

Artistic Expression at Risk: The Overlap of Sound Mark Protection and Phonogram Protection in EU IP Law

RÉMI SAIDANE*

ABSTRACT

This article attempts to determine to what extent sound mark protection and phonogram protection overlap at the expense of artistic expression in EU law. It first analyses the sound mark protection regime to show that acquiring sound mark protection is difficult, although the criteria for registration have become more flexible and clarified. However, the rights granted to sound mark proprietors are extensive, which allows them to challenge a variety of sounds at the expense of artistic expression. Secondly, the phonogram protection regime is studied to demonstrate that phonogram protection is easy to acquire thanks to its light requirements. It is then argued that the Court of Justice of the European Union in *Pelham* failed to provide efficient and flexible safeguards to protect artistic expression against phonogram producers' claims. Finally, the detrimental effects on artistic expression caused by the overlap of sound mark protection and phonogram protection are analysed. When sound mark protection is granted, phonogram protection will easily, if not automatically, overlap with it. The accumulation of the two protections, because of their unfavourable approach to artistic expression, leads to detrimental effects on it. Moreover, there is a conflict of individual imperatives between the two systems at the expense of artistic expression. This article thus finds that the combined effects of the expansion of sound mark protection and the unprotective approach to artistic expression regarding phonogram protection in *Pelham* cause serious interferences with artistic expression. Neither of the two regimes adequately protects artistic expression, and the possibility of combining them seriously puts artistic expression at risk. This article suggests that reforms to integrate fair use in both sound mark and phonogram regimes are necessary.

* LLM Candidate, University of Cambridge; LLB (Maastricht).

I. INTRODUCTION

It is the summer of 2013. The train from Paris arrives in Aix-en-Provence. As one of the passengers alights, he hears four notes sung in a woman's voice coming from the train station's speakers: 'C, G, A-flat, E-flat'. Mesmerised by this sound, the man steps closer to the loudspeakers: finally, rock icon David Gilmour knows what his next single will sound like. After hearing the jingle for France's national railway operator, the SNCF, the musician decided to use this five-second sound sample as the central element of his song 'Rattle that Lock'.¹ Although he reached an agreement to use this sample with *Sixième Son*, the producer of the jingle, the latter would soon start legal proceedings before French courts based on copyright-related protection of phonograms. This claim would ultimately be rejected.² While this dispute between the producers and the artist was based on a copyright-related claim, it could have been that the SNCF had brought a trade mark claim against David Gilmour. The SNCF jingle is broadly perceived by consumers as a tool to identify the company's services,³ which could be expected to be subject to trade mark protection. This case is one example of how the trade mark protection of sounds (hereinafter 'sound mark protection') and the copyright-related protection of phonograms (hereinafter 'phonogram protection') could overlap at the expense of artistic expression.

Sound marks are trade marks vested in sounds.⁴ Their purpose is to protect distinctive sounds of goods or services of an undertaking, to avoid their use by another undertaking in the course of trade.⁵ They are 'non-traditional marks', as opposed to traditional marks like words, given that their recognition as trade marks is a recent phenomenon.⁶ Meanwhile, phonograms are any exclusively aural fixation of sounds of performances or other sounds.⁷ They are subject to copyright-related protection in favour of phonogram producers.⁸ Artistic expression is a component of freedom of expression allowing one to take part in

¹ Laura Snapes, 'David Gilmour in Legal Fight with Composer of French SNCF Train Jingle' *The Guardian* (London, 19 November 2019) <www.theguardian.com/music/2019/nov/19/david-gilmour-legal-fight-composer-french-sncf-train-jingle-michael-boumendil> accessed 26 September 2021.

² CA Paris 15 June 2021, n° 19/14255.

³ *Sixième Son*, 'SNCF' (*sixiemeson.com*) <www.sixiemeson.com/sncf/> accessed 26 September 2021.

⁴ Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark [2017] OJ L154/1 ('Trade Mark Regulation'), art 4; Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trade marks [2015] OJ L336/1 ('Trade Mark Directive'), art 3.

⁵ Justine Pila and Paul Torremans, *European Intellectual Property Law* (2nd edn, Oxford University Press 2019) 375–376.

⁶ Irene Calboli and Martin Senftleben, 'Introduction' in Irene Calboli and Martin Senftleben (eds), *The Protection of Non-Traditional Trademarks* (Oxford University Press 2018) 1–2.

⁷ International Convention for the Protection of Performers, Producers of Phonograms and Broadcasting Organizations (adopted 26 October 1961, entered into force 18 May 1964) 496 UNTS 43 ('Rome Convention'), art 3(b).

⁸ Paul ACE van der Kooij and Dirk JG Visser, *EU IP Law: A Short Introduction to European Intellectual Property Law* (deLex B.V. 2015) 106–109.

the ‘public exchange of cultural, political and social information and ideas of all kinds’.⁹

The continuous expansion of intellectual protection regimes in European Union (EU) intellectual property (‘IP’) law has led to areas of cumulative protection.¹⁰ In that context, and because they are both vested in sounds, phonogram protection and sound mark protection may cohabit in some instances. The reliance on the two regimes could be a way for undertakings to cumulate their benefits. This phenomenon is, in fact, one facet of a larger one: the copyright/trade mark interface.¹¹ While the two regimes serve different purposes, they could cohabit the same medium. Such cohabitation could affect artistic expression because the cumulated protections could be powerful tools for the commercial purpose of opposing artistic works in favour of sound marks.

It therefore seems necessary to answer the following question: to what extent do European Union laws on phonogram protection and sound mark protection overlap at the expense of artistic expression?

To answer this question, this article will follow a doctrinal legal research methodology. It will, in its first part, analyse sound mark protection under EU law. For this purpose, the restrictive criteria for sound mark protection, as well as the extensive rights granted by such protection, will be examined. For this purpose, an analysis of the secondary law developed at the EU level and the judgments of the Court of Justice of the European Union (hereinafter ‘CJEU’ or ‘the Court’) in connection with phonogram protection will be undertaken (Section II). This will be followed by a study of the easily acquirable protection of phonograms under EU law. The flexible criteria for phonogram protection will be explored. The EU secondary law and CJEU judgments on sound mark protection will be analysed. The extent of the protection granted will be examined as well as the clarifications in relation to artistic expression in the *Pelham* case (Section III). Finally, the overlap of the two regimes and the risks this poses to artistic freedom will be assessed. The two legal frameworks will, following individual analyses of each of them, be confronted to demonstrate how they overlap in a way that could affect artistic expression (Section IV). This research will be limited to EU law, thus excluding national law. Moreover, the only intellectual property rights studied will be phonogram producers’ rights and sound mark proprietors’ rights. All other rights are not relevant for the purpose of this research. Finally, the friction between the two systems will only be studied in cases where phonogram protection

⁹ Christophe Geiger and Elena Izyumenko, ‘The Constitutionalization of Intellectual Property Law in the EU and the *Funke Medien*, *Pelham* and *Spiegel Online* Decisions of the CJEU: Progress, But Still Some Way to Go!’ (2020) 51 IIC - International Review of Intellectual Property and Competition Law 282, 293. See Case C-476/17 *Pelham GmbH, Moses Pelham, Martin Haas v Ralf Hütter, Florian Schneider-Esleben* EU:C:2019:624, para 34.

¹⁰ Martin Senftleben, *The Copyright / Trademark Interface: How the Expansion of Trademark Protection Is Stifling Cultural Creativity* (Kluwer Law International 2020) 15, 16.

¹¹ *ibid* 1–10.

is used by undertakings to protect signs that could qualify as sound marks from artists sampling them. The other aspects of the overlap will not be studied.

II. THE EXTENSIVE PROTECTION OF SOUND MARKS UNDER EU LAW

Sound marks may be protected under EU law if the strict criteria for registration are met (Section II.A). If their sound mark is registered, sound mark proprietors will enjoy a broad set of rights to oppose artistic expression (Section II.B).

A. THE CRITERIA FOR THE REGISTRATION OF SOUND MARKS

To be protected under EU law, sound marks can be registered for certain classes of goods or services, either as EU trade marks or as national trade marks.¹² Sound marks are part of the class of trade marks informally called ‘non-traditional marks’, for they are trade marks created by means of unorthodox media.¹³ Originally, authorities showed a fierce reluctance to register sound marks and other non-traditional marks.¹⁴ However, in the EU, the evolution of the legal framework for sound marks and the judgments of the General Court of the CJEU have introduced some flexibility into the regime.

(i) The Need for a Distinctive Sign with the High Threshold of Resonance

For a sound mark to be registered, it must be a sign capable of distinguishing the goods or services of an undertaking from those of other undertakings.¹⁵

Previous EU legal instruments on trade marks did not explicitly list ‘sound’ as a type of sign.¹⁶ However, the new Regulation (EU) 2017/1001 on the European Union trade mark (hereinafter ‘EUTMR’) and Directive (EU) 2015/2436 to approximate the laws of the Member States relating to trade marks (hereinafter ‘TMD’) have clearly welcomed it into the family of signs subject to trade mark protection.¹⁷

Turning to distinctiveness, the Court further developed in *Rewe Zentral* that it is generally assessed in relation to: (a) the goods or services for which registration

¹² Trade Mark Regulation, art 6; Trade Mark Directive, art 1.

