Greetings to Annette Kur from the Second Floor

Dieter Stauder[1]

Finding the right words to salute Annette Kur is not easy, even though we worked in close proximity in the same Institute for a long time. We learned a lot about and from each other, and our professional lives had much in common. Trust developed. This is why we Max Planck people maintain our companionship and friendly familiarity. But a word of greeting in a *festschrift* should also contain an appropriate degree of scholarly distance.

In the former buildings of the Max Planck Institute, Annette's office was on the second floor of an old villa in Siebertstraße 3, a room which in earlier times was inhabited by the servants of the baronial family who had built the house. The second floor – not to forget the other floors, or the friends in the cellar – was one of the creative hotspots of the Institute, and a nucleus of friendships which were often to last for a long time. Over the years it accommodated an illustrious group of researchers and scholars, of which Rudolf Kraßer was the old master, and Kurt Haertel, one of the founding fathers of the European patent system, the celebrity. Annette became an important member of this team. All of us in Siebertstraße and, later, in the buildings elsewhere, became known as the 'Max Planck Mafia', now a fond expression for us old ones.

Annette's arrival in Siebertstraße marked the beginning of some gradual changes in the Institute, that could soon be discerned and that have had an enduring effect. Annette was the first female academic to head a department. She took over the Department for the Nordic Countries from Hans Peter Kunz-Hallstein, who originates from the same city as she does. Both are familiar with the languages, the culture and the law of the Nordic countries. We found this succession quite remarkable and decided to 'wait and see'. The North was not so far away. And it made perfect sense that a woman should be in charge of countries which have always been progressive with respect to the position of women in society.

[1] Dr. iur., ret. Professor, Université Robert Schuman, ret. Director, Section Internationale du CEIPI, Strasbourg. Translation: Ansgar Ohly.

Something was changing in the Institute; things were slightly different from what they used to be. The unmistakable male predominance among the Institute members had become less sacrosanct. Gradually, the spirit of the second floor also percolated to the management floor. At first slightly smiled at, then taken seriously, the energetic lady came to our centre of attention. The change was brought about by the ombudsman, or, rather, the ombudswoman Annette. With the ombudsman, a new figure entered the Institute. He, or rather she, protected consumers from misleading practices and deception, engaged in empirical research, looked into new types of legal action and stressed the public good to which our area of law is committed. The protection of consumers and of the economically and socially weaker was a heartfelt concern for Annette, both in professional and private life. We felt that.

Annette personified the apparent severity of the North with its commitment, fairness and humanity, as we noticed before long. But it also soon became clear to us that she was open to the South, to conservative Bavaria and its inhabitants – among whom some notable specimens adorned our Institute – and that she shared their zest for life. Annette celebrated heartily with us, including at Ringberg. The scholars, speakers and guests whom Annette invited to our old villa and who became members of our 'family' are as unforgettable to us as the Institute is to them.

At Ringberg and elsewhere, Annette has made significant contributions to the future of European trade mark, design and unfair competition law. The design law proposal, written with Marianne Levin, Friedrich-Karl Beier and Kurt Haertel, became the blueprint of EU design law. Annette's suggestions and arguments have often been the crucial ones. Her determination and her clear opinion matter and have effect.

Annette has temperament. When she said 'no' she hit the table with her fist – at least that is how it seemed to me. Her 'trade mark' is her way of forming her own opinion, defending it and contradicting inconclusive arguments, although never in a doctrinal or patronising way. We learned this from her, and her attitude spread. In her hands, the 'capitalist' instruments of intellectual property lose their rigidity. With elegance and empathy, Annette has prepared the ground for her convictions of social justice. Individuals and enterprises find protection under the umbrella of the social purposes of the law.

When we look at the impressive series of titles and honours that Annette has been awarded, at her almost endless list of publications and presentations, at her manifold contributions to and impacts on the world of intellectual property law, her companions of old times are full of admiration and respect. We honour our spirited and courageous Annette and her youthful verve from the bottom of our hearts.

Annette Kur: Toward Understanding

Stacey Dogan[1]

Any fool can know. The point is to understand.

