourse of objective/considerable value or a contribution to the public debate? Is the defendant allowed to express his views in a trenchant way? Or is the defendant required to report in a balanced way or even sparingly?

If necessary, please differentiate between:
– criticism of another’s mark or derogatory reference to another’s mark;
– parody, satire or irony;
– artist’s use of another’s mark;
– using another’s mark as a badge of loyalty or allegiance;
– using another’s mark for the purposes of comparison, point of reference, description, identification, or to convey information about the characteristics of defendant’s own product

to the extent that such use may be considered as an exercise of the constitutional right of freedom of speech (please specify in case use is understood as involving a non–trademark use in which case the question of freedom of speech does not arise).

It should first be ascertained whether the trademark is used in business dealings. If this is not the case, trademark claims can be discounted from the outset. The balance of interests is then solely carried out in line with the provisions of the general law of torts. Thus, the purely political, scientific or artistic use of a mark does not normally fall within the scope of application of MarkenG. Conversely, all cases in which the trademark user itself is involved in active business dealings, e.g. the distribution of critical stickers, T–shirts, printed items, remain within the scope of application of MarkenG.

The next step is to ascertain whether a trademark–related use exists. Here, the criteria are less clear-cut, especially since less recent German jurisprudence evidently had not incorporated the wide concept of use as defined by the European Court of Justice (ECJ GRUR Int. 1999, 438 – BMW/Deenik). In the traditional view, there is no trademark–related use if it is clear to the unprejudiced observer that there is no intention to advertise or to use the trademark of the criticised undertaking itself. This would mean that particularly vitriolic or offensive modes of use were no longer covered by the scope of application of MarkenG, but were subject to general examination under the law of torts.

Where a trademark has been used both in business dealings and in a trademark–related capacity, trademark infringement has usually been upheld. The balance of interests has then rarely been taken further.

A balance of interests resulted primarily where the claim was not based on MarkenG but on the general provisions of tort law. Here, the public interest in criticism can carry weight in favour of the criticising party, especially where the expression of an opinion serves to conduct an intellectual conflict of interests. If the pursuit of private or competitive interests is the primary aim, however, the balance of interests will tend to benefit the criticised party.

b) Specifically, please describe how joke articles are assessed.

If joke articles are sold, business dealings are deemed to exist. Under established case law hitherto, the question of whether trademark use represents a legal violation depends on whether the public assumes the trademark to originate from the trademark proprietor itself (e.g. BGH GRUR 1994, 808, 810 – Markenverunglimpfung I). Accordingly, particularly offensive joke items have not usually been evaluated as a trademark violation but merely in accordance with the general provisions of the law of torts. However, it appears doubtful whether the Federal Supreme Court will continue to uphold this distinction in the future as it is difficult to reconcile with the European Court of Justice’s expanded concept of utilisation. German law does not contain specific provisions for joke articles. Where trademarks have been distorted without any intended criticism and without any notable opinionated content, the Federal Constitutional Court has dismissed the basic constitutional protection of art. 5, para. 1 Basic Constitutional Law (BVerfG NJW 1994, 3342).
c) May using another’s mark as a badge of loyalty or allegiance be considered as an exercise of the constitutional right of freedom of speech? Does it matter whether the scarves and other goods are sold to consumers? Does it matter whether the manufacturer indicates that the goods are not original?

There is nothing under German law that corresponds to the case scenario of the Arsenal judgement. Such cases are still subject to general provisions. Accordingly, where club insignias, for instance, are used by fans themselves, no business dealings would exist and thus no trademark infringement. Where fan merchandise is sold, business dealings exist and thus so does trademark-related use. The current German view is that sec. 23 MarkenG is not applicable to this situation either, and the sale of such items without the approval of the trademark proprietor would therefore infringe trademark law. The plea of freedom of expression can likely be ruled out here since adoption of an unaltered trademark would not comprise any opinion-related components. In the German view, the reference to the fact that the goods are not originals has no significance for the adoption of trademarks (BGH – GRUR 2004, 860, 863 – Internet–Versteigerung).

d) To the extent that such use may be considered as an exercise of the constitutional right of freedom of speech please specify the cases in which the defendant is entitled to use another’s mark for the purposes of comparison, point of reference, description, identification or to convey information about the characteristics of defendant’s own product.

References which cannot directly contribute to the formation of an opinion are not covered by the protective scope of freedom of expression. In other respects, comparisons in advertising are admissible pursuant to sec. 6 Act on Unfair Competition (UWG) (see 1.2 above). Other admissible references represent descriptive use pursuant to sec. 23 no. 2 and sec. 3 MarkenG.

