

Trademark protection for faces?

A comprehensive analysis on the benefits and drawbacks of trademarks and the right to facial image

by **Barna Arnold Keserű** *

Abstract: The purpose of this paper is to present a comprehensive framework for the possibility of trademark protection for human faces. In the case law of the European Union Intellectual Property Office there are a few examples of trademarks, which consist of only photorealistic human faces. Private law protects the use of images; however, the trends of recent years demonstrate that trademarks could also have a role in such protection. The author aims to analyze the similarities and differences between trademark protection and personality rights in order to determine whether trademarks for faces are necessary or not. The over-

arching analysis compares twelve aspects of the two ways in which the legal systems protect facial imagery, highlighting their various advantages and drawbacks. The comparison includes the following attributes: function of protection, scope of protection, territorial dimensions of protection, temporal dimensions of protection, conditions of protection, content of protection, limitations and exceptions, transferability of rights, enforcement of rights, requirement of use, termination of rights and costs.

Keywords: Trademark, Right to Image, Individual Rights, Intellectual Property

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A. Introduction

1 In the global economy, competitiveness is key to the long-term success of companies. Competitiveness has a number of core elements, one of which is the intellectual property right. In the so-called II. HAG decision the European Court of Justice held that trademark rights are an essential element in the system of undistorted competition.¹ As Luszczyk noted, trademarks are lighthouses among the numerous

goods and services of varying quality, providing commercial information for the consumers.²

2 Trademarks are usually words or logos; however, any kind of sign may be subject to protection if it is capable of distinguishing goods or services. In recent years the Board of Appeal of the European Union Intellectual Property Office (hereinafter referred to as EUIPO) has recognized that photographs of human faces are eligible for trademark protection. This evolving case law has not as yet received considerable critical attention; nevertheless, it raises many practical and theoretical questions. This study

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1 C-10/89. SA CNL-Sucal NV. v. Hag GF AG (1990), European Court of Justice.

2 Luszczyk Viktor, 'A védjegy és a versenyjogi szabályozás összeegyeztetése az Európai Közösségben' [2001] Magyar Jog, 121.

- focuses on the fundamental question: compared to personality rights, is trademark protection a legitimate alternative? Does trademark protection have more benefits than the right to facial image?
- 3 The findings of this research should make an important contribution to the marketing and advertising industry, and especially for fashion models. This could prove useful, not only for European market actors and intellectual property offices, but also for non-Europeans since the investigated issues affect the core elements of trademark law, which are the same globally.
 - 4 There is a limited amount of qualitative analysis on this topic, especially in academic literature. Terpstra (2021) briefly analyzed a few Dutch examples of portrait trademarks, and argued that there are some essential objections against that phenomenon, and even if they may be overruled, not everyone would see any added value of portrait trademarks.³ Troutt (2005) investigated the application of trademark protection to actual persons from a theoretical perspective (including racism and slavery), stating that “critical theoretical interpretation of Lanham Act boundaries and culture of mass marketing suggest that the day may not be far off when a human persona may prove sufficiently distinctive in interstate commerce to qualify as a protectable signifier”.⁴ That day has already come to pass, as will be illustrated. Troutt also provides insight into a trademark infringement case related to the golf legend Tiger Woods.⁵ Woods’ portrait was used without permission, thus he sued for trademark infringement. The court denied the lawsuit on all grounds, arguing that Tiger Woods cannot be a walking, talking trademark. Images and likenesses of Woods are not protectable as a trademark because they do not fulfil the trademark function of designation. Dogan and Lemley (2006) argued from a moral perspective that the people who claim ownership rights over their personalities are willing, in many cases, to sell their dignity for a fairly low price. It is a form of paternalism where individuals are protected against their own commodification.⁶

3 Syb Terpstra, ‘Famous faces: the portrait as a trademark’ (2021, <https://bureaubrandeis.com/famous-faces-the-portrait-as-a-trademark/?lang=en>).

4 David Dante Troutt, ‘A Portrait of the Trademark as a Black Man: Intellectual Property, Commodification, and Redescription’ (2005) 38 U.C. Davis Law Review, 1141 (p. 1142).

5 ETW Corp. v. Jireh Publ’g., Inc. 332F.3d 915 (6th Cir. 2003).

6 Stacey L. Dogan & Mark A. Lemley, ‘What the Right of Publicity Can Learn from Trademark Law’ (2006) 58 Stanford Law Review 1161 (p. 1182).

- 5 A further study will examine the landmark decisions of the EUIPO in cases involving the protectability of faces and the trademark law issues arising from them. For the purposes of this study, it is sufficient to point out, that in the first instance the EUIPO has refused the application on the basis of lack of distinctiveness, but the Board of Appeal (hereinafter referred as BoA) has repealed the decisions and ordered the trademark applications to be published in accordance with the general registration procedure. The first indicator of the new case law concerns the Dutch model Maartje Robin Elke Verhoef, who has applied for trademark protection on her face on 14 October 2015. It was initially rejected, but in November 2017 the BoA held that the portrait photo met the criteria for protection.⁷ Rozanne Verduin and Yasmin Wijnaldum has also filed their portrait photo on 16 October 2017, and 11 September 2018. According to the same script, the BoA has annulled the refusal decisions and ordered to continue both registration procedures in May 2021.⁸ In recent months two additional cases have been concluded with the same result. The portrait of Jill Kortleve, filed on 18th of January 2022 was supported by the BoA in December 2023,⁹ and the portrait of Puck Schrover applied on 19 April 2023 was approved by the BoA in January of 2024.¹⁰

B. METHODOLOGY AND THE SOURCE OF DATA

- 6 The subject of the investigation are portrait trademarks. This is not an existing category in trademark classifications. Throughout the paper, the term portrait trademark refers to trademarks, which only contain photorealistic representation of human faces, either of real persons or computer-generated persons, and the trademark does not include any other distinctive elements such as names, titles or logos. Non distinctive frames or backgrounds are allowed. The signs may be colored or black and white as well.

