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TRADEMARKS AND THEIR RELATION
WITH LITERARY AND ARTISTIC WORKS

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CONTENTS

I. INTRODUCTION

1. At the fifteenth session of the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT), held in Geneva from November 28 to December 2, 2005, the SCT agreed to ask the International Bureau to prepare an issues paper on trademarks and copyright (see document SCT/15/4, paragraph 19). Accordingly, the Secretariat has prepared the present document, which discusses the rationale, criteria and subject matter of copyright and trademark law (chapter II.), the scope of protection under the respective protection regimes (chapter III.) and issues of cumulative protection (chapter IV.).

2. The document is intended to set out some of the issues connected with the protection of trademarks and their relation with literary and artistic works. It may also facilitate selecting particular aspects for further analysis by the SCT, should the Committee find it desirable to do so.

II. RATIONALE, CRITERIA AND SUBJECT MATTER OF PROTECTION

3. In this chapter, section (a) discusses the rationale, criteria and subject matter of copyright protection. Section (b), correspondingly, deals with the rationale, criteria and subject matter of trademark protection. The final section (c) highlights the conceptual differences in respect of rationale and criteria of protection. Moreover, the existing overlap with regard to protected subject matter will be illustrated.

(a) Works – expressions of personal creativity

4. Copyright law can be described as the branch of intellectual property law, which deals with the rights of creators in their literary and artistic works. In accordance with Article 2(1) of the Berne Convention for the Protection of Literary and Artistic Works (hereinafter referred to as the "Berne Convention"), literary and artistic works include "every production in the literary, scientific and artistic domain, whatever may be the mode and form of its expression." Copyright law is concerned with virtually all forms and methods of publicly communicating literary and artistic works. Printed publications, public performances, sound and television broadcasting, the public showing of films in cinemas and the making available of works on the Internet may serve as examples of relevant acts.

5. Copyright law protects the individual form in which ideas are expressed in a work, but not the ideas themselves ("idea/expression dichotomy"). The creativity protected by copyright law may thus be characterized as creativity in the choice and arrangement of words, musical notes, colors, shapes etc. In the following subsections, the rationale underlying copyright law and the criteria for copyright protection will be discussed before providing an overview of subject matter eligible for copyright protection.

(i) Rationale underlying copyright law

6. The protection of literary and artistic works rests on different traditions of legal theory. The civil law tradition of *droit d'auteur* is based on natural law theory. It focuses on the author and his or her unique form of self-expression leading to the creation of a work. The work is regarded as a materialization of the author's personality. Moreover, it is assumed that an intellectual bond unites the author with the created work. On its merits, the natural law

argument appeals to feelings of rightness and justice. As it is the author who spends time and effort on the creation of a new work, it is deemed justified that he or she reaps the fruit of the creative labor. Accordingly, it is posited that the author acquires a property right in the work by virtue of the mere act of creation. The law merely recognizes formally the acquisition of rights which is conceived as a natural consequence of the activity of creating a work[1].

7. Copyright's common law tradition is rooted in utilitarian copyright theory. It introduces considerations of social utility. Viewed from this perspective, exclusive rights are conferred on authors in order to give an incentive to create literary and artistic works. Rather than following directly from the act of creation, the exclusive rights of authors appear as granted prerogatives, which deserve positive legal enactment. The grant of copyrights is seen as an instrument to spur intellectual creation and ensure a sufficient supply of disseminated knowledge and information. The main objective is to further the overall welfare of society. The utilitarian approach thus complements the individualistic natural law conception by emphasizing the interests of society as a whole.

8. Society's interests may be of an economic, social and cultural nature. Traditionally, the intention to promote knowledge and learning plays a decisive role. The 1709 Statute of Anne, for instance, was titled an "Act for the Encouragement of Learning, by vesting the Copies of Printed Books in the Authors or Purchasers of such Copies." The Preamble of the 1996 WIPO Copyright Treaty recalls the interest in education, research and access to information. The encouragement of individual creativity and its dissemination may also be seen as a means of promoting, enriching and disseminating the national cultural heritage.

9. From the viewpoint of industry policy, it may also be argued that society benefits from adequate copyright protection because of its stimulating effect on the rapidly emerging information industry. The proper protection of literary and artistic works lays the basis for recouping substantial investments in the development and marketing of creative works. The growth of copyright industries is considered an engine of new employment[2].

10. The rationale of copyright protection is thus manifold. In sum, literary and artistic works are protected in order to reward authors for their creative labor (natural law argument) and encourage the creation of new works for the benefits which society may derive from the promotion of knowledge and learning, the cultivation of the national cultural heritage and the encouragement of investments in information products (utilitarian arguments).

(ii) Criteria for copyright protection

11. For a work to enjoy copyright protection, it must be an original intellectual creation of the author. Accordingly, it is a precondition that the production concerned originate from a natural person. The requirement of an intellectual creation corresponds to the intellectual nature of the object of copyright protection – an author's individual expression represented in the work.

12. The requirement of originality can be understood as a reference to the uniqueness of literary and artistic works resulting from the personal and individual character of the process of creation. Under national laws inspired by natural law theory (see above), the originality criterion may be construed as requiring a certain level of artistic creation. Combinations of factors such as sufficient skill, judgment, experience, labor or capital may follow from

utilitarian conceptions. In general, the threshold for passing the originality test is fairly low. The protection of a work depends neither on a particular quality or value nor on a substantial effort in terms of creativity, labor or investment.

(iii) Overview of subject matter of copyright protection

13. As indicated above, the subject matter of copyright protection includes every production in the literary, scientific and artistic domain, whatever the mode or form of expression. Accordingly, there is a wide variety of intellectual creations which fall within the province of copyright law provided that they fulfil the criteria for protection applied under national law. As the originality requirement does not necessarily imply an elevated standard of quality or effort, the reference to the realm of literature, art or science need not be understood to restrict the subject matter eligible for copyright protection. Works that have little in common with literature, art or science, such as purely technical guides, engineering drawings, timetable indexes, street directories or trade catalogues may nevertheless enjoy copyright protection according to national law. The exemplary enumeration of subject matter in Article 2(1) of the Berne Convention contains a reference to "maps, plans, sketches and three-dimensional works relative to geography, topography, architecture or science."

14. Practically all national copyright laws provide for the protection of the following types of work:

– literary works, such as novels, short stories, poems, dramatic works and any other writings;

– musical works, with or without words, such as melodies, songs, choruses, and musico-dramatic works, such as operas, musicals, operettas;

– choreographic works;

– works of art, such as drawings, paintings, etchings, lithographs, sculptures;

– architectural works;

– photographic works;

– motion pictures;

– maps and technical drawings;

– computer programs (see Article 4 of the WCT).

15. Many copyright laws protect also works of applied art (see document SCT/9/6). Protection is normally given irrespective of the work's content and length. Moreover, protection does not depend on the work's purpose. Copyrighted works may thus be destined for purposes as diverse as "pure" art, amusement, education, information or advertisement.

