

**Report Q188**

in the name of the United States Group  
by Kathryn BARRETT PARK and Uli WIDMAIER

**Conflicts between trademark protection and free speech**

**Questions**

**1) Analysis of current legislation and case law**

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

Freedom of speech is guaranteed by the First Amendment to the U.S. Constitution, which provides: "Congress shall make no law... abridging the freedom of speech, or of the press..." The First Amendment supersedes all state and federal laws, and its prohibitions are binding on all persons acting under the authority of federal and state law. See *New York Times Co. v. Sullivan*, 376 U.S. 254, 264–65 (U.S. Supreme Court, 1964).

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

"The First Amendment generally prevents government from proscribing speech... or even expressive conduct... because of disapproval of the ideas expressed. Content-based regulations are presumptively invalid." *R.A.V. v. City of St. Paul, Minnesota*, 505 U.S. 377, 382 (U.S. Supreme Court, 1992). Expressive conduct is also protected. See *Texas v. Johnson*, 491 U.S. 397, 404 (U.S. Supreme Court, 1989).

The First Amendment protects all artistic speech, "including music, pictures, films, photographs, paintings, drawings, engravings, prints, and sculptures." *ETW Corp. v. Jireh Publishing, Inc.*, 332 F.3d 915, 924 (6<sup>th</sup> Cir. 2003).

Commercial speech is "entitled to a measure of First Amendment protection... [but does] not receive the same level of constitutional protection as other types of protected expression." *Hoffman v. Capital Cities/ABC, Inc.*, 255 F.3d 1180, 1184 (9<sup>th</sup> Cir. 2001). Thus, commercial speech "may freely be regulated if it is misleading." *Id.* at 1184–85.

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

Both individuals and corporations are protected under the First Amendment. "[T]he corporate identity of the speaker [does not] deprive[ ] this proposed speech of what otherwise would be its clear entitlement to protection." *First Nat'l Bank of Boston v. Bellotti*, 435 U.S. 765, 778 (U.S. Supreme Court, 1978).

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

Free speech is protected in all these circumstances. "When judicial enforcement of private personal rights touching forms of communication restricts freedom of speech, state action is implicated." *L.L.Bean, Inc., v. Drake Publishing Inc.*, 811 F.2d 26, 30 n.2 (1<sup>st</sup>

Cir. 1987). The First Amendment restricts all federal and state governmental actors, including courts. *New York Times Co. v. Sullivan*, 376 U.S. 254, 264–65 (U.S. Supreme Court, 1964).

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

All federal courts in the United States, including all trial courts, are empowered to hear and fully adjudicate issues pertaining to the U.S. Constitution. Parties to a lawsuit invoke free speech interests the same way they raise any other legal issue, e.g., by the routine civil procedures of submitting pleadings, motions, briefs, jury instructions, etc.

b) *Is there a provision in your trademark law which specifically concerns the admissibility of e.g.:*

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

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

All these activities are routinely dealt with in the case law without situation-specific statutory provisions. Illustrative cases are discussed below under Section 1.4 The Trademark Act does contain a specific “free speech” type of provision dealing with trademark dilution. The Federal Trademark Dilution Act (“FTDA”), 15 U.S.C. 1125(c) and 1127, acknowledges First Amendment interests by providing that: “Noncommercial use of a mark [and] all forms of news reporting and news commentary” are not actionable under the FTDA. In this context, “noncommercial” means speech that “does more than propose a commercial transaction.” *Mattel, Inc., v. MCA Records, Inc.*, 296 F.3d 894, 906 (9<sup>th</sup> Cir. 2002).

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

All federal courts in the United States can hear and adjudicate constitutional issues. Since the U.S. Constitution and its Amendments (including the First Amendment) are the supreme law of the land, no special statutory provision is necessary for courts to entertain free speech concerns in a trademark dispute. The Trademark Act does, however, contain a fair use defense that rests on policies related to free speech. It is a defense to an infringement claim “[t]hat the use of the name, term, or device charged to be an infringement is a use, otherwise than as a mark, of the party’s individual name in his own business... or of a term or device which is descriptive of and used fairly and in good faith only to describe the goods or services of such party, or their geographic origin...” 15 U.S.C. 1115(b)(4). The fair use defense protects “the right of society at large to use words or images in their primary descriptive sense.” *KP Permanent can Make-Up, Inc., v. Lasting Impression I, Inc.*, 125 S.Ct. 542, 551 (U.S. Supreme Court, 2004). It apply even in cases where the plaintiff shows a likelihood of confusion. *Id.*

d) *How much discretion do the courts have in applying free speech concerns?*

U.S. courts are bound by controlling precedents, but otherwise have plenary power to decide First Amendment disputes, subject to appellate review by courts of appeal and the Supreme Court.

