Branderella: trade marks and fictional characters

by Eleonora Rosati*

Abstract

Different IP rights are available for the protection of fictional characters. As far as copyright is concerned, doubts may however subsist regarding the classification of characters as self-standing works which enjoy copyright protection separate from the works in which they are contained. In addition, copyright protection is limited in time and encompasses the external appearance of such characters. Trade mark protection might thus present a certain attractiveness, due to the fact that it could be virtually perpetual and relate to elements that are not necessarily connected with the external appearance of the character. This contribution discusses why trade mark protection could and/or should be pursued, and details advantages and shortcomings of such regime under EU law. As regards the latter, it is doubtful whether trade mark registration could be effectively pursued in each and every instance, particularly on consideration of the applicability of the absolute grounds for refusal or invalidity concerning distinctiveness, public policy and morality and aesthetic functionality. In addition, the scope of protection – where available – would go only as far as allowing the trade mark owner to repress third-party uses of identical or similar signs, insofar as such uses are uses in a trade mark sense and affect the functions of the registered trade mark. All this suggests that the most effective way to protect a fictional character through IP is a comprehensive strategy that relies on different rights allowing the pursuit of different objectives of exclusivity, but is also conscious of the limitations that are inherent to each and every right.

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1. Introduction

‘BRANDERELLA’ might not (yet) be registered as a trade mark but, if we consult the EUIPO trade mark database, we discover that the following are (or were) registered for games, toys and playthings in Class 28: ‘CINDERELLA’; ‘SLEEPING BEAUTY’; ‘THE LITTLE MERMAID’; ‘PRINCE CHARMS’; ‘TINKER

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1 EUTM 005238118.
2 EUTM 005235205.
3 EUTM 000414193.
4 EUTM 004200151 (expired).
BELL’s, just to mention a few. This means that, whilst the works in which these characters appeared for the first time are no longer protected by their ‘natural’ intellectual property (IP) right, that is copyright, one should not think that any use of these characters – broadly intended, so to encompass also their names – would be allowed. So, for instance, while the owner of all these trade marks appears entitled to, eg, make and sell toys and dolls representing Cinderella, Sleeping Beauty, the Little Mermaid, Tinker Bell or a Prince Charming, it could be also in a position to prevent others from doing the same. The result could be that, while in principle the public domain features that constitute the likeness of a character like Sleeping Beauty (the copying of original features of, say, Disney’s adaption of the Sleeping Beauty character would give rise to issues of potential copyright infringement) could be reproduced in, say, a doll, it is questionable whether such doll could be advertised and sold as, say, ‘Sleeping Beauty’. Taking into account certain judicial decisions which will be discussed in what follows, it might be even doubtful whether it is possible at all to market a doll that is not branded as ‘Sleeping Beauty’ but which, nonetheless, evokes the character of Sleeping Beauty and – thus – the relevant trade mark in the mind of the consumers.

In light of the considerations above, it might appear that, indeed, trade mark registration allows one to retain or achieve significant protection for their fictional characters, whether still protected by copyright or fallen in the public domain. However, as it will be discussed in what follows, it is questionable whether trade mark protection is or should be available at all in certain instances. Even if it were, the scope of protection might be actually more limited than what it may look like at first.

This contribution discusses why trade mark protection could and/or should be pursued, and details advantages and shortcomings of such regime under EU law. The analysis is structured as follows: Part 2 discusses the ‘natural’ IP regime for fictional characters, that is copyright, and considers the potential difficulties and limitations associated with it; Part 3 focuses on trade mark law and reviews advantages and disadvantages of registration; Part 4 concludes noting that, whilst it is true that nothing prohibits different IP rights from subsisting on the same ‘object’ (whether simultaneously or at different times), a close scrutiny of the relevant requirements for protection under each and every of them should be undertaken by relevant authorities to avoid undue IP life extensions of such ‘objects’.

2. Once upon a time there was copyright …

Copyright protection is available to any work in a Berne and, now, EU sense. While no particular issues arise in relation to the literary, artistic or dramatic works that feature certain characters, in that they are regarded as ‘traditional’ copyright subject matter, whether copyright also vests in fictional characters as such has occasionally proved controversial. Difficulties are linked to the fact that, first, one might wonder whether a character is to be considered a ‘work’ in a copyright sense and, secondly, assuming that it is, what type of work a character is. While the latter appears to be less fundamental question than the former, it might still be a problematic one to answer in those European jurisdictions that envisage an exhaustive list of protectable works.