(b) Trademarks[3] – distinctive signs for use in trade

16. Trademark law provides protection to the owner of a trademark by ensuring the exclusive right to use it to identify goods or services. Trademarks play a crucial role in a market-based economy allowing competing manufacturers and traders to offer consumers a variety of goods and services in the same category. In order to allow consumers to consider the alternatives in the marketplace and make their choice between competing offers, the different goods and services must be distinguished. The means for distinguishing goods and services on the market is usually a trademark.

17. Trademarks promote initiative and enterprise worldwide by providing the owners of trademarks with a means to obtain recognition and financial profit. Trademark protection hinders the actions of unfair competitors, preventing them from using identical or similar trademarks to offer inferior or different goods or services, thereby creating confusion with the original goods or services. The system enables market participants to produce and market goods and services under fair conditions. In the following subsections, the rationale underlying trademark law and the criteria for trademark protection will be discussed before providing an overview of signs, which may serve as trademarks.

(i) Rationale underlying trademark law

18. Article 15(1) of the Agreement on Trade-Related Aspects of Intellectual Property Rights (hereinafter referred to as the "TRIPS Agreement") contains a now widely accepted definition of trademark, namely "any sign, or any combination of signs, capable of distinguishing the goods or services of one undertaking from those of other undertakings." This definition reflects the origin function as well as the distinction function of trademarks. By giving the right to trademark owners to prevent competitors from using protected distinctive signs, trademark law ensures that trademarks can be applied to identify the commercial source of a product or service. Trademarks indicate that the products or services to which they are attached have been put on the market by, or under the authority of, a particular commercial entity. The function of indicating the commercial source presupposes that the trademark distinguishes the goods or services of a given enterprise from those of other enterprises. In consequence, consumers can individualize the different offers in the marketplace and express their preference by selecting a specific product or service. This, in turn, will help the public's preferred suppliers, products and services to prevail in the marketplace. The protection of trademarks thus contributes to the proper functioning of market economies. It encourages transparency and fair competition in the market.

19. The core function of distinguishing goods and services of undertakings in the course of trade has important ramifications. On the one hand, it may be said that, by clearly identifying the source from which a given good or service originates, a trademark gives an incentive for undertakings to maintain the quality of their products or services. The consumer will perceive the trademark, indicating that certain goods or services have the same commercial origin, as a guarantee of similar quality. The producer remains free to vary the quality of the goods or services bearing a particular trademark. However, he or she will suffer the consequences of any decline. Although not offering any legal guarantee of quality, trademarks, therefore, are able to fulfil a quality function in economic terms[4].

20. On the other hand, a trademark's reputation may go beyond the qualities and characteristics of the goods or services to which it is applied. Besides indicating origin and denoting quality, a trademark may be associated in the minds of consumers with a specific style of life. Like a guarantee of quality, a trademark may become, for instance, an emblem of prestige[5]. The "mark image" will most often result from substantial investment in the promotion and advertising of the products or services on which the trademark is used (investment function).

21. The rationale of preserving the distinctiveness of marks used in trade safeguards the exclusive link between a trademark and the producer using it on goods or services. To the extent to which investment in product quality and promotion leads to a particular reputation of the trademark, this exclusive link also ensures that the producer will reap financial rewards accruing from that investment[6]. Moreover, consumers will be protected against confusion as to the commercial origin of goods and services, and the quality and reputation associated with a trademark. In sum, trademarks are protected because they individualize the goods or services of a given enterprise and distinguish them from the goods or services of competitors (origin and distinction function), symbolize qualities associated with goods or services (quality function) and are used as reference point for investments in the promotion of a product or service (investment function)[7].

(ii) Criteria for trademark protection

22. The requirements that a sign must fulfill in order to serve as a trademark are reasonably standard throughout the world. The first requirement relates to the core function of trademarks, namely to denote the commercial source of goods or services and thereby distinguish them from the goods or services of competitors (see above). It follows that a trademark must be distinctive. As stipulated in Article 15(1) of the TRIPS Agreement, it must be "capable of distinguishing the goods or services of one undertaking from those of other undertakings." Lack of distinctiveness may particularly result from the fact that a given sign is generic in the sense that it defines a category or type to which the goods or services belong (use of the term "chair" for chairs, or "drinks" for alcoholic beverages). A further reason for lacking distinctiveness may be the descriptive character of the sign concerned. With regard to the grounds to deny registration in this context, Article 6*quinquies*(B)(2) of the Paris Convention for the Protection of Industrial Property (hereinafter referred to as the "Paris Convention") refers to "signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, place of origin, […] time of production." Descriptive signs may thus be defined as those that serve in trade to designate certain characteristics of the goods or services concerned.

23. The second condition for granting trademark protection relates to the possible harmful effects of a trademark if its use is likely to be misleading or would violate public order or morality. Article 6*quinquies*(B)(3) speaks of trademarks "contrary to morality or public order and, in particular, of such a nature as to deceive the public." The protection against use and registration as trademarks given to emblems and signs of States and international intergovernmental organizations in Article 6*ter* of the Paris Convention may be understood as a special case evolving from this principle (see document SCT/15/3, paragraphs 38 and 39).

(iii) Overview of subject matter of trademark protection

24. It follows from the preceding discussion that a wide variety of signs may be considered eligible for trademark protection. Virtually any sign that is capable of distinguishing goods or services of undertakings in the marketplace may serve as a trademark, provided that further conditions are fulfilled, such as compliance with standards of morality or public order.

25. Practically all national trademark laws provide for the protection of visually perceptible signs (see Summary of Replies to the Questionnaire on Trademark Law and Practice, document WIPO/STrad/INF/1), in particular the following types:

– words, including personal names;

– letters, numerals;

– figurative elements and devices;

– combinations of colors;

– pictorial devices, such as logotypes, paintings, figures, drawings;

– combinations of the above.

26. Under many national trademark systems, three-dimensional signs relating, for instance, to product packaging or product shape, also enjoy protection as trademarks. As the range of protectable signs is directly linked to the trademark function of distinguishing goods or services in commerce, examples of relevant signs can only serve the purpose of illustration. New types of trademarks, such as color marks, multimedia marks, sound marks and olfactory marks, may evolve in the market on the basis of new marketing and advertising strategies and changing consumer perceptions.

(c) Subject matter under both the copyright and trademark regimes

27. A comparison of the objectives of copyright protection on the one hand and the objectives of trademark protection on the other hand shows that there are substantial differences. Whereas copyright law seeks to offer adequate rewards and incentives for the creative efforts of authors and further investments in resulting works, trademark law seeks to preserve loyalty among competitors in the marketplace by safeguarding the distinctiveness of signs used in commerce. Whereas the foremost objective of the protection of literary and artistic works can be seen in ensuring a sufficient supply of information products, the protection of trademarks can be regarded as a specific means of ensuring fairness in competition and avoiding consumer confusion.

28. The different conditions required to enjoy copyright protection or trademark protection are consistent with the respective policy objectives. Accordingly, the criteria for protecting works are substantially different from those for recognizing and protecting trademarks. Whereas a work must be an author’s original intellectual creation, a trademark must be capable of distinguishing the goods or services of one undertaking from those of other undertakings in trade.