Albert Einstein

I remember the first time that I met Annette Kur, about a decade ago, at the annual Trademark Scholars' Roundtable that Graeme Dinwoodie and Mark Janis had launched a few years earlier. As we settled into the conference room, I noticed an elegant newcomer among the familiar faces from the United States. Introductions revealed the newcomer as Annette Kur, a name that I recognized as a leading European intellectual property scholar. Beyond the name, I knew little about Annette or her work, because – like too many American intellectual property specialists – I had only the slightest familiarity with either the law or the legal literature from Europe.

Over the next two days, I observed Annette engage in the conversation with a style I have come to recognize as classic Kur. Mostly, she listened, with intensity, to the intellectual sparring over how to define and address boundary problems in trademark law. Her spoken contributions were spare but incisive, and introduced me to a complicating and contrasting European lens for understanding trademark and unfair competition law. I remember struggling with the indeterminacy of a law that turned on undefined notions of 'unfairness', especially given the variability of that concept from Germany to France to Benelux. But I was struck by the depth and breadth of Annette's knowledge of the various permutations, as well as of the historical, political, and philosophical forces that had brought them about. That knowledge, of course, comes in no small part from her position at the epicenter of European intellectual property debates over the past few decades. Perhaps the most memorable qualities that I recall from that first encounter with Annette were her

[1] Associate Dean for Academic Affairs, Professor and Law Alumni Scholar, Boston University School of Law.

open-mindedness and apparent lack of an ideological agenda. She appeared to be grappling honestly with the kaleidoscope of normative frames that we discussed; while she hailed from the European tradition, she took seriously the competition-related concerns that animated my more economically oriented approach.

In the years since that first meeting, I have engaged with Annette at countless conferences and have read a smattering of her many articles. Each of these encounters reinforces my impression of a keen thinker with a deep command of law and theory, combined with the curiosity and philosophical flexibility that allow her to change her mind. Annette has approached her scholarly journey in the best possible way: as a quest for understanding. Indeed, one might argue that her willingness to reconsider is part of what has equipped Annette to play a central role in the quest for greater coherence in a time of transition in Europe.

The remainder of this introduction describes two faces of Annette Kur: as a tutor on European IP laws and sensibilities, and as a role model for a scholarly life of relevance and meaning.

1 THE TEACHER

Before describing my experience of Annette the teacher, it may help to picture the student body I have in mind: scholars such as myself, steeped in the US tradition of intellectual property law and theory. At least nominally, US intellectual property law – including trademark – hews to a utilitarian model, with a heavy emphasis on economics and debate over the social welfare justifications for various legal rules. Of course, the literature is replete with challenges to that model, from both normative and descriptive perspectives.[2] But even skeptics concede that, as of the early twenty-first century, the language of economics, consumer welfare, and markets has played a central role in judicial and scholarly writings on intellectual property.[3] In copyright and patent law, this translates into an emphasis on incentives. In trademark law, it leads to a heavy focus on marketplace competition and concepts like

[2] For examples in trademark law, see, e.g., Deven Desai, *Bounded by Brands: An Information Network Approach to Trademarks*, 47 *U.C. Davis L. Rev.* 821 (2014); Chad J. Doellinger, *A New Theory of Trademarks*, 111 Penn St. L. Rev. 823 (2007) (contending that 'the economic approach' to trademarks 'has gradually eroded the true normative – and moral – foundation of trademark law'); Mark P. McKenna, *The Normative Foundations of Trademark Law*, 82 Notre Dame L. Rev. 1839 (2007); Mark P. McKenna, *A Consumer Decision-Making Theory of Trademark Law*, 98 Va. L. Rev. 67 (2012); Jeremy Sheff, *Veblen Brands*, 96 Minn. L. Rev. 769 (2012); cf. Ariel Katz, *Beyond Search Costs: The Linguistic and Trust Function of Trademarks* (2010) *B.Y.U.L. Rev.* 1555 (proposing a modified version of the economic model that distinguishes between the 'linguistic function' and the 'trust function' of trademarks).