¹³ Calboli and Senftleben (n 6) 1–4.

¹⁴ Dev S Gangjee, ‘Paying the Price for Admission: Non-Traditional Marks Across Registration and Enforcement’ in Irene Calboli and Martin Senftleben (eds), *The Protection of Non-Traditional Trademarks* (Oxford University Press 2018) 61, 62.

¹⁵ *ibid* art 4(a); Trade Mark Directive, art 3(a). See Pila and Torremans (n 5) 348.

¹⁶ Council Regulation (EC) 207/2009 of 26 February 2009 on the European Union trade mark [2015] OJ L341/21, art 4; 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 [2008] OJ L299/25, art 2.

¹⁷ Trade Mark Regulation, art 4; Trade Mark Directive, art 3.

is sought; and (b) the perception of the targeted public composed of consumers of the goods or services.¹⁸ A minimum degree of distinctiveness is, however, sufficient for registration.¹⁹ Nevertheless, the Court in *Glaverbel* added that, although the criteria to assess distinctiveness were the same for all trade marks, the perception of the target consumers could differ for certain classes of trade mark.²⁰ The Court was implicitly referring to non-traditional marks, as evidenced by the previous judgments it cited.²¹

For sound marks, the application of the criterion of the ‘perception of the target consumers’ was thus further elaborated in *Globo Comunicação*.²² The Court acknowledged the increasing role of sounds as a means of identifying goods or services, especially in the media sector.²³ Regarding the perception of the target consumers, the sound needed to have a ‘certain resonance’ enabling them to perceive and regard the sound as a trade mark having the ability to identify a good or service, rather than a mere functional element or an element devoid of inherent characteristic.²⁴ Excessively simple and banal sounds, such as the repetition of two identical notes, would make such a resonance impossible. It would not enable the target consumer to perceive it as identifying the good or service, because it would merely refer to itself and would not lead to a certain form of attention enabling the target consumer to perceive the sound’s identifying function.²⁵ Nevertheless, the sound did not have to be original or fanciful to meet the threshold.²⁶ The CJEU later confirmed the standard of resonance when applying the criterion of the perception of the target consumers in *Ardagh Metal Beverage*.²⁷ ‘Resonance’ was the standard for sound marks, and the other standards developed for other types of marks could not be applied to sound marks.

Criticism has been raised regarding the concept of ‘resonance’. Indeed, this word was not defined by the Court. While it is defined in the *Cambridge Dictionary* as a ‘feeling, thought, memory’ that something makes someone have, or the

¹⁸ Case T-79/00 *Rewe Zentral AG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* (OHIM) EU:T:2002:42, [2002] ECR II-705, para 27.

¹⁹ *ibid* para 28.

²⁰ Case C-445/02 P *Glaverbel SA v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* (OHIM) EU:C:2004:393, [2004] ECR I-6267, para 23.

²¹ *ibid*. On non-traditional trade marks, see Joined Cases C-456/01 P and C-457/01 P *Henkel KGaA v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* (OHIM) EU:C:2004:258, [2004] ECR I-5089, para 38. See also Joined Cases C-468/01 P to C-472/01 P *Procter & Gamble Company v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* (OHIM) EU:C:2004:259, [2004] ECR I-5154, para 36.

²² Case T-408/15 *Globo Comunicação e Participações S/A v European Union Intellectual Property Office* EU:T:2016:468, paras 41–46.

²³ *ibid* paras 42–44.

²⁴ *ibid* para 45. See Guy Heath and others, ‘When Should a Sound Mark Be Regarded as Excessively Simple, Notwithstanding the Familiarity of Consumers with the Use of Sound Marks in the Economic Sector Concerned?’ (2016) 107 *The Trademark Reporter* 505, 506.

²⁵ *Globo Comunicação* (n 22) para 46. See Heath and others (n 24) 506.

²⁶ *ibid* para 57. See Heath and others (n 24) 506.

²⁷ Case T-668/19 *Ardagh Metal Beverage Holdings GmbH & Co KG v European Union Intellectual Property Office* EU:T:2021:420, para 24.

'quality' in a thing that 'makes this happen',²⁸ no clear legal definition was given by the Court. Even when relying on the definition from the *Cambridge Dictionary*, it implies a subjective assessment relying on feelings that is likely to vary among the average consumers of the good or service concerned by the sound mark.²⁹ Moreover, the words used in the different language versions of the judgment to describe this concept make it even more unclear. In French, the word used, *prégnance*, can be translated as 'something that imposes itself on the mind, which produces a strong impression'.³⁰ In Spanish, the word *fuertza* was employed, which means strength.³¹ These words, while tending to describe a similar concept, diverge substantially in terms of definition, which blurs the exact meaning of the concept of 'resonance'. Finally, while EU law has in principle accepted the registration of sound marks, the two judgments of the CJEU led to the rejection of the sound marks at stake for being too banal, and a substantial number of decisions of the Boards of Appeal of the EUIPO rejected sound marks.³² This shows how difficult it is in fact to register a sound mark because of the criterion of distinctiveness.³³ On a side note, trade marks can be registered when they lack inherent distinctiveness thanks to their distinctiveness acquired through use.³⁴ This possibility has been acknowledged for sound marks by the CJEU.³⁵

(ii) *The Flexibility Introduced for the Criterion of Appropriate Representation*

Finally, the third criterion is a procedural one, concerning the representation of the sign on the register.³⁶ The sign must satisfy the so-called *Sieckmann* criteria. Accordingly, for a sign to be deemed a trade mark, it must be represented in a manner that is clear, precise, self-contained, easily accessible, intelligible, durable and objective.³⁷ The *Sieckmann* criteria would later be incorporated into the EUTMR and the TMD.³⁸ These criteria play an important role for non-traditional marks, because of the unconventional ways of representing

²⁸ 'Resonance' (*Cambridge Dictionary*, 2022) <<https://dictionary.cambridge.org/fr/dictionnaire/anglais/resonance>> accessed 3 April 2022.

²⁹ Stefan Martin, 'The Hiss Produced by the Opening of a Drink Can Cannot Be Registered as EUTM' (2021) 16 *Journal of Intellectual Property Law & Practice* 1164, 1166; Gordon Humphreys, Nedim Malovic, and Stefan Martin, 'Round-Up of Non-Traditional EU Trade Mark Decisions in 2021' (2021) 17 *Journal of Intellectual Property Law & Practice* 350, 356.

³⁰ 'Prégnance' (*Larousse*, 2022) <www.larousse.fr/dictionnaires/francais/pr%C3%A9gnance/63496#:~:text=Lit%C3%A9raire,ou%20moins%20grande%20aux%20sujets.> accessed 3 April 2022; 'Prégnant' (*Larousse*, 2022) <www.larousse.fr/dictionnaires/francais/pr%C3%A9gnant/63499> accessed 3 April 2022.

³¹ Martin (n 29) 1166.

³² Humphreys, Malovic, and Martin (n 29) 356.

³³ Martin (n 29) 1166.

³⁴ Trade Mark Regulation, art 7(3).

³⁵ *Globo Comunicação* (n 22) para 51.

³⁶ Pila and Torremans (n 5) 350.

³⁷ Case C-273/00 *Ralf Sieckmann v Deutsches Patent- und Markenamt* EU:C:2002:748, [2002] ECR I-11737, para 55.

³⁸ Trade Mark Regulation, recital 10, art 4(b); Trade Mark Directive, recital 13, art 3(2). See Gangjee (n 14) 67.

them.³⁹ Each class of non-traditional marks is subject to its own representation requirements.⁴⁰ Originally, the Court admitted in *Shield Mark BV* that the *Sieckmann* criteria could not be met for sound marks when the sign is represented by a description using the written language, such as an indication of the musical notes or a sequence of musical notes, or the cry of a cockerel, or a mere onomatopoeia.⁴¹ A sign could, however, be represented by employing musical notation, with a stave divided into measures, a clef, musical notes and rests indicating the relative value and accidentals when deemed necessary.⁴² In addition, the previous EUTMR and TMD explicitly required a graphic representation,⁴³ which would exclude several means of representation, such as sound files. This made the representation of sound marks technically difficult. However, with the adoption of the new EUTMR and TMD, the criterion of graphic representation has been removed.⁴⁴ Indeed, as the European Commission had highlighted, alternative representations such as sound files could be preferable to graphic representation in some instances.⁴⁵

As a result, the inflexible criterion of graphic representation has been replaced by a standard of ‘appropriate representation’, or so-called ‘adequate representation’, according to which any appropriate form of representation using generally available technology can be employed to represent trade marks.⁴⁶ Today, sound marks can be represented either by an accurate representation of the sound in musical notation or an audio file reproducing the sound.⁴⁷

All in all, it is possible to register sound marks, thanks to the explicit introduction of sound as signs and the flexibility introduced for representation in EU law. The strict criterion of distinctiveness and its standard of resonance nevertheless render such registration unclear and complicated. If one manages to meet such a standard, their sound mark would enjoy extensive protection (Section II.B).

³⁹ Gangjee (n 14) 66.

⁴⁰ *ibid* 67.

⁴¹ Case C-283/01 *Shield Mark BV v Joost Kist h.o.d.n. Memex* EU:C:2003:641, [2003] ECR I-14313, para 64. See Pila and Torremans (n 5) 352–353.

