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STANDING COMMITTEE ON THE LAW OF TRADEMARKS, INDUSTRIAL DESIGNS AND GEOGRAPHICAL INDICATIONS

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**TRADEMARKS AND THEIR RELATION
WITH LITERARY AND ARTISTIC WORKS**

Document prepared by the Secretariat

I. INTRODUCTION

1. At the sixteenth session of the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT), held in Geneva from November 13 to 17, 2006, the SCT agreed to ask the Secretariat to develop a paper for consideration by the SCT at its eighteenth session, based, *inter alia*, on submissions by SCT Members providing an overview of jurisprudence on the overlap between copyright and trademarks, including new types of marks, with a particular focus on identifying existing and potential problems.

2. Submissions were received from Colombia, Norway, the Russian Federation and the United Kingdom¹. The submissions address the following topics:

- Coexisting protection under the copyright and trademark regimes (Section II),
- Copyright and new types of marks (Section III),
- Copyright as a relative ground for refusal of a trademark application or as a ground for invalidation of a trademark registration (Section IV), and
- “Privatizing” of cultural assets in the public domain (Section V).

Accordingly, the Secretariat has prepared the present document, which summarizes the above-mentioned submissions made by SCT Members.

II. COEXISTING PROTECTION UNDER THE COPYRIGHT AND TRADEMARK REGIMES

3. Document SCT 16/5 analyzed in detail the differences between the copyright and trademark regimes, as regards the underlying rationale behind copyright and trademark law, the criteria for protection and the scope of the protection afforded by each right. The document further referred to the fact that certain subject matter can fall within the scope of copyright and trademark protection at the same time, which may give rise to a number of issues.

4. The submission of Norway presents an example of subject matter which enjoys protection under Norwegian law as copyright, as a trademark and as a design. The object in question is the “TRIPP-TRAPP” chair, which is registered as a three-dimensional mark for “chairs for children”, is registered as a design and enjoys protection as a protected work under the Norwegian Copyright Act. Moreover, certain technical aspects of the chair enjoy patent protection.

III. COPYRIGHT AND NEW TYPES OF MARKS

5. As mentioned above, certain subject matter may fall within the scope of protection by both copyright law and trademark law. This is particularly the case for subject matter which may constitute non-traditional marks, such as three-dimensional shapes, slogans, holograms, motion signs and melodies.

6. At the sixteenth session of the SCT, several delegations expressed the view that the relationship between copyright and trademark protection should be further explored, with particular regard to new types of marks.

7. The submissions of Norway, the Russian Federation and the United Kingdom address the question of new types of marks and their relationship with copyright. Generally speaking, those submissions indicate that there is no different treatment for non-traditional marks, nor separate criteria for assessing the registrability of those marks. For a broader analysis of that subject, reference is made to document SCT/17/3 (Relation of Established Trademark Principles to New Types of Marks).

IV. COPYRIGHT AS A RELATIVE GROUND FOR REFUSAL OF A TRADEMARK APPLICATION OR AS GROUND FOR INVALIDATION OF A TRADEMARK REGISTRATION

8. As stated in paragraph 75 of document SCT/16/5, “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.” It follows from the Summary of Replies to the Questionnaire on Trademark Law and Practice, that such is the case in 37 of the 67 jurisdictions which replied to the Questionnaire on this point (see pages 74 and 75 of document WIPO/STrad/INF/1).

9. The submissions made by the four SCT Members mentioned in paragraph 2, above, refer to the fact that, under the trademark law of those SCT Members, copyright constitutes a relative ground for refusal of a trademark application or a reason for invalidation of a trademark registration. The submissions further explore two particular issues, namely (a) whether or not, and to what extent, the relevant ground is raised *ex officio* by the Industrial Property Office, and (b) the question as to *when* there exists a copyright capable of constituting a relative ground for refusal.

- (a) Copyright as a relative ground for refusal raised *ex officio* or as a ground for invalidation

10. In the United Kingdom, registration of a trademark may be refused on the ground that the sign is the subject of copyright in a literary or artistic work. This ground is however rarely invoked *ex officio* by the Office, as it is considered that it depends on factual and legal questions of, *inter alia*, qualification, subsistence and ownership of the right. In most cases, the ground is invoked in evidence-based *inter-partes* actions. It should be noted that the ground in question is altogether a comparatively rare ground of objection in the United Kingdom.

