

List of works cited

I. National Statutes

1. United States of America

Lanham (Trademark) Act, 15 U.S.C. §§ 1051 et seq. (2013).

Trademark Law Revision Act of 1988, Pub. L. No. 100-667, Stat 3935 (Nov 16, 1989) amending 15 U.S.C. 1051 et. seq.

U.S. Copyright Act, 17 U.S.C. §§ 101 et seq. (2013).

2. European Union

a) Community Statutes

Directive 2008/95/EC, of the European Parliament and the Council of 22 October 2008 to approximate the Laws of the Member States Relating to Trade Marks, O.J. (L 299) 25 – “Trade Mark Directive”.

Commission Regulation EC No. 2868/95 of 13 December 1995, implementing Council regulation (EC) 40/94 on the Community Trade Mark O.J. (L 303).

b) Austria

Markenschutzgesetz 1970, BGBl 1970/260 idF 2009/126 (Austrian Trademark Act) (2013).

Bundesgesetz über das Urheberrecht an Werken der Literatur und der Kunst und über verwandte Schutzrechte – Urheberrechtsgesetz, BGBl 111/1936 idF 2010/58 (Austrian Copyright Act) (2013).

c) Germany

Gesetz über den Schutz von Marken und sonstigen Kennzeichen – Markengesetz [MarkenG] [Trade Marks Act], Oct. 25, 1994 Bundesgesetzblatt [BGBl] I S. 3082 as amended.

Gesetz über Urheberrecht und Verwandte Schutzrechte – Urheberrechtsgesetz [UrhG] [Copyright Act], Sept. 9, 1965 Bundesgesetzblatt [BGBl] S. 1273 as amended.

Gesetz gegen den unlauteren Wettbewerb [UWG] [Unfair Competition Act], May 27, 1896, Bundesgesetzblatt [BGBl] I S 254, as amended.

II. Court Rulings and other decisions

1. United States of America

A.J. Canfield Co. v. Honickman 808 F.2d 291, 296 (3d Cir. 1986).

American Paging Inc. v. American Mobilephone, Inc. 13 U.S.P.Q.2d (BNA) 2036 (T.T.A.B. 1989), aff'd 923 F.2d 869, 17 U.S.P.Q. 1726 (Fed Cir. 1990).

Banff Ltd v. Federated Dep't Stores, Inc., 841 F.2d 486 (2d Cir. 1988).

Bonito Boats, Inc. v. Thunder Craft Boats, Inc. 489 U.S. 141 (1989).

Booth v. Colgate-Palmolive Company 362 F. Supp. 343 (S.D.N.Y. 1973).

Boston Professional Hockey Association, Inc. v. Dallas Cap & Emblem Mfg., Inc. 510 F.2d 1004 (5th Cir. 1975).

Burroughs v. Metro-Goldwyn-Mayer Inc., 683 F.2d 610 (2d Cir. 1982).

Ex parte Carter Publications 92 U.S.P.Q. (BNA) 251 (Comm'r Pat. & Trademarks 1952).

In re: Circus Foods, Inc., 252 F.2d 310 (C.C.P.A. 1958).

In re Celia Clarke 17 U.S.P.Q.2d (BNA) 1238 (T.T.A.B. 1990).

Coca-Cola Co. v. Rodriguez Flavouring Syrups Inc., 89 U.S.P.Q. 36 (Chief Examiner 1951).

Columbia Broadcasting System, Inc. v. DeCosta, 377 F.2d 315 (1st Cir. 1967).

Comedy III Productions, Inc v. New Line Cinema, 200 F.3d 593 (4th Cir. 1999).

Conan Properties; Inc. v. Conans Pizza, Inc., 752 F.2d 145 (5th Cir. 1985).

Dastar Corp. v. Twentieth Century Fox Film Corp. 539 U.S. 23 (2003).

In re DC Comics, 689 F.2d 1042 (C.C.P.A. 1982).