⁴² *Shield Mark* (n 41) para 64.

⁴³ Council Regulation (EC) 207/2009 (n 16) art 4; Directive 2008/95/EC (n 16) art 2.

⁴⁴ Trade Mark Regulation, art 4; Trade Mark Directive, art 3.

⁴⁵ Commission, ‘Proposal for a Regulation of the European Parliament and of the Council amending Council Regulation (EC) No 207/2009 on the Community trade mark’ COM (2013) 151 final, 7. See also Max Planck Institute for Intellectual Property and Competition Law, *Study on the Overall Functioning of the Trade Mark System in Europe* (Publication Office of the European Union 2011) 67.

⁴⁶ Trade Mark Regulation, recital 10. See Gangjee (n 14) 65.

⁴⁷ Commission Implementing Regulation (EU) 2018/626 of 5 March 2018 laying down detailed rules for implementing certain provisions of Regulation (EU) 2017/1001 of the European Parliament and of the Council on the European Union trade mark, and repealing Implementing Regulation (EU) 2017/1431 [2018] OJ L104/37, art 3(3)(g).

B. THE EXTENSIVE RIGHTS OF SOUND MARK PROPRIETORS TO OPPOSE ARTISTIC EXPRESSION

Once a sound mark is registered, it enjoys the broad protection granted under EU law for trade marks. The rights of sound mark proprietors are registered for ten years,⁴⁸ and can be renewed every ten years.⁴⁹ These rights are subject to a limited number of exceptions and limitations, under which the relativisations regarding artistic expression are limited.

(i) The Broad Set of Rights Granted to Sound Mark Holders

Three grounds are available to raise a claim for trade mark infringement: double identity,⁵⁰ likelihood of confusion,⁵¹ and trade mark reputation.⁵²

Under a claim for double identity, trade mark holders can prevent a third party from using in the course of trade and without their consent a sign identical to the trade mark and used in relation to goods or services which are identical to those for which the trade mark is registered.⁵³

As regards the likelihood of confusion, trade mark holders can prevent a third party from using in the course of trade and without their consent: (a) a sign identical or similar to the trade mark; (b) in relation to goods or services identical or similar to the goods or services for which the trade mark is registered; and (c) where there exists a likelihood of confusion for the public between the trade mark and the sign, which includes the likelihood of association between the sign and the trade mark.⁵⁴

Finally, a trade mark reputation claim is available for trade mark holders to prevent third parties from using, under certain conditions, certain signs in the course of trade and without their consent.⁵⁵ First, there must be a sign which is identical or similar to the trade mark. Second, the sign must be used in relation to any good or service, either identical, similar, or dissimilar to that of the earlier mark. Third, the earlier trade mark must have a reputation. The concept of reputation implies a certain degree of knowledge among the relevant public.⁵⁶ The relevant public depends on the marketed good or service and can be either the general public or a specialised public.⁵⁷ Fourth, the use of that sign must either

⁴⁸ Commission Implementing Regulation (EU) 2018/626 (n 47) art 52; Trade Mark Directive, art 48.

⁴⁹ Commission Implementing Regulation (EU) 2018/626 (n 47) art 53; Trade Mark Directive, art 49.

⁵⁰ Trade Mark Regulation, art 9(2)(a); Trade Mark Directive, art, 10(2)(a).

⁵¹ Trade Mark Regulation, art 9(2)(b); Trade Mark Directive, art 10(2)(b).

⁵² Trade Mark Regulation, art 9(2)(c); Trade Mark Directive, art 10(2)(c).

⁵³ Trade Mark Regulation, art 9(2)(a); Trade Mark Directive, art 10(2)(a).

⁵⁴ Trade Mark Regulation, art 9(2)(b); Trade Mark Directive, art 10(2)(b).

⁵⁵ Trade Mark Regulation, art 9(2)(c); Trade Mark Directive, art 10(2)(c).

⁵⁶ Case C-301/07 *PAGO International GmbH v Tirolmilch registrierte Genossenschaft mbH* EU:C:2009:611, [2009] ECR I-9429, para 21.

⁵⁷ *ibid* para 22. See Case C-375/97 *General Motors Corporation v Yplon SA* EU:C:1999:408, [1999] ECR I-5421, para 24.

take unfair advantage of, or be detrimental to, the distinctive character or repute of the mark. For trade mark reputation claims, no likelihood of confusion is required, which means that a mere link in the mind of the average consumer between the sign and the mark is sufficient.⁵⁸

Sound mark proprietors can therefore rely on claims for double identity, likelihood of confusion, and trade mark reputation to protect their sound marks from being infringed by third parties, including artists. This extensive set of rights allows them to prevent third parties from using identical, similar, or dissimilar sounds in a broad range of scenarios, with few criteria to be met.

(ii) The Few Limitations and Defences that Protect Artistic Expression

There are only a few limitations and defences which artists could rely on against sound mark claims, and the relativisations of trade mark proprietors' rights in relation to artistic expression are limited.

First, there are internal limitations in the trade mark system that can be relied on to limit the scope of sound mark protection. This is the case with the criterion of the infringing sign being used 'in the course of trade'.⁵⁹ Indeed, trade mark protection is, in principle, only relevant against signs used in the course of trade,⁶⁰ that is in the context of commercial activity with a view to an economic advantage and not as a private matter,⁶¹ and in the user's own commercial communication.⁶² This criterion supposedly excludes purely artistic uses of a trade mark from the scope of trade mark proprietors' claims,⁶³ but can be insufficient to exclude mixed commercial uses. These are non-commercial uses of a trade mark in a commercial context in relation to goods or services,⁶⁴ such as the use of a sampled sound mark in a song that would later be commercialised. While the sound mark is not used to distinguish the song as a product, it would end up being incorporated into it when commercialised.

Another internal limitation is the requirement that the infringing sign is used 'in relation to goods or services'.⁶⁵ The CJEU has adopted a flexible approach to that criterion, according to which a 'reference', 'link' or 'association' to the goods

⁵⁸ Case C-408/01 *Adidas-Salomon AG and Adidas Benelux BV v Fitnessworld Trading Ltd* EU:C:2003:582, [2003] ECR I-12537, para 31.

⁵⁹ Łukasz Zelechowski, 'Invoking Freedom of Expression and Freedom of Competition in Trade Mark Infringement Disputes: Legal Mechanisms for Striking a Balance' (2018) 19 ERA Forum 115, 118.

⁶⁰ Trade Mark Regulation, art 9(2); Trade Mark Directive, art 10(2).

⁶¹ Case C-206/01 *Arsenal Football Club plc v Matthew Reed* EU:C:2002:651, [2002] ECR I-102773, para 40.

⁶² Joined cases C-236/08 to C-238/08 *Google France SARL and Google Inc v Louis Vuitton Malletier SA, Google France SARL v Viaticum SA and Luteciel SARL and Google France SARL v Centre national de recherche en relations humaines (CNRRH) SARL and Others* EU:C:2010:159, [2010] ECR I-2417, para 56.

⁶³ Zelechowski (n 59) 118.

⁶⁴ *ibid* 119; Martin Senfleben, 'Robustness Check: Evaluating and Strengthening Artistic Use Defences in EU Trademark Law' (2022) 53 International Review of Intellectual Property and Competition Law 567, 572.

⁶⁵ Trade Mark Regulation, art 9(2); Trade Mark Directive, art 10(2).

or services is sufficient to pass the threshold.⁶⁶ This diminishes the limiting effect of the criterion in protecting artistic expression. More generally, the realm of trade mark protection expanded into the natural realm of copyright and rights related to copyrights,⁶⁷ with no parallel development of users' rights.⁶⁸ As a result, the gatekeeping role of the two internal limitations in restricting the extent of trade mark claims has been eroded, with their contours being blurred and trade marks being over-protected.⁶⁹ An illustration of this phenomenon is the extension of the list of particularly relevant infringements in the new EUTMR and the TMD,⁷⁰ which entrenches the criterion of use in relation to goods or services.⁷¹

Next to these internal limitations, only a limited set of four defences are explicitly provided in the EU trade mark system,⁷² with no defence specifically designed for artistic expression.⁷³ First, third parties who are natural persons can use their own name or address, regardless of any trade mark protection.⁷⁴ Second, under the descriptive use defence, third parties can freely use signs or indications concerning mere characteristics of the goods or services.⁷⁵ This exception could allow the use of elements of cultural significance registered as trade marks thanks to their acquired distinctiveness.⁷⁶ Its protective effect on artistic expression is, however, limited. Purely decorative uses,⁷⁷ as well as faithful reproductions of a trade mark,⁷⁸ are excluded from the scope of this defence.⁷⁹ Next, under the non-distinctive use defence, third parties can freely use non-distinctive signs or indications.⁸⁰ Finally, under the referential use defence, third parties can use a trade mark to identify or refer to goods or services as those of the proprietor of

⁶⁶ Case C-63/97 *Bayerische Motorenwerke AG and BMW Nederland BV v Ronald Karel Deenik* EU:C:1999:82, [1999] ECR I-905, para 42; Case C-533/06 *O2 Holdings Limited and O2 (UK) Limited v Hutchison 3G UK Limited* EU:C:2008:339, [2008] ECR I-4231, paras 35–36; Case C-17/06 *Céline SARL v Céline SA* EU:C:2007:497, [2007] ECR I-7041, para 23; Joined cases C-236/08 to C-238/08 *Google France SARL and Google Inc v Louis Vuitton Malletier SA, Google France SARL v Viaticum SA and Luteciel SARL, and Google France SARL v Centre national de recherche en relations humaines (CNRRH) SARL and Others* EU:C:2010:159, [2010] ECR I-2417, para 72; Case C-324/09 *L'Oréal SA and Others v eBay International AG and Others* EU:C:2011:474, [2011] ECR I-6011, para 93. See Senfileben, 'Robustness Check' (n 64) 577–578.

