

FICTIONAL TRADE MARKS: WHEN INTELLECTUAL PROPERTY BECOMES REALITY


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Definition of fictional trade marks. *Capsul Corp, Acme, Big Kahuna Burger, Morley, Duff Beer, Daily Planet, Stark industries, Wayne enterprises or Tonyglandil*, etc. These are just a few examples of encountered trade marks in pop culture: *Dragon Ball (Z, GT and Super), The Looney Tunes, Pulp Fiction, The Walking Dead, The Simpsons, Superman, Iron Man, Batman and The Dummies*. More specifically, these are *fictional trade marks* or *proto brands*¹. They are defined as "virtual" distinctive signs identifying products or services, but existing in fictional universes². The examples could thus be multiplied endlessly. However, distinctions must be made. On the contrary, the fictional trade marks that the the public is confronted with do not all have the same value. Some are intended to be unavoidable and can play a key role in the course of the work in which they are included. This is the case, for instance, of Homer Simpson's favourite brand of beer - *Duff Beer* - or the *Weyland-Yutani* mark used in the *Alien* saga. On the other hand, other fictional brands are perfectly forgettable, their sole ambition being to enrich the setting. Who remembers the brands *Slusho!*³*Re-pet*⁴ or *Dapper Dan*⁵? On the other hand, and whatever the hypothesis, fictional trade marks must necessarily be distinguished from "real" trade marks⁶, registered with a competent authority in order to identify products and services.

Process of defictionalisation. The border between fiction and reality is sometimes very thin or even non-existent. So, it is when the fictional trade mark breaks the *fourth wall* and becomes a genuine trade mark itself.

For example,

- *True Blood* ()⁷, a sign straight from the eponymous TV show⁸, to designate energy drinks,

¹ L. Pearson, "The real life of fictional trade marks", *The Trade mark reporter* 2020, Vol. 110, No. 5, p. 839.

² *Ibid.* See also, B. M. Arrow, "Real-Life Protection for fictional trade marks", 21 *Fordham Intell. Prop. Media & Ent. L.J.* 111 (2011); I. G. McFarland and J. T. Winemiller, "Fictional brands, famous marks: recurring characters, places, and elements can serve as source identifiers for creative works", *Landslide* 2019, Vol. 11, No. 4.

³ V. M. Reeves, *Cloverfield*, 2008.

⁴ V. R. Spottiswoode, *At the Dawn of the Sixth Day*, 2000.


⁵ J. and E. Coen, *O'Brother*, 2000.

⁶ This is so even though some of these "real" brands are understood as fictional. One example is the *Suntory Hibiki* brand in *Lost in Translation*. V. L. Pearson, "The real life of fictional trade marks", *supra*, p. 841.

⁷ Trade mark No. 1157957 registered in Mexico by HBO, Inc.

⁸ B. Buckner, A. Ball, M. Hudis, *True Blood*, 2008-2014.



- *Bubba Gump Shrimp* ()⁹, used to refer to a chain of restaurants directly inspired by the *Forrest Gump* movie¹⁰,
- *Anchorman's Sex Panther*¹¹ for perfumes and used in the movie *Anchorman* (*Anchorman: The Legend of Ron Burgundy*)¹² or,
- *Stay Puft*¹³ for marshmallows, which originated in the movie *Ghostbusters*¹⁴.

Once filed and registered with the competent authorities, fictional trade marks are thus the subject of what can be described as defictionalisation or *reverse product placement*¹⁵. In this respect, it is interesting to note that some companies have specialised in this field. As an example, we should mention the company Omni Consumer Products (OCP), whose name is a direct reference to the military-industrial and commercial conglomerate at the centre of the film *Robocop*¹⁶. The process of defictionalisation thus takes place, in theory, with the help of the owners of the rights over the intellectual work. Consequently, this process should be understood simply through the prism of the contractual exploitation of fictional trade marks. However, there are many situations where fictional trade marks become "real" even though the owner of the rights in the intellectual work is not involved. *Duff* became a beer brand without the permission of the creators and producers of *The Simpsons*¹⁷. The sign *Daily Planet*, the Metropolis newspaper where Clark Kent - aka *Superman* - and Lois Lane work, was indeed used to designate a newspaper¹⁸. The sign *The Krusty Krab*, a sign well known to *SpongeBob SquarePants* fans, has also been used in reality and without authorisation to designate a restaurant¹⁹. The penetration of these fictional trade marks into the "real" world, without authorisation, raises questions about the levers of action available to right holders.

The process of "fictionalisation". The boundary between fiction and reality becomes even more blurred when the fictional trade mark chosen to integrate a work of fiction is likely to conflict with a previous "real" trade mark. Indeed, many trade marks imitate, in a more or less crude and parodic manner, "real" distinctive signs that are likely to be protected under trade mark law or even copyright law. For instance, the misappropriation of the *Tonigencyl*, a french trade mark²⁰, which in a sketch by Les Nuls became the *Toniglandyl* trade mark.

⁹ Trade mark no. 737620 registered in the Benelux by Paramount Pictures Corporation.

¹⁰ R. Zemeckis, *Forrest Gump*, 1994.

¹¹ Trade mark No. 007293715 registered as a European Union trade mark.

¹² A. McKay, *Anchorman - The Legend of Ron Burgundy*, 2005.

¹³ Trade mark No. 6429340 registered in the United States by Columbia Pictures Industries, Inc.

¹⁴ I. Reitman, *Ghostbusters*, 1984.

¹⁵ V. L. Pearson, "The real life of fictional trade marks", op. cit. p. 843.

¹⁶ P. Verhoeven, *Robocop*, 1987.

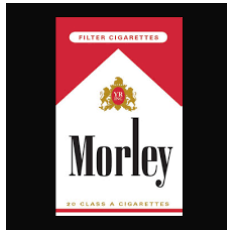
¹⁷ "The Simpsons: a Duff beer, a cult drink from the series, withdrawn from sale in Colombia", *The Huffington Post*, 21 Aug. 2012, online; D. Durand, "Une bière 'Duff', issue de la série The Simpsons, bientôt sur le marché", *Le Figaro*, 13 Jul. 2015, online.

¹⁸ *DC Comics, Inc. v. Powers*, 465 F. Supp. 843, 850 (S.D.N.Y. 1978).

¹⁹ *Viacom Int'l Inc. v. IJR Capital Invs. , LLC*, 242 F. Supp. 3d 563 (S.D. Tex. 2017), *aff'd* 891 F.3d 178 (5th Cir. 2018).

²⁰ French trade mark no. 1234804.

The *Morley* brand - used in many, many works of fiction ²¹



and most recently in the series *The Walking Dead* - uses the figurative elements of the *Marlboro* brand²² .



Finally, in *Tintin, Paramoule*²³, a film production company, and *Paris Flash*²⁴, a magazine whose star journalists are Walter Rizotto and Jean-Loup de la Batellerie, refer respectively to the *Paramount* company²⁵ and the weekly magazine *Paris Match*²⁶. These uses, again without the authorisation of the holders of the prior rights, raise questions regarding the rules of intellectual property law.

The issue of fictional trade marks is cross-cutting, involving not only the owners of the rights to the intellectual works in which they are used confronted to the defictionalisation process, but also the owners of prior rights, who may be concerned by the use of these trade marks. While greater vigilance on their part is required, they must also be able to take advantage of legal means to have these unauthorised "uses" sanctioned. Two types of response can naturally be considered: firstly, sanctioning the existence of a trade mark right relating to a sign identical or similar to a prior fictional trade mark (**I**); secondly, sanctioning uses likely to infringe a fictional trade mark or resulting from the use of a fictional trade mark (**II**).

²¹ D. Montay, 'When a brand of cigarettes is everywhere', *Daily Mars*, 24 Oct 2013, online. Morley cigarettes are the ones smoked by the famous cigarette man in the *X-Files* series. They were first featured in 1961 in the series *The Dick Van Dyke Show*.

²² See in particular Trade mark No. 972741 registered with the Office of Bosnia and Herzegovina.

²³ Hergé, *Tintin in America*, 1931.

²⁴ Hergé, *The Castafiore Jewels*, 1962.

²⁵ EU Mark No. 016802324.

²⁶ EU Mark No. 002105120.

I. Cancellation of contested registrations

The trade mark, whose the use is likely to infringe a fictional trade mark, may have been registered beforehand and as a reminder registration crystallises the rights of the applicant by granting an exclusive right. The first objective of the owner of the rights in a work of the mind should be to try to obtain the invalidity of the contested trade mark. It would thus be possible to invoke absolute grounds for invalidity (**A**), but also relative grounds for invalidity (**B**), being specified that in either case, the success of the invalidity action may be particularly uncertain.

A. Absolute grounds for invalidity

Referred to in Articles 4 of the Directive 2015/2436 (Trade mark Directive)²⁷ 7 of the European Union Trade Mark Regulation (EUTMR)²⁸, absolute grounds for invalidity are characterised by the fact that they can be invoked, as a main claim, by any third party, without it being necessary to demonstrate any interest in taking legal action²⁹. The procedure is, moreover, and apart from some exceptions³⁰, an administrative procedure³¹, with invalidity actions being brought, as a main claim, before the EUIPO, for European Union trade marks. Finally, it should be remembered that, unlike the relative grounds for invalidity, the eleven absolute grounds for invalidity are underpinned by the public interest. Only four of them, however, should be given particular attention in the context of fictional trade marks: distinctiveness (**1**), public policy and public morality (**2**), deceptiveness (**3**) and, finally, bad faith (**4**).

1. The distinctiveness of the trade mark

The notion of distinctiveness. The EU Trade Mark Regulation³² requires the trade mark to be distinctive, but also that to not be vitiated by the defect of descriptiveness or genericity. In other words, the trade mark must be inherently distinctive, in that it must be perceived by the consumer as a trade mark in relation to the goods and services, and extrinsically distinctive, in that the sign applied for must be arbitrary, in relation to the designated goods and services.

Arbitrariness and fictional marks. Applied to fictional trade marks, this requirement, and more specifically the requirement of extrinsic distinctiveness, could make it possible to challenge registrations for fictional marks that are themselves generic or descriptive of the

²⁷ Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trade marks.

²⁸ Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark.

²⁹ EUTMR, art. 63.

³⁰ EUTMR, art. 60.

³¹ EUTMR, art. 60.

³² EUMR, Art. 7(1)(b), (c), (d).

goods or services they designate in works of fiction and registered for those same goods and services. The defect of descriptiveness or genericity, which is irrelevant in the work of fiction, could then have serious consequences in reality and lead, naturally, to the invalidity of the trade mark.

This would apply to a *Jurassic Park* trade mark filed and registered for theme parks featuring dinosaurs - either animatronic or cloned. However, these assumptions should be residual. More interesting, but also more difficult to understand, is the question of the assessment of fictional trade marks in the light of the requirement of autonomous distinctiveness.

The requirement of independent distinctiveness. Is it possible to register the title of an intellectual work, the name of a character and, *a fortiori*, a fictional trade mark as a trade mark? The question may seem naive, since practice in this area seems to show that trade mark law does not pose any obstacle to such registrations. To be convinced of this, one need only consult the registers and note that there are countless trade marks registered by HBO³³, DC Comics³⁴, the Moulinsart company³⁵ or Warner Bros Entertainment Inc.³⁶. The theory of trade mark law should, however, counterbalance the certainties of practice and the offices.

As has just been recalled, the requirement of independent distinctiveness implies that the sign applied for must be perceived by the consumer, in relation to the designated goods and services, as being a trade mark. As the Court of Justice regularly points out, the concept of general interest underlying this requirement is confused with the essential function of the trade mark, which is to guarantee to the consumer or end user the identity of the origin of the goods or services designated by the trade mark, by enabling the consumer to distinguish without possible confusion those goods or services from those which have another origin³⁷. Therefore, signs which are unable to fulfil the essential function of the trade mark are rejected for registration or cancelled. This is the basis for the dismissal or cancellation of three-dimensional signs³⁸, since they do not sufficiently diverge from the norms of the sector, colour marks³⁹, sound signs⁴⁰, movement and position marks. The

³³ The TM View database lists, as of 17 September 2021, 4071 trade marks registered by HBO. Examples of EU trade marks include: *Ballers* (Trade mark No. 014428775); *Boardwalk Empire* (Trade mark No. 009788019); *Game of Thrones* (Trade mark No. 016868291).

³⁴ The TM View database lists 5692 trade marks registered by DC Comics as of 17 September 2021. These include, for example, the European Union trade marks: *Aquaman* (Trade mark No. 017871710); *Batman* (00038125); *Batman vs. Superman: Dawn of Justice* (Trade mark No. 013066014).

³⁵ The TM View database lists, as of 17 September 2021, 102 trade marks registered by the Moulinsart company. For example, we find the following European Union trade marks: *Thomson and Thomson* (Trade mark n° 001088574); *Tintin* (Trade mark n° 000145151); *Captain Haddock* (Trade mark n° 001088608).

³⁶ The TM View database lists, as of 17 September 2021, 13814 trade marks registered by Warner Bros Entertainment Inc. Examples include the European Union trade marks: *A ClockWork Orange* (Trade mark No. 018084208); *Albus Dumbledore* (Trade mark No. 001441971); *Animaniacs* (Trade mark No. 017032335).

³⁷ See in particular, CJEU, 8 May 2008, Case C-304/06 P, *Eurohypo*, pt. 56.

³⁸ V. ECJ, 12 Feb 2004, Case C-218/01, *Henkel*; CJEU, 20 Oct 2011, Case C-344/10, *Freixenet*, GDPR 2012, III, p. 92; CJEU, 11 Sept 2014, Case C-521/13, *Think Schubwerk*, GDPR 2014, III, p. 802; CJEU, 7 May 2015, Case C-445/13, *Voss of Norway v OHIM*, EU:C:2015:303, GDPR 2015, III, p. 485.

³⁹ See on the subject, M.-J. Costeira, "Les marques de couleur - Quoi de nouveau après la directive (UE) 2015/2436 et le règlement (UE) 2017/1001", *RAE* 2019, n° 3, p. 435, S. Martin, "Le caractère distinctif des marques de couleurs dans le cadre du RMUE", *RFPI* 2019, n° 8, p. 61. V. ECJ, 24 June 2004, Case C-49/02, *Heidelberger Bauchemie*.

⁴⁰ V. GC, 13 Sept. 2016, Case T-408/15, *Globo Comunicação e Participações v. OHIM*.

requirement of autonomous distinctiveness also makes it possible to prevent the recognition of an exclusive right in favour of signs perceived as exclusively laudatory⁴¹ - slogans - or decorative⁴² by the average consumer. The same requirement could, finally, be opposed to signs with a high symbolic value.

It should be recalled that the first significant application of the requirement of autonomous distinctiveness in France concerned a sign with a particular "symbolic" value. The sign in question was Korda's photo of Che Guevara.



