

The protection of fictional characters under EU intellectual property law

By Valentine Labaume

ABSTRACT

Fictional characters, may encounter different issues over the course of their existence. On the one hand, a third party could employ a fictional character for a different work than the one it was originally a part of. On the other hand, character creators have the possibility to register the name or physical appearance of a character as a trademark to market products in their likeness. Intellectual property, more specifically trademark law for the character's business life, and copyright law, thus becomes a necessity in the two hypotheses outlined above. However, the EU copyright and trademark system needs to be improved.

1. INTRODUCTION

Pop culture is everywhere these days, from comics to movies to books. It involves fictional characters. A fictional character covers fictional human characters, such as *Tarzan* or *James Bond*, as well as non-human characters, such as *Woody* in *Toy Story*, or *Mickey Mouse*.¹ A fictional character can originate from several sources including literary works, such as *Rapunzel* from the Grimm Brothers, strip cartoons such as *Tintin* from *Hergé*, artistic works including drawings and paintings such as *Mona Lisa* from *Leonardo Da Vinci*, or cinematographic works such as *Rocky* from the eponymous movie.² A fictional character can be either literary or visual.

In EU law, the cumulation of intellectual property rights is expressly acknowledged.³ In this manner, a fictional character could be protected by copyright as well as by trademark law. Both systems contain different advantages and disadvantages. These both systems show a need for IP protection for these fictional characters. But is the protection granted by copyright and trademark law sufficient enough to protect them?

2. COPYRIGHT PROTECTION OF FICTIONAL CHARACTERS

2.1 The requirement of an original work for fictional characters

2.1.1 The notion of work

To be copyrightable, the fictional character has to be a

work. The notion of work is neither defined by the Infosoc Directive⁴ nor by any other directive. The concept of work found its interpretation in case law. However, this notion remains elusive and still undefined.⁵

In the *Levola Hengelo*⁶ case, the question submitted to the Court was: what constitutes a work? However, the Court of Justice of the European Union (CJEU) did not proceed to define a work at this occasion and did not answer the question directly. The Court only stated that the work must “*be original in the sense that it is the author's own intellectual creation*”.⁷ In doing so, the CJEU reminds the importance of the originality criteria. As a consequence, the criterion of originality cannot be dissociated from the concept of “work”, because the criterion is built into the notion of “work”.⁸ Even the WIPO, in its guide to the Berne Convention, does not define the concept of work, though it explains that this notion is dependent on the originality criterion: “*nowhere defines what is meant by the word. But it is clear from its general tone that these must be intellectual creations.*”⁹

In this sense, Advocate General (AG) Wathelet disagreed with the CJEU. According to him, the requirement of a “work” must be fulfilled at first, then, secondly the requirement of “originality”.¹⁰ In his point of view, this chronology has to be observed in order to prevent the risk of confusion or merger of these two concepts.¹¹ In line with J. McCutcheon, the problem arises with respect to “unconventional works”, due to the fact that the CJEU will focus on the work itself instead of merging it with “originality”, as it is doing for “conventional works”.¹² In other words, the main assessment of a “conventional work” is the criterion of “originality”. Thus, the condition of work is implicitly met, without having to analyze it. However, since an “unconventional work” is harder to identify, the criterion of a “work” is in this case more rigorously examined.

According to the *Levola Hengelo* case, a work is an “autonomous” concept,¹³ which refers to a non-statutory definition. It is given to EU Member States, which then have to follow this uniform interpretation. The AG Wathelet, in his opinion, stated that a work is an autonomous concept,¹⁴ and the CJEU agreed on this point.¹⁵ An autonomous concept usually exists when there is a lack of reference to national legislation in directives.¹⁶ The principle of autonomy is expressed in the *Ekro* case.¹⁷ All Member States must then have an identical scope and meaning of the notion of work, meaning they cannot add any other standards in addition to the autonomous conception.¹⁸

Moreover, a particular situation exists regarding countries with a closed-list system, such as the UK or the Netherlands. To be protected in the UK for instance, a work should be part of the list of categories which are protected by copyright, including: literary, dramatic, musical, and artistic works, sound recordings, films, broadcasts and published editions.¹⁹ The *Levola Hengelo* case was based on Dutch law, therefore referring to a country with a closed-list system. The second question submitted to the Court is important since it was asked whether the illustrative of Article 2(1) of the Berne Convention, including “every production in the literary, scientific and artistic domain, whatever may be the mode or form of its expression”²⁰ limits the scope of copyright protection to creations which can be perceived by sight and/or by hearing.²¹ In this case, the CJEU completely ignored this question. Thus, national Courts did not receive any guidance concerning “unconventional work”, which does not enter in any category. The question arose related to the strict observance of these categories. This list of categories has an inclusive nature, which suggests an open-ended list.²² That is why some “unconventional works” try to place themselves within these categories, to be protected.²³ However, *Levola Hengelo* demonstrates that this list has limits, in the sense that it does not accept all the works within its categories.²⁴ An issue is therefore raised, since the CJEU did not offer any guidance, meaning that national Courts have to decide on their own, as long as the work meets the criterion of originality. In the *Levola Hengelo* case, AG Wathelet states that a work is limited to one that can be perceived by hearing or/and by sight, nonetheless without affirming that any other work is automatically rejected.²⁵ This identification by hearing or sight is a common ground for all works of all of the listed categories.

However, in this case, the CJEU criticizes the fact that taste cannot be detected with “precision and objectivity”,²⁶ reflecting the fact that the criterion of objectivity is important for the CJEU. A work has to be objectively iden-

tifiable, and AG Wathelet and the CJEU both agreed on the “objectivity” requirement. According to AG Wathelet, this objectivity is “imperative to comply with the principle of legal certainty in the interest of the copyright holders”.²⁷

To summarize the requirement of “work”, it appears from the *Levola Hengelo* case and AG Wathelet’s Opinion, that in order to be considered a work, a creation must be original, objectively identifiable, and also perceivable in such a way as to be heard or seen - if the creation does not meet this last condition, the notion of work will have to be considered on a case-by-case basis.

Now, it is interesting to apply this attempt of a work’s definition to fictional characters. Firstly, we must ponder on what the object of the protection would be. A fictional character is a fictional human or non-human character.²⁸ Therefore, by analogy with a human, the character is composed of three important parts: its physical appearance, its personality, and its name. These three parts need to be original, in order to be copyrightable. Then, the creation has to be objectively identifiable. For graphic characters, such as characters from movies or TV shows, this is not an issue, since the audience can see them and objectively recognize them. However, this criterion could pose an issue with regard to literary characters. A literary character, by definition, is from a novel or literary work. In this case, the public is required to use their imagination in order to perceive the character. In this case, the objectivity of the identification could be discussed, since every person reading or having read the work could imagine the literary character in a different way. To judge whether a character in literary fiction is a work of art, one would have to assess the extent of the character’s description. The more accurately the character is described, the more objectively it can be perceived. An issue is also posed concerning the case of characters which evolve through a longstanding story.²⁹ In this case, the character must be identifiable with sufficient objectivity. This special issue will be analyzed later in this chapter.

¹ WIPO, ‘Character merchandising: report prepared by the international bureau’, December 1994, 4.

² *Ibid* 5.

³ COUNCIL REGULATION [EC] No 6/2002 of 12 December 2001 on Community designs, Recitals 31 and 32.

⁴ Directive 2001/29/EC of the European Parliament and of the Council of 22 May 2001 on the harmonization of certain aspects of copyright and related rights in the information society.

⁵ Jani McCUTCHEON, ‘Levola Hengelo BV v Smilde Foods BV: The Hard Work of Defining a Copyright Work’ [2019] 82[5] *The Modern Law Review* 936-950.

⁶ Judgement of the 13th of November 2018, *Levola Hengelo*, C-310/17, ECLI:EU:C:2018:899.

⁷ *Ibid* para 36.

⁸ McCUTCHEON (n5)

⁹ GUIDE to the BERNE CONVENTION for the

Protection of Literary and Artistic Works [Paris Act, 1971], Published by the World Intellectual Property Organization, 17.

¹⁰ Opinion of Advocate General WATHELET, Case C-310/17, *Levola Hengelo V. Smilde Food*, para 46.

¹¹ *Ibid*.

¹² McCUTCHEON (n5).

¹³ *Levola Hengelo* (n6) para 33.

¹⁴ Opinion of Advocate General Wathelet (n10) paras 37-39.

¹⁵ *Levola Hengelo* (n6) para 33.

¹⁶ Eleonora ROSATI, ‘Copyright and the Court of Justice of the European Union’ (Oxford University Press 2019), 6.

¹⁷ Judgement of the 18 January 1984, *Ekro*, C-327/82, EU:C:1984:11, para 11.

¹⁸ Opinion of Advocate General Wathelet (n10) para 39.

¹⁹ Copyright Designs and Patents Act 1988, Art 1.

²⁰ Berne Convention for the Protection of Literary and Artistic Works (as amended on

September 28, 1979), art2[1].

²¹ Request for a preliminary ruling from the Gerechtshof Arnhem-Leeuwarden (Netherlands) lodged on 29 May 2017 — *Levola Hengelo BV v Smilde Foods BV*.

²² McCUTCHEON (n5).

²³ *Ibid*.

²⁴ *Ibid*.