⁶⁷ Senfileben, *The Copyright / Trademark Interface* (n 10) 134, 141.

⁶⁸ Jens Schovsbo, 'Mark My Words - Trademarks and Fundamental Rights in the EU' (2018) 8 UC Irvine Law Review 555, 557, 564–566.

⁶⁹ *ibid* 557, 564–566.

⁷⁰ Trade Mark Regulation, art 9(3); Trade Mark Directive, art 10(3).

⁷¹ Schovsbo (n 68) 564–565.

⁷² Trade Mark Regulation, art 14(1); Trade Mark Directive, art 14(1).

⁷³ Senfileben, 'Robustness Check' (n 64) 599.

⁷⁴ Trade Mark Regulation, art 14(1)(a); Trade Mark Directive, art 14(1)(a). See Senfileben, 'Robustness Check' (n 64) 581.

⁷⁵ *ibid* art 14(1)(b); Trade Mark Directive, art 14(1)(b). See Senfileben, 'Robustness Check' (n 63) 583.

⁷⁶ Senfileben, 'Robustness Check' (n 64) 583.

⁷⁷ Case C-102/07 *Adidas AG and Adidas Benelux BV v Marca Mode CV and Others* EU:C:2008:217, [2008] ECR I-2439, para 48.

⁷⁸ Case C-48/05 *Adam Opel v Autec AG* EU:C:2007:55, [2007] ECR I-1017, para 44.

⁷⁹ Senfileben, 'Robustness Check' (n 64) 583–584.

⁸⁰ Trade Mark Regulation, art 14(1)(b); Trade Mark Directive, art 14(1)(b). Senfileben, 'Robustness Check' (n 64) 583.

that trade mark.⁸¹ This exception could be relevant in cases of mixed commercial uses deemed to be in the course of trade when there is an artistic, polemical, parodic, or satirical purpose.⁸² In practice, however, there is little evidence of the application of this exception in these contexts.⁸³

It has been argued that the four defences should be construed as balancing tools to be generally used in the trade mark system. Intellectual property rights cannot be treated as pure economic assets as tangible objects would be under property law, because of the societal need to access knowledge.⁸⁴ The interface between the exclusive rights and the socio-economic need for free access to intellectual property objects should be considered when applying the defences, thus justifying a liberal and user-friendly approach.⁸⁵ But even with this approach, the defences are, in any case, subject to the burden of proving that the use of the sign is in accordance with honest practices in industrial or commercial matters.⁸⁶ The new EUTMR and TMD especially stress that, in the context of artistic expression, while trade mark law must be applied in a way that ensures full respect for fundamental rights and freedoms, including freedom of expression, the use of a trade mark can only be deemed fair if it is in accordance with honest practices in industrial and commercial matters.⁸⁷ This requirement is problematic from a theoretical point of view given that it is uncertain whether artistic productions should be subject to industrial and commercial standards.⁸⁸ By obliging artists to abide by such standards, their creative autonomy could be affected,⁸⁹ thus interfering with artistic expression. Moreover, from a practical point of view, artists are not always acquainted with commercial and industrial behavioural standards, and it could be difficult to expect them to fully master these standards.⁹⁰

Finally, there is a limitation internal to trade mark reputation claims, namely the ‘due cause’ limitation. According to this limitation, a trade mark with a reputation cannot be protected against the use of a sign with due cause.⁹¹ While the CJEU has not yet ruled on due cause in the context of artistic expression, it has shown some flexibility in the application of this criterion in the context of freedom of expression and freedom of competition.⁹² The Court recognises objectively overriding reasons as well as subjective interests of third parties as

⁸¹ Trade Mark Regulation, art 14(1)(c); Trade Mark Directive, art 14(1)(c).

⁸² Zelechowski (n 59) 127; Senfileben, ‘Robustness Check’ (n 64) 581.

⁸³ Senfileben, ‘Robustness Check’ (n 64) 581.

⁸⁴ Zelechowski (n 59) 128.

⁸⁵ *ibid.*

⁸⁶ Trade Mark Regulation, art 14(2); Trade Mark Directive, art 14(2).

⁸⁷ Trade Mark Regulation, recital 21; Trade Mark Directive, recital 27.

⁸⁸ Senfileben, ‘Robustness Check’ (n 64) 586–587.

⁸⁹ *ibid.* 586.

⁹⁰ *ibid.*

⁹¹ Trade Mark Regulation, art 9(2)(c); Trade Mark Directive, art 10(2)(c).

⁹² Case C-323/09 *Interflora Inc and Interflora British Unit v Marks & Spencer plc and Flowers Direct Online Ltd* EU:C:2011:604, [2011] ECR I-8625, para 91; Zelechowski (n 59) 129.

forming part of the concept of due cause.⁹³ It tends to treat due cause as an open-ended general clause to balance the competing interests of trade mark proprietors and users,⁹⁴ which could be relied on in an artistic context.

To sum up, artists only have little room to answer to sound mark proprietor claims. The internal limitations tend to show deficiencies with the recent expansion of trade mark protection. The few defences available were not designed to protect artistic expression. Even when these defences are construed to protect artistic expression, the burdensome requirement of honest practices is a bar to the reliance on these defences for artists. The due cause limitation may be relied on in the context of artistic expression, but it would only be available against sound mark reputation claims.

As a result, it can be said that sound mark protection is difficult to acquire but offers extensive rights to its proprietors, at the expense of artistic expression. Next to it, the phonogram regime could be an unorthodox but easy way to protect sounds used in the course of trade in relation to goods or services (Section III).

III. THE EASILY ACQUIRABLE PROTECTION OF PHONOGRAMS UNDER EU LAW

Phonograms are protected by so-called related rights. The light criteria for their protection are defined in EU legislation and international instruments (Section III.A). The rights granted under these regimes are set out in EU Directives and have been subject to some clarifications by the CJEU in the *Pelham* case (Section III.B).⁹⁵

A. THE LIGHT CRITERIA FOR THE PROTECTION OF PHONOGRAMS

The criteria to determine whether there is a phonogram protected by a right related to copyright diverge to some extent from the criteria for copyright protection of works. These criteria can be inferred from the Directive 2001/29/EC on the harmonisation of certain aspects of copyright and related rights in the information society (hereinafter the InfoSoc Directive),⁹⁶ and, failing that, from international treaties.⁹⁷

First, there should be a phonogram. While the InfoSoc Directive does not explicitly define what a phonogram is, it can be determined that these criteria can

⁹³ Case C-65/12 *Leidseplein Beheer BV and Hendrikus de Vries v Red Bull GmbH and Red Bull Nederland BV* EU:C:2014:49, paras 45–48. See Zelechowski (n 59) 129.

⁹⁴ *ibid* paras 27–49. See Zelechowski (n 59) 130.

⁹⁵ *Pelham* (n 9).

⁹⁶ Copyright Directive.

⁹⁷ Pila and Torremans (n 5) 267.

be found in the WIPO Performance and Phonograms Treaty (hereinafter WPPT)⁹⁸ which the EU and a majority of Member States have already signed.⁹⁹ Article 2(b) WPPT defines phonograms as the fixation of the sounds of a performance or other sounds, or of a representation of sounds, other than in the form of a fixation incorporated in a cinematographic or other audio-visual work.¹⁰⁰ Contrary to copyright protection,¹⁰¹ no requirement of originality has to be fulfilled for phonogram protection.¹⁰² Indeed, it is vested in the mere fixation of the sounds, rather than in the arrangement of these sounds.¹⁰³ This renders the threshold for phonogram protection lower than for copyright protection of works.¹⁰⁴

Another condition is that, contrary to sound mark protection, there is generally no formality required. National law may provide some formalities, but their strictness is limited to a notice including the year of the first publication and the symbol (P) placed on the copies.¹⁰⁵

Thus, in the EU, the criteria for phonogram protection are light and flexible. No creativity is necessary. While formalities could be imposed, these are, in practice, easy to overcome and require a mere inscription on commercialised copies, and no registration is required. This framework would allow undertakings to easily protect sounds used in the course of trade in relation to goods or services against artistic expression. Once the criteria for protection are fulfilled, phonogram producers can access the rights granted in relation to the said phonogram (Section III.B).

B. THE RIGHTS OF PHONOGRAM PRODUCERS IN RELATION TO ARTISTIC EXPRESSION IN THE *PELHAM* CASE

Under EU law, the set of rights granted to phonogram producers regarding their phonograms is part of the general copyright and related rights system. First, under article 2(c) of InfoSoc Directive, phonogram producers have the exclusive right to authorise or prohibit direct or indirect, temporary or permanent reproduction by any means and in any form, in whole or in part, of

⁹⁸ WIPO Performances and Phonograms Treaty (adopted 20 December 1996, entered into force 20 May 2002) TRT/WPPT/001 ('WPPT').