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

Any factual, philosophical, political, ideological or other criticism of a company's practices is fully constitutionally protected, as long as some "factual basis" underlies the criticism. *Texas Beef Group v. Winfrey*, 201 F.3d 680, 688 (5<sup>th</sup> Cir. 2000). However, a defendant has no First Amendment right to make "misleading use of plaintiff's marks" to criticize plaintiff. *Coca-Cola Co. v. Purdy*, 382 F.3d 774, 787 (8<sup>th</sup> Cir. 2004). The First Amendment protects speech critical of a company or its practices from tarnishment claims, which arise under dilution law. See *Mattel, Inc., v. MCA Records, Inc.*, 296 F.3d 894 (9<sup>th</sup> Cir. 2002) (federal dilution claim); *L.L.Bean, Inc., v. Drake Publishers, Inc.*, 811 F.2d 26 (1<sup>st</sup> Cir. 1987) (state dilution claim).

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

*If necessary, please differentiate between:*

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

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

In trademark infringement claims, courts balance the competing values of allowing free speech and preventing consumer confusion by tolerating a higher risk of consumer confusion in cases of constitutionally protected expression than in cases where the conduct in question does not contain such expression. See *Cliffs Notes, Inc., v. Bantam Doubleday Dell Publishing Group, Inc.*, 886 F.2d 490, 495 (2<sup>nd</sup> Cir. 1989). In the infringement context, protectability is not lost merely because defendant's use is commercial.

In federal trademark dilution claims, in contrast, classifying speech as commercial or noncommercial is crucial since noncommercial speech is expressly exempted from FTDA coverage. Mixed commercial/noncommercial speech is classified as noncommercial. *Mattel, Inc., v. MCA Records, Inc.*, 296 F.3d 894 (9<sup>th</sup> Cir. 2002).

The reputation of the trademark in question can be important. Speech using marks that have become icons of U.S. culture may enjoy higher First Amendment protection than speech using less well-known marks. *Mattel, Inc., v. Walking Mountain Productions*, 353 F.3d 792 (9<sup>th</sup> Cir. 2003).

U.S. law permits criticism to be expressed harshly. A balanced or sparing way of presenting criticism is not required. *Hustler Magazine v. Falwell*, 485 U.S. 46 (U.S. Supreme Court, 1988).

We discuss below (1) Criticism of Plaintiff; (2) Classic Parody; (3) Parody and Political Speech; and (4) Artistic Speech. We discuss use of another's mark as a badge of loyalty or allegiance, and for the purposes of comparison, point of reference, etc., later in our responses to Questions (c) and (d), respectively.

### **Criticism of Plaintiff**

Making nonconfusing use of plaintiff's marks to criticize plaintiff is constitutionally protected. See *Taubman Co. v. Webfeats*, 318 F.3d 770, 777–78 (6<sup>th</sup> Cir. 2003). However, there is no First Amendment right to make "misleading use of plaintiff's marks" and exploit consumer confusion to criticize the plaintiff. *Coca-Cola Co. v. Purdy*, 382 F.3d 774, 787 (8<sup>th</sup> Cir. 2004).

### **Classic Parody**

Parody is "an artistic work that imitates the characteristic style of an author or a work for comic effect or ridicule." *Lyons Partnership v. Gainnoulas*, 179 F.3d 384, 388 (5<sup>th</sup> Cir. 1999), citing *Campbell v. Acuff-Rose Music*, 510 U.S. 569 (U.S. Supreme Court 1994). "A parody must convey two simultaneous – and contradictory – messages: that it is the original, but also that it is not the original and is instead a parody. To the extent that it does only the former but not the latter, it is not only a poor parody but also vulnerable under trademark law, since the customer will be confused." *Cliffs Notes, Inc., v. Bantam Doubleday Dell Publishing Group, Inc.*, 886 F.2d 490, 494 (2<sup>nd</sup> Cir. 1989).