[3] See Barton Beebe, *The Semiotic Analysis of Trademark Law*, 51 UCLA L. Rev. 621, 623–624 (2004) (concluding that the search-costs theory 'has long offered a totalizing and, for many, quite definitive theory of American trademark law . . . The influence of this analysis is now nearly total').

consumer search costs.[4] My own scholarship has embraced this economic lens, emphasizing competition as the principal goal of trademark law, and the legal protection of marks as a tool for achieving that goal.[5]

Because the utilitarian approach focuses on outcomes rather than deontological notions of right or wrong, scholars and jurists in the utilitarian tradition tend to frame their analysis by reference to the overall societal impact of legal rules.[6] We ask, for example, whether extending trademark protection to new subject matter would leave consumers better off (by protecting against confusion and possible mistaken purchasing decisions) or worse off (by limiting price and quality competition in product markets).[7] The law fiercely protects the right of comparative advertisers – even when their advertising may 'free ride' on trademark holders' reputations – because it enables more informed and competitive markets.[8] More generally, debates over proposed changes to intellectual property laws center on whether they will improve societal outcomes, rather than favoring a particular interest group or sector.[9]

Or at least that's the theory. In reality, developments in US trademark law can lead to much head-scratching for those who measure the law against its stated utilitarian goals. Critics have pointed out that doctrines such as post-sale confusion,[10] initial interest confusion,[11] merchandising rights,[12] and dilution[13] have little justification in a competition-centered trademark regime. Yet courts (and sometimes legislatures) embrace these doctrines, often dressing them up in the language of confusion.[14] Countless scholars have pointed out the incoherence of some of these

[4] See *Qualitex Co.* v. *Jacobson Products Co.*, 514 U.S. 159, 163–164 (noting that trademark law 'reduce[s] the customer's cost of shopping and making purchasing decisions' and 'helps assure a producer that it (and not an imitating competitor) will reap the financial, reputation-related awards associated with a desirable product') (internal citations omitted); *Ty Inc.* v. *Perryman*, 306 F.3d 509, 510 (7th Cir. 2002) ('The fundamental purpose of a trademark is to reduce consumer search costs by providing a concise and unequivocal identifier of the particular source of particular goods.').

[5] E.g., Stacey L. Dogan and Mark A. Lemley, *The Merchandising Right: Fragile Theory or Fait Accompli?*, 54 Emory L.J. 461 (2005); Stacey L. Dogan and Mark A. Lemley, *Trademarks and Consumer Search Costs on the Internet*, 41 Hous. L. Rev. 777 (2004).

[6] See generally Graeme B. Dinwoodie, *The Death of Ontology: A Teleological Approach to Trademark Law*, 84 Iowa L. Rev. 611 (1999).

[7] Id.

[8] See, e.g., Stacey L. Dogan and Mark A. Lemley, *A Search-Costs Theory of Limiting Doctrines in Trademark Law*, 97 Trademark Rep. 1223 (2007).

[9] See generally Stacey Dogan, *Greeted with a Shrug: the Impact of the Community Design System on United States Law*, in Annette Kur, Marianne Levin and Jens Schovsbo (eds.), The EU Design Approach: A Global Appraisal (Edward Elgar, 2018), 207, 209.

[10] See Sheff, *Veblen Brands*, note 2 above.

[11] See Dogan and Lemley, *Trademarks and Consumer Search Costs*, note 5 above.

[12] See Dogan and Lemley, *The Merchandising Right*, note 5 above.

[13] 15 U.S.C. § 1125(c).

[14] E.g., *Boston Prof'l Hockey Ass'n, Inc.* v. *Dallas Cap & Emblem Mfg., Inc.*, 510 F.2d 1004 (5th Cir. 1975) (concluding that, despite the district court's opinion that the defendant's use of

explanations. As Greg Lastowka observed, 'Courts sometimes perform their multi-factored analysis in such bizarre ways that some sort of doctrinal mischief is clearly afoot'.[15] Courts, in other words, are rationalizing their decisions by reference to traditional legal standards, but their outcomes seem in tension with the normative goals that those standards were designed to promote. At least in some of these cases, the outcome cannot be justified based on utilitarian principles. There's something else going on.

It is against this backdrop that I encountered Annette Kur for the first time. I had spent the last several years (often with Mark Lemley) grappling with the 'doctrinal mischief' committed by courts in internet-related trademark cases.[16] Like many other US scholars, we framed our critique within the utilitarian tradition, pointing out that the courts' decisions (which effectively expanded trademark holders' rights) would reduce competition, impoverish the information marketplace, and leave consumers worse off. Defendants made these same claims in litigation, but often to no avail.[17] In our view, these courts had seized on expansive notions of confusion to allow claims of infringement designed to prevent reputational free riding rather than to promote functioning competitive markets.[18] This anti-free-riding impulse struck us (and others) as inconsistent with the competition-based foundation of US trademark law.