⁹⁹ Copyright Directive, recitals 15 and 19.

¹⁰⁰ WPPT, art 2(b).

¹⁰¹ Case C-145/10 *Eva-Maria Painer v Standard VerlagsGmbH, Axel Springer AG, Süddeutsche Zeitung GmbH, Spiegel-Verlag Rudolf Augstein GmbH & Co KG, Verlag M DuMont Schauberg Expedition der Kölnischen Zeitung GmbH & Co KG* EU:C:2011:798, para 87; Case C-310/17 *Levola Hengelo BV v Smilde Foods BV* EU:C:2018:899, para 36.

¹⁰² Case C-476/17 *Pelham GmbH, Moses Pelham, Martin Haas v Ralf Hütter, Florian Schneider-Esleben* EU:C:2018:1002, Opinion of AG Szpunar, para 30.

¹⁰³ *ibid* para 30.

¹⁰⁴ Lionel Bently and others, 'Sound Sampling, a Permitted Use Under EU Copyright Law? Opinion of the European Copyright Society in Relation to the Pending Reference before the CJEU in Case C-476/17, *Pelham GmbH v. Hütter*' (2019) 50 *International Review of Intellectual Property and Competition Law* 467, 469.

¹⁰⁵ Rome Convention, art 11. See Pila and Torremans (n 5) 272.

their phonograms.¹⁰⁶ Moreover, under article 3(b) of the InfoSoc Directive, phonogram producers enjoy an exclusive right to authorise or prohibit the making available to the public, of their phonograms in a way that the public may access them from a place and at a time individually chosen by them.¹⁰⁷ These rights are subject to exceptions and limitations set out in article 5 of the InfoSoc Directive, in special cases not conflicting with a normal exploitation of the phonogram and that do not unreasonably prejudice the legitimate interests of phonogram producers.¹⁰⁸ In addition, phonogram producers enjoy exclusive rights to allow or prohibit the rental and lending of their phonograms.¹⁰⁹ They also have a distribution right, which is the exclusive right to make available to the public, by sale or otherwise, their phonograms and copies of their phonograms.¹¹⁰ The rights of phonogram producers expire seventy years after the lawful publication of the phonogram. Failing that, they expire seventy years after their lawful communication to the public. Failing that, they expire fifty years after their fixation.¹¹¹

The CJEU has recently clarified the extent of the rights of phonogram producers in relation to artistic expression. Indeed, on 29 July 2019, the Court released three major rulings on copyright protection and copyright-related protection: *Funke Medien*,¹¹² *Spiegel Online*,¹¹³ and *Pelham*.¹¹⁴ The latter judgment was especially relevant for phonogram protection and artistic expression. Through its answers, it established the extent of phonogram protection in relation to artistic expression.

(i) The Rights of Phonogram Producers Extending to All Samples Recognisable to the Ear

Under its interpretation of article 2(c) of the InfoSoc Directive, the CJEU infers that phonogram producers' reproduction right allows them to prevent anybody from extracting a sound sample from their phonogram, even if very short, to include that sample in another phonogram in a form recognisable to the ear.¹¹⁵

To reach such a conclusion, the Court relied on the concept of a 'fair balance'. This concept was already well-established in the CJEU's judgments on

¹⁰⁶ Copyright Directive, art 2(c).

¹⁰⁷ *ibid* art 3(2)(b).

¹⁰⁸ *ibid* art 5.

¹⁰⁹ Directive 2006/115/EC of the European Parliament and of the Council of 12 December 2006 on rental right and lending right and on certain rights related to copyright in the field of intellectual property [2006] OJ L376/28, art 3(1)(b).

¹¹⁰ *ibid* art 9(1)(b).

¹¹¹ Directive 2006/116/EC of the European Parliament and of the Council of 12 December 2006 on the term of protection of copyright and certain related rights [2006] OJ L372/12, art 3(2).

¹¹² Case C-469/17 *Funke Medien NRW GmbH v Bundesrepublik Deutschland* EU:C:2019:623.

¹¹³ Case C-516/17 *Spiegel Online GmbH v Volker Beck* EU:C:2019:625.

¹¹⁴ *Pelham* (n 9).

¹¹⁵ *ibid* para 39.

copyright law, such as *Promusicae*¹¹⁶ or, more recently, *Renckhoff*.¹¹⁷ Accordingly, a fair balance must be struck between the protection of the rights of phonogram producers and the protection of the fundamental rights of phonogram users and the public interest.¹¹⁸ The CJEU thus proceeds to balance these interests. It first admits that, as a matter of fairness, reproduction by a user of a sound sample extracted from a phonogram, even if very short, must in principle be regarded as a reproduction ‘in part’ of that phonogram within the ordinary meaning of the provision.¹¹⁹ Such a reproduction shall therefore be subject to the exclusive right granted to the producer of the phonogram under that provision.¹²⁰ Nevertheless, to correctly strike the balance, the CJEU states that, if the sound is modified in a form unrecognisable to the ear in the new phonogram, it cannot be considered a reproduction under article 2(c).¹²¹ It justifies this choice by first highlighting that the protection of IP under the Charter is not absolute.¹²² Moreover, as the ECtHR highlighted, it should be possible to take part in the public exchange of cultural, political, and social information and ideas of all kinds.¹²³ Therefore, to balance adequately the two interests, the CJEU concludes that a sample taken from a phonogram and used in a new phonogram in a modified form unrecognisable to the ear for a distinct artistic creation is not a ‘reproduction’ under article 2(c) of the InfoSoc Directive.¹²⁴

Thus, in the light of fundamental rights, the CJEU has limited the extent of phonogram protection to cases where samples recognisable to the ear are used. This conclusion has many implications. First, the concept of ‘unrecognisable to the ear’ has raised concerns because of its lack of elaboration. Indeed, more precise information on the standard of the person’s hearing are necessary.¹²⁵ Are they the average layperson with little to no expertise in music? Or are they music experts who are acquainted with the industry, such as composers?¹²⁶ Moreover, it is debatable whether limiting the interest of phonogram producers to sounds that are only recognisable to the ear is enough to protect artistic expression. It may require more room to be reasonably safeguarded. Allowing phonogram producers to have claims against any sample recognisable to the ear would become

¹¹⁶ Case C-275/06 *Productores de Música de España (Promusicae) v Telefónica de España SAU* EU:C:2008:54, [2008] ECR I-271, paras 61–70. See Caterina Sganga, ‘A Decade of Fair Balance Doctrine, and How to Fix It: Copyright versus Fundamental Rights before the CJEU from *Promusicae* to *Funke Medien, Pelham* and *Spiegel Online*’ (2019) 41 *European Intellectual Property Review* 672, 675.

¹¹⁷ Case C-161/17 *Land Nordrhein-Westfalen v Dirk Renckhoff* EU:C:2018:634, paras 41–47.

¹¹⁸ *Pelham* (n 9) para 32.

¹¹⁹ *ibid* para 28.

¹²⁰ *ibid* para 29.

¹²¹ *ibid* para 30.

¹²² *ibid* para 33.

¹²³ *ibid* para 34.

¹²⁴ *ibid* paras 37, 39.

¹²⁵ Bernd Justin Jütte, ‘CJEU Permits Sampling of Phonograms Under a De Minimis Rule and the Quotation Exception’ (2019) 14 *Journal of Intellectual Property Law & Practice* 827, 828.

¹²⁶ Martin Sentleben, ‘Flexibility Grave — Partial Reproduction Focus and Closed System Fetishism in *CJEU, Pelham*’ (2020) 51 *International Review of Intellectual Property and Competition Law* 751, 757.

inconvenient in the music industry, where sound sampling is generalised. With fifty-four per cent of the new albums on *Billboard's Top 25 charts* of 2021 containing samples,¹²⁷ this technique has become one of the main tools used by composers today. Hindering its use could be detrimental to phonogram producers themselves in the longer term when their own phonograms would contain samples recognisable to the ear.

(ii) *The Impossibility of Relying on External Exceptions Based on Freedom of Expression to Protect Artistic Expression in Relation to Sound Sampling*

A second contribution by the CJEU is its refusal to rely on external exceptions based on fundamental rights to protect artistic expression. In *Pelham*, the issue was whether the exceptions to phonogram producers' rights granted under article 5 of the InfoSoc Directive were exhaustive and sufficiently protected the interests and fundamental rights of users of protected subject matter as well as those of the public interest.¹²⁸ If so, this would prevent the Member State from establishing its own 'external' exceptions under its national law. The CJEU found that, indeed, the exceptions under article 5 were exhaustive and provided enough protection for the interests of users of protected subject matter as well as the public interest.¹²⁹ This decision was, according to the Court, consistent with its previous judgments, such as *Renckhoff*.¹³⁰

To justify such a choice, the CJEU relied again on the concept of fair balance. According to the Court, the exclusive rights of phonogram producers under articles 2 to 4 InfoSoc Directive, on the one hand, and the exceptions as codified in article 5 InfoSoc Directive, on the other hand, were sufficient to strike the balance adequately.¹³¹ This internal system for balancing was sufficient to protect the fundamental rights at stake and consequently excluded the need for a system external to the Directive to protect such rights.¹³² In addition, the Court found that the internal limitations further ensure an adequate internal balance because, as article 5(5) required, the internal limitations themselves were only applicable in special cases not conflicting with the normal exploitation of the work that would not unreasonably prejudice the legitimate interests of the right holder.¹³³ As Recital 32 dictated, these internal limitations also had to be applied

¹²⁷ Tracklib, 'State of Sampling' (*Tracklib.com*, 29 November 2021) <<https://www.tracklib.com/blog/tracklib-presents-state-of-sampling-2021>> accessed 15 January 2022.

