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# How Important is a Title? An Examination of the Private Law Created by The Motion Picture Association of America

## I. INTRODUCTION

How important is a movie title? “There’s no way to exaggerate how important a movie title can be.”<sup>1</sup> Joe Roth, studio chief of Walt Disney Company, explains, “We’re surrounded by so much cultural clutter that you’re halfway home if you can find a title that helps you distinguish your product or connect it with a special image.”<sup>2</sup> For a marketing-conscious movie executive like Roth, movie titles are worth big money. When Disney first developed *Ransom*, the Mel Gibson thriller about a father rescuing his son from diabolical kidnappers, Sony Pictures already owned the title.<sup>3</sup> Roth wanted the title so bad that he paid \$600,000 to obtain it.<sup>4</sup> “I would do it again in a second,” Roth says.<sup>5</sup> “It was absolutely perfect. Imagine having a one word title for a Mel Gibson movie that tells you the whole story of the film.”<sup>6</sup>

Deals like this are commonplace among the “big boys” of the movie industry, but why?<sup>7</sup> Why was Disney required to pay for the use of the title *Ransom*? How did Sony own the rights to the title of an unreleased movie, and who was protecting those rights? Furthermore, how did Disney learn that Sony owned the rights to the title? The answers to these questions lead to a single source: The Motion Picture Association of America (MPAA).

The MPAA, along with its international counterpart, the Motion Picture Association (MPA), serve as the voice and advocate of the American motion picture, home video, and television industries.<sup>8</sup> The MPAA has over 150,000 titles on file at its Title Registration Bureau

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1. Patrick Goldstein, *Hey, Let's Play the Movie Title Game! The Crucial Search for a Perfect Grabber Can Be a Long, Complicated and Expensive Process*, L.A. TIMES, Aug. 20, 1997, at F1, available at 1997 WL 2239469.

2. *Id.*

3. *Id.*

4. *Id.*

5. *Id.*

6. *Id.* (noting that Disney's *Ransom* grossed over \$136 million domestically).

7. *See id.* (noting at least seven similar title fights in 1997 alone); *see also* Linda Lee, *A Banner Year for Movie Title Tangles*, N.Y. TIMES, Aug. 18, 1997, at D1.

8. *See* About the MPA, MPAA, at <http://www.mpa.org/about/content.htm> (last visited Dec. 5, 2001).

(the "Bureau").<sup>9</sup> Registering a movie title with the Bureau is analogous to copywriting an invention,<sup>10</sup> and is currently the best way to protect a title from unauthorized use.<sup>11</sup> Through its arbitration process, the Bureau privately settles all disputes regarding conflicting movie titles.<sup>12</sup> Additionally, the Bureau has its own operating rules and substantive guidelines by which its arbitration panels abide when resolving title conflicts.<sup>13</sup> Similar to other arbitrators, the Bureau's arbitrators generally do not apply judicial law.<sup>14</sup> When parties contract into arbitration clauses, they contract out of all the law that a court would have applied but for the arbitration agreement.<sup>15</sup> In effect, the arbitrators are privatizing the respective segments of judicial law. Thus, the MPAA has effectively privatized public law.<sup>16</sup>

This Comment discusses the ramifications of the MPAA's privatization of law. Part II examines the importance of a movie's title. Part III outlines the direct negotiation and arbitration procedures exercised by the subscribers to the Bureau and regulated by the MPAA's Title Committee (the "Committee"). Part IV compares two different sources of law: (1) the Bureau's "private law," and (2) federal and state public trademark laws. Lastly, Part V assesses the consequences of the MPAA's arbitration process and its privatization of law.

## II. THE SIGNIFICANCE OF THE TITLE

Motion picture production companies will do almost anything to find the perfect movie title: educated market research,<sup>17</sup> extensive consumer testing,<sup>18</sup> countless mall interceptions,<sup>19</sup> hundreds of prerelease

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9. Linda Lee, *supra* note 7.

10. Telephone Interview with Mitchell Schwartz, Director, Title Registration Bureau (Oct. 22, 2001).

11. See Memorandum of the Title Committee of the Motion Picture Association of America, Inc. at 1-2 (Apr. 1, 1992) [hereinafter Title Committee Memorandum] ("The Bureau shall be the central registration bureau for titles of theatrical motion pictures submitted for listing by service Subscribers.") (on file with the author).

12. See Title Committee Memorandum, *supra* note 11, at 8 (defining the Bureau's arbitration process).

13. See *id.*; see also Telephone Interview with Mitchell Schwartz, *supra* note 10.

14. See Stephen J. Ware, *Default Rules from Mandatory Rules: Privatizing Law through Arbitration*, 83 MINN. L. REV. 703, 707-26 (1999).

15. *Id.*

16. *Id.*

17. Goldstein, *supra* note 1.

18. See *id.*

19. See *id.* (defining "mall intercept" as a technique whereby researchers stand outside heavily trafficked movie theaters and show moviegoers various mock-ups of a film poster, all with the same imagery and lettering, but with different titles).

viewings,<sup>20</sup> and spending millions of dollars.<sup>21</sup> Why do these companies go through such a long, complicated, and expensive process of choosing something as trivial as a title? Given the rising cost of making and marketing a movie, which (according to the MPAA) averages from \$54.9 million for production and \$27.3 million for prints and advertising,<sup>22</sup> a recognizable title can give studios the upper hand, especially during the film's crucial opening weekend.<sup>23</sup> Studio marketing experts believe that a bad title can irreparably harm a film's first image with moviegoers.<sup>24</sup> "A movie starts to breathe with a title, it's the first thing about a film that audiences are exposed to," says Tom Sherak, chairman of Twentieth Century Fox's domestic film group.<sup>25</sup> According to Sherak, "when you're up against dozens of other films, it's important to make a good first impression."<sup>26</sup> For instance, Sherak regrets not coining a different name for the 1991 drama *Dying Young*.<sup>27</sup> The unsuccessful film stars Julia Roberts in a story about a dying man who falls in love with his nurse. Sherak recalls, "It was a tough sell under any circumstances, but that title made it seem even more downbeat than it was. It was so bad that when we made up promotional T-shirts for the film, nobody wanted to wear them."<sup>28</sup>

Some studios have been fortunate to catch a bad title before the film's release. The 1998 Twentieth Century Fox film *The Edge*, starring Anthony Hopkins, was originally titled *The Bookworm*.<sup>29</sup> The studio used research audiences to test the film, and the recruited moviegoers gasped and thrilled in all the right places.<sup>30</sup> They loved the movie, recalls producer Art Linson, but they hated the title.<sup>31</sup> Fortunately, the studio had enough time to change the title to *The Edge* before the film hit the market.<sup>32</sup>

For every film, studios must go through a similar process of select-

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20. *See id.*

21. *See Twentieth Century Fox Film Corp. v. Marvel Enters.*, 155 F. Supp. 2d 1, 7 (S.D.N.Y. 2001) (discussing Fox's payment of \$1.6 million for the rights to the title and characters of their 2000 movie, *X-Men*).

