



**Non-Fungible Tokens (NFT)
& propriété intellectuelle**

Jacques de Werra




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- **Introduction**
- Droit d'auteur
- Droit des marques
- Conclusion




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Définition

- Jeton Non-Fongible / Non-Fungible Token (NFT):
“a unique digital identifier that cannot be copied, substituted, or subdivided, that is recorded in a blockchain, and that is used to certify authenticity and ownership (as of a specific digital asset and specific rights relating to it)” (Merriam-Webster)



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**Blockchain technologies
and IP ecosystems:
A WIPO white paper**




WIPO
WORLD
INTELLECTUAL PROPERTY
ORGANIZATION




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Non-fungible tokens (NFTs) are a type of cryptographic token that represents assets that can be commercialized in a digital way. They function as verifiable proofs of authenticity and ownership within a blockchain network, bearing several characteristics such as scarcity, uniqueness and non-fungibility.²⁷ In particular, NFTs allow their owner to possess the (digital/virtual) representation of a unique object unequivocally associated to their wallet or user in the virtual space.


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Question préliminaire


- Quel(s) droit(s) s'applique(nt) en ligne ?
- Principe de la territorialité (?) ou règles uniformes au sein des univers concernés (// UDRP) ?

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Cinéma


- Miramax, LLC, v. Quentin Tarantino, et al., Case No. 2:21-cv-08979-FMO-JC, Central District of California



<https://tarantinonfts.com/>

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Each NFT in the collection consists of the original script from a single iconic scene, as well as personalized audio commentary from Quentin Tarantino himself.

Royale with Cheese

Jules and Vincent are driving and discussing life in Europe. "You know what they call a quarter pounder with cheese in Paris? They call it a royale with cheese"




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Cession de « tous les droits »

20. Under the Original Rights Agreement, Tarantino and Bender granted to Miramax, in exchange for valuable consideration, in perpetuity throughout the universe, "all rights (including all copyrights and trademarks) in and to the Film (and all elements thereof in all stages of development and production) now or hereafter known including without limitation the right to distribute the Film in all media now or hereafter known (theatrical, non-theatrical, all forms of television, home video, etc.)," excluding only a limited set of "Reserved Rights" which were reserved to Tarantino as an individual. Ex. A, ¶¶ 2-4.


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À l'exception des droits réservés de Q. Tarantino

21. Tarantino's Reserved Rights were limited to the "soundtrack album, music publishing, live performance, print publication (including without limitation screenplay publication, "making of" books, comic books and novelization, in audio and electronic formats as well, as applicable), interactive media, theatrical and television sequel and remake rights, and television series and spinoff rights." *Id.*,

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Droit d'auteur et droit de propriété


Qui est propriétaire de quoi ?

- Droit d'auteur sur l'œuvre intangible


≠

- Droit de propriété sur le bien tangible (p.ex. exemplaire original du script)

=> Art. 16 al. 3 LDA: « Le transfert de la propriété d'une œuvre [= Werkexemplar], qu'il s'agisse de l'original ou d'une copie, n'implique pas celui de droits d'auteur »

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Qualification de l'usage de l'œuvre


- Est-ce que l'usage concerné (NFT) constitue une violation du droit d'auteur ?

=> **Reproduction / communication au public de l'œuvre?**

This Essay explores the nature of NFTs and to what extent, if any, they may be considered unauthorized copies or derivatives of the underlying work. NFTs are digital tokens that do not themselves include a copy of an associated work. At best, NFTs might include a link to a digital copy of a work. As such, this Essay concludes that NFTs are not unauthorized copies or derivatives of the underlying work and as such are not subject to copyright infringement claims.


Behzadi, Emily, The Fiction of NFTs and Copyright Infringement (February 4, 2022). University of Pennsylvania Law Review Online's Volume 170 (2022), Available at SSRN: <https://ssrn.com/abstract=4025604> or <https://dx.doi.org/10.2139/ssrn.4025604>

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Violation de la marque « Pulp Fiction »?

62. Defendants' unauthorized use of the Pulp Fiction Mark alleged herein is likely to deceive consumers as to the origin, source, sponsorship, or affiliation of the Pulp Fiction NFTs, and is likely to cause consumers to believe, contrary to fact, that the Pulp Fiction NFTs are sold, authorized, endorsed, or sponsored by Miramax, or that Defendants are in some way affiliated with or sponsored by Miramax. Defendants' conduct therefore constitutes trademark infringement in violation of Section 32(1) of the Lanham Act, 15 U.S.C. § 1114(1).