2.1. A ‘work’ that is sufficiently ‘original’

EUTM 005150685.

Cf however the ‘special’ status of Peter Pan under UK law: section 301 of the Copyright, Designs and Patents Act 1988 GOSH Children’s Charity for the benefit of Great Ormond Street Hospital for Children with a right to a royalty in respect of the public performance, commercial publication or communication to the public of the play “Peter Pan” by Sir James Matthew Barrie, or of any adaptation of that work, notwithstanding that copyright in the work expired on 31 December 1987.

With the exception of Shrek’s own Prince Charming, the term ‘Prince Charming’ is arguably not particularly distinctive for this type of goods, in that it indicates a stock character.
There is no statutory definition of ‘work’ in EU copyright directives, including Directive 2001/29 (the InfoSoc Directive). However, recently the Court of Justice of the European Union (CJEU) tackled the notion of ‘work’ in its judgment in *Levola Hengelo*, C-310/17. Noting that the InfoSoc Directive provides both a set of exclusive rights relating, in the case of authors, to their ‘works’ and relevant exceptions and limitations to such rights but makes no express reference to the laws of individual Member States for the purpose of determining the meaning and scope of the concept of a ‘work’, such concept is to be considered an autonomous concept of EU law. Such conclusion on the side of the CJEU is not surprising, also considering its frequent use in copyright case law: the CJEU has indeed often employed this interpretative standard in its copyright case law, with the practical effect of strengthening harmonization of copyright laws across the EU.

In *Levola Hengelo*, C-310/17, the CJEU considered that two cumulative conditions must be satisfied for subject matter to be classified as a ‘work’ within the meaning of the InfoSoc Directive. First, the subject matter concerned must be original in the sense that it is the author’s own intellectual creation, in accordance with the decision in *Infopaq International*, C-5/08 and subsequent case law. Second, only something which is the expression of the author’s own intellectual creation may be classified as a ‘work’ within the meaning of that directive. Recalling both the wording of Article 2(1) of the Berne Convention and the idea/expression dichotomy in Articles 2 of the WIPO Copyright Treaty and 9(2) of the TRIPs Agreement, the Court concluded that for there to be a ‘work’ as referred to in Directive 2001/29, the subject matter protected by copyright must be expressed in a manner which makes it identifiable with sufficient precision and objectivity, even though that expression is not necessarily in permanent form.

In the case of a fictional character, the definition of ‘work’ may be satisfied when the character at issue appears in a single work and its features are identifiable in accordance with the CJEU criteria. The assessment, however, might be potentially more complex when the character is one with a longstanding history and which has appeared and changed to some extent over time. Would it be possible to identify with sufficient precision and objectivity the protectable expression which renders such character a ‘work’?

Under US law, the answer appears to be in the affirmative, insofar as certain requirements are satisfied. In 2015, the U.S. Court of Appeals for the Ninth Circuit was called to decide whether defendant Mark Towle had infringed DC Comics’ exclusive rights under a copyright when he built and sold replicas of the Batmobile, as it appeared in the 1966 television show *Batman* and the 1989 film *BATMAN*. “Holy copyright law, Batman!” noted Circuit Judge Ikuta at the beginning of his opinion.
The court considered whether the Batmobile itself could a protected character under US law by adopting a 3-part test: first, the character must generally have physical as well as conceptual qualities; second, the character must be sufficiently delineated to be recognizable as the same character whenever it appears (this requires the presence of identifiable character traits and attributes, but the character does not need to have a consistent appearance); third, the character must be especially distinctive and contain some unique elements of expression, meaning that it cannot be a stock character such as a magician in standard magician garb. Even when a character lacks sentient attributes and does not speak (like a car), it can be a protectable character if it meets this standard. Applying this test, to the case at issue, the court concluded that the Batmobile would be protected by copyright and that the defendant had infringed it.

It appears that, even if this test is only directly applicable under US law, it could be useful also in a European context. We could indeed consider that fulfilment of all requirements of the test is substantially what is required under EU law to identify a ‘work’ that is sufficiently ‘original’. Indeed, whilst the first and third step seem to relate to the originality of the character and, thus, what makes it its ‘author’s own intellectual creation’, the result of their ‘free and creative choices’ and ultimately what carries their ‘personal touch’, the second step entails the consideration of whether such character is “identifiable with sufficient precision and objectivity” and is, thus, a ‘work’ in the sense clarified in *Levola Hengelo*, C-310/17.

