



**REPORT FOR THE HEARING**  
in Case E-5/16

REQUEST to the Court pursuant to Article 34 of the Agreement between the EFTA States on the Establishment of a Surveillance Authority and a Court of Justice by the Norwegian Board of Appeal for Industrial Property Rights (*Klagenemnda for industrielle rettigheter*), in the case of

**Municipality of Oslo (*Oslo kommune*)**

concerning the interpretation of Directive 2008/95/EC to approximate the laws of the Member States relating to trade marks, and in particular Article 3(1)(b) to (f) thereof.

**I Introduction**

1. By a letter dated 22 March 2016, registered at the Court as Case E-5/16 on 31 March 2016, the Norwegian Board of Appeal for Industrial Property Rights (*Klagenemnda for industrielle rettigheter*; “The Board of Appeal”) requested an Advisory Opinion in the case pending before it.

2. The case before the Board of Appeal concerns an appeal from the Municipality of Oslo (“the Municipality”) against a decision by the Norwegian Industrial Property Office (“NIPO”) of 5 August 2014. By way of this decision, the NIPO rejected applications for trade marks consisting of or including works of art by the Norwegian sculptor Gustav Vigeland, such as the sculptures “The Angry Boy” (*Sinnataggen*) and “The Monolith” (*Monolitten*). The trade mark applications were submitted by the Municipality, which manages Vigeland’s rights.

**II Legal background**

*EEA law*

3. Directive 2008/95/EC of the European Parliament and of the Council of 22 October 2008 to approximate the laws of the Member States relating to trade marks (OJ 2008 L 299, p. 25 and EEA Supplement 2011 No 40, p. 1 (Icelandic) and 2015 No 3, p. 342 (Norwegian)) (“the Directive”) was made part of the EEA Agreement by Joint Committee Decision No 146/2009 of 4 December 2009 (OJ 2010 L 62, p. 43, and EEA Supplement 2010 No 12, p. 42) (“Decision No 146/2009”). It is referred to at point 9h of Annex XVII (Intellectual Property) to the EEA

Agreement. No constitutional requirements were indicated for the purpose of Article 103 of the EEA Agreement. Consequently, the decision entered into force on 5 December 2009, and the time limit for the EFTA States to implement the Directive expired on the same date.

4. According to point 9h of Annex XVII to the EEA Agreement, the provisions of the Directive shall, for the purposes of the EEA Agreement, be read with the following adaptations:

*(a) in Article 3(2), the term “trade mark law” shall be understood to be the trade mark law applicable in a Contracting Party;*

...

5. Recital 7 of the Directive reads:

*This Directive should not exclude the application to trade marks of provisions of law of the Member States other than trade mark law, such as the provisions relating to unfair competition, civil liability or consumer protection.*

6. Article 2 of the Directive reads:

*A trade mark may consist of any signs capable of being represented graphically, particularly words, including personal names, designs, letters, numerals, the shape of goods or of their packaging, provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings.*

7. Article 3(1) of the Directive includes the following grounds for refusal or invalidity:

*1. The following shall not be registered or, if registered, shall be liable to be declared invalid:*

...

*(b) trade marks which are devoid of any distinctive character;*

*(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, or the time of production of the goods or of rendering of the service, or other characteristics of the goods or services;*

...

*(e) signs which consist exclusively of:*

*(i) the shape which results from the nature of the goods themselves;*

*(ii) the shape of goods which is necessary to obtain a technical result;*

*(iii) the shape which gives substantial value to the goods;*

*(f) trade marks which are contrary to public policy or to accepted principles of morality;*

...

8. Article 3(2) of the Directive reads, in extract, as follows:

*2. Any Member State may provide that a trade mark shall not be registered or, if registered, shall be liable to be declared invalid where and to the extent that:*

*(a) the use of that trade mark may be prohibited pursuant to provisions of law other than trade mark law of the Member State concerned or of the Community;*

...

*(d) the application for registration of the trade mark was made in bad faith by the applicant.*

9. Article 3(3) of the Directive reads as follows:

*3. A trade mark shall not be refused registration or be declared invalid in accordance with paragraph 1(b), (c) or (d) if, before the date of application for registration and following the use which has been made of it, it has acquired a distinctive character. Any Member State may in addition provide that this provision shall also apply where the distinctive character was acquired after the date of application for registration or after the date of registration.*

10. Article 4(4)(c)(iii) of the Directive reads as follows:

*4. Any Member State may, in addition, provide that a trade mark shall not be registered or, if registered, shall be liable to be declared invalid where, and to the extent that:*

...

*(c) the use of the trade mark may be prohibited by virtue of an earlier right other than the rights referred to in paragraph 2 and point (b) of this paragraph and in particular:*

...

*(iii) a copyright;*

...

11. Directive 2006/116/EC of the European Parliament and the Council of 12 December 2006 on the term of protection of copyright and certain related rights (OJ 2006 L 372, p. 12 and EEA Supplement 2009 No 25, p. 278 (Icelandic) and 2010 No 38, p. 150 (Norwegian)) was made part of the EEA Agreement by Joint Committee Decision No 56/2007 of 8 June 2007 (OJ 2007 L 266, p. 17, and EEA Supplement 2007 No 48, p. 13), and is referred to at point 9f of Annex XVII (Intellectual Property) to the EEA Agreement. No constitutional requirements were indicated for the purpose of Article 103 of the EEA Agreement. Consequently, the decision entered into force on 9 June 2007, and the time limit for the EFTA States to implement the Directive expired on the same date.

12. Article 1(1) of Directive 2006/116/EC reads as follows:

*1. The rights of an author of a literary or artistic work within the meaning of Article 2 of the Berne Convention shall run for the life of the author and for 70 years after his death, irrespective of the date when the work is lawfully made available to the public.*

*National law*<sup>1</sup>

13. The Directive was implemented in Norway by Act No 8 of 26 March 2010 on protection of trademarks (the Trade Marks Act) and Regulation of 25 June 2010 No 937 (the Trade Marks Regulation).

14. Section 2 second paragraph of the Trade Marks Act reads:

*Trademark rights may not be attained for signs that consist exclusively of a shape that results from the nature of the goods themselves, is necessary to obtain a technical result or adds substantial value to the goods.*

15. Section 14 first paragraph second sentence reads:

*[In order to be registered, a trademark] must have a distinctive character as a token for the kind of goods or services it represents.*

16. Section 14 second paragraph (a) of the Trade Marks Act reads:

*A trademark may not be registered if it exclusively or subject to only minor changes or additions consists of signs or indications that serve to ...*

*a) designate the kind, quality, quantity, purpose, value or geographical origin, ... or other characteristics of the goods or services, ...*

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<sup>1</sup> Translations of national provisions are unofficial.

17. Section 15 first paragraph (a) of the Trade Marks Act reads:

*A trade mark cannot be registered if it:*

*a) is contrary to law, public order or accepted principles of morality;*

...

### III Facts and procedure

#### *Background*

18. In view of the actual or imminent lapse of intellectual property protection for copyright protected works by some Norwegian artists, the Municipality, which manages several of these rights, applied for trade mark protection of a number of artworks that will become freely available under the Norwegian Copyright Act. As regards the work of Gustav Vigeland, the Municipality applied for trade mark protection with regard to several artworks. The following works of art are mentioned in the request as examples:

19. “The Angry Boy” (*Sinnataggen*) by Gustav Vigeland:



20. Cast iron gate by Gustav Vigeland:



21. Section of cast iron gate by Gustav Vigeland:



22. The statute “Egil Skallagrimsson” by Gustav Vigeland:



23. “The Monolith” (*Monolitten*) by Gustav Vigeland:



24. A sculpture by Gustav Vigeland:



*The dispute before the Board of Appeal*

25. In the case at hand, the Board of Appeal is called upon to decide on the appeals brought by the Municipality against NIPO's refusal to register certain trade marks. The refusals to register the trade marks were based, respectively, on Section 14 first paragraph of the Trade Marks Act on lack of distinctive character, Section 14 second paragraph (a) of the Trade Marks Act on descriptive marks and Section 2 second paragraph third alternative of the Trade Marks Act on trade marks that consist of a shape that adds substantial value to the goods. With regard to some of the trade marks, registration was granted for certain types of goods and services.

26. The Board of Appeal takes the view that, in addition to the grounds considered by NIPO, other grounds may exist on which to refuse the registration of the trade marks. In particular, the Board of Appeal considers that the rule in Section 15 first paragraph (a) of the Trade Marks Act, which implements Article 3(1)(f) of the Directive, may be applicable.

27. The Board of Appeal questions whether the decision of the German Federal Patent Court in the *Mona Lisa* case<sup>2</sup> should set a precedent in European law. According to the Board of Appeal, if trademark protection of well-known works of art can only be refused on grounds of lack of distinctiveness, this leaves open the possibility for distinctiveness to be achieved through use thus qualifying the work for registration at a later stage. Consequently, any undertaking could, in principle, achieve trademark protection for copyright works that become freely available, regardless of the cultural value of such works.