22. *See Dave Larsen, Can Hollywood Have an Original Concept?*, SAN DIEGO UNION-TRIB., Feb. 20, 2002, at F5, available at 2002 WL 4586677.

23. *See id.*

24. Goldstein, *supra* note 1 (quoting Tom Sherak, chairman of the Twentieth Century Fox domestic film group).

25. *Id.*

26. *Id.*

27. *Id.*

28. *Id.*

29. *Id.*

30. *Id.*

31. *Id.*

32. *Id.*

ing a workable title.<sup>33</sup> The most difficult aspect of choosing a title is that competing studios often have already registered the best titles with the Bureau.<sup>34</sup> When a conflict arises, the studio must either create a new title or confront the competing studio.<sup>35</sup> This process is Hollywood's version of the name game, and the judge, jury, and lawmaker of this game is the Motion Picture Association of America and its Title Arbitration Bureau.

### III. THE BUREAU'S PROCESS

Titles, whether for books or movies, cannot be registered as trademarks.<sup>36</sup> Similar to the protection trademark law would provide, however, the Bureau has been charged with avoiding "identical usage or harmful similarity" in American movie titles since 1925.<sup>37</sup> The Bureau provides a service to which all members of the MPAA must subscribe.<sup>38</sup> These Bureau members (the "Subscribers") must register new titles before they use them.<sup>39</sup> When a studio buys scripts or books, or when an exciting event occurs,<sup>40</sup> or whenever a studio believes they might conceivably make a movie about a topic, it registers the proposed title with the Bureau.<sup>41</sup> Each member may register up to 250 permanent titles for protection at any given time.<sup>42</sup> The larger studios, however, using corporate-umbrella entities, retain thousands of titles.<sup>43</sup> Addition-

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33. See *id.* (providing a listing of replaced motion picture titles: Disney's *Space Cadet* was changed to *Rocket Man*; Disney's *In Pursuit of Honor* was changed to *G.I. Jane*; MGM's *Birds of a Feather* was changed to *The Birdcage*; Disney's *My Posse Don't Do Their Homework* was changed to *Dangerous Minds*; Disney's *Coma Guy* was changed to *While You Were Sleeping*; and TriStar's *Cop Gives Waitress a \$1 Million Tip* was changed to *It Could Happen to You*).

34. See Telephone Interview with Mitchell Schwartz, *supra* note 10.

35. See *id.*

36. See *infra* Part IV; see also Mark S. Lee, *Trademark Essentials*, SD58 ALI-ABA 1, at 19 (1999).

37. See Telephone Interview with Mitchell Schwartz, *supra* note 10.

38. See Title Committee Memorandum, *supra* note 11, at 1 (stating that all members of the MPAA shall be required to subscribe to the service of the Bureau; producers and distributors who are not members of the MPAA shall be afforded the opportunity to subscribe on a voluntary basis).

39. See *id.* at 2 (stating that Subscribers shall register the title of each and every one of their United States theatrical motion pictures with the Bureau).

40. See Carla Hall, *Christopher Columbus-The Lawsuit; Moviemakers Go to Court For the Discoverer's Name*, WASH. POST, NOV. 27, 1990, at C01, available at 1990 WL 2095929 (quoting Dorothy Beer, former head of the Bureau) (finding that movie companies often try to corner the title market). For example, when the Israeli raid on the Entebbe, Uganda airport made headlines in the 1970s, one company registered a dozen Entebbe titles. *Id.* When Marilyn Monroe died, another company registered at least ten movie variations using her name. *Id.*

41. See Title Committee Memorandum, *supra* note 11.

42. *Id.* at 4 (noting that the Permanent Original List shall be limited to 250 entries per Subscriber—protection shall be permanent for all titles on this list unless the title is withdrawn).

43. See Goldstein, *supra* note 1.

ally, the Bureau allows Subscribers to register an unlimited amount of titles on a non-permanent basis.<sup>44</sup> As time passes, and studios continue to register titles at a rapid rate, a record number of conflicts develop each year.<sup>45</sup>

How do Subscribers discover a conflict? The Bureau issues a daily title-registration report that tracks newly registered titles.<sup>46</sup> If a Subscriber feels a proposed title is harmfully similar to its already registered title, it must file a complaint within ten business days.<sup>47</sup> That Subscriber cannot use the protested title until usage rights are conclusively determined.<sup>48</sup> To determine these rights, the conflicting parties are presented two choices: (1) settling by direct negotiation; or (2) sending the complaint to the president of the MPAA for resolution.<sup>49</sup>

Upon receiving a complaint, the president of the MPAA sends it to an arbitration panel composed of at least three disinterested Title Committee members.<sup>50</sup> In effect, these arbitrators are judges; in actuality, they are movie studio executives.<sup>51</sup> Still, courts will enforce the arbitrators' decision under the Federal Arbitration Act,<sup>52</sup> which requires courts to enforce arbitration decisions "save upon grounds as exist in law or in equity for the revocation of any contract."<sup>53</sup> Thus, the MPAA's private arbitration process allows movie studio executives, acting as arbitrators, to create binding law.

Although the creation of law is a core function of government,<sup>54</sup> "private-law" created through arbitration has become a considerable source of recent law.<sup>55</sup> A main concern with this influx of "private law" is that while government adjudication requires that the decision-maker be the judge and/or jury, private arbitration merely requires a panel of

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44. See Title Committee Memorandum, *supra* note 11, at 3-5 (outlining the Bureau's procedures for movie title registration).