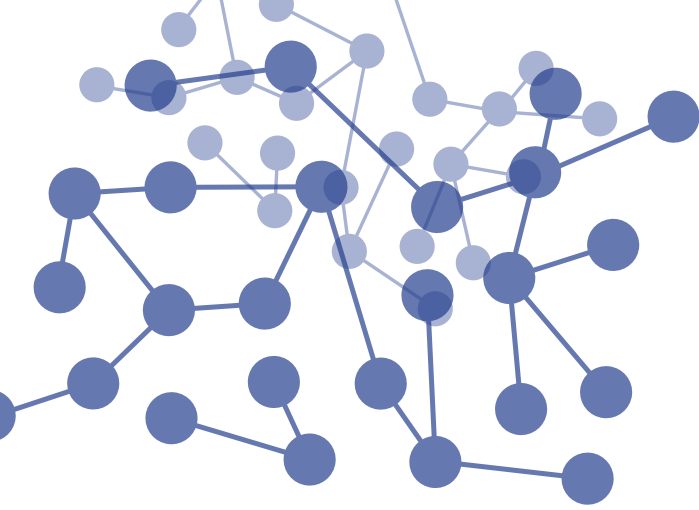
²⁵ Opinion of Advocate General Wathelet (n10) para 51.

²⁶ *Levola Hengelo* (n6) para 42.

²⁷ Opinion of Advocate General Wathelet (n10) para 58.

²⁸ WIPO (n1) 4.

²⁹ Eleonora ROSATI, ‘Branderella : Trade Marks and Fictional Characters’ (December 3, 2019). Yann Basire (ed), *Propriété Intellectuelle et Pop Culture* (LexisNexis, coll. IRPI, 2020), Available at SSRN: <https://ssrn.com/abstract=3497596>, 3.



In this way, a graphic character can be considered a work, without considering the “originality” criterion. The fulfilment of the work requirement for a literary character could be discussed.

2.1.2 The notion of “Originality”

In the *Levola Hengelo* case, it is stated that there is a need of two cumulative requirements for a creation to be considered as a work, within the meaning of the Infosoc Directive.³⁰ First, the creation “must be original in the sense that it is the author’s own intellectual creation”³¹ and secondly, it must be the “expression of this author’s own intellectual creation”³², according to the *Infopaq International*³³ case. This “author’s own intellectual creation” is the result of the “free and creative choice of the author”.³⁴

With regard to fictional characters, the originality criterion requires them to be the result of the free and creative choice of the creator.³⁵ It should be suggested to the creator of a fictional character to describe it precisely. Indeed, the fictional character should not be “stock”. A stock character is considered as “the archetype of a story’s character”.³⁶ In other words, it is considered as a typical character, without original traits. Thus, main characters are more likely to be protected, since the story is focused around them. However, being a main character is not a guarantee of protection, since the condition of originality must be met. This explains why a fictional character must be described precisely both in terms of physical appearance and personality.

2.2 The copyright protection applied to different parts of fictional characters

2.2.1 The physical appearance of a fictional character

A fictional character is composed, in part, by its physical appearance. Indeed, this appearance must be described in order to be perceived by the public. Referring to the *Levola Hengelo* case, it is possible to state that a fictional character could be considered as a work when it is identifiable, according to CJEU criteria, and when it appears only in a single work.³⁷ However, CJEU cases related to fictional characters are quite scarce. Decisions from national courts such as French or Italian Courts could give guidance and clues.

2.2.1.1 French courts

Regarding national law, French Courts have attempted to answer the question of whether the physical appearance can be protected or not. A particular case in 2008 concerned

a comic strip called “*Les Blondes*”.³⁸ This comic strip tells short stories about blonde girls, representing the stereotype of the slightly silly blonde girl. This blonde girl is a caricature, with a large chest, small articles of clothing, etc. Another comic book, called “*La revanche des blondes*” (which could be translated as “*The revenge of blonde girls*”), was published later on and employed the same stereotype as observed in “*Les Blondes*”. In the case, the judge of the “Tribunal de Grande Instance” (TGI) of Paris declared that the character of the blonde girl in the comic book was original. Indeed, the judge based his decision on specific facial characteristics, a very specific representation of the hairstyle as well as her clothes.³⁹

The judge carefully listed all of the attributes of the character’s physical appearance. At first glance, this decision could seem surprising, since the physical appearance of the characters from “*Les Blondes*” is common, only blonde girls with little clothing. To understand the ruling, it is important to understand the judge’s reasoning. To consider the comic strip “*La revanche d’une blonde*” as an infringement, the judge first compared the physical appearance of characters in both comics. Then, he compared “*l’impression d’ensemble produite sur le public*”, the overall impression made on the audience by this comparison. Therefore, the judge explains that the combination of characteristics and the particular treatment of the “*Blondes*” character constitutes originality.⁴⁰ Thus, these characteristics make the character identifiable and distinct from all precedent characters produced.⁴¹

This ruling, despite it not coming from the highest court, could nonetheless give an incentive concerning the protection of the physical appearance of characters. In the same regard, another very recent judgment was handed down in France, concerning fictional characters. The ruling was rendered by a Court of Appeal (CA), which is the second highest judicial authority in France.

In this recent ruling, the CA applied the same reasoning as in the “*Les Blondes*” case. This case concerns the “*Péchés Mignons*” comic strip. The fictional characters of these comic strips are characterized with large eyes and mouths. The judge stated that the combination of all characteristics, including facial shapes and expressions, hairstyles, poses, choice of clothing and accessories of the character, confers a particular physiognomy.⁴² This judgement is in line with the reasoning found in previous case law and is in accordance with the CJEU case and criteria of originality. The judge even stated that it is a “*parti-pris esthétique empreint de la personnalité de son auteur*”⁴³, which means that the physical appearance of the fictional characters constitutes aesthetic choices that reflect the personality of the author.

To summarize the reasoning in French case law, the physical appearance of a fictional character is copyrightable, due to the fact that the combination of all physical characteristics produces an overall impression on the public.

2.2.1.2 Italian Court

A recent Italian judgment has clarified and given some indications concerning the protection of fictional characters.

In the *Unidis Jolly Film v. Paramount Pictures Corporation*⁴⁴ case, a fictional character originating *a priori* from the Italian movie “*Per un pugno di dollari*” makes a brief appearance in the American cartoon “*Rango*”. The makers of the Italian movie therefore pursued the creators of “*Rango*” in court for using the main character of their film, without their authorization. To decide if there was an infringement of the Italian filmmakers’ rights, the judges examined whether the character in the film “*Rango*” is a copyrighted character.

In this case, the main difficulty the judge faced was to determine whether the character appearing in “*Rango*” is a reference to “*the man with no name*” from Sergio Leone’s western trilogy or a direct reference to Clint Eastwood, the actor who played this character. The judge relied on several criteria to answer this question. Firstly, they underlined the fact that the contexts of the two films are radically different. Sergio Leone’s film is very dramatic and pessimistic, and aimed towards adults, whereas “*Rango*” is more directed towards children, all the while containing adult references.⁴⁵ Secondly, the judge compared the physical appearance of the two characters in “*the man with no name*” and the Spirit of the West. He deduced from this analysis that the Spirit of the West displayed obvious similarities with “*the man with no name*” in terms of clothing, gestures, tone of voice and physical characteristics reminiscent of the actor Clint Eastwood.⁴⁶

The judge stated that a fictional character, to be immediately perceptible as such by the public or the critics, and therefore potentially be protected by copyright, must necessarily be distinguished from the actor who embodies it.⁴⁷ The main point of this judgment is that a fictional character must be recognisable outside of its original context. The judge here reminded that a character needs to be the result of an autonomous and personal artistic creation of its creator and contain such characteristics as to make it immediately recognisable as such, as an expression of the “author’s own intellectual creation”⁴⁸, even outside of the context in which it was initially placed and invented.⁴⁹ In other words, a fictional character which is

identifiable by its physical appearance, personality or others characteristic features, must be immediately recognisable and original, independently of the context which it is placed in. It means that when the character is placed in a context other than its original one, the audience must be able to recognise it immediately, for the character to be subject to copyright. It should be recognizable independently of the context, and in the specific case of movies, independently of the actor playing the role.

In this case, the “*the man with no name*” character has not acquired any penetration or permanence in the public, in film criticism or in subsequent works, as to qualify it as a creative work and identifiable as such.⁵⁰ Indeed, the judge encountered difficulties to determine whether the character in the “*Rango*” movie is a reference to the “*the man with no name*” or to the actor Clint Eastwood.

To analyze the criterion of originality of the character, the judge then also based his judgement on the “*scarto semantico*”, that could be translated as a “semantic gap”.⁵¹ The judge compares the character with the attributes of characters from pre-existing works. In this case, “*the man with no name*” is compared with already existing works. This analysis reveals multiple and recurrent characteristics present in literature, such as the stereotype of the negative, ambiguous, double-dealing, foreign, outlaw hero, going back to the beginning of Western literature with “the Odyssey”, and in the specific cinematographic sector.⁵²

Finally, a fictional character which represents a clear reference to a previous work is authorized, when it soberly evokes the previous work as a brief homage, a tribute to the actor or director. Indeed, it is the same author/director who “admits” his foreignness to the previous author’s work and integrates it as such in his own work for the sole purpose of denouncing his own narrative or bibliographical references.⁵³ In this case, the representation of Clint Eastwood is considered as a cameo, since it is a clear homage to this actor and lasts less than two minutes.

³⁰ *Levola Hengelo* (n6) para 35.