7 EUIPO, Decision of the Fourth Board of Appeal in the case R 2063/2016-4 (EUTM 014679351)

8 EUIPO, Decision of the Fourth Board of Appeal in the case R 468/2021-4 (EUTM 017953534), EUIPO, Decision of the Fourth Board of Appeal in the case R 378/2021-4 (EUTM 017358458).

9 EUIPO, Decision of the Fourth Board of Appeal in the case R 1704/2023-4 (EUTM 018640603)

10 EUIPO, Decision of the Fourth Board of Appeal in the case R 2173/2023-4 (EUTM 018864324)

- 7 From a practical point of view, searching for portrait trademarks in the EUIPO eSearch plus database is not an easy task. At present, there is no separate administrative category for portrait trademarks; in most cases they are registered as figurative trademarks and less frequently as 3D trademarks. The Vienna Classification (from January 1, 2023 the 9th edition is in force) provides an opportunity to search for human faces among figurative trademarks (2.1.1. class for men, 2.3.1. for women, 2.5.1. for children). However, it has no allowance for the type of visualization, so in this way a uniquely drawn figurative face is in the same Vienna class as the photorealistic portraits. It shall be noted that the Vienna classification of EU trademarks are not completely consistent; e.g., the 011552321 trademark with the photo of the Hungarian Judit Stahl is classified as just a picture (22.05.01.), not a human face. However, in this class there are only 539 EU trademarks, which makes it easy to find realistic photos among them.
- 8 Irrespective of the actual status, among the circa 3400 EU trademarks with female faces, 50 trademarks and trademark applications can be listed according to the eSearch plus, which are photorealistic photos without any distinctive element (like names or logos). From the 50 listed trademarks, 38 have been filed since 2015, and 21 since 2021. Using the same selection method, among the approximately 8800 EU trademarks with male faces there are 67 photorealistic photos, or computer-rendered faces. More than half of these trademarks have been filed since 2021. It should be noted that a trademark application filed in 2022 consists of a female face although it is categorized as a male face in the EUIPO database, so the presented data is corrected accordingly. Only 4 trademark applications were filed for children's faces, three of them for boys, and one for a family photo with boys and girls.
- 9 In the Annex the application number for the collected trademarks can be found. The following table summarizes these data:

According to EUIPO database	Male portrait	Female portrait	Children portrait
Total number of applications	67	50	4
Currently under protection	57	23	3
Currently under examination	1	10	0
Before Board of Appeal after the refusal	0	4	0
Filed after 2015	48	38	2
Filed after 2021	38	21	0

1. Table on the portrait trademark applications at the EUIPO until 26th November, 2023. Compiled by the author.

- 10 Despite the fact that the absolute number of portrait trademarks is still low, there has been a progression in the last years in the number of new applications. The author deduces from the data gathered that the increasing number of portrait trademarks justifies the comprehensive research of this topic. Among the female trademarks, the majority of signs are photos of fashion models, while among males the earliest trademarks refer to sportsmen, like Michael Schumacher or John Cena and other wrestlers. In the last years, mainly Dutch applicants started to exploit the trademark protection, and a new trend is the application of AI-generated realistic faces; 46 such applications were filed by Trend Development BV., and all of them have already been registered. It should be noted that the high number of applications relating to only one applicant distorts the objectivity of trends.
- 11 The study is based on the qualitative assessment of trademark law and private law. During the comparison of trademark protection and personality rights, the detailed assessment of personality rights will be carried out according to Hungarian law, as there isn't unified private law in the European Union. However, the aspects examined are the same in each country, so the structure of comparison can be applied to any legal system. The main contribution of this paper is to provide the necessary comparative framework for further evaluations. In the paper the term of the right to facial images is used as a synonym for the right to personal portrayal and the right to likeness.
- 12 On the side of trademark law the rules of Regulation (EU) 2017/1001 of the European Parliament and of the Council on the European Union trade mark (hereinafter referred to as EUTMR), and the 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 (recast) (hereinafter referred to as Trademark Directive) provide the basis for the comparison.
- 13 The analysis is carried out according to twelve dimensions which may be important for strategic decisions. In the conclusion the results of the comparison are illustrated in a point-scale based spreadsheet.

C. TRADEMARK PROTECTION VS. PERSONALITY RIGHTS FOR HUMAN PORTRAITS

I. Function

14 It is generally accepted that the function of trademarks is to identify the goods or services of the owner and to distinguish them from the other competitors' goods and services. This function can be detected in the ancient times as well, where the signs used by the producers served as the indication of source of origin.¹¹ However, the value of modern trademarks lies in their selling power, because – as Schechter argued – the primary function of trademarks shall be the creation and retention of custom.¹² The traditional approach is supported by the recital (11) of the EUTMR and recital (16) of the Trademark Directive. This function shall be considered within the scope of trade. Article 10. of Trademark Directive provides exclusive rights to the owners, entitling them to prevent all third parties from using the trademark without consent in the course of trade, in relation to the goods and services. Thus, the scope of trademark protection covers only the commercial activities, which is clearly a serious limitation. Non-commercial activities, such as private use, political use, and use by civil organizations are beyond the scope of trademark law if they lack commercial elements. This is in harmony with Article 16. of the TRIPS Agreement which also limits protection to trade.