45. Telephone Interview with Mitchell Schwartz, *supra* note 10.

46. *Id.*

47. See Title Committee Memorandum, *supra* note 11, at 7. ("[N]o protest shall be valid unless a copy of [the] same and fees payable are received by the Title Registration Bureau within the ten day time period specified above.").

48. *Id.* at 7.

49. *Id.* at 8. If the parties fail to reach a settlement through direct negotiation, the dispute shall be referred to the president of the MPAA by a formal written request for arbitration. *Id.*

50. *Id.*

51. See *id.* (stating the Title Committee shall be made up of a representative and an alternate from each of the member studios of the MPAA).

52. See generally 9 U.S.C. §§ 1-16 (1994).

53. See 9 U.S.C. § 2 (1994); see also Ware, *supra* note 14, at 737 (analyzing the extent to which the FAA requires and permits courts to review arbitrator's decisions).

54. See generally U.S. CONST. art. I § 8; see also U.S. CONST. art. III.

55. See Ware, *supra* note 14, at 705-08 (defining "private-law" as privately created law that is enforced by government and outlining how arbitration creates "private-law").

arbitrators.<sup>56</sup> Nonetheless, both forms of adjudication result in court enforceable decisions.<sup>57</sup> Thus, "private law" grants arbitrators great power, and the arbitrators of the MPAA's Title Registration Bureau provide no exception.<sup>58</sup>

### A. Negotiations

It is rare that the Bureau's arbitrators get to use this broad lawmaking power, as most movie title conflicts never reach arbitration.<sup>59</sup> Of the thousands of complaints member studios registered with the Bureau last year, only four cases were settled through arbitration.<sup>60</sup> Why does this happen? Instead of arbitrating, the top executives of the production companies<sup>61</sup> settle everything behind closed doors.<sup>62</sup> Although the Bureau publishes no operating rules or standards for conducting negotiations, and despite the cloud of confidentiality that cloaks the process,<sup>63</sup> history has exposed certain particulars.

For example, if a studio wants to use a title registered by a rival studio, it can offer to buy it (like when Disney bought *Ransom*), or it can offer one of its own registered film titles in exchange for the desired title.<sup>64</sup> For instance, one of Disney's blockbuster 1998 films was a Pixar-produced computer-animation comedy called *A Bug's Life*.<sup>65</sup> Because the movie was aimed at family audiences, Warner Brothers production studios lodged a protest to protect its most valuable animated character, Bugs Bunny.<sup>66</sup> The conflict resulted in a trade: Disney surrendered the rights to two of its titles, *Father's Day* and *Conspiracy Theory*, in exchange for permission to use "Bug's" in its title.<sup>67</sup>

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56. *See id.*

57. *Id.*

58. *See* Title Committee Memorandum, *supra* note 11, at 13 (stating any party can enforce an award of an arbitration or appeals panel in any court of competent jurisdiction).

59. Telephone Interview with Mitchell Schwartz, *supra* note 10.

60. *See id.*

61. *See* About the MPA, MPAA, *supra* note 8. In addition to being on the board of directors for the MPAA, executives from the following companies are also the chairmen and presidents of the seven major producers and distributors of motion picture and television programs in the United States: Disney Company, Sony Pictures Entertainment, Inc., Metro-Goldwyn-Mayer Inc., Paramount Pictures Corp., Twentieth Century Fox Film Corp., Universal Studios Inc., and Warner Brothers. *Id.*

62. *See* Linda Lee, *Name Those Movies: Would a Feature Film By Another Name Smell So Sweetly of Success? Maybe Not, as Studio Executives Do Battle and Pay Big Bucks*, N.Y. TIMES, Aug. 23, 1997, available at 1999 WL 5375030.

63. *Id.*

64. Telephone Interview with Mitchell Schwartz, *supra* note 10.

65. *See* Entertainment Section, Walt Disney Company Homepage, at <http://www.disney.go.com> (last visited, Dec. 1, 2001).

66. *See* Goldstein, *supra* note 1, at 3 (quoting Tom Roth, studio chief of Disney studios).

67. *Id.*

Furthermore, not all conflicts are battles between the “big seven” production companies. Predictably, when a large movie production company squares off in negotiations with a small production company, the larger company holds a considerable advantage.<sup>68</sup> For instance, when Disney discovered that a small Sundance Film Festival film had already registered the title *Nothing to Lose*, Disney negotiated for the title.<sup>69</sup> Eric Bross, the director of the original *Nothing to Lose*, said, “Disney played a little game [and] dilly-dallied back and forth, hoping we’d go away. They were trying to buy us off cheaply.”<sup>70</sup> Large production companies like Disney can afford to play this game because they have the financial backing, and indeed, Disney’s resources eventually proved overwhelming. Bross surrendered the rights to his title for a mid-six-figure sum.<sup>71</sup>

When the conflicting parties cannot reach a settlement, one party must either change its title or choose arbitration.<sup>72</sup> Oliver Stone was forced to change the title of his 1998 movie from “Stray Dogs,” to “U-Turn” because the original title was the property of Akira Kurosawa, who would not clear the name.<sup>73</sup> Additionally, MGM changed the name of its 1997 urban drama from “Hurricane” to “Hurricane Streets” because Paramount had owned the title “Hurricane” since 1979.<sup>74</sup> Subscribers must immediately report all settlements, either by negotiation, change of title, or withdrawal of protest, to the Title Registration Bureau, which publishes the relevant facts in its daily report.<sup>75</sup> Only then will the title be free of restriction and available for use by the prevailing party.<sup>76</sup>

### B. Arbitration

Arbitration is the only remedy in the rare event that the parties fail to reach a settlement through direct negotiation.<sup>77</sup> The arbitration panel conducts an informal hearing to decide if any “harmful similarity” exists, and if so, to decide the respective usage rights of the parties.<sup>78</sup> Although the Title Committee’s arbitration process is largely informal, it

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68. See Lee, *supra* note 62, at 2.