³¹ Judgment of 4 October 2011, *Football Association Premier League and Others*, C-403/08 and judgement of the 4th of October 2011, *Karen Murphy*, C-429/08, EU:C:2011:631, para 97; see *Levola Hengelo* (n6) para 36.

³² *Levola Hengelo* (n9) para 37.

³³ Judgement of 16th July 2009, *Infopaq*, C-5/08, ECLI:EU:C:2009:465.

³⁴ *Football Association Premier League Ltd and Others v QC Leisure and Others and Karen Murphy v Media Protection Services Ltd* (n31) para 98 ; Judgement of the 1st of December 2011, *Painer*, C-145/10, EU:C:2011:798, paras 87-89.

³⁵ *Football Association Premier League and*

Others and Karen Murphy (n31) para 98 ; See also *Painer* (n34).

³⁶ Jasmine ABDEL-KHALIK, ‘Scènes à Faire as Identity Trait Stereotyping’ [2018] 2(2)The Business, Entrepreneurship & Tax Law Review 241-273.

³⁷ ROSATI (n29) 3.

³⁸ Tribunal de grande instance (TGI) de Paris, Chambre civile 3, 21 mai 2008, 08/00609.

³⁹ *Ibid.*

⁴⁰ *Ibid.*

⁴¹ *Ibid.*

⁴² Cour d’appel de Paris, Pôle 5, Chambre 2, Arrêt du 24 janvier 2020, Répertoire général n° 18/06949.

⁴³ Cour d’appel de Paris (n42).

⁴⁴ Court of Rome, Industrial Tribunal, *Unidis*

Jolly Film v. Paramount Pictures Corporation, decision n.6504/2021 R. G. 27160/2017, published on April 16, 2021.

⁴⁵ *Ibid* 11.

⁴⁶ *Ibid.*

⁴⁷ *Ibid* 16.

⁴⁸ *Football Association Premier League and Others* (n31).

⁴⁹ *Unidis Jolly film SRL v. Paramount Pictures Corporation* (n44) 14.

⁵⁰ *Ibid* 15.

⁵¹ *Ibid* 18.

⁵² *Ibid* 17.

⁵³ *Ibid* 19.

To summarize, this case instructs quite largely on the reasoning found behind the protection of fictional characters. According to the Italian judges, a fictional character is original when it is recognizable regardless of the context and of the actor who embodies it. Moreover, the judge compares this fictional character, with all of its attributes, with previous works. However, this fictional character, even though it is not original, could be protected as the citation exception.

This tribunal's reasoning is doubtful, especially concerning the new criterion of penetration of the character in the public. The fact that a character may be recognizable in any context should not be a *sine qua non* condition to it being able to obtain copyright protection. A character may be original, characterising the "author's own intellectual creation", without the public being able to recognise it in any context. Indeed, an original character from a film, which was not a clear success, or from a book, would not be recognizable by everyone in any context. In this case, "the man with no name" is the main character of Sergio Leone's Western trilogy. Thus, if we strictly follow the tribunal's reasoning, this main character would not be entitled to copyright on the grounds that he is not immediately recognizable. But what would have been the Court's verdict if Clint Eastwood had not been known? Would the "Western's Spirit" character from the *Rango* movie have become immediately recognizable? The reasoning of this tribunal would therefore be more in favour of well-known fictional characters such as *Mickey Mouse*, *James Bond* or even *Batman*, who are, undeniably, immediately recognizable in any context. However, fictional characters from lesser-known works or, in the case of films, played by not so very well-known actors, are not favoured by this criterion. A cartoon character is also much more likely to meet this criterion since it is a drawing, which therefore has particular characteristics that a human could not have systematically. For instance, a cartoon character such as *The Pink Panther* could be recognized in any context. There is no problem in differentiating from the actor who plays it, since he is not visible. This is one less difficulty to overcome. This new criterion is a difficulty for film characters. It should be more interesting to keep this new criterion as an additional

one, in order to help characterise a fictional character as eligible for copyright.

2.2.2 The protection of the character's personality

A character's personality is a real problem for fictional characters, since it is very abstract. Indeed, this issue has been sparsely studied by authors and academics. It is a relatively new subject, and very little is known about its copyright protection. As with the physical appearance of a character, there are few CJEU rulings that relate to the personality of a character. However, it is worthwhile to study judgments of national courts, such as French courts.

Regarding French case law, another case from 1989 concerned the personality of a fictional character. This case concerned "*La bicyclette bleue*", inspired by the book "*Gone with the Wind*". The judges compared the similarities between the two works scene by scene. This is significant, because the court states that it found "*des similitudes portant (...) sur les caractères physiques et psychologiques des personnages principaux et de certains personnages secondaires*" (which means: "similarities relating to (...) the physical and psychological attributes of the main characters and certain secondary characters").⁵⁴ It is important since the judge also compared psychologic characteristics, which constitute the personality of the character. However, the question that arises concerns the importance of the character's personality. Indeed, the personality may either contribute to the originality of the character, or constitute a facet of the originality.⁵⁵

It is interesting to reach back for the French "*Péchés Mignons*"⁵⁶ case law reasoning. In this case, the judge focused on the physical appearance of the character, but above all, on the personality of each character. He indeed stated that each of the characters has a particular expression or personality trait, treated in a humorous and off-beat way.⁵⁷ These expressions embody the author's creative choice.⁵⁸ The judge lists the character traits of each of the characters, including a woman's seductiveness, a teacher's self-contentment, a young man's self-confidence, a girl's ingenuity, or a young woman's frightened surprise.⁵⁹ He couples each personality trait with its identifiable physical appearance. Thus, the psychological traits contribute to the originality of the character. Indeed, the originality of

⁵⁴ Cour d'appel de Versailles ch.civ.réun. 15 décembre 1993.

⁵⁵ 'Cosplay : de l'hommage à l'atteinte aux droits', Stefan Martin at 'Propriété Intellectuelle et Pop culture : saison 3', CENTER FOR INTERNATIONAL INTELLECTUAL PROPERTY STUDIES (CEIPI), 26th of March 2021, through zoom.

⁵⁶ Cour d'appel de Paris [n42].

⁵⁷ Ibid.

⁵⁸ Ibid.

⁵⁹ Ibid.

⁶⁰ Brigitte JOPPICH, 'Alternative Dispute Resolution under WIPO Rules for TV Format Protection Right Issues', GRUR-Prax 2010, 213.

⁶¹ BGH, decision dated June 26, 1993 – I ZR

176/01, GRUR 2003, 876, 877.

⁶² Ibid.

⁶³ OLSWANG LLP and Sukhpreet Dr SINGH, 'The FRAPA report 2011 : protecting format rights', 10.

⁶⁴ *Levola Hengelo* (n6) para 40.

⁶⁵ Interview of Professor Eleonora ROSATI [Professor], 23rd of April 2021, zoom.

⁶⁶ *Nichols v Universal Pictures Corporation*, 45 F 2d 119 [2d Cir 1930].

⁶⁷ *Warner Bros Pictures, Inc v Columbia Broadcasting System*, 216 F.2d 945 [1954].

⁶⁸ *DC Comics v. Towle*, 802 F.3d 1012 (9th Cir. 2015).

⁶⁹ Circuit Judge L. Hand comment about *Nichols v Universal Pictures Corporation*, 45 F 2d 119 [2d Cir 1930].

⁷⁰ Lim TZE PING, 'Beyond Copyright: Applying a Radical Idea-Expression Dichotomy to the Ownership of Fictional Characters' [2018] 21 Vand J Ent & Tech L 95, 57.

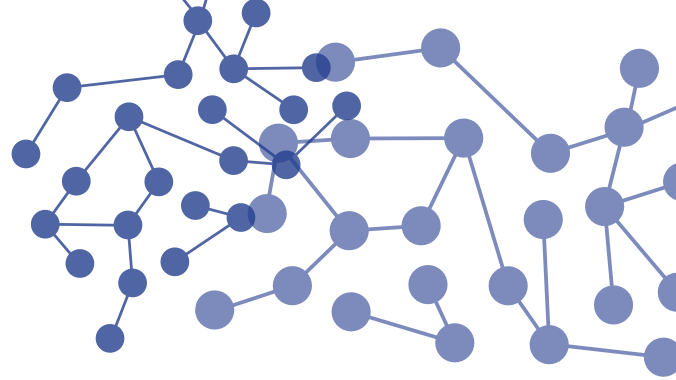
⁷¹ *MGM, Inc. v. Am. Honda Motor Co.*, 900 F. Supp. 1287, 1302 [C.D. Cal. 1995].

⁷² *Walt Disney Prods. v. Air Pirates*, 581 F.2d 751, 757-58 [9th Cir. 1978].

⁷³ *Burroughs v. MGM, Inc.*, 519 F. Supp. 388, 391 [2d Cir. 1981].

⁷⁴ Mark BARTHOLOMEW, 'Protecting the performers: setting a new standard for character copyrightability' [2001] 41(2) Santa Clara Law Review 341-378.

⁷⁵ *Warner Bros Pictures, Inc v Columbia Broadcasting System* (n67).



the character is only attributed with the simultaneous contribution of the physical appearance and the character trait. The question here is therefore whether the personality itself confers the originality to the character or whether it must necessarily be associated with a physical appearance.

It is clear from these various rulings on the personality of the fictional character that the personality is an integral part of the fictional character, and that it is therefore protected. In the *“Péchés Mignons”* case, it is obvious that the judge based his reasoning on the moral characteristics of the characters to determine the originality of the character.