Parody implicates free speech interests. "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." *L.L.Bean, Inc., v. Drake Publishers, Inc.*, 811 F.2d 26, 34 (1<sup>st</sup> Cir. 1987). Therefore, the courts tend to insist on a strict application of the likelihood of confusion requirement in trademark disputes involving parodies. If the defendant's parodic reference to plaintiff's marks creates no more than a moderate likelihood of confusion, trademark infringement liability will not attach. See *New York Stock Exchange, Inc., v. New York, New York Hotel, LLC*, 69 F. Supp. 2d 479 (S.D.N.Y. 1999), rev'd on other grounds, 293 F.3d 550 (2<sup>nd</sup> Cir. 2002).

On the other hand, where a defendant's parody of the plaintiff's mark is insufficiently transformative, i.e. so similar to the original mark that consumers may easily be confused because they cannot tell that they are looking at a parody, an injunction may issue. This is true even though the defendant's parodic intent is genuine and defendant is not seeking to exploit plaintiff's mark to sell competing goods or services. See *Anheuser-Busch, Inc., v. Balducci Publications*, 28 F.3d 769 (8<sup>th</sup> Cir. 1994). Also, a parody that is merely a pretext for defendant's commercial exploitation of plaintiff's mark is not protected under the First Amendment and can be enjoined if the standard criteria of the Trademark Act are met. See *Harley-Davidson, Inc. v. Grottanelli*, 164 F.3d 806 (2<sup>nd</sup> Cir. 1999). If the use of plaintiff's mark is irrelevant to the point of the parody and the

parody could have been made just as effectively without using the mark, the parody enjoys no First Amendment privilege. See *Elvis Presley Enterprises, Inc., v. Capece*, 141 F.3d 188 (5<sup>th</sup> Cir. 1998).

### **Parody and Political Speech**

Political speech is protected under the First Amendment. It depends on the facts of the case whether defendant's politically motivated parodic use of plaintiff's marks is also protected. If defendant's use gives rise to a substantial likelihood of confusion, it is subject to Lanham Act liability regardless of the political context. See *MGM–Pathe Comm's. Co. v. Pink Panther Patrol*, 774 F. Supp. 869 (S.D.N.Y. 1991). If no likelihood of confusion is present, even a defendant's prominent appropriation of plaintiff's trade slogan will not give rise to trademark liability. See *MasterCard Int'l. Inc. v. Nader 2000 Primary committee, inc.*, 2004 WL 434404 (S.D.N.Y. March 8, 2004).

With respect to dilution claims, a defendant's use of plaintiff's mark for political speech may be viewed as noncommercial and hence exempt from the FTDA. *MasterCard, id.* at \*9.

### **Artistic speech**

When the defendant's conduct is characterized as artistic speech the Lanham Act is construed narrowly to take First Amendment concerns properly into account. "[T]he [Lanham] Act should be construed to apply to artistic works only where the public interest in avoiding consumer confusion outweighs the public interest in free expression." *Rogers v. Grimaldi*, 875 F.2d 994, 999 (2<sup>nd</sup> Cir. 1989).

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

Like parodies, joke articles are analyzed under a balancing test of infringement and First Amendment interests. Where the defendant's humorous expressive message creates only a small likelihood of confusion, the joke article is not actionable. See *Yankee Publishing, Inc. v. News America Publishing, Inc.*, 809 F. Supp. 267, 279 (S.D.N.Y. 1992).

- c) *May using another's mark as a badge of loyalty or allegiance be considered as an exercise of the constitutional right of freedom of speech? Does it matter whether the scarves and other goods are sold to consumers? Does it matter whether the manufacturer indicates that the goods are not original?*

There are no U.S. cases in which the use of another's mark in the described fashion—typically with regard to supporting athletic teams and the like—has given rise to First Amendment concerns. Cases like these are normally resolved without any reference to the First Amendment and typically turn on whether plaintiff has trademark rights in the claimed marks and whether defendant's use of plaintiff's mark operates as a source identifier and causes confusion. If these conditions are not met, trademark law does not prohibit defendant's activities. See *Boston Professional Hockey Ass'n, Inc., v. Dallas Cap & Emblem Mfg., Inc.*, 510 F.2d 1004 (5<sup>th</sup> Cir. 1975).