2) Proposals for adoption of uniform rules

2.1) a) Should free speech interests be invoked in trademark litigation?

Yes. Trademarks are essential means of identification for companies, products and services. They must thus also be usable in a critical, satirical or artistic context. Under German law, this question cannot be negated for the simple reason that trademark law also has to consider basic statutory rights as an objective system of values.

b) If so, should there be provisions in trademark law which specifically concern the admissibility of e.g.:

- criticism of another’s mark or derogatory reference to another’s mark;
- parody, satire or irony;
- artist’s use of another’s mark;
- using another’s mark as a badge of loyalty or allegiance;
- using another’s mark for the purposes of comparison, point of reference, description, identification, or to convey information about the characteristics of defendant’s own product

... to the extent that such use should be considered as an exercise of the constitutional right of freedom of speech? (Please specify in case use should be understood as involving a non–trademark use in which case the question of freedom of speech does not arise).

Ultimately, an express provision for these forms of utilisation appears to make sense above all where – as prescribed by the ECJ for the area of harmonised European trademark law – a concept of further utilisation applies. In the area of German law, this would mean that the law would have to expressly provide for the first three case groups
as these have not been specified by sec. 23 MarkenG before. In the area of German law, the final case group would not require an express provision since this is already covered by sec. 23 MarkenG.

Where national trademark jurisdictions fail to contain provisions which – as under German law – permit the cases of the last group (utilisation for the purpose of comparison, referral, etc.), a provision should be introduced under the proviso of the necessity of public morality.

With regard to the use of a trademark as a sign of loyalty or affiliation, a provision governing private areas is required as use of this type is not found in business dealings.

Where the sale of fan merchandise and similar items is affected, it should not be accorded privileges but be subject to the general regulations.

c) Or should there be an “open end clause” or “fair use clause” or any other gateway in trademark law which permits taking into account freedom–of–speech–arguments? Or should the courts apply freedom–of–speech arguments directly with reference to the Constitution? How much discretion should the courts have in applying free speech concerns?

A general “open–end” or “fair–use” clause, on the other hand, does not appear suitable as it contains too few criteria for the admissibility of use. In all probability, such an open clause would not serve the purpose of legal harmonisation as different national jurisdictions would be likely to develop their own catalogues of criteria.

Direct recourse to the constitution is subject to the same misgivings. Again, what primarily applies here is that each national jurisdiction formulates its basic statutory right to freedom of expression differently and this would represent an obstacle to harmonisation.

In the German view, immediate recourse elicits the misgiving that basic statutory rights would have no direct third–party effect between private–law subjects.

Discretion in the narrow sense, i.e. the power to pass different decisions with the same factual circumstances, should not be granted to the court as this would compromise legal security. However, the court should be in a position to take into account all the factual circumstances of the individual case and to undertake a balance of interests on this basis.

2.2) In cases where defendant primarily seeks to attack a company’s ecological or employment policy, commercial practices and the like, should these cases be addressed in the context of a potential tarnishment of the plaintiff’s trademarks or should rules prohibiting defamation such as libel and slander be applied?

The objectives of trademark law and libel law only partly correspond. In the case of libel law, the focus is on protection against the assertion of falsehoods and against abusive or offensive statements. Conversely, trademark law protects assets from impairment. Such impairment is also conceivable without libel. Both bodies of provisions should thus be applicable in parallel.

2.3) a) Should there be limits to free speech in a trademark infringement context?

Yes. In their capacity as valuable assets, trademarks require protection under the Basic Law. In addition, they also permit the practice of a profession and the observance of corporate freedom. For this reason alone, it is necessary to consider the opposing interests of the trademark proprietor on the one hand and of the criticising part of the other. Above and beyond this, freedom of expression is also subject to limits in other contexts. There would be no justification for according privileges to criticism that refers to trademarks.
b) If so, what should be the criteria be for determining whether a freedom–of–speech argument is justified? How important should the reputation of the trademark in question be? Should it matter whether the use of the trademark in question is non–commercial or should defendant also be entitled to invoke free speech–arguments if the trademark use is mainly commercial in nature? Should it matter whether the use of the trademark involves an expression or social discourse of objective/considerable value or a contribution to the public debate? Should the defendant be allowed to express his views in a trenchant way? Or should the defendant be required to report in a balanced way or even sparingly?

