The European Proceedings of
Social and Behavioural Sciences
EpSBS

www.europeanproceedings.com
e-ISSN: 2357-1330

DOI: 10.15405/epsbs.2020.12.54

TIES 2020

International conference «Trends and innovations in economic studies»

APPLICATION OF RULES ON DISTINCTIVENESS OF TRADEMARK TO WORKS OF SCIENCE

V. V. Dmitrii (a)*
*Corresponding author

(a) Ural State Law University, Yekaterinburg, Russia, agaety@mail.ru

Abstract

Many scientific works (especially in the field of humanities and social sciences) are not distinguished by the uniqueness of form. This means their lack of originality (as uniqueness), which may cast doubt on the protection of such works by copyright. At the same time, in practice, works of science often have a distinctive ability in the eyes of researchers. The sign of "fame" of the elements of a work is used by the law on trademarks to endow non-original elements with the properties of a protected copyright object. Thus, a work with a low level of originality can acquire distinctive ability and as a result receive protection as a full-fledged object of copyright. There is a need to take into account, when determining the protectability of a copyright object, its distinguishing ability. The analogy of the rules on trademarks as applied to works of science (analogy of law) in this case is appropriate and necessary.

Keywords: Science, originality, trademarks, distinguishing ability.

https://doi.org/ 10.15405/epsbs.2020.12.54
Corresponding Author: V. V. Dmitrii
Selection and peer-review under responsibility of the Organizing Committee of the conference
eISSN: 2357-1330

1. Introduction

The results of scientific activity are subject to legal protection within the framework of various intellectual property institutes: first of all, copyright and patent institutes. The results of scientific and technical activities naturally tend to go into the field of patent law, where its novelty is an indispensable condition for the protection of the result (articles 1350–1353 of the Civil Code of the Russian Federation). However, a large number of scientific results can only be protected by copyright. In Russia, works of science are protected by copyright along with works of literature and art (article 1259 of the Civil code of the Russian Federation). At the same time, the concept that only the original (unique, inimitable) work is protected by copyright is widespread in science (Gavrilov, 2018). This concept, with the requirement to take into account the actual status of the work, is also supported in Russian judicial practice1. However, many scientific results (especially in the field of the humanities and social sciences) are not distinguished by the uniqueness of the form, which is due to the methodology of scientific research, common terminology, analysis of the same sources, etc. The main thing in the works of science is their content. However, the content of the work is not protected by copyright (Novoselova, 2017).

The current state of problem research in Russian science is as follows. Studies are underway to identify the nature of intellectual property (Vasiliev, 2014); devoted to new methods of managing rights to the results of intellectual activity (Lisachenko, 2018); devoted to the principles of legal protection of the results of scientific activity in general (Belikova, 2019). The postulates that copyright is intended solely to protect the form of a work are questioned on the example of works of science (Kashanin, 2010); proposals on the recognition of the results of scientific activity as objects of independent legal protection are considered (Murzin, 2019).

We believe that the options for protecting works of science by analogy have not yet been sufficiently explored: using the tools of the Institute for legal protection of a trademark.

2. Problem Statement

Legal protection of most works of science by copyright is difficult due to the lack of uniqueness of the form of expression. At the same time, works of science are often individualized according to their content and author. Thus, works of science receive a distinctive ability that is ignored by copyright.

3. Research Questions

We set a number of tasks in our research, including:

- consider the sign of "fame" of the elements of the work when used as a trademark,
- determine the copyright object's ability to acquire distinctiveness,
- to establish the possibility of an analogy of the rules on trademarks in terms of acquisition by designating distinctiveness in relation to works of science with a low level of originality.

[1] The determination of the Constitutional Court of the Russian Federation of December 20, 2005 No. 537-O; p. 80 of the Resolution of the Plenum of the Supreme Court of the Russian Federation of April 23, 2019 No. 10 "On the application of part four of the Civil Code of the Russian Federation".

https://doi.org/ 10.15405/epsbs.2020.12.54
Corresponding Author: V. V. Dmitrii
Selection and peer-review under responsibility of the Organizing Committee of the conference
eISSN: 2357-1330

4. Purpose of the Study

The purpose of our work is to identify for works that are not protected by copyright due to the lack of uniqueness of the form, the admissibility of applying, by analogy, the rules on the distinctiveness of trademarks as a way of acquiring patentability.

5. Research Methods

The methods used in this research are universal scientific research methods (generalization, abstraction, formalization, analysis, synthesis) as well as specific legal research methods (technical, comparative-historical, contrastive-comparative, etc.).

6. Findings

6.1. Protection of results not recognized as copyright

For Russian practice, the issue of protecting parts of a work, and, first of all, the name of the work is relevant. In accordance with paragraph 7 of Article 1259 of the Civil Code of the Russian Federation, copyright extends to part of the work, to its name, to the character of the work, if by their nature they can be recognized as an independent result of the author's creative work. However, most often, the title of the work is not an original (unique) designation, if only because of its brevity.