28. The Board of Appeal also refers to the Opinion of Advocate General Ruiz-Járabo Colomer in *Shield Mark* who found "it more difficult to accept ... that a

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<sup>2</sup> Reference is made to the Decision of 25 November 1997 of the German Federal Patent Court (*Bundespatentgericht*) in Case 24 W (pat) 188/96, GRUR 1998, p. 1021 ("*Mona Lisa*").

creation of the mind which forms part of the universal cultural heritage, should be appropriated indefinitely by a person to be used on the market in order to distinguish the goods he produces or the services he provides with an exclusivity which not even its author's estate enjoys".<sup>3</sup> In this regard the Board of Appeal questions whether that view of Advocate General Ruiz-Járabo Colomer could have a bearing on the application of Article 3(1)(f) of the Directive.

#### IV Questions

29. The following questions have been referred to the Court:

**1. May trade mark registration of copyright works, for which the protection period has expired, under certain circumstances, conflict with the prohibition in Article 3(1)(f) of the Trade Marks Directive on registering trade marks that are contrary to 'public policy or ... accepted principles of morality'?**

**2. If Question 1 is answered in the affirmative, will it have an impact on the assessment that the copyright work is well-known and of great cultural value?**

**3. If Question 1 is answered in the affirmative, may factors or criteria other than those mentioned in Question 2 have a bearing on the assessment, and, if so, which ones?**

**4. Is Article 3(1)(e)(iii) of Directive 2008/95/EC applicable to two-dimensional representations of sculptures?**

**5. Is Article 3(1)(c) of Directive 2008/95/EC applicable as legal authority for refusing trade marks that are two or three-dimensional representations of the shape or appearance of the goods?**

**6. If Question 5 is answered in the affirmative, is Article 3(1)(b) and (c) of Directive 2008/95/EC to be understood to mean that the national registration authority, in assessing trade marks that consist of two or three-dimensional representations of the shape or appearance of the goods, must apply the assessment criterion of whether the design in question departs significantly from the norm or customs of the business sector, or may the grounds for refusal be that such a mark is descriptive of the shape or appearance of the goods?**

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<sup>3</sup> Reference is made to Opinion of Advocate General Ruiz-Járabo Colomer in *Shield Mark*, C-283/01, EU:C:2003:197, point 52.



## **V Written observations**

30. Pursuant to Article 20 of the Statute of the Court and Article 97 of the Rules of Procedure, written observations have been received from:

- the Municipality, represented by Felix Reimers and Vincent Tsang, advocates;
- the Norwegian Government, represented Ida Thue, advocate, Office of the Attorney General (Civil Affairs), and Linn Edvartsen, Senior Adviser, Ministry of Foreign Affairs, acting as Agents;
- the EFTA Surveillance Authority (“ESA”), represented by Carsten Zatschler, Øyvind Bø and Marlene Lie Hakkebo, members of its Department of Legal & Executive Affairs, acting as Agents;
- the European Commission (the “Commission”), represented by Julie Samnadda and Tibor Scharf, members of its Legal Service, acting as Agents;
- the German Government, represented by Thomas Henze and Mathias Hellman, acting as Agents;
- the Czech Government, represented by Lucie Březinová and Jiří Vláčil, Ministry of Foreign Affairs, acting as Agents; and
- the United Kingdom Government, represented by Julia Kraehling, Cabinet Office European Law Division, Treasury Solicitor’s Department, acting as Agent, and by Nicholas Thomas Saunders, Barrister.

## **VI Summary of the arguments submitted and answers proposed**

### *The Municipality*

31. At the outset, the Municipality considers that works of art may, in principle, be registered as trade marks, whether or not their copyright protection has lapsed. The legal protection pursuant to the trade mark regime is different to that under the copyright regime and the lapse of protection of under one regime should not affect protection under the other.

32. The case at issue concerns shapes that are unique and well suited to distinguish goods and services of different commercial providers. All of the shapes have been exclusively connected to, and used by or through, the Municipality since the death of Gustav Vigeland in 1943. Many of these shapes are well known and valuable, in particular, due to the efforts and investments made by the Municipality.

33. With regard to the first question, the Municipality maintains that it follows from the wording of Article 3(1)(f) of the Directive that this provision seeks to prevent the registration of “trade marks which are contrary to public policy or to accepted principles of morality”. However, the present case does not concern a trade mark which is claimed in itself to be “contrary to public policy”. It is merely the registration of the trade mark which is allegedly contrary to “public policy”. An interpretation of Article 3(1)(f) of the Directive such as to encompass situations where it is not the shape and content of the mark that are contrary to public policy would expand the provision’s wording and is not supported by its purpose. According to the Municipality, the matter for assessment must be “the sign itself”.<sup>4</sup>

34. Moreover, the Municipality claims that an application of Article 3(1)(f) of the Directive that excludes copyright protected shapes from protection under the trade mark regime after the copyright protection has lapsed is inapplicable and also appears meaningless.<sup>5</sup> Rather, in its view, protection afforded under the trade mark regime should be based on whether the shape is capable of distinguishing the goods and services of one undertaking from those of another, irrespective of whether the shapes are also pieces of art and any lapse of copyright protection.

35. As regards the second question, the Municipality rejects an application of Article 3(1)(f) of the Directive which excludes the possibility to obtain trade mark rights based on the fact that the work of art is well-known and of great cultural value. An application of that kind would raise difficulties related to the assessment of a work’s fame, including the grounds on which such an assessment is based and the assessment of how and when its fame was established.

36. Furthermore, the Municipality seeks to distinguish the case at hand from *Shield Mark*,<sup>6</sup> as the present case concerns an entity specifically chosen by the artist, Gustav Vigeland, to administer and safeguard his artistic reputation and memory. It contends that the efforts of the Municipality have been a significant factor in ensuring that several of the shapes covered by the trade mark applications in the present case are well known. The shapes in question are exclusively connected to the Municipality and there are no other entities that have justifiable interests in the commercial exploitation of these shapes. Therefore, according to the Municipality, the second question should be answered in the negative.

37. Turning to the third question, the Municipality submits that the assessment should also take account of the underlying reasons for the cultural and commercial

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<sup>4</sup> Reference is made to the judgment in *INTERTOPS*, T-140/02, EU:T:2005:312, paragraphs 32 and 33; Office for Harmonization in the Internal Market (“OHIM”), *Guidelines for Examination in the Office for Harmonization in the Internal Market*, Part B, Section 4 on Absolute Grounds for Refusal; and Ulrika Wennersten, *Immaterialrätt och skydd av samhällsideal* (2014).

<sup>5</sup> Reference is made to Annette Kur, *Too pretty to protect? Trade Mark Law and the Enigma of Aesthetic Functionality*, Max Planck Institute for Intellectual Property & Competition Law Research Paper No. 11-16.

<sup>6</sup> Reference is made to the Opinion of Advocate General Ruiz-Járabo Colomer in *Shield Mark*, cited above.

value and fame of the work of art in question. Thus, it should be assessed whether the value and fame of the work are related to characteristics and qualities of the artwork alone, or if the value and renown may be attributed to investments and efforts made by the Municipality.

38. Furthermore, the Municipality submits that the assessment pursuant to Article 3(1)(f) of the Directive must also take into account whether the shape in question is merely known as a work of art or is considered an identity bearer of one trader. The latter makes it possible to distinguish goods and services from this trader in relation to those of other traders.

39. As regards the fourth question, the Municipality argues that neither the wording nor the history of Article 3(1)(e)(iii) of the Directive supports an interpretation of that provision that covers not only three-dimensional shapes but also images of shapes.

40. With regard to the fifth question, the Municipality contends that, pursuant to Article 2 of the Directive, the shape of a product is in principle eligible for registration as long as the shape is distinctive. Thus, a refusal to register a trade mark pursuant to Article 3(1)(c) of the Directive cannot be based on the mere fact that the trade mark in question is shaped as a product covered by the classes in respect of which the application is made. Consequently, a refusal to register trade marks shaped as products covered by the classes for which the application is made may only be based on Article 3(1)(c) of the Directive where the shape in question does not significantly depart from the norm or customs of the business sector concerned.

41. Turning to the sixth question, the Municipality contends that, pursuant to the wording of Article 2 of the Directive, the shape of a product is in principle eligible for registration as long as it is “capable of distinguishing the goods or services of one undertaking from those of other undertakings”.<sup>7</sup> The grounds for refusal specified in Article 3(1)(b) and (c) of the Directive should be reserved for common shapes that do not depart significantly from the norm or customs of the business sector concerned, e.g. a heart shape for jewellery. In its view, the strict practice established by the Norwegian trade mark authorities contravenes Article 2 of the Directive.<sup>8</sup>

42. The Municipality does not propose any specific answers to the questions referred.

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<sup>7</sup> Reference is made to the judgment in *Voss of Norway*, C-445/13 P, EU:C:2015:303, paragraph 81 and the case law cited.

<sup>8</sup> Reference is made to the OHIM Board of Appeal decision of 25 April 2016 in Case VM 15/112 (*Legofigur (3D-merke)*) and to the judgment in *Best-Lock (Europe) Ltd v OHIM (Lego Juris)*, T-395/14, EU:T:2015:380.

