



Trademark Issues in Entertainment

Eric E. Johnson

ericejohnson.com



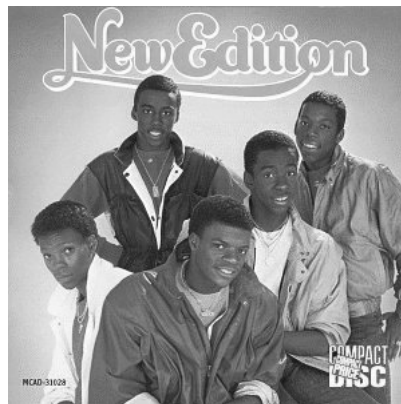
Konomark
Most rights sharable

Key trademark issues in the entertainment context:

- Ownership of band names
- Clearance of footage
- Titles as trademarks
- Trademarks and merchandising
- Putative use of trademark to exclude others from expressive works

Ownership of band names

- Standard trademark doctrine and concepts apply.
 - Source
 - Reputation
- Not who is first to think of or coin
- Agreements to the contrary may or may not be enforceable/valid





Bell v. Streetwise Records,
640 F. Supp. 575 (D. Mass 1986)

- Bell, Bivins, Brown, DeVoe, & Tresvant seek exclusive rights to the mark “New Edition” for performing and recording
- Streetwise produced, recorded, and marketed the first New Edition LP, and claims that the mark “New Edition” belongs to them.



Bell v. Streetwise Records,
640 F. Supp. 575 (D. Mass 1986)

- Streetwise says it employed Bell, Bivins, Brown, DeVoe, & Tresvant to serves as a public front for a concept which it developed, and to promote recordings embodying that concept: “black bubblegum music of the 80s”
- Four of the five current members of New Edition started at a talent show, where they performed as “New Edition.”
– Defendants discovered them there.



Bell v. Streetwise Records,
640 F. Supp. 575 (D. Mass 1986)

- “Priority is established not but by conception by bona fide usage.”
- But that doesn’t resolve this case.



Bell v. Streetwise Records,
640 F. Supp. 575 (D. Mass 1986)

- “[I]n the case of joint endeavors, where prior ownership by one of several claimants cannot be established, the legal task is to determine which party ‘controls or determines the nature and quality of the goods which have been marketed under the mark in question.’”
- **Question: What are the goods?**



Bell v. Streetwise Records,
640 F. Supp. 575 (D. Mass 1986)

- Bell, Bivins, Brown, DeVoe, & Tresvant say the goods are entertainment services of themselves
- Streetwise claims the goods are the recordings, which they own, and which embody the Streetwise concept.



Bell v. Streetwise Records,
640 F. Supp. 575 (D. Mass 1986)

- “[P]ublic association ... is crucial in establishing just what the mark has come to identify, i.e., what the ‘goods’ are.”
- “In order to determine ownership in a case of this kind, a court must first identify that quality or characteristic for which the group is known by the public.”
- “[T]he second step [is to determine] who controls that quality or characteristic.”



Bell v. Streetwise Records,
640 F. Supp. 575 (D. Mass 1986)

- “The ‘magic’ that sold New Edition, and which ‘New Edition’ has come to signify, is these five young men.”
- “I conclude that the quality which the mark New Edition identified was first and foremost the five plaintiffs ... The ‘goods’ therefore are the entertainment services they provide. They and no one else controlled the quality of those services. They own the mark.”

Clearance of footage

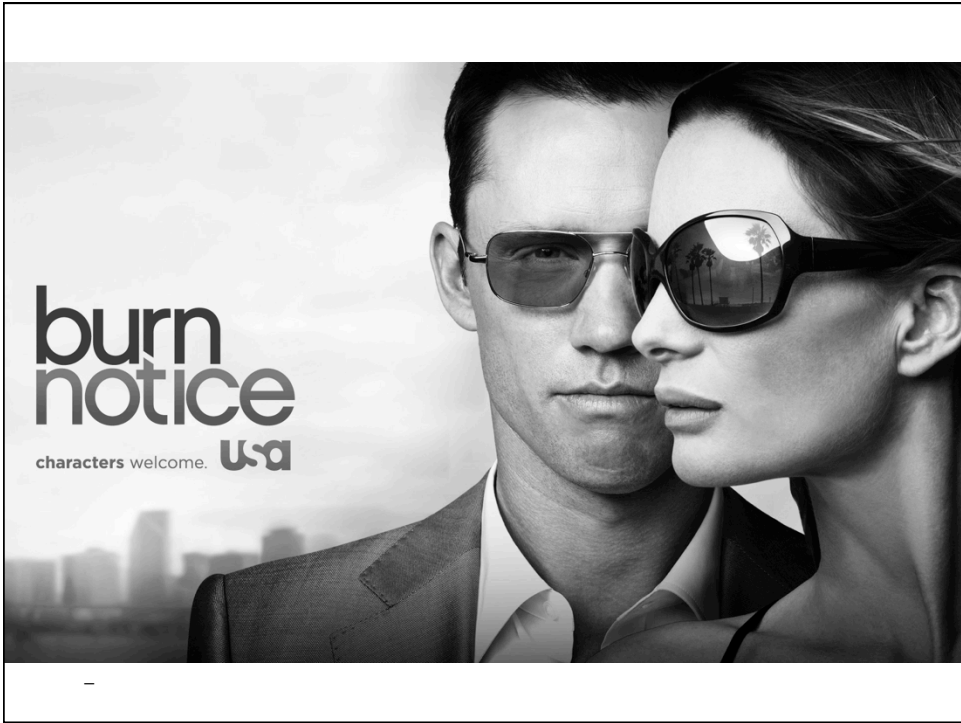
- Apply standard trademark doctrine to logos and trade names caught on film.
- The test for infringement is likelihood of confusion.