29. An area of overlap between the two protection regimes, however, comes to the fore when comparing the respective actual subject matter of protection. Certain subject matter may be susceptible to protection by both copyright law and trademark law. The following examples may serve to illustrate the possibility of overlapping protection:

(i) Pictorial devices (logotypes, paintings, figures, drawings, photographs)

30. Article 2(1) of the Berne Convention gives several examples of literary and artistic works. In this context, drawings and paintings are expressly mentioned. They constitute a classical field of artistic production. At the same time, pictorial devices, such as logotypes, paintings, figures, drawings and photographs, are frequently used as trademarks. As copyright protection does not depend on the purpose for which an intellectual creation is intended, use of a pictorial device in trade to distinguish goods or services, or for advertising does not form an obstacle to copyright protection. In spite of the fundamental difference between the criteria for copyright protection and the requirement of distinctiveness for trademark protection, a drawing, painting or similar pictorial device may effectively enjoy protection in both fields.

(ii) Three-dimensional shapes

31. Similar considerations apply to three-dimensional shapes. Sculptures and other three-dimensional creations are a classical area of copyright protection. Where a relatively low threshold is applied to meet the originality standard and other requirements for copyright protection, the shape of a product or of its packaging may be regarded as a work and fall within the scope of copyright protection. The use of three-dimensional shapes for commercial purposes does not hinder copyright protection, while national law may provide for the protection of three-dimensional trademarks.

(iii) Titles of works, slogans

32. In the field of literary productions, the title of a work or a slogan may fall within the scope of both copyright and trademark law. Article 2(1) of the Berne Convention mentions “books, pamphlets and other writings; lectures, addresses, sermons and other works of the same nature” as examples of literary works. The length of a literary production, however, is not decisive for obtaining copyright protection. Short creations, such as book titles or advertising slogans, may meet the necessary standard of originality and other requirements established under national law. At the same time, titles of works and slogans may enjoy trademark protection.

(iv) Holograms, motion signs, multimedia productions

33. Combinations of pictures, such as the pictures used for a hologram, a series of animated pictures constituting a motion sign, or a combination of audiovisual elements constituting a multimedia production enjoy copyright protection on the condition that they meet the originality standard and further requirements applied under copyright law. “Cinematographic works to which are assimilated works expressed by a process analogous to cinematography” are expressly mentioned in the exemplary enumeration of Article 2(1) of the Berne Convention. Signs of this type may also enjoy trademark protection if they are found to be capable of functioning as trademarks in respect of the specified goods or services.

(v) Sounds, melodies

34. Copyright protects intellectual creations originating from a natural person. Natural sounds will therefore hardly qualify for copyright protection. Contemporary musical productions, however, may consist of a specific combination of natural sounds or of sounds which have specifically been created for the musical composition. In such cases, an original sound or an original combination of sounds may be susceptible to copyright protection, just like melodies as parts of musical compositions. As indicated above, the length of an intellectual production is not decisive when it comes to deciding on copyright protection. Simultaneous protection of sounds and melodies under copyright and trademark law would depend on whether sounds are eligible for trademark protection under the applicable law.

III. SCOPE OF PROTECTION UNDER THE COPYRIGHT AND TRADEMARK REGIMES

35. As a given subject matter may fall within the scope of both copyright and trademark law (see II (c) above), the manner in which the two protection regimes interact in case of double protection becomes relevant. Accordingly, a comparison of the scope of protection under the two regimes will be made in the present chapter. On the basis of this comparative analysis, certain issues of cumulative protection will be analyzed in chapter IV.

36. In section (a) below, the scope of the exclusive rights conferred on copyright owners and trademark owners will be compared. The discussion of rights under copyright law would be incomplete without the consideration of the moral rights of the author and potential points of contact with trademark law. This analysis will be undertaken in section (b). Finally, attention will be devoted to different types of permissible limitations in the fields of copyright and trademark law in section (c).

(a) The scope of exclusive rights

37. The comparison of the scope of exclusive rights in the field of copyright law and the field of trademark law will be carried out in three stages. In subsection (i), an overview of the economic rights of copyright owners will be given. The rights of trademark owners will be discussed in subsection (ii). Finally, a comparative analysis will be conducted in subsection (iii).

(i) Economic rights of the copyright owner

38. The economic rights conferred on the owner of copyright in a protected work can be described as exclusive rights to authorize others to use the protected work. The owner may use the work as he or she wishes and exclude others from using it without his or her authorization. The exclusive economic rights of copyright owners can be characterized as exploitation rights. They give the owner control over certain forms of using the protected work in order to enable the work's commercialization. In this way, the objective of copyright law is realized to reward creative labor, encourage intellectual creations and allow the amortization of investments in information and communication products (see II (a) above).

39. Most copyright laws define the acts of use which cannot be performed without the authorization of the copyright owner. At the international level, a number of economic minimum rights of the author are recognized. Article 9(1) of the Berne Convention sets forth the broad exclusive right of "authorizing the reproduction of [literary and artistic] works, in any manner or form." The right to control the act of reproduction is the legal basis for many forms of exploitation of protected works. It is supplemented by the right of distribution (Article 6 of the WIPO Copyright Treaty) and certain rental rights concerning computer programs, cinematographic works and works embodied in phonograms (Article 7 of the WIPO Copyright Treaty, Articles 11 and 14(4) of the TRIPS Agreement).

40. Public performance rights concern the situation when members of the public gather at a specific place to jointly attend a performance at a predetermined time (hence no transmission to another place). In this regard, the Berne Convention provides for exclusive rights allowing copyright owners to authorize public readings; dramatic, musical and cinematographic performances before an audience; and the public communication of the broadcast of a work by loudspeaker (see Articles 11(1)(i), 11*bis*(1)(iii), 11*ter*(1)(i) and 14(1)(ii) and 14*bis*(1) of the Berne Convention).

41. The Berne Convention also contains a bundle of exclusive rights concerning the complementary communication of works to the public by broadcasting or by means of wires or cables (see Articles 11(1)(ii), 11*bis*(1)(i) and (ii), 11*ter*(1)(ii), 14(1)(ii) and 14*bis*(1)). Without prejudice to these detailed provisions, Article 8 of the WIPO Copyright Treaty provides for the general exclusive right to authorize "any communication to the public […], by wire or wireless means." This broad exclusive right includes "the making available to the public […] in such a way that members of the public may access [literary and artistic] works from a place and at a time individually chosen by them." Article 8 thus comprises the exclusive right of authorizing interactive on-demand communication to the public, in particular via the Internet.

42. Further exclusive rights concern the translation and adaptation of works (Articles 8, 12 and 14(1)(i) of the Berne Convention). Article 14*bis*(1) of the Berne Convention deals with the rights of the owner of copyright in a cinematographic work.

(ii) Rights of the trademark owner

43. In accordance with the objective of trademark law to enable consumers to distinguish between competing goods and services (see II (b) above), exclusive trademark rights place the commercial use of a trademark under the authority of the trademark owner. The central right conferred on the owner of a registered trademark is reflected in Article 16(1) of the TRIPS Agreement. It is the exclusive right to "prevent all third parties not having the owner's consent from using in the course of trade identical or similar signs for goods or services which are identical or similar to those in respect of which the trademark is registered where such use would result in a likelihood of confusion." Taking this definition as a starting point, different levels of exclusivity can be distinguished.