2.2. A work of the ‘right kind’

In European jurisdictions that envisage a closed list of protectable subject matter, an additional difficulty surrounding copyright protection of fictional characters relates to their classification: what types of works are they? A question of this kind, whose compatibility with EU law (or, rather: CJEU case law) is highly questionable.

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16 *D.C. Comics v. Towle*, 802 F.3d 1012, 1026 (9th Cir. 2015), at p. 15.

17 *Football Association Premier League Ltd and Others v QC Leisure and Others* (C-403/08) and *Karen Murphy v Media Protection Services Ltd* (C-429/08), EU:C:2011:631, at [98]; *Painer*, C-145/10, EU:C:2011:798, [87]-[89].

18 *Painer, cit*, n 17, [92].

19 See Rosati, *Copyright, cit*, n 10, 181-185.
remains still a fundamental one to answer, in that impossibility to determine what category a work belongs to leads to a finding that copyright protection is not possible.

So, under UK law (a jurisdiction in which copyright protection is only available to a limited number of works), a ‘work’ is ‘a thing which satisfies the statutory description of a literary, dramatic, etc. work.’ Such ‘thing’ must be, first, a production in the Berne sense and, second, fall within one of the categories provided by the Copyright, Designs and Patents Act 1988 (CDPA). Categorization has implications not just for determining whether a certain work may be actually protected by copyright under UK law, but also what rights attach to such work. So, for instance, section 21(1) CDPA excludes the right of adaptation for artistic works, while providing expressly for it in relation to literary, dramatic and musical works. Similarly, section 17(3) includes conversion of a work into a three-dimensional form within the scope of the right of reproduction only for artistic works, not also literary works. In addition, differences between the various categories subsist also in relation to the topic of infringement. While copyright in a literary, dramatic, musical or artistic work may be infringed without copying the medium on which the work was recorded by the author or published by the publisher, copyright in sound recordings, broadcasts, published editions and films may only be infringed by reproducing the medium produced by the author.

In UK copyright case law there are a few instances in which works have been denied copyright protection due to the very impossibility of placing such works within one of the categories provided by the CDPA. Examples include the assembly of a scene (the scene was that which would be photographed for the cover of Oasis’s Be Here Now album) and the Stormtrooper Helmet from the Star Wars films. Until recently, uncertainties have also surrounded the protectability of TV formats by means of copyright, due to uncertain categorization thereof. The same difficulties of categorization seem likely to subsist also in relation to fictional characters: are they a literary work? a dramatic work? an artistic work?

All this said, as mentioned, it is highly questionable whether an approach of this kind is (still) allowed under EU law. Most recently, in Cofemel, C-683/17, the CJEU considered that the notion of work solely presupposes the fulfilment of two cumulative requirements: first, it implies the existence of an original object, in the sense that said object is the intellectual creation of its author; second, the notion of work is reserved to those elements which are the expression of such creation. When an object is a ‘work’ in this sense, “it shall be eligible, in this respect, for copyright protection, in compliance with Directive 2001/29”. All this rather clearly suggests that no other criteria can be imposed to determine copyright subsistence, not even the requirement that the work at issue is one of the right kind. This conclusion is also in line with certain UK case law, which has noted how – in light of a number of CJEU rulings – it may be arguable that it is not a fatal objection to a claim that copyright subsists in a particular work that the work is not one of the kinds of work listed in section 1(1)(a) CDPA and defined elsewhere in that Act. Nevertheless, it remains clear that the putative copyright work must be a literary or artistic work within the meaning of Article 2(1) of the Berne Convention.

2.3. Which and how many copyrights?

23 Banner Universal Motion Pictures Ltd v Endemol Shine Group Ltd & Anor [2017] EWHC 2600 (Ch) (19 October 2017).
24 Cofemel, cit, n 9, at [30] and [32].
25 Ibid, at [35] (my own translation from Italian, standing the current unavailability of the English version of the judgment).
26 SAS Institute Inc v World Programming Ltd [2010] EWHC 1829 (Ch) (23 July 2010), at [27].
Copyright protection of a character is in principle limited in time; in Europe, it will last for the life of the author and seventy years after their death. This means that in principle, upon falling in the public domain, it will become possible to use a character without the need for a licence to, eg, create a new adaptation of the story featuring said character. So, if we take again the example of *Sleeping Beauty* in the version by Charles Perrault (as also subsequently collected and printed by the Brothers Grimm), both the story and the characters are no longer protected by copyright. However, subsequent adaptations of the public domain stories would warrant their own copyright protection, insofar as they are original. The same is true with regard to the relevant characters: so, if we apply the criteria mentioned above *sub §2.1.*, this means that, eg, Disney’s version of *Sleeping Beauty* as a character with a certain appearance and personality would enjoy its self-standing copyright protection and the same would be true of Dreamworks’s own version, which also has an original appearance and personality. Insofar as no original features of a copyright-protected character are reproduced, it remains possible to use a third-party character to create, eg, new adaptations of well-known story.