Registered as a Community trade mark to designate clothing, among other things, the Paris Court of Appeal, in a judgment of November 21st, 2008, cancelled it for lack of distinctive character. It noted: "that the parties have abundantly emphasised that the worldwide distribution that this work by Korda has known and still knows; that the echo that it received makes it almost a sort of icon emblematic of a historical figure and, through the tragic fate of the latter, of an era of contemporary history; The evocative power of this work in the eyes of all is not disputed.

Whereas it follows that the consumer concerned by the goods covered by the registration, in particular clothing, publishing products and cultural activities, will perceive the contested Community trade mark not as a sign designating to him the origin of the goods or services in which he is interested but as a reference made, for political or artistic purposes, to Korda's work magnifying Che Guevara;

In other words, the consumer's perception of this photo is exclusive of its use to designate in his eyes the origin of the goods and services for which it has been registered".⁴³.

A similar line of reasoning was followed by the French Office, at least initially⁴⁴, when it indicated in a press release⁴⁵ and before any examination on the merits that the #JeSuisCharlie trade marks should be refused for registration⁴⁶. The press release stated that the sign could not "be captured by an economic actor due to its widespread use by the

⁴¹ The slogan may be registered as a trade mark where it constitutes a play on words, where it introduces elements of conceptual tension or surprise, so that it may be perceived as imaginative, surprising or unexpected, or where it possesses particular originality or prominence. ECJ, 21 Jan 2010, Case C-398/08, *Audi AG v OHIM*.

⁴² GC, 28 Sept. 2010, Case T-388/09, *Rosenruist - Gestão e serviços, Lda v OHIM*.

⁴³ Paris Court of Appeal, 21 Nov. 2008, *JurisData* n° 2008-007171; *Propri. industr.* 2009, comm. n° 33, obs. P. Tréfigny-Goy; *PIBD* 2009, n° 889, III, p. 792

⁴⁴ The trade marks were ultimately refused registration on the grounds that they were contrary to public policy and morality.

⁴⁵ INPI, press release, 13 Jan. 2015.

⁴⁶ Y. Basire, "Je suis Charlie": la tentative de récupération d'un "symbole" par le droit des marques", *Propri. industr.* 2015, n° 3, étude n° 5.

community". It is the symbolism of the sign and the fact that it was used as a sign of support for the victims of the attack on the premises of the newspaper Charlie Hebdo, which prevented it from being perceived as a trade mark by the consumer.

The notoriety of a sign, used otherwise than as a trade mark, may therefore prevent it from being recognised as distinctive in the sense of trade mark law. This should be the case for many titles of pop culture works, names of characters, or even fictional trade marks that enjoy a particular notoriety. Although they are all too rare, a few decisions seem to support this view.

The EUIPO's Second Board of Appeal thus recognised, in a decision of February 25, 2015, that the mark *Pinocchio*, filed by Disney Enterprises, Inc. was not distinctive for goods and services in Classes 9⁴⁷, 16⁴⁸, 28⁴⁹ and 41⁵⁰. The Board of Appeal noted that:

"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"⁵¹.

In the same vein, the First Board of Appeal noted a few weeks later, in a case called *The Jungle Book*, that the title of an intellectual work may be protected under trade mark law, provided that it is capable of performing the function of guaranteeing the identity of origin⁵². This is not the case when the sign at issue is understood solely as a reference to the intellectual work. Thus, in the case of the sign *The Jungle Book*, the Board of Appeal noted that the intellectual work in question, whose history is known to all, had been published in a large number of versions and had been adapted for the cinema, theatre and

⁴⁷ 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

⁴⁸ Printer matter; baby books; books; cartoon strips; children's activity books; comic books; comic strips; magazines; picture books.

⁴⁹ 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.

⁵⁰ 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.

⁵¹ OHIM, Rec. 26 Feb 2015, R 1856/2013-2, *Pinocchio*, pt. 26.

⁵² OHIM, Recueil, 18 March 2015, R 118/2014-1, *The Jungle Book*, pt. 23.

television⁵³. Therefore, the sign is not distinctive for goods and services which might have this story as their subject⁵⁴.

It was also on this basis that the General Court of the European Union refused to recognise the quality of a well-known trade mark for the sign *Dr. No*, a character known as the first antagonist of James Bond in the cinema⁵⁵, as it was not perceived by the consumer as a trade mark⁵⁶. The judges noted that the fact that the sign *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 *ipso facto* prevent it from being able to indicate the commercial origin of goods or services⁵⁷. However, it appeared that the sign was not used to identify the commercial origin of the films, but their artistic origin, as the sign in question, affixed to the covers of video cassettes or DVDs, served only to distinguish this film from other films in the James Bond series⁵⁸.

While these decisions deserve particular attention, in that they qualify the possibility of registering the title of an intellectual work or the name of a character as a trade mark, they remain, as it has already been indicated, too rare to affirm forcefully that autonomous distinctiveness constitutes a decisive obstacle to their registration. Moreover, these decisions are not fully satisfactory, as the requirement of independent distinctiveness seems to be confused with the requirement of descriptiveness. Thus, in the case of *The Jungle Book*, the Board of Appeal noted that "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"⁵⁹. A similar approach was taken in the *Pinocchio* case, with the Board of Appeal stating that 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 book"⁶⁰. Apart from the fact that such confusion must be avoided⁶¹, this situation prevents the full extent of the lack of autonomous distinctiveness of these signs, which are so well known as the title of an intellectual work or the name of a character, that refusal to register them should probably apply much more widely.

In addition, there have been some surprising and questionable decisions recognising the validity of pop culture signs. Firstly, the judgment on the sign *Dr No*. While the latter did not seem to be suitable for indicating the commercial origin of goods or services, the Court

⁵³ *Ibidem*, pts. 25 et seq.

⁵⁴ Class 9 : Magnetic data carriers, recording discs; compact discs, DVDs and other digital recording media; cinematographic films (exposed), exposed films; animated cartoons; audio discs; audio recordings; audio and video recordings; CD-ROMs; chips containing musical recordings; compact discs; digital video discs; pre-recorded optical and magneto-optical discs; motion picture films; musical recordings; video cassettes; video recordings; Class 16 - Printed matter; baby books; books; cartoon strips; children's activity books; colouring books; colouring pages; comic books; comic strips; magazines; paintings; picture books; posters.

⁵⁵ T. Young, *James Bond versus Dr. No*, 1962.

⁵⁶ GC, 30 June 2009, Case T-435/05, *Danjaq. LLC v OHIM and Mission Productions Gesellschaft für Film-, Fernseh- und Veranstaltungsproduktion mbH*, *Propr. industr.* 2009, n° 10, comm. 55, obs. A. Folliard-Monguiral.

⁵⁷ *Ibidem*, pt. 24.

⁵⁸ *Ibidem*, pt. 25.

⁵⁹ OHIM, BoA, 18 March 2015, pt. 32.

⁶⁰ OHIM, BoA, 26 Feb 2015, pt. 28.

⁶¹ See e.g. CJEU, 3 Sept. 2020, Case C-214/19 P, *achtung!* pt. 36.

of First Instance suggested that was not the case of the *James Bond* sign - which is much better known than the *Dr No* sign. 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"⁶² . By being peremptory, laconic and cryptic, the formula is difficult to accept. Does this mean that the serial nature of *James Bond* legitimises the fact that this sign can be perceived by the average consumer as a trade mark?

Secondly, there is a decision of the Cancellation Division of the EUIPO⁶³ , which was issued in relation to a figurative mark *Batman*⁶⁴, registered for goods in classes 25⁶⁵ and 28⁶⁶ that must be mentioned.



The application for cancellation was based on the lack of distinctiveness of the contested sign, as the consumer associated the contested sign with the character of *Batman* and not with goods or services. However, the application was not granted by the Cancellation Division. It noted that for the public, *Batman* and its "Bat Symbol" refer to the character created by Bill Finger and Bob Kane for DC Comics. However, "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. Therefore, the contested mark is exclusively associated, by the public, with the character of *Batman* and not "to any other comic or superhero story or franchise", it being specified that the notoriety of the sign cannot be used to claim its lack of distinctiveness. However, the Cancellation Division's reasoning does not escape criticism, as it made two errors. One the one hand, by stating that the Bat signal refers to the character of *Batman*, the Cancellation Division failed to assess the distinctiveness of the sign in relation to the goods and services designated. On the other hand, the Cancellation Division seems to confuse the reputation of a trade mark, which is indeed intended to enhance its distinctiveness, with the reputation of a sign other than a trade mark, which could, on the contrary, have consequences for its validity as a trade mark. Furthermore, it would be wrong to believe that notoriety or reputation is merely a lever for strengthening protection. It should be remembered that in trade mark law, excessive reputation of a trade mark may lead to the loss of the right to it. This is the case when the trade mark, due to the owner's inactivity, becomes generic⁶⁷ . Although obvious, the error

⁶² CFI, 30 June 2009, Case T-435/05, *supra*, pt 25.

⁶³ EUIPO, Cancellation div., 21 May 2020, No. 31 962 C, *Batman*.

⁶⁴ Mark no. 38158.

⁶⁵ Hats and caps; shorts; jackets; shirts; sweatshirts; t-shirts; pullovers; gloves and mittens; trousers; suits; slippers; socks; hosiery; straps; sandals; shoes and boots; belts (clothing).

⁶⁶ Masks (except sports); Fancy buttons, ties and party hats.

⁶⁷ See for the formula excess of notoriety, M.-A. Pérot-Morel, "La dégénérescence des marques par excès de notoriété", in *Mélanges D. Bastian*, Litec, 1974, p. 52. Notoriety can also have perverse effects outside trade mark law, particularly with regard to the contours of private life for "public" persons. V. R. Sarraute, "Le respect de la vie privée et les servitudes de la gloire", *Gaz. pal.* 1966, 14 Jan, p. 12.

was reiterated by the Second Board of Appeal of the EUIPO, which confirmed the analysis of the Cancellation Division by stating: "the popularity of Batman as a character does not invalidate the trade mark, but rather strengthens the origin function of the Bat insignia"⁶⁸.

As can be seen, the question of the distinctiveness, as a trade mark, of the titles of intellectual works or the names of characters should call for the utmost vigilance. Faced with this issue, offices and courts must adopt a more nuanced approach to assessing the distinctiveness of these signs. It goes without saying that such an approach will not necessarily meet with the approval of practitioners⁶⁹, who will see it as an additional obstacle to the registration of high potential trade marks. However, the objective would not be to prevent, *ipso facto*, the registration of titles of intellectual works or character names as trade marks, but to ensure that they are truly distinctive. Such an approach should not, moreover, exclude the possibility of availing oneself of the mechanism of acquisition of distinctiveness through use⁷⁰, especially when the owner of the rights in the intellectual work adopts a "brand" strategy with a title or character, such as *Mickey Mouse*⁷¹ for Disney or *Totoro*⁷² for Studios Ghibli.



Distinctiveness and fictional trade marks. In view of these few elements, the requirement of autonomous distinctiveness could - and the use of the conditional tense is not insignificant - be opposed to fictitious marks registered without the owners' authorisation. It would still be necessary to show that the registered fictional mark occupies an essential place in the work from which it originates, so that its notoriety or symbolic significance prevents it from being perceived as a trade mark by the average consumer. Again, one thinks of brands such as *Duff Beer*, *Krusty Crab*, *Daily Planet* or *Daily Buggle*. It might indeed be questionable whether such signs could fulfill the essential function of a trade mark and be perceived as such by the consumer because of their affiliation or strong attachment to a work of fiction. However, in addition to the scant and hesitant case law in this area, it should not be forgotten that the symbolic impact of a fictional trade mark is necessarily less strong than that of an intellectual work or a character. Moreover, it cannot be ruled out that the use of these signs as trade marks in intellectual works may make it easier for them to fulfill the function of guaranteeing identity of origin. In many cases, therefore, it may not be difficult to overcome the obstacle of distinctiveness, which would

⁶⁸ EUIPO, BoA, 6 Sep. 2021, R 1447/2020-2, *Batman*, pt. 34.

⁶⁹ See e.g. INTA, Amicus Brief, 3 March 2021, Cases R 1719/2019-5 and R 1922/2019-5, *The Estate of the Late Sonia Brownell Orwell v/ EUIPO*.

⁷⁰ V. Y. Basire, "L'acquisition de la distinctivité par l'usage de la marque de l'Union européenne", *RAE* 2019, n° 3, p. 423; A. Folliard-Monguiral, "Le caractère distinctif acquis par l'usage", *Propr. industr.* 2009, n° 9, study 14, n° 9.

⁷¹ EU Mark No. 002827426.

⁷² EU Mark No. 0181939224.

lead to the use of other absolute grounds for invalidity, first and foremost among which would be infringement of public policy and morality.

2. Public order and morality

Definition of public policy and morality. Echoing Article 6 *quinquies*, point B, paragraph 3, of the Paris Convention of March 20, 1883, Articles 4 (1)(f), of the Trade mark Directive and 7 (1)(f) of the EUTMR excludes from registration signs that are contrary to public policy or morality⁷³. On the one hand and while the concept is difficult to grasp⁷⁴, public policy in trade mark law seems to refer to all legal rules necessary for the functioning of a democratic society and the rule of law⁷⁵. Public policy cannot therefore cover economic interests, nor the mere prevention of social disorder by any breach of the law, but encompasses the protection of various interests which a state considers fundamental according to its own value system⁷⁶. The notion of 'morality', on the other hand, refers to fundamental moral values and norms that are the subject of a 'social consensus'. Thus, unlike public order, which is top-down in that it is imposed from above, i.e. by the public authorities, morality arises at the grassroots level, in society⁷⁷. These moral values, which are not fixed in time, are determined according to the "social context, including, where appropriate, the cultural, religious or philosophical diversities that characterise it"⁷⁸. It is not a question of sanctioning "bad taste"⁷⁹, but rather of refusing to register a trade mark that is incompatible with contemporary values. Under EU case law, good morals are invoked when the sign is "not only indecent, but also offensive and degrading to the reader"⁸⁰, "indecent, obscene and repulsive"⁸¹, deeply disgusting and likely to provoke

⁷³ The reference to morality was removed by the Council of State during the examination of the draft texts relating to the 2019 reform of trade mark law, as it considered, in accordance with its case law, that the notion of public policy included morality (see CE, sect., 18 Dec. 1959, *Société Les Films Lutétia*). This is a view that is neither in line with reality, as public policy does not perfectly encompass the notion of public decency, nor is it in line with the European texts - Directive and Regulation - which distinguish between the notions. Case law also rightly chooses to distinguish between them. V. CJEU, 27 Febr. 2020, aff. C-240/18 P, *Constantin Film Produktion GmbH v/ EUIPO*; CCE 2020, n°6, comm. 46, obs. P. Kamina; *Propr. industr.* 2020, n°4, comm. 24, obs. A. Folliard-Monguiral; Y. Basire and M. Sengel, 'Fack Ju Göhte judgment of the CJEU: good morals and freedom of expression', *Légipresse*, May 2020, n° 382, p.303; M.-S. Bergazov and C. Piedoie, "Bonnes mœurs et liberté d'expression en droit des marques: la CJUE annule la décision du EUIPO ayant refusé l'enregistrement de la marque 'Fack Ju Göthe'", *Lexbase aff.*, févr. 2020; *Propr. intell.* 2020, n° 76, p. 106, obs. Y. Basire; *RTD Com.* 2020, p. 330, obs. J. Passa; *Europe* 2020, n° 4, comm. 129, obs. D. Simon; *Légipresse* 2020, n° 387, p. 633, obs. C. de Marassé-Enouf.

