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HUMOUR AND INTELLECTUAL PROPERTY LAW: TRADEMARK PARODY PERSPECTIVE IN THE CZECH REPUBLIC

by

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This article discusses the issue of humour in the context of intellectual property law, with a focus on parody in trademark law. Parody is a form of humorous expression that is generally protected by freedom of expression. Although copyright law has a statutory exception for caricature, parody, and pastiche, no such exception exists in trademark law. Therefore, parody must be treated differently in this area of law. The article first introduces the legal position of parody and discusses the assessment of parody in both copyright and trademark law in the EU and Czech law. Then it examines the peculiarities of the trademark law approach and with the help of German landmark cases, highlights the possibilities for the treatment of trademark parody in the Czech Republic. The outcomes may apply to closely related laws throughout the EU territory.

KEY WORDS

Humour, Parody, Copyright, Trademark, Freedom of Expression

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1. INTRODUCTION

Generally (and historically¹), parody is a form of artistic expression that is usually associated with the imitation of a particular work, person or style.² For a parody to be successful (i.e. to amuse the recipient), there must be a connection between the parodic creation and the original work.³ The legal definition of parody was introduced by the Court of Justice of the EU (“CJEU”) in the landmark copyright parody case *Deckmyn*⁴ (see Chapter 3 below for details of the case).

Concerning both Czech and EU law, the issue of parody was introduced by the Directive 2001/29/EC of the European Parliament and of the Council of 22 May 2001 on the harmonisation of certain aspects of copyright and related rights in the information society⁵ („InfoSoc Directive”) which introduced an optional statutory exception to copyright for caricature, parody and pastiche in its Art. 5(3)(k). The Czech Republic adopted this provision in 2017.^{6,7} This statutory exception means that the copyrighted work may be used for caricature, parody or pastiche without the author’s consent. However, other elements must be fulfilled when applying this exception and using another person’s work.⁸

¹ Cf. Dentith, S. (2000) *Parody*. London: Routledge, p. 45-46.

² Cf. OED (2023) *Oxford English Dictionary*, s.v. “parody (n.2), sense 1.a.” [online] Available from: <https://doi.org/10.1093/OED/4390633272> [Accessed 14 December 2023].

³ Cf. e.g. *Cliffs Notes, Inc. v. Bantam Doubleday Dell Publishing Group, Inc.* (1989) United States Court of Appeals, Second Circuit, 886 F.2d 490, paragraph 494; or Fletcher, A. L. (2010). The Product with the Parody Trademark: What’s Wrong with Chewy Vuiton. *The Trademark Reporter*, 100 (5), p. 1094, citing *Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC*, United States Court of Appeals, Fourth Circuit, 507 F.3d 252.

⁴ Judgement of 3 September 2014, *Johan Deckmyn, Vrijheidsfonds VZW v. Helena Vandersteen*, C-201/13, EU:C:2014:2132.

⁵ Directive 2001/29/EC of the European Parliament and of the Council of 22 May 2001 on the harmonisation of certain aspects of copyright and related rights in the information society. *Official Journal of the European Union* (L 167) 22 June 2001. Available from: <https://eur-lex.europa.eu/legal-content/EN/TXT/?uri=celex%3A32001L0029> [Accessed 3 October 2022].

⁶ Sec. 38g of *Act on Copyright and Rights Related to Copyright 2000*, No. 121/2000 Coll. The Czech Republic. Prague: Collection of Laws. In Czech (“Czech Copyright Act”). In 2017, this provision dealt only with the exception for caricature and parody. The exception for pastiche was added in the latest amendment to the Czech Copyright Act, Act No. 429/2022 Coll., which entered into force on 5 January 2023.

⁷ As Telec and Tůma pointed out, before the introduction of the exception into the Czech Copyright Act, it was possible for the courts to cover the issues of caricature or parody by a simple balancing test of the conflicting fundamental rights. This means that caricature and parody were already an inherent limitation of copyright by that time. See Telec, I. and Tůma, P. (2019) Komentář k § 38g. In: Ivo Telec, Pavel Tůma (eds.). *Autorský zákon: Komentář*. Praha: C. H. Beck, p. 470.

⁸ According to Sec. 29 Czech Copyright Act, the use should not be contrary to the normal exploitation of the work, and it should not unreasonably prejudice the legitimate interests of the author. This provision represents the Czech version of the three-step test.

Although parody is typical for artistic works, it can also be created in the context of trademarks or designs⁹. In the case of trademark parody, there is a risk of trademark infringement.¹⁰ If the parody is successful, there should be no likelihood of confusion. This is because the parody creates an association with the famous mark while at the same time satirizing it (because of its imitation feature).¹¹ There is no point in creating a parody if no one gets the joke. Therefore, a trademark parody would always target well-known trademarks¹² or trademarks with reputation¹³. “Enjoy Cocaine” instead of “Enjoy Coke”¹⁴ or “Chewy Vuitton” instead of “Louis Vuitton”¹⁵ are just a few examples of trademark parodies.

Trademark parody can take two forms. First, when a parodic sign is applied for registration as a trademark (the issue of parody is therefore addressed during the registration process). Second, the parodic sign is simply used without registration, either for commercial purposes (such as creating parodic merchandise¹⁶) or non-commercial purposes (e.g. by opening

⁹ Although parody in design law is not the primary focus of this article, it is important to note that the current initiative for EU design law reform is trying to introduce the “critique and parody” exception, see Commission Proposal for a Regulation of the European Parliament and of the Council amending Council Regulation (EC) No 6/2002 on Community designs and repealing Commission Regulation (EC) No 2246/2002. 28 November 2022. Available from <https://eur-lex.europa.eu/legal-content/EN/TXT/?uri=COM:2022:666:FIN> [Accessed 11 May 2024]. For further discussion on this issue see also Jacques, S. and Derclay, E. (2024). The Parody Exception in EU Design Law: A Catalyst for Creative Evolution, Innovation and Cultural Discourse. *European Intellectual Property Review*, 46 (5), p. 285-298.

¹⁰ Myers, G. (1996) Trademark Parody: Lessons from the Copyright Decision in *Campbell v. Acuff-Rose*. *Law and Contemporary Problems*, 59 (2), p. 181-182.

¹¹ Cf. Machnicka, A. A. (2016) Louis Vuitton does not laugh at its bags’ parody. *Journal of Intellectual Property Law & Practice*, 11 (5), p. 325.

¹² Art. 6bis of the *Paris Convention for the Protection of Industrial Property*, 20 March 1883, as amended on 28 September 1979. Available from: <https://www.wipo.int/wipolex/en/text/287556> [Accessed 7 December 2023], and Sec. 2(d) of the *Act on Trademarks and the Amendments to Act No. 6/2002 Coll. on Courts, Judges, Lay Judges and State Court Administration and on the Amendments to Certain Other Acts (Act on Courts and Judges) 2003*, No. 441/2003 Coll. The Czech Republic. Prague: Collection of Laws. In Czech (“Czech Trademark Act”).

¹³ Art. 5(3) 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. *Official Journal of the European Union* (L 336/1) 23 December 2015. Available from <https://eur-lex.europa.eu/legal-content/EN/TXT/HTML/?uri=CELEX:32015L2436> („Trademark Directive“) [Accessed 7 December 2023] and Sec. 7(1)(c) of the Czech Trademark Act.

¹⁴ *Coca-Cola Company v. Gemini Rising* (1972) District Court for the Eastern District of New York, 346 F. Supp. 1183.

¹⁵ *Louis Vuitton Malletier v. Haute Diggity Dog* (2007) Court of Appeals for the Fourth Circuit, 507 F.3d 252.

¹⁶ Cf., e.g. T-Shirts with “PrayStation” sign and depiction of original “PlayStation” trademark, cf. Knedlo Zelo Wear (2024) *Main Page* [online]. Available from <https://www.knedlozelowear.cz/> [Accessed 14 April 2024].

the public discussion over topics of societal interest¹⁷). Both situations can be decided under trademark law; however, the freedom of expression should be part of the appreciation in each of the mentioned examples.

There are only a few cases concerning humour in Czech case law, and (almost) none of them deals with trademark parodies. However, there are examples of parodies (products and signs that meet the basic elements of parody) on the Czech market that can be mentioned in this regard. One of them is the *IbalGIN* case. The “IbalGIN” pink gin, until recently produced by the Fruko-Schulz company, was being sold in bottles with signs similar to the “Ibalgin” trademark¹⁸. The original “Ibalgin” trademark is known for the famous Czech pain reliever produced by the SANOFI company (formerly Zentiva). Although the *IbalGIN* case is discussed in this paper as an illustrative case, it was brought to the court and recently settled (see Chapter 6 below for more details).¹⁹

Concerning the structure of this article, first, the issue of parody in the context of freedom of expression is explained, including landmark cases of the European Court of Human Rights (“ECHR”). Secondly, it discusses the scope of the legal approach to parody in copyright and trademark law in both the EU and Czech legal systems. Although the approaches are treated separately, the significant impact of the harmonisation of EU law is emphasised. The coverage of both copyright and trademark law is justified by the premise that trademark parody might borrow the basic assessment features from the determination of copyright parody.²⁰

Since there is minimum case law on trademark parody from either the CJEU or the Czech courts and the treatment of trademark parody differs from country to country²¹, an analysis of German case law is provided for further assessment of how trademark parody could be treated. The German legal system is relatively close (and not only geographically or historically)²²

¹⁷ See, e.g. Greenpeace’s parody on the “ESSO” trademark, cf. *Greenpeace v Esso* (2008) The French Court of Cassation No. 06-10961.