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Arts visuels

Bored Ape NFT Spinoff Venture Gone Sour Sparks Legal Fight


- Split among Caked Apes artist group leads to dueling lawsuits
- Ownership, infringement claims after \$1.9 million in sales

By Malathi Nayak
21 mars 2022, 14:12 UTC+1 Updated on 21 mars 2022, 21:59 UTC+1 Europe Edition





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A group of artists created the so-called Caked Apes in January, a spinoff series of the wildly popular and lucrative Bored Ape Yacht Club collection. Now the artists are suing each other over derivative designs of the nonfungible tokens, or NFTs, and fighting over how to share revenue.




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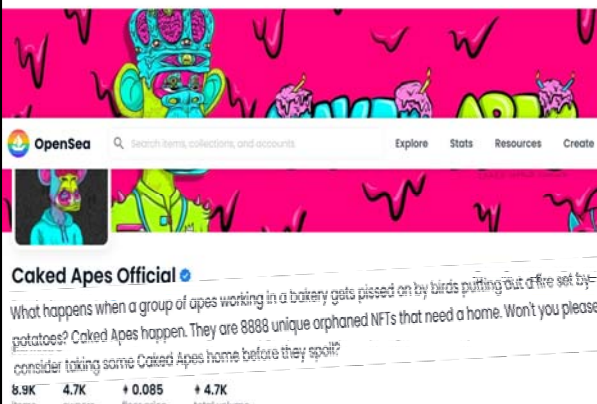
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8. As relevant to this dispute, one of the most successful NFT art projects to date is known as the “Bored Ape Yacht Club,” which is a digital art collection of 10,000 cartoon apes, each with its own unique set of traits, including facial expressions and outfits. Because they are limited in number, among other reasons, the ownership of an official “Bored Ape” has become a status symbol, with celebrities including Stephen Curry, Jimmy Fallon, Paris Hilton, Eminem, and Justin Bieber being reported as current owners. In January 2022, Bieber reportedly purchased his Bored Ape for \$1.29 million.⁴

9. A unique characteristic of the Bored Ape brand is that it not only permits, but also encourages owners to create derivative works from their apes,

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OpenSea Search items, collections, and accounts Explore Stats Resources Create

Caked Apes Official

What happens when a group of apes working in a bakery gets pised on by birds putting out a fire set by potatoes? Caked Apes happen. They are 8888 unique orphaned NFTs that need a home. Won't you please consider taking some Caked Apes home before they spoil?


8.9K	4.7K	+ 0.085	+ 4.7K
Items	owners	floor price	total volume

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Attaque

- Whitley v. Maguire, 22-cv-01837, U.S. District Court, Central District of California (Los Angeles), complaint (18 mars 2022)



1. This action arises from Plaintiff Taylor Whitley’s wrongful ouster from the digital art community he founded and nurtured, ultimately resulting in the loss of years of his own work, along with an extensive list of lucrative projects which he laid the groundwork to create.


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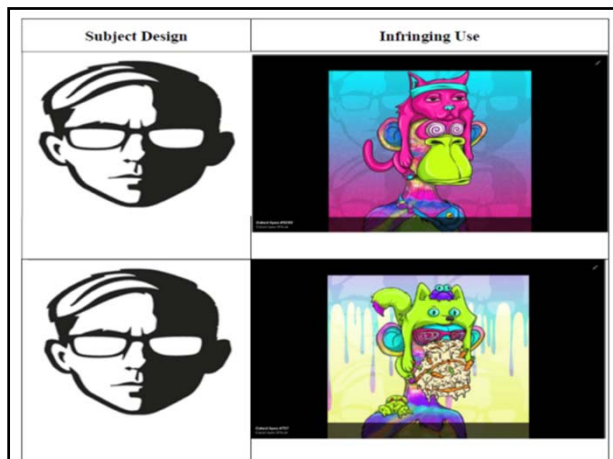
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Violation du droit d’auteur (?)