⁷⁴ V. J.-J. Lemouland and G. Piette, "Ordre public et bonnes mœurs", *Rép. Civ. Dalloz*, 2019, n° 1. Malaurie has listed more than twenty definitions of the concept, while noting that they were not fully satisfactory. He thus proposed the following definition: "Public order is the proper functioning of institutions that are essential to the community". V. M. Malaurie, *L'ordre public et le contrat*, 1953, thesis, Paris, n° 99.

⁷⁵ Guidelines for the examination of EU trade marks by the EUIPO, Part B, Section 4, Chapter 7, p. 4.

⁷⁶ *Ibid.*

⁷⁷ Opinion of Advocate General Bobek, 2 July 2019, Case C-240/18 P, pt 77.

⁷⁸ CJEU, 27 Feb. 2020, Case C-240/18, *Fack Ju Göhte*, supra, pt. 39.

⁷⁹ *Ibid.*, pt. 41.

⁸⁰ GC, 26 Sept. 2014, Case T266/13, *Curve*, pt. 27.

⁸¹ GC, 14 Nov 2013, T54/13, *Ficken Liquors*, pt. 19

indignation⁸², when the expression is "highly offensive and deeply indecent"⁸³ or when the sign is "humiliating, discriminatory, blasphemous or insulting, or incites the commission of criminal acts"⁸⁴.

Traditional conception. The charge of offending public order and morality is then traditionally invoked against racist trade marks⁸⁵, trade marks associated with totalitarian political regimes⁸⁶, trade marks evoking terrorist organisations⁸⁷, trade marks suggesting the commission of illegal activities⁸⁸, trade marks related to prohibited substances⁸⁹, sexist trade marks⁹⁰, trade marks featuring religious symbols⁹¹, trade marks referring to insults or particularly vulgar terms⁹², trade marks with a sexual connotation⁹³, trade marks referring to historical figures⁹⁴ or undermining state institutions⁹⁵.

This traditional reading of public policy and good morals would seem to exclude the possibility of challenging the validity of "real" trade marks reproducing fictional trade marks. However, this does not take into account the evolution of these notions, which seem to have taken on a new dimension in recent years, as shown by the rejection of trade marks such as #JesuisCharlie⁹⁶ and the EFTA Court's decision in the *Vigeland* case.

Vigeland case. In this case, the EFTA Court⁹⁷ considered whether a work that had been protected by copyright but had fallen into the public domain could be appropriated through trade mark law. The municipality of Oslo had registered works by Vigeland, a famous

⁸² OHIM, Gr. BoA, 6 July 2006, R 495/2005-G, *SCREW YOU*, pt. 18

⁸³ GC, 9 March 2012, Case -T417/10, ¡Que *buenu ye! Hijoputa*, pt. 17.

⁸⁴ OHIM, BoA, 28 May 2015, R2899/2014-4, *Die wanderubre*, pt. 7

⁸⁵ GC, 5 Oct. 2011, aff. T526/09-, *Paki*, Propr. intell. 2012, n° 42, p. 96, obs. B. Geoffroy; OHIM, ex. 14 Dec. 2010, application no. 1056019; OHIM, ex. 6 Apr. 2006, application no. 004118915.

⁸⁶ GC, 20 Sept. 2011, Case T 232/10, *Representation of the Soviet coat of arms*; OHIM, Ch.Rec., 6 Feb. 2015, R 2804/2014-5, *MECHANICAL APARTHEID*.

⁸⁷ OHIM, BoA, 29 Sept. 2004, R 0176/2004-2, *Bin Laden*; OHIM, ex., 7 Sept. 2004, application no. ° 003669074; OHIM, ex., 23 Sept. 2013, application no. 011944584, *AL MOUHAJIROUN*; OHIM, ex., 31 May 2013, application no. 011610458, *Haika*; OHIM, ex., 26 Apr. 2010, application no. 8289357, *IRA*.

⁸⁸ V. OHIM, ex., 27 Jan 2011, application no. 9450751; OHIM, BoA, 11 May 2012, R 2052/2011-5, *How to make money selling drugs*.

⁸⁹ GC, 12 Dec. 2019, Case T-638/18, *Cannabis Store Amsterdam*; EUIPO, BoA, 16 June 2020, R 2158/2019-2, 4.20 *Hemp Fest*.

⁹⁰ OHIM, 2 Feb. 2007, application no. 004808821.

⁹¹ OHIM, 2 Feb. 2005, application no. 3239514.

⁹² GC, 9 March 2012, -T417/10, ¡Que *buenu ye! Hijoputa*.

⁹³ GC, 14 Nov 2013, Case T-52/13, *Ficken*. See in the same sense, EUIPO, BoA, 27 Jul. 2020, R 2878/2019-1, *Unfucked*; OHIM, BoA, 26 Jul. 2012, R 1494/2011-1, *GAMMAS*; OHIM, BoA, 23 Feb. 2015, R 793/2014-2, *FUCK CANCER*; OHIM, BoA, 1 Sep. 2011, R 168/2011-1, *fucking freezing! by TÜRPLITZ*; EUIPO, BoA, 12 Jan. 2017, R1054/2016-5, *touch my hole*.

⁹⁴ EUIPO, ex., 13 Apr. 2017, application no. 016056368.

⁹⁵ CA Paris, 26 Feb. 2016, Pôle 5 - Ch. 2, no. 14/20555; L. Marino, "Non, " les sans dents " ne sera pas une marque !", *Gaz. Pal.* 2016, n° 24, p. 30.

⁹⁶ V. Y. Basire, " Je suis Charlie " : la tentative de récupération d'un " symbole " par le droit des marques : *Propr. industr.* 2015, n° 3, étude n° 5.

⁹⁷ EFTA Court, 6 Apr. 2017, Case E-5/17, *Municipality of Oslo v. Patentstyret* : *Propr. industr.* 2017, n° 6, comm. 38, obs. A. Folliard-Monguiral; *CCE* 2017, n° 10, comm. 79, obs. C. Caron; *Propr. intell.* 2018, n° 67, p. 71, obs. Y. Basire.

Norwegian sculptor, as trade marks, even though they had fallen or were about to fall into the public domain.

The Norwegian Intellectual Property Office (NIPO) rejected the applications for registration on the grounds of lack of independent distinctiveness, descriptiveness and the fact that the signs in question could also be regarded as shapes giving substantial value to the goods designated. On appeal, the *Klagenemnda for industrielle rettigheter* (KFIR) confirmed this analysis, while noting that another absolute ground for refusal could have been invoked: infringement of public policy and morality. However, the KFIR decided to ask the EFTA Court what should be done with this type of application for registration.

More specifically, with regard to the KFIR ground of offence to public decency, the EFTA Court noted that, *per se*, the signs for which registration was sought were not in themselves offensive or objectionable⁹⁸. However, it added that certain works of the mind enjoy a special status in that they form part of the cultural heritage of certain States and are assimilated to genuine national emblems or symbols⁹⁹. In such cases, the registration of such works as a trade mark could be perceived as a misappropriation or desecration of them, in particular if the goods or services designated prove to be contrary to the values of the author or the meant message¹⁰⁰. Consequently, the EFTA Court invited the national courts - and the referring court - to make a sovereign assessment of the potential infringement of public policy or morality of an intellectual work of the mind which has fallen or is about to fall into the public domain, taking into account the public perception of the work in question, as well as the nature of the designated goods and services¹⁰¹.

The judges then turned to the question of infringement of public policy, stating that the concept refers to principles or norms considered fundamental to the State or society as a whole¹⁰². Accordingly, the registration of a copyright-free work of the mind must be refused on this ground if, in the circumstances, it presents a serious threat to a fundamental interest of society¹⁰³.

In the light of this analysis, it was no surprise that the referring court - the KFIR - upheld the decision to reject the application for registration, not on the grounds of lack of distinctiveness, but on the basis that it was contrary to public policy and morality¹⁰⁴: since Vigeland and his works are part of the national cultural heritage in the eyes of the Norwegian public, registering them would be contrary to society's fundamental interest in seeing them remain in the public domain. Public order and good morals are thus given an unexpected field of application, where the concept of 'indecent recovery' is still prevalent.

While the solution seems perfectly understandable on an "intellectual level", it appears much less satisfactory on a "legal level". The EFTA Court's intention was clear: to prevent any form of "reconstitution" of a monopoly for works of the mind that enjoy a certain

⁹⁸ *Ibid*, pt. 91.

⁹⁹ *Ibid*, pt. 92.

¹⁰⁰ *Ibid*, pt. 93.

¹⁰¹ *Idem*.

¹⁰² *Ibid*, pt. 94.

¹⁰³ *Ibid*, pt. 96.

¹⁰⁴ KFIR, 13 Nov. 2017, decisions 16/00148 to 16/00154, *Propr. intell.* 2018, n° 67, p. 71, obs. Y. Basire.

notoriety. In this sense, the Court followed the recommendations of *the European copyright society*¹⁰⁵. Once a work of the mind has fallen into the public domain, it must remain free of rights and no longer be subject to any exclusive right. To admit the contrary would call into question the purpose of copyright and its temporary nature. However, can it be said that the registration of a work of the mind that has fallen into the public domain is akin to the reconstitution of a monopoly? The answer is no.

On the one hand, the subject matter of the right differs: an intellectual work for one, a distinctive sign for the other. In addition, there is a difference in the purposes of the rights concerned¹⁰⁶. Consequently, their respective scopes and implementations cannot be assimilated, as trade mark rights cannot replace copyright. Thus, if, by chance, the registration of a work of the mind as a trade mark were to contribute to the reconstitution of a monopoly, a misappropriation of the purpose of the trade mark right would be noted and likely to be sanctioned at all stages of the trade mark's life. The sign could, in fact, be refused registration for lack of distinctiveness. It could also be sanctioned on the grounds of bad faith¹⁰⁷, in accordance with the most recent developments of the Court of Justice¹⁰⁸. Depending on the use that the proprietor makes of his sign, he could also incur the revocation of his right for lack of exploitation. On the other hand, it should be remembered that the trade mark right is only enforced when the disputed use is made in the course of trade, as a trade mark, in the same speciality and is likely to infringe one of the functions of the trade mark. Finally, the infringement of the "spirit" of the work referred to by the Court and the report of *the European Copyright Society*, in particular with regard to the goods and services likely to be designated, could perfectly well be considered in the context of the assessment of the requirement of availability and the implementation of the author's moral rights. In other words, recourse to the concepts of public policy and public morality could - and should - be avoided. It is indeed important not to take too broad a view of these concepts in order to preserve the principle of free competition - the cornerstone of trade mark law - and not to empty the requirement of distinctiveness, which must remain the essential condition of validity of the trade mark right.

¹⁰⁵ European Copyright Society, "Trade mark protection of public domain works - A comment on the request for an advisory opinion of the EFTA Court", 1st Nov 2016, online.

¹⁰⁶ The essential function of a trade mark is to guarantee the commercial origin of the marked goods. This purpose permeates the whole subject matter and legitimises, in particular, the implementation of the trade mark right on condition that the disputed use is made in the course of trade and as a trade mark. With regard to copyright, it is clear from the case law that the main objective of the Copyright Directive is to establish a high level of protection for authors (see, inter alia, CJEU, 4 Oct. 2011, CJEU, 4 Oct. 2011, Case C-403/08, *Football Association Premier League and Others*, pt. 186). In a 1980 judgment, the Court of Justice also emphasised that it was part of the essential function of copyright in such literary or artistic works for the copyright holder to demand royalties for any performance of a film (ECJ, 18 March 1980, Case C-62/79, *Coditel*, pt. 14). Professor Strowel, citing L. Ray Patterson, identifies three functions of copyright: a creative function, a distributive function and an educational function: "(1) the author contributes to the culture of a society by creating works, of which he has ownership; (2) the entrepreneur fulfils the economic purpose of copyright (and in so doing rewards Fauteur) by distributing the work, and, of this distribution process, he has control; (3) the consumer fulfils the social purpose of copyright by using the created work for his intellectual education, which requires that he has unfettered access to it." V. A. Strowel, "Considérations sur le droit d'auteur à la lumière des intérêts sous-jacents", in *Droit et intérêt*, Vol. 3, P. Gérard, F. Ost, M. Van de Kerchove (dir.), Presses de l'Université de Saint-Louis, 1990, p. 233.

¹⁰⁷ See *below*.

¹⁰⁸ CJEU, 29 Jan 2020, Case C-371/18, *Sky v SkyKick*.

In addition to these numerous reservations, it would also be tempting to regard this decision as anecdotal. The EFTA Court cannot be compared to the Court of Justice. Moreover, it dealt with Norwegian law. However, the intellectual significance of this decision should not be minimised. This would be to overlook the fact that the law interpreted is that of the European Union, as the EFTA Court was asked to read Article 3(1)(f) of the Trade Mark Directive. This would also be to ignore the intervention of *the European Copyright Society* and its report on the issue to influence the EFTA Court's decision. The *Vigeland* judgment cannot, therefore, despite the many criticisms that can be made of it, be ignored. In so doing, it offers insights into the problem of unauthorised registrations of fictional marks.

Law and order, good morals and fictional brands. Many works of pop culture have a cult following among their fanbase. While this may be surprising given its religious connotations, it is not excessive, as works such as *Star Wars*, *Star Trek*, *Harry Potter*, *Lord of the Rings* and *Game of Thrones* are, for the most diehard fans, in the realm of the sacred. The relationship between communities of fans - united in *fandom*¹⁰⁹ - and these works is so strong that we are witnessing a form of radicalisation¹¹⁰, bringing with it its share of abuses, ranging from petitions to reverse the end of a series¹¹¹, to cyber-harassment¹¹², and even death threats¹¹³.

This observation naturally leads to questions about the public's perception of the registration of a fictional mark as a trade mark. Would it not be possible to invoke the achievements of the *Vigeland* judgment and, more specifically, the desecration or denaturation of works of the mind as a result of their registration as a trade mark? Although the *Vigeland* judgment concerned works that have fallen into the public domain or are close to doing so, its scope cannot be limited to these cases, since any work of the mind is, in essence, destined to fall into the public domain. Consequently, it is not impossible that the registration of a fictitious trade mark be perceived as a real desecration. However, two pitfalls must be overcome. On the one hand, the fictitious trade mark registered by a third party without authorisation should be apprehended, itself, as a work of the mind seized by copyright, and this, independently of the work in which it is integrated. Such a demonstration could prove perilous, especially for fictitious trade marks consisting exclusively of verbal elements, as originality is particularly difficult to prove in such cases¹¹⁴. On the other hand, it would also be necessary to demonstrate that the registered fictitious mark enjoys a particular aura among the average consumer in order to legitimise the cancellation of its registration. Nothing is less certain, as the assessment of the infringement

¹⁰⁹ An interactive community of fans. V. M. Bourdaa, "La promotion par les créations des fans", *Raisons Politiques*, Presses de Sciences Po, 2016, n° 2, n° 62, p. 101.

