Hollywood's Trademark Law

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Scope

Titles

- Unique issues re titles & source-indication (historically, theoretically)

  → separate project – Titles and TM law

Hollywood's TM law

- Hollywood's fetish for branding has blurred the line between art and commodity
- This blurred line has affected TM law's treatment of infringement in expressive works, with adverse consequences for creators
- We should consider mechanisms for damage control

  *and to provide analytical clarity in these cases

Hollywood's Trademark Law

1. Film as branding device
2. Impact on law, particularly post-*Jack Daniel's*
3. Options to limit the fallout

Film as brand

MGM-Pathe v. Pink Panther Patrol, 774 F. Supp. 869 (SDNY 1991)

- THE PINK PANTHER registered with PTO in 1979
- “The mark has been licensed for use in connection with the sale of a variety of children's consumer items including T-shirts, sleepwear, hats, tote bags, plush toys and plastic figures as well as such products as fiberglass insulation, automobile air fresheners, automobile spare tire covers, and adult clothes.”

Brand as film as brand

- “The future lies in harnessing the power of premium storytelling and expanding brand universes to connect with consumers on a deeper and more genuine level. As the entertainment and media landscapes evolve, brands must adapt and seize the opportunity to make entertainment—not advertisements—to maintain their esteem in the hearts and minds of consumers.”

FAST COMPANY
PREMIUM DESIGN TECH WORK LIFE NEWS IMPACT PODCASTS VIDEO INNOVAT
07-14-2023 | DESIGN

Your brand is Barbie

Don’t waste time wishing you were Mattel. Any company can build an entertainment empire. Here’s how.

SHARE

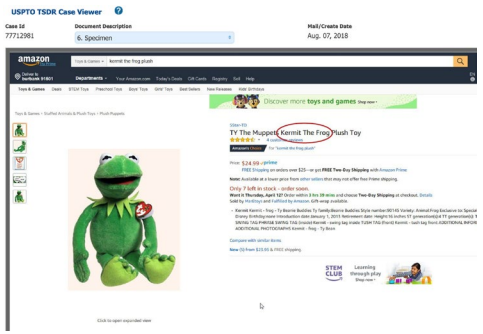
[Photos: Michael Buckner/Variety/Getty Images, Jaime Nogales/Medios y Media/Getty Images, Warner Bros. Pictures]

BY MICHAEL SUGAR

Variations on film-related brands

- Title
  - Series registrable; other titles protectable under 43(a) with secondary meaning

- Characters (with secondary meaning)



- Other features

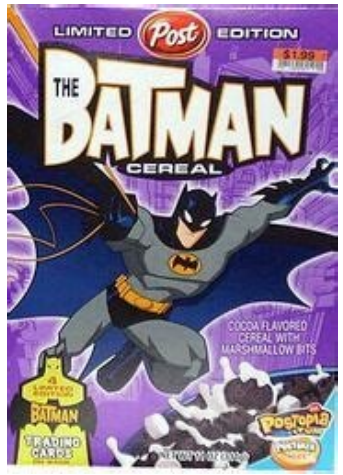
Implications for speech / use of movie marks

Breakfast with Batman:

The Public Interest in the Advertising Age

Jessica Litman†

In an acquisitive society, the drive for monopoly advantage is a very powerful pressure. Unchecked, it would no doubt patent the wheel, copyright the alphabet, and register the sun and the moon as exclusive trade-marks.[1]



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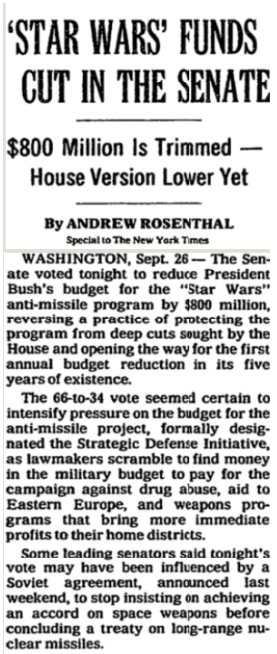
Expressive Genericity: Trademarks as Language in the Pepsi Generation

Rochelle Cooper Dreyfuss



'STAR WARS' FUNDS CUT IN THE SENATE

$800 Million Is Trimmed — House Version Lower Yet

By ANDREW ROSENTHAL
Special to The New York Times

WASHINGTON, Sept. 26 — The Senate voted tonight to reduce President Bush's budget for the "Star Wars" anti-missile program by $800 million, reversing a practice of protecting the program from deep cuts sought by the House and opening the way for the first annual budget reduction in its five years of existence.

The 66-to-34 vote seemed certain to intensify pressure on the budget for the anti-missile project, formally designated the Strategic Defense Initiative, as lawmakers scramble to find money in the military budget to pay for the campaign against drug abuse, aid to Eastern Europe, and weapons programs that bring more immediate profits to their home districts.

Some leading senators said tonight's vote may have been influenced by a Soviet agreement, announced last weekend, to stop insisting on achieving an accord on space weapons before concluding a treaty on long-range nuclear missiles.

Implications for studios' claim of expressive use under *Rogers v. Grimaldi* (post-*JDI*)?

Rogers (2d Cir 1989): use of mark in connection with creative work allowed unless

1. No artistic relationship, or
2. Explicitly misleading

Jack Daniel's (SCT 2023):

"Without deciding whether *Rogers* has merit in other contexts, we hold that it does not when an alleged infringer uses a trademark in the way the Lanham Act most cares about: as a designation of source for the infringer's own goods."

Post-*JDI*

Several courts have found movie/TV title (at least potentially) source-indicating use :. *Rogers* inapplicable

Davis v Blue Tongue Films (9th Cir 2024)

HomeVestors v. Warner Bros Discovery (D Del 2023)

Belin v. Starz Entert. (CD Cal 2024)

Mar Vista Entert. v. THQ Nordic (CD Cal 2024)

Post-*JDI*

At least some of these cases have emphasized the defendant's commercial/branding efforts involving the claimed mark

Belin v. Starz Entert. (CD Cal 2024):

"Indeed, the court notes that Defendants have filed a trademark application to register their own 'BMF' mark in Class 9 (mobile phone cases and related goods), Class 14 (jewelry), Class 16 (pens, pencils and related goods, Class 18 (bags), and Class 21 (beverages and related goods)."

The concern

- Hollywood's ubiquitous TM registration, licensing, and assertion of rights (including with respect to titles) casts doubt on its claims of expressive, non-source-indicating use – at least with respect to title and central characters

- And to the extent that courts treat Hollywood's titles as presumptively source-indicating, that presumption may bleed into other contexts

Options?

- Possibility: election: parties that rely on *Rogers* (rather than LOC) are estopped from asserting TM claims in the title/character/feature at issue
    - Note – *Barbie Girl* – Aqua specifically avoided selling Barbie-related merchandise
    - *Cf* Empire – studio sought registration for mark
    - This does *not* mean the use is infringing – LOC applies