44. As to a third party's use of a sign that is identical to a protected trademark, for identical goods or services, Article 16(1) of the TRIPS Agreement specifies that "a likelihood of confusion shall be presumed." In the case of identity as to the signs concerned as well as relevant goods and services, the trademark owner will therefore be in a position to prevent the use of an identical trademark with the burden of proof being shifted to the defending party.

45. As regards the use of an identical sign for similar goods or services, the use of a similar sign for identical goods or services and, finally, the use of a similar sign for similar goods or services, the test whether "such use would result in a likelihood of confusion" (see definition cited above) applies. The trademark owner's right to object to the use of the identical or similar trademark will therefore depend on an affirmative answer to the question of confusing similarity. The question is whether the similarity between the signs concerned and relevant goods and services implies a risk for consumers to be misled as to the commercial origin of the goods or services.

46. Furthermore, owners of registered well-known marks may be able to object to the use of a reproduction, imitation or translation of the well-known mark on goods or services which are not similar to those for which the well-known mark is registered (see Article 16(3) of the TRIPS Agreement). The decision on the prohibition of use and the refusal or cancellation of a registration in the field of dissimilar goods or services has to be determined by all circumstances of the specific case. In particular, it is to be considered whether the use of the trademark would indicate a connection between the dissimilar goods or services and the owner of the well-known mark, and would be likely to damage the owner's interests (Article 16(3) of the TRIPS Agreement).

(iii) Comparative analysis

47. The conceptual differences between copyright and trademark law (see II (c) above) also become apparent when considering the scope of exclusive rights. Whereas copyright law seeks to provide exclusive exploitation rights broad enough to ensure adequate monetary rewards and incentives for intellectual creation, the purpose of trademark law is to ensure lawful competition by traders through the preservation of the distinctiveness of signs used in trade and the protection of consumers against confusion.

48. The relationship between the copyright owner and the protected work is exclusive in the sense that the owner is the only person entitled to exploit the work in the areas of use falling under his or her exclusive rights. The scope of the exclusive rights of a trademark owner, however, depends on the owner's business activities. The right to prevent third parties from using the mark in trade is subject to the principle of specialty: it can be asserted only with regard to those goods and services in respect of which the trademark is protected – which often occurs by means of registration. In principle, other market participants may use an identical trademark for dissimilar goods or services, provided no risk of confusion, association or dilution is provoked.

49. The protection of well-known marks against dilution in respect of their use for dissimilar goods and services constitutes an exception to the rule of specialty. Protection against dilution rests on considerations of unfair competition law. It aims to protect the owner of a well-known or famous mark against the blurring or tarnishment of the mark's particular reputation and to prevent unfair free-riding on the well-known mark's reputation. Irrespective of this foundation in unfair competition law, the practical outcome of protection against dilution may come close to the absolute position, which the copyright owner has in respect of the protected work. If the individual decision on the protection of a well-known mark in the area of dissimilar goods or services leads to protection with regard to all different kinds of goods and services, the owner of the well-known mark, in fact, can generally control the use

of the mark in trade, just like the copyright owner can control the use of the work in all areas covered by exclusive copyrights. In other words, the owner of the well-known mark would be in a position to exploit and commercialize the particular reputation of the distinctive sign concerned.

50. In spite of this incidental point of contact, the market orientation of trademark law remains. The exclusive right to prevent third parties from the use of a protected trademark, *a priori*, concerns use in the course of trade. The reproduction of a trademark for purposes which are not trade-related, such as private study or illustrations for teaching, do not fall within the scope of the exclusive right, as delineated in Article 16(1) of the TRIPS Agreement. In copyright law, the exclusive rights of copyright owners are not restricted to use of the work in a specific context, such as use in commerce. Specific work categories, such as official texts, news of the day or political speeches may be excluded from copyright protection (see Articles 2(4), 2(8) and 2*bis*(1) of the Berne Convention). Use of a work for private study or for illustrating teaching, however, are examples of use which, in principle, are covered by the exclusive rights of copyright owners. They may be exempted from the owner's control through the introduction of copyright exceptions (see, for instance, Articles 9(2) and 10(2) of the Berne Convention, and section III (c) below).

(b) Moral rights

51. Alongside economic exploitation rights, copyright law provides for the protection of the moral rights of the author in respect of his or her work. The recognition of moral rights underlies the notion that the work constitutes a materialization of the personality of the author (see II (a) above). At the international level, the moral right of attribution and the moral right of work integrity are recognized. Pursuant to Article 6*bis*(1) of the Berne Convention, authors shall have the right "to claim authorship of the work and to object to any distortion, mutilation or other modification of, or other derogatory action in relation to, the said work, which would be prejudicial to his honor or reputation." These moral rights are required to be independent of the author's economic exploitation rights (see preceding section) and to remain with the author even after the economic rights have been transferred. After the author's death, they shall be maintained at least until the expiry of the economic rights (see Article 6*bis*(2) of the Berne Convention – also with regard to exceptions to this general rule). Most national laws accept that the author may waive his or her moral rights, possibly with certain restrictions, but some laws do not recognize the validity of such acts.

52. With regard to areas of overlap between an author's moral rights and the rights of trademark owners, the question has arisen whether, in the field of communication products, "origin" in the sense of trademark law refers only to the manufacturer of the physical item in which the product is embodied (book, videotape), or whether the notion of "origin" includes the intellectual creator of the content that the physical item conveys (novel, motion picture). If the intellectual creator were included, trademark principles could potentially be invoked to support a claim comparable to the author's claim for authorship. National practices, however, seem to indicate that the trademark notion of "origin" does not extend to the creator of the work embodied in the product. As long as the author's moral right to claim authorship is protected under national law, the author can demand that his or her name be indicated as the author and "intellectual origin" of the work on this basis[8].

(c) Limitations and exceptions

53. The exclusive rights of copyright and trademark owners are subject to certain limitations. Some inherent, conceptual limits have already been pointed out above. Copyright law, for instance, protects only the individual form in which ideas are expressed in a work, but not the ideas themselves ("idea/expression dichotomy", see II (a) above). Accordingly, the exclusive rights of copyright owners do not cover the ideas underlying a work. Trademark rights, by definition, are limited to the use of a sign in trade (see III (a) above). Consequently, uses outside a commercial context do not usually fall under the exclusive rights of trademark owners.

54. Subsequently, different types of limitations on copyright and trademark rights will be discussed in more detail. Subsection (i) deals with the limited term of protection to be found in copyright law and points out the difference to trademark law, which provides for the indefinite renewal of trademark registrations. Subsection (ii) devotes attention to the rule of exhaustion of rights. Subsection (iii) gives an overview of uses that are exempted from the control of the right owner in copyright and trademark law.

(i) Term of protection

55. Copyright protection does not run indefinitely. Copyright law provides for a period of time during which the rights of copyright owners exist. The period of duration of copyright begins with the creation of the work. Pursuant to Article 7(1) of the Berne Convention, the general term of protection shall be the life of the author plus fifty years after his or her death. Specific rules may be applied to cinematographic, anonymous or pseudonymous, and photographic works as well as works of applied art (see Article 7(2) to (4) of the Berne Convention and Article 9 of the WIPO Copyright Treaty).