¹¹⁰ C.-C. Garnier, "Are pop culture fans on their way to self-radicalisation?", *Slate*, 24 May 2016, online (in French).

¹¹¹ C. Martin, "Petition to remake Game of Thrones ending pisses off cast", *Première*, 21 May 2019, online (in French). See in particular the petition on change.org, For a new season 8 of Game of Thrones made by competent writers, signed by 1,848,234 people on 11 September 2021.

¹¹² P. Croquet, "Star Wars: the harassment of actress Kelly Marie Tran illustrates the excesses of fan communities", *Le Monde*, 11 June 2018, online (in French).

¹¹³ C. Foltzer, "Rian Johnson admits receiving death threats following The Last Jedi", *Wide Screen*, 4 Apr. 2018, online (in French).

¹¹⁴ See *below*.

of public policy and morality should not be based on the perception of a fan, but on that of a reasonable person with normal thresholds of sensitivity and tolerance¹¹⁵.

In any case, while it should not be ignored, the application of the *Vigeland* case law is undesirable, in that it is unnecessary and dangerous¹¹⁶. It is therefore to be welcomed that this decision has received little attention, as shown in particular by the EUIPO's Examination Guidelines, which do not refer to it. In view of these reservations, it could be tempting to invoke the defect of deceptiveness in order to obtain the cancellation of a fictional mark registered without the authorisation of the owner of the rights of the intellectual work in which it is included. Like public policy and morality, case law has given a new dimension to this absolute ground for refusal.

3. Deceptiveness

Deception and intellectual works. The deceptiveness of a trade mark is nowadays provided for under Articles 4 (1)(g) of the Trade mark Directive and 7 (1)(g) of the EUTMR. The provision provides that the following may not be validly registered and, if registered, may be declared invalid: "A trade marks 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". The text thus refers to trade marks that are likely to deceive as to the nature, quality or geographical origin of the product or service. However, the provision is intended to be particularly inclusive, with the adverb "in particular" indicating that the list of elements to which deception may relate is not exhaustive. Thus, in addition to the traditional approach of punishing deception in relation to both the intrinsic¹¹⁷ and extrinsic¹¹⁸ elements of products and services, the case law has not hesitated to take a bold step forward by ruling, in particular, on deception as to the origin and authorship of an intellectual work.

The question was raised in France, in the case of Baby Lilly, in which the title of a work of the mind - Baby Lilly - had been registered as a trade mark without the author's permission. The author then sued the applicant, who was also the producer of the intellectual work in question, in order to have the contested trade mark cancelled on the grounds of deceptiveness. The Paris Court of Appeal refused to grant his request on the grounds that deception as to the origin and authorship of a work of the mind was not covered by Article

¹¹⁵ CJEU, 27 Feb. 2020, Case C-240/18 P, cited above.

¹¹⁶ See *above*.

¹¹⁷ See for examples of deception of nature, INPI, dec. Dir. Gen., 7 Sept. 1984, Abricot, *PIBD* 1984, III, p. 235; INPI, dec. Dir. Gen., 1 Mar. 1988, Porcelaine bleue; CA Paris, 12 Mar. 1997, Meteotel, *RIPLA* 1998, No. 192, p. 104; OHIM, BoA, 19 Nov. 2011, R. 0892/2009-1, Lactofree. See for deception on product quality, CA Paris, 12 Feb. 1981, Servi frais, *Ann. propr. ind.* 1981, p. 32.

¹¹⁸ See for examples of deception on geographical origin, TGI Paris, 9 Dec. 2016, No. 14/16395, Gold Bavaria, *PIBD* 2017, No. 1065, III, p. 91; CA Paris, 24 Feb. 2015, No. 14/11013, Amsterdam Poppers. See for signs suggesting quality control, TGI Paris, 8 Apr. 2009, Le comptoir du pharmacien, D. 2009, p. 2980, obs. E. Fouassier; CA Paris, Pôle 5, ch. 1re, 14 Feb. 2017, n° 16/04876 concerning the Label Vert mark which evokes an ecological certification; GC, 13 May 2020, aff. T-86/19, Bio-Insect Shocker: "The presence of the term "bio" on the biocidal products for which the contested mark is registered is sufficient to establish a sufficiently serious risk of deceiving the consumer".

L. 711-2, 8° of the French Intellectual Property Code¹¹⁹. The argument could hardly be accepted. Unsurprisingly, the Court of Cassation censured the appeal decision, holding that a trade mark can be deceptive when it is likely to mislead the consumer as to the relationship between the sign used and a work protected by copyright or a derived right¹²⁰. However, the assertion does not escape criticism. Indeed, the defect of deceptiveness must be assessed in relation to the goods and services designated. However, the Court of Cassation chose to refer only to the intellectual work¹²¹. The solution also echoes the decision of the Paris Court of Appeal in the *Inès de la Fressange* case, which noted that the latter no longer exercised any control over the artistic creation of the marketed products in order to identify the defect of deceptiveness¹²². However, it should be remembered that the Court of Justice refuses - somewhat critically¹²³ - to find deception under trade mark law in the case of family names¹²⁴.

Despite the reservations that may be addressed to it, the *Bébé Lilly* case law could be useful in challenging the validity of trade marks that reproduce fictional trade marks and are registered without the authorisation of the owners of the rights in the intellectual works in which they are incorporated. It might indeed be tempting to argue, as the Cour de cassation has done, that such marks mislead the consumer as to the relationship between the sign used as a mark and a work protected by copyright or a related right. One question remains, however. Does the Court of Cassation's cryptic formula mean that deception is possible provided that the registered sign is itself a work of the mind, in which case it would again be necessary to show that the fictional marks are protected by copyright? Or, furthermore, can deceptiveness be found where the sign, reproducing a fictional mark, refers to the work of the mind into which it is incorporated? Although it is difficult to agree with this line of reasoning, it is not impossible that this second interpretation is the one intended by the Court of Cassation. If this were to be the case, the absolute ground of deceptiveness would be particularly welcoming in order to challenge the validity of trade marks that have resorted to the process of defictionalisation without authorisation. It would thus be added to bad faith, which must be considered the most relevant absolute ground in such cases.

4. *Bad faith*

Notion of bad faith. Bad faith is referred to as an absolute ground for invalidity in Articles 4 (2) and 59 (1)(b) of the EUTMR. Although covered by these texts, the notion of bad faith is not defined. It was therefore up to the judges to clarify its meaning, by establishing it as

¹¹⁹ CA Paris, Pôle 5, ch. 1, 27 Jan. 2015, n° 12/15801.

¹²⁰ Cass. com. 11 Jan. 2017, n° 15-15.750, *JurisData* n° 2017-000412; *PIBD* 2017, n° 1067, III, p. 180; *Dalloz IP/IT* 2017, n°5, p. 260, J. Daleau; *RTD com.* 2017, p. 76, obs. F. Pollaud-Dulian; *Propri. industr.* 2017, comm. 16, P. Tréfigny. See also CA Paris, Pôle 5, ch. 2, 30 March 2018, n° 17/04929 and Cass. com., 4 Nov. 2020, n° 18-18455, *Propri. industr.* 2021, n° 2, comm. 12, obs. P. Tréfigny.

¹²¹ F. Pollaud-Dulian, obs. ss. Cass. com. 11 Jan. 2017, *supra*.

¹²² CA Paris, 15 Dec. 2004, *supra*.

¹²³ V. Y. Basire, "La tromperie en droit des marques", in *Consommateur choqué, égaré, trompé*, Y. Basire (ed.), *Légipresse* 2020, Hors-série n° 2, p. 85.

¹²⁴ ECJ, 30 March 2006, Case C-259/04, Elizabeth Emmanuel, *PIBD* 2006, n° 830, III, p. 356; *Propri. intell.* 2006, n° 21, p. 485, obs. G. Bonet; *RLDI* 2006, No. 21, p. 6, note B. Humblot.

an autonomous concept specific to EU law¹²⁵. In its usual sense, bad faith is understood as a state of mind or a dishonest intention¹²⁶. Bad faith in trade mark law is characterised by relevant and corroborating evidence that the rights holder does not intend to compete fairly, but rather "to prejudice the interests of third parties in a manner which is not in accordance with honest practices" or "to obtain, without even targeting a particular third party, an exclusive right for purposes other than those of the functions of a trade mark"¹²⁷. Furthermore, like any absolute ground for invalidity, the defect of bad faith is underpinned by the general interest, the objective being to prevent registrations contrary to honest practices in industrial and commercial matters. In this respect, and contrary to certain preconceived ideas¹²⁸, the existence of a competitive relationship between the applicant and the economic operator requesting the invalidity is not required¹²⁹.

Assessment of bad faith. Bad faith must be assessed broadly, taking into account all factors relevant to the case and existing at the time of filing¹³⁰. Case law has proposed, as a first step, to take into account the following factors: the fact that the applicant knows or ought to know that a third party is using, in at least one EU Member State, an identical or similar sign for an identical or similar product or service which is confusing with the sign applied for; the applicant's intention to prevent the third party from continuing to use such a sign; the degree of legal protection enjoyed by the third party's sign and the sign applied for¹³¹. This list was not, however, intended to be exhaustive. The Court of First Instance has thus identified others: the origin of the contested sign and its use since its creation; the commercial logic behind the filing of the application for registration of the sign as a European Union trade mark; the chronology of events that characterised the occurrence of the contested filing¹³²; the applicant's intention, in general, at the time of the application for registration.

Fictional trade marks and bad faith. This broad assessment of bad faith means that it cannot be confined to the most obvious and classic case of a registration made with a view to depriving a third party of a sign necessary for its activity¹³³. Thus, it may also constitute bad faith to apply for registration of a trade mark with no intention of using it for the

¹²⁵ CJEU, 27 June 2013, Case C-320/12, *Malaysia Dairy Industries Pte. Ltd v/ Ankenævnet for Patenter og Varemarker*, *Propr. intell.* 2013, n° 49, p. 409, obs. G. Bonet; *Légipresse* 2013, n° 310, p. 637, obs. Y. Basire.

¹²⁶ V. CJEU, 12 Sept. 2019, aff. C-104/18 P, *Koton Mağazacılık Tekstil Sanayi ve Ticaret AŞ*; CJEU, 29 Jan. 2020, aff. C-371/18, *Sky v SkyKick*, pt. 74; M. Sengel, "Sky v Skykick: les conséquences de l'impécision des termes employés pour désigner des produits ou services", *Lexbase aff*, Feb. 2020; J. Canlorbe, "Un an de jurisprudence sur les motifs absolus de refus des marques de l'Union européenne", *Propr. industr.* 2020, n°4, chron. n°3, § 6; A. Folliard-Monguial and V. Ruzek, "L'arrêt Skykick : coup de tonnerre sur les libellés exorbitants", *Propr. industr.* 2020, n°5, study 12; *Propr. intell.* 2020, n° 76, p. 113, obs. Y. Basire; *RTD Com.* 2020, p. 332, obs. J. Passa; *Légipresse* 2020, n° 387, p. 635, obs. M. Sengel.

¹²⁷ CJEU, 29 Jan. 2020, Case C-371/18, *Sky v SkyKick*, *supra*, pt. 75. See also CJEU, 12 Sept. 2019, *supra*, para 46.

¹²⁸ GC, 30 Nov. 2017, Case T-687/16, *Koton Mağazacılık Tekstil Sanayi ve Ticaret AŞ*.

¹²⁹ GC, 12 Sept. 2019, Case C-104/18 P, cited above.

¹³⁰ ECJ, 11 June 2009, Case C-529/07, *Chocoladenfabriken Lindt & Sprüngli*. D. 2009. 236, note T. Lancrenon; *Propr. intell.* 2009, n° 32, p. 291, obs. G. Bonet; *PIBD* 2009. 900, III, 1225; *Propr. industr.* 2009, n° 9, comm. n° 52, A. Folliard Monguial.

¹³¹ *Ibidem*, pt. 53.

¹³² GC, 26 Feb 2015, Case T-257/11, *Colourblind*, pt. 68.

¹³³ Cass. com. 4 Oct. 2016, no. 14-22245, D. 2016, 2166, *Dalloz IP/IT* 2016, p. 612, obs. C. Le Goffic, *Propr. industr.* 2016, comm. 89, obs. J. Larrieu.

designated goods and services¹³⁴. The same applies when the application for registration seeks to take advantage of the reputation of a sign and, consequently, is parasitic. This was the basis for the cancellation of the *Simca* trade mark, which reproduced a well-known trade mark that had not been used for many years, and the *Neymar* trade mark, which was registered by a third party with no connection to the Brazilian football star.

In the first case, the judges found from the circumstances of the case that the owner of the contested mark sought to exploit the reputation of the earlier *Simca* marks in a parasitic manner¹³⁵. In the second case, the judges found that the application was made for the purpose of creating an association with the football player Neymar in order to take advantage of his appeal¹³⁶. This case also shows that an action for invalidity based on the applicant's bad faith does not necessarily rely on the existence of an earlier trade mark - in Europe or elsewhere¹³⁷. Consequently, the filing of a fictitious trade mark, without authorisation and in order to benefit from its attraction, could be considered as having been carried out in bad faith. The challenge will then be to demonstrate bad faith, which can be established on condition that objective circumstances make it possible to determine the intention of the trade mark owner at the time of filing¹³⁸. Among these objective circumstances, it would be appropriate to focus on a set of indicators such as the reputation of the fictitious trade mark, its speciality in intellectual works, as well as that of the disputed trade mark or the chronology of events.

The fact that the right holder of the disputed trade mark cannot be unaware of the existence of the fictitious trade mark, that the speciality chosen by the owner of the disputed trade mark is identical or similar to that of the fictitious trade mark in the work of fiction, or that the disputed trade mark is applied for after the use of the fictitious trade mark in the work of fiction in which it is included, are all circumstances - whether or not they are met - that allow the deduction of dishonest intent on the part of the applicant. Bad faith would then constitute the ideal absolute ground for invalidity in order to obtain the invalidity of a fictional trade mark filed without authorization¹³⁹. It would be all the more appropriate as the enforceability of relative grounds for invalidity could be difficult to establish.

B. Relative grounds

The validity of a trade mark is also subject to its availability. This is the case when its registration is not likely to infringe a prior right. This condition of validity is extrinsic to the sign. It is thus a relative ground for refusal which, unlike absolute grounds for refusal, is

¹³⁴ CJEU, 29 Jan. 2020, Case C-371/18, cited above.

¹³⁵ GC, 8 May 2014, aff. T-327/12, *Simca Europe Ltd c/ OHIM*, pt. 56, *Propr. industr.* 2014, n° 6, comm. 49, obs. A. Folliard-Monguiral.

