Abstract
In this paper, we address the phenomenon of overlapping rights in the United States (U.S.). In particular, we analyze how trademark and copyright protections will overlap when the same object serves to identify and distinguish one producer’s goods or services and is also an original work of authorship. The Lalique bottles created for Nina Ricci perfume, for example, may enjoy both trademark and copyright protection. Similarly, cartoon characters are components of copyrightable works (and in some jurisdictions, may be copyrightable works in their own right), but many have also long been registered as trademarks for entertainment services or merchandise.

In theory, trademark and copyright promote different objectives: source identification (or more abstractly, honest market information), in the case of trademarks and creativity in the case of copyright. The contours of protection differ as well. Under U.S. law, a trademark must be “distinctive,” because a sign that does not identify and distinguish goods or services does not fulfill its function of identifying products in the market. By contrast, U.S. copyright law covers original works of authorship. Hence, even though creativity is different from distinctiveness, some trademarks can be original works of authorship and some creative works can be distinctive signs.

However, when trademark and copyright subject matter protections overlap, courts need to ensure that each right remains within its proper domain: protection against only such copying as leads to confusion of source identification for trademarks, and temporally limited protection for works of authorship. Otherwise, copyright owners might succeed in conferring in-gross protection on distinctive signs and perpetual protection on works of authorship. But if courts need to guard against the kind of boundary-blurring of IP regimes that risks “mutant” trademarks and copyrights, the convergence of trademark and copyright subject matter might also usefully facilitate the importation of limiting doctrines from copyright to trademark.

Ultimately, exploitation of the trademark/copyright overlap may herald a transition towards an integrated IP framework that reflects changes in marketing and product development and underscores the increasingly indistinct lines between distinctive signs and creative works. It also indicates how IP owners may attempt to exploit these overlaps beyond the purely national context, but also concerning cross border trade to control the distribution of IP protected products in separate jurisdictions. But this framework need not imply a one-way ratchet toward ever-increasing protection. Rather, in this paper we elaborate that the influence of trademark protection on copyright protection, and vice versa, can lead to a new balancing of trademark rights through importation of copyright limitations based on fair use and free expression, as well as through incorporation of U.S. online service provider liability limitations from copyright into trademark. As a result, the trademark/copyright overlap might lead to more as well as less protection, and perhaps more laughs.

1 Dastar Corp. v. Twentieth Century Fox Film Corp., 539 U.S. 23, 34 (2003).