## *The Norwegian Government*

### Admissibility

43. The Norwegian Government submits that the questions from the Board of Appeal should be dismissed as inadmissible, as the Board of Appeal fails to meet the criteria for qualification as a “court or tribunal” for the purposes of Article 34 of the Agreement between the EFTA States on the Establishment of a Surveillance Authority and a Court of Justice (“SCA”), in particular, the criterion of “independence”.<sup>9</sup>

44. The Norwegian Government submits that the president and vice president of the Board of Appeal are appointed by the King in the Council of State. The other members are appointed by the Ministry of Trade, Industry and Fisheries for a period of up to 5 years. It is possible to renew their term. The competence to dismiss the members of the Board of Appeal lies with the appointing authorities. There are no specific procedures for the dismissal of the members of the Board of Appeal, other than the general rules of administrative law and employment law, which apply in the event of an unlawful dismissal. Further, the Board of Appeal has the status of a defendant in the event of an appeal against its decision before the ordinary courts in Norway. Consequently, the Board of Appeal is in a comparable situation to the *Teleklagenævnet*, which the Court of Justice of the European Union (“ECJ”) considered to not fulfil the criterion of independence.<sup>10</sup>

45. As a result, the Government of Norway concludes that the Board of Appeal does not meet the criterion of independence, and that the Court does not have jurisdiction to answer the questions referred.

### The questions referred to the Court

46. In the event that the Court concludes that the request is admissible, the Norwegian Government proposes the following answers to the questions referred.

47. With regard to the first question, the Government of Norway states that, under Article 2 of the Directive, any type of sign is in principle eligible for registration as a trade mark; hence, a sign that consists of a work of art is not as such excluded from registration. Further, dual protection under copyright and trade mark law is not prohibited.

48. A sign consisting of a work of art has to fulfil the general registration requirements in Article 3(1) of the Directive in order to be registered as a trade mark. A trade mark cannot be registered if it is devoid of any distinctive character

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<sup>9</sup> Reference is made to the judgments in *RTL Belgium*, C-517/09, EU:C:2010:821, paragraphs 37, 38 and 48; *Torresi*, C-58/13 and C-59/13, EU:C:2014:2088, paragraph 18; and *Wilson*, C-506/04, EU:C:2006:587, paragraphs 53 and 54; and the order in *Pilato*, C-109/07, EU:C:2008:274, paragraph 24.

<sup>10</sup> Reference is made to the judgment in *TDC A/S v Erhvervsstyrelsen (Teleklagenævnet)*, C-222/13, EU:C:2014:2265, paragraphs 28 to 38.

(Article 3(1)(b) of the Directive) or if it consists exclusively of signs or indications which may serve, in trade, to designate characteristics of the goods or service (Article 3(1)(c) of the Directive). The essential function of a trade mark is to guarantee the identity of the origin of the marked product to the consumer by enabling him, without any possibility of confusion, to distinguish the product or service from others which have another origin.<sup>11</sup>

49. The Norwegian Government contends further that, although the requirements are the same, it may be more difficult to substantiate a finding of distinctive character for certain categories of marks, because consumers are not used to perceiving the sign in question as a trade mark.<sup>12</sup> This applies for known works of art, as the mark is likely to be perceived by consumers as the artwork, and not as an indication of commercial origin. The more renowned the artwork is, the more this reasoning applies.

50. Moreover, the specific ground for refusal of shape marks specified in Article 3(1)(e)(iii) of the Directive may be of particular relevance for marks consisting of works of art. The Norwegian Government observes that, in contrast to the grounds specified in Article 3(1)(b) and (c) of the Directive, this ground for refusal cannot be overcome by the mark acquiring a distinctive character.<sup>13</sup>

51. In addition, the Norwegian Government argues that Article 3(1)(e)(iii) of the Directive excludes trade mark protection for marks consisting of the shape of products when that shape gives substantial aesthetic value to the goods.<sup>14</sup> The shape and appearance of figurative works of art may give substantial aesthetic value to goods that can be shaped in the same way as the artwork, and registration as a trade mark may therefore be refused for such goods under Article 3(1)(e)(iii) of the Directive.

52. The public interest underlying Article 3(1)(f) of the Directive is to ensure that signs are not registered which would, when used as a trade mark, be perceived by the relevant public as contrary to public policy or to accepted principles of morality.<sup>15</sup> Thus, the rationale behind the provision is to preclude trade marks from registration which would contravene basic principles and values, such as human rights, or be perceived by the relevant public as going directly against the basic moral norms of society. The basic moral norms and perceptions of the particular country where the registration is sought are relevant, and these perceptions may

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<sup>11</sup> Reference is made to the judgments in *Canon*, C-39/97, EU:C:1998:442, paragraph 28, and *Philips*, C-299/99, EU:C:2002:377, paragraph 30.

<sup>12</sup> Reference is made to judgments in *Linde and Others*, C-53/01 to C-55/01, EU:C:2003:206; and *OHIM v Erpo Möbelwerk GmbH (Das Prinzip der Bequemlichkeit)*, C-64/02 P, EU:C:2004:645, paragraph 34.

<sup>13</sup> Reference is made to the judgment in *Benetton*, C-371/06, EU:C:2007:542, paragraph 28.

<sup>14</sup> Reference is made to the judgment in *Benetton*, cited above.

<sup>15</sup> Reference is made to the judgment in *Couture Tech*, T-232/10, EU:T:2011:498, paragraphs 29 and 50.

change over time. The national registration authorities and courts will have a certain margin of appreciation when applying the provision.

53. Moreover, the Norwegian Government argues that the perception of the average consumer is relevant when carrying out the assessment pursuant to that provision.<sup>16</sup> However, it is not necessary that the moral norms are widespread; basic moral norms considered important by a minority are also entitled to protection.<sup>17</sup> The intrinsic qualities of the trade mark as such, in relation to the goods and services applied for, must be assessed when deciding whether the mark is contrary to public policy or to accepted principles of morality. By contrast, the conduct of the person applying for it, or whether the goods or services can be legally offered, is not relevant.<sup>18</sup>

54. According to the Norwegian Government, the General Court has applied the bar on registration of marks contrary to public policy or accepted principles of morality to marks which would be perceived as “grievously offensive”.<sup>19</sup> In their guidelines, the European Union Intellectual Property Office (“EUIPO”) has indicated that such a bar will be applied to deny registration of marks deemed to support terrorist groups or consist of Nazi symbols, as well as to exclude marks consisting of blasphemous, racist or discriminatory words and phrases.<sup>20</sup>

55. Thus, the Norwegian Government submits that the threshold for denying registration on the basis of Article 3(1)(f) of the Directive is generally high. However, the possibility cannot be excluded that a misappropriation of a work of art may, under certain circumstances, be perceived as so offensive by the national public that Article 3(1)(f) of the Directive will apply.

56. However, the mere fact that a trade mark consists of a work of art which is no longer protected by copyright does not suffice to invoke Article 3(1)(f) of the Directive. Such an interpretation of Article 3(1)(f) would be contrary to Article 4(4)(c)(iii) of the Directive. Rather, it is for the national registration authorities and courts to make an assessment of the current basic principles and moral norms in Norway in order to determine under what circumstances a trade mark registration of a work of art would be regarded as so offensive by the public to justify an application of Article 3(1)(f).

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<sup>16</sup> Reference is made to judgments in *Couture Tech*, cited above, paragraph 51; *PAKI Logistics*, T-526/09, EU:T:2011:564, paragraphs 12, 17 and 18; and *Brainlab AG v OHIM (Curve)*, T-266/13, EU:T:2014:836, paragraph 25.

<sup>17</sup> Reference is made to the judgment in *Couture Tech*, cited above.

<sup>18</sup> Reference is made to the judgment in *INTERTOPS*, cited above, paragraphs 27 and 33.

<sup>19</sup> Reference is made to the judgments in *PAKI Logistics*, cited above, paragraph 12; *Efag Trade Mark Company v OHIM*, T-52/13, EU:T:2013:596; and *Curve*, cited above.

<sup>20</sup> European Union Intellectual Property Office, Guidelines for examination of European Union trade marks (“EUIPO Guidelines”) Part B, Section 4, points 2.7.1. and 2.7.2.

57. Turning to the second question referred, the Norwegian Government submits that the more renowned and culturally significant a work of art is, the higher the probability that the public would be offended by a trade mark registration representing a misappropriation of the work. However, it cannot be presumed, at the outset, that registration of a trade mark consisting of renowned and culturally significant artworks would be regarded as so grievously offensive by the public that the high threshold set for the application of Article 3(1)(f) of the Directive is reached.

58. Furthermore, the Norwegian Government contends that a general application of Article 3(1)(f) to the registration of trade marks consisting of renowned and culturally significant artworks appears contrary to Article 2 and Article 4(4)(c)(iii) of the Directive. Moreover, other grounds of refusal laid down in the Directive, for example Article 3(1)(b) and (c) and Article 3(1)(e)(iii), may safeguard the public interest, in keeping in the public domain renowned and culturally significant works of art, for which copyright protection has expired.

59. Thus, in answer to the second question referred, the Norwegian Government argues that whether a work of art is renowned and of high cultural significance may be of relevance in the assessment under Article 3(1)(f) of the Directive. Nevertheless, these considerations are not sufficient in themselves to support the conclusion that a trade mark registration would be contrary to public policy or accepted principles of morality.