Clearance of footage

- Risk averse climate encourages getting unnecessary licenses.
- Practice of needless licensing can affect consumer perceptions.
- Feedback effect.
- Plausible likelihood-of-confusion after feedback?

Clearance of footage

- Product placement may affect consumer perceptions as well.







Film/TV production
prop can labels



These, dating to the 1980s,
are sold on ebay as movie
collectibles. (Seller:
estateliquadatorshc)

Clearance of footage

- Reverse infringement?



unaltered



DEBEVOISE & PLIMPTON

altered



DEBEVOISE & PLIMPTON

Titles as trademarks

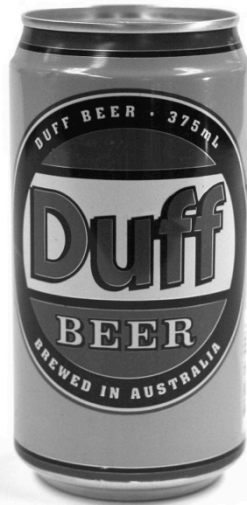
- Standard trademark doctrine and concepts apply.
 - Source
 - Reputation
- USPTO will only register titles for series

-

Trademarks and merchandising

- Standard trademark doctrine and concepts may be left behind.
 - Source
 - Reputation
- Courts sometimes depart from sound trademark concepts to hold for entertainment industry litigants trying to get exclusive rights to fictional elements of a story

-



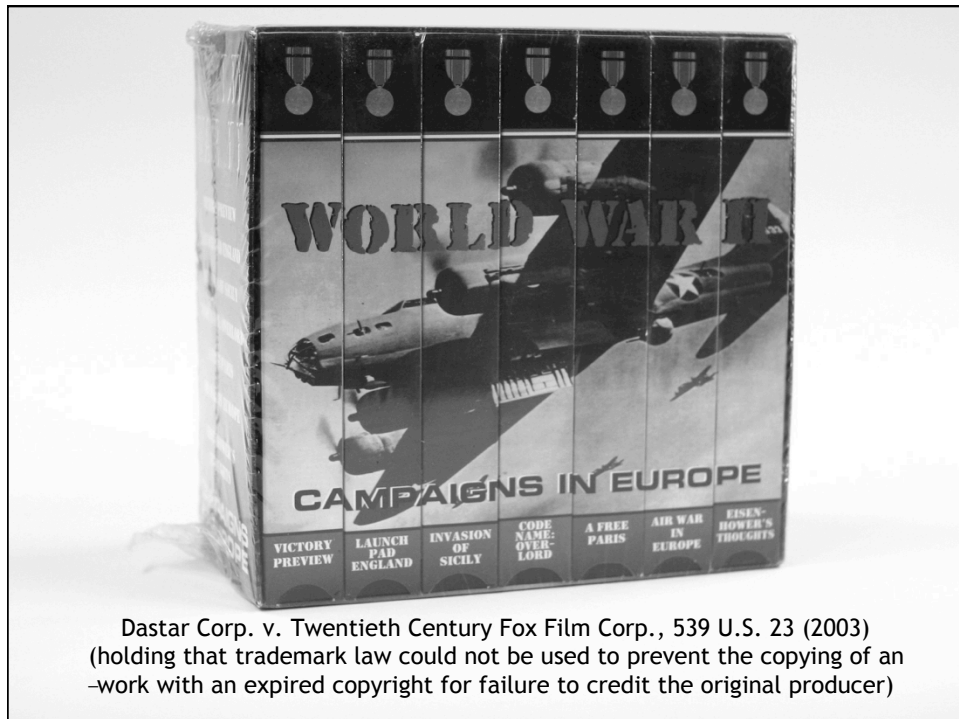
Twentieth Century Fox Film Corp. v. South Australian Brewing Co.
Ltd., 34 IPR 225 (Fed. Ct. New South Wales Dist. 1996)



Warner Bros. Inc. v. Gay Toys, Inc., 724 F.2d 327 (2d Cir. 1983)
(allowing trademark cause of action against manufacture of car
similar to one depicted in television series)

Putative use of trademark to exclude others from expressive works

- Standard trademark doctrine and concepts apply.
 - Source
 - Reputation
- That hasn't stopped plaintiffs from trying.
- Supreme Court refused this tack.



Dastar Corp. v. Twentieth Century Fox Film Corp., 539 U.S. 23 (2003)
(holding that trademark law could not be used to prevent the copying of an
-work with an expired copyright for failure to credit the original producer)