56. The continuation of the period of protection after the death of the author is intended to enable the author's successors to receive economic benefits. It also safeguards investments made in the production and dissemination of works. In recent years, a tendency has emerged towards lengthening the term of protection. Many countries provide for a copyright duration of the life of the author plus seventy years after his or her death[9]. With regard to the author's moral rights (see III (b) above), some countries provide for perpetual protection[10].

57. Several explanations can be given for the temporal limitation of copyright. Viewed from a utilitarian perspective (see II (a) above), copyright protection is granted to enhance the benefits of society as a whole by encouraging creativity and intellectual creation. Copyright protection, accordingly, need not be extended *ad infinitum* but may cease at a point in time which national legislation deems appropriate to ensure a sufficient incentive to create new works and invest in their production and dissemination. On the basis of a natural law approach to copyright, it may be argued that, in the process of its communication, the work gradually becomes an independent factor influencing the cultural and intellectual perception of its age. On account of the increasing independence of the work, the individual link with the author finally expires.

58. Considering the interface between intellectual property law and competition law, it may also be said that copyright protection implies certain restrictions of competition at the production level (less imitated, comparable products on the market) in order to enhance competition at a higher level, namely the innovation level (more intellectual creations). With

regard to the duration of copyright protection, it may then be posited that protection should expire the moment the enhancement of competition at the innovation level, achieved through longer periods of protection, no longer outweighs the restriction of competition at the production level.

59. In this context, it is to be considered that, after the expiry of copyright, a work falls into the public domain and, in principle, may be used freely. Certain restrictions may follow from the exercise of moral rights potentially enjoying longer or perpetual protection under national law (see III (b) above). The free use of works in the public domain includes the use of a work as a basis for new intellectual creations. Works in the public domain may freely be reproduced, communicated and disseminated. The expiry of copyright protection may thus have a positive effect on the creation of new works because it enhances the available material and, as the authorization of the copyright owner is no longer necessary, reduces costs.

60. The above rationale does not apply to trademark law. A temporal limitation of trademark protection would have the effect that, after the expiry of protection, the trademark would fall into the public domain and could freely be used by all market participants. In consequence, consumers could no longer rely on the trademark as an indicator of commercial source, quality and reputation of the goods or services concerned. The trademark would no longer be capable of fulfilling its different functions (see II (b) above). As consumers can hardly be expected to foresee when the protection of a specific trademark expires, this loss of reliance would not only affect trademarks falling into the public domain but the trademark system as a whole. The protection of trademarks could no longer contribute to transparency and fair competition in the market and to the proper functioning of market economies.

61. For this reason, the trademark owner can renew the registration of the trademark indefinitely (see Article 18 of the TRIPS Agreement). In this way, the distinctiveness of trademarks used on the market can be preserved, and consumers and the public at large are not misled. The rule of indefinite renewal allows an enterprise to uphold the exclusive link with its trademarks as long as the latter are used in trade. As Article 19 of the TRIPS Agreement indicates, use may be required to maintain a trademark's registration. The registration may be cancelled 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.

(ii) Rule of exhaustion

62. The economic rights recognized in copyright law, allow copyright owners to control a work's reproduction and the making available of the original and copies of the work to the public through sale or other transfer of ownership (see III (a)(i) above). This effectively amounts to the possibility of controlling the distribution of products (e.g. books, CDs, DVDs and software products) that embody the protected work. Likewise, trademark owners enjoy the exclusive right to put on the market their products under the protected trademark, and can therefore control the distribution (selling, offering for sale, etc.) of those products (see III (a)(ii) above). The exclusive rights relating to the distribution of those products may, however, be limited or "exhausted" in respect of the individual copies or articles that embody the protected work or bear the protected trademark upon their first lawful sale or introduction on the market, thus freeing any further distribution of those copies or articles from any control by the holder of the exclusive rights. In this regard, the rule of exhaustion of rights is applied in both copyright law and trademark law alike.

63. National copyright law, for instance, may provide that, after the first sale or other transfer of ownership of the original or a copy of the work with the authorization of the copyright owner, the latter can no longer exert the right to authorize the making available to the public of the original and copies of the work through sale or other transfer of ownership. The right to control the distribution of those copies of the protected work is exhausted. National trademark law may provide that the trademark owner cannot object to further sales of a product in the course of trade once the product has been put on the market under the trademark by the owner or by someone else with the owner's consent.

64. The exhaustion of rights may be national, regional or international. Pursuant to a rule of national exhaustion, the sale or other transfer of ownership of the original or a copy of the work, or the launching of a product under a trademark would only lead to the exhaustion of rights if it takes place in the territory of the country, the national law of which provides for the exhaustion. In the case of economically integrated areas, such as the European Community, the same rule may be applied with regard to the territory of any of the member States and thus on a regional basis. National or regional exhaustion allows the copyright or trademark owner to object to parallel imports of genuine products that embody the protected work or trademark coming from countries outside the relevant territory.

65. If a rule of international exhaustion is applied, any sale or other transfer of ownership of the original or a copy of the work, or the putting of a product on the market under a trademark exhausts the rights of the copyright or trademark owner in respect of that original, copy or product, regardless of where the sale or putting on the market takes place. Accordingly, parallel imports of genuine products marketed outside the territory of a country or intergovernmental organization would be permissible.

(iii) Permitted use

66. In copyright law, certain uses of protected works are exempted from the control of the copyright owner in order to establish a balance between exclusive copyrights and the rights and interests of others and the public at large, such as the interest in education, research and access to information (see the Preamble of the WIPO Copyright Treaty). The Berne Convention permits the exemption of uses under national law, for instance, with regard to lectures, addresses and similar works delivered in public (Article 2*bis*(2)), quotations, press summaries, review and parody (Article 10(1)), illustrations for teaching (Article 10(2)), newspaper articles on current topics and the reporting of current events (Article 10*bis*), the exercise of broadcasting and related rights (Article 11*bis*(2)), ephemeral recordings made by broadcasting organizations (Article 11*bis*(3)), and the recording of musical works (Article 13(1)). Besides these limitations which are laid down in the text of the Berne Convention, implied limitations are recognized which concern the public performance of works for religious ceremonies, military bands and the needs of child and adult education (so-called 'minor reservations doctrine')[11] and the possible application of limitations on the right of reproduction to the translation right in conformity with fair practice[12].

67. Article 9(2) of the Berne Convention, Article 13 of the TRIPS Agreement and Article 10(1) and (2) of the WIPO Copyright Treaty contain a general clause setting forth three conditions to be met when exempting uses of a work from the authorization of the copyright owner under national law. Exemptions are permissible in "certain special cases" which "do not conflict with a normal exploitation of the work" and "do not unreasonably prejudice the legitimate interests of the author" (so-called three-step test). Examples of

national limitations which have been based on the general provision of Article 9(2) of the Berne Convention include the reproduction of a work for private study, judicial or administrative purposes or for use by disabled persons.