¹²⁸ *Pelham* (n 9) para 56.

¹²⁹ *ibid* para 65.

¹³⁰ *ibid* para 58. See Case C-161/17 *Land Nordrhein-Westfalen v Dirk Renckhoff* EU:C:2018:634, para 16.

¹³¹ *ibid* para 60.

¹³² *ibid* para 65. See Thom Snijders and Stijn van Deursen, 'The Road Not Taken – the CJEU Sheds Light on the Role of Fundamental Rights in the European Copyright Framework – a Case Note on the *Pelham*, *Spiegel Online* and *Funke Medien* Decisions' 50 *International Review of Intellectual Property and Competition Law* 1176, 1183.

¹³³ *ibid* para 62. See Copyright Directive, art 5(5).

consistently,¹³⁴ which implied that Member States could not provide their own external limitations in national law, given that it would disrupt the system.¹³⁵ More importantly, the Court rejected the possibility of an external system on the ground that it would bar the effective harmonisation of the copyright-related protection of phonograms.¹³⁶ Such a choice is not surprising, because the CJEU has consistently rejected traditional national doctrines in favour of the harmonisation of rights and limitations in other fields of intellectual property law, such as trade mark law.¹³⁷

Thus, the CJEU refutes that Member States can rely on fundamental freedoms to set out external limitations to phonogram protection. Instead, the CJEU uses freedom of expression as a tool to 'shape' the internal limits of phonogram protection.¹³⁸ While showing no flexibility regarding possible external limitations, the CJEU allows a liberal interpretation of the phonogram protection system to ensure sufficient protection of freedom of expression and freedom of the arts.¹³⁹ In this way, and with its liberal interpretation relying on internal balancing, the Court ensures that the practical result is similar to using freedom of expression as an external factor.¹⁴⁰

Many challenges arise from the Court's judgment on that point. First, it is doubtful whether the use of internal factors by the CJEU strikes an adequate balance between the two interests and the fundamental rights related to them to protect artistic expression. Indeed, in the case at hand, the Court did use internal factors in a way that would not tolerate a typical sound sampling situation, thus ruling at the disadvantage of artistic expression.¹⁴¹ Moreover, by refusing all forms of external factors and relying on the mere internal system found in legislation, the CJEU has rendered the system even less flexible.¹⁴² As the Advocate General has observed in his Opinion in *Funke Medien*, obvious systemic shortcomings regarding the protection of fundamental rights in relation to copyright and related rights had already emerged from the current framework, which raised the need for a legislative amendment.¹⁴³ To better this situation, scholars have advocated for the introduction of an open-ended exception in article 5 of the InfoSoc

¹³⁴ Copyright Directive, recital 32.

¹³⁵ *Pelham* (n 9) para 64.

¹³⁶ *ibid* para 63.

¹³⁷ Case C-661/11 *Martin Y Paz Diffusion SA v David Depuydt, Fabrik van Maroquinerie Gauquie NV* EU:C:2013:577, paras 54–55. See Senfleben, 'Flexibility Grave' (n 126) 762. See also Martin Senfleben, 'Trademark Transactions in EU Law – Refining the Approach to Selective Distribution Networks and National Unfair Competition Law' in Irene Calboli and Jacques de Werra (eds), *The Law and Practice of Trademark Transactions – A Global and Local Outlook* (Edward Elgar 2016) 350–352.

¹³⁸ Geiger and Izyumenko (n 9) 287.

¹³⁹ *ibid* 287.

¹⁴⁰ *ibid* 288.

¹⁴¹ *ibid* 290.

¹⁴² Senfleben, 'Flexibility Grave' (n 126) 763.

¹⁴³ Case C-469/17 *Funke Medien NRW GmbH v Bundesrepublik Deutschland* EU:C:2018:870, Opinion of AG Szpunar, para 40.

Directive, a so-called 'fair use' clause.¹⁴⁴ While not strictly corresponding to the US 'fair use' clause with its own four-factor system,¹⁴⁵ this flexible clause would function based on a balancing of fundamental rights.¹⁴⁶ This would not threaten the harmonisation of EU copyright law (and hence of phonogram protection), because this clause would be found in EU legislation itself. Meanwhile, it would allow more flexibility in the field of EU copyright law.¹⁴⁷ It would, moreover, permit an adaptation of the law when unforeseen societal, economic, or technological phenomena emerge.¹⁴⁸ Such an addition to the InfoSoc Directive would ameliorate the protection of artistic expression.

(iii) The Practical Inapplicability of the Quotation Exception for Most Artistic Uses

A third contribution by the CJEU concerns the quotation exception established in article 5(3)(d) of the InfoSoc Directive. According to that provision, reproduction and communication of a phonogram may be allowed by Member States when the phonogram is quoted in the context of a critique or review if: it relates to a phonogram that was already made lawfully available to the public; where the source, including the author's name, was made available if possible; where the work or related subject-matter was fairly used; and where it was used to the extent of the relevant purpose.¹⁴⁹ The Court found that this exception could only be relied on when the 'quoted' phonogram is identifiable in the quotation.¹⁵⁰

Again, this conclusion was reached through the medium of a fair balance of fundamental rights. The Court first analyses the concept of quotation as to be understood in its usual meaning in everyday language. It thus applies the definition stated by the Advocate General in his Opinion, that is, the use by a user of an extract of a work or other subject-matter, or the full work or other subject-matter, to illustrate an assertion, defend an opinion, or compare the work or other subject-matter and the assertions of that user, and therefore to enter into a dialogue with the work or other subject matter.¹⁵¹ Then, the Court reads article 5(3)(d) in the light of the freedom of the arts established in article 13 of the Charter.¹⁵² It infers that the technique of sampling a phonogram can only fall under the quotation exception when there is an intention to enter into a dialogue,

¹⁴⁴ Geiger and Izyumenko (n 9) 301. See also Senfileben, 'Flexibility Grave' (n 126) 763. See also Martin Senfileben, 'Bridging the Differences between Copyright's Legal Traditions – The Emerging EC Fair Use Doctrine' (2010) 57 *Journal of the Copyright Society of the USA* 521, 541. On the US 'Fair Use' test, see Lyman Ray Patterson, 'Free Speech, Copyright, and Fair Use' (1987) 40 *Vanderbilt Law Review* 1. On the application of the US fair use test in cases of sound sampling, see Edward Lee, 'Fair Use Avoidance in Music Cases' (2018) 59 *Boston College Law Review* 1873.

¹⁴⁵ Geiger and Izyumenko (n 9) 302.

¹⁴⁶ *ibid.*

¹⁴⁷ *ibid.*

¹⁴⁸ Senfileben, 'Flexibility Grave' (n 126) 763.

¹⁴⁹ Copyright Directive, art 5(3)(d).

¹⁵⁰ *Pelham* (n 9) para 74.

¹⁵¹ *Pelham*, Opinion of AG Szpunar (n 102) para 64.

¹⁵² Charter, art 13; *Pelham* (n 9) para 72.

that the phonogram is recognisable to the ear, and that the already existing conditions under article 5(3)(d) are respected. Indeed, according to the Court, which follows the reasoning of the Advocate General, no dialogue is possible where the phonogram cannot be identified.¹⁵³

Thus, the CJEU uses an internal limitation of EU copyright and related-rights law, the quotation exception, but reads it through the medium of fundamental rights to shape the internal limits of the system to ensure fair protection of artistic expression. As explicitly mentioned in *Spiegel Online*, the purpose of such use is to strike a fair balance between the right to freedom of expression of users of a work or other subject matter and the rights conferred on authors and other rightsholders and to ensure the actual use of the quotation exception when relevant.¹⁵⁴ Here, it can be said that this conclusion combines the flaws of the Court's criterion of what is 'recognisable to the ear' with those of an internal balancing, rather than an external one. Moreover, the obligation to have the intention to enter a dialogue, that the phonogram is recognisable to the ear, and that the already-existing conditions under article 5(3)(d) are fulfilled are inflexible and applicable only in a restricted number of cases, thus excluding typical sampling uses.¹⁵⁵ In the light of the foregoing, the Court's interpretation of article 5(3)(d) hardly protects artistic expression.

To sum up, phonogram protection is easy to acquire, thanks to easily satisfied conditions. It could be of interest to protect distinctive signs of goods or services offered by undertakings. While the CJEU tried to rule in favour of artistic expression by means of a balancing exercise of fundamental freedoms, the efficiency and flexibility of the solutions brought by the Court are restricted and could be favourable for such undertakings. Now that phonogram and sound mark protection have been individually analysed, it seems necessary to assess how the two systems may overlap in a way that endangers artistic expression (Section IV).