69. *Id.*

70. *Id.*

71. See *id.*

72. See Title Committee Memorandum, *supra* note 11, at 8.

73. See Goldstein, *supra* note 1, at 3.

74. See *id.*

75. See Title Committee Memorandum, *supra* note 11, at 7.

76. See *id.*

77. Telephone Interview with Mitchell Schwartz, *supra* note 10.

78. See Title Committee Memorandum, *supra* note 11, at 8, 9.



nevertheless has instituted guidelines for the hearing.<sup>79</sup> Specifically, all arbitrators must be disinterested, must disclose any prior relationship with the involved parties, and must sign a sworn and acknowledged statement that he or she will "hear and decide the controversy faithfully and fairly."<sup>80</sup> Still, the Committee allows parties to challenge the impartiality of arbitrators, which is determined by a vote of the remaining arbitrators.<sup>81</sup> The Committee provides the losing party the right to appeal before a disinterested panel of arbitrators,<sup>82</sup> and the winning party the right to enforce its verdict in court.<sup>83</sup>

When asked about the function of the Bureau and its Title Committee, Mitchell Schwartz, the director of the Title Registration Bureau, stated, "We operate to make sure there is no confusion in the general public."<sup>84</sup> Thus, the main function of the arbitration panel is to ensure that similar titles do not confuse the general public as to the identity or origin of those films. To execute this task, the Title Committee has given substantive guidelines to the arbitration panel regarding their "private law."

The Title Committee defines "conflict" as "the harmful similarities of titles which may cause public confusion as to the identity or origin of a theatrical motion picture."<sup>85</sup> Further, "[b]oth similarity and likelihood of harm must be shown in order to prove 'conflict.'"<sup>86</sup> In evaluating the respective rights to title use, the Title Committee states,

the arbitrators may consider all of the equities involved and allow the balance of such equities to govern their decision. Factors that may be weighed by panels include, but are not limited to, vintage and notoriety of each work; theme or plot of each work; investment in each work; importance to the overall production/distribution plans; present uses; prospects for theatrical release; theatrical sequels; theatrical spin-offs and the like.<sup>87</sup>

One recently arbitrated film was *French Kiss*, the 1995 Meg Ryan comedy that was originally titled *Paris Match*.<sup>88</sup> Castle Rock Entertainment challenged the title, maintaining that it was too similar to *Forget*

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79. Telephone Interview with Mitchell Schwartz, *supra* note 10.

80. See Title Committee Memorandum, *supra* note 11, at 8.

81. See *id.* at 9 (noting that the director of the Title Bureau may cast the deciding vote in a deadlock). In the event of removal of an arbitrator, the arbitration can be postponed until a full quorum (three) of disinterested arbitrators can be assembled. *Id.* The parties additionally have the right to waive their right to a quorum of disinterested arbitrators. *Id.*

82. *Id.* at 9.

83. *Id.* at 13.

84. Telephone Interview with Mitchell Schwartz, *supra* note 10.

85. *Id.*

86. *Id.*

87. *Id.* at 12.

88. See Goldstein, *supra* note 1, at F1.

*Paris*, the Billy Crystal comedy it planned to release within months of the rival film.<sup>89</sup> The arbitration panel decided that the public would be confused, noting that both films were romantic comedies, partially set in Paris, starring two actors who had previously starred in the romantic comedy, *When Harry Met Sally*.<sup>90</sup> Thus, because there was a harmful similarity in titles and a possibility of public confusion as to identity or origin of the motion picture, the Bureau forced *Paris Match* to change its name to *French Kiss*.<sup>91</sup> In contrast, a 1997 panel cleared New Line Cinema's use of the title *Austin Powers, The Spy Who Shagged Me* despite its similarity to the 1977 James Bond film *The Spy Who Loved Me*.<sup>92</sup>

How did the panel reach these decisions? In determining whether any harmful similarity exists, the Title Committee grants arbitration panels great leeway.<sup>93</sup> In determining "conflict" and "rights," the Title Committee lists factors that "may" be evaluated. However, it specifically states that the panel is not limited by this list and that "all the equities involved" may be considered.<sup>94</sup> The Title Committee lists budget, status of scripts, investments already expended, proximity to principal photography or theatrical release, theme or plot, marketing campaign, and anticipated release pattern as factors for possible consideration.<sup>95</sup> In addition, when determining rights, the Title Committee denies arbitrators the right to deprive the holder of an identical, previously registered title from using that title.<sup>96</sup> Nevertheless, the Title Committee grants arbitrators the right to deprive the holder of a subsequently registered title of the right to use its title.<sup>97</sup> In effect, registering first guarantees you the right to use the title.

Despite these substantive guidelines and procedural rules, panel decisions are not always predictable. Accordingly, a 2002 panel ruled that the third *Austin Powers* movie could not use the title *Austin Powers in Goldmember* because of its close relation to the James Bond classic *Goldfinger*.<sup>98</sup> Critics of this ruling claim that the government would not have protected the Bond title in court, that the New Line parody contains

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89. *See id.*

90. *See id.*

91. *See id.*

92. *See Austin Powers 3 Title Ruled 'Inadmissible' by MPAA*, MOVIES.COM-NEWS (Jan. 28, 2002), at <http://www.movies.go.com/news/2002/1/powerstitle012802.html>.

93. Title Committee Memorandum, *supra* note 11, at 12.

94. *Id.*

95. *Id.*

96. Telephone Interview with Mitchell Schwartz, *supra* note 10.

97. *Id.*

98. *Austin Powers Loses Goldmember Appeal*, BBC NEWS-FILM (Feb. 1, 2002), at [http://www.news.bbc.co.uk/hi/English/entertainment/film/newsid\\_1795000/1795840.stm](http://www.news.bbc.co.uk/hi/English/entertainment/film/newsid_1795000/1795840.stm).

no “harmful similarities which may lead to public confusion,” and that the MPAA has wielded too much power and infringed upon free speech.<sup>99</sup> Furthermore, it seems as though the panels are free to ignore past precedent. Remember, a 1997 panel found no harmful similarities between *The Spy Who Shagged Me* and *The Spy Who Loved Me*.<sup>100</sup> Meanwhile, these critics’ arguments may be moot, as the panel decision seems to be based on New Line’s failure to properly register its original title with the Bureau; moreover, the studios seemed to disregard the ruling by settling the conflict through negotiation.<sup>101</sup> Little information is available to help resolve these conflicts. Aside from the final ruling, confidentiality precludes the panels from publishing any findings or opinions.<sup>102</sup>

