

## **Submission from the Norwegian Patent Office relating to trademarks and their relation with literary and artistic works**

Here follows information from The Norwegian Patent Office relating to our practice with the overlap between copyright and trademarks, including new types of marks.

### ***Introduction***

We will in the following give information about the legal situation of trademarks bordering on copyrights according to the Norwegian Trademarks Act, and we will give some examples from our practice.

Some examples will relate to non-traditional trademarks where the question was if the marks were liable to be understood as a protected work of another person. Other examples are of wordmarks and combined marks (combination of text and figurative elements), where the question was if the marks were liable to be understood as the distinguishing title of, or a character from a protected work of another person. We will also give examples regarding whether trademark rights could be acquired in works that have fallen into the public domain.

### ***The Norwegian Trademarks Act***

According to the Norwegian Trademarks Act § 14(1) No. 5, a trademark may not be registered if it includes anything liable to be understood as the distinguishing title of the protected artistic, literary or musical work of another person, or infringes the copyright to such a work or the photography or design rights of another person.

The Office must first establish whether the work or title in question would be understood as a protected work or a distinguishing title of a protected work. Then the Office must undertake a separate examination to establish whether the mark is liable to fulfill the function of indicating the commercial origin of certain goods/services.

In the examination of the term "liable to be understood", the Office will consider the list of goods and/or services which the mark is applied for. As a main rule the Office will not refuse registration of a mark that falls under the above-mentioned provision for all goods and/or services. If the mark is liable to be understood as a distinguishing title of a protected work, the Office might still register the mark for certain goods/services. The requirement is that there is sufficient distance between the goods/services in question and those related to for example books, magazines, publishing-services or the theme of the book. Consequently, a trademark liable to be understood as a distinguishing title of a protected work may still be registered for goods such as tractors and tires, provided that it fulfills all requirements for registration.

Our reasoning for choosing such practice is that there are an enormous amount of titles in the world. If all these titles should enjoy protection for all possible goods and services, this would, in our opinion, imply severe restrictions on traders' interests in acquiring protection for their trademarks.

## ***Cumulative protection***

There would be situations in Norway where it is possible to obtain cumulative protection in relation to the copyright, design, patent and trademark regimes. Sometimes we find that a design or trademark could be protected cumulatively as a copyright, design, trademark and patent. The scope of protection will vary for most of these regimes, but there could be areas where parallel protection is possible. However, cumulative protection presupposes that the holder of the different rights is the same (or that the holder has given his or her consent).

An example of such cumulative protection is the TRIPP-TRAPP chair designed by Stokke. This chair enjoys protection as a three-dimensional trademark registered for "chairs for children" (class 20), it is registered as design, it is patented, and there is a court-decision concluding that it also enjoys protection as a protected work according to the Copyright Act.

TRIPP-TRAPP by Stokke



## ***Non-traditional trademarks***

There are no separate criteria for assessing the registrability of non-traditional trademarks in Norway. Non-traditional marks must, like the more traditional marks, be able to overcome absolute grounds for refusal, such as lack of distinctive character (i.e. descriptiveness and genericness), conflict with public order or morality, or deceptiveness.

The Norwegian Patent Office will examine any trademark application to see if it meets the requirements set forth in the Trademarks Act § 13. This provision states that a trademark, in order to be registered, must be capable of distinguishing the goods of the holder from those of others.

This provision refers to one of the core functions of trademarks, namely to identify the commercial source of goods and services offered in the market.

To see whether a trademark fulfills the requirements for registration, it must be seen in connection with the applied for list of goods and/or services.

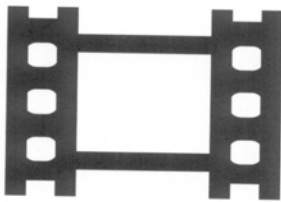
## ***Examples of non-traditional marks and their relation to copyright***

A **sound mark** would probably not be registered if it consists of a whole song or a musical piece. It is not clear where to draw the line regarding the duration of a sound mark. We have no specific examples from the Norwegian practice on a sound mark being refused due to the duration of the sound itself.

