

It's not always in the Bag!

IP owners (or perhaps their lawyers) need to get a sense of perspective, a reality check or basically chill out. Leaving aside the issues on which I have commented previously, suggesting that perhaps the scope and extent of IP protection is over-reaching and inappropriate in a global world, it needs to be remembered that IP protection is a balance and that balance must mean that the protection afforded to certain types of IP is not absolute. Nowhere is that necessary balance greater than in relation to trademarks.

Over the years there has been a tension between, for example, proprietors of trademarks and registrants of domain names; trademarks can exist for multiple owners in parallel in multiple classes (despite recent extensions to trademark rights); by its very nature, there can only be one owner of a domain name or a telephone number. This has led to an online turf war which has exhausted much legal and commercial resource.

However, it is not only within the field of trademarks that this tension exists and this month, I am looking at a case which has been before the French courts, and concerns a Danish artist before it is finally decided on the second occasion before the Court in the Hague and relates to alleged design right infringement.

Louis Vuitton –v- Plesner¹

Vuitton is the holder of various Community Design Registrations for “graphic symbols” and since 2005 has marketed a bag using that design under the name “Audra”

Nadia Plesner Joensen is an artist producing and trading in art. Since 2007, an important theme of her work was to draw attention to the differing media approach to problems in Darfur (Sudan) and other crisis areas and the entertainment industry. By establishing a link between these extremes, Plesner wanted to illustrate that the media interest in celebrities adversely affected the interest in the plight of crises such as Darfur.

In 2008², Plesner created a work “*Simple Living*” which showed an African child holding a Chihuahua dressed in pink and a handbag – an *homage* to Paris Hilton who has been repeatedly pictured with the same accessories. She gave this explanation: *Since doing nothing but hearing designer bags and small ugly dogs apparently is enough to get you on a magazine cover, maybe it is worth a try for people who actually deserve and need attention. If you can't beat them, join them! This is why I chose to mix the cruel reality with showbiz elements in my drawing “Simple Living”.*

¹ Case 389526 / KG ZA 11-294, Judgment of 4 May 2011;
http://www.mediareport.nl/wp-content/uploads/2011/05/kvdl-729332-v1-vonnis_d_d_4_mei_2011.pdf

² Or 2007, the judgment is ambiguous here.

In 2007 and 2008, Plesner used *Simple Living* as an illustration on T-Shirts and posters which she sold for the benefit of an organisation dedicated to helping the victims in Darfur.

Louis Vuitton became concerned by the association between its Audra bag and Darfur and requested Plesner to cease; when she would not, it obtained an *ex parte* order from the Tribunal de Grande Instance in Paris prohibiting the use of the Community Design. Discussions then ensued between the parties until the Danish lawyer advising Plesner advised that settlement negotiations were terminated on the basis that there had been no infringement.

Plesner continued her activities and in 2010 completed the picture *Darfurnica* which included the illustration of *Simple Living* and it was shown at an exhibition in Copenhagen at which *Simple Living* T-Shirts and posters were advertised and (in the case of T-Shirts) sold.

Vuitton then sought an *ex parte* Order against Plesner (now living in the Netherlands) and by Order dated 28 January 2011, the Court issued a preliminary injunction against her³.

Plesner sought to have the injunction overturned and the Court issued its judgment on 4 May 2011⁴.

Both parties relied on the ECHR; Plesner on Article 10 (freedom of expression) and Vuitton on Article 1 of the First Protocol (protection of property, including design rights and the Court required to weigh up these conflicting issues having regard to the ECHR earlier decision in *Appelby –v- United Kingdom*⁵ :

“1. The Court recalls the key importance of freedom of expression as one of the preconditions for a functioning democracy. Genuine, effective exercise of this freedom does not depend merely on the State’s duty not to interfere, but may require positive measures of protection, even in the sphere of relations between individuals.....[]

40. In determining whether or not a positive obligation exists, regard must be had to the fair balance that has to be struck between the general interest of the community and the interests of the individual, the search for which is inherent throughout the Convention. The scope of this obligation will inevitably vary, having regard to the diversity of situations obtaining in Contracting States and the choices which must be made in terms of priorities and resources. Nor must such an obligation be interpreted in such a way as to impose an impossible or disproportionate burden on the authorities [].”

Plesner argued that she was endeavouring to increase the public’s attention to the plight of Darfur by making works of art in which she combined the situation there with the world of show business to suggest that the latter received too much attention. For that reason she used illustrations with symbolic or iconic value, in which sometimes intellectual property rights were vested. However, she argued that the use was justified because her right to freedom of (artistic) expression should outweigh those intellectual property rights.

³ <http://www.mediareport.nl/wp-content/uploads/2011/03/ex-parte-plesner-louis-vuitton21.pdf>

⁴ http://www.mediareport.nl/wp-content/uploads/2011/05/kvdl-729332-v1vonnis_d_d__4_mei_2011.pdf

⁵ <http://graduateinstitute.ch/faculty/clapham/hrdoc/docs/echrappleby.doc>

The Court noted that Vuitton based its action solely on the Community design rights, the main objective of which is to establish a sole right to the rightholder to use the appearance of the work registered by it. The Court postulated (but did not consider) whether the function of design right might also extend to the protection of the reputation of the design or even the reputation of the rightholder as under the preliminary judgment, this function was deemed less essential in any case.

The Court considered the right to artistic freedom to be more important; Plesner had not used the design to “free ride” on Vuitton’s reputation and its use was functional and proportional and did not serve a mere commercial purpose. She used Vuitton’s reputation (and indirectly its use of celebrities to convey its message) to pass on her society critical message and in addition to the bag also used another luxury/show business picture in the form of a Chihuahua dressed in pink. There was no suggestion that Louis Vuitton (or indeed as the court stated, a Chihuahua dressed in pink) were involved in the problems of Darfur.

For these reasons, the Court quashed the earlier preliminary injunction of 27 January 2011 with retroactive effect and made a costs order against Vuitton.

Conclusion

The case raises a number of interesting legal issues; would the outcome have been the same had it dealt with trademarks or copyright rather than design rights; why did the French court come to a different conclusion (and would it have done so had Plesner challenged that *ex parte* order); did the court reach the correct conclusion in relation to the conflict between two ECHR rights; would the same conclusion have been reached if the use made by the artist had not been for the promotion of an overtly good cause – the relief of suffering in Darfur.

Perhaps the most important question is one for the legal audience; is it always a good decision to pursue every possible infringement of your rights irrespective of the public relations issues. After all, even if Louis Vuitton had been successful in court, it could be seen as having failed due to its apparent stance against humanitarian activities. There are more important brand protection and brand image issues than cease and desist. Had Vuitton embraced the use made by Plesner, it might have emerged as a hero rather than a villain. Is that not a protection of the brand?

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