Before meeting Annette, I was generally aware that Europe approached trademark law through a different conceptual lens. Over the course of that first Roundtable with Annette, however, I began to understand the history and political economy of European trademark law, and how those forces shaped trademark doctrine in the region. I came to appreciate, for example, the role of the French perfume industry in inserting a curious provision into the Comparative Advertising Directive that prohibits certain forms of truthful comparative advertising that would clearly benefit consumers.[19] I grew familiar with the explicit anti-free-riding protection contemplated by the European Trademark Directives.[20] And I came to realize

trademarks did not confuse consumers '[w]here the consuming public had the certain knowledge that the source and origin of the trademark symbol was' the mark-holder, the use constituted infringement).

[15] Cf. Greg Lastowka, *Trademark's Daemons*, 48 Hous. L. Rev. 779, 790 (2011).

[16] Dogan and Lemley, *The Merchandising Right*, note 5 above; Dogan and Lemley, *A Search-Costs Theory*, note 7 above.

[17] E.g., Brief for Defendant-Appellee, *Rescuecom Corp.* v. *Google Inc.* (2d Cir., filed Feb. 27, 2007, 2007 WL 6475452); cf. *Rescuecom Corp.* v. *Google Inc.*, 562 F.3d 123 (2d Cir. 2009).

[18] Dogan and Lemley, *A Search-Costs Theory*, note 8 above.

[19] Directive 2006/114/EC of the European Parliament and of the Council of 12 December 2006 concerning misleading and comparative advertising, Art. 4(g); see generally Annette Kur, Lionel Bently, and Ansgar Ohly, *Sweet Smells and a Sour Taste – the ECJ's L'Oreal Decision*, Max Planck Institute for Intellectual Property, Competition & Tax Law Research Paper Series No. 09-12, available at http://ssrn.com/abstract=1492032.

[20] See 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 trademarks, Art. 5(2) (the Directive in

that the feature of US trademark law that I had long criticized as incompatible with the economic view of trademarks – in particular, the persistent intuition that free riding on trademark holders' reputation was somehow wrong – was baked into the trademark law of Europe.

While I initially reacted with dismay at what I viewed as Europe's failure to appreciate the importance of *competition* in unfair competition law, I have realized, under Annette's tutelage, that European notions of 'unfairness' resemble the anti-exploitation impulse that lurks beneath the surface of so many US trademark opinions. Free riding, in other words, troubles courts in both the USA and Europe, but Europe offers a vehicle for addressing it; one might argue that European law is simply more honest, and avoids the doctrinal distortions so common in US law.

Upon closer examination, however, the impression of convergence toward a global anti-free-riding norm appears premature. For one thing, even though courts seem to overlook it at times, US trademark law's emphasis on competition gives advocates a tool to challenge courts' expansionist impulses, and often results in corrections over time. In the internet context, for example, courts have written more nuanced opinions as they have appreciated the benefits to consumers from various unauthorized uses of marks.[21] And the Supreme Court has used competition as a reason to limit trademark rights in other ways, including to add rigor to the secondary meaning and functionality standards in the product design context.[22] In other words, the absence of a *right* against 'taking unfair advantage' matters in US law; while courts may try to circumvent it at times, the normative framework at least partially constrains them.

Even so, the fact that courts in both systems have visceral reactions to free riding says something about basic human intuitions regarding notions of reputation, identity, and exploitation. I have learned from Annette to think critically about my assumption that markets and economics offer the only rational model for trademark

place when I met Annette); see also Commission Regulation 2017/1001 of 16 June 2017 on the European Union Trade Mark, Art. 9(2)(c); Directive 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trademarks, OJ L 336, Art. 10(2)(c).

[21] E.g., *Network Automation, Inc.* v. *Advanced Systems Concepts, Inc.*, 638 F.3d 1137 (9th Cir. 2011). European case law reflects a similar trend. Compare, e.g., *Google France SARL* v. *Louis Vuitton Malletier SA*, 2010 ECJ (C-237-08) (holding that keyword-based ads linking to competing products may interfere with the source-identifying function of a trademark and therefore constitute infringement), with *Interflora Inc.* v. *Marks & Spencer plc*, 2011 ECJ (C-323-09) ¶ 45 ('[O]ne of the blessings of the internet is precisely that it greatly enhances consumers' possibilities to make enlightened choices between goods and services.'). Indeed, rather than convergence toward a global anti-free-riding norm, perhaps we are witnessing a convergence toward an approach that balances trademark-holder concerns with those of consumers and competitors.