¹⁸ See Úřad průmyslového vlastnictví (2022) *Trademark registration No. 476663* [online]. Available from: <https://isdv.upv.cz/obr/ozvyprej/663/O-476663.pdf> [Accessed 1 October 2022].

¹⁹ In the following text, “IbalGIN” stands for the “parodic version” whereas “Ibalgin” signifies the original trademark.

²⁰ E.g., since there is a legal definition of parody introduced by the CJEU for copyright infringement matters, it would not be appropriate to introduce a specific definition for the issue of trademark parody.

²¹ Cf. reports of selected states and groups in AIPPI (2002) *Yearbook 2002/1* [online]. Available from: <https://aippi.soutron.net/Portal/Default/en-GB/RecordView/Index/2995> [Accessed 8 January 2024], p. 291-521.

²² For the proximity of copyright see, e.g., Koukal, P. (2019) *Autorské právo, public domain a lidská práva*. Brno: Masarykova univerzita, p. 73-38; trademark law, on the other hand, is substantially harmonized by the EU law, cf. eg. Sec. 14 of the *Act on the Protection of Trade*

to the Czech law, so the German judiciary could be a useful inspiration for the treatment of trademark parody in the Czech Republic, especially, under the influence of the noticeable EU harmonisation of trademark law. The results of the analysed cases are applied to the illustrative case of *IbalGIN*.

This article concludes that a parodic trademark might be protected by freedom of expression; however, it must make at least a minimal statement (comment, criticism, etc.) about the original trademark or society (i.e., it shall raise public debate); otherwise, it would be considered as a purely commercial activity that unfairly takes advantage of the original trademark's reputation. If the above criteria are met, freedom of expression should be considered as a decisive factor in both the parodic trademark registration procedure and its simple factual use.

The relevance of the topic is even of more importance by the fact that the CJEU received a request for a preliminary ruling on the issue of political parody in the *IKEA-PLAN* case²³ (see Section 3.2.1 below for more details). In addition, the Czech courts recently decided the first copyright parody case in the Czech jurisprudence (see Section 4.1 below), and the recent progress in the *IbalGIN* case (including the trademark/RCD invalidity proceedings and the preliminary injunction proceedings) emphasises the topicality of the parody issue in the Czech intellectual property law, same as in the EU territory.

2. FREEDOM OF EXPRESSION IN THE CONTEXT OF PARODY

On the one hand, intellectual property rights can be characterized as an exception to the general freedom to act²⁴, on the other hand, freedom of expression represents an exception to general intellectual property rights.²⁵ Freedom of expression is one of the most precious political rights that is protected in all democratic societies. In the context of parodying intellectual

Marks and other Signs 1994, MarkenG. The Federal Republic of Germany. Berlin: Federal Gazette. In German, which is comparable to Art. 10 of the Trademark Directive and Sec. 8 of the Czech Trademark Act.

²³ Request for a preliminary ruling of 8 May 2023, C-298/23. *Official Journal of the European Union* (C-286/21) 4 August 2023. Available from: <https://eur-lex.europa.eu/legal-content/EN/TXT/?uri=CELEX:62023CN0298> [Accessed 7 December 2023].

²⁴ Cf. e.g. Art. 2(3) of the *Charter of Fundamental Rights and Freedoms* 1993, No. 2/1993 Coll. The Czech Republic. Prague: Collection of Laws. In Czech ("Czech Charter"): "Anyone may do what is not prohibited by law, and no one may be compelled to do what the law does not require".

²⁵ Cf. Koukal, P. (2019) *Autorské právo, public domain a lidská práva*, op. cit., p. 447-448.

property, freedom of expression is usually on one side of the scale when balancing the rights and interests of the parties involved.²⁶

As regards the determination of freedom of expression in intellectual property law, such cases are usually decided based on the expression's nature – whether it is political, artistic or commercial.²⁷ The more the expression is in the public interest, the less its commercial nature plays a decisive role.²⁸ The artistic expression might be considered both political and commercial, depending on the context and the intention of the performer.²⁹ Therefore, the commercialisation of use under the freedom of expression is more problematic³⁰ and requires a wider scope of assessment from the perspective of political/public debate.

The general (European) scope of the protection of freedom of expression is granted by Art. 10 of the Convention for the Protection of Human Rights and Fundamental Freedoms³¹ (“Convention”) and Art. 11 of the Charter of Fundamental Rights of the EU³² (“EU Charter”). All thoughts and opinions may be freely expressed in any form. What matters is the aim and purpose of the expression.³³ Consequently, the expression of an opinion can be part of any artistic work, even if it is rude or shocking.³⁴ According to the provisions cited, freedom of expression can be restricted by law if the restriction is a “measure necessary in a democratic society” and “pursues any of the legitimate objectives”.

The ECHR has already addressed the issue of freedom of expression under Art. 10 of the Convention and intellectual property rights. In

²⁶ Geiger, Ch. and Izyumenko, E. (2014) Copyright on the Human Rights' Trial: Redefining the Boundaries of Exclusivity Through Freedom of Expression. *International Review of Intellectual Property and Competition Law*, 45 (3), p. 317-318.

²⁷ Bartoň, M. and Hejč, D. (2021) Čl. 17 [Svoboda projevu a právo na informace]. In: Faisal Hussein et al. (eds). *Listina základní práv a svobod*. Praha: C. H. Beck, p. 540.

²⁸ Op. cit., p. 543.

²⁹ Op. cit., p. 541.

³⁰ Pontes, L. M. (2015) Trademark and Freedom of Speech: A comparison between the U.S. and the EU System in the Awakening of Johan Deckmyn v. Helena Vandersteen. In: *Ninth WIPO Advanced Intellectual Property Research Forum: Towards a Flexible Application of Intellectual Property Law - A Closer Look at Internal and External Balancing Tools*, World Intellectual Property Organization, p. 15.

³¹ *Convention for the Protection of Human Rights and Fundamental Freedoms*, 4 November 1950. Available from: https://www.echr.coe.int/documents/d/echr/convention_ENG [Accessed 27 November 2023].

³² *Charter of Fundamental Rights of the EU*, 18 December 2000 (2000/C 364/01). Available from: https://www.europarl.europa.eu/charter/pdf/text_en.pdf [Accessed 27 November 2023].

³³ Bartoň, M. and Hejč, D. (2021) Čl. 17 [Svoboda projevu a právo na informace]. In: Faisal Hussein et al. (eds). *Listina základní práv a svobod*. Praha: C. H. Beck, p. 516.

³⁴ Kosař, D. (2012) Čl. 10 [Svoboda projevu]. In: Jiří Kmec et al. (eds.). *Evropská úmluva o lidských právech. Komentář*. Praha: C. H. Beck, p. 1007.

the *Ashby Donald* case³⁵, the ECHR held that Art. 10 of the Convention covered the situation of posting photographs online and thus making an expression via the Internet³⁶. In assessing whether the imposed restriction on freedom of expression is necessary for a democratic society, the ECHR stated that the Convention leaves almost no room for restrictions on political speech, whereas, in the area of commerce, states are afforded a wide margin of discretion.³⁷ Therefore, the work or activity that generates debate on the issue of “public interest” is afforded greater protection than the (purely) commercial one.

In the *Pirate Bay* case³⁸, the ECHR held that even the sharing of copyrighted material for profits is covered by Art. 10 of the Convention.³⁹ In the context of both decisions, the ECHR maintains that the nature of the information and the interest at stake represent the key margin of appreciation.⁴⁰ The ECHR’s findings suggest that parodies are protected under Art. 10 of the Convention and the assessment of their admissibility should be based on the statement of creative intent, whether or not the parody comments on a matter of public interest. Moreover, as stated in the *Goucha v. Portugal* case⁴¹, satire and parody are given a wider margin of appreciation in the context of freedom of expression and both of them naturally aim to provoke and agitate⁴².

Generally, the CJEU is in the position to interpret the EU law in accordance with the Convention and its interpretation by the ECHR.⁴³ Concerning freedom of expression, Advocate General Collins stated in his opinion that both Art. 10 of the Convention and Art. 11 of the EU Charter have the same „meaning and scope“.⁴⁴

³⁵ *Ashby Donald and others v. France* (2013). No. 36769/08, ECHR.

³⁶ Op. cit, paragraph 34.

³⁷ Op. cit., paragraph 39.

³⁸ *Neij and Kolmisoppi v. Sweden* (2013). No. 40397/12, ECHR.

³⁹ Ibid.

⁴⁰ For further discussion concerning both cases see e.g. Myška, M. (2013), *Ashby Donald v pirátské zátoce: svoboda projevu a vymáhání autorského práva v aktuální judikatuře ESLP. Revue pro právo a technologie*, 4 (8), pp. 37–41. Available from: <https://journals.muni.cz/revue/article/view/5005> [Accessed 4 November 2023].