¹³⁶ GC, 14 May 2019, aff. T-795/17, *Neymar*, pt. 55, PIBD 2019, n° 1118, III, p. 285, *Propr. industr.* 2019, n° 9, comm. 45, obs. A. Folliard-Monguiral, *Propr. intell.* 2019, n° 73, p. 76, obs. Y. Basire, *Dalloz IP/IT* 2019, p. 699, obs. J. Daleau.

¹³⁷ GC, 23 May 2019, Case T-3/18 and T-4/18, *Holzer y Cia v/ EUIPO*, *Propr. industr.* 2019, No. 9, comm. 44, obs. A. Folliard-Monguiral.

¹³⁸ GC, 14 May 2019, Case T-795/17, cited above.

¹³⁹ See for the application of bad faith in relation to a work of the mind, EUIPO, Cancellation div., 17 June 2020, No. 32 441 C, *Peaky blinders*.

not examined by the competent authority, but only when a third party requests it, in the context of an opposition procedure or an action for invalidity. The prior rights in question are listed in a non exhaustive way in Articles 5 of the Trademark Directive and 8 and 60 of the EUTMR. Two of them deserve to be considered in the context of the problem of fictional trade marks: anteriority constituted by an earlier trade mark (1) and anteriority constituted by a work of the mind protected under copyright (2).

1. Anteriority constituted by a trade mark

The registered trade mark. In terms of opposable prior rights, Articles 5 of the Trademark Directive and 8 of the European Union Trade Mark Regulation refers, firstly, to the prior trade mark. This refers first of all to a trade mark registered by a member state office or with the EUIPO¹⁴⁰. It is protected in the speciality, for similar goods and services, or outside the speciality, when the trade mark can be qualified as reputed, for different goods and services, against applications relating to identical or similar signs. However, such an anteriority will not be of any help in challenging the registration of a fictitious trade mark, as the latter is not recorded in any register and exists only through the prism of fictional works. Another lever for action could therefore be considered: the well-known trade mark which, by essence, is not registered.

The well-known trade mark. An earlier trade mark is also a well-known trade mark within the meaning of Article 6*bis* of the Paris Convention for the Protection of Industrial Property¹⁴¹. Similar to the trade mark with reputation¹⁴², the well-known trade mark is defined as a trade mark that is known not only to a significant part of the relevant public, but also in a substantial part of the country in which it is protected¹⁴³. It is to be distinguished from the trade mark with reputation in that it is not registered. This characteristic refers, of course, to fictional trade marks which are not registered and for which it would be tempting, because of their fame/notoriety, to take advantage of the protection regime initially envisaged in Article 6*bis* of the Paris Convention.

It should be recalled, for all intents and purposes, that this provision provides that: "The countries of the Union undertake, either ex officio if the legislation of the country so permits, or at the request of the person concerned, to refuse or to invalidate the registration and to prohibit the use of a trade mark which constitutes a reproduction, imitation or translation which the competent authority of the country of registration or use considers to be well known in that country as being already the mark of a person entitled to the benefits of this Convention and used for identical or similar goods. The same shall apply where the essential part of the mark constitutes a reproduction of such a well-known mark or an imitation liable to create confusion therewith".

¹⁴⁰ EUTMR, Art. 8, paragraph 2, subparagraphs a) and b).

¹⁴¹ EUTMR, art. 8, paragraph 2, sub c).

¹⁴² ECJ, 22 Nov. 2007, aff. C-328/06, *Nieto Nuño* ; *Propr. intell.* 2009, n° 30, p. 91, obs. G. Bonet; *CCE* 2008, n° 2, comm. n° 19, obs. C. Caron; *Propr. industr.* 2008, n° 1, comm. n° 2, obs. A. Folliard-Monguiral; *Europe* 2008, n° 1, comm. n° 23, obs. L. Idot.

¹⁴³ ECJ, 14 Sept. 1999, Case C-375/97, *General Motors*.

Although interesting, by allowing the exemption from the registration requirement, it is doubtful that the well-known trade mark regime is of much use in preventing the registration of a fictional trade mark without authorisation. Indeed, the qualification of a well-known trade mark implies that the fictional trade mark is used as a trade mark, i.e. for the purpose of identifying goods or services. In other words, as already mentioned with regard to the distinctiveness requirement, the fictional mark must be perceived by the average consumer as being a trade mark. Therefore, if it remains confined to the work of fiction, it will be impossible for it to achieve this status. Similarly, if the fictional trade mark were to be exploited through derivative products, it would be difficult to demonstrate that the sign used on them would be perceived by the average consumer as a trade mark. In the *Dr. No* case, the sign referring to *James Bond's* first antagonist was invoked as a well-known trade mark in opposition proceedings to prevent the registration of a *Dr. No* trade mark. The General Court noted, however, that the use of the *Dr. No* sign on the cover of video cassettes, DVDs, music recordings, books, comics, posters, miniature cars and watches did not constitute use as a trade mark. The sign *Dr. No* could therefore not be considered an unregistered trade mark and therefore the opposition based on the existence of such a trade mark prior to the application for registration of the trade mark in question could not succeed¹⁴⁴. An identical decision was handed down in respect of the sign *Octopussy*, the title of the thirteenth *James Bond* film and the name of a character in that film, which was opposed as a well-known mark to the registration of the semi-figurative mark *Octopussy*.



The Fourth Board of Appeal noted that the evidence does not show that the sign 'OCTOPUSSY' is perceived by consumers as an indication of the company which produced the film. It is, on the contrary, a sign which has exhausted its function of distinguishing this film from other films of the same series. It is, in fact, irrelevant that the film has been a great success in the territory of the European Union. The derivative products on which the *Octopussy* sign appears are also irrelevant, as the Board of Appeal considered that this sign was not perceived as an indication of commercial origin, but, on the contrary, as a description of the products marketed under the *007* or *James Bond* trade marks¹⁴⁵.

A similar approach was taken in France in a case involving *Earth, Wind and Fire* - the name of a famous jazz-funk band formed in the late 1960s - in which one of the band members sought to oppose the registration of the trade mark *The Earth Wind & Fire Experience* on the basis of the well-known trade mark *Wind & Fire*. The judges of the Paris Court of Appeal held that the fact that a music group and its name are well known does not mean that the sign *Earth, Wind and Fire* is used as a trade mark. Thus, whether it was a question of "services and conduct of concerts, performances and entertainment" or "recording media such as

¹⁴⁴ GC, 30 June 2009, Case T-435/05, *supra*, pt. 40.

¹⁴⁵ OHIM, BoA, 20 Apr. 2010, R 526/2008-4, *Danjac LLC v Ignacio Furest Salietti*, pt. 16.

records, CDs and DVDs", the sign invoked could not be perceived as an indicator of their commercial origin, but as an indicator of their artistic origin¹⁴⁶. The usefulness of the well-known mark for the purpose of defeating the registration of fictional marks thus appears limited, if not non-existent. Another relative ground could then be invoked: a prior copyrighted work of the mind.

2. Anteriority constituted by a work of the mind

Absolute prior rights. Two types of prior rights must be distinguished within: relative prior rights, which are governed by the principle of speciality, and absolute prior rights, for which the principle of speciality is, on the contrary, irrelevant. If an anteriority falls into this second category, the consequence is simple: an analysis of the goods and services designated by the contested mark will be of any use in order to question its validity. This is the case when a trade mark is opposed to an earlier work of the mind, protected under copyright law.

Fictional trade mark and copyright. A work of the mind may be opposed to a later registered trade mark on the condition, however, that it is shown that the application is made by the owner of the rights in the work and that the work is effectively protected under copyright.

The opposing work must therefore be qualified as original, in that it must constitute "an intellectual creation specific to its author¹⁴⁷", implying that the author has made free and creative choices reflecting his/her personality¹⁴⁸. What about fictional marks that may consist of mere words, combinations of words or a few figurative elements? Can such signs also be captured by copyright?

A negative response seems to be required for the US Copyright Office, which stated in 1958 that: "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". Consequently, "Brand names, trade names, slogans, and other short phrases or expression cannot be copyrighted, even if they are distinctively arranged or printed"¹⁴⁹. However, the stance is more nuanced in France and in Europe. Indeed, if the difficulties for such recognition are real and implies some reservations on the part of the doctrine¹⁵⁰, the fact remains, as we have already expressed¹⁵¹, that there is no decisive obstacle to the recognition of a copyright for a work characterised by its conciseness. Case law – in France

¹⁴⁶ CA Paris, Pôle 5, ch. 2, 15 Dec. 2017, n° 17/00728.

¹⁴⁷ CJEU, 16 July 2009, Case C-5/08, *Infopaq*, point 37, *CCE* 2009, comm. 97, obs. Caron; *Propr. intell.* 2009, p. 379, obs. V.-L. Benabou; *JCP E* 2010, 1691, n° 11, obs. F. Sardain; *RTD com.* 2009, p. 715, obs. F. Pollaud-Dulian.

¹⁴⁸ CJEU, 11 June 2020, aff. C-833/18, *Brompton c/ Chedech*, *Propr. industr.* 2020, chron. 8, F. Glaize; *D.* 2020, p. 1592, J.-C. Galloux and P. Kamina; *Propr. intell.* 2020, n° 77, p. 76, obs. P. Massot.

¹⁴⁹ U.S. Copyright Office, Circular No. 46, Copyright in commercial prints and Labels (1958). This principle can be found today in Circular No. 33: "Works not protected by copyright", available online.

¹⁵⁰ A. Lucas, A. Lucas-Schloetter and C. Bernault, *Traité de la propriété littéraire et artistique*, LexisNexis, 5^e ed., 2017, n° 67: "it seems difficult to envisage that a work of the mind can be constituted by a single word". A decision of the Austrian Supreme Court is also cited, which established the principle that "a word alone cannot constitute a literary work". (OGH (Oberster Gerichtshof), 17 Feb. 1987, *Radial*, ÖBI 1987, p. 109).

¹⁵¹ See *above*.

notably – has thus admitted, on several occasions, that titles of works or names of characters composed of one word could be original¹⁵². It is also interesting to note that among the rare decisions recorded advocating such recognition, great importance was given to the fact that these were *ex nihilo*¹⁵³ creations or terms diverted from their initial common meaning¹⁵⁴. It would therefore not be out of the question for certain fictional marks to be caught by copyright on the basis of their originality, especially when they are composed of verbal elements accompanied by figurative elements. One example is the *Starfleet* logo, which comes straight from the *Star Trek* universe,



or the *Umbrella sign*, used in the *Resident Evil* saga.



In addition to this condition of originality, the invalidity of the disputed trade mark may be claimed under the condition that an infringement of prior copyright is demonstrated. In other words, it must be proven that the disputed trade mark constitutes an infringement of the fictional trade mark, which is protected under copyright law. If the reproduction of the latter were to consist of an identical reproduction, the stakes of the demonstration would be reduced¹⁵⁵. Conversely, if the reproduction were to consist of an imitation, the infringement would have to be assessed in the light of the rules of copyright law and not of trade mark law¹⁵⁶. Moreover, the assessment will be made in the light of the rules of the legal forum from which copyright originates when it is opposed to a European Union trade mark¹⁵⁷. It is therefore irrelevant to attempt to demonstrate the existence of any likelihood of confusion between the conflicting signs¹⁵⁸.

¹⁵² T. civ. Seine, 19 Jan. 1949, *Tarzan*, *S.* 1949, 2, p. 137, note M. G.; TGI Paris, 2 March 1959, *Chéri-Bibi*, *Ann. propr. industr.* 1965, p. 66; CA Lyon, 1^{re} ch, 5 July 1979, *Clochemerle*, *JCP G* 1981, II, 19590, note R. Plaisant; *RIDA* oct. 1979, p. 147; *Ann. propr. ind.* 1981, p. 136; CA Paris, 4^e ch. B, 4 Dec. 1998, *Modulor*, *JurisData* n° 1998-023629; CA Paris, 1^{re} ch., 25 Sept. 1989, *Le chardon*, *RIDA* 2/1990, p. 207; Cass. com., 21 Jan. 2014, n° 12-25547, *Altair*.

¹⁵³ See L. Marino, Titles of works (CPI, art. L. 112-4), Fasc. 1158, *J.-Cl. Propriété littéraire et artistique*, 2015, n° 32: *Tarzan*, *Clochemerle*, *Modulor*.

¹⁵⁴ CA Paris, pôle 5, 2^e ch., 19 Apr. 2019, *Mémoire fauve*, *JurisData* n° 2019-006259 ; TGI Paris, 3^e ch., 4 Nov. 2016, *Hara Kiri*, *CCE* 2017, n° 1, comm. 2, obs. C. Caron

¹⁵⁵ V. T. civ. Seine, 19 Jan. 1949, *Tarzan*, *S.* 1949, 2, p. 137, note M. G.; TGI Paris, 2 March 1959, *Chéri-Bibi*, *Ann. propr. industr.* 1965, p. 66.

¹⁵⁶ TGI Paris, 28 March 1990, *Barbarella*, *PIBD* 1990, III, p. 553.

¹⁵⁷ See by analogy, CJEU, 5 July 2011, Case C-263/09 P, *Elio Fiorucci*.

¹⁵⁸ CA Lyon, 1^{re} ch., 5 July 1979, *Clochemerle*, *JCP G* 1981, II, 19590, note R. Plaisant.

Similar to the absolute grounds for invalidity, the solutions offered by trade mark law in the context of relative grounds for invalidity are not fully satisfactory. It is therefore clear from these developments that bad faith could be the appropriate solution, especially in view of the new dimension that case law has given to the application of this concept, in order to challenge the validity of a fictional trade mark registered without authorisation. In any event, the invalidity of a trade mark does not mean that its use is prohibited. Other solutions must be envisaged in order to sanction uses likely to infringe a fictional trade mark or resulting, on the contrary, from the use of a fictional trade mark.

II. Prohibition of contentious uses

Challenging the validity of a trade mark can call into question the exclusive right relating to it, such a step has no effect on the use that can be made of it. The problem of fictional trade marks is not limited to this simple question, as their use can be harmful when they are reproduced without authorisation by a third party or, on the contrary, when they themselves constitute the reproduction or imitation of real and earlier trade marks in fictional works. It is therefore appropriate to look at the solutions offered by trade mark law (A), but also by copyright law (B).

A. The solutions offered by trade mark law

When considering the issue of the use of a fictional trade mark, two situations must be distinguished. On the one hand, there is the situation where the fictional mark reproduces or imitates an earlier registered mark without authorisation (1). On the other hand, where the fictional mark is used without authorisation by an economic operator for the purpose of identifying, in real life, goods and services (2).