15 Trademark is a form of intellectual property. In fact, it is a special form because, unlike other types of intellectual property, it does not necessarily require creative activity. Creativity is at the heart of patent or copyright, but not for the commercial signs of origin, at least not at first sight. However, in order to avoid the grounds for refusal, the given sign shall have something new, uncommon, and original. It is not prescribed by the law directly, although through the system of grounds for refusal it is obvious that a commercial sign which is merely descriptive, or generally used in the course of trade, or, indeed, just the mere copy of an existing trademark, is not acknowledged by the law, and can be excluded from protection, either ex officio or upon request. These requirements can be deemed as the manifestation of creativity. From this perspective a serious concern arises: how can we classify a human face as a form of intellectual property? Natural faces – which are not

designed by a surgeon – are the “products” of nature. They were not created by anybody, they evolved by the laws of nature and evolution. The author argues that the basic philosophy of intellectual property rights is to protect human creativity, even in the trademark law as well, despite the fact that is not immediately obvious. The protection of human faces expands the theoretical foundation of intellectual property.

16 In the majority of trademarks collected, the owner is not the subject of the sign but a legal entity, such as advertising and model agencies. This leads us to a very important question: who is the owner of the face? The de facto owner is, of course, the individual who “wears” that face; however, if the trademark owner is another person, then the legal owner will be different from the natural bearer of that sign. It is a philosophical contradiction of trademark law: how can somebody own exclusive rights to a sign, if the sign inseparably belongs to a human, who cannot be forced to cease the wearing of it. Immanuel Kant shall be quoted at this point: *“Man cannot dispose over himself because he is not a thing; he is not his own property; to say that he is would be self-contradictory; for in so far as he is a person he is a Subject in whom the ownership of things can be vested, and if he were his own property, he would be a thing over which he could have ownership. But a person cannot be a property and so cannot be a thing which can be owned, for it is impossible to be a person and a thing, the proprietor and the property.”*¹³ This citation clearly depicts the immanent contradiction raised by portrait trademarks: the exclusive economic rights provide economic power over a “property”, which cannot be separated by the human subject, since it is an immanent characteristic of the individual. Whereas the evolution of civil rights, especially human dignity and legal equality, led to the fundamental principle that no person shall be regarded as the property of others,¹⁴ trademark protection for portraits reopens the way for economic slavery of humans through the exclusive control of their bodies.

17 Civil law provides personality rights to protect various aspects of an individual, such as the right to bear a name, the right to reputation, the right to privacy, and the right to a facial image. According to the Hungarian Civil Code (hereinafter referred to as Civil Code), the consent of the individual affected shall be required for producing or using their likeness or recorded voice.¹⁵ The function of personality rights is to provide legal protection for the immanent

11 Vida Sándor & Kováts Borbála, 'Árnyjelzők az ókorban' [2020] Iparjogvédelmi és Szerzői Jogi Szemle 78-79.

12 Frank Isaac Schechter, 'The Rational Basis of Trademark Protection' (1927) 40 Harvard Law Review 813 (p. 813-814).

13 Troutt, *ibid.* 1142, citing Margaret Jane Radin, 'Market Inalienability' (1849) 100 Harvard Law Review.

14 Article 4. of Universal Declaration of Human Rights.

15 Article 2:48(1) of Civil Code

slices of personality. Unlike trademarks, personality rights offer protection, not only in the course of trade, but generally, without any restriction. This way a privately taken photograph of an individual infringes the right to a facial image in the absence of consent. It is a major difference between trademark protection and the right to a facial likeness in favor of the latter.

II. Scope of protection

18 In theory, the essential function of the trademarks can be achieved through the exclusive rights granted to the owner. Since the adoption of the Paris Convention, it has been a widely accepted feature of trademark law that the owner may exclude any third party from using the sign in respect of identical or similar goods or services.¹⁶ This exclusive right is twofold: First, it refers to the fact that the trademark owner is entitled to use the sign, and second, everybody else is prohibited from such a use. The use of own sign do not requires any legal procedure, while the possibility of excluding others from that use is the result of the trademark registration (not to mention some cases of unfair competition, which, compared to trademark law, require more conditions to prohibit the use by others).¹⁷ The list of goods or services is a necessary element of trademark application, which shall be structured according to the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks. Therefore, a portrait trademark confers exclusive rights only in respect of the list of goods and services, and not in general. In contrast, the right to a facial image has no such limitation; it exists independently from any types of goods or services. The rightsholder can enforce the right to a facial image against any unlawful act in any field. This is a major advantage on the side of personality rights.

19 The Paris Convention recognizes well-known trademarks, and both the Trademark Directive and EUTMR recognizes the protection of trademarks with reputation.¹⁸ Such trademarks enjoy a wide range of protection, irrespective of the list of goods and services. In the case of famous persons their portrait trademark may acquire such broad protection,

which leads to the same effect as personality rights.¹⁹ However, while this range of protection is the basic characteristic of the right to personal portrayal, in the case of trademarks, only the trademarks with reputation may obtain the same legal consequences.

III. Territoriality of rights

20 Intellectual property rights are territorial by nature. Territoriality is one of the main features of intellectual property rights.²⁰ It is a clear consequence of the territorially varying legal systems. The Paris Convention introduced the right of priority based on earlier trademarks, the purpose of which is to reduce the drawbacks of territoriality during the spatial expansion of the owner. Similarly, personality rights are also territorial, as they are the part of the civil law of the country concerned. Intellectual property rights are far more internationally harmonized than civil law. The Paris Convention of 1883 and Berne Convention of 1886 initiated the international harmonization of this area, and it is still ongoing. At that time, only a few countries had already adopted a civil code; for instance, Hungary's first civil code was adopted only in 1959.