Regarding a **moving image mark**, there could be situations where one has to decide whether a moving image really can be seen and understood as a trademark or merely seen as a commercial or advertisement for certain goods or services. However, we have no such examples in our practice.

### ***A figurative mark - symbol***

Some **symbols** can be refused on the ground that it must be kept free and available for all to use. An example from Norwegian practice is the symbol for film, which was applied for goods in the classes 9 and 28.



### ***Wordmarks and combined marks which indicate the distinguishing title of or characters from a protected work***

A wordmark or a combined mark (combination of text and figurative elements) which indicates the distinguishing title of or a character from a protected work, would be refused because they describe the contents of a film, book, etc. (Trademarks Act § 13).

Such marks could also be refused if the mark indicates the distinguishing title of or a character from a protected artistic, literary or musical work of another person, or infringes the copyright to such a work (Trademarks Act §14(1) No. 5).

Here are some examples from the Norwegian practice regarding both refusals and registrations:

The wordmark **PEER GYNT** was registered for knitting yarn in class 23 and knitted clothes in class 25. It was refused registration for entertainment-services (class 41), because Peer Gynt is the title of and character from a famous Henrik Ibsen play. The Office stated that even though Peer Gynt is part of the public domain, since Henrik Ibsen died more than 70 years ago, it should still be kept free and available for all to use for entertainment-services (theaters, plays, films, etc).

The wordmark **HERCULES** was registered by the Board of Appeals (BoA) for specified goods in the classes 3, 9, 14, 16, 21, 24, 25, 28, 29 and 30. The holder is The Walt Disney Company. The BoA stated that Hercules is the name of a Greek half-god and such historical and legendary name should be kept free and available for all to use. The BoA refused registration for goods like phonograms, videograms, computer-programs and books, because Hercules would only be understood as indicating for example the contents of a book, and not as identifying the commercial source of the goods in question. The BoA referred to the ECJ-case C-206/01 ARSENAL, where the court stated that an exclusive right towards use of identical sign for identical goods is absolute, and not limited to use which is meant to indicate a commercial origin. This will imply that a registration of **HERCULES** would give the holder a right to refuse others any use of the word **HERCULES**, also for other matters than trademark.

The wordmark **NO LOGO** was registered for "telecommunication-services" in class 38. The Office stated in the opposition-case that the question is whether **NO LOGO** is liable to be understood as the distinguishing title of a protected work, namely the book "No Logo" by Naomi Klein. The Office decided that the wordmark **NO LOGO** would be able to indicate the commercial origin of telecommunication-services, and would not be understood as the distinguishing title of the protected work of another person.

The wordmark **CINDERELLA** as applied by Disney Enterprises, Inc., has been refused for film, DVD, CD etc in class 9, and toys and dolls in class 28, because Cinderella is a famous fairytale-figure, and it is not seen as capable of distinguishing the goods of the holder from those of others. Cinderella must be kept free and available for all to use in their marketing of their goods in class 9 and 28. This case is still pending in the Office (April 2007).

A similar decision was made regarding the wordmark **SNOWWHITE**, also applied by Disney Enterprises, Inc. It has been refused for film, DVD, CD etc in class 9, and toys and dolls in class 28, because Snowwhite is a famous fairytale-figure, and it is not seen as capable of distinguishing the goods of the holder from those of others. Snowwhite must be kept free and available for all to use in their marketing of their goods in class 9 and 28. This case is also still pending in the Office (April 2007).

A similar decision (refusal) has been made for the wordmark **PINOCCHIO**.

The wordmarks **DONALD DUCK** and **MICKEY MOUSE**, applied by Disney Enterprises Inc., are however registered for goods in the classes 3, 14, 18 and 20.

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