



Nicoleta Anghelescu

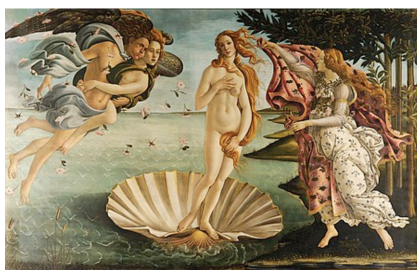
How to strategize in copyrights vs. trademarks conflicts

Nicoleta Anghelescu from Cabinet Enpora outlines the specific task list copyright vs. trademarks conflicts should comply to, required by the specific legislation governing this IP right.

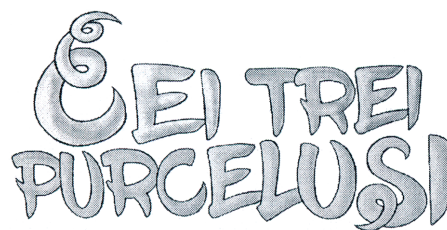
Two years ago, when a wellness and fun resort was opened in my hometown of Bucharest, Romania, the whole city was strewn with street advertisements promoting the new urban oasis. The central protagonist of the commercials was the following image:



Romanian trademark registration

*Birth of Venus*, Sandro Botticelli

An art lover friend of mine was quite intrigued that the main character of the painting *The Birth of Venus* by the famous Renaissance painter Sandro Botticelli could be used for the commercial benefit of a company, other than maybe the Uffizi Gallery in Florence, where the painting is displayed. It was even more surprising for my friend when, after a search in the trademark database of the Romanian State Office for Invention and Trademarks, we found out the image (left) was registered as a trademark under no. 120538 protecting services in classes 41, 43, 44 and 45 of the Nice Classification. I had to explain to him that the protection of copyright is limited in time – in Romania the period is the life of the author and 70 years after its death – and how after this period the work enters the public domain and could, therefore, be used for all purposes, in this case to be registered as part of a trademark. Since the copyrights on Botticelli's painting expired a long time ago, the whole situation complies with the copyright legislation. My friend's conclusion was that even if this use is legal it is still unfair that a work of art is exploited in such a manner.



I personally had the same feeling when I recently came across the trademark registration above (no. 153159). The mark is the Romanian translation of the title of the famous fairy tale "Three little pigs" by the Russian writer Serghei Mihalkov. The trademark owner is producing games and playthings, thus the choice of mark was a well targeted one. Since the author died only in 2009, his works are still protected by copyright thus this trademark owner could be confronted with the invalidation of its trademark.

So, there is nothing to be done for works of art that entered the public domain because of the expiration of the copyrights. However, this is definitely not the case

Résumé

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Nicoleta is the coordinator of the litigation department with a background of more than 10 years of experience in IP prosecution, litigation and portfolio management. As part of Enpora's IP team, Nicoleta advises clients from various activity fields. Her area of expertise is focused on filing invalidation and revocation actions before the Bucharest Court of Law but also includes filing oppositions and appeals before the Romanian Patent and Trademark Office and EUIPO. Working directly with the clients in a manner that meets the expectations of small Romanian businesses, as well as of the biggest names in the pharmaceutical, retail or music industry that she has assisted over the time, has proved to be a considerable strength point. Throughout the last five years Nicoleta took over the development and improvement of the business, both for Romania and the external market.

for copyrights that are still in force and that may be opposed against any acts of unauthorized use, the registration of trademarks included.

According to the Romanian TM legislation, copyright is expressly mentioned as a relative ground of refusal that may be invoked in opposition proceedings as well as in invalidation proceedings. For EUTMs it was established that copyright is not one of the earlier rights referred to in Article 8(4) EUTMR and thus protection provided for by copyright cannot be relied on in opposition proceedings, but only in proceedings for a declaration of invalidity of the EUTM in question [T-435/05 Dr. No, par. 41].

Irrespective of the proceeding to be initiated, copyright vs. trademarks conflicts should comply to a specific task list required by the specific legislation governing this IP right.