21 Nowadays, traditional civil law (including personality rights, law of property, law of inheritance, law of obligations and so on) is not harmonized at an international level, and only to a small extent harmonized at an EU level, which mainly focuses on consumer protection aspects.²¹ Deeper harmonization – especially in the field of personality rights – is not necessary at all, since every EU member state has its unique legal tradition, and the social order and social values may differ country by country. However, since intellectual property rights are considered primarily as an economic tool,²² the

16 Article 6bis of Paris Convention.

17 Beck Salamon, *Magyar védjegyjog* (Kertész József Könyvnyomdája, 1934) 159-160.

18 Article 9. (2)c) of EUTMR and Article 10 (2)c) of Trademark Directive.

19 Munkácsi Péter, 'A közismert és jó hírű védjegyek az Európai Bíróság „General Motors Corporation v. Yplon SA („Chevy”) döntése tükrében' [2000] Iparjogvédelmi és Szerzői Jogi Szemle 22.

20 Bobrovsky Jenő, 'Az enyém, a tied és a miénk a szellemi tulajdonban. Áttekintés a közkincs és a szellemi magántulajdon egyes összefüggéseiről az Internet tükrében' (p. 13.) <http://www.mie.org.hu/pdf/Public_domain-Mie.pdf>

21 Fazekas Judit, *Fogyasztóvédelmi jog 2.0* (Gondolat Kiadó, 2022) 17-27.

22 Szalai Péter, 'A védjegyoltalom sajátos problematikája a szellemi tulajdonjogban' in Keserű Barna Arnold – Kóhidi Ákos (eds.), *Tanulmányok a 65 éves Lenkovich Barnabás tiszteletére* (SZE-DFK – Eötvös József Könyv-és Lapkiadó Bt.,

European Union provides a geographically unitary set of rights for the single market.²³ An excellent instance is the European trademark system, which ensures a unitary character for EU trademarks. It means that it has equal effect throughout the Union in respect of any status issues, such as registration, transfer, surrender or cancellation.²⁴

- 22 For the European market, the unitary EU trademark offers an advantage over the right to facial images, because trademark law provides the same content on the same legal basis for the trademark owner throughout the European Union, while the general civil law rules, and the extent of the right to image may vary from one member state to another. Outside of the European Union this advantage diminishes in the absence of regional territoriality.

IV. Temporal validity of rights

- 23 With regards to the term of protection, there are significant differences between intellectual property rights. The general theory behind copyrights and patents is that the owners and their successors have the possibility to exploit the economic potential of their creation for a limited period of time, after which the works and inventions will belong to the public domain. From this perspective, intellectual property rights are temporary, while the public domain is permanent and infinite. This thesis is supported by the historical development of intellectual property rights and expressed by the Article 8.²⁵ of the Constitution of United States of America.²⁶ However, trademark law follows a different logic. According to Adler, trademarks provide exclusivity for indefinite time.²⁷ There is no such public domain-driven reason for limited protection as in the case of copyright and patent. The term of protection and the requirement for renewal is a purely rational feature of trademark law, as it

can lead to the termination of formally registered but unused, unnecessary trademarks. It serves as a filter to purge the register of obsolete trademarks.²⁸ The TRIPS Agreement requires the member states to register the trademarks for a minimum of 7 years, and unlimited number of renewals shall be provided by the law.²⁹ In contrast, the vast majority of the countries offer 10-year terms for registered trademarks. According to the data gathered by World Intellectual Property Organization a decade ago, 10 years is the most common duration, whereas Bangladesh registers trademarks perpetually and Zambia applies the 7-year rule of TRIPS.³⁰ The Trademark Directive requires the registration of trademarks for a period of 10 years from the date of filing the application, and those may be renewed for further 10-year periods without limitation. The EUTMR applies the same rule for EU trademarks.³¹ Consequently, trademarks may be maintained forever, even after the death of the portrait model.

- 24 By contrast, personality rights may exist only during the life of the person. After death, in the absence of legal capacity, personality rights would be meaningless. Some personality rights – like the right to prevent the use of a facial portrait – may transform after death to the right in memoriam.³² The Civil Code prescribes that in the case of any violation of the memory of a deceased individual, the relative and/or the person named heir apparent in the will of the deceased shall be entitled to bring court action.³³ It shall be noted, that the rightsholder of the right in memoriam is the relative or the heir of the deceased individual, since the dead, of course, cannot obtain any rights. This right has a narrower reach than the right to facial image because the relatives or the heir may enforce it only in the case of violation of memory; however, not every use of image harms a memory. Such acts may be prevented by the living individual according to the right of likeness. The temporal limitation of personality rights and the unique transformation for right in memoriam is a

2015), 414 (p. 425-427).

23 *Study on the Overall Functioning of the European Trade Mark System*, (Max Planck Institute, 2011) (p. 145-146.)

24 Article 1.(1) of EUTMR.

25 „The Congress shall have Power To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries”

26 Bobrovsky, *ibid.* 19-20.

27 Emmanuel Adler, 'System des Österreichischen Markenrechtes' (Manzsche Verlags- und Universitätsbuchhandlung, 1909), cited by Beck, *ibid.* 96.

28 Beck, *ibid.* 96.

29 Article 18. of the TRIPS Agreement.

30 WIPO/STrad/INF/1 Rev. 1. Standing Committee on The Law of Trademarks, Industrial Designs and Geographical Indications, 2010, World Intellectual Property Organization, 182-185.