DC Comics, Inc. v. Filmation Associates, 486 F.Supp. 1273 (S.D.N.Y. 1980).

Detective Comics, Inc. v. Bruns Publications, Inc. 111 F.2d 432 (S.D.N.Y. 1940).

- E. Wine Corp. v. Winslow-Warren, Ltd. 137 F.2d 955 (2d Cir. 1943).
- Feist Publications, Inc. v. Rural Tel. Service, 499 U.S. 340 (1991).
- Fleischer Studios Inc. v. A.V.E.L.A, Inc. 772 F.Supp. 2d 1155 (9th Cir 2011).
- Groucho Marx Prods. v. Day & Night Co., 523 F. Supp. 485 (S.D.N.Y. 1981).
- Hanover Star Milling Co. v. Metcalf 240 U.S. 403 (1916).
- Harry C. Fisher v. Star Company 231 N.Y. 414, 132 N.E. 133, cert denied 257 U.S. 654 (N.Y. 1921).
- Harvey Cartoons v. Columbia Pictures Indus. 645 F.Supp. 1564 (S.D.N.Y. 1986).
- Hess's of Allenton, Inc. v. National Bellas Hess, Inc., 169 U.S.P.Q. (BNA) 673 (1971).
- Ideal Toys Corp. v. Kenner Products, 443 F. Supp 291 (S.D.N.Y. 1977).
- Ilco Corporation v. Ideal Security Hardware Corporation, 527 F.2d 1221 (1976).
- Jantzen Knitting Mills v. Spokane Knitting Mills Inc., 44 F.2d 656 (D. Wash 1930).
- Lahr v. Adell Chem. Co., 300 F.2d 256 (1st Cir. 1962).
- Metro-Goldwyn-Mayer, Inc. v. Am. Honda Corp., 900 F. Supp. 1287, (C.D. Cal 1995).
- MGM-Pathé Communications Co. v. The Pink Panther Patrol, 774 F.Supp. 869 (S.D. N.Y. 1991).
- Microstrategy, Inc. v. Motorola, Inc, 245 F.3d 335 at (4th Cir. 2001).
- Moseley v. V Secret Catalogue, Inc. 537 U.S. 418 (2003).
- National Comics Publ'n, Inc. v. Fawcett Publ'n, Inc., 191 F.2d 594 (2d Cir. 1951).
- Nichols v. Universal Pictures Corporation, 45 F.2d 119 (1930).
- Oliveira v. Frito-Lay, 251 F.3d 56 (2nd Cir. 2001).
- One Industries, LLC v. Jim O'Neal Distributing Inc., 578 F.3d 1154 (9th Cir. 2009).
- In re: Nuclear Research Corporation, 16 U.S.P.Q.2D (BNA) 1316 (1990).
- Persha v. Amour & Co., 239 F.2d 628 (5th Cir. 1957).
- Philip Morris Inc. v. Star Tobacco Corp., 879 F. Supp 379 (S.D.N.Y. 1995)
- Pillsbury Co. v. Milky Way Prods. 215 U.S.P.Q. (BNA) 124 (N.D. Ga. 1981).
- Polaroid Corp. v. Polarad Electronics Corp., 287 F.2d 492, 495 (2d Cir. 1961).
- Prestonettes, Inc. v. COTY, 264 U.S. 359 (1924).
- Qualitex Co. v. Jacobson Products Co. 514 U.S. 159 (1995).
- Rescuecom, Corp. v. Google, Inc. 562 F.3d 123 (2nd Cir. 2009).
- Rice v. Fox Broad Co. 330 F.3d 1170 (9th Cir. 2003).

