

# WHEN FICTION BECOMES REALITY

Webinar Cineforum

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Simon RIAUX, Cinema expert  
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9 July 2024

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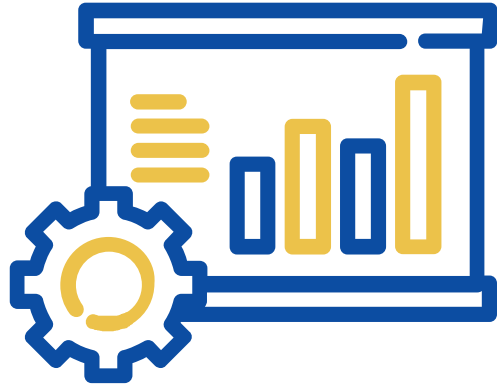
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## PROGRAMME

80'  
**Presentation**

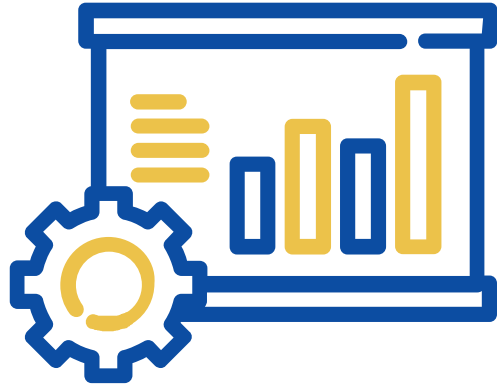
Introduction  
Cancellation proceedings  
Absolute grounds  
Relative grounds  
Trade mark infringement  
Copyright infringement  
Conclusion

10'  
**Questions and answers**



**Which of the following fictional vehicle was brought to reality?**

- 1. Knight Bus, from *Harry Potter***
- 2. Hoverboard, from *Back to the Future***
- 3. Flying Carpet**



Which of the following signs is a real trade mark?

1.

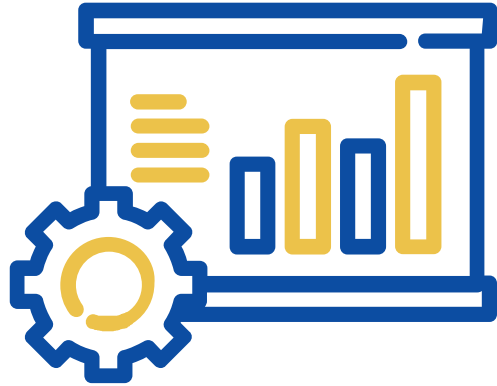


2.



3.





**Which of the following signs got registered as trade marks?**

- 1. Duff Beer**
- 2. Central Perk**
- 3. Bubba Gump Shrimp Co**
- 4. None**
- 5. All**

« I'd buy that for a  
dollar ! » (why you should advert for fictional brands)



## Product placement, a godsend or a break in the suspension of disbelief?

- **Product placement as an opportunity**

Marketing, publicity and budget enhancer

- **Suspension of disbelief**

How a bottle of Pepsi prevented Brad Pitt from saving the World

- **Red Apple Tobacco**

A fiction that gives more than cancer



## Fake me hard

- ***It's fake because it's true.***

How we notice placement products and why it eats fiction before our brains.

- **The truth is out there, even if you can't buy it (for now).**

The ugly truth about that entity that lives throughout many worlds and dimensions, but is neither God or Cthulhu. Don't panic.

- **How fictional brands accomplished what advertisement, publicity and marketing only dream to achieve?**

And why I didn't even bothered to illustrate that presentation.

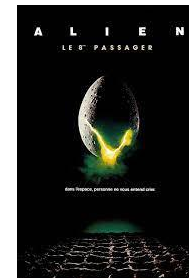
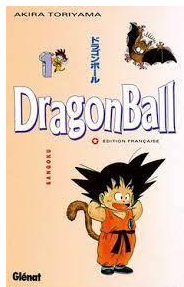


## Introduction

# Fictional Trade mark – Proto Brands

« *the term “proto-brand” to refer to “virtual brands in computer-synthesized or fictional worlds” that have yet to be actualized in the real world* »

(L. Pearson, The Real life of fictional trademarks, TM Reporter, 2020, Vol. 110, n° 5)



**Les  
SIMPSON**

## Introduction

- **Numerous examples** (See e.g. Wikipedia: list of fictitious trade marks)
- Sometimes **unmissable**/sometimes **completely forgettable**



