IP Expresso: Anything Wrong With the Resurrection of Works in the Public Domain Through Trademark Law?

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Anything Wrong with Resurrection?

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Angry Boy by Vigeland
EFTA Court, 6 April 2017 Case E-5/16,

EFTA Court, 6 April 2017 Case E-5/16,

In view of the actual or imminent lapse of intellectual property protection for copyright protected works by some Norwegian artists, Oslo Municipality, which manages several of these rights, applied for trade mark protection for a number of artworks of Gustav Vigeland, one of the most eminent Norwegian sculptors.
that will become freely available under the Norwegian Copyright Act.

Conflict Between Copyright Limited Time Protection and Perpetual Trademark Protection

- Two different rationales:
- Copyright: incentive for creation (see also Patent)
  - Fixed duration : no possible influence of the rightholder on the term
  - Duration linked to the person of the author (Life Term + 70 years PMA) but not in every system (post publishing/ 50 years…)
  - Distinction between copyright and related right
  - Duration is independant of the exploitation (except for Phonogram Producers see Directive 2011/77/EU)

- Trademark: distinguishing products and services
  - Possible perpetuity
  - Subject to renewal (as for Designs in a limited way)
  - Possibility of loosing the monopoly for non-use and/or degeneration
  - Duration is related on the capacity of exploitation of TM

Copyright « Limited Time » Protection

- What happens when the protection lapses for copyright and neighbouring rights ?
- Possible term extension by virtue of law (see Tem Directive from 50 PMA to 70 PMA)
- Rebirth of certain works to protection (International Private Law)
  - ECJ Bod Dylan case
  - US Supreme Court decision Golan v. Holder, No. 10-545
- In certain countries: perpetual moral right (not an exclusive right of exploitation but remaining control)

Conflict Between Copyright Limited Time Protection and Perpetual Trademark Protection

Copyright / Patent/Designs	Trademark
Regime after protection No more possible exclusive right on the same object Free competition/public access Possible exclusive right on derivative works Territory : independance but limited : rule of the shorter term	**Regime after protection** The sign becomes available again for a new exclusivity period on the benefit of another economic operator for the same purpose (or different purpose) Territory : independance

No Unique Regime for Public Domain in IP

EFTA Court Vigeland

> Point 66. The public domain entails **the absence of individual protection for, or exclusive rights to, a work.** Once communicated, creative content belongs, **as a matter of principle,** to the public domain. In other words, the fact that works are part of the public domain is not a consequence of the lapse of copyright protection. **Rather, protection is the exception to the rule that creative content becomes part of the public domain once communicated.**

Conflict Between Copyright Limited Time Protection and Perpetual Trademark Protection

Copyright / Patent/Designs	Trademark
« Public domain » after protection No more possible exclusive right on the same object Free competition/public access Possible exclusive right on derivative works **Public domain « outside » the protection** No possible appropriation whatsoever : ideas	**« Public domain » after protection** The sign becomes available for a new exclusivity period on the benefit of another economic operator for the same purpose **Public domain « outside » the protection** Sign which can be considered as a trademark - In general - In relation to certain products and services - Because it conflicts with public order

Not a Single Definition of the Public Domain in IP

- Works that are no more protected (after legal term) or/and ?

- « Things » that are not subject to protection
  - In general : ideas
  - Or according to the conditions set in the law for each IP right ?

- Avoidance of any exclusivity ?

What is Wrong With Resurection ?

Providing Ever-lasting Protection (Objective reason) or Attributing it to the Wrong Guy ?

- Position of the Commission in the Vigeland case:

« *To appropriate a work of art for an indefinite period through the registration of a trade mark contradicts the very purpose and logic of the time limits established for copyright. It would also grant the trade mark owner more extensive rights than those enjoyed by the author's estate. Hence, once copyright protection of the work has expired, the work of art should be able to be freely used by any person.* »

Providing Ever-lasting Protection (Objective reason) or Attributing it to the Wrong Guy ?

