Fictional Characters in 3D

Trademark Protection as an Option
Establishment of Trademark Rights in Characters

The same principles apply to the establishment of trademark rights in characters, whether 2D or 3D, as apply to any other type of design mark.
General considerations

Key considerations are:

Does the design/character function as a mark

Is it necessary to establish acquired distinctiveness

What goods/services are actually offered/rendered

Who owns/controls the nature and extent of use of the “mark”
Is the character/name merely descriptive of the goods/services?

“Little Mermaid” held descriptive of dolls. The Board drew a distinction between character names in the public domain and those derived from works in which the applicant owned IP rights - In re United Trademark Holdings, 122 USPQ 2d 1796 (2017)
Trademark Registration for Characters

Mascots and other characters used in advertising are frequently registered

TMEP 1302.02(c): a 3 dimensional costume design may function as a mark for entertainment services - In re Red Robin Ent., 222 USPQ 911(TTAB 1984)
When examining a 3 dimensional mark, the Examining Attorney must determine if the proposed mark is inherently distinctive.

n.b., 15 USC 1127 is relied on to establish that the design of a character does not function as a mark unless it identifies and distinguishes the goods/services in addition to identifying the character.
Requirements for applications are not unlike those for titles, character names.

Line drawings can be used to depict the subject matter of the registration sought.

Reg. No. 4687162 depicts the Flo character used in connection with insurance services by Progressive Casualty Insurance.
Specimens for 3 dimensional marks

Photographs may be submitted as specimens showing the character engaged in rendering the services for which application is made
Enforcement of trademark rights in characters

Within the PTO

The issue of likelihood of confusion is subject to the same considerations as with other types of design marks and the determination of the issue may be difficult to predict.
The comparison may be between a 2D depiction and a character depicted in 3D as well as 2D

Paddington & Co. v Lead Ltd., Opp No 91150248 (5/29/09)

A divided Board found a 2D depiction of a bear in floppy hat and duffel coat for class 16 products not likely to cause confusion with the Paddington Bear character generally depicted with floppy hat and duffel coat
The Board’s opinion includes this statement:

The detectives Dick Tracy and Columbo both wore raincoats, but they are hardly similar to one another.

Question whether the degree of public recognition of Paddington Bear weighed against finding the other bear design likely to cause confusion.
Dilution protection is also available for characters in 3D under the Lanham Act

DC Comics v Deanna Rivetti, Opp No 91219851 (8/17/17)

The Board sustained the opposition to registration of SUPER WOMAN OF REAL ESTATE on the basis of dilution

The Board took note not only of the mark applied for in standard character form but also the manner of actual use
Rivetti and consideration of the context of use to assess commercial impression

In assessing the commercial impression of the applicant’s mark, the Board took note of the use on the submitted specimen of the character/design in a blue bodysuit with a five-sided shield with SW within the shield, and a red cape, all in the manner of the DC Comics’ characters.
15 USC 1125(a) as a basis for protection of characters in 3D whether or not registered

1125 (a) prohibits use of symbols/devices likely to confuse as to association, sponsorship, or approval

This protection extends to characters in 3D such as the Marlboro Man - Philip Morris USA v Cowboy Cigarette, 2003 WL 22852243 (SDNY 2003)
In 1125(a) cases, when must the performer as well as the “character” portrayed be considered

See Wendt v Host Int’l, 125 F3d 806 (9th Cir 1997) (did defendant replicate the Cheers characters only or the actors who portrayed them?) and the partial dissent in White v Samsung, 1992 US App LEXIS 19253 (9th Cir 1992) (on the need to distinguish between the performer and role and whether anything appropriated and distinctive is attributable to the performer rather than the role)