

# The Copyright-Trademark Registration Puzzle

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# The Puzzle

- The United States has historically embraced registration for copyright, but not for trade marks (for which protection is grounded in use)
- Europe has favoured basing trade mark protection on registration (rather than use), but since the late 19<sup>th</sup>/early 20<sup>th</sup> century has granted copyright protection without formality

# Schematic of the Puzzle

	United States	Europe
Registration	Copyright	Trade Marks
Automatic	Trademarks (use)	Copyright

# The Implications of the Paradox?

- Does it suggest that Europe is not fundamentally “anti-registration”?
- Or that (as Jane Ginsburg suggested that a cynic might suggest) the US supports corporate actors but not individuals (“the unwary”)?
- Or that the adoption of registration for copyright or trade marks is as much a matter of historical accident as logic?

# The History Of Copyright Formalities

- Stef van Gompel, Ch 3
- 18<sup>th</sup>-19<sup>th</sup> Centuries – All countries had formalities, esp registration
- Late nineteenth century – European countries started to abandon, whereas in 20<sup>th</sup> Century US retained (though not a constitutive from 1909, just condition precedent to action – still retained for US works)
- Why?

# Van Gompel's explanations

- Rise in natural rights accounts of copyright in EU
- Emergence of authorship-thinking
- Abstract notion of the work
- No real benefits achieved from registration
- Cf. US public-interest orientation, and belief that were real benefits (identifying ownership, whether in public domain etc)

# History of Trade Mark Formalities

- First recognition (in Great Britain at least) in the context of common law, based on use
- Mid-nineteenth century onwards – French law of 1857 (replacing 1803 law where mere condition for bringing action), GB rejected in 1862 but adopted in 1875 (many colonies did so before then)
- But US attempt at federal registration Act, 1870, was held unconstitutional in *Trade-Marks Cases* (1879) 102 US 82 (leaving only constitutional basis as the Commerce clause)

# Explanations

- Principle that exclusivity in a mark derives from public associations which are only engendered through use
- Scepticism about value (Nota McGill tract, 1912; echoed in Burrell, 'Trademark Bureaucracies')
- Cf
- Perceived public benefits in terms of notice/evidence from registration
- Advantages in allowing registration before use – priority, avoid wasted expenditure



# Rethinking the Schematic

	Creation	Registration	Use
United States		Copyright	Trademarks
Europe	Copyright	Trade Marks	

# Analysis of schematic

- Replacing binary 'registration/automatic' with 'creation/registration/use'
- Rather than paradox, the approaches now have some consistency: the US chooses the most taxing option (registration rather than creation for copyright, use rather than registration for trade mark)

# Explaining the New Schematic

- The US has a consistently greater emphasis on the public benefit/restricting availability of TMs and Copyrights
- More plausibly, the US scheme has been less influenced by internationalisation (and has been less amenable to foreign claims)

# Internationalisation and Registration in Trade Marks

- Registration systems in trade mark law are as much a product of internationalisation as practical domestic benefits. As Paul Duguid (2009) has argued “Anglo-Saxon trademark law was international before it was national.”
- French 1857 law allowed foreigners to bring actions “if in the countries where they are situated diplomatic conventions have established reciprocity for French marks.”
- Registration allows traders to claim foreign rights based in domestic activities (Paris Art 6 quinquies, Madrid Agreement and Protocol)
- Limited international recognition of use-based rights (Paris, Art 6bis, on well-known marks)

# Internationalisation and Registration in Copyright

- Van Gompel, Ch 4, explains – late nineteenth century moves to registration in country of origin only
- Berne (Berlin Revision 1908): no formality. Key influence on eg UK and Netherlands.
- US notoriously remained outside until 1989, and then retained aspects of registration as far as compatible (registration as condition to sue for US-works only, no statutory damages/attorney fees for pre regn)

# Lessons from the Trademark-Copyright Registration Paradox

- Registration not intrinsically good or bad – may facilitate internationalisation (trade marks) or not (copyright)
- Those who want to re-formalise copyright need to demonstrate how – today - formalities will assist international protection
- This may not be implausible. A database of rights information is less obstructive than it once would have been, and thus could be attractive enough to be adopted voluntarily. Mild legal incentives might be sufficient to stimulate.