- Opinion of Advocate General Ruiz-Járabo Colomer in *Shield Mark*

"*difficult to accept ... that a creation of the mind which forms part of the universal cultural heritage, should be appropriated indefinitely by a person to be used on the market in order to distinguish the goods he produces or the services he provides* ***with an exclusivity which not even its author's estate enjoys***" (C-283/01, EU:C:2003:197, point 52).

- No possible public access to the work

&

- Benefit of the exclusivity to someone who does not deserve it

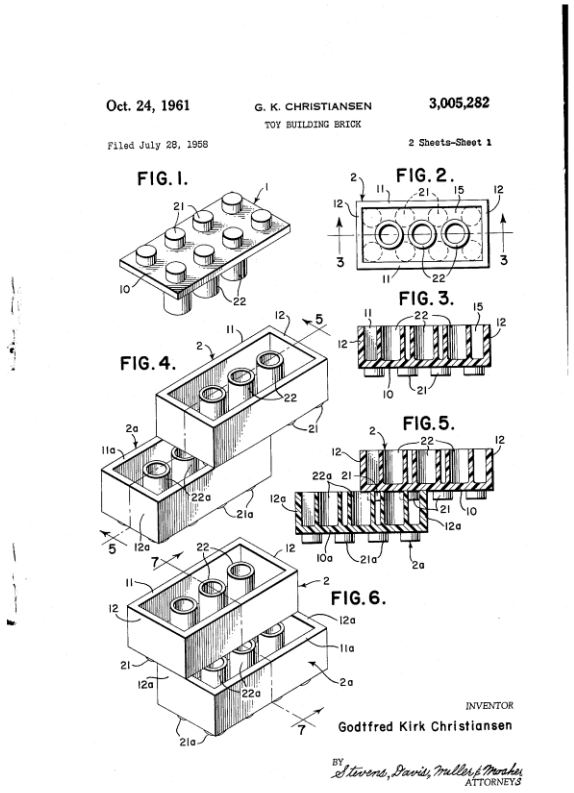
Providing Ever-lasting Protection or Attributing it to the Wrong Guy ?

Three different justifications for excluding « resurrection »:

- Hinders competition: economic public order
- Bans public access to the work: public interest matter : public order /commons
- Blurs the boundaries between different IP titles and brings confusion on the rationales of each protection

- Possible mix

Ground for Refusal of Resurrection: Enhancing Competition



Oct. 24, 1961 G. K. CHRISTIANSEN 3,005,282

TOY BUILDING BRICK

Filed July 28, 1958 2 Sheets-Sheet 1

FIG. 1.

FIG. 2.

FIG. 3.

FIG. 4.

FIG. 5.

FIG. 6.

INVENTOR

Godtfred Kirk Christiansen

BY Stevens, Davis, Miller & Mosher

ATTORNEYS

First Ground for Refusal of Resurrection: Enhancing Competition

CJEU, 14 September 2010, *Lego Juris A/S v OHIM and Mega Brands Inc.*,

C-48/09 P., [2010] ECR I-08403.

> "when the shape of a product merely incorporates the technical solution developed by the manufacturer of that product and patented by it, **protection of that shape as a trade mark once the patent has expired would considerably and permanently reduce the opportunity for other undertakings to use that technical solution**. In the system of intellectual property rights developed in the European Union, technical solutions are capable of protection **only for a limited period**, so that subsequently they **may be freely used by all economic operators."**

First Ground for Refusing Resurrection: Enhancing Competition

Gen. Court, Yoshida Metal Industry Co. Ltd., T-331/10;

- the rationale of the ground for refusal in Article 7(1)(e)(ii) of Regulation No 207/2009 **is to prevent trade-mark protection from granting its proprietor a monopoly over technical solutions or functional characteristics of a product** which a user is likely to seek in the products of competitors.
- Article 7(1)(e) is thus intended **to prevent the protection conferred by the trade-mark right from being extended beyond signs which serve to distinguish a product or service from those offered by competitors, so as to form an obstacle preventing competitors from freely offering for sale goods incorporating such technical solutions or functional characteristics in competition with the proprietor of the trade mark**".
- Also see ECJ, 8 April 2003, Linde, Winward, Rado, C-53 to 55/01, [2003] ECR I-0316, para. 72.