Creative producers can use the ambiguities and uncertainties of Bureau rules to find loopholes for their title. For example, when Sony produced *Bram Stoker’s Dracula* and *Marie Shelly’s Frankenstein*, the original titles of *Dracula* and *Frankenstein* were registered to Universal Studios.<sup>103</sup> By honoring the long-dead authors, Sony conveniently and cleverly differentiated its films from the original horror movies. Universal took Sony to arbitration and the panel found no harmful similarities in titles that might lead to public confusion as to origin or identity. Thus, the panel ruled in Sony’s favor.<sup>104</sup>

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99. Roger Ebert, ‘Austin Powers’ Title Creates No Confusion, *TIMES UNION ALBANY, N.Y.*, Feb. 21, 2002, available at 2002 WL 8892388; see also Forest Gabitsch, ‘International Man of Mystery’ Surrenders His Freedom of Speech, *U-WIRE*, Feb. 14, 2002, available at 2002 WL 12486331; Gayle MacDonald, *Powers Play: The Studio that Litigated Me*, *GLOBE AND MAIL*, Feb. 9, 2002, available at *West-news* (quoting Marian Hebb, a copywrite lawyer in Toronto, “[the title ‘Goldmember’is] clearly a parody. My guess would be if it got before a U.S. court, the judge would label it a fair use of parody”). On the other hand, copywrite lawyer Claude Brunet, a partner with the law firm Ogilvy Renault in Montreal, states, “From what I’ve seen in terms of the trailers, the connection between Bond and Powers is obvious. The rules of parody are complex . . . and one has to be extremely careful where one treads.” *Id.*

100. See *Austin Powers 3*, at *MOVIES.COM-NEWS supra* note 92.

101. See *id.* (stating that New Line apparently failed to go through the proper channels); see also Elaine Dutka, *Morning Report Arts and Entertainment Reports from the Times, News Service and the Nation’s Press*, *L.A. Times*, Apr. 13, 2002 at F2 (stating the arbitration panel found that New Line had committed a technical infraction by going public with the title before it had been properly registered, and additionally stating that the studios reached a private agreement which will allow New Line to use the title “Goldmember” because New Line studio assured MGM they will get future Bond parodies approved by MGM prior to release); *M2-Showbiz-Eminem Kiss Rap*, 2002 Birmingham Post & Mail Ltd., Apr. 12, 2002 at Evening Mail P49, available at 2002 WL 19003687 (stating that in return for MGM allowing New Line to use the title “Goldmember,” NewLine has agreed to include advertisement trailers of upcoming MGM films in the opening credits of “Goldmember” and “Lord of the Rings”).

102. Telephone Interview with Mitchell Schwartz, *supra* note 10; see also *supra* text accompanying note 62.

103. Goldstein, *supra* note 1.

104. See *id.*

Additionally, the Title Committee grants arbitration panels broad powers in awarding damages.<sup>105</sup> For instance, take the panel's recent decision against Miramax:<sup>106</sup> The panel demanded a whopping \$1,500 per-day, per-screen, for all 1,200 screens showing Miramax's *Scream*.<sup>107</sup> The panel further demanded \$20,000 for unauthorized use<sup>108</sup> and \$20,000 in legal fees.<sup>109</sup> Why did the panel exact such a significant fine? When Miramax first registered the title, Sony registered a timely complaint that the title was too similar to Sony's previously registered *Screamers*.<sup>110</sup> By the time the MPAA ordered an arbitration meeting, Miramax had already been showing *Scream* in theaters for six weeks.<sup>111</sup> Moreover, Miramax delayed an additional month before responding to the complaint.<sup>112</sup> Thus, the panel levied the unprecedented fine to get Miramax's attention for snubbing their nose at the process and causing possible public confusion.<sup>113</sup> In the aftermath of the fines, Miramax was fortunate to quietly settle the dispute when Disney, Miramax's parent company, gave Sony better terms on *Starship Troopers*, a sci-fi thriller that the two studios co-produced.<sup>114</sup> If the panel meant to deter future

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105. Title Committee Memorandum, *supra* note 11, at 13 (stating that the panel may consider all the relevant circumstances in determining damages, including but not limited to, the nature of the violation, whether it was willful and whether the violation caused actual injury to the prevailing party).

106. *See* Goldstein, *supra* note 1.

107. *Id.*

108. *Id.*; *see also* Title Committee Memorandum, *supra* note 11, at 13 (stating that a Subscriber cannot use a protested title for which it does not have the rights under the terms of this Memorandum and the Operating Rules). If a Subscriber uses a protested title or any other title for which it does not have the right under the terms of this Memorandum and the Operating Rules, the injured Subscriber(s) may request a general arbitration under the provisions of Article III Section (d). *Id.* In the event of an unauthorized use, the arbitration or appeals' panel may consider the following options as well as any others that the parties may offer. *Id.*

(1) A recommendation to the MPAA Board of Directors that the Subscriber's registrations and membership be terminated under the provisions of Article V Section (d) of the Memorandum of the Title Committee.

(2) A prohibition of any use of the title involved irrespective of whether or not there exists a "conflict" as defined in Article III Section (a) of the Memorandum of the Title Committee; or

(3) Any other corrective action that is fair under the circumstances after full consideration of the facts and equities involved, including but not limited to "corrective" advertising, changes of any further advertising or other materials in all media including, but not limited to, changes of all prints bearing the offending title.

*Id.*

109. *See* Title Committee Memorandum, *supra* note 11, at 13 (stating that the arbitrator may impose costs and reasonable attorneys' fees upon the losing party); *see also* Lee, *supra* note 7 (outlining the arbitration against Miramax).

110. Lee, *supra* note 7.

111. *See* Goldstein, *supra* note 1, at F1.

112. *See id.*

113. *See* Goldstein, *supra* note 1.