Episode 16, season 4: *Duffless*



166/213 episodes



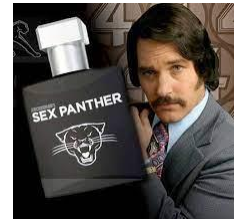
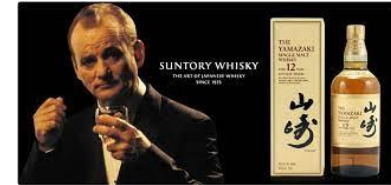
Robocop

## Introduction

Distinction to be made with the « real » trade mark

Narrow line between fiction and reality - Fiction becomes reality

Fictional trade mark breaks the 4th wall



## Introduction

- **Reverse product placement:** by the **right holder** or with his **authorisation**
- **Registered trade mark - licence agreements**



*the future of yesterday, today.*



## Introduction

- **Reverse product placement** without any authorisation of the owner





## Introduction



# What are the possible legal solutions?

- Challenging the validity
- Challenging the use



## Cancellation proceedings

- **Application/registration prior to the use**

- **Recognition of an exclusive right**

Ex: Pizza planet (Toy story) – Diessl Andreas – EUIPO – 009270992

Los Pollos Hermanos (Breaking Bad) – Jérémie Laheurte – INPI - 4200245



(Dragon ball) – Mathieu Dubosq – INPI - 4549131

- **Two options of contesting the validity of the trade mark**

Absolute grounds

Relative grounds

## Distinctiveness

### Distinctiveness per se / Descriptive or generic signs

The sign must **NOT** be descriptive or generic

**Generic or descriptive fictional trade mark /real trade mark which is identical regarding the G/S**



## Distinctiveness

### Distinctiveness per se

Application/registration of a **work's title** or of a **character's name**



**See Batman case** (no 31 962 C - 21/05/2020)

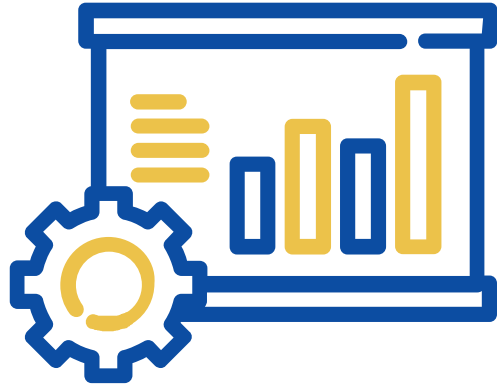
Batman and its 'bat symbol' is identified by the public as referring to the character created by Bill Finger and Bob Kane for DC comics

**Same reasoning** as for **intellectual works** and **name of characters** for the **fictional trade mark**

## Distinctiveness

- **Symbolic significance** of the fictional trade mark?





Which of the following principle does not apply to fictitious trade mark?

1. Public policy and principles of morality
2. Trade mark application made in bad faith
3. Deceptiveness
4. **Calumny!** The **same rules** apply to both real and fictitious trade marks

## Public Policy and Morality



**Art. 7 §1, f), EUTMR et 4 § 1, f) Directive 2015/2436**

Shall be liable to be declared invalid trade mark which are contrary to public policy or to accepted principles of morality

**No legal definition of the concepts**

**Racist or sexist signs, signs referring to drugs...**

## Public Policy and Morality

### Broader application of the concepts

#Jesuis Charlie



**Vigeland case** (EFTA Court, 6 April 2017, Case E-5/16)  
“Certain pieces of art could have a particular status”  
(Vigeland)

- A trade mark registration can be perceived as a **misappropriation or a desecration** of the artist's work
- Questionable reasoning
- Application to the fictional trade mark?

## Deceptiveness

**Deceptiveness:** Shall be liable to be declared invalid marks which are of such a nature as to deceive the public, for instance, as to the nature, quality or geographical origin of the goods or service (Art. 7 (1) g) EUTMR )



### Traditional approach

- Nature of the good
- Quality of the good
- Origin of the good
- Quality control



## Deceptiveness

### Application to fictional trade marks?



#### Bébé Lilly case

(Cass. com., 11 Jan 2017, n°15-15.750)

Trade mark is deceptive if there is a link between the trade mark and a work protected by copyright



## Bad Faith

A **subjective motivation** on the part of the **trade mark applicant**, namely a **dishonest intention or other sinister motive**

The **intention** of the applicant for registration at the relevant time is a subjective factor which must be **determined by reference to the objective circumstances of the particular case**