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

Much of the use addressed in the Question does not normally raise First Amendment issues and is resolved on doctrinal grounds. See Response to Section (c), *supra*. However, the Question also raises issues concerning the permissibility of comparative advertising and the constitutional protection enjoyed by comparative advertising speech.

To the extent it is truthful and not misleading, comparative advertising is commercial speech protected under the First Amendment because it “serves the beneficial purpose of imparting factual information about the relative merits of competing products...” *Deere & Co. v. MTD Products, Inc.*, 41 F.3d 39, 44 (2<sup>nd</sup> Cir. 1994).

## **2) Proposals for adoption of uniform rules**

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

Yes. Parties should always be able to assert their rights of free speech in trademark litigation.

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

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

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

Yes. Trademark law should contain specific provisions designed to vindicate free speech interests.

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

In addition to specific provisions designed to protect free speech interests, trademark law should also contain a fair use clause permitting the good-faith use of words in their primary descriptive sense. A doctrinal resolution of free speech issues is ordinarily preferable to, and leads to more predictable legal rules, than safeguarding free speech interests by direct reference to the Constitution, which should be reserved for exceptional cases. Courts should have broad discretion in applying free speech concerns, both via relevant principles of trademark law and, if need be, via direct appeal to the Constitution.

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

All factual, philosophical, political, ideological or other criticism of a company or its products or practices should be constitutionally protected so long as it has some basis in fact. However, the critic should not have the right to make confusing or misleading use of the company’s marks. Speech rights should prohibit the use of tarnishment claims to suppress truthful or sincere criticism of a company.

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

Yes.

- b) *If so, what should be the criteria be for determining whether a freedom-of-speech argument is justified? How important should the reputation of the trademark in question be? Should it matter whether the use of the trademark in question is non-commercial or should defendant also be entitled to invoke free speech-arguments if the trademark use is mainly commercial in nature? Should it matter whether the use of the trademark involves an expression or social discourse of objective/considerable value or a contribution to the public debate? Should the defendant be allowed to express his views in a trenchant way? Or should the defendant be required to report in a balanced way or even sparingly?*

*If necessary, please differentiate between:*

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

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

A defendant’s use of a plaintiff’s mark that creates substantial confusion should not be tolerated even though it is made for expressive purposes, but where defendant’s use of plaintiff’s mark qualifies as protected speech, tolerance of consumer confusion should be somewhat higher than where it does not. This approach should apply to all constitutionally protected speech, regardless of whether it may be classified as parody, humor, political speech, criticism, artistic speech, etc. A defendant should be able to invoke free speech protections for both noncommercial and truthful commercial speech. The objective value of the defendant’s speech contribution should be irrelevant because courts and other governmental authorities are ill-equipped to assess the objective merit of speech. Trenchant, one-sided, even tasteless speech should be freely permitted, and there should be no requirement that critical or parodic speech be balanced or sparing.

- c) *How should joke articles be assessed?*

The level of constitutional protection for expressive speech should be the same regardless of whether the speech can be characterized as political, parodic, artistic, humorous, or some other category. Therefore, if a joke article qualifies as protected speech under established principles of free speech law, it should be assessed under the same trademark and constitutional rules as other types of expressive conduct.

- d) *Should using another’s mark as a badge of loyalty or allegiance be considered as an exercise of the constitutional right of freedom of speech? Should it matter whether the scarves and other goods are sold to consumers? Should it matter whether the manufacturer indicates that the goods are not original?*

Such articles, illustrating the marks of athletic teams and the like, should be analyzed under traditional trademark law, including the modern law of fair use and nominative fair use, but should not give rise to separate defenses under rights of free speech.

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

Parties should be permitted to use another's mark in conformance with the laws of comparative advertising, fair use, and nominative fair use.

