

IP Protection for Featured Characters in Digital and Physical Media

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The Trademark Trial and Appeal Board (TTAB) recently ruled in *In re Joseph A. Stallard* (dba Osgoode Media) that Osgoode Media could not register the image of a character as a trademark in connection with a video game. However, this does not mean the image of a character can never be eligible for trademark protection. Instead, registrants will need to carefully evaluate circumstances where trademark protection is applicable to a character associated with their product or services, as well as consider whether other intellectual property (IP) protections are available.

Trademark Protection for Characters

Trademarks are commonly associated with tradenames, slogans, and logos. But the U.S. Patent and Trademark Office (USPTO) will trademark “any word, phrase, symbol, design, or a combination of these things that identifies ... goods or services”^[1] — which can include a character mark associated with a video game or other product or service. For example, Sonic the Hedgehog is a video game character that Sega Corporation has registered with the USPTO as a design mark on multiple occasions, with illustrations of the titular character incorporated into the logo design of the series name.

So, if character trademarks are permitted, why did the TTAB deny Osgoode Media’s trademark request? In its opinion, the TTAB clarified that “designations that merely identify a character in a creative work are not registrable.” In other words, the character being registered must identify and distinguish the *source* of the work. In a video game context, this means the character must create an association between the mark and software in order to be eligible for trademark protection. For example, this might include the character being centrally depicted on the launch screen, website, or other marketing materials for the video game — or anything else that would cause an individual to associate the image of the character with the video game. This same concept can also apply to images of a character from a comic book or cartoon.

The use of a trademark to protect a character can offer substantial benefits, particularly in terms of enforcement against competitors and counterfeiters. It also allows a company to strengthen its IP rights, which can be advantageous for licensing purposes. However, the USPTO only allows insubstantial changes to the overall design, which can limit the flexibility for future modifications. Additionally, there may be color limitations, which could restrict the scope of protection. Therefore, while trademarking a character design can be beneficial, additional IP protection may be necessary to address potential gaps in trademark protection.

Other IP Protections for Characters

Whether or not a character is eligible for trademark protection, it is worth considering other IP rights that may be available. These IP rights can bolster protection for a successfully trademarked character, or can provide an alternative option if trademark protection is not possible.

Copyright

For video games, copyright protection is available in two ways. First, the underlying code for the video game is a copyrightable work. Second, the overall appearance — including art, sound, characters — is eligible for copyright protection. Generally, if the same party owns both elements, then it must register the code and audio-visual components as a single unit. In doing so, this would also protect the appearance of any character within the video game.[2]

An individual video game character image can also be copyrighted, provided it is distinctive and original. However, note that protection only extends to the specific expression of the character. The idea of the character itself is not subject to protection, and therefore, similar characters can be created by others, provided they are not exact copies. This same concept applies to artistic renderings of characters in cartoons, graphic novels, and comics,[3] as well as the literary delineation of a character's specific attributes in textual form, such as in a novel.[4]

The Copyright Act is a strict liability statute, meaning it may be easier for a copyright holder to enforce their rights against violators, even if the violator did not have the intent to infringe.

Design Patent

To some limited extent, it is also possible to seek a design patent to protect the unique, visual characteristics of a video game character featured as an ornamental design on commercial goods. While possible, it is a weak option to pursue when trademark and copyright protection are readily available.

Conclusion

While Osgoode Media has recently requested reconsideration of the TTAB's final decision on its trademark application, *In re Joseph A. Stallard* nonetheless highlights the unique challenges and considerations associated with IP protections for character images. We will continue to monitor the outcome of this matter, should the TTAB elect to reconsider its final determination.

[1] United States Patent and Trademark Office, [What is a trademark?](#)

[2] United States Copyright Office, [Circular 61: Copyright Registration of Computer Programs](#) (March 2021).

[3] United States Copyright Office, [Circular 44: Cartoons and Comic Strips](#) (October 2015).

[4] United States Copyright Office, [Compendium of U.S. Copyright Practices](#), Section 313.4(H) (January 28, 2021).

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