Conduct which **departs from accepted principles of ethical behaviour or honest commercial and business practices**

**All the relevant factors specific to the particular case** which obtained at the time of filing the application for registration should be taken into account

## Bad Faith

### General interest



The application for registration of a trade mark is liable to be regarded as having been filed in bad faith notwithstanding the fact that, at the time of that application, there was no use by a third party on the internal market of an identical or similar sign for identical or similar goods  
(CJUE, 12 sept. 2019, C-104/18 P, §52)

## Bad Faith

Desire to exploit the renown in order to benefit from it

See Neymar and Simca case

Objective circumstances: reputation of the fictional  
trade mark – speciality?



## Relative Grounds

- **Fictional trade mark as earlier trade mark?**
- **Fictional trade mark as well-known trade mark**



## Relative Grounds

- Earlier copyright
- Rightholder
- Fictional trade mark protected by copyright?
- Original?



**See Brompton case:** The subject matter reflects the personality of its author, as an expression of his free and creative choices (CJUE, 11 June 2020, aff. C-833/18 )

## Relative Grounds

- One word can be protected by copyright
- Questionable solution

E.g: Tarzan, Chéri-Bibi, Le Chardon, Altaïr, Hara Kiri

### USA - Copyright office (1958 circular):

To be entitled to copyright protection, a work must contain something capable of being copyrighted - that is, an appreciable amount of original text or pictorial material. . . .

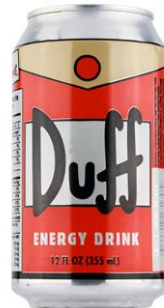
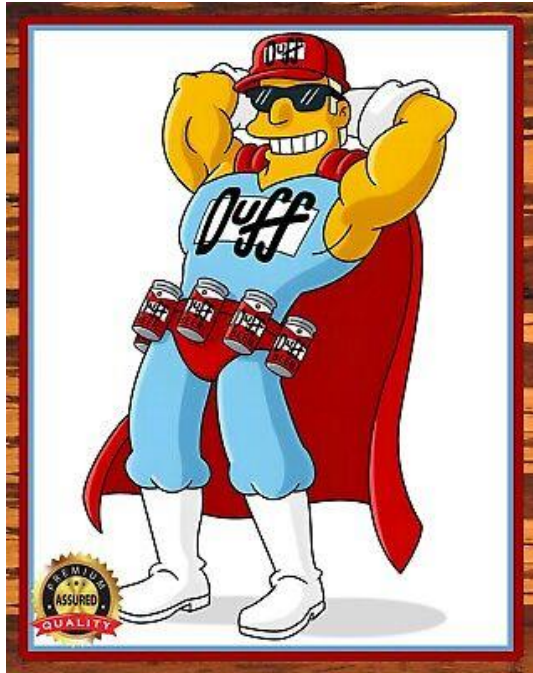
Brand names, trade names, slogans, and other short phrases or expressions cannot be copyrighted, even if they are distinctively arranged or printed



**HARA  
KIRI**  
journal bête  
et méchant



## Relative Grounds





## Infringement?

- Difficult to challenge the registration
- What about use?
- Infringement on fictional trade mark
- Trade mark infringement?
- Copyright infringement?

## Trade mark infringement

### Requirements for the implementation of trade mark right

- Use without the authorisation of the owner
- Use for the same or similar G/S
- The expression 'using' involves active behaviour and direct or indirect control of the act constituting the use
- Use in the course of trade
- Use as a trade mark
- Infringement on one of the trade mark functions

## Trade mark Infringement

No infringement when there is a real use of fictional trade mark

No exclusive right (no registration)

Well-known trade mark?



## Trade mark infringement

### Daily Planet case:

- Daily Planet had played a key role in both the Superman story and the development of the Superman
- DC Comics had invested significant effort and expense to offer “a myriad of products born of the Superman story”
- Many of these products featured the Daily Planet
- DC Comics had “demonstrated an association of such duration and consistency with” the Daily Planet “to establish a common law trademark therein.”
- “any use thereof by defendants would create a substantial likelihood of confusion at the consumer level.”



## Trade mark infringement

### The Krusty Krab case:

- key element of SpongeBob SquarePants since 1999;
- The appearance of THE KRUSTY KRAB restaurant in 166 of 203 aired television episodes and two feature films
- the hundreds of millions of dollars in gross receipts and advertising expenditures for the films;
- the approximately one billion page views for nick.com, the official site for the series;
- and print and Internet advertisements for THE KRUSTY KRAB licensed consumer merchandise



Ingredients of fictional universes warrant trademark protection when the public recognizes them as symbols of a specific entertainment property.