60. As regards the third question, the Norwegian Government is of the opinion that, since no facts other than the renown and cultural significance of the work are referred to in the request. Thus, the Court should not enter into a hypothetical analysis<sup>21</sup> of other facts that could be relevant for the assessment. In any event, it would not be possible to provide an exhaustive account of what facts may be of relevance in any individual case, since each case must be assessed on its own merits.

61. Turning to the fourth question, the Norwegian Government submits that the public interest underlying Article 3(1)(e) of the Directive is to prevent the exclusive and permanent right which a trade mark confers from serving to extend indefinitely the life of other intellectual property rights which the legislature has sought to make subject to limited periods, such as copyright.<sup>22</sup> Thus, the aim is to keep the essential characteristics of particular goods, which are reflected in their shape, in the public domain. Moreover, Article 3(1)(e)(iii) of the Directive excludes trade mark protection for marks consisting of the shape of products, when that shape gives substantial aesthetic value to the goods.<sup>23</sup>

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<sup>21</sup> Reference is made to the judgment in *Shield Mark*, C-283/01, EU:C:2003:641, paragraphs 52 to 54.

<sup>22</sup> Reference is made to the judgment in *Hauck*, C-205/13, EU:C:2014:2233, paragraph 31.

<sup>23</sup> Reference is made to the judgment in *Benetton*, cited above.

62. The Norwegian Government observes that, on the basis of a literal interpretation, Article 3(1)(e)(iii) of the Directive applies only to three-dimensional marks reproducing a shape that is relevant to the goods and services for which registration is sought. In its view, however, Article 3(1)(e)(iii) of the Directive would be easily circumvented, and its aim not fulfilled, if two-dimensional marks which provide faithful and naturalistic depictions of the shape of goods were to be treated differently from three-dimensional reproductions of a shape.

63. Therefore, the Norwegian Government takes the view that two-dimensional marks that exclusively give faithful and naturalistic depictions of a shape relevant to the shape of the goods should be assessed in the same manner as three-dimensional marks reproducing such shape.<sup>24</sup>

64. As regards the fifth question, the Government of Norway submits that the public interest underlying Article 3(1)(b) and (c) of the Directive is to preclude signs that are not capable of fulfilling the origin function. These provisions thereby prevent signs from being registered as trade marks, which are descriptive for characteristics of the goods or services, and signs that should be kept free for all traders to use.<sup>25</sup>

65. Further, the Norwegian Government submits that distinctiveness or descriptiveness must be assessed by reference to the goods and services for which registration is sought and to how the average consumers of those goods and services will perceive the mark.<sup>26</sup>

66. It follows from case law that the prohibition on registration of descriptive marks may be applied to deny registration of marks reproducing the shape or appearance of goods.<sup>27</sup> As is the case under Article 3(1)(b) and Article 3(1)(e)(iii) of the Directive, the assessment under Article 3(1)(c) of the Directive must be the same regardless of whether the mark is in two-dimensional or three-dimensional format.

67. With regard to the sixth question referred, the Norwegian Government maintains that the ECJ has held that the shape or appearance of a mark must depart significantly from the norms and customs in the sector to fulfil the requirement for

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<sup>24</sup> Reference is made to judgments in *Storck*, C-25/05 P, EU:C:2006:422, paragraph 29, and *Louis Vuitton*, C-97/12 P, EU:C:2014:324, paragraph 53.

<sup>25</sup> Reference is made to judgments in *Windsurfing Chiemsee*, C-108/97 and C-109/97, EU:C:1999:230, paragraph 25, *Linde and Others*, cited above, paragraphs 73 and 75, and *OHIM v Wm. Wrigley Jr. Company (Doublemint)*, C-191/01 P, EU:C:2003:579, paragraph 31.

<sup>26</sup> Reference is made to judgments in *Celltech*, C-273/05 P, EU:C:2007:224, and *Gut Springheide*, C-210/96, EU:C:1998:369.

<sup>27</sup> Reference is made to the judgments in *Linde and Others*, cited above, paragraphs 69 and 70; *Nadine Trautwein Rolf Trautwein GbR, Research and Development v OHIM (Representation of a dog)*, T-385/08, EU:T:2010:295; and *Trautwein v OHIM (Representation of a horse)*, T-386/08, EU:T:2010:296.



a distinctive character, as the average consumer is not used to drawing conclusions on the origin of products on the basis of their shape.<sup>28</sup>

68. In this regard, the Norwegian Government argues that the requirement that the mark “departs significantly from the norms and customs” does not establish a new and independent ground for refusal. In fact, this requirement is only an interpretation of the requirement for distinctive character applied to certain types of marks. As regards trade marks consisting of works of art, which are by their nature unique, the question of whether the shape departs significantly from the norms or customs will not be of much guidance in the assessment of distinctiveness, as no relevant norms or customs for comparison exist. Instead, the general distinctiveness requirement will have to be applied. In addition, by virtue of Article 3(1)(c) of the Directive, it must be assessed whether the shape indicated by the mark is descriptive for characteristics of the goods and services.

69. Based on the above considerations, the Norwegian Government submits that the request of the Board of Appeal must be declared inadmissible. In the event that the Court determines that it has jurisdiction, the Government submits that the questions should be answered as follows:

*1. Trade mark registration of works of art, for which the term of protection under copyright has expired, may under certain circumstances conflict with the prohibition in Article 3(1)(f) of Directive 2008/95 on registration of marks being contrary to public policy or to accepted principles of morality, but the mere fact that a mark consists of such a work will not be sufficient for the provision to apply.*

*2. Whether a work of art is renowned or of high cultural significance may be of relevance in the assessment under Article 3(1)(f) of Directive 2008/95, but not as such sufficient to support a conclusion that a trade mark registration would be contrary to public policy or accepted principles of morality.*

*4. Article 3(1)(e) of Directive 2008/95 applies in the same manner to two dimensional marks giving naturalistic depictions of a shape relevant to the goods, as to three-dimensional marks reproducing such shape. Thus, if a mark consists exclusively of a two-dimensional naturalistic depiction of a sculpture which is relevant to the shape of the goods for which trade mark registration is applied, Article 3(1)(e) third indent is applicable if the shape of the sculpture gives substantial value to the goods.*

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<sup>28</sup> Reference is made to judgments in *Procter & Gamble*, C-473/01 P and C-474/01 P, EU:C:2004:260 and *Louis Vuitton*, cited above, paragraphs 54 and 55.

5. Article 3(1)(c) of Directive 2008/95 is applicable as a ground for refusal for marks consisting of two-dimensional or three-dimensional reproductions of the shape or appearance of the goods.

6. For two- or three-dimensional marks reproducing the shape or appearance of products, an assessment of whether the shape or appearance departs significantly from the norms or customs in the sector should be conducted under Article 3(1)(c) of Directive 2008/95 if relevant norms or customs for comparison exists. In addition, trade mark registration shall be refused under Article 3(1)(c) if the mark is descriptive of characteristics of the goods or services.

ESA

Admissibility

70. ESA considers the Board of Appeal competent to refer questions to the EFTA Court, since Article 34 SCA does not call for strict interpretation.<sup>29</sup> In addition, national boards with institutional set ups and procedures comparable to that of the Board of Appeal have already been considered competent to refer questions to the Court.<sup>30</sup>

The questions referred to the Court

71. As a preliminary remark, ESA submits that according to the case law of the ECJ, all grounds for refusal listed in Article 3(1) of the Directive are independent and require separate examination.<sup>31</sup> Likewise, the multiple grounds for refusing registration under Article 3 of the Directive must be interpreted in the light of the respective public interest underlying each of them.<sup>32</sup> Moreover, as the grounds for refusal or invalidity set out in Article 3(1) of the Directive are identical in substance to those of Article 7(1) of Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark (“the Trade Mark Regulation”)<sup>33</sup>, the case law and practice concerning Article 7(1) of the Trade Mark Regulation are of relevance when assessing Article 3(1) of the Directive.<sup>34</sup>

72. With regard to the first question, ESA submits that Article 3(1) of the Directive does not specifically mention as a ground for denying registration the

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<sup>29</sup> Reference is made to Joined Cases E-3/13 and E-20/13 *Fred Olsen and Others v the Norwegian State* [2014] EFTA Ct. Rep. 400, paragraph 59, and Case E-23/13 *Hellenic Capital Market Commission* [2014] EFTA Ct. Rep. 88, paragraph 34 and case law cited.

<sup>30</sup> Reference is made to *Fred Olsen and Others*, cited above, paragraph 72, Case E-1/11 *Dr A* [2011] EFTA Ct. Rep. 484, paragraph 42, and Case E-4/04 *Pedicel AS v Sosial- og helsedirektoratet* [2005] EFTA Ct. Rep. 1, paragraph 21.

<sup>31</sup> Reference is made to the judgment in *Linde and Others*, cited above, paragraph 67.

<sup>32</sup> *Ibid.*, paragraph 71 and case law cited.

<sup>33</sup> OJ 2006 L 372, p. 12.

