

# ***IP AND POP CULTURE***

**Batman, James Bond, Pinocchio, Mowgli  
and trade mark right**



Organised by:





**Yann BASIRE,**  
Maître de conférences and Director General  
CEIPI, University of Strasbourg

Organised by:



# IP AND POP CULTURE

- Why?
- A serious topic?
- A legitimate object of study
- Stronger link with IP

# IP AND POP CULTURE

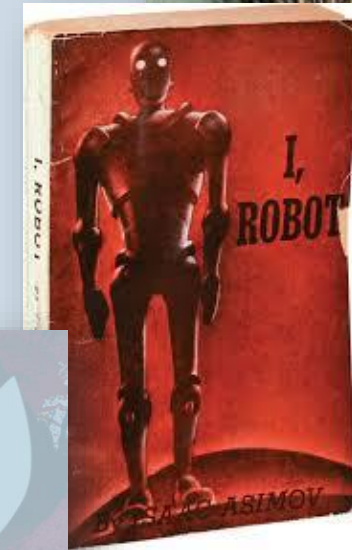
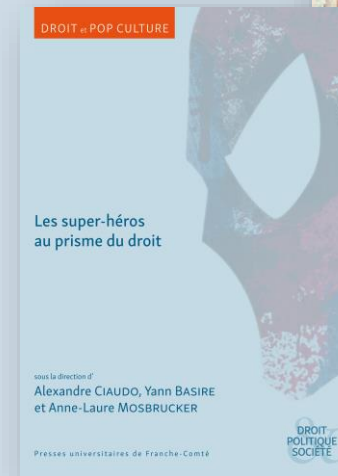
- Distinction between High Culture and Low Culture
- Hierarchy?
- Opera > Video game or movie hero?
- Pop culture must be distinguished from mass culture
- Pop culture invites reflection

# IP AND POP CULTURE



# IP AND POP CULTURE

- Many projects related to Pop culture
- Pop culture makes the law more accessible
- Pop culture contributes to representing the law
- Pop Culture as an economic and cultural model must also be understood as an object of study



# IP AND POP CULTURE

The subjects linking pop culture and intellectual property are rich and numerous

- the delicate issue of street art ;
- the taxation of derivative products ;
- the authorised and unauthorised uses of pop culture works ;
- the practice of fan fictions, spoilers, memes, scan trad, retrogaming, speedwatching, cosplay ;
- questions linked to cultural appropriation ;
- the legal framework of e-sport ;
- the creative process with electronic music and artificial intelligence ;
- the social model of pop culture.

# IP AND POP CULTURE

The protection of the titles and of the names of characters by TM right...an issue?





IL MARCHIO E COSTITUITO DALLA LEGGENDA DRAGONBALL, IMPRESSA CON CARAT TERI DI FANTASIA, ASSOCIATA ALLA FIGURA A MEZZOBUSTO DI UN PUPAZZO SOR RIDENTE SU SFONDO CON CAMPITURE CHIARE E SCURE

(210)/(260) Numéro de la demande 1999900808875  
 (270) Langue de la demande it  
 (220) Date de la demande 1999-12-20  
 Office des marques Italy - UIBM  
 (190) Office d'enregistrement IT  
 (111) Numéro de l'enregistrement 0000877957  
 (151) Date de l'enregistrement 2002-11-21  
 (550) Type de marque Other  
 (511) Classification de Nice 16,18  
 Statut actuel de la marque Registered

(510) Liste des produits et services

**IT**

(511) Numéro de la classe de Nice 16  
 Liste des produits et services Carta e cartone; stampati; articoli per legataria; fotografie; cartoleria; adesivi (materie collanti) per la cartoleria o per uso domestico; materiale per artisti; pennelli; macchine da scrivere e articoli per ufficio (esclusi i mobili); materiale per l'istruzione o l'insegnamento (tranne gli apparecchi); materie plastiche per l'imballaggio; caratteri tipografici; cliché.  
 (511) Numéro de la classe de Nice 18  
 Liste des produits et services Cuoio e sue imitazioni; pelli di animali; bauli e valigie; ombrelli e ombrelloni; bastoni da passeggio; fruste e articoli di selleria.



