The Unfairness of Overlapping Rights: the Case Against Trademark and Copyright Protection Overlaps

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In this paper, I criticize the practice of using trademark law in addition to, or instead of, copyright law to grant exclusive rights on a variety of creative works, including characters, illustrations, pictures, artistic works, aesthetically pleasing designs, and so forth. My analysis focuses primarily on U.S. law but includes extensive comparison with EU law and other countries. Notably, I argue that, regardless of whether creative works can theoretically fit under both sets of copyright and trademark protection, extending trademark protection to creative works inevitably results in breaching the societal bargain upon which copyright law and policies were originally built. In other words, this protection is unfair and frequently it could be said that it is against the public interest.

At the outset, I highlight the different origin, and societal bargain at the basis of copyright and trademark law respectively. In particular, I emphasize how the two sets of laws serve different purposes and protect different subject matters: copyright law is meant to protect works of authorship against copying and related rights, while trademark law is meant to protect distinctive signs that are used in the course of trade to signal commercial origin so as to avoid that consumers are confused by inappropriate uses of these signs. Because of their different purposes, copyright and trademark law follow different rules formality requirements, infringement, and most importantly duration.

Yet, throughout the past decades, it has been argued with increased force that the subject matter protected under copyright and trademark protection may overlap because creative works can function both be a creative works and distinctive signs. Areas where the traditional contours of copyright and trademark law can overlap are, for example, the protection of logos and other artistic signs or emblems used in the course of trade; the protection of slogan and short sentences also used in the course of trade; the protection of fictional characters used as indicators of commercial origin, sponsorship, or affiliation; the protection of the aesthetic or artistic features of objects of industrial or fashion design; and so on.

When these overlaps occur, however, one form of protection permits to prolong or reinforce the intellectual property monopoly on a specific item—a logo, a character, a slogan, etc.—by exploiting the differences between copyright and trademark protection. Not surprisingly, intellectual property practitioners have been quickly at noticing the "opportunities" created by the possibility of cumulating copyright and trademark protection for the same items. Yet, this opportunistic exploitation of overlapping copyright and trademark protection is problematic, frequently a threat for competition and freedom of expression and, ultimately it is a breach of the societal bargain at the basis of copyright and trademark law and policies.

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