<sup>34</sup> Reference is made to the judgment in *Strigl*, C-90/11 and C-91/11, EU:C:2012:147, paragraph 19.

fact that a work has been previously protected by copyright. What is more, a copyrighted work may be registered as a trade mark, provided that the right holder consents. Thus, the fact that the protection period has expired cannot in itself lead to the conclusion that registration of that work is precluded. Also, the protection given to trade marks is rather different to copyright protection. Finally, there are a number of examples where works which have fallen into the public domain after the expiry of copyright have been registered as trade marks.<sup>35</sup> However, not every work that has previously been protected by copyright can be registered as a trademark as soon as the protection period has expired.

73. In this regard, ESA submits that, in order to be registered as a trade mark, the work must fulfil the criteria set out in Article 3 of the Directive. In particular, famous works of art which are no longer copyright protected have to fulfil the criterion of distinctiveness pursuant to Article 3(1)(b) of the Directive. In this regard, it could be more difficult to establish distinctiveness for famous works of art which are well-known to consumers as such and which might therefore not easily indicate any commercial origin, as required by the Directive.

74. Moreover, ESA contends, that, by virtue of Article 3(1)(e)(iii) of the Directive, such a work cannot be registered if it consists exclusively of the shape giving a substantial value to the product. This may be the case for many famous works of sculpture as their substantial value necessarily lies in the form itself.<sup>36</sup> In the case at hand, it may be particularly difficult to establish distinctiveness and an indication of commercial origin for some of the works, which include works that are among Norway's most famous artistic works.

75. Before addressing the second question, ESA considers it useful to first clarify the applicable test for denying registration pursuant to Article 3(1)(f) of the Directive. Thus, ESA addresses the third question first.

76. ESA submits that Article 3(1)(f) of the Directive does not define what constitutes "public policy" or "accepted principles of morality". EUIPO considers that the rationale of a provision of this kind is to preclude trade marks from registration where granting a monopoly would "contravene the state of law or would be perceived by the relevant public as going directly against the basic moral norms of society".<sup>37</sup> Further, according to these guidelines, the concept of "public policy" is a reference to EU law applicable in a certain area "which reflect a common understanding on certain basic principles and values, such as human rights".<sup>38</sup> Moreover, the General Court has held that it is necessary to take account not only of the circumstances common to all Member States, but also of the

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<sup>35</sup> Reference is made to S. Dusollier, *A positive status for the public domain*, in Dana Beldiman (ed.), *Innovation, Competition, Collaboration*, Edward Elgar Publishing, 2015, p. 160.

<sup>36</sup> *Ibid.*, p. 162.

<sup>37</sup> EUIPO Guidelines, Part B, Section 4, point 2.7, p. 4.

<sup>38</sup> *Ibid.*

particular circumstances of individual Member States which are likely to influence the perception of the relevant public within those states.<sup>39</sup>

77. ESA submits that the case-law concerning Article 7(1)(f) of the Trade Mark Regulation has not strictly distinguished between the assessment of “public policy” and “accepted principles of morality”. The General Court has held that the provision prevents registration of marks that are racist or discriminatory and therefore contrary to the fundamental values of the Union.<sup>40</sup>

78. Given the specific meaning of “public policy” in the Directive, ESA considers that this concept may be capable of also extending to other legitimate public policies adopted by the EEA States. Typically, the expression would be applicable where the registration of a sign would contravene legislation. It is for the national body to assess whether the registration of a trade mark would be contrary to public policy.

79. The term “accepted principles of morality” is a broad concept. According to the EUIPO Guidelines, the provision of the Trade Mark Regulation and, hence, by extension, Article 3(1)(f) of the Directive excludes the registration of trade marks which contain blasphemous, racist or discriminatory words or phrases which are clearly conveyed by the mark applied for in an unambiguous manner.<sup>41</sup> Its rationale is to preclude assistance to people who wish to further their business aims by means of trade marks that offend certain basic values of civilised society.<sup>42</sup>

80. ESA further submits that the General Court has held that the standard to be applied is that the sign must have a clearly offensive impact on the reasonable consumer with average sensitivity and tolerance thresholds.<sup>43</sup> However, it is not necessary to establish that the applicant wants to insult the public by registering a particular trade mark. It is sufficient that the registered trade mark might be seen as offensive.<sup>44</sup>

81. Therefore, ESA argues that, in order for a trade mark to be contrary to Article 3(1)(f) of the Directive, it must either be contrary to public policy or clearly offensive to a reasonable consumer with average sensitivity.

82. As regards the second question, ESA maintains that the request does not identify any public policy reasons why the registration of a well-known work or a

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<sup>39</sup> Reference is made to the judgment in *Couture Tech*, cited above, paragraph 34.

<sup>40</sup> Reference is made to the judgments in *Couture Tech*, cited above, paragraph 15, and *PAKI Logistics*, cited above, paragraph 21 et seq.

<sup>41</sup> EUIPO Guidelines, Part B, Section 4, point 2.7.2.

<sup>42</sup> Reference is made to the OHIM Board of Appeal decision of 6 July 2006 in Case R 495/2005-G, *Jebaraj Kenneth trading as Screw You*, paragraph 13.

<sup>43</sup> Reference is made to the judgment in *Federico Cortés del Valle López v OHIM (¡Que bueno ye! Hijoputa)*, T-417/10, EU:T:2012:120, paragraph 21.

<sup>44</sup> Reference is made to the judgment in *PAKI Logistics*, cited above, paragraph 21 et seq.

work of great cultural value should be precluded. There appears also to be no provision of EEA law that precludes the registration of formerly copyright-protected works under such circumstances.

83. A desire to ensure the greatest possible public access to works of great cultural value and the objective of preventing the exploitation for commercial purposes of works which are of a defining nature for national identity could serve as public policy grounds for refusing registration should the Court be minded to extend the public policy concept in the specific trade mark context. Such a refusal would, however, have to be limited to an assessment carried out on a case by case basis of the works' cultural value.

84. On the question whether the registration of a work of great cultural value could contradict "accepted principles of morality", this would require, in ESA's view, that it is clearly offensive to the reasonable consumer to register such a work as a trade mark. However, ESA questions whether, in fact, the registration of a work of great cultural value would be able to offend the reasonable consumer of average sensitivity. Although in his Opinion in *Picaro*<sup>45</sup> Advocate General Ruiz-Járabo Colomer appeared to take the position that a general interest exists in protecting the name of great artists, this approach was not followed by the ECJ.<sup>46</sup>

85. In addition, ESA submits that, although the EUIPO Board of Appeal considers there to be circumstances in which it would be contrary to accepted principles of morality to register certain symbols,<sup>47</sup> it has also found that the repute of a work could not prevent its registration as a trade mark.<sup>48</sup>

86. Consequently, ESA takes the view that whether the work is well-known or of great cultural value cannot in itself prevent such works from being registered as trade marks in the absence of a coherent policy to encourage the dissemination of such works. For a work of great cultural value to be denied registration under Article 3(1)(f) of the Directive, a registration of that kind would have to be contrary to public policy or clearly offensive to the reasonable consumer of average sensibility. It is for the Board of Appeal to assess whether this is the case for the works in question.

87. With regard to the fourth and fifth questions, ESA submits that both Article 3(1)(e)(iii) and Article 3(1)(c) apply to two-dimensional and three-dimensional representations of goods such as sculptures, as in certain cases such shapes may

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<sup>45</sup> Reference is made to the Opinion of Advocate General Ruiz-Járabo Colomer in *Ruiz-Picasso and Others v OHIM (Picaro)*, C-361/04 P, EU:C:2005:531.

<sup>46</sup> Reference is made to the judgment in *Ruiz-Picasso and Others v OHIM (Picaro)*, C-361/04 P, EU:C:2006:25.

<sup>47</sup> Reference is made to the OHIM Board of Appeal decision of 17 September 2012 in Case R 2613/2011-2, *Republic of Turkey v Yaqub (ATATURK)*, paragraph 19.

<sup>48</sup> Reference is made to the OHIM Board of Appeal decision of 31 August 2015 in Case R 2401/2014-4, *Anne Frank Fonds (Le Journal d'Anne Frank)*, paragraphs 32 to 34.

consist exclusively of the shape which gives substantial value to the goods or be merely descriptive of the goods or services provided.

88. Turning to the sixth question, ESA contends, with regard to the notion of distinctive character for the purposes of Article 3(1)(b) of the Directive, that the trade mark must serve to identify the goods in respect of which registration is sought.<sup>49</sup> This must be assessed by reference to the relevant public's perception of the mark.<sup>50</sup>

89. As regards Article 3(1)(c) of the Directive, ESA submits that the provision prevents the registration of trade marks which consist of purely descriptive signs that other traders might also want to use.<sup>51</sup>

90. According to ESA, Article 3(1)(b) and Article 3(1)(c) of the Directive are applicable to signs that consist of two-dimensional and three-dimensional representations of the shape or appearance of the goods. Therefore, both the distinctiveness of the sign pursuant to Article 3(1)(b) and the descriptiveness of the sign pursuant to Article 3(1)(c) of the Directive have to be examined before a sign can be registered as a trade mark.