If necessary, please differentiate between:

– criticism of another’s mark or derogatory reference to another’s mark;
– parody, satire or irony;
– artist’s use of another’s mark;
– using another’s mark as a badge of loyalty or allegiance;
– using another’s mark for the purposes of comparison, point of reference, description, identification, or to convey information about the characteristics of defendant’s own product

To the extent that such use should be considered as an exercise of the constitutional right of freedom of speech? (Please specify in case use should be understood as involving a non–trademark use in which case the question of freedom of speech does not arise).

Ultimately, all circumstances can be considered in an individual case. Particular consideration should be given to the following:

– the cause for criticism and the public interest in an intellectual or political debate of the relevant issue;
– the proximity of the criticised company or product to the issue at the centre of the political debate, i.e. the degree of responsibility of the company concerned;
– the degree of truth in the criticising statement;
– the form of criticising statement;
– the duration and intensity of criticism, e.g. number of flyers circulated, etc.
– location, time, forum and target group of criticism.

The reputation of the trademark is a less significant aspect, since less–known trademarks must also be protected from disparaging criticism. What can be significant, however, is when the satirical or critical statement is capable of undermining a particularly positive reputation, for example if a food trademark is depicted in a disgusting manner.

Commercial criticism, and particularly the criticising party’s own economic interests, tend to be more suited to the establishment of tougher standards. Non–commercial criticism thus enjoys greater freedom.

The poignancy of the attack is only one of several factors that must be considered when evaluating admissibility. Verbal insults will usually be inadmissible. On the other hand, an obligation to a particularly neutral or even wordless reference is also justified.

c) How should joke articles be assessed?

There should be no specific provisions relating to joke items. As what is normally involved here is commercial communication and since the relevant criticism is likely to have less intellectual content, joke items will frequently be evaluated as trademark infringements.
d) Should using another's mark as a badge of loyalty or allegiance be considered as an exercise of the constitutional right of freedom of speech? Should it matter whether the scarves and other goods are sold to consumers? Should it matter whether the manufacturer indicates that the goods are not original?

The sale of fan merchandise does not require any special privilege. Again, the focus is on the commercial interest of the supplier, and the opinion-related component is again relatively small. However, the fans use the items outside of commercial dealings and this does not infringe trademark law. The same can apply when clubs or interest groups distribute items of this type to their members free of charge. Here too, business dealings may be absent.

e) To the extent that such use should be considered as an exercise of the constitutional right of freedom of speech please specify the cases in which the defendant should be entitled to use another's mark for the purposes of comparison, point of reference, description, identification or to convey information about the characteristics of defendant's own product.

These situations have less to do with cases of free speech since they are primarily concerned with factual statements. Where opinions are expressed – for example, in the case of comparisons – the general standards apply: in particular, the comparison must not be impertinent, cause damage to reputations etc. Since these cases are mostly concerned with commercial communication, the standards tend to be stricter than with critical or satirical references.

Summary

The right to free expression of opinion is guaranteed in § 5 para. 1, line 1 of the Basic Constitutional Law [Grundgesetz]. The fundamental rights provide protection for citizens against unwarranted governmental interference. They do not apply directly in conflicts between citizens, but courts must interpret all statutory law in the light of the constitutional system of fundamental rights (so called indirect effect of fundamental rights – mittelbare Drittwirkung der Grundrechte). The right to freedom of expression can be invoked by private persons as well as legal entities; commercial speech comes under its scope of protection as well.

According to § 5 para 2 of the Basic Law, the freedom of expression is limited by general legislation, including the Trademarks Act [MarkenG]. Trademarks are not only protected under the MarkenG, but also constitute immaterial property and are protected under Art. 14 para. 1 of the Basic Law as such.

The MarkenG does not include any express provision on the interrelationship between trademarks and the freedom of expression, neither does German law provide for a general "fair use"-exception. The freedom of expression is taken into account by the MarkenG through its definition of possibly infringing use: Certain forms of use, i.e. use of the mark not in the course of trade (e.g. in a public discussion), or for other purposes than to distinguish goods or services (e.g. solely as an indication of certain characteristics or features of the goods as in § 23 para. 2 MarkenG). Theoretically, there is no room for discretion of the courts, as the question of legal sanctions for trademark infringement is a legal one. Practically, there are certain undetermined legal terms – such as the concept of "use as a mark"– which are open to interpretation. Cases that come under the MarkenG have to be judged by its regulations exclusively, e.g. cases of critical reference to a trademark, parodies etc. WhereTrademark Law does not apply, e.g. in cases of expressions made not in the course of trade, the Law against Unfair Competition (UWG), as well as general tort law, namely the provisions against defamation, libel and slander, do apply without limitations.
The MarkenG does not define which forms of use of a mark constitute "trademark use". If the definition of trademark use is interpreted in a broad sense following the case-law of the ECJ (see in particular BMW v. Deenik, GRUR Int. 1999, 438), there might be a growing need to protect the freedom of expression even in cases where marks are used in a trademark sense. In this context and because the wording of § 23 of the MarkenG does not cover all forms of use relevant to the freedom of expression, it seems to be advisable to expressly include certain forms of trademark use that are protected by the freedom of expression in the wording of the law.