List of works cited

- Sid & Marty Krofft Television Productions v. McDonald's Corp. 562 F.2d 1157 (9th Cir. 1977).
- T.A.B. Systems v. PacTel Teletrac, 77 F.3d 1372 (Fed. Cir. 1996).
- Timothy Anderson v. Sylvester Stallone 11 U.S.P.Q.2d (BNA) 1161 (C.D. Cal 1989).
- Toho Co., Ltd. v. William Morrow and Company, Inc., 33 F. Supp. 2d 1206 (C.D. Cal 1998).
- Traffix Devices, Inc. v. Mktg. Displays Inc., 532 U.S. 23, 34 (2001).
- Troy Walker v. Viacom International, Inc., No. C 06-4931 SI, 2008 U.S. Dist. LEXIS 38882.
- Union Mfg. Co. v. Han Baek Trading Co. 763 F.2d 42, 47-48 (2d Cir. 1985).
- United Artists vs. Ford Motor Co., 483 F. Supp. 89 (S.D.N.Y. 1980).
- Universal City Studios, Inc. v. J.A.R. SALES, Inc., 216 U.S.P.Q. 679 (C.D. Cal 1982).
- Patten v. Superior Talking Pictures, 8 F. Supp. 196 (D.C.N.Y. 1934).
- Van Dyne-Crotty, Inc. v. Wear-Guard Corp., 926 F.2d 1156, (Fed. Cir. 1991).
- Wal-Mart Stores, Inc. v. Samara Brothers, Inc. 529 U.S. 205 (2000).
- Walker v. Viacom International, Inc. No. C 06-4931 SI, 2008 U.S. Dist. LEXIS 38882 (2008).
- Walt Disney Co. v. Powell, 698 F. Supp. 10 (D.C.C. 1988).
- Walt Disney Productions v. The AIR PIRATES et. al., 345 F.Supp. 108 (1972).
- Warner Bros. Pictures, Inc. v. Columbia Broadcasting Sys., 216 F.2d 945 (9th Cir. 1954).
- Zazu Designs v. L'Oreal, S.A., 979 F.2d 499, 504 (7th Cir. 1992).

2. European Union

- Case C-206/01, Arsenal Football Club plc v. Matthew Reed, 2002 E.C.R. I-10273.
- Case C-393/09 Bezpečnostní softwarová asociace v. Ministerstvo kultury 2010 E.C.R. I- 13971.
- Case C-102/77, Hoffmann-La Roche & Co., AG et. al v. Centrapharm Vertriebsgesellschaft Pharmazeutischer Erzeugnisse, m.b.H. 1978 E.C.R. 1139.
- Case C-234/06, Il Ponte Finanziaria SpA v. OHIM et. al., 2007 E.C.R. I-7333.
- Case C-5/08 Infopaq Int'l A/S v. Danske Dagblades Forening 2009 E.C.R. I-6569.
- Case C-299/99, Koninklijke Philips Electronics NV v. Remington Consumer Products Ltd., 2002 E.C.R. I-5475.
- Case C-104/01, Libertel Groep BV v. Benelux Merkenbureau 2003 E.C.R. I-3793.
- Case C-487/07, L'Oréal SA et. al. v. Bellure NV et. al. 2009 E.C.R. I-5185.

- Case C-273/00, Ralf Sieckmann v. Deutsches Patent- und Markenamt, 2002 E.C.R. I-11737.
- Case C-283/01, Shield Mark BV v. Joost Kist 2003 E.C.R. I-14313.
- Case C-252/12, Specsavers Int'l Healthcare, Ltd. et. al. v. Asda Stores, Ltd. Jul. 18, 2013; available at <http://curia.europa.eu>.
- Case T-482/08 Atlas Transport v. OHIM 2010 E.C.R. II-108.
- Case T-353/07 Esber SA v. OHIM, 2009 E.C.R. II-226 “Coloris”.
- Case T-135/04 GfK AG v. OHIM, 2005 E.C.R. II-04865.
- Case T-194/03, Il Ponte Finanziaria SpA v. OHIM et. al., 2006 E.C.R II-445.

3. Great Britain

Holly Hobbie Trade Mark, (1984) 329 R.P.C. (H. L.).