(210)/(260) Numéro de la demande 1611210  
 (270) Langue de la demande fr  
 (220) Date de la demande 1989-02-15  
 Office des marques France - INPI  
 (250) Lieu de dépôt INPI PARIS  
 (190) Office d'enregistrement FR  
 (111) Numéro de l'enregistrement 1611210  
 (550) Type de marque Combined  
 (511) Classification de Nice 09,16,28,35,39,41  
 (531)/(532) Classification de Vienne 02.01.21, 02.01.25, 03.07.01, 02.01.03, 02.01.02  
 Statut actuel de la marque Registered


(510) Liste des produits et services

**FR**

(511) Numéro de la classe de Nice 00  
 Liste des produits et services Appareils et instruments scientifiques, nautiques, géodésiques, électriques, photographiques, cinématographiques, optiques, de pesage, de mesurage, de signalisation, de contrôle (inspection), de secours (sauvetage) et d'enseignement;appareils pour jeux conçus pour être utilisés seulement avec récepteur de télévision;appareils pour l'enregistrement, la transmission, la reproduction du son ou des images;supports d'enregistrement magnétiques, disques acoustiques;distributeurs automatiques et mécanismes pour appareils à prépaiement;caisses

# VALIDITY OF THE SIGN?

- Some other examples:

–  (3, 4, 14, 16, 18, 25, etc.)

– *Who Watches the Watchmen* (3, 9, 14, 16, 18, 25, etc.)

–  (9, 16, 25, 28, 41)

# DISTINCTIVENESS

- Distinctive?



- The notoriety of a sign, used otherwise than as a trade mark, may therefore prevent it from being recognised as distinctive within the meaning of trade mark law

# DISTINCTIVENESS

## Requirement of Distinctiveness

- The sign must be perceived as TM by the consumers
- **Function of TM**
- **3D TM:** *Average consumers are not in the habit of making assumptions about the origin of products on the basis of their shape or the shape of their packaging in the absence of any graphic or word element and it could therefore prove more difficult to establish distinctiveness in relation to such a three-dimensional mark than in relation to a word or figurative mark*
- **Slogans:** these signs are exclusively perceived as laudatory or promotional signs and not as trade mark
- **Colors**
- **Sound TM**
- **Symbols**



#JesuisCharlie

# DISTINCTIVENESS

BoA R 1856/2013-2, 25/02/2015 PINOCCHIO



Pinocchio, filed by Disney Enterprises, Inc.  
Classes 9, 16, 28 and 41

(Recording discs; cinematographic films, exposed films; audio discs; CD-ROMS; compact discs; computer game programs; computer game discs; DVDs; DVD recorders; digital versatile discs; digital video discs; motion picture films; video cassette recorders; video game discs; video cassettes; Printer matter; baby books; books; cartoon strips; children's activity books; comic books; comic strips; magazines; picture books.: Action figures; bath toys; collectable toy figures; crib toys; dolls; electric action toys; inflatable toys; mechanical toys; plush toys; puppets; squeeze toys; stuffed toys; toy figures; Entertainment services; amusement park and themed park services; educational and entertainment services rendered in or relating to theme parks; live stage shows; presentation of live performances; theatre productions; entertainer services.)

# DISTINCTIVENESS

*"if a title in question is famous enough to be truly well known to the relevant public where the mark can be perceived in the context of the goods/services as primarily signifying a famous story or book title, a mark may be perceived as non-distinctive. A finding of non-distinctiveness in this regard will be more likely where it can be shown that a large number of published versions of the story have appeared and/or where there have been numerous television, theatre and film adaptations reaching a wide audience. 'PINOCCHIO' belongs to the category of titles described above. It is indeed a title of a story that is long established and well known as a reference to a children story about a wooden boy whose nose grows when he lies. PINOCCHIO' has been established for so long that it has 'entered into the language' as the cancellation applicant notes, and that it is incapable of being ascribed any meaning other than just a particular story"*

# DISTINCTIVENESS

## 11/8/2014-1, 18/03/2015, THE JUNGLE BOOK

- Cumulative protection title + trade mark is *a priori* not excluded
- No distinctive character when the sign applied for is purely understood as a reference to the author's work or type of story without any additional element which could impart distinctive character to the sign indicating the business origin
- Everyone **knows the story** from childhood; multiple **adaptations** from multiple sources.
- **Non-distinctive and descriptive** for:
  - films, printed matter...(Cl. 9, 16)
  - entertainment, amusement park services...(Cl. 41)