As far as the mutual interests in the private right to a trademark and the fundamental right to freedom of expression have to be assessed directly against one another, the following circumstances are taken into account: The intention of the person using the mark, the importance of the topic expressed for forming a public opinion, as well as the form of the expression. Use of another persons mark for economic reasons will rarely be justified by the fundamental right in this appreciation of interests. German courts regularly assessed the commercial sale of joke articles as infringing, where trademarks where referred to in a reviling manner. So far, the German courts did not decide on the use of trademarks as tokens of loyalty or affiliation (as in ECJ, GRUR Int. 2003, 229 – Arsenal Football Club), but it seems that no special rules should apply.

Résumé

La liberté d'expression est un droit protégé par l'article 5 I, page 1 de la Loi fondamentale [allemande]. Son action n'est pas limitée à la défense des interventions de l'Etat. Les juridictions de l'ordre judiciaire doivent également considérer l'effet dit des libertés publiques non seulement envers l'Etat, mais aussi envers les particuliers, dans le cadre de l'application de la Loi fondamentale [allemande]. Les expressions d'un avis ou d'une conviction dans les rapports commerciaux sont également soumises à l'étendue de la protection de la liberté d'opinion, de laquelle les entreprises peuvent en principe aussi se prévaloir. La liberté d'opinion est consentie dans les limites des lois générales, article 5 II de la Loi fondamentale [allemande]. Le droit applicable aux marques est également régi par ces dispositions. La marque, pour sa part, est non seulement protégée par les dispositions du droit applicable aux marques, mais tient également lieu de propriété incorporelle constitutionnelle dans l'esprit de l'article 14 I de la Loi fondamentale [allemande].

Toujours est-il que le droit ne connaît pas de dispositions légales particulières applicables au rapport entre la liberté d'opinion et le droit applicable aux marques. Le droit allemand ne connaît pas d'exception générale dite d'usage impartial. Le droit applicable aux marques respecte la liberté d'opinion, dans la mesure où certaines formes d'utilisation de la marque ne sont pas considérées comme violation de la marque à priori, notamment l'emploi de la marque en dehors des relations commerciales (p. ex. lors d'une discussion publique) et l'utilisation de la marque à d'autres fins qu'un marquage au sens propre du mot (p. ex. exclusivement comme information sur les critères ou caractéristiques d'une marchandise ou d'une prestation de service, § 23 n° 2 du droit applicable aux marques ). Le droit applicable aux marques ne concède nulle liberté d'appréciation au juge en matière d'ordonnance des sanctions légalement prévues en cas de violation. Toujours est-il que certaines notions de droit laissent beaucoup d'espace libre aux appréciations – citons la notion de l'emploi propre à la marque à titre d'exemple. Le domaine d'application des prescriptions du droit applicable aux marques est exclusivement applicable aux faits matériels de la référence critique, de la parodie etc. En dehors de ce domaine, p. ex. lors d'expressions dans des rapports non commerciaux, les dispositions délictuelles et celles de la Loi [allemande] contre la concurrence déloyale sont applicables sans restriction, notamment s'il s'agit de la protection de l'honorabilité personnelle de quelqu'un.

Le droit applicable aux marques n'énonce pas ce qui est effectivement un emploi propre à la marque. Plus l'extension de la notion d'un emploi propre à la marque – en donnant suite à la jurisprudence de la Cour Supérieure de Justice [européenne] [notamment le jugement international
rendu par la Cour Supérieure de Justice en 1999, 438 – BMW/Deenik) – s’accroît, plus le besoin augmente de faire place à la liberté d’expression en dépit d’un emploi propre à la marque. Il se pourrait qu’il soit judicieux, face à cette circonstance, de régler certains états de fait relatifs à l’emploi d’une marque entrant dans le domaine de la liberté d’opinion expressément et légalement, pour la simple raison que le libellé des domaines d’application du § 23 du droit applicable aux marques omet de prendre toute une série d’utilisations importantes aux termes du droit fondamental en considération.