4. Germany

- BGH Dec. 13, 2007, GRUR 2008, 714.
- BGH Feb 8, 2007, GRUR 2007, 592.
- BGH Jan 20, 2005, GRUR 2005, 515.
- BGH Aug 28, 2003, GRUR 2003, 1047 “Kellogg's/Kelly's”.
- BGH Dec. 5, 2002, GRUR 2003, 812 “Abschlussstück”.
- BGH Dec. 20, 2001, GRUR 2002, 812 “Frühstücks-Drink II”.
- BGH Dec. 6, 2001, GRUR 2002, 814 “Festspielhaus”.
- BGH Apr 13, 2000, GRUR 2001, 54 “SUBWAY/Subwear”.
- BGH Mar. 30, 2000, GRUR 2000, 1038.
- BGH Jul. 9 1998, GRUR 1999, 54.
- BGH Mar. 11, 1993, GRUR 1994, 191 “Asterix-Persiflagen”.
- BGH Dec. 10, 1987 GRUR 1988, 533.
- BGH Apr. 17, 1986, GRUR 1986, 892 “Gaucho”.
- BGH July 12, 1984 GRUR 1985, 46 “Idee Kaffee”
- BGH June 20, 1984, GRUR 1984, 872 “Wurstmühle”.
- BGH May 17, 1984 GRUR 1984, 813 “Ski-Delial”
- BGH July 13, 1979, GRUR 1979, 856 “Flexiole”.
- BGH May 31, 1975, GRUR 1975, 135.
- BGH Dec. 8, 1959, GRUR 1960 251 “Mecki II”.
- BGH Apr. 1, 1958, GRUR 1958, 500 “Mecki-Igel”.
- BGH Nov. 15, 1957, GRUR 1958, 54 “Sherlock Holmes”.

List of works cited

Press release, BGH, Urheberrechtlicher Schutz einer literarischen Figur [Copyright Protection of a Literary Character] (concerning the unpublished judgement BGH July 17, 2013, I ZR 52/12), available at <http://juris.bundesgerichtshof.de>.

BPatG Apr 11, 2000, BPatGE 43 “COBRA BOSS”.

BPatG Feb. 16, 2000, 28 W (pat) 80/99.

BPatG Feb 14, 1995, BPatGE 35 “Jeannette”.

OLG Köln Oct. 14, 2011, 6 U 128/11.

OLG Hamburg Mar. 22, 2006, GRUR-RR 2006, 408 “OBELIX”.

OLG Frankfurt am Main Feb. 23, 1984 GRUR 1984, 520 “Schlumpfe”.

LG Kiel Apr. 28, 2011, 15 O 22/11.

LG Köln Dec. 12, 2012, GRUR-RR 2013, 102.

LG Hamburg Apr. 28, 2009, ZUM 2009, 581.

LG Berlin Aug. 11, 2009 ZUM 2010, 69.

5. Austria

OGH Mar. 20, 2003, docket No., 6 Ob 270/01a, available at <http://ris.bka.gv.at>.

6. International law

Paris Convention for the Protection of Industrial Property Art. 5, Mar. 20, 1883, 21 U.S.T. 1583, 828 U.N.T.S. 305.

III. Journal Articles/Reports

1. United States of America

Robert G. Bone, *Enforcement Costs and Trademark Puzzles*, 90 Va. L. Rev. 2099 (2004).

Ralph Brown, *Advertising and the Public Interest, Legal Protection of Trade Symbols*, 57 Yale L.J. 1206 (1948).

E. Fulton Brylawski, *Protection of Characters – Sam Spade revisited*, 22 Bull. Copyright Soc’y 77 (1974).

Lee Burgunder, *The Scoop on Betty Boop: A Proposal to Limit Overreaching Trademarks*, 32 Loy. L.A. Ent. L. Rev. 257 (2011-2012).