31 Article 52 of EUTMR and Article 48 of Trademark Directive.

32 Görög Márta, *A kegyeleti jog és a nem vagyoni kártérítés* (Pólay Elemér Alapítvány, 2008).

33 Article 2:50 of Civil Code, Görög Márta, 'A kegyeleti jog gyakorlásának jogosultjairól és az érvényesíthetőség időbeli korlátairól' [2005] Polgári Jogi Kodifikáció 15 (p. 15-19).

drawback as compared to the practically unlimited validity of trademarks.

V. Conditions of protection

- 25 There is a significant difference between trademarks and the right to facial image in terms of the conditions for protection. Registered trademarks require a procedure before the competent intellectual property authority. The registration procedure has been a fundamental element of trademark laws since the adoption of Paris Convention. The relevant legal sources assume that trademarks are created by registration, and the structure of the legislation follows this procedural logic. It shall be noted, that some countries which provide protection for a limited extent for unregistered trademarks, while others recognize only the registered form of trademarks, and have civil law, competition law and criminal law provisions for other commercial signs which are not trademarks.³⁴
- 26 To acquire protection, the sign shall satisfy the positive requirements: essentially it must have a distinctive character and it must be capable of being represented in a manner which enables the competent authorities and the public to determine the clear and precise subject matter of the protection.³⁵ On the other hand, the sign shall avoid the grounds for refusal (both absolute and relative grounds) as those are the negative requirements of protectability. Besides, the application shall pass more examination phases during the registration process in order to have grant of protection, which may take a considerable amount of time.
- 27 Personality rights are different from trademarks in the way they are created. Personality rights exist *ex lege*; persons are entitled to personality rights by the force of law. There is no need for administrative procedure; nobody makes a decision to grant personality rights. They are provided for every person (including legal entities where the given personality right does not inherently pertain solely to human beings)³⁶ only by the fact that every human has the right to dignity, and personality rights stems from dignity.³⁷ In this sense, personality rights are the projection of legal capacity and every person

34 Verena von Bomhard & Artur Geier, 'Unregistered Trademarks in EU Trademark Law' (2017) 107 Trademark Rep 686-698.

35 Article 4. of EUTMR and Article 3. of Trademark Directive.

36 Article 3:1. of Civil Code.

37 Article 2:42. Civil Code.

automatically possesses these rights from the beginning of their legal capacity. Consequently, the right to facial image has a striking advantage over trademarks, since no action and time is required by individuals to obtain this right.

VI. Content of protection

- 28 There are a few similarities in respect of the content of protection between trademark and the right to facial images; however, there are also a number of important differences. The primary function of both rights is to grant exclusive rights to the owner. By exclusivity every third party may be prevented from the use of the subject of protection. However, as described above, exclusive rights on trademarks can be enforced only in the course of trade and in respect of the list of goods and services (excluding trademarks with reputation). The concept of use may cover a wide range of activities. The Trademark Directive and EUTMR simultaneously presents instances of use, such as affixing the sign to the goods or to the packaging, offering or putting the goods on the market, or stocking the goods for those purposes, importing and exporting the goods under the sign, using the sign as a trade or company name, and using the sign on business papers and in advertising.³⁸
- 29 In contrast, the content of the right to facial image may vary from country to country. According to the Civil Code, it provides protection against the unauthorized production or use of images. Prior to 2014, the previous Civil Code only prohibited unauthorized use, whereas the current law has extended the scope of protection to production as well.³⁹ This constitutes a wide range of enforcement as it is not limited to any type of goods or services, nor to commercial activities.

VII. Limitations and exceptions

- 30 As legal systems have historically evolved, the number of limitations of rights has risen. Just as rights do not exist without limits, the protection of trademarks and the right to facial image also have their own legal limitations. Article 17. of the TRIPS Agreement allows the member states to introduce exceptions for trademark protection. The Trademark Directive under Article 14. lists certain

38 Article 10 of Trademark Directive and Article 9 of EUTMR.

39 Szeghalmi Veronika, 'A képmás polgári jogi védelme és a hazai szabályozás alapvonalainak áttekintése európai példákön át' [2014] Médiaakutató 53 (p. 55).

limitations of trademarks, where the owner is not entitled to prohibit a third party from using the sign. However, the exhaustion of the rights conferred by a trademark is regulated in a different article, it is undoubtedly one of the limitations of the exclusive rights of use. The EUTMR applies the same set of limitations and exceptions for European Union trademarks.

- 31 The limits of rights to personal portrayal vary country by country. In Hungary, there is a general clause for personality rights which defines the aims of these rights, but simultaneously sets general limits to them. According to the Civil Code, each individual is entitled to freely exercise their personality rights, but only within the framework of the law and within the rights of others. This means that the exercising of personality rights cannot result in the violation of law or harm another persons' rights.⁴⁰ Besides, the right to a facial image has specific limitations as well. A recording may be produced and used without the authorization of the individual if the recording is created in a crowd, or it is connected to activities in a public event. According to Hungarian case law, the courts apply the crowd as an exception if the visual recording aims to catch individuals as an uncountable mass of people, and to demonstrate the crowd effect. Even if the individuals can be recognized, for the sake of illustration at important events, the crowd can be recorded. The other element of the restrictions relates to such public events motivated by public interest;⁴¹ namely, political summits, publicly held speeches, riots, or events organized by public bodies. The common feature of these events is that they are part of public affairs.