[22] E.g., *Wal-Mart Stores, Inc.* v. *Samara Bros., Inc.*, 529 U.S. 205 (2000); *TrafFix Devices, Inc.* v. *Marketing Displays, Inc.*, 532 U.S. 23 (2001).

protection. The fact that culturally rich Europe judges fairness by a different metric has at least opened me to the possibility of a different world view.

2 THE ROLE MODEL

While I found Annette's substantive instruction in European trademark law eye-opening and educational, her more lasting impact came through the model that she provided of a scholarly life of relevance, incisiveness, and integrity.

It must have been heady for Annette, as a young scholar, to play such a central role in the crafting of the European Design System. She approached the task with vigor, proposing with her co-authors a framework for protecting the 'design approach'.[23] At the time, she and her colleagues were convinced that 'the needs of the design industry' mandated a sui generis design right. They forged ahead with a proposal that the European Parliament accepted almost whole cloth.[24] For scholars (as opposed to lobbyists) to have such a dramatic impact on the law is almost unprecedented. Having achieved such spectacular success, one might have expected Annette either to rest on her laurels or to spend the ensuing years defending and justifying the Design System's virtues.

Annette, however, viewed her part in the European Design System as anything but complete. After the system went into effect, she shifted into an evaluative role, observing the law's rollout with a dispassionate eye. She hosted workshops at the Max Planck Institute to assess the law's economic impact and to gauge its interpretation by the courts. She wrote articles exploring some of the unanticipated effects of the design law, such as its use to inhibit competition in the market for spare automobile parts.[25] And she grappled with competition concerns associated with allowing designers to tack on multiple forms of legal rights over the same design feature.[26] Most recently, in a book reflecting on the design experience from the Max Planck study through the present, Annette frankly acknowledged that the original proposal came at a time of 'strongly affirmative' views on intellectual property protection, and gave inadequate attention to limitations and exceptions.[27] Annette's openness, non-defensiveness, and intellectual flexibility have allowed

[23] See Max Planck Institute for Foreign and International Patent, Copyright and Competition Law, *Towards a European Design Law* (1991). For a history of the project and its impact on European law, see Annette Kur and Marianne Levin, *The Design Approach Revisited: Background and Meaning*, in Annette Kur, Marianne Levin and Jens Schovsbo (eds.), The EU Design Approach: A Global Appraisal (Edward Elgar, 2018), 1–27.

[24] See Kur and Levin, id.

[25] See, e.g., Josef Drexl, Reto Hilty and Annette Kur, *Design Protection for Spare Parts and the Commission's Proposal for a Repairs Clause*, 36 IIC 448–457 (2005).

[26] E.g., Annette Kur, *What to Protect, and How? Unfair Competition, Intellectual Property, or Protection Sui Generis*, in Na Ri Lee et al. (eds.), Intellectual Property, Unfair Competition and Publicity (Edward Elgar European Intellectual Property Institutes Network Series, 2014), 11–32.

[27] Id. at 25.

her to play an ongoing, constructive role in shaping the design system – and intellectual property laws more generally – at a time of transition in Europe.

Her combination of vision, vigor, humility, and insight make Annette a model of a scholar who seeks not only attention, but relevance over time. In an industry that often rewards the most provocative and polarizing ideas, Annette opts for the pragmatic and incremental. In a community of people who like to hear themselves speak, Annette listens. As she wrote in 2014, in discussing the tension between unfair competition and other forms of intellectual property:

> For the academic community, it follows that long-standing efforts by many to shed more light on this complicated and complex area should be continued and, where possible, deepened. Moreover, we should definitely become more 'European' in the way in which we try to arrive at a deeper understanding, and a more transparent and consistent treatment, of the many issues posed [by the tensions that her work explored.]

May we all become more 'European' in the sense that Annette describes it – in a way that seeks deeper understanding, transparency, and consistency across different areas of law. May we all, in other words, be a little more like Annette Kur.