Determining the applicable legislation

Acting against a national trademark application or registration based on prior copyrights should be straightforward from the point of view of the applicable legislation. Proceedings brought under the provisions of the Romanian TM Law and based on prior copyrights request the application of the Romanian copyright legislation. In a case of invalidation of a Romanian trademark based on copyrights where the author was a Hungarian national the defendant invoked that the applicable law should be the law of the country where the author is a national. The Romanian Courts have analyzed the case based on the provisions of the Romanian copyright law.

When invalidating an EUTM based on prior copyrights, the cancellation applicant has the choice of one of the 28 copyright legislations of the EU member states. To that end EUIPO must obtain, on its own motion and by whatever means considered appropriate, information about the national law of the Member State concerned [C-0530/12 Shape of a hand, par.45].

Proving ownership of the invoked copyright

More frequent than one might think in trademark oppositions or invalidation cases based on copyright is the issue of proving the applicant is the owner of the opposed work of art has proven to be an obstacle that could cause one winning the case. The author is presumed to be the person under whose name the work was brought to the attention of the public for the first time. Any means of proving the quality of author are accepted. Usually, the works are registered with a collective society. Affidavits or witness testimonials may also be used. According to the Romanian copyright legislation, the works created in the course of employment – unless otherwise mentioned in the employment agreement – belong to the employee.

If the work was subject to assignment or license a particular attention must be given to the written form of the respective agreements which is required in several legislations. The Romanian copyright legislation requests the written form as the only way of proving the assignment of copyright. In a case of national trademark invalidation based on copyright recently solved by the Bucharest Court of Appeal the company claiming ownership on the invoked copyright on a design failed to

obtain invalidation of the subsequent trademark although the company was also the owner of a trademark that included the infringed design, registered and used for more than 10 years in another country. It turns out that the design was created by a graphic designer at the request of the company however the company failed to sign a written assignment agreement with the author. Failing to comply with the imperative request of the written form of the assignment agreement the company was unable to prove its ownership of the invoked copyright.

Originality of the work

Any work that presents originality, regardless of its value or destination, enjoys protection by copyright. Originality refers to the creative effort and personal touch of the author and must distinguish the work from what was already created and also from usual and banal. Thus when considering trademark invalidation based on copyright the applicant must have the means to sustain the originality of the invoked work. Maybe when it comes to graphic or auditive works proving originality is not such a difficult task. There is plenty of case law that ensures to some extent that even the most simplistic graphical expressions are protected by copyright. When it comes to words, it may be way more difficult to prove originality. The cases are not very frequent, however, book titles or more often advertisement slogans could come in conflict with trademarks and copyright is invoked as legal basis for invalidation. From the settled case law of the Romanian Courts, the one analyzing the commercial slogan “Sanatatea mai presus de orice/ Health above all” shapes some guidelines on how originality is assessed when it comes to expressions and phrases. The Court established that it is the very nature of slogans to include striking sentences to create a link between the product, its qualities and the producer. In this cases originality comes rather from the word combination than from an intellectual creation. However to the extent that such syntagms/phrases/words are not in themselves original, nor does the combination of them contain elements of originality, the result of creation is not an original work within the meaning of the copyright provisions.

Preferring copyrights as basis for an invalidation

With those elements checked, are copyrights preferable as a basis for a trademark invalidation or just a choice of last resort where there is no other IP right at hand? This seems to be the case as I have observed in the matters that came to my notice. However choosing copyright as basis for the invalidation proceedings comes with following advantages:

- To the extent that the prior work is reproduced partially or completely by the subsequent trademark resemblance may be found regardless of the existence of likelihood of confusion. This is helpful when you deal with complex marks for instance where there is infringement of the design however the word part is different.
- You are not restrained by a category of goods or services
- You do not have to deal with the question of use
- Author’s moral rights may be helpful in assessing the infringement

On the other side, invoking copyrights in trademark invalidation proceedings may not ensure a favorable result to the extent that in some cases copyright protected works may be used without the authorization of their authors. Most frequent cases of fair use refer to the freedom of expression and the right to use a work for parody. However, these cases are very much influenced by the purpose of registration of those marks. Usually, fair use is found when marks are not meant to obtain direct commercial advantages but are registered primary for the purpose of gaining awareness or support general interest causes. Thus, particular circumstances of each case have much to say, as always, to reach the expected result.