1. *The use of a fictional contentious trade mark*

Conditions for the implementation of the exclusive right. As recalled, the implementation of the trade mark right implies that a certain number of conditions must be met. The disputed use must, first of all, result from an active behaviour of its author, who must have direct or indirect control over the act of use¹⁵⁹. Secondly, it must be carried out in the course of trade, in the context of a commercial activity seeking an economic

¹⁵⁹ CJEU, 2 April 2020, Case C-567/18, *Coty Germany GmbH v Amazon Services Europe Sàrl, Amazon Europe Core Sàrl, Amazon FC Graben GmbH, Amazon EU Sàrl*, point 37, *Propr. industr.* 2020, n° 6, comm. 35, obs. A. Folliard-Monguiral; *CCE* 2020, n° 6, comm. 47, obs. P. Kamina; *RPIN* 2020, No. 4, p. 36, note C. Piedoie and L. Vauban. *Propr. intell.* 2020, n° 76, p. 121, obs. Y. Basire. See also, CJEU, 3 March 2016, aff. C-179/15, *Daimler AG c/ EGYÜD Garage*, *Comm. com. électr.* 2016, comm. 32, obs. Ch. Caron, *Propr. industr.* 2016, comm. 26, obs. A. Folliard-Monguiral, *PIBD* 2016, n° 1049, III, p. 367 points 39 and 40.

advantage and not in the private domain¹⁶⁰. Moreover, the use must be made by a third party in the context of its own commercial communication¹⁶¹. The disputed use must, moreover, be made as a trade mark, i.e. for the purpose of designating identical or similar goods or services, unless the proprietor of the earlier trade mark seeks to rely on protection by virtue of the reputation of the trade mark. Finally, it must be likely to affect the essential function of the trade mark¹⁶² - the function of guaranteeing identity of origin - or one of its other functions¹⁶³.

Fictional trade marks and lack of use as a trade mark. In view of these conditions, it seems unlikely, if not impossible, to benefit from trade mark law in order to sanction the use in a work of fiction of a fictional mark reproducing or imitating a "real" mark. Indeed, although it is conceivable that the use could be considered as being made in the course of trade, it cannot, in any event, be considered as being made as a trade mark, as the identification of fictitious products or services does not allow this pitfall to be overcome. Moreover, such use is not likely to undermine the essential function of the mark. The analogy with the case law relating to toys or scale models is particularly enlightening here. In this respect, the Court of Justice noted in the *Adam Opel* judgment that the reproduction of a trade mark on this type of object, without the authorisation of the proprietor, was not likely to undermine the function of guaranteeing identity of origin. It noted that the average consumer of products in the toy industry, normally informed and reasonably attentive and aware, is used to scale models being based on real examples and even attaches great importance to absolute fidelity to the original, so that the consumer understands that the reproduction of a third party's trade mark on such products indicates that it is a reproduction on a reduced scale of an *Opel* vehicle¹⁶⁴. Therefore, such use cannot be considered infringing.

¹⁶⁰ ECJ, 12 Nov. 2002, aff. C-206/01, *Arsenal football club*, RJD A 2003, n° 2, n° 204; *Propr. intell.* 2003, n° 7, p. 200, obs. G. Bonet; *D.* 2003, p. 755, note P. De Candé; *PIBD* 2003, n° 764, III, p. 263; *RTDE* 2004, p. 106, obs. G. Bonet; *JCPE* 2003, 1114, n° 17, obs. G. Parléani; *RTD com.* 2003, p. 415, obs. M. Luby.

¹⁶¹ CJEU, 23 March 2010, joined cases C-236/08 to C-238/08, *Google Adwords: Gaz. Pal.* 23 Apr. 2010, n° 113-114, p. 45, note V. Brunot; *RLDI* 2010/60, n° 1980, note L. Grynbaum; *RLDI* 2010/61, n° 1999, note C. Castets-Renard; *Comm. com. électr.* 2010, study 12, G. Bonet; *Comm. com. électr.* 2010, comm. 70, C. Caron; *Légipresse* 2010, n° 274, p. 158, obs. C. Maréchal; *Comm. com. électr.* 2010, comm. 88, P. Stoffel-Munck; *Propr. industr.* 2010, comm. 38, P. Tréfigny-Goy; *RTD eur.* 2010. 952, chron. E. Treppoz; *D.* 2010. 885, obs. C. Manara, p. 1971, obs. P. Tréfigny-Goy, and *D.* 2011. 911, obs. S. Durrande; *Propr. industr.* 2010, comm. 38, A. Folliard-Monguiral; *JCP* 2010, n° 23, 642, obs. L. Marino; *Europe* 2010, comm. 181, L. Idot. See. F. Pollaud-Dulian, L'emploi des marques d'autrui dans un système de référencement commercial sur Internet : *Propr. intell.* 2010, n° 36, p. 823 ; CJUE, 25 March 2010, aff. C-278/08, *Bergspechte* : *Propr. industr.* 2010, comm. 39, A. Folliard-Monguiral; *Comm. com. électr.* 2010, comm. 70, C. Caron; *D.* 2011. 908, chron. S. Durrande; CJEU, 2 Apr. 2020, Case C-567/18, *Coty Germany v/ Amazon Services Europe et a.*, *supra.*; CJEU, 22 Dec. 2022, Cases C-148/21 and C-184/21, *Christian Louboutin v/ Amazon*.

¹⁶² ECJ, 12 Nov. 2002, Case C-206/01, *Arsenal Football Club*, *supra.*

¹⁶³ ECJ, 12 Nov. 2002, Case C-206/01, *supra.* - ECJ, 18 June 2009, Case C-487/07, *L'Oréal v/ Bellure*; *Propr. intell.* 2009, n° 34, p. 655, obs. G. Bonet; *JCP* 2009, n° 31, 180, comm. L. Marino; *Propr. industr.* 2009, comm. 51, A. Folliard-Monguiral; *RLDI* 2013/91, n° 3024, obs. S. Proust - CJEU, 23 March 2010, joined cases C-236/08, C-237/08 and C-238/08, *Google France and Google*, *prec.* See also, on this issue, Y Basire, *Les fonctions de la marque : essai sur la cohérence du régime juridique d'un signe distinctif* : LexisNexis, Coll. CEIPI, 2015, n° 63.

¹⁶⁴ ECJ, 25 January 2007, Case C-48/05, *Adam Opel AG*; *D.* 2007, p. 2835, obs. S. Durrande; *RTD com.* 2007, p. 712, obs. J. Azéma; *RTDE* 2007, p. 685, obs. J. Schmidt-Szalewski; *Propr. intell.* 2007, n° 23, p. 237, obs. G. Bonet; *Propr. industr.* 2007, n° 3, comm. n° 18, obs. A. Folliard-Monguiral.

The solution is unequivocally shared by the French judges who have had occasion to affirm on several occasions that such use was in no way detrimental to the function of guaranteeing identity of origin¹⁶⁵. The owner of the *Apple* trade mark cannot, therefore, rely on its trade mark - with a reputation¹⁶⁶ - in order to have the use of the *Pear Icarly* sign sanctioned under trade mark law (¹⁶⁷).



The use of a fictional trade mark, which is limited to a work of the mind, cannot be sanctioned under trade mark law. What happens when it is the fictional trade mark that is reproduced or imitated, without authorisation, by an economic operator?

2. *The litigious use of a fictional trade mark*

The absence of registration of the fictional mark. The fictional trade mark is, by definition, not registered. However, it cannot be ruled out that it may be used on derivative products, as may the names of intellectual works or characters. However, such use is not sufficient to bring an infringement action and claim any exclusive right. It should be remembered that Articles 10 of the Trade mark Directive and 9 of the EUTMR specifies that trade mark rights result from the sole registration of the sign¹⁶⁸.

Since registration is lacking in such cases, it may be tempting once again to invoke the well-known trade mark regime.

Well-known trade mark. In addition to the fact that it can constitute a prior claim for identical or similar goods and services, the well-known trade mark, understood within the meaning of Article 6*bis* of the Paris Convention, can be invoked to engage the civil liability of the author of a litigious use, both within and outside the speciality. Could the owner of a work of the mind then rely on it to sanction the use of a fictional trade mark in reality?

¹⁶⁵ CA Paris, 31 Oct. 2008, *JurisData* n° 2008-372349; *PIBD* 2009, III, p. 762; Cass. crim., 24 Sept. 2014, n° 13-83.490, *JurisData* n° 2014-021754; *PIBD* 2014, n° 1017, III, p. 886; *Propr. industr.* 2015, comm. 2, P. Tréfigny; *RTD com.* 2014, p. 888, B. Bouloc; *Propr. intell.* 2015, n° 54, p. 92, obs. J. Canlorbe; *Légipresse* 2015, n° 332, p. 627, obs. Y. Basire. *Contra*: TGI Paris, 10 Feb. 2011, *PIBD* 2011, n° 949, III, p. 651; TGI Paris, 6 May 2011, *PIBD* 2011, n° 949, III, p. 648.

¹⁶⁶ An action based on a reputed trade mark is subject to the same conditions of enforcement. See EUTMR, Art. 9(2)(c).

¹⁶⁷ D. Schneider, *iCarly*, 2007-2012.

¹⁶⁸ V. Y. Basire, "Les atteintes au droit de marque dans l'ordonnance du 13 novembre 2019", in *Le nouveau droit des marques en France*, Y. Basire and J. Canlorbe (dir.), Coll. CEIPI, LexisNexis, 2021, p. 107.

For example, Article L. 713-5 of the French Intellectual Property Code, in the version resulting from the Ordinance of 13 November 2019¹⁶⁹ transposing Directive 2015/2436¹⁷⁰, provides:

"The use in the course of trade, for goods or services, of a well-known trade mark within the meaning of Article 6 *bis* of the Paris Convention for the Protection of Industrial Property, without the authorization of the proprietor, shall not constitute an infringement but shall give rise to civil liability:

1° A sign identical to the mark and used for goods or services identical to those for which the mark is well known;

2° A sign identical or similar to the mark and used for goods or services identical or similar to those for which the mark is well known, if there is a likelihood of confusion in the minds of the public, including the likelihood of association of the sign with the mark;

3° a sign identical or similar to the mark and used for goods or services identical, similar or dissimilar to those for which the mark is well known, if such use of the sign, without due cause, takes unfair advantage of, or is detrimental to, the distinctive character or notoriety of the mark".

Fictional trade marks and the well-known trade mark regime. However, several conditions must be met in order to benefit from this provision. Firstly, the "owner" of the well-known trade mark must prove that his sign is well-known, independently of the work in which it is integrated. As we have already mentioned, it is up to him to show that his mark is known by a large proportion of the relevant public, in accordance with the case law of the Court of Justice¹⁷¹. However, before doing so, it is essential to ascertain the nature of the fictional mark. Is it possible to qualify it as a trade mark within the meaning of trade mark law? The answer to this question will depend on its use made. Thus, when the use of the fictional trade mark is limited to the work of the mind, it cannot be qualified as use as a trade mark and, consequently, cannot benefit from the provisions of Article L. 713-5 of the French Intellectual Property Code.

The solution might be different if the fictional trade mark were to break the fourth wall in order to be used for derivative products. In such a case, which is not residual, it would be excessive to assert, in a peremptory manner, that such use is made as a trade mark. Let us recall once again that the European Court of First Instance refused to consider the sign *Dr. No* as a trade mark, notwithstanding the fact that it is used on a large number of derivative products¹⁷². Beyond the arguments developed in this decision, the fictional mark could, in

¹⁶⁹ Ordinance No. 2019-1169 of 13 November 2019 on trade marks or service marks.

¹⁷⁰ Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trade marks.

¹⁷¹ ECJ, 22 Nov. 2007, Case C-328/06, *Nieto Nuño*; *Propr. intell.* 2009, n° 30, p. 91, obs. G. Bonet; *CCE* 2008, n° 2, comm. n° 19, obs. C. Caron; *Propr. industr.* 2008, n° 1, comm. n° 2, obs. A. Folliard-Monguiral; *Europe* 2008, n° 1, comm. n° 23, obs. L. Idot.

¹⁷² GC, 30 June 2009, Case T-435/05, *Danjaq. LLC v OHIM and Mission Productions Gesellschaft für Film-, Fernseh- und Veranstaltungsproduktion mbH*, cited above.

this context, be opposed because of its exclusively decorative character, thus preventing it from fulfilling the function of guaranteeing identity of origin.

However, this is not an insurmountable obstacle. On the one hand, unlike the name of a character or the title of a work of the mind, we are dealing here with signs used as trade marks in a fictional universe. This primary function could be useful in demonstrating that a fictional mark can have a distinctive function in reality when applied to derivative products. On the other hand, the owner of the intellectual work could try to invoke the acquisition of distinctiveness through the use of his sign, as in the case of a registered trade mark¹⁷³. In any event, these are avenues of reflection already being explored in the United States, as evidenced by the rare decisions handed down on the subject.

Thus, in a case concerning the use of the *Daily Planet* sign - the newspaper in which Clark Kent and Lois Lane officiate - the New York District Court noted that DC Comics, Inc. "licenses the Superman story as a package"¹⁷⁴ [...] plaintiff has, through the Licensing Corporation of America, engaged in extensive licensing of the Superman character as well as the Superman story covering a myriad of products. From the numerous exhibits presented and the testimony elicited, it is clear that the *Daily Planet* has played a key role in many of these licensing agreements. Despite the fact that the *Daily Planet* has never individually been the subject of one of these agreements, it has been prominently displayed on many of the products emanating from these agreements"¹⁷⁵. Consequently, the use by a third party of the *Daily Planet* sign for a newspaper had to be sanctioned because of the risk of confusion that it could cause with the fictional trade mark.

In the same vein, in a *Viacom* case concerning the sign *The Krusty Krab*, taken from the SpongeBob SquarePants universe and used by a third party without authorisation for a restaurant, the US Court of Appeals for the Fifth Circuit affirmed that the fictional mark "has acquired distinctiveness through secondary meaning"¹⁷⁶. In doing so, it noted that the sign has appeared in more than 80% of the episodes since 1999. *The Krusty Krab* is therefore a central element of the SpongeBob universe. Viacom, the rights holder, has also "earned millions on licensed products that display The Krusty Krab mark". The US Court of Appeals for the Fifth Circuit also noted that the mark has been used extensively in promotional activities. Moreover, it is often referred to in the press: "The mark frequently appears on the "SpongeBob SquarePants" social media platforms and is integrated into the SpongeBob website and mobile app". Therefore, the sign *Krusty Krab* cannot simply be considered as a restaurant in a cartoon, but also as a mark identifying the origin of goods. Thus the Court held that "third parties cannot appropriate the goodwill and reputation of The Krusty Krab by naming a restaurant The Krusty Krab absent a showing that the restaurant was developed in a context sufficient to avoid any likelihood of consumer confusion".

¹⁷³ See *above*.

¹⁷⁴ *DC Comics, Inc. v. Powers*, 465 F. (N.D.Y. 1978).

¹⁷⁵ *Ibid*.

¹⁷⁶ *Viacom Int'l Inc. v. IJR Capital Invs. , LLC*, 242 F. Supp. 3d 563 (S.D. Tex. 2017), aff'd 891 F.3d 178 (5th Cir. 2018).

The scope of protection. Once this double hurdle - the notoriety and the perception of the sign - has been overcome, the owner of the well-known trade mark is in a position to take full advantage of Article L. 713-5 of the French Intellectual Property Code.