⁴¹ *Sousa Goucha v. Portugal* (2016). No. 70434/12, ECHR.

⁴² Op. cit., paragraph 50.

⁴³ Cf. e.g. Judgement of 22 October 2020, *Silver Plastics GmbH & Co. KG and Johannes Reifenhäuser Holding GmbH & Co. KG v. European Commission*, C-702/19 P, EU:C:2020:857, paragraph 25.

⁴⁴ Opinion of Advocate General Collins, delivered on 15th June 2023, case C-451/22, *RTL Nederland BV, RTL Nieuws BV. European Court Reports*. Available from: <https://eur-lex.europa.eu/legal-content/EN/TXT/?uri=CELEX:62022CC0451> [Accessed 27 November 2023], paragraph 49.

Regarding trademark parody, Advocate General Bobek emphasised that it does “play a role in trademark law”.⁴⁵ This role of freedom of expression in EU trademark law is reflected in several aspects. First, Art. 51(1) of the EU Charter obliges all official EU institutions to respect the protected rights within the limits of their respective powers. As mentioned above, freedom of expression is protected by Art. 11 the EU Charter. Secondly, Regulation 2017/1001⁴⁶ and its Recital 21 ensures that the rules are applied with respect to fundamental rights, in particular, freedom of expression.⁴⁷ Finally, in its case law, the EUIPO recognizes that the freedom of expression “must be duly taken into account” when assessing the (in)validity of a trademark.⁴⁸

In his opinion, Advocate General Bobek suggested that “the weight to be given to freedom of expression in the area of trade mark law may be somewhat different, perhaps slightly lighter, in the overall balancing of the rights and interests present”⁴⁹ than in the area covered by copyright law (art, culture, literature). The relevant question is how much less weight and under what circumstances freedom of expression might be accorded in trademark parody cases.

As Helfer and Austin point out, “[a]lthough [...] parody is often offensive, it is nevertheless ‘deserving of substantial freedom both as entertainment and as a form of social and literary criticism’ [...] Denying parodists the opportunity to poke fun at symbols and names which have become woven into the fabric of our daily life, would constitute a serious curtailment of a protected form of expression.”⁵⁰ Therefore, it may be concluded that whereas parody exception plays the role of an internal limitation

⁴⁵ Opinion of Advocate General Bobek, delivered on 2nd July 2019, case C-240/18 P, Constantin Film Produktion GmbH v European Union Intellectual Property Office (EUIPO). *European Court Reports*. Available from: <https://eur-lex.europa.eu/legal-content/EN/TXT/?uri=CELEX:62018CC0240> [Accessed 27 November 2023], paragraph 47.

⁴⁶ Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark. *Official Journal of the European Union* (L 154) 16 June. Available from: <https://eur-lex.europa.eu/legal-content/CS/TXT/?uri=CELEX:32017R1001> [Accessed on 27 November 2023].

⁴⁷ Op. cit., paragraph 21 of the recital.

⁴⁸ See, for instance, OHIM the Boards of Appeal decision of 2 September 2015, case R 519/2015-4, paragraph 16 (citing OHIM the Boards of Appeal decision of 6 July 2006, case R 495/2005-G, paragraphs 15-17).

⁴⁹ Opinion of Advocate General Bobek, delivered on 2nd July 2019, case C-240/18 P, Constantin Film Produktion GmbH v European Union Intellectual Property Office (EUIPO). *European Court Reports*. Available from: <https://eur-lex.europa.eu/legal-content/EN/TXT/?uri=CELEX:62018CC0240> [Accessed 27 November 2023], paragraph 56.

⁵⁰ Helfer, L., R. and Austin, G. W. (2011) *Human Rights and Intellectual Property: Mapping the Global Interface*. New York: Cambridge University Press, p. 293.

to the author's rights, freedom of expression shall be understood as an external limitation to the trademark owner's rights.⁵¹

Apart from the general European scope of protection, in Czech law, freedom of expression is based on Art. 17 of the Czech Charter, which is part of the Czech constitutional order. All the above-mentioned provisions of the Convention, the EU Charter and the Czech Charter shall be duly applied to protect freedom of expression in the Czech case law.

3. EU LAW APPROACH TO PARODY

3.1. PARODY AND COPYRIGHT IN THE EU LAW

The EU copyright law is not fully harmonised or unified. Some Member States of the EU do have open exceptions like the US *fair use* doctrine, e.g. Belgium⁵². However, partial harmonisation of EU copyright law was achieved by the InfoSoc Directive, which, among others, introduced a statutory exception for parody. Although Member States are not obliged to adopt this exception into their copyright laws, the European Parliament recommended that they do so.⁵³ The Czech Republic has adopted this limitation into the Czech Copyright Act by amending Act No. 102/2017 Coll.

The landmark copyright parody case considered by the CJEU is *Deckmyn*⁵⁴. The merit of the case lies in the calendar created by J. Deckmyn (from Vlaams Belang political party) which shows the Mayor of Gent throwing gold coins to people wearing veils and people of colour. The image was allegedly similar to the cover of the comic book "Suske en Wiske" (created by W. Vandersteen). J. Deckmyn based his defence on political caricature and parody. The Belgian court referred the preliminary question to the CJEU in seeking the definition of parody under EU law.

⁵¹ Concerning the trademark law and its external limit see, e.g. Żelechowski, Ł. (2018) Invoking freedom of expression and freedom of competition in trade mark infringement disputes: legal mechanisms for striking a balance. *ERA Forum*, 19, p. 133. Available from: <https://link.springer.com/article/10.1007/s12027-018-0498-3> [Accessed 13 April 2024].

⁵² Hernandez, I. et al. (2020) *Comparative Advertising and Parodies: Treatment Through a Fair Use Approach Under Trademark and Copyright Law in Selected Jurisdictions* [online]. Available from: <https://www.inta.org/wp-content/uploads/public-files/advocacy/testimony-submissions/Comparative-Advertising-and-Parodies-Survey-4.20.20.pdf> [Accessed 3 October 2022], p. 5.

⁵³ European Parliament resolution of 9 July 2015 on the implementation of Directive 2001/29/EC of the European Parliament and of the Council of 22 May 2001 on the harmonisation of certain aspects of copyright and related rights in the information society. *Official Journal of the European Union* (C 265/121) 11 August 2017. Available from: <https://eur-lex.europa.eu/legal-content/EN/TXT/?uri=CELEX:52015IP0273> [Accessed 3 October 2022].

⁵⁴ Judgement of 3 September 2014, Johan Deckmyn, Vrijheidsfonds VZW v. Helena Vandersteen, C-201/13, EU:C:2014:2132.

The CJEU stated that parody is an autonomous term of the EU law, and therefore only the CJEU can define what parody is.⁵⁵ This interpretation is applied uniformly throughout the EU. According to the CJEU, “the essential characteristics of parody are, first, to evoke an existing work while being noticeably different from it, and, secondly, to constitute an expression of hum[o]r or mockery.”⁵⁶ Moreover, the concept of parody is not subject to any further conditions.⁵⁷

Furthermore, according to the CJEU, conflicting rights and interests must be weighed to strike a fair balance between the copyright holder, on the one hand, and freedom of expression, on the other, and therefore all the relevant circumstances of the case must be taken into account.⁵⁸ However, Nordemann and Kraetzig point out that this requirement makes it difficult to implement the definition of parody, as it can “create legal uncertainty and potentially restrict the freedom of expression”⁵⁹. Rigorous application of the principle of non-discrimination, which must always be considered as relevant circumstance, could be hazardous for controversial parodies.⁶⁰

3.2. TRADEMARK PARODY IN THE EU LAW

Two possible outcomes of the EU copyright approach to parody might be applied to the EU trademark law. First, concerning the autonomous definition of parody under the *Deckmyn* case, it does not seem very useful to redefine parody for trademark law purposes, so the assessment of parody should be the same. Second, the necessity of protecting the freedom of expression and its balancing with property rights should be the same in trademark law too.

There is no exception for parody in the harmonisation of the EU trademark law. In the context of parody, the trademark with reputation comes into play. As there is a need to protect the reputation of a trademark, the dilution and confusion principles apply to the assessment of trademark infringement. The harmonising Trademark Directive in its Art. 5(3)(a) states that a trademark shall not be registered or shall be declared invalid if it is identical

⁵⁵ Op. cit., paragraph 15.

⁵⁶ Op. cit., paragraph 20.

⁵⁷ Op. cit., paragraph 21.

⁵⁸ Op. cit., paragraphs 27-28.

⁵⁹ Nordemann, J. B. and Kraetzig, V. (2016) *The German Bundesgerichtshof changes its concept of parody following CJEU Deckmyn v. Vrijheidsfonds/ Vandersteen*. [blog entry] 3 November. Kluwer Copyright Blog. Available from: <http://copyrightblog.kluweriplaw.com/2016/11/03/the-german-bundesgerichtshof-changes-its-concept-of-parody-following-cjeu-deckmyn-v-vrijheidsfonds-vandersteen/> [Accessed 3 October 2022].

⁶⁰ Ibid.

or similar to an earlier trademark (reputed in Member State⁶¹) “and the use of the later trade mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark”. Furthermore, Art. 10(2)(c) of the Trademark Directive states that the owner of a trademark with reputation is entitled to prohibit any non-consensual use of the sign in the course of trade, irrespective of the goods or services concerned, of the sign which “takes unfair advantage of or is detrimental to, the distinctive character or the repute of the trade mark”.

