Title Dispute - Similar or Identical Titles for Film and TV Projects

November 17, 2010 by Bob Tarantino

Aaron Moss, writing at Law Law Land, has a great post about identical or similar movie titles: Reuse and Confuse? The Recycling of Hollywood Movie Titles. He provides a slew of examples of how Hollywood's major studios have dealt with competing movie titles (the settlement in respect of Austin Powers in Goldmember (a title to which the producers of Goldfinger objected) evidently obliged star Mike Myers to record on-air promos for airings of the latter movie). As Moss notes, titles are generally not capable of copyright or even trade-mark protection, so in what arena do disputes arise and get settled?

The answer is the MPAA's Title Registration Bureau, a voluntary agreement that is binding on all member organizations of the MPAA, including the major studios, as well as independent producers who sign the agreement. Members register in-development film projects with the bureau, which sends out lists of proposed titles. The members can then object to a title that is similar to one that has been previously registered. If the challenged title is not voluntarily withdrawn by the registering studio, the dispute will proceed to mandatory arbitration.

For a Canadian take on the topic of protecting film and TV titles, see my IPilogue post (reproduced in full after the jump - and which, ironically, bears one of the single worst titles I've ever fashioned for a blog post), Neither Fish Nor Fowl – Trade-mark and Copyright Protection for Titles.

A suitable name for an entertainment project can be critical to its success and can even enhance the aesthetic effect of the overall work. In an over-saturated information environment, a memorable title for a novel or movie can be the difference between a hit whose name is on everyone's lips and a dud which sinks anonymously into the churning waters of the entertainment industry's annual output. That being said, idiosyncratic titles are no guarantee of success or even attention: the six-letter Avatar is a box office sensation orders of magnitude greater than Mr. Magorium's Wonder Emporium.

Prompted by the Federal Court of Canada's decision in Drolet v. Stiftung Gralsbotchaft (2009 FC 17) [Drolet], this short article addresses what protection, if any, is available under Canada's statutory intellectual property regimes for the "title" of a book, movie or song. The answer may surprise owners of certain registered trade-marks.

Copyright

In the realm of copyright, the matter approaches the status of truism: the title of a work is not itself eligible for protection as a copyrighted work. However, some scrutiny is required in order to reach that conclusion. The definition of "work" in the Copyright Act (Canada) is brief: "'work' includes the title thereof when such title is original and distinctive". It may be tempting to conclude that copyright can therefore subsist in a title (the title presumably being a "literary work"). But David Vaver opens his discussion of titles in his text Copyright Law with his own admirably concise statement: "Titles have

no copyright" (Vaver, Copyright Law, Irwin Law (2000) [Vaver] at 49). The favoured interpretation of the Copyright Act is that a title, in and of itself, cannot be the subject of copyright protection independent from the work to which it refers. The leading cases in the area (see, e.g., Francis, Day & Hunter Ltd. v Twentieth Century Fox Corp. Ltd. (1939), [1940] AC 112 (PC) [Fox] and Flamand v Societe Radio-Canada (1967), 53 CPR 217 (Que. SC)) express scepticism at the notion that a title could ever qualify for protection, preferring to view the definition of "work" as simply clarifying that the title is merely included in the ambit of protection accorded to the broader work itself. In any event the cases appear to set a bracingly high threshold for protection of a title qua title: "The Man Who Broke the Bank at Monte Carlo" was deemed, in Fox, to be insufficiently "original and distinctive" to allow the owner of copyright in a song of that name to exercise his copyright so as to prevent someone from releasing a movie featuring the same name.

Trade-mark

If copyright has proven an inhospitable choice, Canadian mark owners, and the Canadian Intellectual Property Office (CIPO), have traditionally viewed trade-mark protection as a more fruitful possibility for protecting titles. The following films and television shows turn up in the CIPO trade-marks database as either a registered or allowed mark in connection with the "ware" of motion pictures or filmed entertainment: Borat, The Godfather, Grey's Anatomy, Mission: Impossible and The Dark Knight. The availability of trade-mark protection under Canadian law is at odds with the approach adopted by the United States, where single-work titles are barred from registration (see Julie Jauron, "Drolet v Stiftung: Protection of titles under trademark law: the Canadian Situation" (May 2009), 217 Trademark World 15 [Jauron]; and see In re Cooper (1958), 254 F.2d 611 and Herbko International Inc. v Kappa Books Inc. (2002), 308 F.3d 1156). However, that Canadian availability may now be a thing of the past.

In Drolet, the Federal Court of Canada definitively pronounced, in what appears to have been a case of first impression, that titles of entertainment works are not registrable as trade-marks under the Trade-marks Act (Canada) and the court ordered the expungement of a registered book title. The court concluded that, even if a book could qualify as a "ware", a title fails to meet the requirements of Section 12 of the Trade-marks Act because the title is inherently descriptive – the title of a book is, effectively, simply a description of the book itself (Drolet at paras. 180 and 185). As the court rhetorically asks, "How would it be possible to market a book without referring to its title?" (Drolet at para. 188).

The reasoning in Drolet also made reference to the Copyright Act, asserting that allowing trade-mark registration of a title would "thwart and skirt" the Copyright Act, by permitting the limited monopoly of the trade-mark owner, which through continual use could potentially extend in perpetuity, to preclude use of the combination of words which make up the title long after copyright protection in the underlying work had lapsed (Drolet at para. 188). To use the example cited by the Federal Court, if a title could be trade-marked, even after copyright had expired for the work called Gone With the Wind, the book could only ever be sold under a different name.

Policy Considerations

The Canadian treatment of titles under intellectual property statutes appears, in light of Drolet, to be converging: single-work titles should not be the subject of copyright or trade-mark protection (absent some heretofore unseen level of “distinctiveness” which might result in copyright protection). Though the Federal Court in Drolet was considering only the title of a book, the reasoning is easily transferable to titles of works such as movies and songs. While “one-off” titles are not proper candidates for protection, the titles of periodicals and book series can be protected as trade-marks (see Jauron at page 17) – because the title in such cases is more than simply descriptive of the product, it also confirms that each issue, edition or installment originates from the same source (see Jauron at page 17).

The most compelling rationale for the approach is that single-work titles are so granular (and potentially consist of words that are simply component parts of speech and writing) that according protection to them would radically expand the field of protected works and correspondingly drastically reduce the ambit of the public domain (see Vaver at page 50). Such an expansion is problematic from both copyright and trade-mark perspectives: copyright because it would preclude use of the protected word(s) in fields far beyond the initial use, and trade-mark because protection (and thus exclusion) could be so long-lasting. Further, titles (considered solely as titles) have marginal economic or cultural value, so there is little reason to incentivize their creation by according them statutory protection, and much damage which could be done by doing so.

There is also an underlying subtlety to the disarmingly straightforward rationale found in Drolet: while the court may overstate matters when it says that there is no way to refer to a book other than by its title (for example, one could use a book’s ISBN, or refer to it as “that book Stephen King published in December 2009”), using a title seems to be the most effective. That appeal to efficacy, then, ties together the different motivations: allowing protection for titles would dramatically and negatively alter the calculus of protection and the public domain, increase clearance costs, limit the viability of free expression and insert unnecessary logical puzzles and philosophical conundrums (How do you separate a work from its title? Why should copyright extend to a word only a few letters long?) into the heart of intellectual property law.