

Titles as trade marks

*One of the best marketing tools that a producer can acquire is the ability to select a distinctive and memorable film or television title and then to be able to turn that title into a trade mark. **Wayne Covell** discusses how to clear a film or television title and how to use it as a trade mark.*

Major Hollywood studios and television networks have no equal when it comes to registering motion picture and television titles as trade marks. Titles are not subject to copyright protection so the studios and networks have spent a fortune registering their titles as trade marks and then taking legal action against usurpers. But not all film and television titles can become trade marks, even if they are famous. Only a select few achieve that status.

Title clearance

When creating or choosing a title of a motion picture or television program it's best to pick one that will not be confused with another film or television title. This certainly helps avoid law suits and ensures the E & O Policy will be issued. The policy will typically have a 'title clearance' clause protecting against an alleged unauthorized use of the title, but before issuing the policy the insurer will require a clear 'title report' supported by a professional opinion. The report (see, for example, www.thomson-thomson.com) lists over hundreds of pages prior use of a particular title in film, television, radio, books and theatre.

A 'title opinion' on the report is typically provided by a specialist trade marks attorney. The opinion addresses whether or not the title is safe to use. Where a title has merchandising potential the attorney or the insurer will also order an 'entertainment search report.' This is a broader report, virtually identical to a trade mark availability search, but focusing on popular film and television merchandise items. If the report is clear this is the ideal time to file trade mark applications covering those areas in the main countries of interest.

Title Registration Bureau MPAA

It's impossible to talk about title clearance without mentioning the way Hollywood decides motion picture title disputes. The Motion Picture Association of America (MPAA) set up its own Title Registration Bureau in 1925 in response to filmmakers' wishes to protect their titles. By agreement each member (mostly the major Hollywood studios and their subsidiaries) is required to register forthcoming titles with the bureau. Independent distributors can opt in for a small fee. If the title is registered, the other members agree not to use a confusingly similar title. A

compulsory arbitration system applies where there is a dispute and, over the years, there have been many.

Warner Bros registered *Casablanca* with the bureau for its 1942 feature starring Humphrey Bogart and then threatened legal proceedings against *A Night in Casablanca* starring the Marx Bros. In a notorious exchange of letters with Warner Bros, Groucho Marx retorted that he ‘had no idea that the City of Casablanca belonged exclusively to Warner Brothers ... What about ‘Warner Brothers’ — do you own that too? You probably have the right to use the name Warner, but what about Brothers? Professionally, we were brothers long before you were ...’ (see <http://www.chillingeffects.org/resource.cgi?ResourceID=31>) The dispute dragged on, but after the press got a hold of the story, Warner Bros relented, the title was registered and *A Night in Casablanca* was released in 1946.

Generally the system works well, but it only binds its members and the MPAA does not register television titles. Also, some independent producers are reluctant to register as it tends to favour prior titles registered by the majors. One thing is for sure: it hasn’t stopped the majors from applying for trade mark registration in relation to their titles.

Title wars

There is now a widely held view that numerous film and television titles are not trade marks in the legal sense because they can’t work as badges of origin. The mere use of the title in cinemas and broadcasting doesn’t mean the owner will offer goods or services by reference to the title. Why then, do the studios and networks even bother to register titles as trade marks?

This issue played centre stage when a Melbourne-based writer and composer registered the trade mark *The Hunchback of Notre Dame* for ‘entertainment services’. He then sued Disney in the Federal Court of Australia for trade mark infringement after it released the animated feature *Disney’s Hunchback of Notre Dame*. The action failed because Disney said that it hadn’t used the title as a trade mark. *The Hunchback of Notre Dame* is based on the 1833 English translation of an ‘epic gothic novel’ first published in French in 1831 by Victor Hugo. Disney proved over the years there had been many cinematic, television and musical versions of *The Hunchback of Notre Dame*. There was even a ballet version. In one of her last decisions before being elevated to the High Court, Justice Crennan held that Disney ‘were doing no more than indicating’ that its film, DVD and CD contained its ‘version or adaptation of a well-known story.’ In essence, it was a descriptive use ‘of an established title of the story.’ Disney used the title as the name of its product and not as a badge of origin or trade mark. In her Honour’s view this was reinforced by Disney’s use of the ‘possessive’ form, that is, *Disney’s The Hunchback of Notre Dame* rather than just *The Hunchback of Notre Dame*.

The Hunchback of Notre Dame decision is unusual. Ordinarily, the studio sues a small operator rather than the reverse. It’s also a decision that could haunt Disney. It begs the question: if Disney’s use is descriptive why did it bother to apply for various

trade marks that contain *Disney's Hunchback of Notre Dame*? Disney has many registrations for *Disney* per se and, thus, in light of this decision, applications incorporating the title *The Hunchback of Notre Dame* add nothing to Disney's portfolio of trade mark rights. Further, Disney has registered the title itself, *Hunchback of Notre Dame*, without the possessive form of *Disney* for merchandising items from shampoo to popcorn (reg'd tm # 650069). The title will, presumably, be used by Disney as a badge of origin after all, at least in relation to merchandise.