3. **Why trade mark registration?**

Even if historically the simultaneous protection of the same object under different IP rights was disallowed in certain jurisdictions on consideration of the demarcation between the subject matter protected by patent, copyright and trade mark law, no provision currently precludes the possibility for an ‘object’ to be simultaneously protected by different IP rights and no impediments exist for a shape previously protected by a now expired IP right to be registered as a trade mark. The possibility of IP rights cumulation is actually expressly acknowledged in EU IP law. In all this, overlaps in protection are also the result of the progressive expansion of the scope of the various rights beyond their original remit and are not necessarily problematic per se, considering the multifaceted nature of many objects or invention or creation, the different rationale underlying the various rights, as well as the different protection available under each of them. So, for instance, the doing of a certain act might constitute

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28 OHIM, Second Board of Appeal, Case R 486/2010-2, 14 December 2010, at [15].

29 OHIM, Second Board of Appeal, Case R 486/2010-2, 14 December 2010, at [16].


infringement under more than one right and the availability of a defence under one of those rights (eg, trade mark exhaustion) would not prevent a finding of liability under the other rights (eg, copyright).  

All this said, however, under EU trade mark law pre-existing IP protection might weigh against the possibility of trade mark registration (this is the case of the absolute grounds in Article 7(1)(e)(iii) of the EU Trade Mark Regulation (EUTMR)/4(1)(e)(iii) of the EU Trade Mark Directive (EUTMD)) or call for scrutiny under other absolute grounds (eg, public policy and morality). In the particular case of fictional characters, trade mark registration of such characters or of certain elements thereof presents some attractive features: first, unlike copyright, trade mark protection may potentially last in perpetuity; second, it allows to bypass certain difficulties of the copyright regime, including the very question of subsistence of protection; third, it may offer protection even if and when no protectable features of a character are actually copied. Despite all this, trade mark protection might be challenging to obtain and maintain.

3.1. Requirements for trade mark registration

A sign that can be represented in an appropriate manner can be registered as a trade mark insofar as it possesses the ability to distinguish the goods and services covered by it as originating from a certain undertaking (Article 4 EUTMR/3 EUTMD). In other words, a sign is registrable if has distinctive character. However, when it comes to signs consisting of or event just referring to fictional characters, the subsistence of certain absolute grounds for refusal or invalidity – not just distinctiveness, but also public policy and morality, and aesthetic functionality – require close scrutiny, in that they might challenge the very possibility of obtaining (or maintaining) these registrations.

Starting from distinctiveness, its very subsistence might be doubtful in certain cases, especially when the character at issue is very well-known and several takes on that character are available. So, if take again Sleeping Beauty, the Disney version of Aurora is undoubtedly well known, but would consumers think of Disney, that is the owner of the trade mark registration, when seeing the sign ‘SLEEPING BEAUTY’ in isolation (that is, without representations of Disney’s Sleeping Beauty or use of the sign ‘DISNEY’)? Or would they rather think of the character Sleeping Beauty as something other than an indicator of origin (eg, as a cultural reference) or, eg, Tchaikovsky’s eponymous ballet? To satisfy this requirement, what is needed is indeed that the relevant public is able to identify the product in respect of which registration of the sign at issue is sought as originating from a particular undertaking.

If we consider public policy and morality, this is a ground that has begun receiving increasing consideration in more recent times. So far, the most comprehensive judicial assessment of how the absolute ground for public policy and morality might apply in the context of trade mark registrations for signs previously protected by

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32 Evora, C-337/95, EU:C:1997:517, at [58]. See the discussion in Kur, ‘The presentation right’, cit, 313-314, considering whether a solution in the form of a ‘comparison of limitations’ between trade mark law and copyright law might be feasible. Cf Art & Allposters International, C-419/15, EU:C:2015:27, in which the CJEU held that exhaustion of copyright’s right of distribution does not apply in a situation where a reproduction of a protected work, after having been marketed in the EU with the copyright holder’s consent, has undergone an alteration of its medium.