However, one question remains unanswered. To which speciality, to which goods and services should the well-known trade mark be linked? Logic, and more importantly legal rigour, dictates that the speciality of the well-known trade mark must be identified in relation to the goods and services for which it is used in reality and not in the work of the mind¹⁷⁷. It could not be otherwise: as the well-known trade mark is not registered, only the use of the trade mark should make it possible to determine its speciality¹⁷⁸, in the same way as other signs used in business life, such as company names, trade names, signs and domain names. This seems to be confirmed by American case law, as one author analyses: "The fictional mark functions as an actual mark, albeit for entertainment services rather than the fictional goods or services it identifies in its original context"¹⁷⁹. Therefore, the owner of the well-known mark could claim protection as such on the basis of the derivative products for which it is exploited.

However, unlike in the case of opposition or cancellation, the well-known mark could not only be invoked in the speciality, i.e. against a disputed use relating to identical or similar goods and services, but also beyond this speciality, when the disputed use concerns different goods and services.

However, the demonstration of infringement will not follow the same logic, depending on the circumstances and the choice made by the proprietor. The latter could, in fact, attempt to demonstrate the existence of a likelihood of confusion between the conflicting signs, in accordance with the precepts laid down by the Court of Justice¹⁸⁰. However, this proof can only be used against a disputed use in the same speciality¹⁸¹. It could also, and more simply, rely on the rules governing the protection of the reputed trade mark, both within and outside the speciality.

Article L. 713-5, 3° of the French Intellectual Property Code provides, in the manner of Articles 10, § 2, c) of the Trade mark Directive and 9, § 2, c) of the EUTMR related to the trade mark with reputation, that a well-known trade mark is infringed by the unauthorised use of "a sign identical or similar to the trade mark and used for goods or services identical, similar or not similar to those for which the trade mark is well-known, if such use of the sign, without due cause, takes unfair advantage of, or is detrimental to, the distinctiveness or notoriety of the trade mark". It appears, therefore, that the notion of likelihood of confusion is absent from the provision. The implementation of the specific protection

¹⁷⁷ AIPPI, Yearbook 1991/1, p. 271. A well-known mark is defined as "a mark which is known to a large section of the public concerned with the production or trade or use of the goods in question and which is clearly perceived as indicating a particular origin of those goods".

¹⁷⁸ V. CA Douai, 1st ch. 2^e sect. 4 June 2020, n° 18/06301, *Dalloz IP/IT* 2020, p. 635, obs. I. Hegedus.

¹⁷⁹ L. Pearson, "The real life of fictional trade marks", *op. cit.* at 854.

¹⁸⁰ See *above*. V. ECJ, 28 Sept. 1998, case C-39/97, *Canon*, pt. 18, *RTDE* 2000, p. 100, obs. G. Bonet; ECJ, 11 Nov. 1997, case C-251/95, *Sabel v. Puma Dassler Sport*, pt. 18, *JCP E* 1998, n° 25, p. 988, obs. C. Gavalda and G. Parléani; *RTDC* 1998, p. 740, obs. M. Luby; ECJ, 22 June 1999, case C-342/97, *Lloyd*, *RTD eur.* 2000. 108, obs. G. Bonet.

¹⁸¹ CPI, art. L. 713-5, 1° and 2°.

granted to the well-known trade mark implies, on the contrary, to demonstrate that the public establishes a link between the conflicting signs¹⁸². In other words, the second –and conflicting mark must suggest to the average consumer the first and well-known trade mark. In the absence of such a link, the use of the conflicting later mark cannot be considered wrongful or prejudicial.

Like the likelihood of confusion, the existence of the link is assessed globally, taking into account all relevant factors¹⁸³: the degree of similarity between the conflicting marks, the nature of the goods or services for which the conflicting marks are respectively registered, the degree of proximity or dissimilarity of those goods or services as well as that of the relevant public, the intensity of the earlier reputed mark, the degree of distinctiveness, intrinsic or acquired through use, of the earlier mark or, alternatively, the existence of a family of marks¹⁸⁴.

Once this link has been established, it must be shown that the disputed use constitutes a fault or causes damage to the owner of the well-known trade mark. The fault consists, in this context, in taking undue advantage of the distinctive character or reputation of the well-known trade mark. In other words, the third party must not be guilty of an act of parasitism, in that it has placed itself in the wake of the well-known trade mark in order to take advantage of the commercial, advertising or qualitative efforts of its owner¹⁸⁵. The fault, like the link, must be assessed on the basis of all the relevant factors in the case. However, it should be recalled that where the trade mark is exceptionally well known, the fault may be found without the need to rely on other factual elements¹⁸⁶.

In view of these elements, the use of a fictional trade mark - without authorisation - could legitimately be sanctioned on this basis. Indeed, there is little doubt as to the approach taken by a third party consisting in using a sign derived from a work of the mind, the idea being for him to benefit from the image conveyed by this universe.

Regarding damage, it can take two forms: dilution and tarnishment. Dilution damage occurs when the ability of the mark to identify the goods or services for which it is registered and used as originating from the owner of the mark is weakened, as the use of the later mark leads to a dispersion of the identity of the earlier mark and its hold on the public's mind¹⁸⁷. This is particularly the case where the earlier mark, which had an immediate association with the goods or services for which it is registered, is no longer able to do so¹⁸⁸. As with other forms of infringement, dilution damage must be assessed globally, it being specified

¹⁸² ECJ, 27 Nov. 2008, Case C-252/07, *Intel Corporation*, *Propr. industr.* 2009, no 1, comm. 3, obs. A. Folliard-Monguiral; *Comm. com. élect.* 2009, no 2, comm. 14, obs. Ch. Caron; *RTDE* 2008, p. 938, obs. J. Schmidt-Szalewski; *Propr. intell.* 2010, No. 34, p. 651, note G. Bonet.

¹⁸³ *Ibid.*

¹⁸⁴ V. GC, 5 July 2016, Case T-518/13, *Future Enterprises v. EUIPO - McDonald's International Property*.

¹⁸⁵ ECJ, 18 June 2009, Case C-487/07, *L'Oréal v Bellure*, *supra*.

¹⁸⁶ See in relation to a trade mark of exceptional reputation, GC, 2 Oct. 2015, aff. T-624/13, *Darjeeling*, *Propr. intell.* 2016, no 58, p. 86, obs. Y. Basire.

¹⁸⁷ Initially appearing in Germany (see a decision of the *Ladgericht Elberfeld* of 11 September 1924 concerning the usurpation of the trade mark "Odol" (toothpaste) by a manufacturer of cutlery), the concept of dilution was theorised by the American author Schechter: F. I. Schechter, "The rational basis of trade mark protection", *Harvard Law Review*, Vol. 40, No. 6 (Apr., 1927), p. 813.

¹⁸⁸ ECJ, 27 Nov. 2008, Case C-252/07, *Intel*, *supra*.

that repute - even if exceptional - and the link that the relevant public can establish between the conflicting marks are not sufficient to characterise dilution damage¹⁸⁹. The Court of Justice requires proof that, following the use of the second mark, there has been a change in the economic behaviour of the average consumer of the goods or services for which the earlier mark was used, or that there is a serious risk that such a change will occur in the future¹⁹⁰. As this proof is particularly difficult - if not impossible - to provide¹⁹¹, it would be preferable for the owner of a well-known mark from a fictitious universe to try to rely on the prejudice of tarnishment.

This occurs when the goods or services for which the identical or similar sign is used by the third party can be perceived by the public in such a way that the attractiveness of the trade mark is diminished. It is akin to damage to the brand image. Tarnishment can be considered in three cases: when the well-known trade mark is linked to products that are of poor quality or give rise to undesirable or dubious mental associations that clash with the associations or image generated by the legitimate use of the trade mark of its owner; when it is linked to products that are incompatible with the quality and prestige attached to the trade mark, although this is not in itself an unhealthy use of the trade mark; when its nominal or figurative part is modified or altered in a negative form¹⁹². Such hypothesis could find expression in the case of fictional marks. It cannot be ruled out that the image of the well-known fictional mark is tarnished as a result of use in connection with goods which give rise to undesirable associations¹⁹³ or modification of the sign in a negative sense¹⁹⁴.

Although the levers for action are limited, trade mark law through the well-known trade mark regime offers a solution to sanction the use of a fictional trade mark, without authorisation, in reality. What about the levers that can result from copyright?

B. Copyright solutions

Copyright, insofar as it can treat a distinctive sign as a work of the mind, could be invoked not only against a disputed fictional trade mark, but also in order to have the disputed use of a fictional trade mark in reality sanctioned (1), provided, however, that the exception of parody is not invoked (2).

¹⁸⁹ V. GC, 25 May 2005, Case T-67/04, *Spa Monopole v OHIM*, pt. 44. See in the same sense, CFI, 22 March 2007, Case T-215/03, *Vips*, pt. 50.

¹⁹⁰ ECJ, 27 Nov. 2008, *supra*, pt. 77. V. CJEU, 14 Nov. 2013, aff. C-383/12 P, *Environmental Manufacturing LLP c/ OHIM*, *Propr. industr.* 2014, n° 1, comm. 5, obs. A. Folliard-Monguiral

¹⁹¹ V. J. Passa.

¹⁹² OHIM, Rec. 25 Apr 2001, Case R 283/1999-3, *GDPR* 2001, No 725, III, p. 398.

¹⁹³ *Ibid.* In this case, the Board of Appeal considered that the use of the trade mark Hollywood for tobacco products could be detrimental to the image of the trade mark Hollywood registered for chewing gum.

¹⁹⁴ CA Rennes, 27 Apr. 2010, No. 09/00413, *PIBD* 2010, No. 922, III, p. 493; *Propr. industr.* 2011, comm. 2, note by P. Tréfigny (concerning the use of the signs *Petit Chavire*, *Le Mauvais goût du large*, *Thon au Fuel*).

1. Copyright infringement

An original distinctive sign. Sanctioning the contentious use of a fictional trade mark and the use of a contentious fictional trade mark as an infringement of copyright implies that the distinctive sign serving as a basis for the infringement action can be qualified as a work of the mind. In other words, the sign in question must also qualify as an original work. A *work is original* when it constitutes "an intellectual creation specific to its author"¹⁹⁵, implying that he has made free and creative choices reflecting his/her personality¹⁹⁶. As already mentioned, although this may be an obstacle that cannot be overcome for some signs that are considered too simple, others, such as figurative signs or signs representing the packaging of a product, may still be considered original¹⁹⁷. Once this obstacle has been overcome, it is still necessary to consider the form(s) of copyright infringement.

Infringement of economic rights. There is little doubt that the contentious use of a fictional trade mark in reality or the use of a contentious fictional trade mark, reproducing or imitating a trade mark - a work of the mind - in a work of fiction, may infringe, first of all, the author's economic rights and, more particularly, the right of reproduction and the right of representation, which constitute the most traditional prerogatives of the author¹⁹⁸.

The reproduction right is defined as the material fixation of the work by any process that allows it to be communicated to the public in an indirect way¹⁹⁹. Reproduction therefore implies the use of a medium interposed between the work and the public. The right of representation is defined as the right to authorize the communication of the work to the public by any means, such as public recitation, lyrical performance, dramatic representation, transmission in a public place of the work on television or, again, television broadcasting²⁰⁰. In other words, performance means the public execution of the work, whether its transmission to the public is direct - theatrical or musical performance - or indirect - by television broadcasting.

These prerogatives are the prerogative of the author or, more generally, of the holders of the rights - right holders or successors in title. Consequently, the mere reproduction or representation of a fictional trade mark in reality or of a real trade mark in a work of fiction, both of which are protected by copyright, without the authorisation of the author or the holder of the rights could constitute an infringement. Articles 2 and 3 of the Directive 2001/29/EC on the harmonization of certain aspects of copyright and related rights in the information society provide that the Member states shall provide for the exclusive right to authorize or prohibit reproduction and any communication to the public of their work. In

¹⁹⁵ CJEU, 16 July 2009, Case C-5/08, *Infopaq*, point 37, CCE 2009, comm. 97, obs. Caron; *Propr. intell.* 2009, p. 379, obs. V.-L. Benabou; *JCPE* 2010, 1691, n° 11, obs. F. Sardain; *RTD com.* 2009, p. 715, obs. F. Pollaud-Dulian.

¹⁹⁶ CJEU, 11 June 2020, aff. C-833/18, *Brompton c/ Chedech*, *Propr. industr.* 2020, chron. 8, F. Glaize; *D.* 2020, p. 1592, J.-C. Galloux and P. Kamina; *Propr. intell.* 2020, n° 77, p. 76, obs. P. Massot.

¹⁹⁷ See *above*.

¹⁹⁸ C. Caron, *Droit d'auteur et droits voisins*, LexisNexis, 6^e éd., 2020, n° 312.

¹⁹⁹ CPI, art. L. 122-3.

²⁰⁰ CPI, art. L. 122-2.

the same sense, Article L. 122-4 of the French Intellectual Property Code states that any reproduction or representation of a work in its entirety made without the consent of the author or his successors or assigns is unlawful²⁰¹. Article L. 335-2 of the same Code, relating to the criminal aspect of copyright infringement, completes this provision by indicating that any reproduction, representation or dissemination, by any means whatsoever, of a work of the mind in violation of the author's rights constitutes an infringement offence. Litigation concerning reproductions of intellectual works is plentiful and has been the subject of particularly abundant case law²⁰², it being specified that no commercialization is required in order to sanction such behaviour²⁰³.

The protection conferred by copyright allows, moreover and fortunately, to embrace hypotheses other than those of simple identical reproduction. Otherwise, as some authors have pointed out, the protection conferred would be useless in that it would *be* "sufficient to escape the wrath of the law by making a few minor modifications, changing a few words for example"²⁰⁴. Article L. 122-4 of the French Intellectual Property Code thus provides that the partial reproduction or representation of a work may also be considered unlawful. This principle was recalled by the Court of Justice in its *Infopaq* decision²⁰⁵. Copyright thus allows not only partial reproductions and representations of a work of the mind to be sanctioned, but also imitations. Partial reproduction will be wrongful if it is shown that it relates to the original elements of the original work²⁰⁶.

In the latter case, although the term "*imitation*" is used, it is important to depart from the precepts applied in trade mark law. There is no need to try to show that there is any risk of confusion in the mind of the consumer, which means taking into account the overall impression created by the signs in question²⁰⁷. On the contrary, in copyright law, case law has established the principle that infringement is assessed solely on the basis of similarities and not differences²⁰⁸. However, legal scholars have pointed out the difficulties associated with this method of assessing infringement, which could lead to a quasi-systematic recognition of infringement of rights due to the standardisation of works²⁰⁹. In this respect, it appears that the case law shows a certain flexibility, by characterising infringement when the essential characteristics of the original form of the imitated work are found, without

²⁰¹ CPI, art. L. 122-4.