91. Finally, ESA submits that, according to ECJ case law, the examiner first has to assess whether registration would be contrary to Article 3(1)(e) of the Directive. Even if that preliminary obstacle is overcome, neither the wording of Article 3(1) of the Directive nor the scheme of the Directive indicate that the other grounds for refusal, including all the criteria of Article 3(1)(c), should not also apply to applications to register the three-dimensional shape of product marks.<sup>52</sup>

92. Therefore, ESA proposes that the Court should answer the questions as follows:

*1. Article 3(1)(f) does not prevent the registration of signs as trade marks where the sign consists of a work that has been protected by a copyright, but for which the protection period has expired.*

*2. The fact that a sign consists of a work that is well-known or of great cultural value cannot in itself prevent such signs from being registered as a trade mark pursuant to Article 3(1)(f) in the absence of a coherent policy to encourage the dissemination of such works. It can however be a factor in the assessment of whether the registration of such a sign would be offensive to the reasonable consumer of average sensitivity.*

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<sup>49</sup> Reference is made to the judgment in *Audi*, C-398/08 P, EU:C:2010:29, paragraph 33.

<sup>50</sup> *Ibid.*, paragraph 34.

<sup>51</sup> Reference is made to the judgment in *Representation of a dog*, cited above, paragraph 49.

<sup>52</sup> Reference is made to the judgment in *Linde and Others*, cited above, paragraph 66.

3. *The assessment of whether the registration of a trade mark is contrary to “public policy” pursuant to Article 3(1)(f) of the Trade Marks Directive depends on the particular public policy in question. In the assessment of whether the registration of a trade mark is contrary to “accepted principles of morality” pursuant to Article 3(1)(f) of the Directive it is particularly important to consider whether the sign contains blasphemous, racist or discriminatory words or phrases, which are clearly conveyed by the mark applied for in an unambiguous manner, and is clearly offensive to the reasonable consumer with average sensitivity.*

4. *Article 3(1)(e)(iii) and Article 3(1)(c) of the Trade Marks Directive are applicable to two- and three dimensional representations of goods such as sculptures.*

5. *Article 3(1)(b) and Article 3(1)(c) of the Trade Marks Directive are applicable to signs which consists of two- and three dimensional representations of the shape or appearance of the goods, and therefore both the distinctiveness of the sign pursuant to Article 3(1)(b) and the descriptiveness of the sign pursuant to Article 3(1)(c) of the Trade Marks Directive have to be examined before a sign can be registered as a trade mark.*

#### *The Commission*

93. As regards the first three questions, the Commission contends, in accordance with the judgment in *Couture Tech*, that the absolute grounds of refusal laid down in Article 7(1) of the Trade Mark Regulation must be assessed with reference to the average consumer.<sup>53</sup> The relevant public may also be the average consumer in a single Member State.<sup>54</sup> In the case of Article 3(1)(f) of the Directive, an assessment must be made as to how the sign in question is perceived by the average consumer who is a member of the general public in the Member State concerned.

94. According to the Commission, the notions of “contrary to public policy” and “contrary to accepted principles of morality” in Article 3(1)(f) of the Directive must be distinguished. The term “contrary to public policy” may be considered on its own merits and a registration of a trade mark may be held to be “contrary to public policy” without it being offensive on any moral ground as such.

95. Such an interpretation of the phrase “contrary to public policy” allows for the consideration of an economic ground, a ground based on allowing free use of any particular subject matter, as opposed to the grant of an exclusive property right

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<sup>53</sup> Reference is made to the judgment in *Couture Tech*, cited above, paragraph 27.

<sup>54</sup> Reference is made to the judgment in *Couture Tech*, cited above.

in the form of a trade mark, or a cultural ground particular to the Member State concerned.

96. However, according to the Commission, the mere fact that a trade mark consists of, or includes, an artistic work which is protected by copyright law does not justify, in itself, a refusal under the national provision giving effect to Article 3(1)(f) of the Directive. In principle, therefore, a sign may be protected concurrently as a trade mark and under the copyright regime.

97. On a second point, the Commission submits that the primary function of a trade mark is to guarantee the identity of the goods or services designated by the mark. Thus, a trade mark not only enables its proprietor to distinguish himself from his competitors, but also provides a guarantee to the consumer or end-user that all the goods or services covered by the sign, constituting the trade mark, have the same trade origin.

98. Moreover, according to the Commission, the relevant public for the purposes of the assessment by virtue of Article 3(1)(f) of the Directive is the general public that views and appreciates works of art and who may consider such works of art to be part of the national heritage accessible to and useable by all. In its view, in the case of well-known works of art for which copyright protection has expired, the relevant public would have an expectation that goods and services applying the works of art could be produced by any economic operator.

99. The effect of the grant of a trade mark in such circumstances would be to perpetuate exclusive rights over the work of art, which should normally be in the public domain and capable of being freely used by any person including any economic operator in whatever manner.

100. In this regard, the Commission submits that, in relation to shapes, the ECJ's case law establishes that the rationale of absolute grounds of refusal is "to prevent the exclusive and permanent right which a trade mark confers from serving to extend indefinitely the life of other rights which the EU legislature has sought to make subject to limited periods".<sup>55</sup> In its view, this statement of the ECJ should not necessarily be limited to shapes but may be of general application.

101. Moreover, the Commission continues, due regard must be had to the fact that to appropriate a work of art for an indefinite period of time through the registration of a trade mark contradicts the very purpose and logic of the time limits established for copyright. In addition, it would grant the trade mark owner more extensive rights than those enjoyed by the author's estate.<sup>56</sup> Hence, once copyright protection in the work has expired, the work of art should, in the absence of any

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<sup>55</sup> Reference is made to the judgment in *Philips*, cited above, paragraph 78.

<sup>56</sup> Reference is made to the Opinion of Advocate General Ruiz-Járabo Colomer in *Shield Mark*, cited above, points 50 to 52.



other form of protection that applies at that time, be able to be freely used by any person.

102. Further, the Commission argues that the more well-known the work of art is, the more likely the circumstances of the author or artist will be known to the general public. Therefore, the possibility cannot be excluded that the registration as a trade mark could also be considered as the desecration of a work. This may be the case if the work of art in question holds a particular importance in the collective memory and the common cultural heritage as an emblem of sovereignty or of the nation's foundation and values. Therefore, the cultural value of a well-known work of art may also be taken into account.

103. Moreover, the Commission contends that the general public may never identify a work of art as emanating, for example, from a museum unless the name of the museum accompanies the representation of the work of art in the trade mark application.

104. As far as the identity of the trade mark applicant and the nature and type of goods and services are concerned, the Commission submits that, in principle, these factors should usually be irrelevant for the purposes of assessing the public policy dimension.<sup>57</sup> Nevertheless, there may be cases in which the nature of the goods or services applied for can reinforce the public policy considerations for precluding registration where those goods and services appear incompatible with the dignity of the artistic work and the symbol with which this work is associated.

105. Accordingly, the Commission takes the view that there may be circumstances where it would be “contrary to public policy” to proceed to register a trade mark where it includes or consists of a copyright work for which the copyright is about to expire or has expired.

106. In relation to the fourth question, the Commission submits, that the reference to “shape” in Article 3(1)(e)(iii) of the Directive cannot be construed as meaning that the two-dimensional representation of an object, including a sculpture, would necessarily fall outside the scope of application of that provision. In its view, “the shape of goods” refers to their outward appearance that is, their configuration or their contours, and not necessarily to their volume. A two-dimensional sign may therefore represent the “shape” of a product.<sup>58</sup> Moreover, the ECJ takes a cautious approach towards Article 3(1)(e) of the Directive.<sup>59</sup> Thus, Article 3(1)(e)(iii) of the Directive must be interpreted as applying also to two-dimensional representations of objects, such as sculptures.

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<sup>57</sup> Reference is made to judgments in *PAKI Logistics*, cited above, paragraphs 16 to 18 and 34, and *¡Que buenu ye! Hijoputa*, cited above, paragraphs 21 and 26.

<sup>58</sup> Reference is made to the judgment in *Yoshida Metal Industry*, T-331/10, EU:T:2012:220, paragraph 27.

<sup>59</sup> Reference is made to the judgment in *Société des Produits Nestlé*, C-215/14, EU:C:2015:604, paragraphs 36 to 40.

107. As regards the fifth question, the Commission points out that, in its request, the Board of Appeal refers to “two- or three-dimensional representations of the shape or appearance of the goods”. However, according to the Commission, the difficulty in answering the fifth question lies in the fact that the request does not specify the goods and services for which the trade mark application was made.

108. The Commission claims that the public interest aim of Article 3(1)(c) of the Directive is that descriptive signs or indications relating to the characteristics of goods or services in respect of which registration is applied for may be freely used by all. Examination of the descriptive character of a sign requires a determination whether there is a sufficiently direct and concrete link between the sign and the kind, quality, or other characteristic of the goods or services in question as specified in Article 3(1)(c) of the Directive, having regard also to the public interest in keeping descriptive signs, which thus lack distinctiveness, free for the use of all.

109. The Commission submits that, in principle, a work of art does not convey direct and concrete messages, as, by its very nature, art is open to subjective interpretation. A work of art is also by its nature disconnected from products or services for which it may serve in trade within the meaning of Article 3(1)(c) of the Directive.