2.2.3 The case of the evolution of the character

Sometimes characters can grow, and become more mature or evolve over time. This can be the case for the heroes of sagas such as *Harry Potter* or television shows such as *The Office*. The personality of a character may change, as well as its relationships with other characters. These elements can evolve drastically, for instance from an angelic to an evil character, or substantially. The character’s lifestyle may also change and have an impact on its personality, for instance an event could turn a character’s life upside down and change its mentality.

Television format cases are an interesting illustration. There is no legal definition of television format but it results from the media industry.⁶⁰ The German Federal Court of Justice, in 1993, rendered a decision concerning the television format.⁶¹ The Court defined this television format as *“the totality of all its characteristic features which are capable of acting as a general mould shaping each single episode and thus enable the audience at the same time to recognize such episodes easily as parts of a series”*.⁶² Afterwards, the Format Recognition And Protection Association (FRAPA) explained that *“The key component of any successful television format is the unique combination of content, story, characters/hosts, pace, music, lighting and stage/set design (amongst other things)”*.⁶³ From these two definitions, it is clear that fictional characters are an integral part of the television format. The television show cannot in fact be dissociated from its characters since, without them, the show would simply not exist. Thus, the whole show is protected, including its script. The script can therefore be spread over several years, allowing the fictional characters to evolve and change, both physically and mentally. Thus, the evolution of a fictional character could be protected.

Moreover, the *Levola Hengelo* case offered guidance and defined a work as something identifiable with precision and objectivity.⁶⁴ The characters of television formats can change over time and it may be difficult to find a precise and objective identification. To identify these precise and objective characteristics, there must be an attribute which is proper to a character.⁶⁵ In other words, the physical attribute which could be identifiable and protected has to be maintained throughout every step of the character’s evolution. For instance, if a character that has big blue eyes, evolves or gets older, it could still be considered as a work since its big blue eyes would not change. In addition, this physical attribute has to be original. It is impor-

tant to keep in mind that the physical attribute needs to stay the same overtime, over the course of any change. The reasoning employed is the same as in the change of physical appearance. The fictional character which changes overtime has to at least keep its identity, its personality trait that characterizes it. In addition, it has to be original.

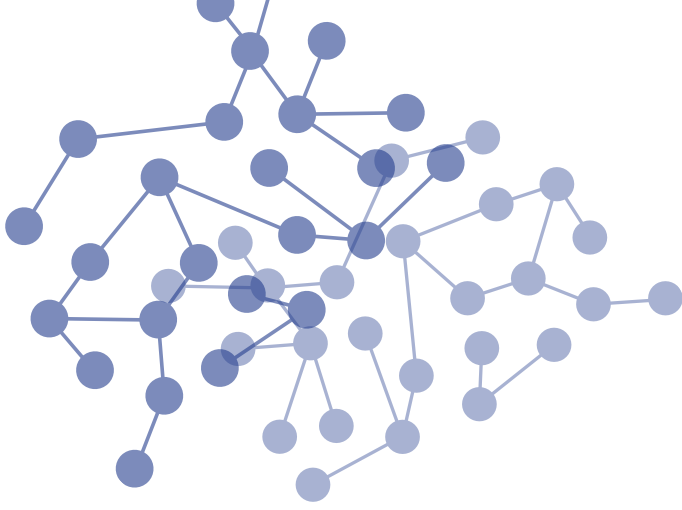
3. COMPARISON BETWEEN EU AND U.S. SYSTEMS

3.1 The implementation of tests

The U.S. copyright law system pays particular attention to the protection of fictional characters. Over the years, the United States has set up a protection for these characters through case law. Three different tests have been created for the process of protecting these fictional characters: the *“sufficiently delineated test”*⁶⁶, the *“story being told” test*⁶⁷, and as the newest addition the *“three-part-test”*.⁶⁸

The first test to really mark the protection of fictional characters is the *“sufficiently delineated test”*, from the *Nichols v Universal Pictures Corporation* case. In his comment, Judge L. Hand states that *“the less developed the characters, the less they can be copyrighted: that is the penalty an author must bear for marking them too indistinctly”*.⁶⁹ In other words, the judge states that a character must be *“sufficiently delineated”* to be copyrightable. This statement seems to indicate that the author must describe and develop the character sufficiently, in order for it to be protectable by copyright. The court advocates a well-developed character.⁷⁰ This copyright protection is therefore not entitled to stock characters. The characters must be distinctive and, in that sense, their description has to be specific. The public must not risk confusing two different characters based on the lack of distinctiveness they bear towards each other. Some well-known characters have already been protected by copyright by virtue of this test. A few of these are *James Bond*⁷¹, *Mickey Mouse*⁷² or even *Tarzan*⁷³. However, this test is limited in terms of conditions, and therefore needs to be further developed.

Due to their deficiencies, the U.S. courts came up with a much more restricted test, that possesses conditions that are more difficult to satisfy. This test competes with the *“sufficiently delineated test”*, which bore a lack of standards in the protection of fictional characters.⁷⁴ *“The story being told” test* originated in the *Warner Bros Pictures v. CBS*⁷⁵ case, also called the *“Sam Spade case”*. The judge stated that only the main character of *“the story being told”* should be copyrightable. This test specifies the *“sufficiently delineated tests”*, but is also more restrictive. Indeed, the character cannot be stock and must be delineated. Therefore, this new test sets up a new condition which is that of the *“character of the story being told”* criterion.



Until “*the three-part-test*” came to life, the “*sufficiently delineated test*” and “*the story being told*” test were the only two standards within the scope of the protection of fictional characters. The “*story being told*” test replaced the older one by being more restrictive. This duality however caused struggles within and between courts on the subject of knowing which test had to be used at each instance. From court decisions, it is noticeable that literary characters have failed the “*story being told*” test.⁷⁶ Therefore, the judges favor the “*sufficiently delineated*” test for these specific literary characters.

Since 2015, fictional characters have also been protected by “*the three-part test*”. This test was invented in the context of the *Towle*⁷⁷ case. In this case, M. Mark Towle reproduced Batman’s car, named “*Batmobile*”, by making it into a real car. He sold it as the “*Batmobile vehicle*”, although DC Comics, which is the holder of all Batman intellectual property rights, had not given any authorization to do so. Mark Towle claimed that there was no protection of copyright for the “*Batmobile*”. Consequently, he was allowed to reproduce it.

The most important point in this case was to determine whether the “*Batmobile*” was entitled to its own copyright protection. To this end, the judges elaborated a new test in order to identify whether a fictional character is eligible for copyright protection. This test is composed of three parts, giving it its eponymous name.

Firstly, the character must have “*physical as well as conceptual qualities*.”⁷⁸

Secondly, the character must be original and “*sufficiently distinctive*.”⁷⁹ Indeed, the originality requirement is not sufficient on its own anymore. In the *Godzilla* case, in order to fulfil this criterion, the court stated that the character must be “*sufficiently delineated*” and must also be able to demonstrate “*consistent, widely identifiable traits*.”⁸⁰ This sufficient delineation is important in order for the public to recognize this character whenever it appears.⁸¹ The judges find it important for the traits and attributes of the characters to be persistent. Some well-known fictional characters obtained copyright protection by satisfying this requirement, such as *James Bond*⁸², *Batman*⁸³ or *Godzilla*.⁸⁴ This delineation concerns the character’s traits and attributes, not particularly its physical appearance. According to the U.S. Court of Appeals, the physical appearance is less significant than distinctive qualities.⁸⁵ In other words, a fictional character has better chances of being protected if it shows distinctive qualities, rather than just having its specific appearance. Physi-

cal traits alone are not sufficient in order to be protected by copyright.

Finally, the character must be “*especially distinctive*” and “*containing some unique elements of expression*.”⁸⁶ These phrases indicate that the character must have its own attributes and have a uniqueness to it. For instance, it cannot be a stock character such as, for instance, a magician who did not speak.⁸⁷ However, the *DC Comics v. Towle* case demonstrates that a car can be protected by U.S. copyright. At first sight, it may seem strange that a car is eligible to obtain this protection. In this case however, the “*Batmobile*” fulfilled all criteria of “*the three-part-test*”. It is sufficiently delineated and distinctive, with physical and conceptual qualities. The character is not necessarily a human, with the capacities to speak. However, if the character plays an important role in the work, by fulfilling the criteria, it is copyrightable.

The “*three-part-test*” has been recently applied throughout the “*Moodsters*”⁸⁸ case. The *Moodsters* in question are five anthropomorphized emotions. Each emotion is represented by a character via a specific color, e.g., red for anger. Originally, the characters were presented in a book, as literary characters, and in a television episode, as graphic characters. Later on, the *Moodsters* also became toys. After the release of Disney’s “*Inside Out*” film, whose pitch consists of the interaction of five anthropomorphized emotions inside of a girl’s brain, the author Daniels, creator of the *Moodsters*, sued the Walt Disney company for copyright infringement.