Subject Design	Infringing Use
	


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53. Whitley's authorization to use the Subject Design was contingent on receiving his agreed upon portion of revenue from the Caked Apes NFT project and WTF.Industries receiving its share, and his ongoing involvement with and management of the Caked Apes NFT project. When WTF.Industries did not receive its agreed-upon share, his authorization was revoked.

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Contre-attaque

Nygard et al. v. Whitley, 22-cv-00425, U.S. District Court, Central District of California (Los Angeles), complaint (20 mars 2022)

1. This action arises from the unhinged, destructive, and egotistical acts of Plaintiffs' former collaborator and joint venture partner, Defendant Taylor Whitley p/k/a "taylor.wtf" ("Whitley"), to sabotage a successful digital art project and brand they started together, known as "Caked Apes," after Whitley failed to usurp ownership and control of the project entirely for himself.

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11. The creation of these derivative works is expressly authorized by the terms and conditions of Bored Ape ownership, which grants owners "an unlimited, worldwide license to use, copy, and display the purchased Art for the purpose creating derivative works based upon the Art" with no restriction on "earning revenue from any of the foregoing."

12. In or about November 2021, Plaintiffs and Whitley—who had met each other in online art communities—began to discuss working together to create and promote a Bored Ape derivative project. Because Plaintiff Maguire owned a Bored Ape, Plaintiff Nygard owned three Mutant Apes (which were created by the same founders of Bored Apes and granted similar rights to create derivative works), and Whitley owned eleven Bored Apes, they were each permitted to create their own derivative ape projects.

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TERMS & CONDITIONS

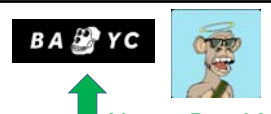
iii. Commercial Use. Subject to your continued compliance with these Terms, Yuga Labs LLC grants you an unlimited, worldwide license to use, copy, and display the purchased Art for the purpose of creating derivative works based upon the Art ("Commercial Use"). Examples of such Commercial Use would e.g. be the use of the Art to produce and sell merchandise products (T-Shirts etc.) displaying copies of the Art. For the sake of clarity, nothing in this Section will be

<https://boredapeyachtclub.com/#/terms>

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Licence Bored Ape

Clare Maguire



Taylor Whitley

Subject Design

Violation (?)

Infringing Use

Création d'une oeuvre dérivée



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Musique

Dame Dash Prohibited From Selling Jay-Z's 'Reasonable Doubt' as NFT Following Roc-A-Fella Lawsuit

Judge sides with label, but Dash claims he wasn't trying to mint and sell the album as an NFT, but rather his entire stake in Roc-A-Fella Records

JUNE 22, 2021 1:30PM ET



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- Roc-A-Fella Records v. Dash, 21-cv-5411, U.S. District Court, Southern District of New York (SDNY), 18 juin 2021




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32. Pursuant to 28 U.S.C. § 2201(a), RAF, Inc. seeks a judgment from this Court declaring the following: (a) RAF, Inc. owns all the rights to *Reasonable Doubt*, including its copyright; (b) Dash, as a RAF, Inc. shareholder, has no direct ownership interest in *Reasonable Doubt*; (c) Dash is not permitted to sell any interest in *Reasonable Doubt*; and (d) Dash must transfer to RAF, Inc., any NFT or other asset in his possession, custody, or control reflecting rights to *Reasonable Doubt*.


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**Cession du droit d'auteur
ou cession d'une part des revenus (royalties)?**

"SuperFarm is proud to announce, in collaboration with Damon Dash, the auction of Damon's ownership of the copyright to Jay Z's first album, *Reasonable Doubt*...The newly minted NFT will provide ownership of the copyright, transferring the rights to all future revenue generated by the album from Damon Dash to the auction winner."

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**Cession du droit d'auteur
ou cession d'une part des revenus (royalties)?**

Nevertheless, as Dash avers in his Declaration, he never minted an NFT nor did he claim to own a one hundred percent interest in the Reasonable Doubt copyright.

So the bottom line is simple: neither Jay-Z nor RAF can preclude the sale of Dash's 1/3 interest as Jay-Z does not own said interest and RAF has no restrictions on the transfer, assignment or disposal of such interest.


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Droit d'auteur


- Nature et objet de l'opération visée (objet physique et/ou œuvre)
- Titularité originaire/dérivée du droit d'auteur
- Existence et portée des actes juridiques (contrats) relatifs aux biens intangibles (cession / licence, portée etc.)