### **Summary**

The U.S. Group believes that defendants should always be able to assert free speech rights in trademark litigation, and that trademark law should be designed to vindicate those interests both via specific doctrinal provisions and via a fair use exception permitting the good-faith use of words in their primary descriptive sense. Moreover, the courts should have broad discretion to take free speech concerns into account in adjudicating trademark disputes, relying on applicable principles of trademark law as well as directly on the constitutional right to free speech. In the opinion of the U.S. Group, however, the predictability of the law is better served when free speech concerns are resolved in the majority of cases through doctrinal principles of trademark law interpreted to take free speech interests broadly into account, and only in exceptional cases by directly adjudicating the constitutional right to free speech itself.

The doctrinal accommodation of free speech rights should take the following form: A defendant's use of a plaintiff's mark that creates substantial consumer confusion should not be permitted even though it is made for expressive purposes. However, where defendant's use of plaintiff's mark qualifies as protected speech, tolerance of consumer confusion should be higher than where it does not. This approach should apply to all constitutionally protected speech, regardless of whether it may be classified as parody, humor, political speech, criticism, artistic speech, etc. Badges of loyalty representing the marks of athletic teams and the like, should be analyzed under standard trademark law principles and should not give rise to separate defenses under rights of free speech.

All factual, philosophical, political, ideological or other criticism of a company or its products or practices should be constitutionally protected. While even a sincere critic of a company should not have the right to make substantially confusing or misleading use of the company's marks, speech rights should prohibit the use of tarnishment claims to suppress truthful or sincere criticism of a company. Parties should be permitted to use another's mark in conformance with the laws of comparative advertising, fair use, and nominative fair use. Speech should be protectable regardless of whether it is commercial or noncommercial. Courts should not attempt to judge the objective value of a defendant's speech. Trenchant, one-sided, even tasteless parody or criticism should be freely permitted, and there should be no requirement that critical or parodic speech be balanced or sparing.

### **Résumé**

Le groupe U.S. pense que les défendeurs doivent toujours pouvoir faire valoir leur droit à la liberté d'expression dans des contentieux de droit des marques, et que le droit des marques doit être organisé afin de justifier ces intérêts, à la fois à travers des provisions doctrinales spécifiques ainsi que par une exception de "fair use" permettant l'utilisation de bonne foi de mots dans leur sens descriptif premier. Par ailleurs, les cours doivent avoir le pouvoir discrétionnaire de prendre en compte des questions de liberté d'expression en rendant leurs décisions dans des contentieux de marque, en s'appuyant sur les principes applicables de droit des marques ainsi que sur le droit constitutionnel à la liberté d'expression. Selon l'opinion du groupe U.S., cependant, le caractère prévisible de la loi est mieux assuré si les questions de liberté d'expression sont résolues dans la



majorité des cas par des principes doctrinaux de droit des marques interprétés de façon large pour prendre en compte la liberté d'expression, et seulement dans des cas exceptionnels en recourrant au droit constitutionnel à la liberté d'expression en tant que tel.

Le compromis doctrinal des droits à la liberté d'expression doit prendre la forme suivante: L'utilisation par le défendeur de la marque du demandeur qui crée un risque de confusion substantiel pour le consommateur ne doit pas être permis, même si cette utilisation existe à des fins d'expression. Cependant, lorsque l'utilisation par le défendeur de la marque du demandeur constitue un message protégé, le niveau de tolérance de la confusion pour le consommateur doit être plus élevé que si ce message ne l'est pas. Cette approche doit s'appliquer à tous les messages constitutionnellement protégés, nonobstant leur possible classification comme parodie, humour, message politique, message artistique, etc. Des insignes de loyauté représentant les marques d'équipes sportives ou autres, doivent être analysés selon les principes standards du droit des marques et ne doivent pas donner lieu à des défenses annexes en tant que droit à la liberté d'expression.