²⁰² See, for example, CA Grenoble, 18 Jan. 2001, CCE 2001, comm. 59, note. C. Caron; Cass. com, 11 Jan. 2005, CCE 2005, comm. 37, note. C. Caron; CA Nîmes, 30 Nov. 2004, CCE 2005, comm. 187, obs. C. Caron. See on this issue, C. Caron, *Droit d'auteur et droits voisins*, *op. cit.*, n° 534.

²⁰³ *Ibid.*

²⁰⁴ A. Lucas, A. Lucas-Schloetter and C. Bernault, *Traité de la propriété littéraire et artistique*, LexisNexis, 5^e éd., 2017, n° 325.

²⁰⁵ CJEU, 16 July 2009, case C. 5/08, *Infopaq*, point 27, CCE 2009, comm. 97, obs. C. Caron; *Propr. intell.* 2009, p. 379, obs. V.-L. Benabou; *JCP E* 2010, 1691, n° 11, obs. F. Sardain; *RTD com.* 2009, p. 715, obs. F. Pollaud-Dulian.

²⁰⁶ A. Lucas, A. Lucas-Schloetter and C. Bernault, *Traité de la propriété littéraire et artistique*, *op. cit.*, 2017, n°326.

²⁰⁷ Cass. com. 8 Apr. 2014, *Propr. intell.* 2014, n° 52, p. 273, obs. A. Lucas. See on this issue, M. Vivant and J.-M. Bruguière, *Droit d'auteur et droits voisins*, Dalloz, Précis, 4^e éd., 2019, n°1081.

²⁰⁸ Cass. civ. 1^{re} ch. 4 Feb. 1992, *GAPI*, *Dalloz*, 1^{re} éd. 2004, n° 30, comm. Y. Monelli. See also CA Paris, 9 May 2007, CCE 2007, comm. 147, obs. C. Caron.

²⁰⁹ M. Vivant and J.-M. Bruguière, *Droit d'auteur et droits voisins*, *op. cit.* n°1081; C. Caron, *Droit d'auteur et droits voisins*, *op. cit.*, n°535.

authorisation, in another creation²¹⁰. Thus, as two authors note, such an analysis "necessarily requires the judge to balance similarities and differences"²¹¹ .

Applied to fictional trade marks, this method of assessment would involve, as in trade mark law, comparing the conflicting signs/works with regard to their similarities and differences, taking into account their distinctive/original characteristics. However, unlike trade mark law, it will not be useful to seek to find a likelihood of confusion in the mind of the average consumer and, moreover, to compare any speciality beforehand, as copyright is, unlike trade mark law, an "absolute" right which does not exist in relation to goods and services.

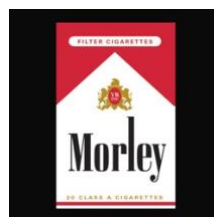
In the light of these different elements, could it not be considered that this sign,



the logo of the United States Space Force, constitutes a copyright infringement of the famous Starfleet emblem from the *Star Trek* Universe ?



What about the Morley cigarette pack,



compared to a Marlboro cigarette packs?



²¹⁰ *Ibid.*

²¹¹ M. Vivant and J.-M. Bruguière, *Droit d'auteur et droits voisins, op. cit.* , n°1082.

Infringement of moral rights. In addition to an infringement of economic rights, the contentious use of a fictional trade mark and the use of a contentious fictional trade mark may also constitute an infringement of the author's moral right to respect. This infringement may concern both the right to respect for the author's name and the right to respect for the work.

With the right to respect for the author's name²¹² - also known as the right of authorship - the author of the work can claim that his or her name be associated with the work, so that the public can establish the link between the work and its author²¹³. The author may, on the contrary, choose a pseudonym or anonymity. It goes without saying that when a fictitious trade mark is used in reality without authorisation and without reference to its author, an infringement of the right of authorship must be established. The same applies if a trade mark/work is used without such reference in a work of fiction.

The right of integrity of the work, referred to in Article 6*bis* of the Berne's Convention – and in Article L. 121-1 of the French Intellectual Property Code –, allows the author to demand that the work be communicated to the public as he or she wishes. Case law has had occasion to affirm that this is an "absolute right to oppose any alteration, however slight, likely to alter its character and distort its thought"²¹⁴. These alterations may be material and concern the integrity of the work²¹⁵, but also moral or "spiritual" and therefore concern the spirit of the work. This last type of infringement is qualified by the doctrine of "contextual" infringement²¹⁶, in that it makes it possible to sanction the use of a work which distorts it or which affects the perception "that the author intends to give to the public"²¹⁷. Such an infringement can be found when the work is used in circumstances that depreciate, denigrate or, quite simply, affect its meaning. Thus, the use of a work for advertising purposes²¹⁸, for electoral purposes²¹⁹ or in a work of an erotic nature²²⁰ has been sanctioned in this respect. Consequently, the author of a fictional trade mark could easily claim that the spirit of his work has been infringed in order to prohibit and punish the use of this sign in reality for goods or services. This infringement would result, on the one hand, from the commercial approach and, on the other hand, from the nature of the goods and services which could prove to be in conflict with the spirit of the fictional mark. Once again, the example of the imitation *Starfleet* logo deserves to be cited. It is unlikely that this imitation, used to identify the United States Space Force under the Trump administration, is in line with *Starfleet's* philosophy, which, despite its acknowledged defensive and even offensive role, is primarily concerned with exploring the Galaxy without any warlike intent. The same

²¹² CPI, art. L. 121-1, para. 1.

²¹³ C. Caron, *Droit d'auteur et droits voisins*, *op. cit.*, n° 272.

²¹⁴ CA Paris, 20 Nov. 1935, S. 1936, 2, 170.

²¹⁵ A. Lucas, A. Lucas-Schloetter and C. Bernault, *Traité de la propriété littéraire et artistique*, *op. cit.* 2017, n° 617 et seq.

²¹⁶ *Ibid.*

²¹⁷ *Ibid.*

²¹⁸ CA Paris, Pôle 5, 11 June 2014, *JurisData* n° 1997-022411; CA Paris, Pôle 5, 19 June 2015, *Propr. intell.* 2015, p. 412, obs. J.-M. Bruguière.

²¹⁹ CA Versailles, 1^{re} ch., 20 Dec. 2001, *RIDA* 2002, n° 2, p. 448 ; *Propr. intell.* 2002, n° 4, p. 55, obs. A. Lucas.

²²⁰ CA Paris, 4^e ch., 14 June 1993, *JurisData* n° 1993-022088.

observation can be made with regard to fictional trade marks that are identical to or imitate a real trade mark in an inappropriate context.

One example is the sketch by the French humorists Les Nuls, in which the fictional brand *Toniglandyl*, an imitation of the brand *Tonigencyl*, is promoted,



and at the end of which Alain Chabat, a French actor, concludes with the following slogan: "Toniglandyl. With this, my cock is concrete". Provided that the *Tonigencyl* trade mark is also protected by copyright, would it not be possible to invoke the infringement of respect for the work in such a case? If the question remains open, it naturally leads to the question of the defendant's ability, in such circumstances, to invoke the parody exception.

2. *The parody exception*

Parodic fictional trade marks. There are many examples of brands being parodied in works of fiction. In addition to *Toniglandyl*, there is *Adadas*, the brand name of the jogging suit of Mr. Megot, the sports teacher in *The Petit Spirou*, *Parkerman*, the brand name of a fountain pen used by Mr de Mesmaeker in *Gaston Lagaffe*, *Chryslus*, the brand name of a car manufacturer in the game *Fallout* or *Paris Flash*, the brand name of a magazine in *Tintin*. There are just as many examples of fictional brands parodied by economic operators. One thinks, in particular, of the misappropriation of the *Jurassic Park* or *Ghostbusters* signs which have been - and still are - the subject of misappropriation.

This observation naturally leads to the question of whether it is possible, in this context, to invoke the exception of parody, as envisaged in Article 5, § 3, k), of the Directive 2001/29/EC on the harmonization of certain aspects of copyright and related rights in the information society in order to escape the complaint of infringement.

The parody exception and freedom of expression. The parody exception refers to the use of a work of the mind for humorous purposes. It is rooted in freedom of expression, as European Union judges have stated. In a *Deckmyn* judgment, the Court of Justice stated that in order to better understand the objectives pursued by such an exception, it was necessary to refer to the objectives pursued by Directive 2011/29. Among those objectives is that of achieving harmonisation which contributes to the application of the four freedoms of the internal market and which relates to respect for the fundamental principles of law and, in particular, of property, including intellectual property, and of freedom of

expression and the public interest: "It is common ground that parody constitutes an appropriate means of expressing an opinion"²²¹.

Moreover, the concept of parody is an autonomous concept in European law²²², which is why it is necessary to turn to the case law of the Court of Justice in order to determine its contours.

The conditions for the parody exception. The Court of Justice, again in its *Deckmyn* judgment, identifies several conditions for the application of the parody exception.

Firstly, the Luxembourg judges note that the essential characteristic of parody is that it evokes an existing work²²³. How could it be otherwise? As Professor Caron points out, this is the primary purpose of parody: "without the evocation of a work, there is no parody!"²²⁴

However, secondly, the parody must have perceptible differences from the parodied work²²⁵. In other words, while the parody must necessarily evoke a primary work, it must not generate any "risk of confusion"²²⁶ in the public's mind. Otherwise, the public would be led to believe that it is dealing with a work that is merely modified and not parodied.

Thirdly, the parody must constitute a manifestation of humour or mockery²²⁷. Such a condition seems to exclude parodies that are part of a more serious context²²⁸ - which in the end are not parodies -.

Fourthly, the parody exception must respect a fair balance between, on the one hand, the interests and rights of authors and, on the other hand, the freedom of expression of the user of a protected work availing itself of the parody exception²²⁹. Thus, while the exception imposes on the author an infringement of the right to respect for the work, this must be measured and the parody must not lead to an excessive distortion of the work²³⁰.

Finally, it is irrelevant whether the parody is itself original, whether it ignores the right of authorship²³¹ or whether it is commercially exploited²³².

²²¹ CJEU, gde ch. 3 Sept. 2014, aff. C-201/13, *Deckmyn*, pt. 25; *JurisData* n° 2014-022523; *Propr. intell.* 2014, n° 53, p. 393, obs. J.-M. Bruguière; *CCE* 2014, n° 11, comm. 82, note C. Caron; *RIDA* 4/2014, p. 387, obs. P. Sirinelli; *RTD com.* 2014, p. 815, obs. F. Pollaud-Dulian; *D.* 2014, p. 2097, note B. Galopin; *Légipresse* 2014, p. 604, note N. Blanc; *JCP E* 2015, 1389, n° 7, obs. A. Zollinger; *RLDI* 2014/108, 3583, obs. C. Castets-Renard, pt 25.

²²² *Ibidem*, pt. 15.

²²³ *Ibidem*, pt. 20.

²²⁴ C. Caron, obs. under CJEU, gde ch., 3 Sept. 2014, aff. C-201/13, aforementioned, *CCE* 2014, n° 11, comm. 82.

²²⁵ CJEU, Grand Chamber, 3 Sept. 2014, Case C-201/13, *Deckmyn*, *supra*, pt. 20.

²²⁶ V. C. Caron, *Droit d'auteur et droits voisins*, *op. cit.*, n° 397. V. CA Paris, 18 Feb. 2011, n° 09/19272, *CCE* 2012, comm. 1, obs. C. Caron; Cass. civ. 1st ch. 10 Sept. 2014, n° 13-14.629 which expressly refers to "the absence of risk of confusion".

²²⁷ CJEU, Grand Chamber, 3 Sept. 2014, Case C-201/13, *Deckmyn*, *supra*, pt. 20.

²²⁸ CA Versailles, 17 March 1994, n° 10041/92, D. 1995, somm. p. 56, obs. C. Colombet; CA Riom, 15 Sept. 1994, D. 1995, jurispr.p. 429, obs. B. Edelman.

²²⁹ CJEU, Grand Chamber, 3 Sept. 2014, Case C-201/13, *Deckmyn*, *supra*, pt. 27.

²³⁰ A. Lucas, A. Lucas-Schloetter and C. Bernault, *Traité de la propriété littéraire et artistique*, *op. cit.*, 2017, n° 485.

²³¹ CJEU, Grand Chamber, 3 Sept. 2014, Case C-201/13, *Deckmyn*, *supra*, pt. 21.

²³² A. Lucas, "Droit des auteurs - Droits patrimoniaux - Exceptions au droit exclusif - Étude analytique des exceptions", *JCl Civil Annexes - Propriété littéraire et artistique*, 2022, n° 117.

Fictional trade marks tested against the parody exception. In the light of the Court of Justice's findings in the *Deckmyn decision*, it seems possible to rely on the parody exception in order to escape the infringement charge in the case of disputed use of a fictional mark or the use of a fictional disputed mark. However, it cannot be said that the exception can be applied generally, as the Court of Justice has stated that all the circumstances of the case must be taken into account in order to determine whether the conditions for the parody exception are met²³³. Thus, we could undoubtedly conclude that the use of the *Toniglandyl* sign or the *Adadas* sign constitutes "lawful" parodies, in that it makes it possible to evoke an existing work, while presenting perceptible differences with respect to it, and this in a humorous context. Such a conclusion could also be drawn in the case of misappropriation of fictional trade marks by economic operators in order to sell products or services. More problematic are "parodies" which are made in a serious context and whose sole purpose is to imitate real or fictional trade marks. Examples include the fictional cigarette brand *Morley*, which is based on the visual identity of the *Marlboro* brand, or the sign used by the United States Space Force, which, as we have already seen, bears a striking resemblance to the *Starfleet* logo²³⁴. The parody exception cannot, therefore, be used in every case where a fictional trade mark is involved, as its application must be assessed on a case-by-case basis.

Although it is the subject of a limited, if not non-existent, litigation in Europe and has been ignored by the legal profession up to now, the subject of fictional trade marks deserves special attention. It is clear from these developments that the issue - or rather the issues - are particularly complex: complex in terms of the uses concerned; complex in terms of the responses that can be provided.

We have found that the unauthorised registration of a fictional trade mark to identify real goods or services can hardly be challenged, the appropriate solution being, in all likelihood, to invoke the complaint of bad faith at the time of filing. However, we were given the opportunity to recall some essential principles regarding distinctiveness, with greater vigilance on the part of the offices being required in the case of pop culture trade marks more generally. Beyond these considerations related to the existence of the trade mark right, we also found that the trade mark right would most often fail to prevent the use of a disputed fictional mark or the disputed use of a fictional trade mark. Copyright law could, however, come into play, provided that the earlier sign can also be qualified as a work of the mind, that the infringement is established in accordance with the known precepts of copyright law and, finally, that the defendant cannot rely on the parody exception. Thus, although the obstacles are numerous, intellectual property rights can provide answers to the problems generated by fictitious trade marks. It is not excluded, moreover, that ordinary liability law - and in particular unfair competition in its parasitic aspect - may take over. In any case, these are avenues for reflection for pop culture "professionals" that deserve to be tested in the context of litigation.

²³³ CJEU, gde ch., 3 Sept. 2014, aff. C-201/13, *Deckmyn*, prec.

²³⁴ See *above*.