VIII. Transferability of rights and in rem attributes

- 32 As explained earlier, the commercial exploitation of trademarks is a crucial point of protection. There are numerous methods of exploitation, one of which is the partial or entire transfer of ownership. Trademarks may be transferable, as Article 21. of the TRIPS Agreement requires the member states to provide the transferability of trademarks, either with or without transfer of the business to which the trademark belongs. Previously, the Paris Convention also recognized the transferability of trademarks. The version of the text in force at the

time of its adoption did not contain any guidelines on transfer. The Convention was amended in 1937 at the London Conference to include rules on assignment. Reflecting the contemporary conflicting trends in trademark law at the time, the amendment was intended to maintain the status quo, but not to force the member states to adopt new rules.⁴² It is clear from the current wording that the primary concern was to respect the trademark laws of the Member States and to preserve their independence. In particular, the Paris Convention was amended to take account of the interests of the United States, which left it to the discretion of the Member States to recognize the validity of a transfer that is made only with the undertaking or the business (goodwill).

- 33 Section 4. of EUTMR bears the title of EU trademarks as objects of property, which clearly refers to the economical consideration of trademarks. Section 5. of Trademark Directive also has the same title. Both recognize the assignment in gross, which means that the transfer may be carried out without the transfer of any other business assets, such as the undertaking partially or totally, or trade secrets.⁴³
- 34 The commercialization of personality rights varies on a wide scale among the different legal systems. As a general rule, in continental civil law countries the transfer of personality rights is not possible, or just to a limited extent, or only in respect of certain personality rights.⁴⁴ Hungarian Civil Code does not contain a specific provision on the prohibition of the transfer of personality rights. However, from the jurisprudence it is a well-established doctrine that personality rights are the derivatives of human dignity and thus non-transferable.⁴⁵ In recent years some scholars have argued in favor of new economic theories of personality rights which include the possibility of transfer by the fact that in the current socio-economic era some rights – like the right to

40 Article 2:42. of Civil Code. Fézer Tamás, 'Harmadik rész. Személyiségi jogok', in Osztovitovics András (ed.), *A Polgári Törvénykönyvről szóló 2013. évi V. törvény és a kapcsolódó jogszabályok nagykommentárja*, Vol. 1. (Opten, 2014) 249 (p. 255-258.)

41 Győr Regional Court of Appeal, ÍH2018.131.

42 Irene Calboli, 'Trademark assignment „with goodwill”: a concept whose time has gone' [2005] *Florida Law Review* 772 (p. 817).

43 Keserű Barna Arnold, 'A magyar védjegyek átruházására vonatkozó szabályok összehasonlítása a közösségi védjegyvoltalom átruházásának szabályaival, különös tekintettel a szellemi tulajdon elméleteire' [2011] *Iparjogvédelmi és Szerzői Jogi Szemle* 42 (p. 67).

44 Horst-Peter Götting, *Persönlichkeitsrechte als Vermögensrechte* (Paul Siebeck, 1995).

45 Görög Márta, 'A képmáshoz és hangfelvételhez való jog védelmének fejlődéstörténete és a jogosultat megillető „rendelkezési jog” gyökere', in Görög Márta – Menyhárd Attila – Koltay András (eds.), *A személyiség és védelme. Az Alaptörvény VI. cikkelyének érvényesülése a magyar jogrendszeren belül* (ELTE-ÁJK, 2017), 253 (p. 264).

a name or right to facial image – obviously have monetized value.⁴⁶

- 35 In order to exploit the potential economic value of facial images, trademark protection offers the full range of property rights, so it may be transferred or licensed, levied in execution, be given as security or be the subject of other rights in rem. On the contrary, the right to facial image as one of the personality rights is strongly linked to the individual; thus, economic exploitation is extremely limited by assignments.

IX. Enforcement of rights

- 36 *Lex imperfecta* in Roman law is such a norm which forbids something to be done and, if this has been done, neither voids it nor imposes a penalty on the person who has violated the law.⁴⁷ *Lex imperfecta* is a rule without consequences, thus unenforceable. Efficient legal protection requires the possibility of enforcement (*lex perfecta* norms), since the real value of a right is determined by the effective, quick, and inevitable enforcement. Enforcement of intellectual property rights is exceptionally harmonized at international levels compared to other areas of private law, in particular, personality rights. Before the TRIPS Agreement, the provisions dealing with enforcement of rights were basically general obligations to provide legal remedies and, in certain cases, for the seizure of infringing goods. At that time the enforcement was left primarily to national legislation. However, the enforcement section of the TRIPS Agreement was one of the most impactful achievements of the diplomatic conference.⁴⁸ The European Union has also taken steps to harmonize the enforcement of intellectual property rights across the EU, with the European Parliament and the Council adopting the Directive on the enforcement of intellectual property rights on 29 April, 2004. Although the detailed rules may

differ within the EU and the TRIPS member states, the trademark owners may generally foresee the applicable measures, procedures and remedies if their rights are infringed.