11. In the Russian Federation, a designation which is identical to the name of a work of science, literature or art, or to the character or quotation from such a work, known in the Russian Federation on the filing date of the trademark application, may not be registered as a trademark without the consent of the copyright owner or its lawful successor. This is not examined *ex officio* by the office during the registration procedure. However, the owner of prior copyright or his successor in law may challenge the validity of a registration effected in breach of the aforementioned requirement of consent. Several court decisions illustrate this position².

- (b) Conditions under which a sign qualifies for copyright and constitutes a relative ground for refusal or as a ground for invalidation

12. Whether *ex officio* or in the course of an *inter partes* proceeding, an industrial property office may conclude that a sign cannot be registered as a trademark because it is the subject of copyright. In the process leading to that conclusion, the Office must determine, first of all, that the sign in question is a work which qualifies for copyright protection. In some cases, the Office subsequently determines in respect of which goods and/or services for which registration of the mark is sought copyright constitutes a relative ground for refusal. In other words, the sign qualifying for copyright protection does not constitute inevitably a ground for refusal in respect of *all* possible goods and/or services.

13. As regards, firstly, the subject matter which may be considered as attracting copyright protection, the submission of the United Kingdom points out that “copyright as a literary work does not subsist in, for instance, the title or isolated parts of the text of a book or poem. Single (even invented) words, or even sentences, taken from larger works are unlikely therefore to be objectionable on the basis that they attract copyright as a literary work.”³

14. As regards the goods and/or services in respect of which copyright is considered to constitute a relative ground for refusal, the submission of Norway indicates that, in Norway, a trademark may not be registered if it includes anything liable to be understood as enjoying copyright protection. However, the Norwegian Office does not refuse registration on the ground of an existing copyright, in respect of *all* goods and/or services, as a matter of course. The prohibition applies only in respect of those goods and/or services which are somehow related to the protected work, such as books or magazines, publishing services or other services linked to the theme of the protected work⁴.

15. The Norwegian Office justifies its practice by explaining that there is an enormous amount of titles in the world, and that affording unlimited protection to all those titles would reduce traders’ chances of finding available signs to be used as marks.

16. The Court of Justice of the Andean Community ruled⁵ that a title of a literary, artistic or scientific work which is the subject of a copyright may not be registered as a trademark, insofar as the use of such title as a trademark *in respect of the goods and/or services for which trademark registration is sought* would result in a likelihood of confusion. However, a title may be registered as a trademark for those goods and/or services in respect of which use as a trademark would not result in a likelihood of confusion.

17. The Court further considered that there are titles which enjoy a high level of reputation and originality. By definition, use of those titles as a trademark is likely to create confusion, irrespective of the good and/or service for which such use is made. Consequently, those titles cannot be registered as trademarks for any good and/or service.

V. “PRIVATIZING” OF CULTURAL ASSETS IN THE PUBLIC DOMAIN

18. Paragraphs 96 to 98 of document SCT/16/5 provide an extensive explanation of the issue at stake. By way of summary, it may be recalled that, in principle, a literary or artistic work which has fallen into the public domain may be used freely, including for commercial purposes. However, there might be public policy reasons which would justify that an enterprise should not be entitled to acquire trademark rights in a work that is in the public domain.

19. In Norway, the word Peer Gynt was refused registration as a trade mark for entertainment services because it is the title and character of a famous Ibsen play. The Office stated that, even though Peer Gynt is presently part of the public domain, since Ibsen died more than 70 years ago, the sign should be kept free and available for all to use *in respect of entertainment services*. As regards other goods and services, however, the Office did not consider that it would be justified to maintain the sign free and available. The sign was therefore registered as a trademark for knitting yarn and knitted clothes.

20. *The SCT is invited to consider the contents of the present document and to indicate whether it wishes to make any recommendations concerning the work of the SCT in that area.*

[End of document]

¹ The full text of the submissions is available on the SCT Electronic Forum.

² Decision cancelling the trademark registration of the illustration of “Ptitsa Gzhel” in the name of a person other than the person with whom the owner of the copyright had executed an agreement; decision cancelling the registration as a trademark of the name “Winnie,” filed without the consent of the successor in title of the author of the book “Winnie the Pooh and the others.”

³ Exxon Corp. v. Exxon Insurance Consultants International Ltd.

⁴ The word mark PEER GYNT was registered in Norway for knitting yarn in class 23 and knitted clothes in class 25, but refused for entertainment services in class 41. The word marks HERCULES, CINDERELLA and SNOWWHITE have been registered in respect of certain goods, but not in respect of other goods such as videograms, phonograms, books or toys.

⁵ Decision of the Court of Justice of the Andean Community of March 5, 1999, rendered as a reply to a request for pre-judicial interpretation (SUPERMAN and SUPERMANI).