## Copyright infringement

### Originality of the work

#### Difficult – not impossible

- Infringement on **patrimonial rights**
- Infringement on **moral rights**

## *Voulez-vous brander avec moi ?*

- Advertisement became a universal language, a very specific grammar. You know it. I know it. But cinema knows it better.
- Fictional brands, or the gruesome and revolutionary art of how to go too far.
- Because I'm French, that's when I quote Baudrillard and pretend to have a conclusion.

## Imitation/Parody

Imitation of a trade mark as fictional trade mark

Lack of use as TM

No infringement on the essential function

Analogy with case law related to toys





## Copyright infringement

### Parody exception

#### C-201/13 – Johan Deckmyn



- Evoke an **existing work**, while being noticeably different from it
- Constitute an **expression of humour or mockery**
- **Noticeable differences with respect to the original parodied work**; that it could reasonably be attributed to a person other than the author of the original work itself
- It should relate to the **original work itself** or mention the source of the parodied work



## Conclusion

Transversal Issue

Securing fictional trade marks

External solutions to intellectual property?



**THANK YOU!**



## Questions and answers

**If a fictional brand appears in a film/book/game, is it automatically protected by copyright? Can it be used without the permission of the creators?**

## Questions and answers

**What do you think should be improved in the relationship between the cinematic world and trade marks?**

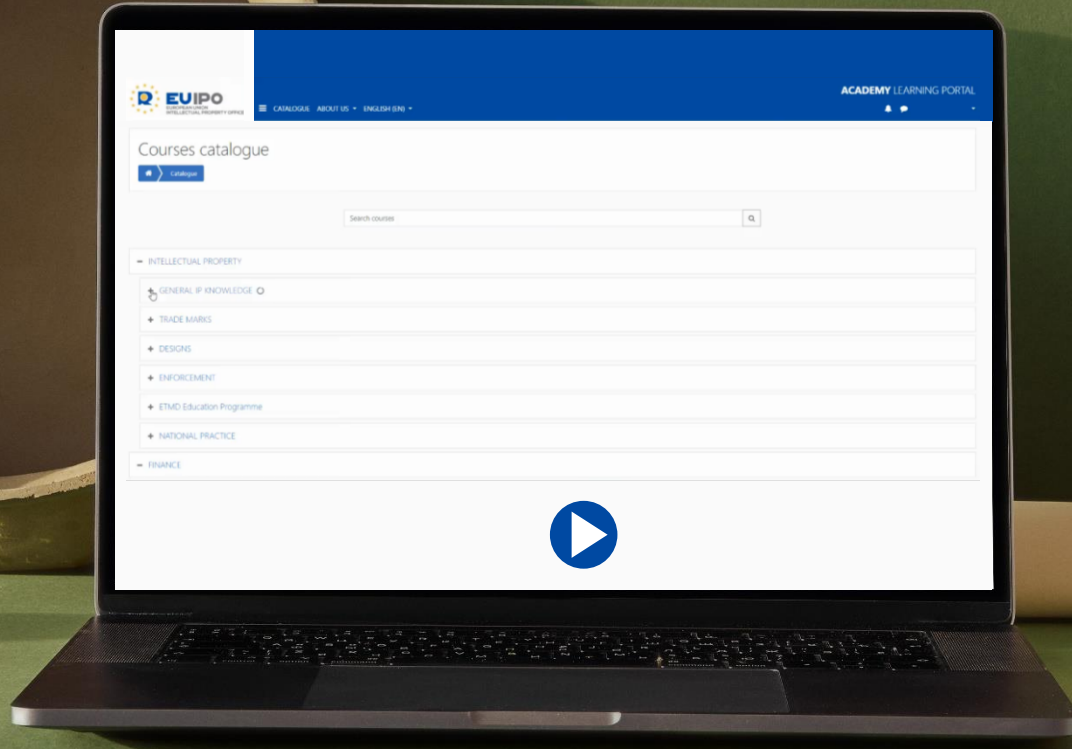
**What are the weak/strong points?**

**What are contractual improvements to make?**





## Keep in touch with the EUIPO Academy





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**EUIPO**

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**THANK YOU**

## Credits – Movie extracts authorisation

*Forrest Gump*, by Robert Zemeckis, Paramount Pictures, 1994