# DISTINCTIVENESS

TFI 30/6/2009 case T-435/05 Danjaq, LLC v. EUIPO Dr. No

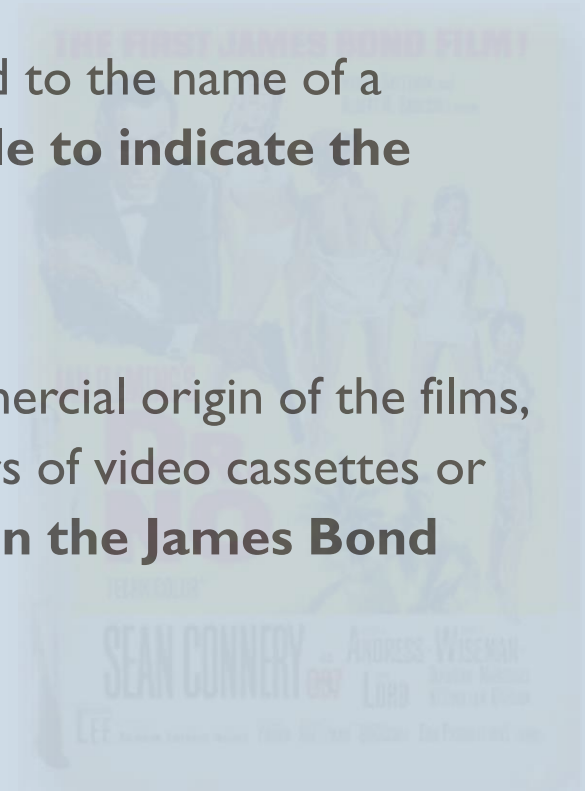
- Dr. No – 9, 12, 18, 25, 32.
- Opposition proceedings
- Earlier right: Dr. No – non registered TM – 6 bis
- No demonstration of the well-knownness of the sign





# DISTINCTIVENESS

- Dr. No refers to the title of the first film in the James Bond series and to the name of a character in the film does **not prevent it, ipso facto, from being able to indicate the commercial origin of goods or services**
- However, it appeared that the sign was not used to identify the commercial origin of the films, but their artistic origin, since the sign in question, affixed to the covers of video cassettes or DVDs, **served solely to distinguish that film from other films in the James Bond series**



# DISTINCTIVENESS

## These decisions are not fully satisfactory:

- The requirement of distinctiveness *per se* seems to merge with the requirement of descriptiveness

*"all these goods may include those that serve as a support for the Jungle Book stories, either as books, films, or other adaptations and will therefore give an indication of their content to the relevant public"*  
(Jungle Book)

- The average consumer *"will simply think that these goods and services refer to the story of 'PINOCCHIO', this being the only meaning of the term concerned. The subject-matter of these goods and services is clearly the title and also the fictional character from a well-known children's book "*  
(Pinocchio)

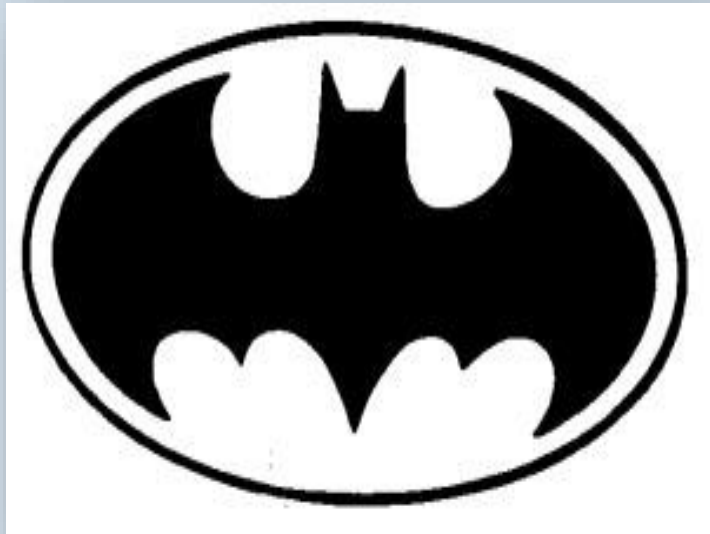
# DISTINCTIVENESS

## Surprising décisions:

- James Bond - The judges stated that the commercial origin of the film Dr. No was "indicated by other signs, such as '007' or 'James Bond', which are affixed to the covers of video cassettes or DVDs and which indicate that its commercial origin is in the company producing the films in the 'James Bond' series"
- Does this mean that the serial nature of James Bond means that this sign can be perceived by the average consumer as a trade mark?