- 37 In respect of personality rights, neither procedural nor substantive harmonization exists for enforcement. This is clearly a weak point for the right to facial image. In Hungary, the Civil Code provides basically the same civil law remedies against infringements of personality rights as for intellectual property rights, although not to the full extent. Apart from the obvious remedies like declaration of infringement, discontinuation of infringement, restoration of the previous state, seizure of goods or depriving the infringing goods from unlawful nature, the most remarkable sanction is that the person may claim from the violating party the financial advantage acquired by the infringement according to the principle of unjust enrichment. This is independent from attributability; only the fact of infringement is necessary to apply this measure. The minimum financial advantage for unlawful use of facial images is the sum of the license fee which shall be paid at market value for the use of image. A specific remedy, which is available only in intellectual property cases, is to demand information on the identity of persons who were involved in the production or distribution of the infringing goods.
- 38 In Hungary there is a special remedy for personality rights, the so-called grievance fee, which is a monetary claim for violation of personality rights. The rules of liability for damages shall apply to this claim; however, no damages shall be proved.⁴⁹ The aim of the grievance fee is not to remedy the undesirable shifts in pecuniary relations like the purpose of tort law, but to compensate the aggrieved party for any immaterial, non-pecuniary disadvantages and inconveniences. The secondary function of the grievance fee is to punish the infringing party. The punishment is manifested in the amount of the fee, which is determined by the court, considering the degree of responsibility, the number or duration of the infringement, the severity of the infringement and its impact upon the aggrieved party and their environment.⁵⁰
- 39 While the civil law remedies and injunctions for trademarks and right to facial images are fairly similar and balanced, the degree of protection by criminal law significantly differs. According to the provisions of Article 61. of the TRIPS Agreement, the member states shall provide for criminal procedures

46 Schultz Márton, *A személyiségi jog vagyoni értékminőségének elvi és dogmatikai alapjai, különös tekintettel a névjogra* (PhD dissertation, 2019., Menyhárd Attila, 'Forgalomképes személyiség?' in Menyhárd Attila – Gárdos-Orosz Fruzsina (eds.), *Személy és személyiség a jogban* (Wolters Kluwer, 2016) 65, Harkai István, 'A képmáshoz való jog és pénzben kifejezhető értéke a számítógépi programalkotásokban' in Báró-Farkas Margit Chiara – Kemény Zsanett (eds.), *A pénzügyi világ kihívásai a 21. században* (Pro Talenti Universitatis Alapítvány, 2018).

47 Thomas A. McGinn, 'The Expressive Function of Law and the Lex Imperfecta' (2015) 11 Roman Legal Trad, 28.

48 Daniel Gervais, *The TRIPS Agreement: Drafting History and Analysis*, (Sweet & Maxwell, 2008), (p. 440).

49 Sándor István, 'A képmáshoz való jog és a sérelemdíj bírósági gyakorlatának tendenciái' [2020] Belügyi Szemle 53 (p. 63). DOI: 10.38146/BSZ.2020.4.2

50 Article 2:52. of Civil Code.

and sanctions to be applied at least in cases of willful trademark counterfeiting or copyright piracy on a commercial scale. The Hungarian Criminal Code consists of more crimes against intellectual property rights, including counterfeiting and trademark infringement as well.⁵¹ Conversely, the protection of the right to a facial image by criminal law is highly limited. While the right to facial image basically belongs to the field of civil law, criminal law only prohibits the production or publication of fake images that harm the honor of the injured party. This way, many of the unlawful, commercial use of facial images are beyond the scope of criminal law, unless those images are not protected as trademarks either.

X. Requirement of use

- 40 Trademarks as an economic monopoly right are designed to provide exclusivity, but in return this exclusive right shall be used. Trademarks in modern trademark laws cannot be registered just to permanently block the market; this is prevented by the requirement of genuine use.⁵² Although Article 19. of TRIPS does not require an obligation to use the trademarks, it recognizes that such national requirements with the provision of use are required to maintain a registration. This registration may be cancelled only after an uninterrupted period of at least three years of non-use, unless valid reasons based on the existence of obstacles to such use are shown by the trademark owner. The two main components of this rule are the minimum of years of non-use to apply detrimental consequences, and the possibility of exemption with valid reasons.⁵³
- 41 European law extends the period for lack of genuine use to an uninterrupted five years from the date of registration or later at any time during the protection, and if this period expires, the trademark

51 Chapter XXXVII. of Act C. of 2012 on Criminal Code.

52 This requirement is relatively new, most of the EU member states adopted this rule only in the second half of the 20th century. For example, the Hungarian Salamon Beck noted in 1934 that the use of a trademark is not generally obligatory, which allowed to register trademarks only for defensive purposes. However, the Ministry of Trade could prescribe mandatory use of trademarks for certain products, such as straw cutters or sugar. See Vida Sándor, 'A védjegy "tényleges használata" az Európai Bíróság gyakorlatában' [2007] Iparjogvédelmi és Szerzői Jogi Szemle 45., Beck, *ibid.* 169-172.

53 See Vida Sándor, 'A védjegy „tényleges használata” az Európai Bíróság gyakorlatában' [2011] Iparjogvédelmi és Szerzői Jogi Szemle 91.

shall be subject to negative sanctions.⁵⁴ The lack of genuine use dismantles the power of exclusivity, since an opposition or a cancellation request based on non-used trademark will be rejected, a non-used trademark cannot be enforced against trademark infringement, and finally, anyone can submit a request for a non-used trademark to be revoked.

- 42 This requirement of genuine use and all the negative effects resulting from its absence are justified by the economic function of trademarks. To the contrary, personality rights stem from constitutional human rights; in fact the recognition of personality rights is one form of the protection of human rights. This origin makes it clear that genuine use cannot be required in the case of personality rights. The right to facial images shall not be exercised obligatorily in order to maintain the protection, and the individual will never lose the possibility of enforcement in case of non-use. The right to a facial image is granted by the law without any further conditions.