68. In trademark law, Article 17 of the TRIPS Agreement allows "exceptions to the rights conferred by a trademark, such as fair use of descriptive terms, provided that such exceptions take account of the legitimate interests of the owner of the trademark and of third parties[13]." Besides the example of fair use of descriptive terms given in Article 17, the exemption of the use of one's own name or address, or place of provenance of one's goods, even if identical to a protected trademark, and limitations serving the purpose of comparative advertising can be found in national trademark laws.

69. Furthermore, the unauthorized use of a trademark may be permitted for the purpose of review or parody. For the same purpose, copyright law also allows the introduction of limitations. The area of review and parody thus constitutes a common ground of both fields of intellectual property law. The reason for this shared type of limitation can be seen in its human rights foundation. Limitations permitting review and parody rest on the fundamental guarantee of freedom of speech.

70. With regard to differences in the number and types of limitations, it is to be recalled in general that the rights of trademark owners, *a priori*, concern only the use of a mark in trade (see III (a) above). Certain uses covered under copyright limitations, such as private use, or use for judicial or administrative purposes, do not fall within the scope of exclusive trademark rights. Hence there is no need for corresponding limitations in trademark law.

IV. ISSUES OF CUMULATIVE PROTECTION

71. On the basis of the preceding comparative analysis of the scope of protection under the copyright and trademark regimes, certain issues of cumulative protection will be analyzed in the present chapter. The following discussion will show that issues of cumulative protection, in general, revolve round one common theme: the potential risk of circumventing policy objectives of one protection regime by invoking parallel protection under the other regime.

72. Section (a) below clarifies the way in which double protection of subject matter falling within the scope of both copyright and trademark law may be acquired. On the basis of this clarification, attention will be devoted in section (b) to the question of the moral rights of the author and their impact on a work's use as a trademark. Differences in the exhaustion regimes applied in copyright law and trademark law will be discussed in section (c). Section (d) concerns differences in the forms of use which may be exempted from the authorization of the right owner in copyright and trademark law. The issue of the maintenance of trademark protection after the expiry of copyright protection will be raised in section (e). Finally, the question of the acquisition of trademark rights in works that have fallen into the public domain will be dealt with in section (f).

(a) Ways of acquiring double protection

73. The legal mechanisms for obtaining copyright protection differ from those applied in trademark law. Pursuant to Article 5(2) of the Berne Convention, the enjoyment and the exercise of rights relating to a literary and artistic work "shall not be subject to any formality."

In consequence, works need not be registered in order to be protected under copyright law. The act of creation (or, in some national laws, fixation) directly leads to the acquisition of copyright. The owner of copyright in a work is generally, at least in the first instance, the author who created the work. Exceptions to this general principle can be found in national law. For example, national law may provide that, when a work is created by an author who is employed for the purpose of creating that work, the employer, not the author, is the owner of the copyright in the work. It is to be noted, however, that moral rights (see III (b) above) belong to the author of the work, whoever may be the owner of the economic rights protected by copyright.

74. A trademark can be protected on the basis of either use or registration. The Paris Convention contemplates a trademark registration system in Contracting Parties (see Article 6 of the Paris Convention). In countries that maintain a system of trademark protection based on use, the registration of a trademark merely confirms the trademark right that has been acquired by use. In those countries, the first user has priority in a trademark dispute, not the person who first registered the trademark. In countries that base trademark protection on registration, the natural or legal person registering a trademark acquires the exclusive rights to the trademark.

75. In the case of a sign that enjoys copyright protection, the person who wants to use it as a mark in trade has to ensure that the intended use does not come into conflict with the copyright that may be owned by another person. In many countries, copyright in a sign for which trademark protection is sought, is taken into account in the course of the trademark registration procedure and constitutes a relative ground for refusal (see Summary of Replies to the Questionnaire on Trademark Law and Practice, document WIPO/STrad/INF/1). If copyright is not considered in the framework of the registration process, a trademark which infringes an earlier copyright owned by a third person may be invalidated for this reason after registration (see Article 6*quinquies*(B)(1) of the Paris Convention).

76. In many countries, copyright (with the exception of moral rights) may be assigned. This means that it may be transferred to a commercial undertaking that wants to use the work as a trademark. In some countries, an assignment of copyright is not legally possible. However, a practical effect similar to assignment can be achieved through licensing. A licensing agreement may authorize, for instance, the use of a work as a mark in trade. When a license extends to the full period of copyright and all economic rights protected by copyright (see III (a) above), the licensee is, *vis-à-vis* third parties and for all practical purposes, *de facto* in the same position as an owner of copyright.

77. A practical example may be an enterprise asking an illustrator to create a logotype to be used as a trademark on one of its products. If the work of the illustrator is eligible for copyright protection, different scenarios arise. In copyright systems in which the person creating a work (the illustrator) is the first owner of copyright, the enterprise must seek to obtain the illustrator’s authorization for the intended use of the logotype in commerce. This authorization may already be part of or implicitly follow from the initial contract in which the enterprise commissioned the logotype. It may also be obtained by way of an assignment of copyright or a licensing agreement.

78. As mentioned above, there are also copyright systems in which the person employing an author for the purpose of creating a work automatically becomes the owner of the copyright in the work. Under such a system, the enterprise would be the owner of copyright in the logotype from the outset. Consequently, it would not be obliged to obtain the illustrator's authorization for the intended use of the logotype as a mark in trade.

(b) Moral rights of the author

79. The moral rights of the author are independent of the economic rights protected by copyright and belong to the author even after the transfer of the economic rights (Article 6*bis*(1) of the Berne Convention). In the case of a commissioned work, the patron commissioning the work may thus become the owner of the economic rights recognized under copyright law (see III (a) above), including the right to use the work as a trademark in commerce (see the example given in the preceding section). The moral rights, namely the right to claim authorship and the right of work integrity (see III (b) above), however, remain in the hands of the author.

80. On account of the author's moral right to claim authorship, an enterprise using a work as a trademark may, in the absence of an agreement to the contrary, be obliged to indicate the name of the author in connection with the use of the trademark, for instance, on goods or packaging bearing the trademark.

81. The moral right of work integrity is defined in Article 6*bis*(1) of the Berne Convention as the right to "object to any distortion, mutilation or other modification of, or other derogatory action in relation to, the […] work, which would be prejudicial to [the author's] honor or reputation." An author may exert this right with regard to direct modifications of a work used as a trademark. If an enterprise, for instance, changes the colors of a trademark which also enjoys copyright protection, this change may be perceived as a distortion, mutilation or modification of the work in the sense of Article 6*bis*(1).

82. Pursuant to national practice, an infringement of the moral right of work integrity may also be found when the work as such is left untouched but placed in a derogatory context. Accordingly, the exertion of the moral right of work integrity may also be possible when an enterprise using a copyrighted trademark makes no changes to the mark but extends business activities to goods or services which may be regarded as objectionable. In such a case, the use of the work in relation to the goods or services might amount to an infringement of the moral right of work integrity.

83. The use of a work as a trademark thus raises the issue of potential conflicts with the author's moral rights. It may imply an obligation to indicate the name of the author in connection with the use of the trademark and require particular regard for the integrity of the work. In practice, this problem can be avoided through appropriate contracts, at least in those countries that permit a partial or complete waiver of moral rights.