110. However, the Commission argues that, in the case of a trade mark consisting of, or including, the two-dimensional representation of a sculpture, such a sign could be descriptive in respect of any good or service which has, or would be expected by the public to have, the sculpture or its author as a main object. Thus, such a sign could be descriptive of the content of printed matters such as books (Class 16), of the purpose of arranging of travel tours (Class 39) or cultural activities (Class 41) as classified in the Nice Agreement. In such a case, there could be a genuine interest in allowing third parties to use the sign at issue to indicate to the public the content or purpose of their goods or services.

111. As regards the sixth question, the Commission limits its assessment, in light of its observations made with regard to the fifth question, to Article 3(1)(b) of the Directive. It contends that the previous considerations can be reiterated when applying Article 3(1)(b) of the Directive. Sculptures may coincide *inter alia* with the appearance of works of art of common metal (Class 6) or works of art of precious metal (Class 14) or lithographic works of art, posters and postcards (Class 16).

112. The Commission submits that, according to the case law of the ECJ, “only a mark which departs significantly from the norm or customs of the sector and thereby fulfils its essential function of indicating origin is not devoid of any distinctive character”.<sup>60</sup>

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<sup>60</sup> Reference is made to the judgment in *Storck*, cited above, paragraph 26 and the case law cited.

113. However, the Commission argues that it would be difficult to discern the business sector and the relevant “norm of the sector”, where a sign consists of a three-dimensional work that is work of art and the goods applied for merely reproduce this work of art in order to create a replica which has no utility other than purely ornamental. In these circumstances, the criterion of “departing significantly” appears irrelevant. Moreover, a replica can never depart significantly from the norms because these norms are always defined by reference to the original work of art on which the replica is based.

114. Thus, the Commission argues that in the case at hand a relevant factor is whether the characteristics of a sign are, in the public’s perception, purely attributable to the ornamental and decorative nature of the goods, rather than indicating the commercial origin of these goods. If this is the case, the sign is devoid of any distinctive character and falls within Article 3(1)(b) of the Directive.<sup>61</sup> The ECJ confirmed this view when it held in the context of infringement actions that where “the relevant section of the public views the sign purely as an embellishment, it necessarily does not establish any link with the registered mark”.<sup>62</sup>

115. Therefore, the Commission proposes that the Court should answer the questions referred as follows:

*1. - 3. It may be contrary to public policy within the meaning of Article 3(1)(f) of Directive 2008/95/EC in certain circumstances, to proceed to register a trade mark in respect of a well-known copyright work of art, where the copyright protection in that work has expired or is about to expire. The status of that well known work of art including the cultural status in the perception of the general public for that work of art may be taken into account.*

*4. Article 3(1)(e)(iii) of Directive 2008/95/EC must be interpreted as applying also to two-dimensional representations of object such as sculptures.*

*5. Article 3(1)(c) of Directive 2008/95/EC applies to two- or three-dimensional representations of the shape or appearance of the goods where there exists a sufficiently concrete link between the sign and the kind, quality or any other characteristic within the meaning of that provision having regards to the public interest underlying that provision. Signs consisting of two- or three-dimensional representation of the shape or appearance of the goods should not be considered descriptive and therefore*

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<sup>61</sup> Reference is made to judgments in *EE Ltd*, T-77/14, EU:T:2015:620, paragraphs 44 to 48, and *Glaverbel*, T-36/01, EU:T:2002:245, paragraph 28.

<sup>62</sup> Reference is made to the judgment in *Adidas*, C-408/01, EU:C:2003:582, paragraph 40.

*lack distinctiveness, as a matter of principle, for the sole reason that they coincide with the shape of the goods.*

*6. When applying Article 3(1)(b) of Directive 2008/95/EC to trade marks consisting of two- or three-dimensional representation of artistic works which coincide with the shape or appearance of the goods applied for, whether this shape or appearance departs significantly from the norm of presentation of the goods at issue is not a relevant factor.*

*A relevant factor is whether the characteristics of a sign are, in the general public's perception, purely attributable to the ornamental and decorative nature of the goods at issue, rather than indicating the commercial origin of these goods and thereby is devoid of any distinctive character.*

### *The Czech Government*

116. The Czech Government provides a joint answer to the first three questions. As a preliminary remark, the Czech Government submits that when determining whether the trade mark is contrary to public policy or accepted principles of morality attention should be paid only to the trade mark itself.<sup>63</sup> More specifically, what needs to be considered is the intrinsic quality of the trade mark and not the circumstances relating to the conduct of the person applying for the trade mark.<sup>64</sup> Consequently, the court deciding the case should assess whether the registration of a trade mark, namely the acknowledgement of an exclusive link between the sign and the products and/or services of the applicant, would conflict with public policy or principles of morality as set out in Article 3(1)(f) of the Directive.

117. Further, the Czech Government submits that public policy grounds can only be relied on “if there is a genuine and sufficiently serious threat to a fundamental interest of society and, moreover, those grounds must not serve purely economic ends”.<sup>65</sup> Thus, Article 3(1)(f) of the Directive may only be applied in exceptional circumstances.

118. As regards a famous piece of art, for which the protection period has expired and which forms part of the universal cultural heritage, the Czech Government argues that there is a fundamental interest of society at stake, namely the interest in enabling access to these outstanding creations of the mind for everyone.<sup>66</sup> Moreover, the interest of public accessibility cannot be achieved if an individual

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<sup>63</sup> Reference is made to the judgment in *INTERTOPS*, cited above, paragraph 27.

<sup>64</sup> *Ibid.*, paragraph 28.

<sup>65</sup> Reference is made to the judgment in *VBV – Vorsorgekasse*, C-39/11, EU:C:2012:327, paragraph 29.

<sup>66</sup> Reference is made to the rejection by the Czech Industrial Property Office of a trade mark application in Case No O-98450.

can gain an exclusive right resulting from the registered trade mark.<sup>67</sup> Therefore, trade mark registration of copyright works for which the protection period has expired should be refused on the ground of public policy, in exceptional cases, where there is a fundamental interest of society in leaving certain famous pieces of art available to everyone, such as well-known and outstanding creations of mind that are part of the universal cultural heritage.

119. As regards the fourth question, the Czech Republic submits that a trade mark which is a two-dimensional representation of a sculpture can hardly serve to identify the goods or services covered by that trade mark, as required by the criterion of distinctiveness under Article 3(1)(b) of the Directive.<sup>68</sup> It is more likely that the relevant group of consumers would be tempted to consider the trade mark on the products only as a reproduction of the relevant piece of art.

120. Therefore, the Czech Republic submits that the requirement of distinctiveness as specified in Article 3(1)(b) in connection with Article 3(1)(e)(iii) of the Directive is, in terms of sculptures, not fulfilled.

121. In answer to the fifth question, the Czech Government submits that a sculpture, as a unique result of creativity of an artist, can never be considered a descriptive sign as specified in Article 3(1)(c) of the Directive.

122. The Czech Republic considers that, in light of the answers proposed to the previous questions, it is not necessary to provide an answer to the sixth question.

123. As a final point, the Czech Republic states that its earlier observations on Questions 1 to 6 only concern the mandatory grounds for refusal. For the sake of completeness, it observes that, having regard to the factual circumstances, Article 3(2) of the Directive may also be relevant.

124. Consequently, the Czech Republic proposes that the Court should answer the questions as follows:

*1. - 3. Article 3(1)(f) of the Directive 2008/95 should be read in the way, that in exceptional cases, where there is a fundamental interest of the society on leaving certain very famous pieces of art available to everybody, such as well-known and outstanding creations of mind being part of the universal cultural heritage, the trade mark registration of copyright works, for which the protection period has expired, should be refused on the ground of public policy.*

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<sup>67</sup> Reference is made to the Opinion of Advocate General Ruiz-Járabo Colomer in *Shield Mark*, cited above, points 51 and 52.

<sup>68</sup> Reference is made to the judgment in *Société des Produits Nestlé*, cited above, paragraph 59 et seq.

4. *The requirement of distinctiveness as stated in Article 3(1)(b) in connection with Article 3(1)(e)(iii) of the Directive 2008/95, in terms of sculptures, is not fulfilled.*

5. *A sculpture as a unique result of creativity of an artist can never be considered to be a sign or indication in terms of Article 3(1)(c) of the Directive 2008/95.*

#### *The German Government*

125. The German Government provides an answer only to the first question. It does not consider it necessary to assess the second and third questions, since its answer to the first question is in the negative.

126. As a preliminary point, the German Government notes that the notions of “public policy” and “accepted principles of morality” laid down in Article 3(1)(f) of the Directive are not defined in the Directive and, since this provision is a general clause, require interpretation within the systematic context of the particular regulations in which they appear, while also taking into account the overall purpose of such regulations.

127. The German Government contends that the decision whether a trademark should be excluded from registration on the basis of Article 3(1)(f) of the Directive must always be reached by reference to the goods or services for which trade mark registration is sought, while also giving consideration to the public interest underlying the particular rule. Ultimately, however, it is of no significance that it is impossible to ascertain the specific goods and services for which NIPO refused to grant trademark registration, since the existence of copyright, or expired copyright, is not relevant for the assessment under Article 3(1)(f) of the Directive.

