



Titles and Trade-marks (and Cigarettes!) in Film and TV Projects

February 10, 2011 by Bob Tarantino

As we've discussed previously here at the Signal ([Title Dispute - Similar or Identical Titles for Film and TV Projects](#)) the extent to which the "title" of a motion picture or television project can function as a trade-mark involves a fairly detailed analysis. Leonard Glickman has published "[What's In a Title?](#)" (hat tip: [Entertainment Law Reporter](#)), which offers a lengthy consideration of the matter, including a discussion of the possibility of a title which would otherwise be unprotectable as a trade-mark acquiring a "secondary meaning". As Leonard notes in his conclusion:

In light of the foregoing restrictions with respect to the protection and registration of titles, what options are available to producers of films or other single work titles? In Canada, an applicant could apply on a proposed use basis for a series of works and stretch out the application process by extending the time frame for filing a declaration of use. In the interim, the applicant could produce and release a sequel thereby creating a series and removing obstacles to registration and enforceability. Even if a sequel is not produced and the application is abandoned, the producer can start to build secondary meaning in the title and attempt to enforce its rights in the title against third parties. When filing the application, the applicant must have a *bona fide* intent that it will produce a series of productions. Otherwise, the application or registration may be open to challenge under Section 30(i) of the Canadian *Trade-marks Act*.

US commentators have suggested there is merit to registering single work titles under the state registration system. Although the registrations have little substantive value, they will be disclosed in title search reports and potentially deter a third party from adopting the title. Another method used to protect titles is to register proposed titles with the Motion Picture Association of America's Title Registration Bureau, the members of which are the Hollywood studios and hundreds of independent production companies. Once a title is so registered, other members of the Bureau are bound by the Bureau's rules which impose restrictions on their ability to adopt and use the same title or a confusingly similar title.

On a slightly tangential (but related, really!) point, Samuel M. Duncan's article "[Protecting Nominative Fair Use, Parody, and Other Speech-Interests by Reforming the Inconsistent Exemptions from Trademark Liability](#)", while bearing a bit of a mouthful of a title, offers an excellent overview of US trademark law and, of particular value for entertainment lawyers, provides the tools to assess when the use of a trademark in an audio-visual project is shielded from claims of infringement.

Finally, with a hat tip to the [Dear Rich blog](#), an interesting little tidbit about depicting trademarked tobacco products in movies. As readers of the Duncan article, linked to above, will know, the mere depiction of a trademarked product in a film or TV project may not give rise to a viable infringement claim (though often E&O policy clearance requirements will nevertheless prohibit such a depiction) - notwithstanding that, however, Philip Morris has made this [rather polite request to film and TV producers](#):



Unfortunately, the fact that we do not engage in product placement does not mean that our brands are never shown. Some producers and directors choose to depict our brands in their work without our permission. But we are limited in our ability to stop all displays of our brands because federal and state trademark laws, as well as the U.S. Constitution, protect freedom of expression and the "fair use" of trademarks in works such as movies and television shows. Our position is clear – we do not want our brands or brand imagery depicted in movies and television shows. The unauthorized use of our brands and brand imagery perpetuates the misunderstanding among some that we pay or are otherwise responsible for these depictions, which is simply not the case. We strongly encourage the movie studios to eliminate references to or depictions of our brands.

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