(c) Different exhaustion regimes

84. The rights of both copyright and trademark owners are subject to the rule of exhaustion (see III (c) above). As exhaustion of rights may be national, regional or international (see III (c) above), the exhaustion regimes applied under national copyright and trademark law may differ.

85. National law may provide for the application of a rule of international exhaustion in the field of trademark law. In consequence, the rights of the trademark owner are exhausted in respect of a product once that product is put on the market under the trademark irrespective of where that act takes place. Parallel importation of genuine goods bearing the trademark would thus be possible.

86. The decision to allow parallel importation in the field of trademark law, however, may be overridden in the case of a trademark which also enjoys copyright protection. If, in the field of copyright law, national law provides for the application of a rule of national exhaustion, the rights of the copyright owner would not be exhausted by the sale or other transfer of ownership of the original or a copy of the work in a foreign country. The owner of copyright in a work used as a trademark may be able to prevent the parallel importation of products carrying the trademark by relying on the copyright. Importation of goods with a trademark that also constitutes a protected work may be held to be an infringement of copyright.

87. Accordingly, the issue arises of how to deal with differences in the exhaustion regimes applied under copyright law and trademark law. Existing national solutions seem to indicate that, in the outlined example, it may be asked whether the copyrighted work constitutes part of the product itself or is rather an accessory, such as an element of the packaging or labeling of the product. In the latter case, the decision, taken in trademark law, to allow parallel importation may prevail.

(d) Different forms of permitted use

88. The exemption of certain uses from the authorization by the copyright owner or the trademark owner often reflect policy decisions taken in the respective fields of intellectual property law. As the different forms of exempted use in copyright law do not necessarily correspond to those exempted in trademark law (see III (c) above), it may not be sufficient to permit a specific unauthorized use of protected subject matter in only one field. In the case of overlapping protection, an unauthorized use that is permitted under trademark law may still be held to amount to copyright infringement and *vice versa*.

89. Under trademark law, for instance, the unauthorized use of a trademark may be permitted for the purpose of truthful comparative advertising on the grounds that true comparisons of relevant facts are likely to reduce consumers' information search costs and may have positive effects on the economy by improving market transparency[14]. If national trademark law provides for a limitation of this type, truthful comparative advertising implying use of a trademark which also enjoys copyright protection may nevertheless require a corresponding limitation in the field of copyright law. Otherwise, the comparative advertising permitted under trademark law may be held to constitute copyright infringement[15].

90. Differences as to the forms of use permitted under copyright law and trademark law thus give rise to the question of the impact on subject matter enjoying double protection. If the answer is that the permission of use in one field should also constitute a defense against infringement in the other field, subject matter enjoying double protection would be subject to all exemptions of use set forth in copyright law and trademark law. If, by contrast, corresponding limitations in both areas are required, subject matter enjoying overlapping protection would only be subject to exemptions of use existing both in copyright law and trademark law. In certain cases, intermediary solutions might be developed by following a

functional distinction. If, for instance, a logotype enjoying double protection is used to distinguish goods or services, trademark rules may be held to prevail. If it is used as an element of a more complex work of art and thus placed in an artistic context, copyright rules may be applicable.

(e) Extension of protection of works through trademarks

91. While copyright law provides for a limited term of protection, the trademark owner can enjoy exclusive rights indefinitely by continued use in trade or by periodically renewing the registration of the trademark (see III (c) above). The owner of copyright and trademark rights in subject matter enjoying overlapping protection may thus be able to maintain trademark protection after the expiry of the term of copyright protection. The maintenance of the trademark registration may however be subject to uninterrupted use of the trademark in the marketplace (see Article 19 of the TRIPS Agreement).

92. The scope of trademark rights, however, is not identical to the scope of the exploitation rights protected by copyright law (see III (a) above). Trademark law aims at the preservation of a trademark's distinctiveness in order to prevent unfair competition and consumer confusion (see II (b) above). By definition, trademark rights are restricted to use of protected subject matter in trade. Upon the expiry of copyright protection, the owner of rights in subject matter eligible for double protection thus looses control over uses that are not trade-related, such as private, scientific and educational use. Pursuant to national law, certain uses of this kind may already have been exempted from the authorization of the copyright owner during the term of copyright protection (see III (c) above).

93. The trademark right to prevent third parties from using the mark in trade, moreover, is subject to the principle of specialty. It may be invoked only in relation to those goods and services in respect of which the trademark is protected. These goods and services reflect the business activities of the trademark owner. In the absence of use of the trademark on relevant goods and services in the marketplace, the trademark owner may be unable to maintain trademark protection. The expired copyright, by contrast, provided protection against any commercial use which was not authorized by the owner or permitted by law – irrespective of the owner's business activities. As explained above, a comparable position with regard to use in trade may only be obtained by the owner of a well-known or famous mark because of the protection of trademarks of this type against dilution or misappropriation of reputation (see III (a) above).

94. The maintenance of trademark protection in a work after the expiry of copyright protection in that same work does not enable the owner to perpetuate the previous level of protection. The subject matter falls into the public domain in respect of all forms of use which are not covered by remaining trademark rights. In particular, it becomes free for use that is not trade-related, and use in trade that does not concern goods or services in respect of which the subject matter enjoys trademark protection.

95. The issue of the maintenance of trademark protection after the expiry of copyright protection may be approached from different angles. From the perspective of copyright law, it begs the question whether the reasons for the temporal limitation of copyright (see III (c)(ii) above) would require that subject matter enjoying double protection fall into the public domain *completely*, or whether the remaining scope of protection flowing from trademark law can be reconciled with the objectives underlying the temporal limitation of copyright. From

the perspective of trademark law, the risk of consumer confusion and unfair free-riding on the trademark's reputation resulting from a possible rule of parallel expiry of copyright and trademark protection in the case of double protection, and repercussions on the trademark system as a whole, would have to be considered (see III (c)(ii) above).

(f) "Privatizing" of cultural assets in the public domain

96. In principle, a literary or artistic work which has fallen into the public domain may be used freely – also for commercial purposes. An enterprise may use, for instance, a melody stemming from a famous piece of music for advertising purposes or include reproductions of a famous painting in the packaging or labeling of its products. Certain restrictions may follow from the exercise of moral rights (see IV (b) above) if national law provides for the maintenance of moral rights after the expiry of the term of protection of economic rights recognized under copyright law.

97. The use of works which have fallen into the public domain, for the purpose of promoting and marketing goods or services, gives rise to the question of the acquisition of trademark rights in such works. If an enterprise acquires trademark rights in a work in the public domain, it can prevent third parties from using the work in trade as a distinctive sign with regard to the goods or services in respect of which it can assert trademark protection. As far as the scope of trademark rights reaches (see III (a) above), the enterprise would thus be able to appropriate subject matter which, previously, was part of the public domain.