Toute critique factuelle, philosophique, politique, idéologique, ou autre d'une compagnie ou des ses produits ou pratiques doit être constitutionnellement protégée. Alors qu'une critique même sincère ne devrait pas avoir le droit d'utiliser de façon confuse ou trompeuse les marques d'une compagnie, le droit à la liberté d'expression doit empêcher l'utilisation de l'argument de dénigrement pour supprimer une critique véridique ou sincère envers une compagnie. Les parties doivent pouvoir utiliser leurs marques respectives en conformité avec les lois de la publicité comparative, le "fair use" et le "fair use" nominatif. Le message doit être protégé, nonobstant son caractère commercial ou pas. Les cours ne doivent pas essayer de juger la valeur objective du message du défendeur. Une parodie ou une critique incisive, partisane ou même d'un goût douteux doit être librement permise, et il ne doit y avoir aucune condition que le message critique ou de parodie soit balancé ou modéré.

### **Zusammenfassung**

Die U.S. Gruppe ist der Ansicht, dass Beklagte in Warenzeichenprozessen jederzeit in der Lage sein sollten, ihr Recht auf Redefreiheit auszuüben, und dass das Warenzeichenrecht so ausgerichtet sein sollte, dass es dieses Interesse sowohl durch spezifische doktrinaire Bestimmungen als auch durch eine Ausnahme für den fairen Gebrauch von Worten in ihrer ursprünglichen deskriptiven Bedeutung verteidigt. Darüber hinaus sollten die Gerichte weites Ermessen darüber haben, Belange der Redefreiheit bei der Entscheidung warenzeichenrechtlicher Streitigkeiten in Betracht zu ziehen und sich dabei sowohl auf anwendbare warenzeichenrechtliche Prinzipien als auch direkt auf das verfassungsrechtliche Recht der Redefreiheit zu stützen. Nach Ansicht der U.S. Gruppe ist es für die Kalkulierbarkeit des Rechts besser, wenn Probleme der Redefreiheit in der Mehrzahl der Fälle durch doktrinaire Prinzipien eines Warenzeichenrechts gelöst werden, das die Belange der Redefreiheit freizügig berücksichtigt, und nur in ausserordentlichen Fällen das verfassungsrechtliche Recht auf Redefreiheit direkt angewendet wird.

Die doktrinaire Berücksichtigung der Redefreiheit sollte wie folgt gestaltet werden: Die Nutzung einer Marke des Klägers durch den Beklagten durch die eine beachtliche Verwirrung beim Verbraucher verursacht wird, sollte nicht erlaubt sein, selbst wenn sie für expressive Zwecke erfolgt. Wird die Nutzung der Marke des Klägers durch den Beklagten jedoch von der Redefreiheit geschützt, so sollte eine grössere Toleranz für eine Verwirrung beim Verbraucher gewährt werden als dort, wo dies nicht der Fall ist. Dieser Ansatz sollte auf sämtliche von der verfassungsrechtlichen Redefreiheit geschützten Äusserungen angewendet werden, unabhängig davon, ob diese als Parodie, Humor, politische Äusserung, Kritik, künstlerische Äusserung, etc. eingeordnet werden. Treueabzeichen, die etwa die Marken von athletischen Teams wiedergeben, sollten unter normalen warenzeichenrechtlichen Prinzipien analysiert werden und sollten keinen separaten Schutz nach dem Recht auf Redefreiheit geniessen.

Alle faktische, philosophische, politische, ideologische oder andere Kritik an einem Unternehmen oder dessen Produkte sollte verfassungsrechtlich geschützt sein. Obwohl selbst ein ehrlicher Kritiker eines Unternehmens nicht das Recht haben sollte, die Marken des Unternehmens in erheblich verwirrender oder irreführender Weise zu verwenden, sollte das Recht auf Redefreiheit der Verwendung von Ansprüchen wegen Rufschädigung, die zur Unterdrückung wahrer oder ehrlicher Kritik am Unternehmen eingesetzt werden, entgegenstehen. Den Parteien sollte erlaubt sein, die Marken der jeweils anderen Seite im Rahmen des Rechts der vergleichenden Werbung, des fairen Gebrauchs und des nominativen fairen Gebrauchs zu nutzen. Die Rede soll geschützt werden können, unabhängig davon, ob sie kommerziell oder nicht kommerziell ist. Gerichte sollten nicht versuchen, den objektiven Wert der Rede des Beklagten festzustellen. Scharfe, einseitige, sogar geschmacklose Parodie oder Kritik sollte frei erlaubt sein, und es sollte keinen Grundsatz geben, dass kritische oder parodierende Rede balanciert oder schonend sein soll.