In global practice, there are three modes of legal protection of the name of a work:

1) copyright protection when the title is original;

2) protection in case of actions related to unfair competition, if the name has distinctive meaning;

3) protection by the right applicable to trademarks when the name of a work is registered as a trademark (Liptsik, 2002, p. 104).

Thus, the non-original title of a work is not protected by copyright. At the same time, one cannot ignore the trend, which calls for taking into account the fame of the title of the work. In Russian literature, Khokhlov (2008) noted that the prevailing judicial practice allows the recognition of titles of works as independent objects in rare cases and rather under the influence of the wide popularity of the work itself (p. 69).

However, is it permissible to take into account the fame of a work as a criterion for its legal protection? Copyright does not answer this question. But a similar category is of great importance in the law on trademarks – this is the category of distinctiveness.

6.2. Acquisition of a distinguishing mark in trademark law

Among the rules on trademarks, there is a rule designed for the situation when a designation that is not subject to legal protection (and which, accordingly, cannot be registered as a trademark), suddenly becomes protectable. This rule is about acquiring a designation of distinctiveness. In the Russian Civil Code this rule is contained in article 1483. By virtue of a general prohibition, state registration of designations that do not have distinctive ability is not allowed. However, this prohibition does not apply to signs that have become distinctive as a result of their use. The acquisition of distinctiveness by a designation is a matter of fact, the result of the subjective opinion of consumers.

https://doi.org/ 10.15405/epsbs.2020.12.54
Corresponding Author: V. V. Dmitrii
Selection and peer-review under responsibility of the Organizing Committee of the conference
eISSN: 2357-1330

6.3. "Quiet Flows the Don": registration as a trademark of the name of a famous work of literature

The category of "distinctiveness" is central for Russian trademark law. And, probably, this category is also implicit in relation to copyright objects that are registered as trademarks.

In accordance with subparagraph 1 of paragraph 9 of article 1483 of the civil code, without the consent of the copyright holder, designations identical to the name of a work of science, literature or art known in Russia on the date of filing an application for state registration of a trademark, a character or a quotation from such a work, a work of art or a fragment thereof, cannot be registered as trademarks. In the literature the norm of subparagraph 1 of paragraph 9 of Article 1483 of the Civil Code of the Russian Federation is subjected to conceptual criticism, since this norm does not take into account the principles and rules inherent in copyright (Gavrilov, 2012) – and, as it turned out, it is no coincidence.

In the practice of the Russian court of intellectual rights, a case was considered on the possibility of registering the phrase "Quiet Flows the Don" as a trademark – the name of a Russian novel known far beyond Russia. At the same time, the phrase "Quiet Flows the Don" is unoriginal (non-unique). This is a stable phrase that has roots in folklore - the name of the Great Russian River. From the point of view of the concept of originality (uniqueness) of the work or its part, the phrase "Quiet Flows the Don" itself is not protected by copyright.

The Intellectual Property Rights Court found it necessary to request the opinions of Russian scientists on the question: does the title of the work: well-known, but not original, fall under the rule of subparagraph 1 of paragraph 9 of article 1483 of the Civil Code of the Russian Federation? Most of the experts interviewed (E.A. Pavlova, V.V. Orlova, V.A. Khokhlov, O.M. Kozyr, A.P. Rabets) spoke in favor of the fact that the title of the work should be, first of all, protective (and only then – it is known); accordingly, only with respect to the original name does the rule apply that the name of a work known in Russia cannot be registered as a trademark without the consent of the holder of the exclusive right to the work. Only two experts (A.P. Sergeev and D.V. Murzin) spoke in favor of the fact that in the situation under consideration only the fame of the title of the work matters, even if this title was unoriginal.

The Intellectual Property Rights Court made a compromise conclusion in its decision: the work itself must have the characteristics of an object that is subject to protection in accordance with the rules governing the legal regime of copyright objects, and its name, which in itself may not meet the eligibility condition, must be known in the Russian Federation on the filing date of the application for registration of a trademark (the well-known name of the protected work)[2]. Even such a dual conclusion dealt a strong blow to the prevailing position in the Russian doctrine, according to which copyright protects only original (unique) objects.

[2] Resolution of the Court of Intellectual Property Rights dated 09.10.2014 in Case No. CIP-296/2013 (http://kad.arbitr.ru/Document/Pdf/4a560d07-1cd0-4860-9d14-e8352b52047d/6d621ed6-2ded-495d-8486-76f4c1445630 / SIP-296-2013_20141009_Reshenija_i_postanovlenija.pdf? IsAddStamp = True). For full answers by expert scientists to questions posed by the Intellectual Property Rights Court, see: Consideration of a dispute over the legality of registering a trademark with the verbal designation "Quiet Flows the Don". Expert reviews // Journal of the Court of Intellectual Property Rights. 2015. No. 7. P. 22-44 (http://ipcmagazine.ru/jurnal/journal032015.pdf).

https://doi.org/ 10.15405/epsbs.2020.12.54
Corresponding Author: V. V. Dmitrii
Selection and peer-review under responsibility of the Organizing Committee of the conference
eISSN: 2357-1330

6.4. Acquisition of distinctiveness by an unprotected copyright object

It seems that sub-paragraph 1 of paragraph 9 of article 1483 of the Civil Code purposefully introduces an independent sign of the work's protection capacity – its fame. Original works do not need special legal regulation, since they are fully protected by copyright (including in the case of unauthorized use as trademarks). Trademark law recognizes that there are works that are not protected by copyright, and that is why it establishes a special design aimed at preventing abuse of rights (primarily in the form of unfair competition).