114. *See id.* (noting that with *Scream II*, a sequel already in the works, Miramax would face a

unfair use by levying such a healthy fine against Miramax, it seems to have worked. As soon as the cease-and-desist order appeared from MGM, the owners of the title *Goldfinger*—New Line Cinema—quickly and quietly recalled already running trailers, posters, images, and online promotional advertising containing *Goldmember*.<sup>115</sup>

The above instances are perfect examples of the Bureau creating law through its arbitration panels and Title Committee. It declares judicial and administrative rules of procedure, boasts an aggregate of judicial precedents, and retains a body of authoritative grounds from which it can base future decisions. Thus, the Bureau has created private law; its private arbitration panels decree decisions that are enforceable by the courts.<sup>116</sup>

Moreover, the Bureau has effectively cornered the market on title conflict disputes among Subscribers by implementing its mandatory “direct negotiation” or “arbitration” policy.<sup>117</sup> In effect, this forces plaintiff Subscribers to rely on arbitration panels to enforce their intellectual property rights, while forcing defendant Subscribers to rely on panels to enforce their creativity and right to freedom of speech. The question this article seeks to resolve is whether the private panel’s protection of Subscriber rights is in conflict with the protection that courts would otherwise apply.

#### IV. PRIVATELY CREATED LAW VERSUS GOVERNMENT CREATED LAW.

Registering a title with the Bureau automatically assures protection from unfair use.<sup>118</sup> The Bureau, however, only has jurisdiction over its Subscribers, and if a non-Bureau member unfairly makes use of a Subscriber’s title, that Subscriber must turn to the courts for relief.<sup>119</sup> Hence the question: to what extent is the Subscriber entitled to protection? Although consumers identify books, periodicals, newspapers, plays, television programs, songs, record albums, and motion pictures by their title, the United States Patent and Trademark Office (USPTO)<sup>120</sup> has

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dramatic loss of box-office potential if it were promoted under a different title—thus, it chose to settle instead of facing the possibility of an adverse ruling from the panel). *Id.*

115. See *Austin Powers* in *Goldmember* at <http://www.upcomingmovies.com/austinpowers3.html>.

116. See *supra* text accompanying note 55.

117. See Title Committee Memorandum, *supra* note 11, at 8.

118. See generally *id.*

119. Telephone Interview with Mitchell Schwartz, *supra* note 10; see also Title Committee Memorandum, *supra* note 11, at 3-5.

120. BLACK’S LAW DICTIONARY 1148 (7th ed. 1999) (defining the United States Patent and Trademark Office as the Department of Commerce agency that examines patent and trademark applications, issues patents, registers trademarks, and furnishes patent and trademark information and services to the public).

stated that the titles of these single expressive works are “generic” and therefore cannot be registered as trademarks. Likewise, courts have resisted protecting the title of a single work.<sup>121</sup> Historically, outside the Bureau, the only realistic possibility for protecting the title of a single motion picture was under the doctrine of unfair competition, an old common law concept now codified by statute.<sup>122</sup>

### A. *The Government’s Law*

#### I. PRONG ONE: ENTITLEMENT TO PROTECTION

The doctrine of unfair competition burdens the plaintiff Subscriber with proving: (1) that it is entitled to protection; and (2) that the defendant’s use of the title is likely to cause confusion among consumers.<sup>123</sup> The first prong is demanding, as it requires the plaintiff to show that the title is “not generic;” and that the title has acquired a “secondary meaning.”<sup>124</sup> The degree of protection a title will receive “is directly related to the [title’s] distinctiveness.”<sup>125</sup> In determining distinctiveness, courts typically categorize the movie title, in descending order of strength,<sup>126</sup> as

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121. See MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 10:4 (4th ed. 1999); see also *In re Cooper*, 254 F.2d 611, 616-17 (C.C.P.A. 1958) (upholding the PTO’s refusal to register a book title but noting that the “rights in book titles are afforded appropriate protection under the law of unfair competition”); *Sugar Busters LLC v. Brennan*, 177 F.3d 258, 269 (5th Cir. 1999); *Maljack Prods., Inc. v. Goodtimes Home Video Corp.*, 81 F.3d 881, 887 (9th Cir. 1996); *Twin Peaks Prods., Inc. v. Publ’ns Int’l, Ltd.*, 996 F.2d 1366, 1379 n.4 (2d Cir. 1993); *Rogers v. Grimaldi*, 875 F.2d 994, 998 (2d Cir. 1998); *Lee*, *supra* note 7, at 21.

122. See Mary A. Donovan, *On Your Mark! Basic Principles of Trademarks*, 646 PLI/Pat 169, 174 (2001) (noting that most states have laws addressing this issue, and every state has its own trademark registration system for marks used within its borders). The Lanham Act, 15 U.S.C. §1051, enacted pursuant to the Commerce Clause of the Constitution in 1946, codifies U.S. Federal Law in this area. *Id.* Section 43(a) of the Lanham Act creates federal causes of action for unfair competition, whether or not the mark is registered. *Id.*

123. *Jenkins v. Paramount Pictures Corp.*, 90 F. Supp. 2d 706, 709 (E.D. Va. 2000).

124. *Id.* at 712 (finding the title *First Contact* to be generic and not entitled to trademark protection). Additionally, *Jenkins* notes that titles of expressive works are treated differently than other trademarks. *Id.* Titles, even if suggestive, arbitrary or fanciful [not generic], nonetheless require secondary meaning to receive trademark protection, while other suggestive, arbitrary, or fanciful marks do not. *Id.* See also McCarthy, *supra* note 121, § 10:2 (stating that the courts have given trademark protection to literary titles of one-shot, single works only upon a showing of secondary meaning, even though the title is not descriptive).