36 I discuss this in E Rosati, ‘The absolute ground for refusal or invalidity in Article 7(1)(e)(iii) EUTMR/4(1)(e)(iii) EUTMD: in search of the exclusion’s own substantial value’ (forthcoming) JIPLP, from which this part of the contribution is derived.
copyright is arguably the decision of the EFTA Court in *Vigeland*. On consideration that a number of artworks by Norwegian artists, notably those of Gustav Vigeland, would soon enter the public domain under the Norwegian copyright law, the Oslo Municipality (which managed several of these copyrights) sought to register six artworks by Vigeland as trade marks.

The Norwegian Industrial Property Office (‘NIPO’) rejected some applications *tout court*, due to their lack of distinctiveness or because the signs consisted of a shape that adds substantial value to the goods. Some registrations were granted in respect of certain goods and services. The Oslo Municipality appealed to the Board of Appeal. In addition to the grounds considered by NIPO, the Board also noted that registration might be refused on grounds of public policy and morality. The Board referred the case to the EFTA Court for guidance.

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37 EFTA Court, *Municipality of Oslo, Case E-5/16*. 
The EFTA Court considered *inter alia* the interplay between the public domain and copyright protection, holding that the latter would be an exception to the rule that creative content becomes part of the public domain once communicated, as well as the rationale of copyright and trade mark protection. Because of the potentially everlasting exclusivity afforded to a trade mark owner, several conditions must be satisfied for a trade mark to be registered. The court considered that a trade mark based entirely on a copyright work presents "a certain risk of monopolisation of the sign for a specific purpose, as it grants the mark’s proprietor such exclusivity and permanence of exploitation which not even the author of the work or his estate enjoyed". Hence, “[t]he interest in safeguarding the public domain […] speaks in favour of the absence of individual protection for, or exclusive rights to, the artwork on which the mark is based.” The court observed that absolute ground in what is currently Article 7(1)(f) EUTMR/4(1)(f) EUTMD refers to ‘public policy’ and ‘morality’: in certain cases these two limbs overlap, but these concepts are not synonyms. Refusal based on ‘public policy’ is done on objective criteria, whilst an objection to a trade mark based on ‘accepted principles of morality’ concerns an assessment of subjective values. In a case like the one at issue, both public interest and morality could be at stake. Starting from the latter, on the one hand registration of those artworks would not be offensive *per se*. On the other hand, trade mark registration of artworks that are considered part of a certain nation’s cultural heritage and values might be perceived by the average consumer as offensive, and therefore be contrary to accepted principles of morality.

Moving on to public interest considerations, which may vary from country to country and change over time, “an artwork may be refused registration, for example, under the circumstances that its registration is regarded as a genuine and serious threat to certain fundamental values or where the need to safeguard the public domain, itself, is considered a fundamental interest of society.” The public policy/morality does not require consideration of the classes of goods and services for which registration is sought. At the same time, it also applies in very specific – if not exceptional – circumstances, ie where registration is sought for a sign that consists exclusively of a work pertaining to the public domain and the registration of which constitutes a genuine and sufficiently serious threat to a fundamental interest of society. The mere fact that a work is protected or was previously protected by copyright is not sufficient to justify application of the ground, since “in principle, nothing prevents a sign from being protected under both trade mark and copyright law.”

From *Vigeland*, it appears that registration as a trade mark of public domain work may not be necessarily contrary to public policy or accepted principles of morality, as one needs to consider the status and perception of the artwork at issue in the jurisdiction where registration is sought. In this sense, ‘the risk of misappropriation or desecration of a work’ may be a relevant consideration in certain, specific instances. It is arguable that considerations of this kind might be undertaken when registration is sought for a sign depicting the likeness of a well-known character, whether fictional or real, especially if such character is closely tied to the cultural heritage of a certain country.

