

Resolution



Question Q188

Conflicts between trademark protection and freedom of expression

Yearbook 2005/II, page 357 – 358
Executive Committee of Berlin, September 24 – 29, 2005

Q188

AIPPI

Considering:

- a) that trademarks are occasionally used in the context of critical speech, satire, political discussion, artistic expression and in other contexts that are not primarily of a competitive nature;
- b) that such forms of trademark use may raise issues of freedom of expression that are not usually present in other contexts;
- c) that trademark protection may conflict with the freedom of expression under certain circumstances;
- d) that in some jurisdictions these issues are expressly or implicitly addressed e.g. in the context of the requirement of trademark use, use in commerce, fair or descriptive use or as a general exception from trademark laws;
- e) that trademark protection and freedom of expression interests need to be balanced;
- f) that comparative advertising is addressed in Resolution Q140 “Unfair competition – comparative advertising” (Yearbook 1998/VIII, pages 399 – 402).

Resolves:

- 1) It should be possible in principle to invoke freedom of expression as defence in trademark cases in exceptional circumstances, for example in the context of critical speech, satire, political discussion and artistic expression.
- 2) A balancing of interests between trademark rights on the one hand and the right to freedom of expression on the other hand requires that neither right should prevail in every situation but that an analysis of all relevant factors must in each instance be undertaken by the court and the competent authority as the case may be.
- 3) Among the factors that should be considered are the commercial or non-commercial nature of the defendant’s use, whether the parties are in competition, the motive, form and context of the use, including whether it is justified in the public interest, whether an opinion is fairly expressed, whether factual allegations are true and not misleading, whether the trademark is unfairly used, exploited or denigrated, and the reputation of the trademark.

- 4) As a general rule, freedom of expression should not be a defence where the trademark use would result in a commercial benefit and the parties are competitors.
- 5) This Resolution does not consider comparative advertising, and is without prejudice to libel law in either criminal or civil actions in any given jurisdiction.