125. *Id.*

126. See *id.*

either “fanciful,” “arbitrary,”<sup>127</sup> “suggestive,”<sup>128</sup> “descriptive,”<sup>129</sup> or “generic.”<sup>130</sup>

If a court finds a Subscriber’s title to be “generic,” the title is not entitled to trademark protection.<sup>131</sup> Accordingly, when the author of the 1945 short story *First Contact* sued Paramount for its 1996 movie *Star Trek, First Contact*, the court did not protect the author because it deemed the title generic.<sup>132</sup> The court determined that the phrase *First Contact* had come to describe an entire genre of science fiction, namely literature regarding humankind’s first encounter with extraterrestrial life.<sup>133</sup>

In contrast, when the producers of Tom Cruise’s *Top Gun* sued an amusement park that intended to name a ride after the movie, the courts categorized “Top Gun” as descriptive.<sup>134</sup> The category into which the court places a title, whether generic or descriptive, is vital to the life of

127. *Id.* The court defined fanciful or arbitrary marks as “coined words that bear no relationship to the products with which they are associated.” *Id.* (noting *Clorox Chem. Co. v. Chlorit Mfg. Corp.*, 25 F. Supp. 702 (E.D. Pa. 1983) (“Clorox”); *Eastman Kodak Co. v. Rakow*, 739 F. Supp. 116 (W.D.N.Y. 1989) (“Kodak”); *Abercrombie & Fitch Co. v. Huntingworld, Inc.*, 537 F.2d 4, 9 n.6 (2d Cir. 1979) (“Ivory” soap)). Additionally, the court stated that “[t]hese marks are terms that enter the language as a trademark for a particular good or service.” *Id.*

128. *Id.* The court defined suggestive marks as “words which suggest some quality or character of a product, but not clearly enough to avoid the need for imagination.” *Id.* (citing *Coca-Cola Co. v. 7-Up Co.*, 497 F.2d 1351 (C.C.P.A. 1974) (“uncola” soft drink); *Stick Prods., Inc. v. United Merchants & Mfrs.*, 295 F. Supp. 497 (S.D.N.Y. 1968) (“contact” for self-adhesive shelf paper)).

129. *Id.* The court defined descriptive marks as “marks which identify a characteristic, quality, or other aspect of a product or service with which it is associated. They are not protectible unless consumers have learned to associate them with a single source, i.e., they have acquired ‘secondary meaning’ . . . .” *Id.* (citing *Zimmerman v. Holiday Inns of Am., Inc.*, 266 A.2d 87 (1970) (“Holiday Inn” Motel); *Hayes Microcomputer Prods., Inc. v. Bus. Computer Corp.*, 219 U.S.P.Q. 634 (T.T.A.B. 1983) (“Intelligent Modem”); *King-Size, Inc. v. Franks King Size Clothes, Inc.*, 547 F. Supp 1138 (S.D. Tex. 1982) (“King Size” clothing for larger men)).

130. *Id.* The court defined generic, unprotectible terms as “common descriptions for classes of goods to which a particular product belongs.” *Id.* (citing *Kellogg Co. v. Nat’l Biscuit Co.*, 305 U.S. 111 (1938) (“Shredded Wheat” held generic and unprotectible); *Locite Corp. v. Nat’l Starch & Chem. Corp.*, 516 F. Supp 190 (S.D.N.Y. 1981) (“Super Glue” held unprotectible)).

131. *See Abercrombie*, 537 F.2d at 9 (stating a generic term is not entitled to trademark protection because “no matter . . . what success [the trademark owner] has achieved in securing public identification, it cannot deprive competing manufacturers of the right to call an article by its name”).

132. *See Jenkins v. Paramount Pictures Corp.*, 90 F. Supp. 2d 706, 712 (E.D. Va. 2000).

133. *See id.* (finding that the title of a single expressive work is generic if that title is the name of a subcategory of which the work in question is a member). *Id.* Therefore, a film such as *The Godfather* is not merely a species of motion pictures, it is a species of the “mobster movie” genre. *Id.*

134. *See Paramount Pictures Corp. v. Dorney Park Coaster Co.*, 698 F. Supp. 1274, 1278 (E.D. Pa. 1988) (finding the title *Top Gun* to be at least descriptive because no evidence supported the proposition that that segment of society already familiar with the U.S. Navy Miramar training facility immediately understood that the movie was meant to portray the school).

the lawsuit. The court granted relief to *Top Gun*'s producer whereas the court granted nothing to the author of *First Contact*.<sup>135</sup>

Still, under government-created law, even if a movie producer proves the title is not generic, he or she will not be entitled to protection unless "secondary meaning" is also established.<sup>136</sup> A title only achieves secondary meaning if the public perceives the title to be a designation of the origin of the product.<sup>137</sup> Courts use the following factors to determine secondary meaning: advertising expenditures, consumer studies, sales success, unsolicited media coverage of the work, attempts to plagiarize the mark, the length and exclusivity of the mark's use, and evidence of actual confusion.<sup>138</sup> Hence, Paramount, the producers of *Top Gun*, established secondary meaning because the public associates the words "Top Gun" with Paramount's motion picture, thereby suggesting to the public that products bearing that name emanate from a single source.<sup>139</sup> Using a similar analysis, a court found secondary meaning in the titles *JAWS* and *JAWS 2*.<sup>140</sup> In these cases, the court noted the large amount of monetary expenditures and extensive promotional efforts as exceptionally relevant in its determination of secondary meaning.<sup>141</sup>

Additionally, an unreleased film can acquire a secondary meaning.<sup>142</sup> Thus, evidence of extensive prerelease advertising led a California court to find secondary meaning in the film title *The Wonderful Life of the Brother's Grimm*, even though the film was not complete.<sup>143</sup> A New York court reaffirmed this concept when it granted Orion Pictures Company the opportunity to establish secondary meaning in its title, *A Little Romance*, even though the motion picture was not yet complete.<sup>144</sup>

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135. See *id.*; see also *Jenkins*, 90 F. Supp. 2d at 712.

136. See *supra* text accompanying note 124.

137. *Id.*

138. *Jenkins*, 90 F. Supp. 2d at 713 (holding that the literary work *First Contact* had no secondary meaning because the plaintiffs never spent any substantial time, energy, or money advertising or promoting the mark; consumers did not believe that *First Contact* primarily refers to the story; the story only achieved slight sales success; there was rare unsolicited media coverage; the mark was not plagiarized; and consumer confusion was limited).

139. See *Paramount*, 698 F. Supp. at 1276-77.

140. See *Universal City Studios, Inc. v. Montgomery Ward & Co.*, 207 U.S.P.Q. 852, 856 (N.D. Ill. 1980) (finding secondary meaning because of the wide dissemination of the *JAWS* books, the large number of people who have been exposed to the movie, the wide dissemination of merchandising properties licensed under the mark "JAWS," and the court's own observation and experience).

141. See *id.*

142. See *McCarthy*, *supra* note 121, at § 10:4, 277 (1973) (stating that if a work is not released, a significant amount of prerelease publicity of the title may cause the title to acquire recognition sufficient for protection).