Finally, it is arguable that a trade mark application for a sign that represents a character might be also fall within the scope of application of the absolute ground for refusal in Article 7(1)(e)(iii) EUTMR/4(1)(e)(iii) EUTMD, is the sign at issue consists exclusively of the shape or another characteristic that gives substantial value to the goods. “A shape gives substantial value to a product if it has the potential to determine to a large extent the consumer’s

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38 *Vigeland*, at [65]-[69].
39 *Ibid*, at [70], also referring to *Shield Mark AG*, at [52].
40 *Ibid*, at [72].
41 *Ibid*, at [85]-[86]. On the notions of ‘public policy’ and ‘morality’ in EU trade mark law, see also recently *Constantin Film AG*, at [75]-[83].
42 *Vigeland*, at [91]-[92].
43 *Ibid*, at [96].
44 *Ibid*, at [62].
behaviour to buy the product.”

In what remains as of today the most analytical assessment of and guidance on the substantial value ground – *Hauck* –, the CJEU confirmed that the aim of the exclusion is “to prevent the exclusive and permanent right which a trade mark confers from serving to extend indefinitely the life of other rights which the EU legislature has sought to make subject to limited periods”. In his Opinion in that case, Advocate General Szpunar linked this explanation to both a deeper public interest rationale and the need to respect and balance different rights and interests. It appears correct to consider the notion of value as different from that of reputation, because what the law requires for the substantial value exclusion to apply is only that consumers’ choice will be affected by the aesthetic features of the shape or characteristic, not by the reputation of the trade mark owner or other trade marks also used to identify those same goods. AG Szpunar emphasized all this, in particular in his Additional Opinion in *Louboutin*. In the case of an application to register the appearance of a fictional character as a trade mark, it would indeed be the very appearance of the sign, especially if aesthetically pleasing or because of the values associated with that character, that would arguably lead consumers to make certain purchasing decisions.

To summarize the considerations above and apply them in a practical scenario, one might wonder whether a sign of this kind would fall with the scope of application of the three absolute grounds examined:

The sign is described as one that “consists of a blue rectangle on which appears the bust of a woman with hair in shades of gold, cream skin, pink lips, brown and white eyes and black eyebrows. A gray ribbon appears in the woman’s hair. The details and outlines in the woman’s hair and face and the ribbon are black.” Yet, it is also apparent that the sign is exclusively an extract from the famous painting *Birth of Venus*, by Sandro Botticelli.

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45 OHIM, Fifth Board of Appeal, Case R 942/2012-5, 16 January 2013, at [11]. In the same sense, speaking specifically of ‘eye-appeal’ of a shape, see OHIM, Second Board of Appeal, Case R 486/2010-2, 14 December 2010, at [16].


48 OHIM, Fifth Board of Appeal, Case R 942/2012-5, 16 January 2013, at [11]-[12] and [19].

Although this sign is a registered trade mark in the US\textsuperscript{50}, one could wonder whether registration would and should be allowed under EU trade mark law. It appears unlikely that consumers would perceive the sign as inherently distinctive (distinctiveness might be acquired through use though) and not simply as the representation of a well-known artwork. The sign itself would also arguably raise the question whether registration should be allowed in the first place: support to a conclusion in the negative comes from the \textit{Vigeland} decision, also considering the similar factual background. Finally, it might be possible to exclude registration also on grounds that the sign consists exclusively of ‘another characteristic’ which gives substantial value to the goods. In this sense, the conclusion that the CJEU achieved in \textit{Textilis}\textsuperscript{51} (concerning registration of the famous ‘Manhattan’ print as a trade mark) might be considered. In that referral, the EU court had been asked to provide guidance on the application of the ground (in the pre-reform version) to a sign which consists of two-dimensional and decorative motifs and which is affixed to goods such as fabric or paper, contains lines and contours. In excluding the retroactive application of the ground as reformed in 2015, the CJEU considered that, even if that sign represents shapes which are formed by the external outline of drawings representing, in a stylized manner, parts of geographical maps, it also contains decorative elements which are situated both inside and outside those outlines, as well as word elements (‘Manhattan’). As such, it would not be indissociable from the shape of the goods to which it is affixed, the form of which differs from the decorative motifs.\textsuperscript{52} In the case of the sign representing \textit{Venus}, there are no particular elements situated outside the outlines of the character and there are no word elements. As such, it might be considered that the sign consists exclusively of the shape or another characteristic which gives substantial value to the goods. In conclusion, registration of a sign corresponding to a fictional character might fall short of the required distinctiveness (this appears to be true in relation to both word and figurative marks), and might be also contrary to public policy and morality, as well as falling within the scope of application of the substantial value ground.