# DISTINCTIVENESS

21/05/2020 - No 31 962 C



- The applicant claimed that consumers associate the contested sign directly to the character of Batman and its costume and therefore it will **not be perceived as an indication of the origin of the goods but as an indication of the purpose of the goods:** to wear the same costume as Batman.
- The EUTM proprietor argued that, on the contrary, the trade mark is used to **differentiate the goods from the proprietor's franchise from goods offered by other companies,** which is the function of a trade mark

# DISTINCTIVENESS

## Cancellation division:

- Batman and its 'bat symbol' is **identified by the public as referring to the character** created by Bill Finger and Bob Kane for DC comics.
- Considering the longevity of the character and its numerous adaptations for books, comics, TV series and films, the Cancellation Division considers that **it is reasonable to believe that all the relevant public will recognise the 'bat symbol' in the EUTM**
- It follows that the contested EUTM will **exclusively be associated by the public with the Batman character from the DC comics universe**, and not to any other comics or superhero story or franchise
- The fact that the 'bat logo' is **well known by the public cannot constitute the basis for a claim of non-distinctiveness**

# DISTINCTIVENESS

- Faced with this issue, offices and courts must adopt a **more nuanced approach** to assessing the distinctiveness of these signs
- Such an approach will not necessarily meet with the **approval of practitioners**
- An additional **obstacle** to the registration of **high-potential trade marks**
- The objective would not be to prevent, *ipso facto*, the registration of titles of works or character names as trademarks, but to **ensure that they are truly distinctive**
- The **mechanism of acquisition of distinctiveness through use**, especially when the owner of the rights in the intellectual work adopts a "brand" strategy with a title or character



# PUBLIC ORDER AND MORALITY

- Concept of « Public order and morality »?
- Public order and morality are traditionally invoked against racist trademarks, trademarks associated with totalitarian political regimes, trademarks evoking terrorist organisations, trademarks suggesting the commission of illegal activities, trademarks linked to prohibited substances, sexist trademarks, trademarks using religious symbols, trademarks referring to insults or particularly vulgar terms, trademarks with a sexual connotation, trademarks referring to historical figures or undermining state institutions.
- Could these concept be used to avoid the registration of a name of a character, title of a work or the work itself?

# PUBLIC ORDER AND MORALITY

Vigeland case, EFTA Court, 06/04/2017, Case E-5/16



Oslo Municipality applied for trademark protection for a number of artworks of one of the most eminent Norwegian sculptors – the works in question were falling in the public domain

The NIPO refused the registration – lack of distinctive character and because these signs would be considered as shapes that add substantial value to the goods

Norwegian Board of Appeal **referred six question to the EFTA** courts in order to determine if an artwork which will become part of the public domain can be registered as a trademark



# PUBLIC ORDER AND MORALITY

- There is not any provision in Directive 2008/95 which prevents a sign from being protected under both trade mark and copyright law
- The finality of these rights are different : thus, an economic operator could register as a trade mark an artwork protected by copyright
- However: the fact that the copyright is limited in time creates **legitimate expectations** in particular to the benefit of the public – General interest (freedom of art)
- How to avoid the registration of such a sign?

# PUBLIC ORDER AND MORALITY

The requirement of distinctiveness **would be useless**

- Article 3(1) points (b) to (d) – does not ensure that a sign is, in general, kept free for use – distinctiveness through use
- Such a registration would be contrary to the accepted principles of morality and public policy?
- It depends of the artwork in question
  - certain pieces of art could have a particular status and be considered as **prominent parts of a nation's cultural heritage**, an emblem of sovereignty or of the nation's foundations and values
  - a trade mark registration can be perceived as a **misappropriation or a desecration** of the artist's work, in particular if it is granted for goods or services that contradict the values of the artist or the message communicated through the artwork in question.
  - in such a case, **the registration of the sign could offend the average consumer and be contrary to accepted principles of morality.**

# PUBLIC ORDER AND MORALITY

Contrary to public policy:

- registration of sign may be refused on this basis only in **exceptional circumstances**.

- this could be the case if the registration as a trade mark of a work of art is regarded as a **genuine and serious threat to certain fundamental values** or where the need to safeguard the public domain, itself, is considered a fundamental interest of society

- decision confirmed by the Board of Appeal

# PUBLIC ORDER AND MORALITY

- Perfectly understandable on an "intellectual level"
- Less satisfactory on a "legal level"
- Prevent any form of "reconstitution" of a monopoly for works of the mind that enjoy a certain notoriety
- The Court follows the recommendations of the European Copyright Society

# PUBLIC ORDER AND MORALITY

Is there any reconstitution of monopoly, an overlap of rights?

⇒ No

- not the same object
- not the same finality
- not the same legal regime

# CONCLUSION

- Not a simple question
- Pragmatic approach
- Distinctiveness *per se* must be taken into account for every goods and services
- The solution of the EFTA Court is dangerous



# THANK YOU

[YANN.BASIRE@CEIPI.EDU](mailto:YANN.BASIRE@CEIPI.EDU)

TWITTER: [@YANNBASIRE](https://twitter.com/YANNBASIRE)



Organised by:

