

Trade Marks and their relationship with literary and artistic work.

1. Section 5(4)(b) of the Trade Marks Act 1994 provides:

“A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented:

(a).....;

(b) by virtue of an earlier right other than those referred to in subsections (1) to (3) or paragraph (a) above, in particular by virtue of the law of copyright, design right or registered designs.

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an “earlier right” in relation to the trade mark.”

2. In addition, Section 3(6) of the Act provides:

“(6) A trade mark shall not be registered if or to the extent that the application is made in bad faith.”

Commentary

3. The above grounds are the most likely grounds that would be invoked to prevent the registration of a mark the subject of copyright in a literary or artistic work.
4. They are not however grounds which are likely to be invoked in ex officio examination, depending as they do on factual and legal questions of qualification, subsistence, ownership, notional infringement and sometimes bad faith. Such questions have usually to be determined on the basis of evidence provided by parties. Despite this, the UK Registry does also perform a role in ex-officio examination.

Ex officio examination

5. As regards fictional names, we would object to eg the name SHERLOCK HOLMES (the well known fictional detective in the UK) since the name has long since passed out of the original Conan Doyle estate which presumably owned the copyright in the books. On the other hand, we would accept eg INSPECTOR GADGET as that more recent character is likely to be commercially ‘controlled’ by Disney, or whoever the film rights belong to.
6. Particular attention is paid to goods/services likely to be aimed at children which commonly carry ‘characters’ as a means of attraction. As stated, a judgment will be made as to the likelihood that such a character is under commercial control.
7. As regards non-fictional, famous, names we object to their registration if in our opinion the legitimate rights of third party merchandisers may be adversely affected. However, such objection is likely to be limited to those goods (posters/photos/books) which simply carry the famous person’s image and can therefore only be described as eg a DAVID BECKHAM poster.

8. Each case will depend on the circumstances but it is important to realise that in this area the UK uses as a basis of objection distinctiveness/descriptiveness grounds in *ex officio* examination almost exclusively. The sections of our Act quoted at the head of this paper are in the vast majority of instances the subject of evidence based inter-partes action.

Inter – partes.

9. A number of inter –partes decisions have been issued by the Registry (see eg LITTLE HIPPO (BL O/287/01) which help. In this case it is said that (relying on Exxon Corp v Exxon Insurance Consultants International Ltd (1982 RPC 69) copyright as a “literary work” does not subsist in eg 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”.
10. As far as artistic works are concerned, the same factual and legal questions in para 4 above would have to be addressed. In particular, the ‘copying’ of the artistic work would have to constitute what would be taken as copyright infringement; not merely that the infringing work happens to be similar to the ‘original’ copyright work, but that it is the result of copying. There are many authorities on the subject and we would rely on them accordingly.
11. It is the case that the section 5(4)(b) is a comparatively rare ground of objection in the UK.

New marks.

12. The above principles apply equally to all types of mark; there is no different treatment for non-traditional marks.