Second Ground for Refusal of Resurrection: Public Access to « Commons » & Freedom of Creation/Expression

High Cultural Value Work but Poor Distinctive Value Sign?

German Federal Patent Court, 25 November 1997, case 24 W (pat) 188/96, Mona Lisa, Gewerblicher Rechtsschutz und Urheberrecht 1998, p. 1022.

- The applicant had failed to establish the requisite distinctiveness. Because the painting was frequently used by third parties in advertising, the public would regard the Mona Lisa as a mere advertising instrument rather than as an indication of source
- Painting had become customary in established trade practices.
- Registration of the Mona Lisa was not contrary to public policy or accepted principles of morality.
- Appropriation of the Mona Lisa on the basis of trade mark law would not violate the principle that cultural expressions should remain freely available for the public after the expiry of copyright protection.

Second Ground for Refusing Resurrection: Public Access to « Commons » & Freedom of Creation/Expression

EFTA Vigeland

Point 65.The lapse of copyright protection also serves the principles of legal certainty and **protection of legitimate expectations**, by providing a pre-determined time frame after which **anyone can draw from ideas and creative content of others without limitation**. The considerations relating to the public domain also serve, **to some extent, the general interest in protecting creations of the mind from commercial greed** (see opinion of Advocate General Ruiz-Járabo Colomer in *Picasso*, C-361/04 P, EU:C:2005:531, point 69) and **in ensuring the freedom of the arts.**

Second Ground for Refusing Resurrection: Public Access to « Commons » & Freedom of Creation/Expression

- How to achieve public access and freedom of creation ?
- « Symbols » that can not be appropriated (notwithstanding the protection) because of their cultural value ?

TRADE MARK	COPYRIGHT
Public interest in accessibility: see flags, olympic symbol… Sign degenerating because of common use Public order	No impediment to copyright protection because of high cultural value of the creation (French Case on the Philippe Découflé Parade in 1989)

Second Ground for Refusing Resurrection: Public Access to « Commons » & Freedom of Creation/Expression

- How to achieve public access and freedom of creation ?
- Protection of « Sharability » ?

TRADE MARK	COPYRIGHT
Principle of speciality: only relative appropriation in relation to a category of product	No principle of speciality: general appropriation
Course of the trade	Any kind of use: commercial/non commercial
Limited exceptions : art. 12 **Dictionaries /Art. 14 1 c)** use of the trade mark necessary to indicate the intended purpose of a product or service, in particular as accessories or spare parts.	Several exceptions: parody, quotation…

Second Ground for Refusing Resurection: Public Access to Commons

EFTA Vigeland.

Point 100

- Registration of a **sign may only be refused** on basis of the public policy exception (Article 3(1)(f) 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.**

Second Ground for Refusing Resurrection : Public Access to Commons

- Hierarchy of **fundamental interests**
  - Cultural heritage
  - Well-known works
  - Works or pieces of works which can have a function of identification of a creation(titles of a work)
  - Works or pieces of works which can have a function of identification of a product or a service (work that can be understood as a Trademark)
  - Works or pieces of works which were created for identification purposes (logos)
  - Adjuncts to a prior work providing a different work and/or sign

