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Commercial & Intellectual Property Lawyers



## How to protect your movie and film titles

Being in the entertainment industry, you would know how much effort it takes to think of a catchy title.

Once you do, the last thing you want is for someone to copy it.

This article provides you with a brief overview as to the best form of protection under Australian law, considering some interesting case studies along the way.



## Benefits of trade mark registration

First up, let's dissolve the common myth that owning a registered business name, domain name, or company name, grants ownership rights over that name. Not so! By far, the best form of protection you can have over a name is trade mark registration. This is done through the Australian government body known as "IP Australia" which administers and regulates trade marks (and other intellectual property) in Australia.

### The benefits of trade mark registration include:

- an exclusive monopoly to use the trade mark across Australia wide on the goods and services for claimed under the registration (subject to some exceptions);
- the power to authorise other people to use the trade mark in relation to the goods and services for which the trade mark is registered;
- you can use the "®" symbol with the marks; and
- a trade mark registration as an asset that can be bought, licenced, or sold.

## What makes a good trade mark?

For a trade mark to be registrable, it should be unique. While that might seem obvious, I am always surprised by the number of clients who want to protect a descriptive name.

If you take care to make your mark distinctive, you will greatly increase your chances of getting it registered.

The reason behind this is simple. The Trade Mark Office will not grant anyone a monopoly over words that others in the industry have a genuine need to use to describe their similar services.

For example, one could not obtain trade mark over "movie house" for a theatre, as others in the business of movie theatres may need to use these words. In contrast, the words "Nova", "Hoyts", "Ace" and "Regent" are all distinctive brand names registered as Australian trade marks with respect to cinemas.

## Movie titles

Many organisations have also registered film titles as trade marks.

This, however, has sometimes led to interesting issues when other businesses have tried to use or register those marks for other goods and services.

## Six in the City

In 2004, a Queensland company owned by Susan Stigwood, filed a trade mark application for the words “SIX IN THE CITY” in relation to online dating services. To Ms Stigwood’s rather unpleasant surprise, shortly after her trade mark application was accepted, the Home Box Office,

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Inc (HBO) lodged an opposition against it, claiming that due to its reputation in popular “Sex and the City” TV show, consumers were likely to be misled into believing that Ms Stigwood’s services were somehow associated with the TV show.

The case was the subject of a lot of media attention, which ironically, may even have helped put Ms Stigwood’s business on the “map”. “This could only happen in New Zealand”, said one person, referring to the comical notion that New Zealand residents pronounce “six” as “sex”. This idea is even entertained by the Registrar for the hearing, who dismissed any risk of actual mistake or confusion arising from the “well-known tendency of New Zealanders to pronounce ‘six’ in a way that resembles ‘sex’”.

More recently, HBO have opposed trade marks outside Australia, including “SUCCESS IN THE CITY”, “SOMA AND THE CITY” and “SOX IN THE CITY”, demonstrating that it will pull out all stops in the fight to protect its trade marks.

## Home and Away

Earlier this year, a dispute arose in relation to the “Home and Away” trade mark owned by Channel Seven, the owner of registered trade mark “HOME AND AWAY” (covering television programs and live entertainment amongst other things).

Many Australians will be familiar with this long-running soapie, which airs weeknights on Channel

7. In 2011, Hunter Property Holdings (Aust) Pty Ltd filed an application to register a trade mark, “Home and Away Caravans”. This was opposed by Channel 7, presumably due to the similarity in the names, despite the fact the “Home and Away Caravans” application covered completely separate classes of goods and services. A “tweet”

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on Twitter by law firm Phillips Ormonde Fitzpatrick, jokingly questions whether there may have been “confusion with a Summer Bay Caravan Park?”

This matter remains unresolved, but nonetheless shows the lengths to which film and televisions companies will take to protect their trade marks from even the remotest possibility of infringement, confusion or deception.

## Matrix Eyewear

In 2003, Time Warner Entertainment Company LP opposed the trade mark application for “MATRIX EYEWEAR” filed by local company Just Spectacles Pty Ltd.

Time Warner claimed that there would be confusion between the two marks. It provided evidence that it has used the word “Matrix” extensively in relation to promotion of its movie, “The Matrix” through movie showings, DVD sales and video sales.

Time Warner emphasised that its Matrix movie and promotional merchandise had prominently featured its “sunglasses look” and so public confusion would arise. The addition of the word “EYEWEAR” serves only as a descriptive term, with the main identifying feature being the word “MATRIX”, which is clearly identical to the famous film title.

Time Warner opposed registration on the grounds of its widespread reputation and potential licencing for eyewear, but ultimately lost, as it could not show that it was manufacturing or licencing its own Matrix-branded eyewear.

Names in the entertainment industry are big business as the above examples show and these are only of the many that have been disputed.

For more advice tailored to your needs in this area call Sharon Givoni on 03 9527 1334 – our lawyers have experience in this area and would be delighted to have a chat with you. There are many film and television titles registered in Australia already – see examples in the box below. Remember that trade mark registration is granted on a first come first serviced basis so don't leave it too late if you have a name that you are committed to.

### Examples of registered film titles in Australia

Trade mark no	Trade mark	Owner
631891	THE HUNCHBACK OF NOTRE DAME	Disney Enterprises, Inc.
640883	JURASSIC PARK and Image	Universal City Studios
730353	MISSION IMPOSSIBLE	Paramount Pictures Corporation
759841	TITANIC and Image	Twentieth Century Fox Film Corporation
806879	ATLANTIS THE LOST EMPIRE	Disney Enterprises, Inc.
806880	LILO AND STITCH	Disney Enterprises, Inc.
901489	THE LION KING	Disney Enterprises, Inc.
934713	FINDING NEMO	Disney Enterprises, Inc.
1099873	PIRATES OF THE CARIBBEAN	Disney Enterprises, Inc.
1068431	MEET THE ROBINSONS	Disney Enterprises, Inc.

### Examples of registered Television titles in Australia

Trade mark no	Trade mark	Owner
433048	NEIGHBOURS	FremantleMedia Australia Pty Ltd
433049	JOHNS & DAUGHTERS	FremantleMedia Operations
477634	A CURRENT AFFAIR	Nine Network Australia Pty Ltd
494508	HOME AND AWAY	Channel Seven Sydney Pty Ltd
646768	TODAY TONIGHT	Seven Network (Operations) Limited
775356	GETAWAY and Image	Nine Network Australia Pty Ltd
865406	THE GREAT OUTDOORS and Image	Seven Network (Operations) Limited
934309	AUSTRALIAN IDOL and Image	FremantleMedia Limited
1107968	SEX AND THE CITY	Home Box Office, Inc
1274433	PACKED TO THE RAFTERS and Image	Seven Network (Operations) Limited