



Interplay between trademark rights and copyright

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Time: Sunday, 21 May 2017 - 9:00 am-11:00 am

The topic aims at discussing the interplay between trademark rights and copyright, in particular under the following aspects: (i) protection by copyright of distinctive signs (verbal trademarks, combined trademarks, figurative trademarks, 3D trademarks); (ii) effects of copyright protection on the distinctiveness of a trademark (iii) admissibility of arguments based on copyright in the frame of trademark disputes (whether opposition proceedings, civil proceedings or criminal proceedings); (iv) hierarchy (if any) between trademark rights and copyright; (v) need for IP practitioners to include a disclaimer in their trademark search reports regarding potential conflicting signs protected by copyright.

A. Introduction

B. Protection by copyright of distinctive signs (verbal/combined/figurative/3D trademarks)

In particular, the following issues will be addressed:

1. What are the formalities, if any, to comply with to obtain copyright protection?
2. Is registration available, or compulsory?
3. Can a “legal person” (by contrast to a “natural” person) own copyright?
4. Is there a presumption regarding the ownership of copyright?
5. What can the holder of a copyright do in order to secure/evidence his rights (e.g. file its creation with a copyright registry, to deposit his creation with a public notary, to send oneself a registered letter containing the copyrighted material and not open it, etc.)?
6. Can a verbal trademark be protected by copyright? If so, under what conditions? Is there a minimum number of letters a verbal trademark must comprise to be eligible to protection?
7. Can a family name be protected by copyright? If so, under what conditions?
8. Can the original combination of two existing words be protected by copyright? If so, under what conditions?

9. Can a combined trademark be protected by copyright? If so, under what conditions?
10. Can a figurative trademark be protected by copyright? If so, under what conditions?
11. Can a 3D trademark be protected by copyright? If so, under what conditions?
12. Generally speaking, are the products/services claimed by a trademark relevant when assessing whether such trademark is protected by copyright?

C. Effects of copyright protection on the distinctiveness of a trademark

13. Is the fact that a trademark benefits from copyright protection relevant in the assessment of distinctiveness (absolute ground of exclusion)?

D. Admissibility of arguments based on copyright in the frame of trademark disputes (whether opposition proceedings, civil or criminal proceedings)

In particular, the following issues will be addressed:

14. Are arguments based on copyright admissible in the frame of trademark opposition proceedings and civil/criminal proceedings, as a means of defence (e.g. the claimant relies on trademark rights and the respondent on copyright)?
15. Can a trademark be cancelled on the basis of a copyright claim? If so, under what conditions? Is the fact that the owner of the litigious trademark was aware or should have been aware of the copyrighted work relevant in this context?

E. Hierarchy (if any) between trademark rights and copyright

In particular, the following issues will be addressed:

16. Is there a hierarchy between trademark rights and copyright? If so, which one would prevail?
17. Do other principles than the principle of prior rights apply in this context?

F. Need for IP practitioners to include a disclaimer in their trademark search reports regarding potential conflicting signs protected by copyright

In particular, the following issues will be addressed:

18. Do you include a disclaimer in your trademark search reports regarding potential conflicting signs protected by copyright?
19. What should be the wording to be used in this context?