XI. Termination of rights

- 43 There is a considerable difference between trademarks and personality rights in respect of termination, determined by their legal nature. Trademark protection may cease to exist on more legal grounds. The most common case of termination is the lack of renewal, as described above; the trademark owner shall periodically file an application for renewal and pay the fee in order to maintain protection. Chapter VI. of EUTMR provides provisions for surrender, revocation and invalidity as different reasons for termination. As a trademark is granted by an application, it may be surrendered by the request of owner, either in respect of some or all of the goods or services. Revocation procedures refers to cases where maintaining the protection will be detrimental to the general purposes of trademarks. As explained above, the requirement of use is a basic principle of trademark law by economic nature of trademarks; hence, non-use or the lack of genuine use is the most frequently cited ground for revocation. Another ground for revocation is the loss of distinctiveness. If a trademark is extremely widespread and leads to a nearly monopolistic situation on the market, the sign may become the common name in the trade for the product or service for which it was registered. This way the trademark loses its most essential attribute, which makes it impossible to maintain its protection. The third ground for revocation in the EUTMR relates to the informational function of trademarks, as a trademark shall be declared to be revoked if it is liable to mislead the public, in particular as to the

54 Article 16. of Trademark Directive and Article 18. of EUTMR.

nature, quality or geographical origin of those goods or services.⁵⁵

- 44 The grounds for invalidity primarily refer to cases where the trademark should not have been registered in the first place. Thus, the absolute and relative grounds for refusal are transformed into absolute and relative grounds for invalidity, which provide the post-grant assessment of these grounds. Article 60 (2) of EUTMR consists of such relative grounds for invalidity which are not mentioned among the grounds for refusal. In this way these grounds can only be invoked within a post-grant invalidity procedure instead of an opposition during the registration procedure. This group includes the right to a name, the right to personal portrayal, copyright, and industrial property rights.
- 45 While trademark protection can be terminated in more ways, the right to a facial image is an inalienable right of the individual, provided ex lege by the law; consequently, it cannot be terminated. As long as the person is alive, they are entitled to the right to a facial image, and nobody can claim the invalidity or revocation of such right. This is a considerable advantage in defense of such rights.

XII. Costs

- 46 Costs are a relevant aspect of acquiring exclusive rights. As trademarks are registered by the competent authorities, an application fee is paid for the procedure. For a European Union trademark, the lowest application fee is 850 EUR which covers one class, according to the Nice classification. The same fee be paid at the time of renewal. By and large, this is a relatively low price for an exclusive right in the entire territory of the European Union, especially in comparison with national application fees in European countries. Furthermore, it is recommended to give mandate to an attorney-at-law, especially in cases where the possibility of refusal may be high. Obviously, this entails higher costs. In contrast, personality rights are free by their nature, and are granted by law without any procedure that may involve payment. The costs of law enforcement have many variables, but it cannot be assumed that there would be significant additional costs on either side.

D. CONCLUSION

- 47 In the previous chapter, trademark protection and the right to facial image were critically compared according to twelve different aspects in order to

discover whether it is worthwhile to file trademark applications for human faces or not. The unlawful use of faces can be prohibited in both ways; however, the most important strategic question is whether the right to facial image provides sufficient protection and enforcement options, or should it be supplemented by trademark?

- 48 The following table summarizes the results of the comparison. A (+) mark indicates a considerable advantage, and (++) indicates an enormous advantage for the corresponding protection. If there is a (+) mark in both columns, it means that there is no significant difference in the examined element. It should be emphasized once more that the right to facial image is governed by national laws, hence the analysis may lead to different results in different countries based on the same evaluation criteria.

Aspects of comparison	EU Trademark	Right to facial image
Function		+
Scope of protection		+
Territoriality	+	
Temporal validity	+	
Conditions of protection		++
Content of protection		+
Limitations and exceptions	+	+
Transferability	++	
Enforcement	+	
Requirement of use		+
Termination		++
Costs		+
Total	6 +	10 +

2. Table Summarizing table of comparison. Compiled by the author.

- 49 Each type of protection has advantages and disadvantages. As can be seen in the comparison results more benefits can be identified for the right to facial image, outweighing the drawbacks, as opposed to trademark protection for portrait photographs. If the given individual has to choose between trademark and personality right to protect their image, the right to facial image seems an adequate solution. Trademark protection for faces is not essential; however, it may be complementary and the owner may benefit from the advantages of trademark protection. Primarily the economic flexibilities of licensing and transferring could be tempting, and the unlimited number of renewals could support business purposes after the death of an individual. Further study will examine how specific trademark law rules can be applied for portrait photos.

⁵⁵ Article 58. of EUTMR.



Annex: List of selected EU portrait trademarks & trademark applications

Male	Female	Children			
000554428	18640603	005305032	018585938	018935420	
000753483	W01087379	013112404	018585925		
000887190	W00900614	013960216	018585913		
001034032	002112738	015726491	018585918		
W01277883	003803591		018585895		
001257328	003930104		018585908		
001332659	004079851		018585924		
001643675	005035548		018585922		
002550036	009013558		018585910		
009086364	009213687		018585899		
010004901	010245231		018585906		
010004919	012695565		018603544		
010004927	014679351		018603548		
010004935	014657449		018603551		
010004943	016503492		018603559		
010004951	017358458		018603554		
011118767	017355066		018603569		
011775335	017393125		018603571		
012225793	017901626		018603556		
014711907	017903677 ^A				
014908602	017899480				
014908628	017953534				
014908677	017958820				
015165558	017987149				
015165434	018101943				
018100216	018098887				
018100202	018192360				
018277607	018318511				
018364862	018364871				
018406449	018452841				
018406450	018585935				
018594683	018585916				
018585960	018585956				
018585968	018603131				
018585966	018603550				
018585958	018603564				
018585967	018603546				
018585955	018603561				
018585944	018603567				
018585947	018603563				
018585965	018603568				
018585934	018608409				
018585940	018864324				
018585953	018935347				
018585951	018935419				
018585942	018935414				
018585937	018935324				
018585929	018935418				