- Lee Burgunder, *Trademark Registration of Product Colours: Issues and Answers*, 26 Santa Clara L.Rev. 581 (1986).
- Irene Calboli, *The Case for a Limited Protection of Trademark Merchandising*, 2011 U. Ill. L. Rev. 865 (2011).
- Graeme Dinwoodie, *Trademark and Copyright: Complements or Competitors?*, Proceedings of the ALAI Congress, June 13-17, 2001.
- Giselle Fahimian, *How the IP Guerrillas Won: Trademark, Adbusters, Negativeland, and the "Bullying Back" of Creative Freedom and Social Commentary*, 2004 Stan. Tech. L. Rev. 1 (2004).
- David B. Feldman, *Finding a Home for Fictional Characters: A Proposal for Change in Copyright Protection*, 78 Calif. L. Rev. 687 (1990).
- Anne-Virginie Gaide, *Copyright, Trademarks and Trade Dress: Overlap or Conflict for Cartoon Characters?*, Proceedings of the ALAI Congress, June 13-17, 2001.
- Judith Garretson & Roland Niedrich, *Spokes-Characters – Creating Character Trust and Positive Brand Attitudes*, Journal of Advertising, volume 33, no. 2 (2004), 25-36.
- Benjamin A. Goldberger, *How the "Summer of the Spinoff" Came to be: The Branding of Characters in American Mass Media*, 23 Loy. L.A. Ent. L. Rev. 301 (2003).
- Paul Goldstein, *The Competitive Mandate: From Sears to Lear*, 59 Cal. L. Rev. 873 (1971).
- Michael Todd Helfland, *When Mickey Mouse Is as Strong as Superman: The Convergence of Intellectual Property Laws to Protect Fictional Literary and Pictorial Characters*, 44 Stan. L. Rev. 623 (1992).
- Jennifer Konefal, *Federal Trademark Law in an Uncertain State*, 11 B.U. J. Sci. & Tech. L. 283 (2005).
- Leslie Kurtz, *The Independent Legal Lives of Fictional Characters*, 1986 Wis. L. Rev 429 (1986).
- William Landes & Richard Posner, *The Economics of Trademark Law*, 78 Trademark Rep. 267, 290 (1988).
- Jessica Litman, *Breakfast with Batman: The Public Interest in the Advertising Age*, 108 Yale L. J. 1717 (1999).
- Michael V. P. Marks, *The Legal rights of Fictional Characters*, 25 Copyright L. Symp. (ASCAP) 35 (1980).
- Beverly W. Pattishall, *The Goose and the Egg – Some Comments about Trademark Modernization*, 47 Trademark Rep. 801 (1957)

List of works cited

- Peter Shapiro, *The Validity of Registered Trademarks for Titles and Characters After the Expiration of Copyright on the Underlying Work*, 31 Copyright L. Symp. (ASCAP) 69.
- Preet K. Tummala, *The Seinfeld Aptitude Test: An Analysis Under Substantial Similarity and the Fair Use Defense*, 33 U.C. Davis L. Rev. 289 (1999).
- Franklin Waldheim, *Mickey Mouse – Trademark or Copyright*, 54 Trademark Rep. 865, (1964).