128. Furthermore, the German Government submits that even if a trade mark contravenes a statutory provision, that does not constitute *per se* a violation of public policy, unless the provision in question actually serves to protect public policy. Moreover, the public policy notion applies primarily to signs whose exploitation is expressly prohibited by law.<sup>69</sup> Copyright law does not prohibit a work from being exploited *per se*. Rather it grants the originator various rights over his work and it is incumbent upon the originator to authorise or prohibit the use of his work as a trade mark. This right is also reflected in Article 4(4)(c)(iii) of the Directive.

129. According to the German Government a violation of “accepted principles of morality” could occur if the use of a sign, although not prohibited by a statutory

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<sup>69</sup> Reference is made to the judgments in *PAKI Logistics*, cited above, paragraph 12, and *Couture Tech*, cited above, paragraph 49.

provision, is perceived by the relevant public as being deeply abusive or offensive.<sup>70</sup> However, copyright plays no part in such assessment.

130. Therefore, the German Government contends that registering a copyright work as a trade mark cannot be regarded as a contravention of public policy or accepted principles of morality within the meaning of Article 3(1)(f) of the Directive.

131. Moreover, the German Government submits that once the copyright protection of a work expires, it results in freedom of exploitation. This means that a work can generally be registered as a trade mark by anyone, provided that the other prerequisites for trade mark protection are met. Moreover, were it to be possible always to prevent trade mark usage by citing a contravention of public policy, this would reverse the approach taken by the European Union legislature, namely, that the general public can freely exploit a work once the copyright has expired.

132. Finally, the German Government maintains that third parties can only be prohibited by a trade mark from engaging in the product-related exploitation of a sign for specific goods or services. Thus, access to a work and exploitation of a work *as a work* cannot be impaired by trademark law. Furthermore, the general commercial exploitation of a work is not precluded by registering the work as a trade mark for specific goods or services.

133. Therefore, the German Government proposes the following reply to the request:

*Article 3(1)(f) of Directive 2008/95/EC of the European Parliament and of the Council of 22 October 2008 to approximate the laws of the Member States relating to trade marks should be understood as meaning that a trade mark should not be excluded from registration or, if registered, should not be liable to be declared invalid on the grounds that it includes a work or parts of a work for which the copyright term has expired.*

#### *The Government of the United Kingdom*

134. At the outset, the Government of the United Kingdom argues, as regards the first three questions, that in many cases it will be difficult for an applicant to demonstrate that a well-known work of art is distinctive in a trade mark sense so as to be capable of registration as a trade mark.

135. As regards the possibility to rely on Article 3(1)(f) of the Directive to refuse the registration of a trade mark due to the expiry of previous copyright, the Government of the United Kingdom argues that the legislature could not have intended the law to require the refusal or invalidation of trade marks for all works

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<sup>70</sup> Reference is made to the judgment in *PAKI Logistics*, cited above, paragraph 12.

in which copyright has expired. An overlap between trade marks and copyright is usually unobjectionable.

136. The Government of the United Kingdom submits that the focus must be on the mark itself and not the conduct of the applicant.<sup>71</sup> The question whether or not a sign has previously been subject to copyright is not an intrinsic aspect of the sign for which registration is sought and is therefore irrelevant when assessing compliance with Article 3(1)(f) of the Directive. Accordingly, if there is nothing inherently offensive or immoral encompassed in the mark in the form for which registration is sought, Article 3(1)(f) cannot be relied upon to prevent registration of the trade mark sought. The ECJ's case law provides no existing basis for relying on Article 3(1)(f) to refuse to register a work formerly subject to copyright as a trade mark.<sup>72</sup>

137. As regards the concept of public policy, the Government of the United Kingdom submits that the concept is found throughout European law and commonly appears as an exception enabling Member States to derogate from a rule of EU law by reason of their national situation or fundamental principles. The "public policy" exception in Article 3(1)(f) of the Directive performs a similar function. The notion should be applied restrictively, and although Member States have discretion as to what amounts to "public policy", this is subject to judicial supervision.<sup>73</sup>

138. According to the Government of the United Kingdom, three different situations exist which might trigger the application of Article 3(1)(f) of the Directive: first, trade marks with criminal connotations; second, those with offensive religious connotations; and, third, those which are considered explicit or taboo.

139. Moreover, the Government of the United Kingdom contends that it is unnecessary to stretch the scope of Article 3(1)(f) of the Directive in order to prevent the monopolisation of famous works of art from occurring. It is likely that famous cultural works will fail to satisfy the requirement of distinctiveness in Article 3(1)(b) of the Directive.<sup>74</sup> The ECJ has emphasised on a number of occasions that the essential function of a trade mark is to guarantee the identity of the relevant goods to the consumer by enabling him, without any possibility of confusion, to distinguish the goods from those with another origin.<sup>75</sup> If, however,

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<sup>71</sup> Reference is made to the judgment in *Durferrity v OHIM*, T-224/01, EU:T:2003:107, paragraph 76.

<sup>72</sup> Reference is made to the judgment in *Shield Mark*, cited above.

<sup>73</sup> Reference is made to the judgment in *Bouchereau*, 30/77, EU:C:1977:172, paragraphs 33 to 34.

<sup>74</sup> Reference is made to Annette Kur, Exceptions to Protection Where Copyright and Trademark Overlap: Parodies, News Reporting and Other "Speech" Use of Copyright, General Report, in Jane Ginsburg and June Besek (eds.), *Adjuncts and alternatives to copyright/Régimes complémentaires et concurrentiel au droit d'auteur*. Proceedings of the ALAI Congress June 13-17 2001, ALA-USA, New York 2002, 594, at pp. 600-1; and *Mona Lisa*, cited above.

<sup>75</sup> Reference is made to the judgment in *Société des Produits Nestlé*, cited above, paragraph 14.



the mark were registered in a sphere entirely unrelated to the origin of the mark, distinctiveness may be more likely.<sup>76</sup>

140. Moreover, the Government of the United Kingdom argues that registration may also be denied under the “bad faith” provision pursuant to Article 3(2)(d) of the Directive if registration of marks that are cultural works is sought merely to obtain a monopoly, and not with any intention of using the marks as trade marks.<sup>77</sup>

141. As regards the fourth question, the Government of the United Kingdom submits that Article 3(1)(e) of the Directive is applicable to two-dimensional representations of sculptures, provided that the shape depicted in the representation gives substantial value to the goods.<sup>78</sup>

142. Turning to the fifth question, the Government of the United Kingdom submits, at the outset, that the shape of goods may constitute a trade mark. However, shape marks have been refused on the ground that the shape in question lacks distinctiveness, as required by Article 3(1)(b) of the Directive,<sup>79</sup> or that the mark is descriptive of the product for which the mark is sought, as provided by Article 3(1)(c) of the Directive. The rationale for refusing to register pursuant to Article 3(1)(c) is that descriptive signs should be available to all traders, unless the mark has acquired distinctiveness.<sup>80</sup>

143. Thus, the Government of the United Kingdom submits that Article 3(1)(c) of the Directive, like Article 3(1)(b) of the Directive, may be applicable to a shape mark that is a two-dimensional representation of the shape or appearance of the goods. The shape of a product is capable of performing a descriptive function where the shape is descriptive of a characteristic of the goods.

144. Turning, finally, to the sixth question, the Government of the United Kingdom submits that in relation to particular artistic articles, such as sculptures, shapes necessarily vary a great deal as a result of their artistic purpose. As a consequence, it is more difficult to show that any particular shape is outside the norms and customs of that particular sector. A mark may also, or alternatively, be refused under Article 3(1)(c) of the Directive if the mark is descriptive.

145. Therefore, the Government of the United Kingdom proposes that the Court should answer the questions as follows:

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<sup>76</sup> Reference is made to the judgment in *Shield Mark*, cited above, paragraph 14.

<sup>77</sup> Reference is made to Martin Senftleben, Public Domain Preservation in EU Trademark Law - A Model for Other Regions? *The Trade Mark Reporter* 10/2013; 103(4):775; and to the judgment in *Lindt & Sprüngli*, C-529/07, EU:C:2009:361, paragraphs 44 and 45.

<sup>78</sup> Reference is made to the judgment in *Philips*, cited above, paragraph 75.

<sup>79</sup> Reference is made to the judgment in *Storck*, cited above, paragraph 30.

<sup>80</sup> Reference is made to the judgment in *Windsurfing Chiemsee*, cited above, paragraph 25.

*1. The prohibition in Article 3(1)(f) is not applicable by reason of the protection period in copyright for a work having expired in advance of trade mark registration being sought for that work.*

*2. – 3. In the light of the answer to Question 1, no answer to these questions is necessary.*

*4. Article 3(1)(e)(iii) of the Directive is applicable to two-dimensional representations of sculptures, provided that the shape depicted in the representation gives substantial value to the goods.*

*5. Article 3(1)(c) may be used as legal authority for refusing trade marks that are two or three-dimensional representations of the shape or appearance of the goods where the representation of the shape of the goods is descriptive of a characteristic of the goods in question.*

*6. The registration of a shape trade mark may be refused under Article 3(1)(c) of the Directive on the grounds that the shape of the goods depicted by the mark is descriptive of a characteristic of the goods concerned. In addition registration may be refused under Article 3(1)(b) of the Directive on the grounds that the shape of the goods depicted does not depart significantly from the norms and customs for the type of goods at issue.*

Carl Baudenbacher  
Judge-Rapporteur