Work created for the purpose of a Trade mark

- EFTA Vigeland
  - Point 97. *The Court notes, however, that there would be no threat to the need to safeguard the public domain resulting from* ***works that were primarily created to serve as signs to be registered as trade marks****.* ***The protection afforded to such signs under copyright law is merely incidental****. In such circumstances, the purpose behind the sign's creation is to indicate commercial origin only.* ***The same may be true in cases where the rights to a work were sold for the mere purpose of serving as a trademark****. In these instances, it would, in turn, be irreconcilable with the purpose of the Trade Mark Directive if a sign solely created or purchased in order to qualify for the protection afforded by the Trade Mark Directive were to be denied precisely that protection.*

Addition

- EFTA Vigeland
  - *Point 98. The same is true in the case of signs which, albeit based on a work pertaining to the public domain,* ***contain additional elements that are likely to transform or diffuse the original work*** *(compare the judgment in Couture Tech v OHIM, cited above, paragraph 65). For these additional elements to be relevant, the sign must depart significantly from the original creative content such as to avoid confusion between the sign and the work in the eyes of an averagely informed, reasonably aware and perceptive consumer.*

Second Ground for Refusing Resurection : Public Access to Commons

- Hierarchy within the Public Domain ?
- Such hierarchy is meaningless as regards copyright protection principles
  - No other condition than originality is required
  - Copyright is not limited to the domain of arts (software, database…)
  - A work can be the shape of a product (three dimensional)
  - The cultural value of the work is not to be taken into account

Third Ground for Refusing « Resurection »: Avoiding Confusion and Overlap

- Copyright & Trademark don’t share the same objectives:
- Cultural and/or commercial value of the work itself « per se »
- Commercial value of the work as a sign for designating something else: « in relation to »

- **Trademark protection function is diverted if used to protect the cultural and or commercial value of the work itself**

Third Ground for Refusing « Resurection »: Avoiding Confusion and Overlap

- Solutions to be found within Trademark law ?
- EFTA Vigeland

Point 99. Furthermore, 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 Trade Mark Directive.

men realiseert zich dan echter niet, in hoeverre
grote omvang de problemen op ons toe kunnen
stormen, de problemen ~~da~~ waarvan we mis-
schien nog veel te jong zijn, maar die zich
toch zolang ~~as~~ aan ons opdringen totdat we
na heel lange tijd een oplossing gevonden
menen te hebben, een oplossing meestal
die niet bestand blijkt, tegen de wapens die
hem weer te niet doen. Dat is het moeilijke
in deze tijd; idealen, dromen, mooie ver-
wachtingen komen nog niet op of ze worden
door de gruwelijkste werkelijkheid getroffen en
zo totaal verwoest. [Het is een groot wonder
dat ik niet al mijn verwachtingen op heb
gegeven, want ze lijken absurd en onuitvoer-
baar. Toch houd ik ze vast, ondanks alles
omdat ik nog steeds aan de innerlijke goed-
heid van de mensen geloof.
Het is me ten ene male onmogelijk alles
op te bouwen op de basis van dood, ellende en
verwarring, ik zie hoe de wereld op haar ~~zo~~ lang-
zaam steeds meer in een woestijn herschapen
wordt, ik hoor de aanrollende donder steeds
harder die ook ons zal doden, ik voel het

Het Joodse volk spreekt tot de volkeren van de wereld: Het treffe U niet, wat mij heeft getroffen, het gebeure u niet, wat mij is gebeurd.

Uit de „Midrasch".

Third Ground for Refusing « Resurection » : Avoiding Confusion and Overlap

- Anne Frank Diary Saga
- **DECISION of the Fourth Board of Appeal of 31 August 2015** Case R 2401/2014-4
- The examiner has failed to explain why a requirement for availability exists. In actual fact, and since the present case involves the protection of a trade mark, there is no need to justify whether a third party could legitimately profit financially from the work of Anne Frank, her life story and her tragic fate, while the holder is making commercial use of this title. **In any case, the requirement for availability does not exist in Community trade mark law. Consequently, there is no need to examine whether the registration as a trade mark would be incompatible with copyright protection.** In actual fact, a copyright attached to a literary work (identified by its title) is not affected by the registration of a Community trade mark (see Article 53(2)(c) CTMR) or an international registration designating the European Union.