98. This partial "privatizing" of works in the public domain raises several issues. On the one hand, it has to be considered that the work concerned may have become part of the cultural heritage of a given society. Accordingly, the question arises whether it is appropriate for an individual or legal person to acquire trademark rights in the work concerned. There might be a need to keep cultural symbols free for use by all persons, including all traders. On the other hand, free use of works in the public domain by all market participants may cause confusion once consumers associate a distinctive work with an individual trader. The link with a specific trader in the minds of consumers may be the result of substantial investment in promotion and advertising activities. Use of the same work by other traders might thus be regarded as an act of free-riding which takes undue advantage of another's achievements.

V. CONCLUSIONS

99. The following conclusions summarize a number of issues pertaining to the relationship between trademarks and literary and artistic works from a theoretical and a practical point of view. While section (a) seeks to sum up the existing overlap on the basis of functional considerations, section (b) provides an overview of areas in which the formulation of complementary policy objectives might be considered.

(a) Works and trademarks as means of communication

100. The comparative analysis of the rationale and criteria of copyright and trademark protection has shown that the conceptual contours of the two protection regimes differ substantially. The link between the two branches of intellectual property law seems to rest primarily on a factual basis – subject matter susceptible to copyright and trademark protection alike (see chapter II.).

101. A point of contact between both branches of intellectual property law, however, comes to the fore when considering that a trademark, because of its various functions, inevitably becomes the carrier of information, for instance, as to the commercial origin of a product, the reputation of the producer, and the qualities and characteristics of the goods or services concerned. In other words, a trademark may be regarded as the focal point of communication with consumers and potential purchasers of a product or service. The transmitted messages depend on the promotion and sales strategy pursued by the trademark owner. In the case of a trademark that has become the symbol of a certain style of life or attitude of mind, it may even be argued that the trademark itself turns into a product. The consumer may acquire the good or service bearing such trademark primarily because of the image it conveys.

102. A line between copyright and trademark protection may therefore be drawn insofar as the argument is accepted that both areas of law offer protection for carriers of information[16]. While this seems to be manifest in the case of literary and artistic works, it is to be conceded that the information transmitted by a trademark has a less finite character. The associations created in the minds of consumers depend on the situation in the marketplace and the promotion and advertising activities carried out by the trademark owner.

103. The identification of the communication function as a common ground of copyright and trademark protection is conducive to a better understanding of points of contact, which arose in the analysis of the respective scope of protection. Trademark protection comes close to the exploitation rights recognized in copyright law in the field of the protection of well-known and famous marks against dilution (see III (a)). These trademarks may be capable of transmitting even complex life style messages going beyond the mere indication of commercial origin and quality. Arguably, the communication function is particularly strong in this area. Hence the approximation to exploitation rights irrespective of the foundation of protection against dilution in unfair competition law (see III (a)).

104. As to limitations on protection, the exemption of the use of protected subject matter from the authorization of the right owner for the purpose of review and parody could be found not only in copyright law but also in trademark law. The main reason for this parallel may be seen in the strong freedom of speech underpinning of limitations of this type (see III (c)). The fact that there are cases of trademark parody, however, testifies to the potential of trademarks to serve as a means of communication and even of intellectual debate.

105. Accordingly, the relation between trademarks and literary and artistic works may be understood as the relation between different means of communication. This broader perspective widens the view on complementary principles clarifying the relationship between the two fields of intellectual property law.

(b) Complementary policy objectives

106. The overlap of copyright and trademark protection as regards certain subject matter (see II (c) above) raises the question whether there is need to ensure coherence between the two branches of intellectual property law by defining complementary policy objectives and guidelines, particularly, in the following areas:

– the dignity of literary and artistic works as expressions of personal creativity and parts of the cultural heritage (see chapter IV(b) and (f), issues: “Moral rights of the author” and “Privatizing” of cultural assets in the public domain”);

– the field of exhaustion regimes (see chapter IV(c), issue: “Different exhaustion regimes”);

– the field of use permitted by law, such as communication-related limitations, e.g. limitations for the purpose of quotations, review and parody, commercial speech (comparative advertising) and privileges for the press and media (see chapter IV(d), issue: “Different forms of permitted use”);

– the balance between the specific scope of the different areas of intellectual property protection and the principle of freedom of competition in a market economy (see chapter IV(e), issue: “Extension of protection of works through trademarks”).

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1 Cf. Desbois, Le droit d’auteur en France, 2nd edition, Paris 1978, p. 538; Ricketson, The Berne Convention for the Protection of Literary and Artistic Works, London 1987, p. 5-6.

2 Cf. EC Directive 2001/29/EC of the European Parliament and of the Council of May 22, 2001, on the harmonization of certain aspects of copyright and related rights in the information society, recital 4.

3 In this document, the term “trademark” refers to both trademarks and service marks.

[Endnote continued on next page]

[Endnote continued from previous page]

4 See European Court of Justice, SA CNL-SUCAL NV v. HAG GF AG, Case C-10/89, Judgment of October 17, 1990, paragraph 13.

5 Cf. European Court of Justice, Arsenal Football Club plc v. Matthew Reed, Case C-206/01, Opinion of Advocate General Colomer of June 13, 2002, paragraphs 46-47.

6 Cf. Supreme Court of the United States of America, Qualitex Co. v. Jacobson Products Co., 514 U.S. 159, 163-164 (1995).

7 See Cornish/Llewelyn, Intellectual Property: Patents, Copyright, Trade Marks and Allied Rights, London 2003, p. 587.

8 See, for instance, Supreme Court of the United States of America, Dastar Corporation v. Twentieth Century Fox Film Corporation et al., 539 U.S. (2003). As to the situation in France, cf. Edelman, Recueil Dalloz 2004, no. 19, p. 1372-1376.

9 For a discussion of the lengthening of the term of protection, see Supreme Court of the United States of America, Eldred v. Ashcroft, 537 U.S. 186 (2003).

10 See, for instance, copyright legislation in France.

11 See the deliberations at the 1948 Brussels Conference for the revision of the Berne Convention, Documents de la Conférence réunie à Bruxelles, p. 100. Cf. United States – Section 110(5) of the US Copyright Act, Report of the Panel, WTO document WT/DS160/R.

12 See the deliberations at the 1967 Stockholm Conference for the revision of the Berne Convention, Records of the Intellectual Property Conference of Stockholm, p. 1165. Cf. Desbois/Françon/Kéréver, Les conventions internationales du droit d'auteur et des droits voisins, Paris 1976, p. 207-209; Ricketson, ibid., p. 537-542.

13 For an interpretative analysis of the limited exceptions test of Article 17 TRIPS on the one hand, and the "three-step test" of Article 13 TRIPS on the other hand, see United States – Section 110(5) of the US Copyright Act, Report of the Panel, WTO document WT/DS160/R, dated June 15, 2000, on the one hand, and European Communities – Protection of Trademarks and Geographical Indications for Agricultural Products and Foodstuffs, Report of the Panel, WTO document WT/DS174/R (complaint by the United States of America) and WTO document WT/DS290/R (complaint by Australia), both dated March 15, 2005, on the other hand.

14 See Protection Against Unfair Competition – Analysis of the Present World Situation, WIPO publication No. 725, Geneva 1994, p. 62.

15 See High Court of the United Kingdom, IPC Media Ltd. v. News Group Newspaper Ltd., EWHC 317 (2005).

16 Cf. Cornish/Llewelyn, ibid., 571.