As a first step, the judge in this case took into consideration the “*three-part-test*”. As it was aforementioned, the test’s first criterion is “*physical as well conceptual qualities*” of the character. It is undeniable that the *Moodsters* each have their own physical appearance, their color, and conceptual qualities, as their emotions. They are not mere literary characters.⁸⁹ The fictional character, according to the test’s second criterion, has to “*be sufficiently distinctive to be recognizable as the same character whenever it appears*.”⁹⁰ In other words, the character has to have a consistent appearance and identifiable character traits and attributes. In this case, the *Moodsters* are identifiable through the color they are each represented with. However, using colors to represent emotions is apparently not a sufficient delineation and distinctiveness.⁹¹ Indeed, the use of colors to represent emotions is an idea or a concept and not an identifiable trait or attribute. Colors are not copyrightable by themselves.⁹² Ideas are not protected by copyright law under U.S. Code.⁹³

This “*three-part-test*” has become the reference to the protection of fictional characters thus far, and is in line with the “*sufficiently delineated*” test from 1930. The latest evolved in a more restrictive way. However, this test has some shortcomings, especially concerning literary characters. In the *DC Comics v. Towle* case, the Circuit Judge explicitly stated that this “*three-part-test*” concerned graphic and visual characters as opposed to “*mere literary characters*”, meaning it only concerned characters from comic books, television programs or motion pictures.⁹⁴ This distinction could be considered as a weakness of this new “*three-part-test*”.

Today, the “*three-part-test*” seems to have become a

benchmark for character protection testing in fiction. This test would therefore render the two previous tests obsolete, and they will and should probably not be used in the future.

3.2 U.S. Protection of fictional characters shortcomings

The “*story being told*” test and the “*three-part-test*” do not efficiently protect literary characters. Respectively, literary characters failed the first test, and have been explicitly excluded from the scope of the other one. It is difficult to comprehend such a decision, especially concerning the main characters of a novel. These characters are part of the story being told. For instance, why was Sam Spade not protected despite him being the main character of “*The Maltese Falcons*”? Why is there such a distinction between graphic and literary characters?

A special condition is required for literary characters which is not required for other graphic works. The work must be divided by explaining each character and each part of the literary work.⁹⁵ Otherwise, “*the story being told*” test applies, and the character will not be protected. This is questionable, since a musical work, for instance, is not broken down into each instrument.⁹⁶

Copyright protects the expression of an idea but not the idea itself. Concerning literary characters, the public has to imagine the character by means of its description. It is considered as an abstraction. This abstraction delineation of the literary characters differs from the physical delineation.⁹⁷ In the *Gaiman v. McFarlane* case⁹⁸, the judge stated that “[a] reader of unillustrated fiction completes the work in his mind”.⁹⁹ In other words, the reader’s imagination plays a large part in literary characters’ protection. However, one could argue that a literary character has traits and attributes. If the author describes the character in detail, in accordance with the “*three-part-test*” requirements, the literary character should be considered copyrightable.

Another issue caused by literary characters is the subjective aspect given to copyright. Through the imagination of the character, each person reading the story can have a different idea of the literary character described in the novel or short story.¹⁰⁰ This refers to the dichotomy between idea and its expression¹⁰¹: only the expression is protected, not the idea. A fictional character is more than an idea, since the author expresses the idea in words, by describing it. Each perception of the same story is different, and it is the same with literary characters. The problem is that this makes copyright subjective and not objective. The literary character must be well described. The reader has to properly remember the character rather than the plot, in order for the character to be protected by copyright. For instance, Sam Spade was not considered a copyrightable character because the plot and the atmosphere of the work he appeared in were more important than its main character.¹⁰²

This subject matter recalls the interrogation of whether a fictional character is a work or not. Divergences in the doctrine concerning the protection of fictional characters still appear: while some professors believe that a character is a part of a work and is not a copyrightable subject on its own,¹⁰³ others may think that fictional characters should not be considered as a copyrightable subject because the infringement would be too complex to establish.¹⁰⁴ However, this shows that incoherencies and legal uncertainties prevail in the protection of fictional characters.

Finally, literary characters require specific attention from judges. It is obvious that this type of fictional character differs from other characters such as in movies, TV shows or comic books. U.S. Courts employ the same test for all types of works and characters, although they are different and cannot be protected at the same level. Thus, a great lack of regulation regarding these literary characters needs to be addressed in the future, in order to deal with the inconsistencies.

⁷⁶ Lim TZE PING, “Beyond Copyright: Applying a Radical Idea-Expression Dichotomy to the Ownership of Fictional Characters” [2018] 21 Vand J Ent & Tech L 95, 108.

⁷⁷ *DC Comics v. Towle* (n68).

⁷⁸ *Walt Disney Productions v. Air Pirates* (n72), para 755.

⁷⁹ *Halicki Films, LLC v. Sanderson Sales & Mktg.*, 547 F.3d 1213, 1224 (9th Cir. 2008).

⁸⁰ *Toho Co., Ltd. v. William Morrow and Co., Inc.*, 33 F. Supp. 2d 1206 (C.D. Cal. 1998).

⁸¹ ROSATI (n29).

⁸² *MetroGoldwyn-Mayer, Inc. v. Am. Honda Motor Co.*, 900 F. Supp. 1287, 1295-96 (C.D. Cal. 1995).

⁸³ *Sapon v. DC Comics*, No. 00 CIV. 8992(WHP), 2002 WL 485730, at *3-4 (S.D.N.Y. Mar. 29, 2002).

⁸⁴ *Toho Co., Ltd. v. William Morrow and Co., Inc.*, (n78).

⁸⁵ *Warner Bros. Entm’t, Inc. v. X One X Prods.*,

644 F.3d 584, 599 n.8 (8th Cir. 2011).

⁸⁶ Opinion of IKUTA Circuit Judge, *DC Comics v. Towle*, 802 F.3d 1012 (9th Cir. 2015) 15.

⁸⁷ *Rice v. Fox Broadcasting Co.* 330 F.3d 1170 (9th Cir. 2003) para 1175.

⁸⁸ *Daniels v. The Walt Disney Co.*, No. 18-55635 (9th Cir. 2020).

⁸⁹ Opinion of McKEOWN Circuit Judge, *Daniels v. The Walt Disney Co.*, No. 18-55635 (9th Cir. 2020), 7.

⁹⁰ *DC Comics v. Towle* (n68).

⁹¹ *McKEOWN* (n87) 9.

⁹² Opinion of CARDAMONE, *Judi Boisson v. Banian, LTD.* 273 F.3d 262 (2d Cir. 2001).

⁹³ United States Code as enacted in 1947, title 17 – COPYRIGHTS §102(b).

⁹⁴ IKUTA (n84) 15.

⁹⁵ Jani McCUTCHEON, “Works of Fiction: The Misconception of Literary Characters as Copyright Works” (October 9, 2018). Journal of the Copyright Society of the USA (Forthcoming), Available at SSRN: <https://ssrn.com/abstract=3263155> or <http://dx.doi.org/10.2139/ssrn.3263155>, 7.

⁹⁶ *Ibid* 7.

⁹⁷ *Ibid* 17.

⁹⁸ *Gaiman v. McFarlane* 360 F.3d 644, 661 (2004).

⁹⁹ *Ibid* para 661.

¹⁰⁰ *McCutcheon* (n95) 18.

¹⁰¹ United States Code as enacted in 1947, title 17 – COPYRIGHTS §102(b).

¹⁰² Aaron SCHWABACH, ‘Fan Fiction and Copyright : Outsider Works and Intellectual Property Protection,’ Taylor & Francis Group, 2011, ProQuest Ebook Central, 32.

¹⁰³ Leslie KURTZ, ‘The Independent Legal Lives of Fictional Characters’, 3 WIS. L. REV. 429, 440 (1986).

¹⁰⁴ Francis NEVINS, ‘Copyright + Character = Catastrophe’, 39(4) J. COPYRIGHT SOC’Y U.S.A.303, 306 (1992) ; Analysis from *McCutcheon* (n95).

Setting aside the distinction between graphic and literary characters, another dilemma subsists. How are secondary and minor characters protected? “*The story being told*” test explicitly concerns main characters of the story, and not characters who are vehicles for the story being told.

Indeed, this test particularly focuses on the main characters, heroes of the story, whose stories are being told. This is a “*discrimination against secondary characters, however well-delineated*”.¹⁰⁵ Indeed, through this test, the U.S. Courts of Appeals for the second circuit completely put minor and secondary characters aside. Concerning literary characters, secondary and minor characters of this category will probably never be considered, since even main characters are not protected. However, concerning graphic secondary and/or minor characters, it should and could be considered. Depending on the circumstances of the case, the outcome is different. For instance, in the *DC Comics v.* case, the “*Batmobile*” appeared as a minor character, since the role of the car had an importance.

3.3 Conclusion of the comparison with USA

Even if the U.S. system of protection of fictional characters by copyright is limited in certain ways, it is undeniable that these characters are much better protected than in Europe. In addition to general copyright protection, the United States have indeed introduced specific criteria for fictional characters. This has therefore allowed for a more specific and effective protection of these characters.

The CJEU approach could gain much from observing and mimicking the U.S. approach. Through the U.S. approach, it can be observed that having a list¹⁰⁶ of subject matters for copyright is compatible with specific protection of fictional characters. They are not incompatible. Moreover, the criterion of fixation is not mandatory in accordance with the CJEU; the characters do not have the obligation to be perceived and to be identifiable. This is positive for literary characters which could be protected more efficiently. Therefore, these characters could have a better protection. Concerning the potential criteria, the

CJEU could learn from the “*three-part-test*” but including literary characters.