Trademarks with reputation are therefore protected against dilution, tarnishment and taking unfair advantage.^{62–63} In his opinion of the cited judgment, Advocate General Jacobs interpreted all these concepts.⁶⁴ First, Jacobs stated that “[t]he essence of dilution [...] is that the blurring of the distinctiveness of the mark means that it is no longer capable of arousing immediate association with the goods for which it is registered and used.”⁶⁵ Secondly, there is the element of detriment to the reputation of a trademark – tarnishment. According to Jacobs, this is the situation where “the goods for which the infringing sign is used appeal to the public's senses in such a way that the trademark's power of attraction is affected.”⁶⁶

Finally, there is the possibility of trademark infringement caused by taking unfair advantage of the distinctive character or reputation of the mark. This is the case of free-riding or an attempt to trade upon the reputation of the earlier mark.⁶⁷ The concept of free-riding “covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there

⁶¹ The CJEU prefers quantitative scope, see Judgment of 14 September 1999, *General Motors Corporation v. Yplon SA*, C-375/97, EU:C:1999:408, paragraph 31: „a registered trade mark must be known by a significant part of the public concerned by the products or services which it covers“; whereas the Czech Supreme Administrative Court prefers qualitative scope, see e. g. *Dermacour Laboratories s.r.o. v. Úřad průmyslového vlastnictví* (2018) Supreme Administrative Court 6 As 71/2018, paragraph 42: „the public, as a result of its use, is familiar with the mark and associates it with the good qualities it expects from the goods or services so marked and places its trust in it“ [author's own translation].

⁶² Judgment of 23 October 2003, *Adidas-Salomon AG and Adidas Benelux BV v. Fitnessworld Trading Ltd.*, C-408/01, EU:C:2003:582, paragraph 37.

⁶³ For the basics of the concepts, its origin and comparison between EU and the US see, e.g. Luepke, M. H. H. (2008) *Taking Unfair Advantage or Diluting a Famous Mark - a 20/20 Perspective on the Blurred Differences Between U.S. and E.U. Dilution Law*. *Trademark Reporter*, 98(3), pp. 789-833.

⁶⁴ Opinion of Advocate General Jacobs, delivered on 10th July 2003, case C-408/01, *Adidas-Salomon AG and Adidas Benelux BV v. Fitnessworld Trading Ltd.* *European Court Reports* (I-12537) 10 July 2003. Available from: <https://eur-lex.europa.eu/legal-content/EN/TXT/?uri=CELEX%3A62001CC0408> [Accessed 7 October 2022].

⁶⁵ Op. cit., paragraph 37.

⁶⁶ Op. cit., paragraph 38.

⁶⁷ Op. cit., paragraph 39.

is clear exploitation on the coat-tails of the mark with a reputation.”⁶⁸ To obtain protection, the proprietor must prove that there exists a risk of such infringement. The link between the earlier and the later mark should be established.⁶⁹

It is not required to prove the existence of a likelihood of confusion to assess whether a trademark with a reputation has been infringed.⁷⁰ However, if the likelihood of confusion is established, it supports the finding of a link created between the signs in the minds of consumers.⁷¹ Without the link, the dilution infringement of a trademark with reputation cannot be stated.⁷²

The concept of confusion principle is based on a global appreciation of the visual, aural or conceptual similarity of the conflicting marks (the overall impression and its distinctive and dominant components). As the CJEU stated, “the more distinctive the earlier mark, the greater will be the likelihood of confusion”.⁷³ However, when considering a parody of a reputed trademark, the assessment might be sufficiently based on stating the likelihood of association, i.e. a situation where the consumer is not confused as to the source but makes a psychological association between the conflicting marks, especially when different categories of goods or services are concerned.⁷⁴

The CJEU (the General Court, respectively) in the *Polo/Lauren*⁷⁵ case partially dealt with an alleged trademark parody. The dispute between the Polo/Lauren company and OHIM (now EUIPO) dealt with an application for registering an allegedly parodic trademark of Fresh Side company. The original Polo/Lauren trademark depicts a polo player on a horse. The

⁶⁸ Judgement of 18 June 2009, *L’Oreal SA v. Bellure NV*, C-487/07, EU:C:2009:378, paragraph 41.

⁶⁹ Charvát points out that trademark protection against “free-riding” (the taking of an unfair advantage) in the absence of confusion and economic harm to the trademark owner’s rights is debatable and rather redundant. In Charvát’s view, this is reflected in the US law where the provision prohibiting “free-riding” of the reputation was excluded in 2006 by the Trademark Revision Dilution Act. See Charvát, R (2012). *Ochranná známka s dobrým jménem dle práva Evropské unie a České republiky. Právní rozhledy*, 20(22), p. 787.

⁷⁰ Judgement of 11 November 1997, *Sabel v. PUMA*, C-251/95, EU:C:1997:528, paragraph 20.

⁷¹ Judgement of 27 November 2008, *Intel Corporation Inc. v. CPM United Kingdom Ltd*, C-252/07, EU:C:2008:655, paragraph 30.

⁷² *Op. cit.*, paragraph 31.

⁷³ Judgement of 11 November 1997, *Sabel v. PUMA*, C-251/95, EU:C:1997:528, paragraph 22-24.

⁷⁴ Cf. e.g. Judgement of 14 September 1999, *General Motors Corporation v. Yplon SA*, C-375/97, EU:C:1999:408, paragraph 23; or Judgement of 27 November 2008, *Intel Corporation Inc. v. CPM United Kingdom Ltd*, C-252/07, EU:C:2008:655, paragraph 30.

⁷⁵ Judgement of 18 September 2014, *The Polo/Lauren Company, LP v. OHIM*, T-265/13, EU:T:2014:779.

“parodic” trademark depicts a polo player on a bicycle.⁷⁶ OHIM rejected Polo/Lauren’s opposition to the application and the OHIM Board of Appeal sustained this verdict. However, the CJEU annulled the OHIM’s decision on the basis of the earlier trademark with reputation protection and on the grounds of a finding of similarity between the signs.⁷⁷ Therefore, both the doctrine of dilution and the doctrine of confusion were applied in mutual combination. In the following proceeding, OHIM found that the alleged parody was taking advantage of the original’s reputation for economic purposes.⁷⁸ As OHIM stated, “[t]his is not about stopping parody, but it cannot be right to grant protection to a sign that gains cachet by mocking the reputation of another. When the reputation of a brand is involved, trade mark law has no sense of humour.”⁷⁹ Thus, the OHIM confirmed that parody itself does not constitute a ground for the exclusion of trademark infringement.⁸⁰ However, the EU is still awaiting a pure trademark parody case in front of the CJEU that would lead to a clear conclusion of trademark parody treatment.

3.2.1 IKEA-PLAN – *Deckmyn* of a trademark parody?

On 8 May 2023, the Dutch Business Court in Brussels (*Nederlandstalige Ondernemingsrechtbank*) referred to the CJEU a request for a preliminary ruling in the case of political parody on the “IKEA” trademark.⁸¹ There are three referred questions⁸², which might be simply put as:

- 1) Whether freedom of expression constitutes a “due cause” for using a well-known trademark?
- 2) What are the criteria taken into account when assessing the balance of fundamental rights in question?
- 3) Can the national court take into account the list of criteria, e.g. “the extent to which the expression has a commercial character

⁷⁶ Op. cit., paragraphs 2 and 6.

⁷⁷ Op. cit., paragraphs 32, 33 and 39.

⁷⁸ OHIM the Boards of Appeal decision of 7 July 2015, case R 353/2015-5, paragraph 60.

⁷⁹ Ibid.

⁸⁰ Sitko, J. (2018) Parodia w kontekście naruszenia prawa do zarejestrowanego znaku towarowego (analiza prawno-porównawcza). In: Janusz Barta, Jakub Chwalba, Ryszard Markiewicz, Piotr Wasilewski (eds.) *Qui bene dubitat, bene sciet. Księga jubileuszowa dedykowana Profesor Ewie Nowińskiej*. Warsaw: Wolters Kluwer Polska, p. 687.

⁸¹ Request for a preliminary ruling of 8 May 2023, C-298/23. *Official Journal of the European Union* (C-286/21) 4 August 2023. Available from: <https://eur-lex.europa.eu/legal-content/EN/TXT/?uri=CELEX:62023CN0298> [Accessed 27 November 2023].

⁸² For the exact wording of the questions see Ibid.

or purpose” or “the extent to which the expression has a public interest, is socially relevant or opens a debate” etc.?