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Droit des marques

- Hermès International et al v. Rothschild, 1:22-cv-00384, U.S. District Court, SDNY, complaint (14 janvier 2022)




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« hommage » à Hermès (?)

When Rothschild initially sold the NFTs of the "MetaBirkins" digital images, Rothschild described them as "a tribute to Herm[e]s' most famous handbag, the Birkin, one of 'the most exclusive, well-made luxury accessories.

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Jugement du 18 mai 2022

1:22-cv-00384, U.S. District Court, SDNY (juge Rakoff)

A. "MetaBirkins" as Source Indicator or Artistic Expression?

Hermes argues that Rothschild uses the "MetaBirkins" mark, in commerce, to brand a product line, and to attract public attention and signify source. See 15 U.S.C. § 1127 (noting that use in commerce includes when the mark "is placed in any manner on the goods or their containers or the displays associated therewith or on the tags or labels affixed thereto, or if the nature of the goods makes such placement impracticable, then on documents associated with the goods or their sale")

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**Nike, Inc. v. Stockx LLC (1:22-cv-00983),
District Court, SDNY, 14 février 2022**

Nike Dunk Low Retro White Black (Vault NFT)

US M 10

NFT 100% Authentic Edition of 100



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StockX Vault NFT Jordan 1 Retro High OG Patent Bred

A StockX token representing ownership of a physical pair.

NFT StockX Verified Edition of 250



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Product Description

This StockX Vault NFT represents and tracks proof of ownership of the actual sneaker stored within our StockX Vault, which has been verified via StockX's authentication process.

The Fine Print:

- The Vault NFT is not affiliated or associated with, sponsored by, or officially connected to Nike or any of its subsidiaries or affiliates. Any Nike name(s), use and trademark(s) used in the Vault NFT are all the property of Nike and are used in the Vault NFT solely to refer to the physical product to which the Vault NFT corresponds. For more information on official Nike products, please visit www.nike.com.

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- If the physical item associated with this Vault NFT is redeemed by the owner, it is removed from the StockX Vault and shipped to the owner. StockX will then remove the Vault NFT from the owner's Portfolio and from circulation (i.e., "burn" the Vault NFT). Owners can request to withdraw the physical item from the StockX Vault by filling out the Vault Redemption Form, which can be found [here](#).

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Marques pour des biens virtuels


36. On October 27 and 28, 2021, Meta and Nike filed trademarks with the United States Patent and Trademark Office for virtual goods, name sneakers NFTs and “[r]etail store services (sneaker NFT trading platform):

- NIKE (word mark)
- JORDAN (word mark)

BRANDS THAT HAVE FILED METAVERSE TRADEMARKS—AND WHAT IT ALL MEANS

Following Meta’s and Nike’s lead, several food, entertainment and retail companies have filed trademarks to sell virtual goods

By Tobias Schaub, Published on April 11, 2022



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Droit des marques

- Usage « dans le commerce »
(art. 16 al. 1 ADPIC: « au cours d’opérations commerciales »)
- Principe de spécialité (=> marques pour des biens virtuels) sauf marques de haute renommée (art. 15 LPM)

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« Beyond the hype »

=> legal housekeeping/due diligence

- Sur quel(s) bien(s) tangible(s)/intangibles(s) porte l’opération?
- Le bien concerné est-il protégé ?
- Le bien concerné fait-il l’objet de contrats préexistants ?
- L’usage visé du bien viole-t-il des droits de PI de tiers?


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Mise en œuvre de la protection

- Pas de clause d'élection de droit («choice of law») dans les conditions générales du 
(<https://boredapeyachtclub.com/#/terms>)
- Pas d'élection de for (« choice of court ») (?)

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Importance des modes alternatifs de règlement des conflits (MARC)


- Clause d'arbitrage dans les «Mutant Ape Yacht Club Terms and Conditions»
(<https://boredapeyachtclub.com/#/mayc/terms>)

The Metaverse and International Arbitration – How to Anticipate and Resolve Web 3.0 Disputes

By Juliette Asso and Laura Azaria

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NFT & PI: un sujet attractif (mais éphémère?)

NFT => FFT

Food For Thought

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Merci pour votre attention

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