The EU does not have a specific protection framework for fictional characters. To be copyrightable, a fictional character must be a work, with a “sufficient” originality. Substantially, these criteria fulfill the requirements of the “*three-part-test*”.¹⁰⁷ The first and the third criteria of the “*three-part-test*” are related to the originality of the character, whereas the second step corresponds to the definition of a work in the sense of the *Levola Hengelo* case.¹⁰⁸ There is therefore not necessarily a need for specific regulation, since the substance of this test corresponds to what the European legislator applies. Moreover, unlike in the U.S., the CJEU is faced with very few cases involving fictional characters. Thus, it may not be worthwhile to introduce a specific regulation for fictional characters.

4. EU TRADEMARK PROTECTION OF FICTIONAL CHARACTERS

Another form of protection could enable fictional characters to be covered in another way, combined with copyright protection: trademark protection. A trademark may protect the shape of the character. However, it cannot theoretically protect the personality of the character. In other words, the physical appearance and aspect of the character is protected by trademark, whilst this is not the case for the immaterial attributes of this character. Nonetheless, one could wonder if a character’s personality could be protected through trademark protection. Issues may also arise during the trademark registration process.

4.1 The issue of distinctiveness

In order to be registered as a European trademark, the subject matter has to fulfill the requirements of Article 4 of the 2017 EUTMR¹⁰⁹. The sign should be considered as “*a badge of origin, regardless of the goods and services*”.¹¹⁰ However, the most important requirement is the distinctiveness of the sign, according to Article 7(1)(b) EUTMR.

¹⁰⁵ SCHWABACH (n102) 31.

¹⁰⁶ United States Code as enacted in 1947, title 17 – COPYRIGHTS §102(a).

¹⁰⁷ ROSATI (n29).

¹⁰⁸ Ibid.

¹⁰⁹ Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark (Text with EEA relevance).

¹¹⁰ EUIPO, “Trade mark guidelines” (EUIPO guidelines, 1 March 2021) <https://guidelines.euipo.europa.eu/1922895/1786763/trade-mark-guidelines/1-2-distinguishing-character> accessed 20 November 2021.

¹¹¹ Judgement of the 15th of January 2003, *Mystery*, T-99/01, EU:T:2003:7, para 37.

¹¹² Ilanah FHIMA and Dev.S GANGJEE, “The confusion test in European Trade Mark Law”

(Oxford University Press 2019), 139.

¹¹³ Ibid 140.

¹¹⁴ Judgement of the 18th of March 2015, *The Jungle Book*, EUIPO, R 118/2014-1.

¹¹⁵ Judgement of the 16th of November 2017, *Pinocchio*, EUIPO, cancellation decision no. 016875981.

¹¹⁶ *The Jungle Book* (n114) para 24.

¹¹⁷ Ibid para 29.

¹¹⁸ Vanessa BOUCHARA and Louise LACROIX, « la marque est-elle dans le titre ? Ou la protection des oeuvres audiovisuelles par le droit des marques » [Village Justice, 2 June 2020] available at <https://www.village-justice.com/articles/marque-est-elle-dans-titre-protection-des-oeuvres-audiovisuelles-par-droit-des-35555.html> accessed 21 November 2021.

¹¹⁹ Judgement of the 30th of June 2009, *Danjaq v.*

OHMI (Dr. No), TUE, T-435/05, ECLI:EU:T:2009:226.

¹²⁰ Ibid para 25.

¹²¹ *Danjaq v. OHMI* (Dr. No) (n119) para 27.

¹²² Judgement of the 18th of March 2016, *Karl-May-Verlag / OHMI - Constantin Film Produktion (WINNETOU)*, T-501/13, ECLI:EU:T:2016:161.

¹²³ Ibid para 63.

¹²⁴ Cancellation Division, CANCELLATION No 31 962 C, *Batman*.

¹²⁵ BOUCHARA and LACROIX (n118).

¹²⁶ Interview of Professor Yann BASIRE (Director General of CEIPI – Université de Strasbourg), 5th of March 2021, zoom.

¹²⁷ FHIMA and GANGJEE (n112) 140.

A relevant audience has to assess this distinctive character. Their “*degree of attention will be that of the average consumer who is reasonably well informed and reasonably observant and circumspect*.”¹¹¹

The distinctive character of a trademark can be inherent or acquired. In the first case, the distinctive character of a mark is inherent as the properties of the mark itself are considered in the absence of use and education of consumers to recognize the mark.¹¹² Conversely, the acquired distinctive character is based on a lack of inherent distinctiveness. This sign is considered having an acquired distinctive character through use if the consumer is educated to recognize this non-distinctive sign as a trademark denoting a single undertaking.¹¹³

The European Union Intellectual Property Office’s (EUIPO) case law regarding registration of fictional characters as trademarks is very fluctuating.

The EUIPO renders these decisions on a case-by-case basis. *The Jungle Book*¹¹⁴ and *Pinocchio*¹¹⁵ cases can be cited as examples. These two trademarks were refused registration by the EUIPO, on the grounds of lack of distinctiveness. In the case of *The Jungle Book*, the trademark was deemed not to be distinctive for DVDs and books. In this case, the EUIPO stated that the title of an artistic work may not benefit of trademark protection “*when the sign applied for is purely understood as a reference to the author’s work or type of story without any additional element which could impart distinctive character to the sign indicating the business origin*”¹¹⁶. Indeed, in this decision, the examiner adopted this decision because the relevant audience knows the story behind this title which was subject to several different adaptations.¹¹⁷ A good or service bearing this trademark would indicate the story of “*The Jungle Book*”, rather than the commercial origin. A similar reasoning is applied in the *Pinocchio* case. The registration of a *Pinocchio* trademark for figurines was rejected. “*Pinocchio*” was subject to several literary and audiovisual adaptations. Consequently, the name *Pinocchio* has “*entered the common language*” and does not allow for the identification of a commercial origin. In these cases, the distinctiveness is assessed regarding the goods and services designated by the trademark. They could logically guarantee the commercial origin of clothing or other goods, since they do not describe a characteristic of the product.¹¹⁸

Sometimes, controversies occur in the EUIPO’s decisions. The *Dr No* decision¹¹⁹ for instance concerned the title of the movie as well as the name of the character: Dr No. The EUIPO stated in this case that the name refers to the artistic origin rather than its commercial origin.¹²⁰ According to the EUIPO, the commercial origin is reflected through “*James Bond*” or the “*007*” sign. These signs refer to the successful series, which portray the commercial origin. The fact that Dr No is on the cover does not refer to the commercial origin. Concerning movies, sound records or books, “*Dr No*” turns out to be only descriptive of the goods in question.¹²¹

However, the EUIPO held the opposite thesis in other cases. Within the *Winnetou*¹²² case, the EUIPO stated that the name “*Winnetou*” was distinctive since the term does not refer to the film.¹²³ Thus, the commercial origin is gu-

aranteed, which allows for protection of film and related goods. The name of the “*Winnetou*” character is also protected. This shows that a fictional character’s name could be protected if it is sufficiently distinctive. A recent decision on Batman’s logo is also quite controversial and opens a debate on the distinctiveness of the character.

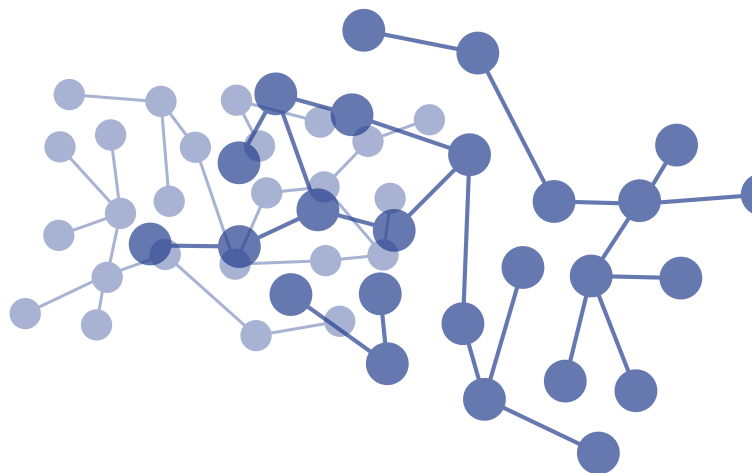
The requirement of distinctiveness regarding fictional characters is very controversial. Quite recently, the ruling on the Batman logo from May 21st, 2020 is evidence of this. In this decision, the judge established that the Batman logo can be registered as a trademark. He states that “*It follows that the contested EUTM will exclusively be associated by the public with the Batman character from the DC comics universe, and not to any other comics or superhero story or franchise.*”¹²⁴ In other words, when someone thinks of the Batman logo, they think directly of its commercial origin, namely D.C. Comics, instead of the character itself, due to its multiple adaptations as well as the longevity of the character.

This decision is open to debate. Indeed, the distinctiveness of the Batman logo and its direct reference to its commercial origin can be questioned. This decision confirms the position adopted in the *Winnetou* decision. It suggests a relaxation of the distinctiveness of trademarks referring to well-known characters.¹²⁵

This should not correspond to a relaxation of the jurisprudence but rather a favor administered to the world-famous character known as Batman, so that he in particular can be protected.

According to Professor Yann Basire¹²⁶, it is the responsibility of the competent authorities to check the conditions of a trademark before its registration. The *Batman* decision reflects a certain inconsistency in judicial decisions. However, the competent authorities could have found acquired distinctiveness to the character of Batman, since it is a world-famous character. To obtain this acquired distinctiveness, the consumer would need to recognize this non-distinctive sign as a trademark denoting a single undertaking.¹²⁷ In the case of Batman or his “*Batmobile*”, this should not be difficult, since they are well-known.