Thus, trademark law indirectly protects not the original work (non-original parts of the work), using its own tools, namely the acquisition of the original non-original work of distinctive ability.

The mechanisms inherent in the legal protection of trademarks are optimally suited to the protection of copyrights on the results of creative activity, which are formally unoriginal, but have received a distinctive ability. But this is the position expressed in trademark law. Russian judicial practice is very cautious about transferring categories of trademark law to copyright: for example, it is stated that the concept of similarity to the degree of confusion is not used in relation to the character of a work[3]. It is obvious that the question of copyright protection of non-original objects that have acquired a distinctive ability is still far from being resolved.

6.5. Permissibility of copyright borrowing categories of trademark law

In international law, there is an example of transferring categories of trademark law to copyright. For example, the inter-American Convention, adopted in 1946, protects the right to such a title for a work which, due to its international fame, has acquired such a distinctive character that it gives it a special identity (Liptsik, 2002). Is this interaction acceptable? It seems that the issue should be considered within the framework of such a popular category in jurisprudence as the “system”, and specifically with reference to the general system of civil rights for the civil law industry and the subsystem of intellectual property for the intellectual property sub-sector.

Initial information about the systems says that they are divided into open and closed, while in open systems the boundaries between the components are impenetrable, and in closed systems the boundaries are blurred (Artyukhov, 2018). In relation to the system of civil rights, this means the following.

The general system of objects of civil rights is open in connection with the breadth of relations that are regulated by civil law (as necessary, more and more new phenomena have been included in the composition of civil law objects: results of intellectual activity, intangible benefits, non-cash money, uncertified securities, digital rights, etc.). Therefore, the legislator is making efforts to ensure that the regulation of relations in connection with specific objects is as isolated as possible (such as, for example, the regulation of relations regarding material things by the right of ownership and the regulation of relations regarding the results of intellectual activity by intellectual property law).

However the subsystem of intellectual property objects is closed: copyright objects, objects of patent law, means of individualization and other objects of intellectual rights directly specified in the law. Therefore, the boundaries between the regulations of various objects are permeable. Traditionally, in the

[3] Clause 82 of the Resolution of the Plenum of the Supreme Court of the Russian Federation of April 23, 2019 No. 10 “On the application of part four of the Civil Code of the Russian Federation”.

field of creative relations there is a relationship of legal regulation in relation to various objects (Shatrov, 1982). Why not allow permeable boundaries between copyright and trademark rights if necessary in this closed system?

7. Conclusion

The example of the title of a work that receives legal protection because it becomes known, i.e. it acquires distinctiveness over time, is a model that should generally expand the conditions for legal protection of works with a low level of originality. This is especially true for works in the humanities and social sciences. There is a need to take into account the distinctive ability of the copyright object when determining its protection capacity. The analogy of trademark rules in relation to works of science (analogy of law) is appropriate and necessary in this case.

Acknowledgments

The present study is implemented with financial support from The Russian Foundation for Basic Research in the framework of scientific project № 18-29-15016.

References

Artyukhov, V. V. (2018). *General theory of systems. Self-organization, sustainability, diversity, crises*. Moscow: URSS editorial.

Belikova, K. M. (2019). Russian law: material and procedural aspects of legal regulation and protection of scientific information contained in the works. *IS. Copyright and related rights, 7*, 7–24.

Gavrilov, E. P. (2012). What will change in article 1483 of the Civil Code of the Russian Federation? *Patents and licenses, 11*, 10–15.

Gavrilov, E. P. (2018). Objects protected by copyright: a case from practice. *Patents and Licenses, 2*, 9–16.

Kashanin, A. V. (2010). The development of the doctrine of the form and content of a work in the doctrine of copyright. *The problem of protection of the content of scientific works. Bulletin of civil law, 2*, 68–138.

Khokhlov, V. A. (2008). *Copyright: legislation, theory, practice*. Moscow: Gorodets.

Liptsik, D. (2002). *Copyright and related rights*. Moscow: Ladomir; UNESCO Publ. House.

Lisachenko, A. V. (2018). The evolution of the system of managing the rights to musical works in the conditions of technological development. *Russian Journal of Law, 4*(121), 84–93.

Murzin, D. V. (2019). The legal nature of the results of scientific activities. *Russ. Law: Education, Practice, Science, 2*, 15–24.

Novoselova, L. A. (2017). *Intellectual Property Law. Vol. 2. Copyright*. Textbook, ed. Law. Moscow: Statute.

Shatrov, V. P. (1982). *International cooperation in the field of inventive and copyright*. Moscow: Internat. Relations.

Vasiliev, A. S. (2014). Some questions of determining the properties of the results of intellectual activity and means of individualization as phenomena of the world. *Journal of the Court of Intellect. Rights, 5*, 62–69.