It's all about the merchandising

Merchandising is in fact the key to titles becoming trade marks, or at least the key to ensuring that the title has a secondary meaning that functions as a trade mark. This is how in 2000 Channel 7 blocked a trade mark application for *Home and Away* which covered cosmetics and perfumes. While Channel 7 did have a prior trade mark registration for its successful *Home and Away* television soapy covering entertainment services and some merchandise, it didn't have a registration covering cosmetics and perfume. But it was found that the show was so well-known through broadcasting *and* merchandising that third party use on cosmetics and perfume was likely to cause consumer deception.

Similar results were obtained by the major Hollywood studios in the *Braveheart*, *Die Hard* and *The Wizard of Oz* decisions. Twentieth Century Fox blocked a Sylvania Waters' man from registering *Braveheart The Musical* for a 'theatre musical production' and T-shirts, caps.' This was despite Fox failing to establish that the movie title *Braveheart* was a trade mark. What it did show, however, was that *Braveheart* was a famous film that had been extensively promoted in the media and on souvenir merchandise items. Fox also blocked an application for *Die Hard* covering eyewear, jewellery, watches, skateboards, skates and surfboards. Although Fox lacked a registration covering these items, it proved that its *Die Hard* movie series starring Bruce Willis were so well known in Australia through promotion and merchandising that the title had acquired a reputation as a trade mark prior to the offending application. Fox won despite 'die hard' having an ordinary English meaning as a 'person who resists change'.

Based on its rights to the 1939 motion picture *The Wizard of Oz* starring Judy Garland, The Turner Entertainment Company blocked a Queensland woman from registering *The Wizard of OZ* and a map of Australia logo for various merchandising products and services. However, it failed to block the Queenslander from registering her marks for many other products and services (including leather goods, alcohol and coach tours) as these were not 'usually associated with the marketing or licensing of motion picture names.'

It's difficult to reconcile these cases with Time Warner's failure to block the registration of *Matrix Eyewear* for optical products in the face of the notoriety of the sunglasses worn in the *Matrix* movies. The term 'matrix' was found to be a 'common place signification' which would not mislead consumers if applied to eyewear by someone other than Time Warner. Surprisingly, however, there was 'no evidence' that the studio had engaged in extensive merchandising.

Time Warner was also unable to stop a trade mark application for *Veronica's Closet* for underwear and clothing. It was found that Time Warner had 'simply' used this as 'the title of the television series' and no goods or services had 'actually been offered in the course of trade'.

In another television title dispute, Paramount Pictures applied for *Cheers* as a trade mark for various products and services including 'restaurant and bar services' following the long running success of the *Cheers* television series in Australia. But the application was blocked by a Queensland man after successfully claiming that he used *Cheers* for 'restaurant and bar services' prior to Paramount.

Even music legends have difficulty protecting their film titles. In 2005 Subafilms Limited (owned by the surviving members of The Beatles, Yoko Ono and George Harrison's estate) failed to block the registration of *Yellow Submarine* in relation to temporary accommodation for backpackers. This was despite Subafilms' trade mark registration for a broad range of goods. The main weakness was that while some evidence of merchandising surrounding The Beatles 1968 film *Yellow Submarine* and its re-release in 1999, the evidence was not extensive. It's a surprising result, especially when you picture weary backpackers returning to their accommodation after a night on the town singing 'we all live in a yellow submarine ...'

The lack of merchandise evidence was also one reason why Channel 7 failed to block the registration of *All Saints* by a British company for clothing despite the huge success of the *All Saints* television program. Another was that, unlike the *Home and Away* decision, *All Saints* had other significations apart from the television show including religious significations.

For the most part, merchandising will protect the title. It will also protect many other elements. Channel 7, for example, blocked an application for *Summer Bay* covering clothing and crockery because this was a fictitious place featuring in *Home and Away* that would mislead consumers if applied to unauthorised merchandise. Similarly, Fox stopped a third party using *Duff Beer* following its extensive use in *The Simpsons* and merchandising.

That's a wrap

There's an intimate relationship between clearing a film or television title and the law of trade marks. After choosing a title it is essential to obtain a title clearance opinion from an attorney who is thoroughly familiar with this branch of intellectual property and entertainment law. And if the title is to be turned into a trade mark then not only must the title become well known, it also needs to make a big splash with merchandising. The bigger the merchandising program the better chance there is of protecting the title as a trade mark.