2. European Union

- Manoranjan Ayilyath, *Character Merchandising and Personality Merchandising: The Need for Protection – An Analysis in the Light of UK & Indian Laws*, Entertainment Law Review (Sweet & Maxwell, London) 23- 3 (2012).
- Ralph Graef, *Die fiktive Figur im Urheberrecht [The Fictitious Character in Copyright Law]*, Zeitschrift für Urheber- und Medienrecht [ZUM] 2012, 108 (2012).
- Frank Huber, Kai Vollhardt & Frederick Meyer, *Helden der Werbung? – Eine Untersuchung der Relevanz von Werbefiguren für das Konsumverhalten [Heroes of Advertisement? – Research on the Relevance of Spokes-Characters for Consumers' Behaviour]*, Marketing volume 31, no. 03, (2009).
- Annette Kur, *Der wettbewerbliche Leistungsschutz – Gedanken zum wettbewerbsrechtlichen Schutz von Formgebungen, bekannten Marken und “Characters” [Protection under Competition Law – Thoughts on the Protection of Shapes, Famous Marks and Characters]*, GRUR 1990, 1.
- Frank Lotze, *Markenmaskottchen – Warum wir bestimmte Werbefiguren nie vergessen [Spokescharacters – Why Certain Marketing Characters are Never Forgotten]*, Welt am Sonntag, Jul 22nd 2012.
- Ralf Mäder, *Messung und Steuerung von Markenpersönlichkeit: Entwicklung eines Messinstruments und Anwendung in der Werbung mit prominenten Testimonials (Schriftenreihe des Instituts für Marktorientierte Unternehmensführung (IMU), Universität Mannheim)*, (2005).
- Matthias Meyer, *Character Merchandising, Der Schutz fiktiver Figuren als Marke [Character Merchandising, the Protection of Fictitious Characters as Trade Marks]*, Europäische Hochschulschriften: Reihe 2, Rechtswissenschaft, volume 3668.
- OHIM – The Manual Concerning Opposition.
- Proposal for a Directive of the European Parliament and of the Council to Approximate the Laws of the Member States Relating to Trade marks, COM (2013) 162 final, 2013/0089 (COD), (proposed 2013).

Heijo Ruijsenaars, Overview of the Legal Aspects of Merchandising in Character Merchandising in Europe (Heijo Ruijsenaars ed., 2003).

Heijo Ruijsenaars, Workshop No. 6 – Character Merchandising, AIPPI Y.B. 1992/III, 348.

Christian Scherz & Susanne Bergmann, Character Merchandising in Germany in Character Merchandising in Europe (Heijo Ruijsenaars ed., 2003), 127-143.

Ilanah Simon, How does “Essential Function” Drive European Trade Mark Law? What is the Essential Function of a Trade Mark? 2005 IIC 401.

Clemens Thiele, Urheberrechtlicher Schutz für Kunstfiguren – von Odysseus bis Lara Croft, (IRIS – Rechtliche Rundschau der europäischen, audiovisuellen Informationsstelle), (2004).

3. International

Heijo Ruijsenaars, *The WIPO Report on Character Merchandising*, Int'l. Rev. of Intell. Prop. and Competition Law [IIC] 1994, 532 (1994).

World Intellectual Property Organisation (WIPO), *Character Merchandising – Report prepared by the International Bureau*, WO/INF/108 (1994).

IV. Treatises

1. United States of America

Louis Altman & Mara Pollack, *Callman on Unfair Competition, Trademarks and Monopolies* (Thomson Reuters 2013);

Jerome Gilson, Anne Gilson Laldone & Karin Green, *Gilson on Trademarks* (83d ed., 2013).

David Hilliard, Joseph Welch & Uli Widmaier, *Trademarks and Unfair Competition* (8 ed. 2010).

William Landes & Richard Posner, *The Economic Structure of Intellectual Property Law* (Harvard University Press 2003).

J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* (4th ed., 1996-2013).

Horwitz, Ethan, *World Trademark Law and Practice* (2d ed., 1985-2013).

2. European Union

Adams, John N., *Character Merchandising* (1996).

3. Germany

Karl-Heinz Fezer, *Markenrecht* (4th ed. 2009).

Thomas Dreier & Gernot Schulze, *Urheberrechtsgesetz: UrhG*, (4th ed., 2013).

Friedrich Fromm & Wilhelm Nordemann, *Urheberrecht* (10 ed. 2008).

Wolfgang Gloy, Michael Losschelder & Willi Edelmann, *Handbuch des Wettbewerbsrechts* (4 ed. 2010).

4. International

Georg Bodenhausen, *Guide to the Application of the Paris Convention for the Protection of Industrial Property* (BIRPI 1969).

Paul Goldstein & P. Berndt Hugenholtz, *International Copyright: Principles, Law and Practice* (2d ed. 2010).