It will be interesting to look for future decisions of the EUIPO concerning the registration of fictional characters. Will they comply with the Batman ruling, or will the EUIPO become tougher, as it may have been in the past with rulings such as *Winnetou*?



4.2 The issue of protecting the personality via trademarks

Trademark protection can only exist in relation to goods and services. However, a fictional character is a character composed of both a physical appearance and a personality. Through trademark protection, the physical appearance is protected. *Quid* of the character's personality? Personality is a moral characteristic. *A priori*, it should not be protected by trademark.

Normally, protecting only a fictional character's appearance, and not its personality, by means of trademark legislation, does not appear to be problematic. However, one could imagine a fictional character as a unitary component. As the personality is a subjective matter, if a third party employed the personality of a determined fictional character to use it in a different way, one could wonder if a trademark law issue is raised. It is truly interesting to assess whether trademark law could also protect the personality of a fictional character. This is not necessary, but it is an interesting subject of study.

Protecting the personality of the fictional character through trademark can take place in more than one way. It can be sufficient to consider the fictional character as a well-known trademark. Thus, it can benefit from protection against dilution, free-riding and tarnishment. These last two hypotheses concern brand image. Through the protection of these images, it would be possible to protect the moral aspects of the character.¹²⁸ One could nevertheless wonder whether this would not be going too far and overstepping the essential functions of a trademark?

The EU offers a specific protection against dilution to trademarks which hold a certain level of recognition amongst consumers.¹²⁹ Indeed, this level of recognition is considered to be reached when "*the earlier mark is known by a significant part of the public concerned by the products or services covered by that trademark*".¹³⁰ This test is quantitative and not qualitative.¹³¹ In other words, the mark does not require to reach a certain level of prestige, luxury or simply to be particularly good to be well-known.

For assessing the well-known character of a trademark, the CJEU follows the test generated in the *General Motors* case. In this matter, the CJEU established that relevant factors to this test include: "*in particular the market share held by the trademark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it*".¹³² This list is not exhaustive, as EU courts retain a certain freedom to consider other factors besides the test.¹³³ This test is particularly similar to the one used to determine whether a sign has acquired distinctiveness. Some tribunals have even used the assessment of acquired distinctiveness to prove or disprove the trademark's reputation.¹³⁴

Therefore, a fictional character is considered as well-known when a significant part of the public is concerned by the product or services.

After demonstrating that the fictional character is well-known, it can obtain protection against dilution, free-riding and tarnishment. Once a mark is considered as well-known, the criterion of likelihood of confusion is not required anymore.

Both concepts of tarnishment and free-riding concern the brand's image and refer to the values conveyed by the brand. A value implies moral and intellectual characteristics. Therefore, through the protection of the trademark against free-riding and tarnishment, it would be possible to protect certain moral aspects of the fictional character. It would thus be possible to go beyond the function of trademark protection, which typically only protects the physical and material aspect of the character.

Consequently, if the owner of a protected fictional character has conveyed some value through it, which is a distinctive sign, these values are protected by trademark. Some aspects of a character's personality and morality, which refer to certain values, could be protected.

However, by protecting the values and thus certain intellectual characteristics of the character through trademark; would the essential function of the trademark not be exceeded? By protecting certain moral characteristics of the fictional character through the trademark; would this not run counter to the essential function of a trademark?

The essential function of a trademark is to distinguish the goods and services of one undertaking from others. Trademark protection occurs in the economic life of the trademark or concerning the goods and services specifically registered. However, when a well-known trademark is at hand, it does not matter if the issue concerning the trademark occurs in business life or concerns the goods and services. Indeed, the trademark is protected anyway.

In this sense, one could wonder whether the purpose of this protection by dilution tools is to protect the fictional character or the author.¹³⁵ It is important to be aware that the moral rights in copyright remain to the authors. In trademarks however, the owner of the trademark is not necessarily the author. In using these dilution tools, care should be taken because the interest of the owner is not necessarily the same as that of the author of the fictional character.¹³⁶ It might be in certain cases like, for instance, the use of a fictional character in a pornographic movie. This would engender a tarnishment of the trademark. To better protect the trademark, the interests of the owner should be the same as that of the author, even though this is not always the case.

However, it is questionable whether it is moral for the trademark to protect intellectual characteristics of a fictional character, even if it has a perfect right to do so.

The protection of the character's personality through the dilution tools of trademark law could, theoretically, work. However, in practice, it is not very useful. Indeed, the interest of protecting only the personality of a character can be questioned, since it is not the primary objective of trademark law. The only positive aspect could be the permanent and renewable protection of personality. But it is rare to perceive only the personality of the character, without taking into account its physical appearance.

4.3 Ground for refusal: *ordre public* and morality

As it was previously stated, a fictional character could be protected by trademark. However, in order to obtain this protection, the owner of a fictional character must ensure that the character does not fall into absolute grounds for refusal of protection, as provided by Article 7 of the EUTMR.

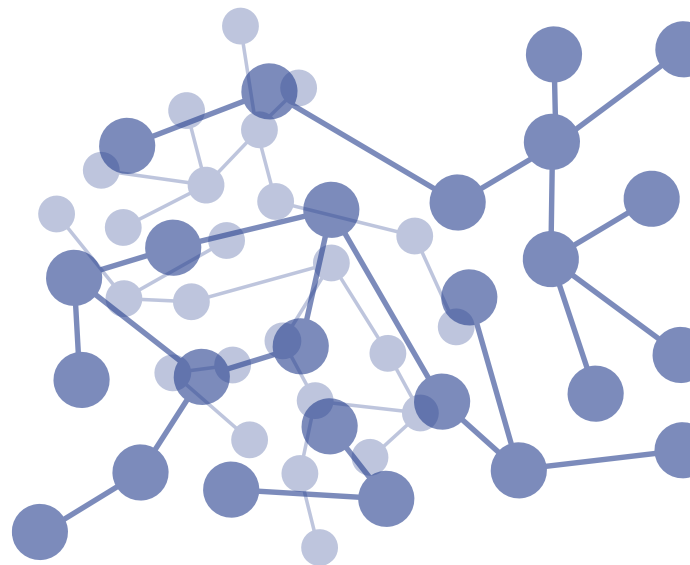
Public policy and morality are two absolute grounds for refusal in trademark, according to the Article 7(1)(f) EUTMR. The European Free Trade Association (EFTA) Court decision in the *Vigeland* case¹³⁷ is an illustration of public policy and morality with respect to trademark registration. The main purpose of the *Vigeland* case was to extend the intellectual property life of these artworks, by protecting them in another way, in order for them to not fall into the public domain. Indeed, through trademark protection, these works of art could have been protected for a long time, or even for an unlimited amount of time. Nevertheless, the EFTA Court did not accept this attempt to escape the public domain. Indeed, the Court based its decision on the interplay between copyright protection and public domain. It considered that a trademark “based entirely on copyright protected work carries a certain risk of monopolization of the sign for a specific purpose”.¹³⁸ Indeed, this registration grants the mark’s “proprietor such exclusivity and permanence of exploitation which not even the author of the work or his estate enjoyed”.¹³⁹ In other words, these artworks have so much cultural value to Norwegian society they must be kept free.¹⁴⁰ There is a fundamental societal interest in the temporal limitations of copyright protection, and the public domain principle in copyright law has societal value of its own.¹⁴¹

These two important notions can overlap but they are not synonymous.¹⁴² Public policy is an objective concept, based on objective criteria whereas “accepted principles of morality” is based on subjective values.¹⁴³ This decision defined a ground for refusal of a trademark registration for reasons of public policy and morality. Ground for refusal of a trademark registration based on public policy occurs only when “there is a genuine and sufficiently serious threat

to a fundamental interest of society”.¹⁴⁴ In addition, the EFTA Court stated that famous artwork, which is a part of the universal cultural heritage, “is a fundamental interest of society at stake, namely the interest of enabling access to these outstanding creations of the mind for everyone”.¹⁴⁵ On the other hand, the principle of morality is assessed on a case-by-case basis.¹⁴⁶ For instance, in this case, the artwork enjoyed the status of national cultural heritage, referring to an emblem of sovereignty, with certain of the nation’s foundations and values.¹⁴⁷ This trademark registration should be considered as a misappropriation or a discretion of the artist’s work under the morality principle.¹⁴⁸

Concerning the fictional character, these absolute grounds of public policy and morality could apply in certain ways. Indeed, based on the misappropriation or discretion of the artist’s work, a fictional character considered to be closely similar to another character could be refused.¹⁴⁹ This theory is more likely to be verified when the character is a cultural heritage of the country.¹⁵⁰

However, this decision, and more generally public policy and morality grounds for refusal, create a debate concerning the overlaps between copyright and trademark protection.



¹²⁸ Interview of Professor Yann BASIRE (Director General of CEIPI – Université de Strasbourg), 5th of March 2021, zoom.

¹²⁹ Ilanah FHIMA, ‘Trade Mark Dilution In Europe and the United States’ (Oxford University Press 2011), 21.

¹³⁰ *General Motors Corporation v. Uplon SA*, judgment of the 14th of September 1999, C-375/97, ECLI:EU:C:1999:408, para 26.

¹³¹ EUIPO (n110).

¹³² *General Motors* (n130) para 27.

¹³³ *Ibid* 34.