IV. THE OVERLAP OF SOUND MARK PROTECTION AND PHONOGRAM PROTECTION AS A DETRIMENT TO ARTISTIC EXPRESSION

If sound mark protection is granted, phonogram protection will almost always overlap with it (Section IV.A), which will be detrimental to artistic expression (Section IV.B).

¹⁵³ *Pelham*, Opinion of AG Szpunar (n 102) para 64.

¹⁵⁴ *Spiegel Online* (n 113) para 82.

¹⁵⁵ Geiger and Izumenko (n 9) 289–290.

A. THE OVERLAP OF SOUND MARK PROTECTION AND PHONOGRAM PROTECTION

The protections of phonograms and sound marks clearly overlap for undertakings seeking protection for their sounds when used as signs to distinguish their goods or services. In particular, this would be relevant where the sound mark-protected content has been developed as part of brand lore.¹⁵⁶ The light and flexible criteria for phonogram protection would be easily, if not automatically, fulfilled when one has already obtained sound mark protection.

When it comes to substantive criteria, sound mark protection requires a distinctive sound,¹⁵⁷ this requirement being subject to the high threshold of resonance.¹⁵⁸ Meanwhile, phonogram protection is vested in a mere fixed sound that does not even need to be original.¹⁵⁹ A sound that met the substantive requirements for sound mark protection would thus always pass the threshold for phonogram protection. With regards to formalities, sound mark protection requires compliance with a burdensome registration process,¹⁶⁰ although the representation of the sound mark on the register has become more flexible and now allows the fixation of sounds as forms of representation.¹⁶¹ Phonogram protection, on the other hand, generally requires no formality and, if national law provides some, these formalities are restricted to a mere inscription on commercialised copies of the phonogram.¹⁶² Unless national law imposes this additional, albeit light formality, the formality requirements for phonogram protection would then be met when one has already recorded a sound and represented it as a sound file on a trade mark register. Finally, phonogram protection additionally requires a certain territorial connection,¹⁶³ but thanks to the concept of national treatment, this criterion is virtually fulfilled in most cases involving a Member State.¹⁶⁴

It thus appears that, when sound mark protection is granted, phonogram protection will almost systematically overlap with it. The cumulation of the two protections can be detrimental to artistic expression (Section IV.B).

¹⁵⁶ Jane C Ginsburg and Irene Calboli, 'Intellectual Property in Transition: The Several Sides of Overlapping Copyright and Trademark Protection' in Niklas Bruun and others (eds), *Transition and Coherence in Intellectual Property Law: Essays in Honour of Annette Kur* (Cambridge University Press 2021) 312–315.

¹⁵⁷ Trade Mark Regulation, art 4(a); Trade Mark Directive, art 3(a).

¹⁵⁸ *Globo Comunicação* (n 22) para 45; *Arlagh Metal Beverage Holdings* (n 27) para 24.

¹⁵⁹ *Pelham*, Opinion of AG Szpunar (n 102) para 30.

¹⁶⁰ Trade Mark Regulation, art 6; Trade Mark Directive, art 1. On the criteria for registration, see *Sieckmann* (n 37) para 55. On the registration of non-traditional marks, see Gangjee (13) 66.

¹⁶¹ Trade Mark Regulation, art 4; Trade Mark Directive, art 3.

¹⁶² Rome Convention, art 11.

¹⁶³ *Pila and Torremans* (n 5) 270.

¹⁶⁴ Rome Convention, art 5.

B. THE DETRIMENT POSED TO ARTISTIC EXPRESSION WITH EXPANDED SOUND MARK AND PHONOGRAM PROTECTIONS

The threat to artistic expression posed by the overlap of phonogram protection and sound mark protection is twofold, because of the expansion of both sound mark and phonogram protection.

(i) The Detrimental Effect of the Expansion of Sound Mark Protection on Artistic Expression

The expansion of trade mark protection to sounds has adverse effects on artistic expression within the sound mark system itself. Sound mark proprietors enjoy a broad range of rights with claims for double identity, likelihood of confusion, and trade mark reputation to prevent artists from using identical, similar, or dissimilar sounds.¹⁶⁵ There are only a restricted number of limitations and defences on which artists could rely to avoid claims stemming from sound mark proprietors.¹⁶⁶

More importantly, the expansion has eroded the internal limitations of the trade mark system aimed at excluding sounds not used in the course of trade to distinguish goods or services.¹⁶⁷ Combined with the lack of parallel development of users' rights regarding artistic uses,¹⁶⁸ non-commercial and mixed artistic users are now exposed to sound mark claims.¹⁶⁹

The CJEU itself has acknowledged in early judgments that trade mark protection shall not be extended in a way that would clash with the public interest,¹⁷⁰ but has disregarded its own observations by eventually giving more weight to trade mark holders' interests.¹⁷¹ Moreover, while the CJEU has engaged in discussing freedom of expression in EU trade mark law, this has been a marginal phenomenon.¹⁷² Artistic expression plays a limited role in the trade mark system for the benefit of sound mark holders. Hence, within the sound mark system, the expansion of sound mark protection has adverse effects on artistic expression.

Outside the sound mark system, the expansion of trade mark protection within the natural realm of phonogram protection leads to the overlap of the two

¹⁶⁵ Trade Mark Regulation, art 9(2); Trade Mark Directive, art, 10(2).

¹⁶⁶ Trade Mark Regulation, arts 9(2) and 14(1); Trade Mark Directive, arts 10(2) and 14(1).

¹⁶⁷ Schovsbo (n 68) 564–566.

¹⁶⁸ *ibid.*

¹⁶⁹ *ibid* 557, 564–566.

¹⁷⁰ See for instance Joined Cases C-108/97 & C-109/97 *Windsurfing Chiemsee* EU:C:1999:230, [1999] ECR I-2779, para 25, as well as Case C-299/99 *Koninklijke Philips Electronics NV v Remington Consumer Products Ltd.* EU:C:2002:377, [2002] ECR I-5475, para 79. See Schovsbo (n 68) 565.

¹⁷¹ Schovsbo (n 68) 566.

¹⁷² Ilanah Simon Fhima, 'Trade Marks and Free Speech' (2013) 44 *International Review of Intellectual Property and Competition Law* 293, 319–320.

regimes, which translates into a clash of 'individual imperatives' between the purposes of phonogram protection and sound mark protection.¹⁷³

Phonogram law, as a system of related rights, was developed jointly with copyright law in the EU.¹⁷⁴ As a result, its imperatives are derived from those of copyright law, namely the dissemination and preservation of cultural expressions,¹⁷⁵ including artistic expression. In that context, the main purpose of phonogram protection is to ensure the pursuit of the cultural innovation cycle, that is the 'incessant process of the creation of fresh, original human expression on the basis of pre-existing sources of inspiration'.¹⁷⁶ Cultural expressions are produced by the constant reinterpretation of pre-existing cultural artefacts.¹⁷⁷ Connected to this idea of innovation cycle is that of intergenerational equity. This idea can be explained in two steps. In the shorter term, it dictates that there should be synchronic intergenerational equity, that is intellectual property rules should permit co-existing generations of creators to share their experiences to together develop new cultural artefacts.¹⁷⁸ In the longer term, diachronic intergenerational equity ensures that future generations of creators shall be able to develop their own cultural artefacts based on previous generations' experiences.¹⁷⁹ Hence, to safeguard intergenerational equity, the phonogram regime should, in theory, require phonogram producers to allow artists to use their phonograms to create new ones.¹⁸⁰ This is possible *inter alia* by limiting the scope of IP rights.¹⁸¹

Meanwhile, the sound mark regime has diverging imperatives.¹⁸² As part of the trade mark system, its core purpose is to safeguard 'market transparency'.¹⁸³ It permits the clear identification of the goods or services offered by an undertaking on the market so that consumers can individualise them and identify their commercial source.¹⁸⁴ This supports the prevalence of the public's favourite supplier of a type of good.¹⁸⁵ This is done by means of a stable distribution of intellectual resources among undertakings,¹⁸⁶ as evidenced by the possible

¹⁷³ Senfleben, *The Copyright / Trademark Interface* (n 10) 12. See Ginsburg and Calboli (n 156) 307–321.

¹⁷⁴ On the joint development of copyright and related rights, see Pila and Torremans (n 5) 222–233.

¹⁷⁵ Senfleben, *The Copyright / Trademark Interface* (n 10) 12.

¹⁷⁶ *ibid* 26, 29.

¹⁷⁷ Julie E Cohen, 'Copyright, Commodification, and Culture: Locating the Public Domain' in Lucie Guibault and P Bernt Hugenholtz (eds), *The Future of the Public Domain: Identifying the Commons in Information Law* (Kluwer Law International 2006) 150. See also Jessica D. Litman, 'The Public Domain' (1990) 39 *Emory Law Journal* 965, 966–967.

¹⁷⁸ Shubha Ghosh, 'Why Intergenerational Equity' (2011) 2011 *Wisconsin Law Review* 103, 107.

¹⁷⁹ *ibid* 108.

¹⁸⁰ Senfleben, *The Copyright / Trademark Interface* (n 10) 35.