3.2. Scope of protection

All the above said, assuming that registrations relating to fictional characters might be validly pursued and maintained, one needs to consider how far protection afforded under the registration may go. Although Article 9 EUTMR/10 EUTMD confers a number of rights on the owner of a trade mark, the possibility to enforce them is limited to those situations in which use of an identical or similar sign is (1) use in a trade mark sense; and (2) such as to affect one of the functions of the registered trade mark. The latter appears to be the case even in double

\textsuperscript{50} USTM 4053608.

\textsuperscript{51} \textit{Textilis}, C-21/18, EU:C:2019:199.

\textsuperscript{52} Ibid, at [39]-[44].

Birth of Venus, by Sandro Botticelli
(source: <uffizi.it>)
identity scenarios, ie when the junior sign is identical to the registered trade mark and is used in relation to identical goods and services.\textsuperscript{53}

The consequences of use of the sign ‘Sleeping Beauty’ might thus be different depending on the context. So, for instance the making and selling of a doll named ‘Sleeping Beauty’ might potentially interfere with the exclusive rights of the ‘SLEEPING BEAUTY’ trade mark’s owner and might give rise to liability under different headings: besides trade mark law, if the doll in question reproduced, say, the original features of Disney’s Sleeping Beauty, then also a claim of copyright infringement and – if available – unfair competition/passing off would require consideration. That would be potentially the case even if the latter sign merely evoked the earlier, registered sign. So, in the UK the High Court of England and Wales considered that the holders of a series of registered word (‘BETTY BOOP’ and device (shown below) UK and EU trade marks could prevent third parties from making available any unauthorized product which bears an image recognizable as Betty Boop regardless of the pose of the character (as it appears in the registered device). The court also found that any unauthorized product which bears an image recognizable as Betty Boop would infringe the word mark marks ‘BETTY BOOP’ regardless of whether the words BETTY BOOP or BOOP (or a slogan like "Boop oop a doop") appear.\textsuperscript{54}

\textit{The registered device in Hearst v A.V.E.L.A.}

However, it is arguable that no infringement of the ‘SLEEPING BEAUTY’ trade marks could be established where use of the sign is one that does not affect any of the functions of the registered trade mark, even if the use is in relation to identical goods as those for which registration has been obtained. So, ‘SLEEPING BEAUTY’ is registered for clothing in Class 25. However, it is doubtful that the sale of T-shirts carrying the sign ‘Sleeping Beauty’ could be considered as affecting the origin function of the trade mark when the context is one that merely refers to the title of a ballet.

\textit{Sleeping Beauty Classic T-Shirt (source: <balletgifts.co.uk>)}

Similarly, the author of a new version of the story of Sleeping Beauty would arguably not use the term ‘SLEEPING BEAUTY’ in a trade mark sense, so that no issue of interference with the trade mark owner’s exclusive rights

\textsuperscript{53} Arsenal Football Club, C-206/01, EU:C:2002:651, at [51].  
\textsuperscript{54} Hearst Holdings Inc & Anor v A.V.E.L.A. Inc & Ors [2014] EWHC 439 (Ch) (25 February 2014).
would arguably arise, irrespective of whether the trade mark SLEEPING BEAUTY is registered in relation to goods and services that can be considered identical or similar to those in relation to which the same sign is being used.35

Conclusion

Different IP rights are available for the protection of fictional characters. As far as copyright is concerned, doubts may subsist regarding the classification of characters as self-standing works which enjoy copyright protection separate from the works in which they are contained. In addition, copyright protection is limited in time and encompasses the external appearance of such characters. Trade mark protection might thus present a certain attractiveness, due to the fact that it could be virtually perpetual and relate to elements that are not necessarily connected with the external appearance of the character. However, it is doubtful whether trade mark registration could be effectively pursued in each and every instance, particularly on consideration of the applicability of the absolute grounds for refusal or invalidity concerning distinctiveness, public policy and morality and aesthetic functionality. In addition, the scope of protection – where available – would go only as far as allowing the trade mark owner to repress third-party uses of identical or similar signs, insofar as such uses are uses in a trade mark sense and affect the functions of the registered trade mark. All this suggests that the most effective way to protect a fictional character through IP is a comprehensive strategy that relies on different rights allowing the pursuit of different objectives of exclusivity, but is also conscious of the limitations that are inherent to each and every right.

35 It should be noted that there might still be potential copyright issues to consider in a case of this kind, especially if the story at issue reproduced protectable expressions of a third-party in-copyright version of it.