¹³⁴ See. IPO, Forever Wedding Rings O-098-11, 9 march 2011, para 79.

¹³⁵ Interview of Professor Eleonora ROSATI (Professor), 23rd of April 2021, zoom

¹³⁶ *Ibid*.

¹³⁷ EFTA Court, *Municipality of Oslo*, Case E-5/16.

¹³⁸ *Municipality of Oslo* (n137) para 70.

¹³⁹ *Ibid*.

¹⁴⁰ Martin SENFTLEBEN: ‘The Copyright/ Trademark Interface – “How the Expansion of Trademark Protection is Stifling Cultural Creativity”’, 19th of March 2021, available at: https://www.youtube.com/watch?v=UZc_mEz-mip4&t=514s accessed 23 November 2021.

¹⁴¹ *Ibid*.

¹⁴² Eleonora 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’ [2020] 15(2) Journal of Intellectual Property Law & Practice 103-122, 28.

¹⁴³ *Municipality of Oslo* (n137) paras 85 and 86.

¹⁴⁴ *Ibid* para 59.

¹⁴⁵ *Ibid*.

¹⁴⁶ *Ibid* (n137) para 55.

¹⁴⁷ *Ibid* para 92.

¹⁴⁸ *Ibid*.

¹⁴⁹ ROSATI (n29) 9.

¹⁵⁰ *Ibid*.

4.4 The overlaps between copyright and trademark protection

After previous discussion concerning the protection of fictional characters through copyright and trademarks, it can be deduced that each of these protections has its strengths and weaknesses. While copyright protection may allow the protection of a character in its entirety, whether visual or intellectual, it lasts for a limited period of 70 years after the death of the creator.¹⁵¹ As for trademark protection, only the name and the visual appearance can be truly protected, and in some cases certain intellectual characteristics. However, protection is only available for predefined goods and services, and in the course of trade. On the other hand, protection can be renewed every ten years, indefinitely. Therefore, it seems logical to consider the possibility of cumulating the two protections in order to obtain a better and longer lasting protection for a fictional character.

In EU law, the cumulation of intellectual property rights is expressly acknowledged.¹⁵² Therefore, copyright and trademark protection could be cumulated. The question arising is the following: would this accumulation not distort the essence of each one of the protections, trademark in particular? Could trademarks be used to divert fictional characters from the public domain and thus extend the intellectual property life of the character?

This question highly divides authors in doctrine. According to Martin Senftleben, copyright is a cyclic innovation system.¹⁵³ This implies that the work of the first author serves as a basis for other authors in derivative works. In other words, the author uses the public domain as a source material to create his new work. The essence of copyright law is to protect the work for a limited period of time, before it then falls into the public domain, where it could be used in another way. At the opposite end of the

spectrum, trademark protection was imagined to enable a distinctive sign to escape public domain.¹⁵⁴ The owner of a trademark keeps it as long as he or she uses it in trade.¹⁵⁵ Trademark has become a standard protection strategy for character merchandising.¹⁵⁶ For instance, *Mickey Mouse*¹⁵⁷, *Asterix*¹⁵⁸ and *Obelix*¹⁵⁹ as well as *Snow-white*¹⁶⁰ are famous fictional characters, but also trademarks. Indeed, copyrighted work must by nature fall into the public domain at some point in time. The concern with trademark protection is that the creator will take the work out of the public domain to extend its life, which subverts the main function of copyright.

However, this position has to be nuanced. There is a big semantic difference between the two types of protection.¹⁶¹ Indeed, copyright law concerns a work while trademark law protects a sign. In the same way, copyright law concerns the public whereas trademark law concerns the average consumer. The two fields of law are totally dissimilar, and their respective domains are completely different. Professors Yann Basire and Eleonora Rosati both agree that the issue resides in the relevant authorities, which do not show the necessary rigor that should be required in this situation. For instance, the public policy ground might be used in order to preserve the public domain. It might be that an office takes the view that the registration of a fictional character whose copyright has expired should be prohibited in this particular scenario because it would be a way to circumvent the system.¹⁶² Relevant authorities have to make sure that the broader goal of intellectual property protection, such as maintaining the public domain, are safeguarded. It is quite normal for a well-known trademark or franchise to want to be protected for as long as possible, in order to commercialize certain merchandise. In this case, the intellectual property overlaps could be authorized.

¹⁵¹ Article 1, Directive 2006/116/EC Of The European Parliament And Of The Council of 12 December 2006 on the term of protection of copyright and certain related rights.

¹⁵² CDR [n6], Recitals 31 and 32.

¹⁵³ SENFTLEBEN [n140].

¹⁵⁴ Ibid.

¹⁵⁵ Ibid.

¹⁵⁶ Ibid.

¹⁵⁷ EUTMs 002827426 and 005240668.

¹⁵⁸ EUTMs 000016147 and 002794162.

¹⁵⁹ EUTMs 000016154 and 002793545.

¹⁶⁰ EUTM 011571511.

¹⁶¹ Interview of Professor Yann BASIRE (Director

General of CEIPI – Université de Strasbourg), 5th of March 2021, zoom.

¹⁶² Interview of Professor Eleonora ROSATI (Professor), 23rd of April 2021, zoom.

5. CONCLUSION

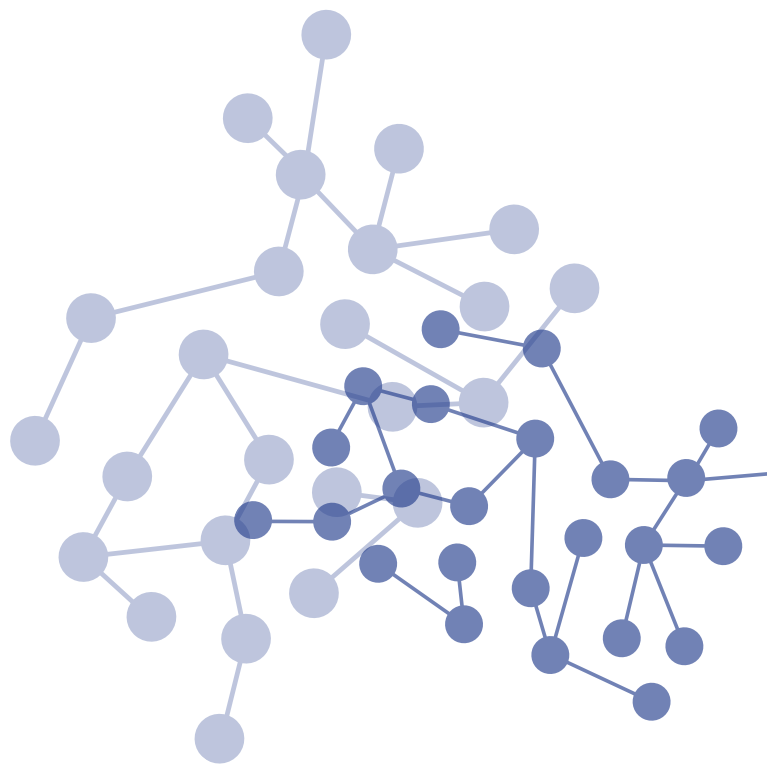
This article highlights some problems concerning the protection of fictional characters and provides some recommendations about improving it. The current EU protection of fictional characters is sufficient, but could be enhanced. A specific protection is not useful in practice but could all the while be considered, in order to recognize and give credit to fictional characters. Fictional characters seem not very important in the EU, less than in the United States at least, as reflected by the lack of EU litigation on the subject.

Regarding copyright protection for fictional characters, whether in the EU or the U.S. system, coverage should differentiate characters by category. Therefore, literary characters in novels should not be subject to the same test as graphic or comic characters, since they exist in a different medium, by definition. In the case of comic characters, physical appearance is objectively and easily identifiable, whereas this is not the case for literary characters. The author of this paper believes that there should be more litigation before the CJEU in order to establish several criteria that would be useful.

The author of this paper also believes that trademark protection is a great protection for fictional characters. She understands that the creator of well-known characters, e.g. *Mickey Mouse* or *James Bond*, would aspire to obtain trademark protection, in order to protect it permanently in economic life. According to her, the registration of a trademark should be authorized because this is not a way to encompass the public domain. She agrees with the position of Professor Yann Basire, stating that these are two different areas, which could perfectly be cumulated. But this registration should be executed in respect to trademark requirements. The author of the paper also suggests to competent authorities to carefully and diligently

analyze each registration, especially in regards to the distinctiveness requirement. A trademark of a fictional character should be “a badge of origin”, without referring to the character itself. This is quite a sensitive topic, given the fact that certain well-known characters are registered, whilst one could doubt their original badge, like *Batman* for instance. The author personally thinks of the character of Batman when she sees Batman, and she does not think of the DC Comics company. In this particular case, the registration of the trademark goes beyond the primary functions of trademark law. It could however be granted for characters such as *Mickey Mouse*, where one thinks directly of Disney.

From now on, it would be interesting to study future cases concerning fictional characters, whether at national or European level, to observe if a new criterion will be generated by relevant courts.



Valentine Labaume

Valentine Labaume is a current master student in media law at Assas University in Paris and pursuing an apprenticeship at Xilam Animation Studio. After obtaining her bachelor's degree at Paris-Saclay University, she completed a Master's degree in European Intellectual Property Law (LL.M.) at Stockholm University in 2020-2021. In this programme, she submitted her master thesis on the protection of fictional characters under EU intellectual property law.