The subject-matter of the case is based on a political campaign (by the same party as in the *Deckmyn* case) using the blue and yellow logo for “IKEA-PLAN” concerning the reform of migration policy in Belgium.⁸³ While IKEA assumes trademark infringement, the political party claims parody as “due cause” for using the “IKEA” trademark.⁸⁴

In this case, the CJEU has the opportunity to comment fully on the issue of freedom of expression in the context of trademark parody, possibly setting the boundaries of when and how this fundamental right will be curtailed. The significance of this case will no doubt be compared to the *Deckmyn* case and its implication for parody in (EU) copyright law. The importance of the case is emphasized by the fact that the International Trademark Association (“INTA”) has submitted an amicus brief to the CJEU in this particular case.⁸⁵ INTA’s intervention in the case is that the CJEU should not extend the interpretation of “due cause” by “allowing ‘parody’ as a general fair use defense in trademark infringement cases”.⁸⁶ In this sense, INTA believes that the “due cause” principle is designed to avoid unnecessary damage to the trademark by the infringer and that “freedom of expression does not automatically secure non-infringement”.⁸⁷ The CJEU does not have to and formally cannot consider INTA’s submission. However, it will be interesting to see whether some of the ideas/arguments put forward by INTA will feature in the CJEU’s decision.

4. THE CZECH LAW APPROACH TO PARODY

4.1. COPYRIGHT

The Czech Republic, as a Member State of the EU, has adopted a statutory exception for caricature and parody from the InfoSoc Directive into Sec. 38g of the Czech Copyright Act. To qualify for the use of the exception, all

⁸³ See Rosati, E. (2023) *What role for freedom of expression under EU trade mark law? An “IKEA-PLAN” prompts a CJEU referral.* [blog entry] 9 July. The IPKat. Available from: <https://ipkitten.blogspot.com/2023/07/what-role-for-freedom-of-expression.html> [Accessed 27 November 2023]; as Rosati points out, IKEA stands for „Immigratie Kan Echt Anders”, meaning „Immigration can really change”.

⁸⁴ *Ibid.*

⁸⁵ Parotta, N. and Lubberger, A. *INTA Attempts to File Amicus Brief with CJEU in Preliminary Ruling Case.* [online]. International Trademark Association. Available from: <https://www.inta.org/news-and-press/inta-news/inta-attempts-to-file-amicus-brief-with-cjeu-in-preliminary-ruling-case-involving-ikea/> [Accessed 10 May 2024].

⁸⁶ *Ibid.*

⁸⁷ *Ibid.*

elements of the three-step test must be met.⁸⁸ According to Czech scholars, this provision helps to strike a balance of interests between the rights and freedom of expression.⁸⁹ However, after five years of the effectiveness of the provision, so far only one parody case has been decided under the parody exception.

The case concerns a conflict between Greenpeace Czech Republic and Czech Energy Group⁹⁰ (“ČEZ”). Greenpeace transformed the three advertising videos of ČEZ by inserting new footage (images of forest fires and deforestation, dead bodies, exhausted coal mines) accusing ČEZ of causing climate change. All three transformed videos were posted by Greenpeace on its Facebook page.⁹¹ The Prague Municipal Court found that neither of the characteristics nor the three-step test had been met.⁹² The High Court in Prague reversed the judgment of the Municipal Court.⁹³

First, the High Court held that in this case, it is a parody according to *Deckmyn’s* definition because the transformed videos evoked the original by adding horrifying images, thus creating irony.⁹⁴ Furthermore, it also met the three-step test (the spots were still used as videos and the reversal of the meaning of the original advertisement to the public is the essence of parody).⁹⁵ In addition, the Greenpeace spots do not conflict with a normal exploitation of the original work and do not unreasonably prejudice the legitimate interests of ČEZ, since it must be clear to any user that the new spots are part of an “ecological battle” in which ČEZ is in the “opposing” position.⁹⁶

⁸⁸ Three-step test is regulated in Sec. 29 Czech Copyright Act. The elements of the test deal with limitations and exceptions to exclusive rights in 1) certain special cases which 2) do not conflict with a normal exploitation of the work and 3) do not unreasonably prejudice the legitimate interests of the right holder.

⁸⁹ Telec, I. and Tůma, P. (2019) Komentář k § 38g. In: Ivo Telec, Pavel Tůma (eds.). *Autorský zákon: Komentář*. Praha: C. H. Beck, p. 470.

⁹⁰ The Czech Republic holds major assets of the group.

⁹¹ Three video spots were dealt in different proceedings but at the same court and judge. See ČEZ a. s. v. *Greenpeace Česká republika, z.s.* (2020) Municipal Court Prague 32 C 2/2019 [not published]; ČEZ a. s. v. *Greenpeace Česká republika, z.s.* (2020) Municipal Court Prague 32 C 7/2019 [not published]; ČEZ a. s. v. *Greenpeace Česká republika, z.s.* (2020) Municipal Court Prague 32 C 1/2020 [not published]. Therefore, the findings in all cases are the same. Against all the decisions, an appeal was brought.

⁹² ČEZ a. s. v. *Greenpeace Česká republika, z.s.* (2020) Municipal Court Prague 32 C 7/2019.

⁹³ See ČEZ a. s. v. *Greenpeace Česká republika, z.s.* (2022) High Court Prague 3 Co 54/2021 [not published]; ČEZ a. s. v. *Greenpeace Česká republika, z.s.* (2022) High Court Prague 3 Co 55/2021 [not published]; ČEZ a. s. v. *Greenpeace Česká republika, z.s.* (2022) High Court Prague 3 Co 56/2021 [not published].

⁹⁴ ČEZ a. s. v. *Greenpeace Česká republika, z.s.* (2022) High Court Prague 3 Co 54/2021 [not published].

⁹⁵ *Ibid.*

⁹⁶ *Ibid.*

An extraordinary appeal was made against all these decisions.⁹⁷ The Supreme Court had to deal with the question of law, whether an audiovisual work might be used for parody. The Supreme Court first stated that there is no reason why a parody of an audiovisual work should not be allowed. Regarding the requirement of “normal exploitation of the original work”, the Supreme Court confirmed that in this case, the insertion of new footage was the essence of the parodic use by creating critical/ironic comments. The Supreme Court also held that it is irrelevant whether the parody was successful. The decisive matter is the artistic intent of the creator. It was also emphasized that individuals or organizations involved in public debate must be able to withstand a higher level of criticism.^{98,99} The findings of the Supreme Court were upheld by the Czech Constitutional Court,¹⁰⁰ which, among others, stated that humour (satire, parody, irony) is part of daily life and a crucial part of democratic society.¹⁰¹

4.2. TRADEMARKS

There is no statutory exception for parody in Czech trademark law. As in the case of copyright, the EU harmonisation is also applied in the Czech trademark law. Therefore, both the doctrine of dilution and the doctrine of confusion are included in the Czech Trademark Act. Pursuant to Sec. 8(2)(c) of the Czech Trademark Act, the use of a similar or confusing mark is prohibited if the earlier mark has a certain reputation in the Czech Republic, regardless of the categories of goods and services, if such use may be detrimental to the distinctive character or reputation of the mark or would take unfair advantage of it. In addition, Sec. 8(2)(b) Czech Trademark Act prohibits the use of a mark that creates a likelihood of confusion with an earlier mark.

The key element in determining trademark parody is the aspect of the trademark's reputation and its recognition by the relevant section of

⁹⁷ See *ČEZ a. s. v. Greenpeace Česká republika, z.s.* (2023) Supreme Court 23 Cdo 2178/2022; *ČEZ a. s. v. Greenpeace Česká republika, z.s.* (2023) Supreme Court 23 Cdo 2403/2022; *ČEZ a. s. v. Greenpeace Česká republika, z.s.* (2023) Supreme Court 23 Cdo 2627/2022. The former is a decision on the merits, and the rest of the decisions dismiss the extraordinary appeal.

⁹⁸ Cf. *ČEZ a. s. v. Greenpeace Česká republika, z.s.* (2023) Supreme Court 23 Cdo 2178/2022.

⁹⁹ For the translated version of the the decision *ČEZ a. s. v. Greenpeace Česká republika, z.s.* (2023) Supreme Court 23 Cdo 2178/2022 see Koukal, P. and Ježek, M. (2024) Parody of Audio-Visual Works. *GRUR International*, 73(2), pp. 172-179.

¹⁰⁰ *ČEZ a. s. v. Greenpeace Česká republika, z.s.* (2024) Constitutional Court I. ÚS 2956/23; *ČEZ a. s. v. Greenpeace Česká republika, z.s.* (2024) Constitutional Court I. ÚS 2957/23; *ČEZ a. s. v. Greenpeace Česká republika, z.s.* (2024) Constitutional Court IV. ÚS 2979/23.

¹⁰¹ *ČEZ a. s. v. Greenpeace Česká republika, z.s.* (2024) Constitutional Court I. ÚS 2956/23, paragraph 30.

the public. The degree of such recognition and reputation may outweigh the differences in goods and services.¹⁰² The most famous marks, e.g. "Coca-Cola" or "Adidas", transcend the boundaries of their relevant markets and would be recognized by almost every person on the planet. In the absence of a precise provision on parody, the determination of whether a trademark parody is permissible relies on the dilution or confusion tests and, in general, on a balancing of the interests and rights of the owners and the parodists (in terms of freedom of expression).¹⁰³

The Industrial Property Office of the Czech Republic¹⁰⁴ has not dealt with parody in any trademark registration procedure¹⁰⁵. A similar conclusion can be drawn from Czech case law. The only case that could be considered to cover the issue of trademark parody was the case of the "LEGO" figures and trademarks used for the political campaign.¹⁰⁶

The Czech Piracy Party¹⁰⁷ used "LEGO" figures in one of its pre-election videos. The Czech Constitutional Court's decision contains some interesting remarks. First, the "LEGO" trademark has a certain reputation as it is known to the public. Second, the pre-election video was found humorous.¹⁰⁸ Finally, the Constitutional Court found that although the "LEGO" trademark was used as a part of political expression and criticism of intellectual property as a part of the political program, but to the court's view, this message could have been conveyed in a way that did not infringe on the owner's rights.¹⁰⁹

This result aligns with the general requirement of balancing the contested fundamental rights. The decision states that even satirical political expression might be in contrary to the trademark owner's rights. The finding is relatively strict. From the general context of the video, it cannot be assumed that

¹⁰² Peřinová, E. (2020) Komentář k § 7. In: Peřinová, E. et al. (eds). *Zákon o ochranných známkách: Praktický komentář*. Praha, Wolters Kluwer, p. 55-56.