¹⁸¹ Brett Frischmann and Mark P McKenna, 'Intergenerational Progress' (2011) 2011 *Wisconsin Law Review* 123, 125.

¹⁸² Senfleben, *The Copyright / Trademark Interface* (n 10) 95.

¹⁸³ Annette Kur and Martin Senfleben, *European Trade Mark Law* (Oxford University Press, 2017) 6–8.

¹⁸⁴ Andrew Griffiths, 'A Law-and-Economics Perspective on Trade Marks' in Lionel Bently, Jennifer Davis and Jane C Ginsburg (eds), *Trade Marks and Brands: An Interdisciplinary Critique* (Cambridge University Press 2008) 245–255.

¹⁸⁵ Kur and Senfleben (n 183) 6.

¹⁸⁶ Senfleben, *The Copyright / Trademark Interface* (n 10) 95.

perpetual renewal of sound mark rights.¹⁸⁷ The CJEU has acknowledged the market transparency objective of trade mark protection.¹⁸⁸ It serves the defensive purpose of preventing competitors from using marks in a way that interferes with the communication of basic information about the commercial origin of goods and services.¹⁸⁹ This permits fair competition, consumer protection, and the proper functioning of markets.¹⁹⁰ Hence, the sound mark regime is inherently designed for commercial purposes, with little consideration for artistic matters.

Thus, while phonogram protection is guided by cultural imperatives demanding a perpetual cycle of creation with a constant flow of cultural resources, sound mark protection is characterised by trade imperatives demanding a static repartition of cultural resources.¹⁹¹ These two types of imperatives diverge to such an extent that the expansion of sound mark protection within the artist-friendly realm of phonogram protection poses a bar to the cultural innovation cycle, putting artistic expression at threat of commercial claims.

(ii) The Detrimental Effect of the Expansion of Phonogram Producers' Rights on Artistic Expression

The expansion of phonogram producers' rights comes at the expense of artistic expression. The easily acquirable phonogram protection has experienced an expansion of its substantive scope of protection, which could be appropriated by sound mark holders trying to protect their sounds used as marks against artistic uses. The additional reliance on phonogram protection could permit undertakings to better protect their sounds used as marks, especially against other sounds that are not aimed at being signs used in the course of trade to distinguish their goods or services. This was rendered possible by the inadequate and inflexible solutions brought by the CJEU in *Pelham*.¹⁹² The court failed to provide safeguards to artistic expression against phonogram producers' claims, which further strengthened the likelihood of successful reliance on the phonogram regime for undertakings.¹⁹³ This judgment has fundamental consequences on the innovation cycle and poses a bar to intergenerational equity. Future musicians are virtually prevented from using short pre-existing musical artefacts, thus putting artistic expression at threat.

While it is true that phonogram protection is only granted for a limited number of years,¹⁹⁴ as opposed to sound mark protection that can be renewed

¹⁸⁷ Trade Mark Regulation, art 52; Trade Mark Directive, art 48. See Pila and Torremans (n 5) 375.

¹⁸⁸ Case C-10/89 *SA CNL-SUCAL NV v HAG GF AG* EU:C:1990:359, [1990] ECR I-3711, para 13.

¹⁸⁹ Kur and Senfileben (n 183) 6.

¹⁹⁰ Senfileben, *The Copyright / Trademark Interface* (n 10) 134.

¹⁹¹ *ibid* 95–96.

¹⁹² *Pelham* (n 9) paras 39, 65, 74.

¹⁹³ Senfileben, 'Flexibility Grave' (n 126) 763.

¹⁹⁴ Directive 2006/116/EC of the European Parliament and of the Council of 12 December 2006 on the term of protection of copyright and certain related rights [2006] OJ L372/12, art 3(2).

indefinitely,¹⁹⁵ the cumulation of sound mark and phonogram protections for that period is still a powerful tool that could affect the very purpose of phonogram protection by posing a bar to the cultural innovation cycle. Moreover, during that timeframe, the phonogram could be updated to effectively start a new phonogram protection period.¹⁹⁶ Undertakings could combine their extensive rights under trade mark law with the extensive scope of protection available under the phonogram regime that goes beyond the ‘course of trade’ and ‘in relation to goods or services’ criteria, without any need for registration. This would only further put artistic expression at threat of commercial claims.

In sum, the cumulation of phonogram sound mark protections would be detrimental to artistic expression. This possibility would be against the imperatives of phonogram protection as it would affect the cultural innovation cycle.

(iii) Amending the Adverse Effects on Artistic Expression of the Overlap of the Phonogram and Sound Mark Regimes

To avoid the adverse effects of the overlap of sound mark and phonogram protections, it is necessary to amend the regimes. It has been proposed that we should rethink the grounds upon which to refuse registration, such as public order and morality, so that pre-existing signs with cultural significance would not be appropriated by undertakings.¹⁹⁷ Such a reform could effectively prevent the appropriation of major cultural artefacts by undertakings. However, it would not address the issue of undertakings gatekeeping their sounds used as marks to prevent artistic uses. These are usually not items of cultural significance that undertakings had appropriated but sounds that were composed with the original purpose of being marks used by undertakings.

To circumvent this problem, it has been argued that an *a posteriori* approach which balances the interests at stake should be adopted at the time of enforcement.¹⁹⁸ Rather than purely refusing to register non-traditional marks, like sounds, this approach would allow undertakings to protect their sounds used as signs to ensure market transparency while not affecting artistic expression. To reach that goal, it has been proposed to integrate a legal presumption of fair use in the honest practices test of trade mark exceptions to permit the use of a sound mark for artistic purposes.¹⁹⁹ Accordingly, the use in an artistic context of a sound mark would be presumed to be fair unless the rightsholder proves with

¹⁹⁵ Trade Mark Regulation, art 52; Trade Mark Directive, art 48.

¹⁹⁶ Ginsburg and Calboli (n 156) 314.

¹⁹⁷ See Martin Senfleben, ‘Towards a New Copyright/Trademark Interface — Why (And How) Signs with Cultural Significance Should Be Kept Outside Trademark Law’ in Graeme B Dinwoodie and Mark D Janis (eds), *Research Handbook on Trademark Law Reform* (Edward Elgar Publishing 2021).

¹⁹⁸ Gangjee (n 14) 80–88.

¹⁹⁹ Senfleben, ‘Robustness Check’ (n 64) 599–600.

individualised facts that unusual grievous harm has been inflicted on the sound mark.²⁰⁰

With regard to the rights of phonogram producers, it appears necessary to find a solution to avoid the outcome in *Pelham* in relation to artistic expression. The introduction of a fair use clause in the EU copyright regime could be a solution, as explained in detail above (see Section III.B.(ii)). This clause would protect the rights of phonogram producers while showing consideration to artistic expression by excluding fair artistic uses from the scope of their rights.²⁰¹

To sum up, the cumulation of phonogram protection and sound mark protection would be detrimental to artistic expression. With the two regimes overlapping, undertakings could successfully rely on it to protect their sounds used as signs in the course of trade, at the expense of artistic expression. This possibility would be against the very imperatives of phonogram protection. Reforms to integrate fair use in both sound mark and phonogram regimes should be considered.

V. CONCLUSION

This article has tried to determine how sound mark and phonogram protections could overlap in EU law, and to examine the resulting cost upon artistic expression. First, it has analysed sound mark protection. While acquiring sound mark protection remains difficult, the criteria for registration have become more flexible and have been clarified. However, the rights granted to sound mark proprietors are extensive and allow them to challenge a variety of sounds, sometimes even outside the course of trade and with no relation to goods or services, at the expense of artistic expression. Second, it has demonstrated that phonogram protection is easy to acquire thanks to its light requirements. It has argued that the CJEU in *Pelham* failed to provide efficient and flexible safeguards to protect artistic expression against phonogram producers' claims. Finally, it has explored the detrimental effects on artistic expression caused by the overlap of sound mark protection and phonogram protection. It has shown that phonogram protection will easily, if not automatically, overlap with sound mark protection when the latter is granted. It has then demonstrated that the accumulation of the two protections leads to detrimental effects on the cultural innovation cycle, at the expense of artistic expression.

Today, European Union laws on phonogram protection and sound mark protection overlap easily, if not automatically, once sound mark protection is granted. This allows a cumulation of the two protections, although they are in theory guided by diverging imperatives. The combined effects of the expansion of sound mark protection and the non-protective approach to artistic expression

²⁰⁰ *ibid* 592.

²⁰¹ Geiger and Izyumenko (n 9) 301.

regarding phonogram protection in *Pelham* cause serious interference with artistic expression. Neither of the two regimes adequately protects artistic expression, and the possibility of combining them puts artistic expression at serious risk. They inhibit the cultural innovation cycle by affecting intergenerational equity.

Reforms are necessary to mitigate the adverse effects of the overlap of the sound mark and phonogram regimes on artistic expression. In the sound mark regime, it is necessary to introduce a presumption of fair use so that the honest practices requirement does not inhibit the cultural innovation cycle. Similarly, a fair use clause should be integrated in the copyright regime so that a more flexible approach towards the artistic use of sounds subject to phonogram protection would be adopted. Otherwise, future artists in the EU may not be as lucky as David Gilmour was in front of the French courts.