



5th IP Case Law Conference

30 April 2024

When copyright works become trade marks

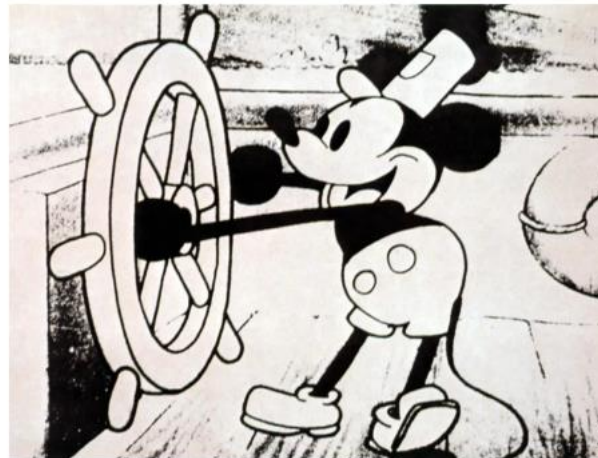
Dr. Anastasiia Kyrylenko

The New York Times

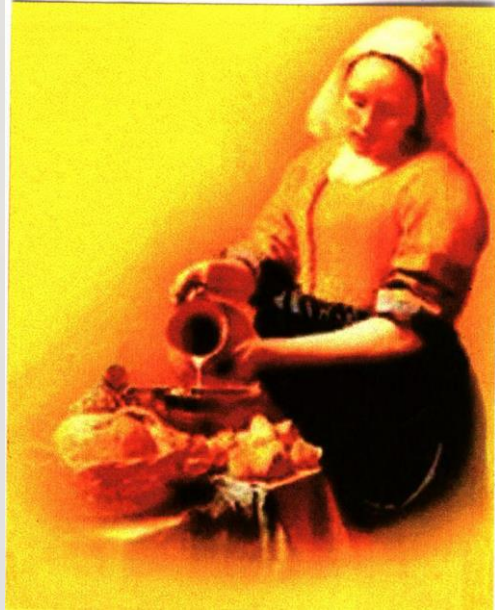
These Classic Characters Are Losing Copyright Protection. They May Never Be the Same.

What could happen to the original version of Mickey Mouse and others after they entered the public domain on Jan. 1? Hint: think Winnie the Pooh wielding a sledgehammer.

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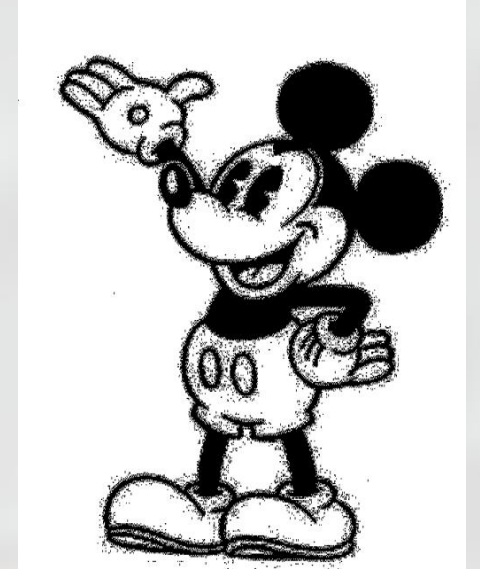
The "Steamboat Willie" version of Mickey Mouse enters the public domain on Jan. 1.
LMPC, via Getty Images