¹⁰³ For further perspective of how trademark parody cases are treated in the EU, see also Ramalho, A. (2009). Parody in Trademarks and Copyright: Has Humour Gone Too Far. *Cambridge Student Law Review*, 5(1), 58-74. For the US perspective, cf. e.g. Simon, D. A. (2013). The Confusion Trap: Rethinking Parody in Trademark Law. *Washington Law Review*, 88(3), pp. 1021-1102; Gerhardt, D. R. (2007). The 2006 Trademark Dilution Revision Act Rolls out Luxury Claim and Parody Exemption. *North Carolina Journal of Law and Technology*, 8(2), pp. 205-230.

¹⁰⁴ Registration authority for industrial property rights in the Czech Republic.

¹⁰⁵ Response of the Industrial Property Office of the Czech Republic of 3. 12. 2021, No. 2021/D21113596/11/ÚPV.

¹⁰⁶ *Česká pirátská strana v. LEGO Juris A/S* (2017) Czech Constitutional Court I. ÚS 2166/16.

¹⁰⁷ Piráti (2022) *Program České pirátské strany: Právní problémy duševního vlastnictví* [online]. Available from: <https://wiki.pirati.cz/kci/dusevko> [Accessed 11 November 2022]; to point out, the Czech Piracy Party program, among others, calls for cancelling the copyright law.

¹⁰⁸ *Česká pirátská strana v. LEGO Juris A/S* (2017) Czech Constitutional Court I. ÚS 2166/16.

¹⁰⁹ Ibid.

consumers would be confused about the support of the LEGO company to the Czech Piracy Party (which constantly fights against intellectual property rights in general). Furthermore, the video does not cause harm to the reputation or to the distinctive character of the "LEGO" trademark. It is also notable that the political advertisement is not so much commercial as a typical business advertisement since it is not aimed at economic gain. The author is of the view that in this case, the Constitutional Court might have considered the rights in question in greater depth, including whether and to what extent the LEGO company's rights had or might have been infringed.

5. LESSONS LEARNED FROM GERMANY

In Germany, the issue of trademark parody is repeatedly being discussed and there is currently a settled case law dealing with this issue. Due to the proximity of the legal systems, the findings of the German courts might be helpful for the assessment in the Czech Republic.

5.1. CASE LAW

In the very first case on this issue, the Federal Court of Justice (*Bundesgerichtshof*) ruled that the use of a well-known trademark in a humorous way to present a product can exclude the unfair advantage of distinctive character based on freedom of art.¹¹⁰ The case was about the purple postcard "Muh", which used and allegedly infringed Milka's "Lila" colour trademark. The card was printed with a poem written by "Rainer Maria Milka" and the poem stated, "It is calm above the tree tops, somewhere a cow is bellowing. Moo!"¹¹¹

The Court confirmed that a creative design is the essence of artistic activity, and since freedom of art protects artistic expression, the parody postcard falls within its scope of protection because of its humorous and satirical depiction of cows.¹¹² If it cannot be assumed that the parodic use is disparaging of the original trademark and that the parodist is pursuing exclusively commercial purposes, the protection of artistic freedom prevails over property rights.¹¹³

In the *eiPott* case¹¹⁴, the German manufacturer sold egg cups under the name "eiPott". The Hamburg Court of Appeal (*Oberlandesgericht Hamburg*) held that the name was artificially created and that "pott" (*pot*) was not

¹¹⁰ *Lila-Postkarte* (2005) Federal Court of Justice I ZR 159/02.

¹¹¹ Cf. Senftleben, M. Adapting EU Trademark Law to New Technologies - Back to Basics? In: Geiger, C. (ed.) *Constructing European Intellectual Property: Achievements and New Perspectives*. Cheltenham: Edward Elgar Publishing, p. 148.

¹¹² *Lila-Postkarte* (2005) Federal Court of Justice I ZR 159/02, paragraph 29.

¹¹³ Op. cit., paragraph 35.

¹¹⁴ *eiPott* (2010) Hamburg Appeal Court 5 W 84/2010.

commonly used for egg cups in Germany. Therefore, the public will not understand the term (in a descriptive way) and so it creates an indication as trademarks do. The pronunciation of “eiPott” is similar to Apple’s “iPOD”.¹¹⁵ This similarity creates a humorous connotation between the two marks.

Based on the distinctiveness of the original trademark, the similarity of goods (the mark “iPOD” is designated also used for “appliances in the kitchen”), and the phonetical similarity, the court found the likelihood of confusion.¹¹⁶ The court also noted that in some exceptional cases, the use of a reputed or well-known trademark for one’s product could be justified under freedom of art (citing, e.g. *Lila-Postkarte* case).¹¹⁷ However, as the Court has stated, in such a case, the mark must combine other elements which allude to the trademark owner. This “creative surplus” (*kreativer Überschuss*) will then overlap the reputation in the overall impression.^{118 119}

In the *Springender Pudel (Jumping Poodle)* case¹²⁰, the Federal Court of Justice held that the jumping poodle was a successful parody of the “PUMA” trademark, but that freedom of art could not take precedence over the property right.¹²¹ The court concluded that the parodic trademark should not be registered because it benefits from the commercial and advertising efforts of “PUMA” and its existence would not be inconceivable without the existence of such a highly distinctive earlier trademark. In addition, “jumping poodle” could be protected by copyright law.¹²² The difference from the *Lila-Postkarte* case is that “jumping poodle” was used for the same category of goods and sought to be protected as a registered trademark.¹²³

In addition, the “jumping poodle” makes no comment or criticism of the original trademark. There is recognizable commercial interest in targeting consumers who are attracted by a humorous reference to the

¹¹⁵ Op. cit., paragraphs 10 and 14.

¹¹⁶ Op. cit., paragraph 15.

¹¹⁷ Op. cit., paragraphs 22-23.

¹¹⁸ Op. cit., paragraph 25.

¹¹⁹ The case cited is very similar to *IbalGIN*. In both cases, the phonetic similarity is the only humorous message. Both marks borrow part of the original’s design, in the case of the *eiPott* it was bitten egg, and in the case of the *IbalGIN* pink and blue color and font of the text. In neither case, there is any further reference or comment made to the original.

¹²⁰ *Springender Pudel* (2015) Federal Court of Justice I ZR 59/13; for the discussion of the case cf. e.g. Clark, B. (2015) *Dogged Pursuit of a trade mark parody: PUMA v PUDEL in the Bundesgerichtshof*. [blog entry] 21 April. The IPKat. Available from: <https://ipkitten.blogspot.com/2015/04/dogged-pursuit-of-trade-mark-parody.html> [Accessed 7 December 2023].

¹²¹ *Springender Pudel* (2015) Federal Court of Justice I ZR 59/13, paragraphs 59-60.

¹²² *Ibid.*

¹²³ Op. cit., paragraph 60.

well-known trademark, without which the business might not be successful. Therefore, freedom of expression cannot prevail over property rights.¹²⁴

The Federal Patent Court took a similar view in the recent *British Airways* case¹²⁵. Based on the dissimilarity of services, the likelihood of confusion with the “British Airways” trademark was not found, however, the taking of unfair advantage was stated.¹²⁶ According to the Court, such a use of the original trademark constitutes a parody protected by freedom of art, nevertheless, it does not justify the unfair use of the former mark. Simultaneously, the latter mark does not make any comment or criticism of the original that could be considered as freedom of expression.¹²⁷ Therefore, the cancellation of the “British Airways” trademark was ordered.¹²⁸

5.2. OUTCOMES

As Pemsel pointed out, German case law provides the perspective that “it is easier to attack the registration of a parody successfully than the use of it”, although the impact of use is more serious than that of registration.¹²⁹ In both, *Springender Pudel* and *British Airways*, the owners of the original trademark sought to cancel the registration of a sign that took unfair advantage, but, the action did not seek to prohibit the unregistered use.

The overall outcomes of the cited case law might be described in the following overview.

- 1) A parodic trademark is protected under freedom of art/freedom of expression if
 - a. it meets the definition of parody (creates an association in the mind of the consumer and is humorous/satirical; copyright assessment permissible);
 - b. it makes a statement about the original trademark (adds something extra – comment, criticism, allusion) or society (i.e. provokes public debate) and
 - c. it does not disparage the original trademark or is not solely for commercial gain.

¹²⁴ Op. cit., paragraphs 62-63.