Third Ground for Refusing « Resurection » : Avoiding Confusion and Overlap

- Anne Frank Diary Saga
- **IPO decision 4 day of July 2013:**
- **Point** 39. In the case of 'The Diary of Anne Frank', the evidence clearly shows that the mark has been used by a number of different publishers to indicate the title of the work. **This is not use in a trade mark sense, but instead use which indicates to a potential reader the subject matter of the book.** The title is not being used to distinguish the goods of one publisher from those of another. As a result, I **consider the evidence has failed to show that, at the date of application, the average consumer had been educated into seeing the sign as indicating the trade origin of the good and services. The mark is therefore excluded from acceptance because it fail to qualify under section 3(1)(b) and (c) of the Act.**

Third Ground for Refusing « Resurection » : Avoiding Confusion and Overlap

- Can solutions avoiding re-appropriation really be found within Trademark law ?
  - Absence of distinctiveness:
    - but possible acquisition of through use: no non-appropriation principle
  - « Substance » of the object:
    - not applicable if the work is used to designate a product or service, which is different from the genuine market
    - No free reproduction of the work in too many circumstances

Acquisition of distinctiveness

- EFTA Vigeland

Point 75: The possibility of acquiring distinctiveness through use provided for in Article 3(3) of the Trade Mark Directive may lead undertakings, which seek to transfer the appeal of formerly copyright protected works to their goods or services, to try to appropriate the work through targeted marketing campaigns. In order to acquire distinctiveness, a strong link must be created between the work and the goods and services so that an averagely informed, reasonably aware and perceptive consumer would recognise the work not as an expression of the creativity of the author or as part of the public domain common to all mankind, but merely as an indication of commercial origin (compare the opinion of Advocate General Ruiz-Járabo Colomer in *Picasso*, cited above, point 69).

Point 78: Consequently, points (b) to (d) of Article 3(1) of the Trade Mark Directive do not ensure that a particular sign is, in general, kept free for use. Thus, these provisions do not guarantee that the work remains within the public domain.

Substantial Value

- CJEU, 18 September 2014, *Hauck GmbH v Stokke AS*, C-205/13, paras 31 and 32

> One of the aims of Article 3(1)(e)(iii) is to prevent the exclusive and permanent right conferred by a trade mark from serving indefinitely to extend the life of rights which the EU legislature has sought to restrict to limited periods and that the concept of “shape which gives substantial value to the goods” in this connection includes shapes which perform an “aesthetic function” or, in other words, shapes which have an “artistic” or “ornamental” value (while not being necessarily limited to such shapes).

Substantial Value

- EFTA Vigeland

> Point 79: *Moreover, the public interest underlying Article 3(1)(e) is to prevent the exclusive and permanent right which a trade mark confers from serving to extend the life of other rights which the legislature has sought to make subject to limited periods* (compare the judgment in *Bang & Olufsen* v *OHIM (representation of a speaker)*, T-508/08, EU:T:2011:575, paragraph 65).

Possible Protection of « Copyright Public Domain » by Trademark Law ?

- EFTA Vigeland

Point 72. The interest in safeguarding the public domain, however, speaks in favour of the absence of individual protection for, or exclusive rights to, the artwork on which the mark is based.

➢Misappropriation

➢« Desacration »

Point 92. Therefore, the possibility cannot be ruled out that trade mark registration of an artwork may be perceived by the average consumer in the EEA State in question as offensive and therefore as contrary to accepted principles of morality.

Need to Define A Common Public Domain in IP ?

- Which purposes for the Common Public Domain ?
  - Public access ? Course of the Trade Scope
  - Competition ?
- Which elements should be under the regime ?
- How ?
  - Exclusion of any protection ?
  - Exclusion of exclusivity ?
  - Unwaivable right to access ?
  - Unwaivable right to reproduce ?
  - Exceptions ? (Analogy for parody?)