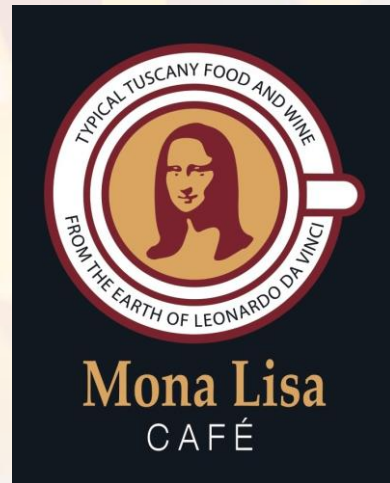
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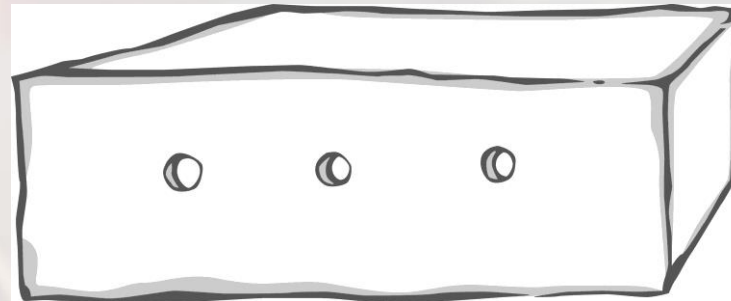
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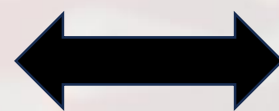


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EUTM
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Copyright



Trade marks

Preliminary considerations

- Term of copyright protection *vs.* potentially eternal protection as TM;
- Overarching protection in copyright *vs.* use in the course of trade, in relation to G&S (Art. 10(2) EUTMD, Art. 9(2) EUTMR)
- Applied for by the RH *vs.* by a third party
- Applied for during the duration of copyright *vs.* when in public domain
- The same sign may be protected as an original creative work by copyright and as an indicator of commercial origin by trade mark law (T-435/05, para. 26);
- Cumulation of TM and other IPRs is permitted under EU law (C-205/13, AGO, para. 34);
- No specific ground for refusal or invalidity of works in public domain in trade mark law.



https://commons.wikimedia.org/wiki/File:Medusa_Rondanini_%28GL_252%29_-_Glyptothek_-_Munich_-_Germany_2017.jpg

Lack of distinctiveness (Art. 4(1)(b) EUTMD, Art. 7(1)(b) EUTMR)

- 24 W (pat) 188/96 “Mona Lisa”:
 - DPMA: rejected for beauty products due to **lack of distinctiveness** and being **contrary to public policy** -- “[t]rade mark protection for a work of art in the public domain represents an inadmissible circumvention and re-monopolization of the work, which cannot be reconciled with public order”
 - BPatG: rejected due to **lack of distinctiveness**, an examination of other grounds for refusal is unnecessary. **Applying the public policy ground may lead to the almost incomprehensible result** that the reproduction of a work protected by copyright - even for the author himself - should under no circumstances be registered as a trade mark. Possible abuses may be countered by means of the cancellation procedure under the **bad faith** provision.



Public policy and morality (Art. 4(1)(f) EUTMD, Art. 7(1)(f) EUTMR)

- E-5/16 “Vigeland”:
 - NIPO: lack of distinctiveness, shape giving substantial value to the goods, descriptive. Appealed to the BoA of NIPO.
 - EFTA court: (1) registering an artwork that is part of a nation’s cultural heritage may be contrary to **acceptable principles of morality** where it is perceived as offensive by an average consumer who considers this a misappropriation or a desecration of the artist’s work; (2) registering an artwork may be **contrary to public policy** if the sign consists *exclusively* of a work pertaining to the public domain and the registration of this sign constitutes a genuine and sufficiently serious threat to a fundamental interest of society (incl. the need to safeguard the public domain). **No threat exists to the need to safeguard the public domain** if a sign consisting of an artwork can be refused registration on other grounds included in the EUTMD.
 - BoA of NIPO: refused registration under the **public policy** ground, as Vigeland’s art has significant cultural value.



https://commons.wikimedia.org/wiki/File:%22bachor%22_%22_Angry_Boy%22.jpg

Bad faith (Art. 4(2) EUTMD, Art. 59(1)(b) EUTMR)

- R 1246/2021-5 “Banksy”:
 - BoA: the same artwork can be protected by copyright as well as by trade mark law. Applying for a EUTM when the same sign is also protected by copyright is **not indicative of bad faith**.
- C-17/24 (pending):
 - Is it bad faith to apply for a shape trade mark because the patent has expired?





Thank you for your attention!