¹²⁵ *British Airways* (2022) Federal Patent Court of Germany 30 W (pat) 15/19.

¹²⁶ Ibid.

¹²⁷ Ibid.

¹²⁸ Ibid.

¹²⁹ Pemsel, M. (2023) *British Airways did not take off – as a trade mark*. [blog entry] 4 July. The IPKat Available from: <https://ipkitten.blogspot.com/2023/07/british-airways-did-not-take-off-as.html> [Accessed 28 November 2023].

- 2) A parodic trademark is not protected under freedom of art/freedom of expression if
 - a. it meets the definition of parody (creates an association in the mind of the consumer and is humorous/satiric; copyright assessment admissible), but, at the same time,
 - b. it does not make a statement about the original trademark or society (i.e. provokes public debate) and
 - c. it disparages the original trademark or is solely for commercial gain and (takes unfair advantage of the distinctive character); and
 - d. (applies for the registration)¹³⁰.

Since a parody must imitate the original, the assessment of the likelihood of confusion is not very useful for trademark parodies. On the other hand, the likelihood of association is sufficient to determine whether a parody is successful, i.e. whether it creates a link in the minds of the recipients. It seems clear that parody as a humorous expression will be considered during the assessment of dilution, particularly in the determination of unfair advantage. Furthermore, whether a parodic trademark makes a statement about the original trademark or society is the key element for the whole consideration. Playing with words and letters might be humorous, but if there is no further message, it would mostly be seen as a simple attempt to profit from the fun and the original trademark owner's expenses.

As Helfer and Austin point out, "defending an unlicensed use on parody grounds requires targeting the product or company identified by the mark rather than using the mark only to gain attention".¹³¹ Luepke adds that if the parody or criticism is reasonable rather than disparaging, freedom of expression would prevail.¹³²

The German scholars and experts concluded that the decision in trademark parody cases does not generally focus on the assessment

¹³⁰ The final requirement would not be questioned in every trademark parody case, however, as the German courts state, the trademark owner does not have to endure the registration of a parodic sign which might be protected under copyright, cf. *Springender Pudel* (2015) Federal Court of Justice I ZR 59/13, paragraph 60.

¹³¹ Helfer, L., R. and Austin, G. W. (2011) *Human Rights and Intellectual Property: Mapping the Global Interface*, op. cit., p. 305.

¹³² Luepke, M. H. H. (2008) Taking Unfair Advantage or Diluting a Famous Mark - a 20/20 Perspective on the Blurred Differences Between U.S. and E.U. Dilution Law. *Trademark Reporter*, 98(3), p. 818.

of trademark law, but rather depends more on the balancing of the fundamental rights at stake.¹³³

6. IBALGIN – ILLUSTRATIVE TRADEMARK PARODY CASE

In the following section, the results of the German case law analysis will be applied and tested on the illustrative case from the Czech Republic.

As mentioned above, “IbalGIN” was a pink gin produced by the Fruko-Schulz company, which was sold in bottles with a design similar to the “Ibalgin” pain reliever of the SANOFI company. SANOFI owns numerous national trademark registrations, e.g. No. 347191¹³⁴. The Fruko-Schulz company owns the national word mark registration “IBAL”¹³⁵, designated for class 33 (alcoholic beverages), and until 11 October 2023 owned EU RCD of the “IbalGIN” bottle label¹³⁶.

In the spring of 2022, the SANOFI company sued for a preliminary injunction consisting of an obligation to refrain from using the sign “IBALGIN” or any combination of the words “IBAL” and “GIN” put on the bottles of gin in “commercial dealings” and to withdraw the products from the market.¹³⁷ The Municipal Court in Prague upheld the application and ordered a preliminary measure.¹³⁸ The Court of Appeal reversed the decision and dismissed the application for a preliminary injunction.¹³⁹ The Court found that the conditions for a preliminary injunction were not satisfied, as there was no violation of “good morality of competition”, the products and relevant markets were different, and the reputation of SANOFI’s “Ibalgin” trademark had not been declared.¹⁴⁰ Moreover, invalidity procedures were initiated in 2023 for both the “IBAL” trademark and the RCD for the “IbalGIN” bottle label.

¹³³ Cf. Born, Ch. (2006) Zur Zulässigkeit einer humorvollen Markenparodie Anmerkung zum Urteil des BGH „Lila-Postkarte“. *GRUR*, 59 (3), p. 194; see also Kefferpütz, M. and Wrage, A. (2015) Parodie und Marke: Ein ewiger Konflikt. *GRUR-Prax*, 7 (21), p. 453.

¹³⁴ Úřad průmyslového vlastnictví (2024) *Trademark registration No. 347191* [online]. Available from: <https://isdv.upv.gov.cz/webapp/webapp.irepgetsoub?pidr=NkLCXMUndGHKvtNbBCvC> [Accessed 6 April 2024].

¹³⁵ Úřad průmyslového vlastnictví (2024) *Trademark registration No. 348055* [online]. Available from: <https://isdv.upv.gov.cz/webapp/webapp.irepgetsoub?pidr=sjFQrICRrTFpIDzXUAsL> [Accessed 6 April 2024].

¹³⁶ EUIPO (2023) *Design No. 008180582-0001* [online]. Available from: <https://euipo.europa.eu/eSearch/#details/designs/008180582-0001> [Accessed 18 November 2023].

¹³⁷ *SANOFI v. Fruko-Schulz* (2022) Municipal Court Prague 2 Nc 1027/2022 [not published].

¹³⁸ *Ibid.*

¹³⁹ *SANOFI v. Fruko-Schulz* (2022) High Court Prague 3 Cmo 36/2022 [not published].

¹⁴⁰ *Op. cit.*, paragraph 7.

On 30 November 2023, the Municipal Court in Prague discontinued the proceedings because SANOFI had withdrawn the action.¹⁴¹ The out-of-court settlement has been disputed¹⁴² and so the Czech jurisprudence will have to await a decision on trademark parody. The results of the settlement are that the “IBAL” trademark in class 33 is designated to all alcoholic beverages, except gin, juniper, and drinks mixed with/of gin or consisting of juniper, and the RCD for the “IbalGIN” bottle label has been surrendered.

This situation itself proves that the SANOFI company did not enjoy the existence of “IbalGIN” and its associated intellectual property rights (national trademark and the RCD) and successfully negotiated its restriction. As a result, not only the registration of conflicting subject-matters but also their use of non-competing products was minimised, if not prohibited altogether. Notwithstanding this progress, the assessment for the case study might be useful, especially if the opportunity for a proper judicial statement on trademark parody was missed by the Czech court in this case.

6.1. PARODY DEFINITION TEST

As the CJEU stated, parody is an autonomous term of EU law. As there is no other definition of parody in Czech law, first, the characteristics provided by the CJEU shall be tested. In the German *Springender Pudel*¹⁴³ case, the court applied the CJEU’s *Deckmyn* definition of parody on trademark parody. There is no relevant reason why the copyright legal definition should not be applied in the trademark law.

Firstly, most Czechs would associate “IbalGIN” with the “Ibalgin” medicine. Not only because of the text but also because of the design of the bottle label. The phonetic similarity as well as the similar colours encourages this finding. As such, “IbalGIN” evokes an original (already existing) “Ibalgin” trademark.

Secondly, “IbalGIN” may be seen as humorous. In this context, the humour may lie in the fact that, instead of taking painkillers, you would take alcohol, which could also relieve your pain. As Fruko-Schulz’s director points out, “Originally it [the production of IbalGIN – author’s note] was

¹⁴¹ *SANOFI v. Fruko-Schulz* (2023) Municipal Court Prague 2 Cm 15/2022 [not published].

¹⁴² The Financial Statement of Fruko-Schulz s. r. o. of 20 October 2023 [online]. Available from: <https://or.justice.cz/ias/ui/vypis-sl-detail?dokument=78994968&subjektId=56910&spis=415334> [Accessed 16 December 2023], paragraph 15 of the Auditor’s report.

¹⁴³ *Springender Pudel* (2015) Federal Court of Justice I ZR 59/13, paragraph 59.

just a joke”¹⁴⁴. However, there is no further criticism, caricature or satire in the “IbalGIN” sign.

The third factor is fulfilled when the later mark is noticeably different from the earlier mark. In this case, there is a difference in the categories of goods and in the composition (design) of products. The emphasis here is on the “gin” part of the later sign. Although the signs themselves are similar, the overall impression leaves no doubt as to the difference between the two products and the marks in question.

It can therefore be said that “IbalGIN” constitutes a parody of the “Ibalgin” trademark.

In the *Deckmyn* case, the CJEU also held that the interests of both parties should be balanced when determining parody, considering all relevant circumstances. In the present case, on the one hand, there is a pharmaceutical company with its painkiller medicine, which is one of the best-selling medicines in the Czech Republic.¹⁴⁵ In this sense, SANOFI certainly sought to protect its property interests in pharmaceutical sales and to preserve the reputation of “Ibalgin” trademark. On the other hand, there is a distillery and alcohol producer whose new product was deliberately named after the famous medicine.¹⁴⁶ Such an interest is undoubtedly commercial, aimed at increasing income by creating a humorous link with a reputed trademark.

According to the findings of the German courts in the *eiPott*¹⁴⁷, *Springender Pudle*¹⁴⁸ and *British Hairways*¹⁴⁹ cases, same as of the CJEU’s *Polo/Lauren*¹⁵⁰ case, it might be concluded that “IbalGIN” has no comment or criticism and so there is a purely commercial interest based on benefiting from the reputation of “Ibalgin” trademark and its distinctive character. The registration of the “IBAL” trademark for alcoholic beverages in 2015 declares

¹⁴⁴ Bělský, M. (2021) IbalGin zaujal, při covidu jsme posílili ve východní Asii, říká šéf likérky [in press] Submitted to: *iDNES.cz*. Available from: https://www.idnes.cz/ceske-budejovice/zpravy/nejedly-rum-fruko-schulz-jindrichuv-hradec-ibalgin.A210831_142304_budejovice-zpravy_pkr [Accessed 9 October 2022]; author’s own translation.

¹⁴⁵ Plíhalová, M. (2016) Zentiva v Praze vyrábí už 85 let. Češi jsou zvyklí na růžový Ibalgin, Francouzům stačí bílý. [in press] Submitted to: *Hospodářské noviny* Available from: <https://domaci.hn.cz/cl-65135800-zentiva-v-praze-vyrabi-uz-85-let-cesi-jsou-zvykli-na-ruzovy-ibalgin-francouzum-staci-bily> [Accessed 9 October 2022].

¹⁴⁶ Bělský, M. (2021) IbalGin zaujal, při covidu jsme posílili ve východní Asii, říká šéf likérky [in press] Submitted to: *iDNES.cz*. Available from: https://www.idnes.cz/ceske-budejovice/zpravy/nejedly-rum-fruko-schulz-jindrichuv-hradec-ibalgin.A210831_142304_budejovice-zpravy_pkr [Accessed 9 October 2022].

¹⁴⁷ *eiPott* (2010) Hamburg Appeal Court 5 W 84/2010.

¹⁴⁸ *Springender Pudle* (2015) Federal Court of Justice I ZR 59/13.

¹⁴⁹ *British Hairways* (2022) Federal Patent Court of Germany 30 W (pat) 15/19.

¹⁵⁰ Judgment of 18 September 2014, *The Polo/Lauren Company, LP v. OHIM, T-265/13*, EU:T:2014:779.

the intention to produce “IbalGIN” as a long-term business plan. “IbalGIN” would probably not be protected by freedom of expression.

6.2. TRADEMARK INFRINGEMENT DETERMINATION

Even if “IbalGIN” is found to be a parody, it is necessary to examine the infringement of the trademark by dilution. First of all, it should be noted that the “Ibalgin” trademark is, from this author’s point of view, a reputed trademark in the Czech Republic. It is likely to meet both the quantitative and qualitative thresholds for establishing reputation. “Ibalgin” is a medicine sold without a doctor’s prescription and has been produced in the Czech Republic for decades. Almost every citizen of the Czech Republic has come across the “Ibalgin” trademark in search of pain relief.¹⁵¹ Therefore, it can be concluded that “Ibalgin” is known by the relevant public in the Czech Republic.

The likelihood of a confusion test would not be very helpful in this case. Undoubtedly, there could be an association and link between the contested signs, however, there would be no confusion as to their sources, pharmaceutical company against distillery company. “IbalGIN” is not a product under SANOFI’s original trademark. There is also no similarity between the categories of products.

The dilution test, which is covered by Sec. 8(2)(c) of the Czech Trademark Act, applies to the protection of reputed trademarks. The first requirement is to prevent unfair advantage from being taken of the distinctive character. According to the CJEU, this is riding “on the coat-tails” of the highly distinctive reputed trademark to “benefit from its power of attraction, its reputation and its prestige, and to exploit, without paying any financial compensation and without being required to make efforts of his own”¹⁵², i.e. a purely commercial activity based on bearing the fruit of someone else’s efforts.

The director of Fruko-Schulz explicitly admitted that “IbalGIN” “alludes to popular painkillers. Gin even has a typical pink colour which alludes to the pills.”¹⁵³ The intention to ride on the coattails of the “Ibalgin’s”

¹⁵¹ Cf. e.g. Barochová, P. (2012) VIDEO: Jak vzniká růžová pilulka, kterou užívají miliony Čechů. [in press]. Submitted to: *iDNES.cz*. Available from: https://www.idnes.cz/onadnes/zdravi/jak-se-vyrabi-ibalgin.A121112_230900_zdravi_pet [Accessed 7 December 2023].

¹⁵² Judgement of 18 June 2009, *L’Oreal SA v. Bellure NV*, C-487/07, EU:C:2009:378, paragraph 49.

¹⁵³ Bělský, M. (2021) IbalGin zaujal, při covidu jsme posílili ve východní Asii, říká šéf líkérky [in press] Submitted to: *iDNES.cz*. Available from: https://www.idnes.cz/ceske-budejovice/zpravy/nejedly-rum-fruko-schulz-jindrichuv-hradec-ibalgin.A210831_142304_budejovice-zpravy_pkr [Accessed 9 October 2022]; author’s own translation.

fame is clear from this statement. Consequently, the marketing effort was reduced to a minimum because there was no need to sell an ordinary pink gin. Therefore, on the basis of these findings, the use of “IbalGIN” could be considered to be an unfair advantage.

The second requirement concerns detriment to the distinctive character or the reputation of the earlier reputed mark. To prove a detriment to the distinctive character of the earlier mark it “requires evidence of a change in the economic behaviour of the average consumer of the goods or services for which the earlier mark was registered consequent on the use of the later mark or a serious likelihood that such a change will occur in the future.”¹⁵⁴ Although Fruko-Schulz’s sales have increased with the new “IbalGIN” product¹⁵⁵, this is a change in the economic behaviour of alcohol consumers, not (primarily) drug consumers. It cannot be assumed that consumers will start buying pink gin instead of pain relievers. Consequently, according to this finding, the simple use of the parodic sign “IbalGIN” should not be prohibited.

To summarize, “Ibalgin” is a trademark with a reputation in the Czech Republic. Although there is no public survey on the recognition of “Ibalgin”, given its historical use in the Czech Republic, it can be assumed that it is recognized by a substantial part of the public in the Czech Republic. On the one hand, it is unlikely that the use of the reputed trademark “Ibalgin” would be found to be detrimental to its reputation. On the other hand, the use of “IbalGIN” would undoubtedly take unfair advantage of the distinctive character and reputation of “Ibalgin”. There is clear evidence of an intention to create a new product and to attract consumers to buy it by riding on the coattails of “Ibalgin’s” reputation. The registration of the “IBAL” word mark in 2015 supports the finding of a long-term business plan (“IbalGIN” was launched in 2020).

7. CONCLUSION

Parody is a form of humorous expression, generally protected by the freedom of expression granted in any democratic society. Its primary aim is to amuse recipients. Occasionally, the joke might be made at the expense of the rights

¹⁵⁴ Judgement of 27 November 2008, Intel Corporation Inc. v. CPM United Kingdom Ltd, C-252/07, EU:C:2008:655, paragraph 77.

¹⁵⁵ “I think people like it, which is proven by the sales statistics. I’m [the director of Fruko-Schulz – author’s note] very happy with it and its popularity is also evident in many supermarket chains that take it from us in a bulk.” Bělský, M. (2021) IbalGin zaujal, při covidu jsme posílili ve východní Asii, říká šéf likérky [in press] Submitted to: *iDNES.cz*. Available from: https://www.idnes.cz/ceske-budejovice/zpravy/nejedly-rum-fruko-schulz-jindrichuv-hradec-ibalgin.A210831_142304_budejovice-zpravy_pkr [Accessed 9 October 2022]; author’s own translation.

of others. Parody is specifically treated in intellectual property law, in copyright law, respectively, in the form of statutory exception to copyright. The law enables copyrighted works to be used for parody if the requirements of the three-step test are met. Trademark law, however, treats parody differently.

By combining the CJEU's general approaches to trademark infringement (concerning the likelihood of confusion and the determination of dilution) with the analysis of landmark trademark parody cases in Germany, the overall perspective for dealing with parodic signs was introduced and tested on the illustrative case from the Czech Republic.

Based on the above, it can be concluded that when a parodic trademark is created (and meets the basic characteristics of parody), the crucial elements in determining its legality are whether it makes some statement about the original trademark or adds some point to the public discussion and how much commercial interest, or benefit is associated with the parodic mark. If there is some kind of statement, the commercial benefit plays a lesser role in the decision and the possibility of protection by freedom of expression is more likely. On the other hand, if there is no such statement, the assessment would be interpreted as taking advantage of the distinctive character of the original trademark, as was already declared by the CJEU in the *Polo/Lauren* case.

Taking into account the preceding, it will be interesting to see how the CJEU deals with the issue of parody as a "due cause" for the non-consenting use of a trademark and the appreciation of freedom of expression in this matter.

From this author's point of view and the given perspective, the freedom of expression could be understood as "due cause". In the first place, it would depend on the assessment of the extent to which the expression is of public interest is socially relevant or opens a debate. Secondly, the extent to which the expression has a commercial character or purpose would play a decisive role. If the former is marginal, the latter would prevail and the non-consent use *in the course of trade* should be prohibited.

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