143. See *Metro-Goldwyn-Mayer, Inc. v. Lee*, 27 Cal. Rptr. 833 (1963).

144. See *Orion Pictures Co. v. Dell Publ'g Co.*, 471 F. Supp 392, 396 (S.D.N.Y 1979) (finding



Thus, a movie producer is entitled to judicial protection for released and unreleased movie titles. Although, to gain this protection, the movie producer must first establish “distinctiveness” and “secondary meaning.”<sup>145</sup>

## II. PRONG TWO: LIKELIHOOD OF CONFUSION

A plaintiff who establishes “distinctiveness” and “secondary meaning” passes the first hurdle in the burden of proof;<sup>146</sup> but there is an additional barrier: proving likelihood of confusion.<sup>147</sup> To meet this burden, it is not necessary to demonstrate that consumers would identify the plaintiff’s movie producer as the source of defendant’s product, but merely that consumers are likely to assume that the defendant’s product is “sponsored, affiliated, or associated with the source of plaintiff’s movie.”<sup>148</sup> Additionally, it is important to remember that it is the likelihood of confusion that serves as a test for infringement, not actual confusion. This is especially true where the alleged infringing title has not been advertised or released.<sup>149</sup> Traditionally, likelihood of confusion is determined by evaluating a number of factors, commonly referred to as the “digits of confusion.”<sup>150</sup> Among the digits of confusion are: (1) strength of the infringed mark;<sup>151</sup> (2) similarity of the marks;<sup>152</sup> (3) degree to which the products or services compete;<sup>153</sup> (4) existence of an intent to trade upon the goodwill of the plaintiff’s mark;<sup>154</sup> (5) evidence

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extensive pre-release advertising and the defendant’s plan to count on the plaintiff’s publicity as the primary means by which to promote its product as evidence of pre-release secondary meaning).

145. *See id.*; *see also* *Tri-Star Pictures, Inc. v. Leisure Time Prods.*, 14 F. Supp. 2d 339, 355 (S.D.N.Y. 1998).

146. *See Jenkins*, 90 F. Supp. 2d at 714 (offering the plaintiff no relief because no evidence was offered to pass the first prong of the government burden, “entitlement to relief”).

147. *See generally* *McCarthy*, *supra* note 121, at § 15:10 (1973).

148. *Paramount Pictures Corp. v. Dorney Park Coaster Co.*, 698 F. Supp. 1274, 1279 (E.D. Pa. 1988).

149. *Am. Dairy Queen Corp. v. New Line Prods., Inc.*, 35 F. Supp. 2d 727, 732 (D. Minn. 1998) (finding likelihood of confusion when American Dairy Queen Corporation sued the makers of the then unreleased movie titled *Dairy Queens*).

150. *Id.*

151. *Id.* at 730. Two factors measure a mark’s strength: the distinctiveness of the mark and the extent to which the mark is recognized by the relevant consumer class. *Id.*

152. *Id.* Similarity of marks is tested on three levels: sight, sound, and meaning. *Id.* Each must be considered as they are encountered in the marketplace. *Id.*

153. *Id.* Where products are in direct competition, the degree of similarity required to prove likelihood of confusion will be less than in the case of noncompetitive products, and lack of direct competition does not preclude a finding of likelihood of confusion. *Id.*

154. *Id.* at 731. An inference of intent to trade upon plaintiff’s goodwill arises if the defendant, with knowledge of plaintiff’s mark, chooses a mark similar to the plaintiff’s mark regardless of the infinite number of possible marks. *Id.*

of actual confusion;<sup>155</sup> (6) likelihood of expansion of the product lines into the same markets;<sup>156</sup> (7) sophistication of buyers;<sup>157</sup> and (8) quality of defendant's products.<sup>158</sup> When reaching a conclusion, courts are free to weigh some factors more heavily than others, holding no one factor as dispositive.<sup>159</sup>

Using a similar analysis, one court found a likelihood of confusion between the original motion picture, *Bridge on the River Kwai*, and the subsequent motion picture, *Return from the River Kwai*.<sup>160</sup> Applying the "digits of confusion," the court found the original title was strong, the titles were substantially the same, the products were in close proximity, there was evidence of actual consumer confusion, the subsequent film had not received positive reviews, and the producers of the subsequent film had acted in bad faith in adopting their title.<sup>161</sup> Likewise, in *Paramount Pictures Corp. v. Dorney Park Coaster Co.*, the court found a strong likelihood of consumer confusion in an amusement park ride named "Top Gun".<sup>162</sup> The riders that engaged in mock space battles most likely believed that the ride was sponsored, affiliated, or had some connection to the origin of a movie with the same name.<sup>163</sup>

Because this law gives courts great leeway in determining likelihood of confusion, not all courts agree on a definition. For instance, when the creator of the movie *JAWS* sued Montgomery Ward for using "Jaws" to identify Ward's trash compacters, a court found a likelihood of confusion as to source, approval, or sponsorship.<sup>164</sup> The court stated that Ward's adoption of the term "Jaws", with intent to capitalize on the plaintiff's mark, leads to a strong inference of likelihood of confusion.<sup>165</sup> In contrast, when the creators of the movie *Godzilla* sued Sears for using "Bagzilla" to identify its "monstrously strong garbage bags," that court refused to apply the *JAWS* holding.<sup>166</sup> According to the *Toho* court, "the

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155. *Id.*

156. *Id.*

157. *Id.*

158. *Id.* at 730-33; *see also* Lee, *supra* note 7, at 18.

159. *See* Lee, *supra* note 7, at 18.

160. *See* Tri-Star Pictures, Inc. v. Leisure Time Prods., 14 F. Supp. 2d 339, 355-58 (S.D.N.Y. 1998).

161. *See id.* at 357 (permanently enjoining and restraining the defendants from releasing the movie under the title *Return from the River Kwai* or with any other title containing the words "River Kwai" or under any title that is confusingly similar to "*Bridge on the River Kwai*" or "Kwai").

162. *See* Paramount Pictures Corp. v. Dorney Park Coaster Co., 698 F. Supp. 1274, 1274 (E.D. Pa. 1988).

163. *Id.*

164. *See* *Universal City Studios*, 207 U.S.P.Q. at 857.

165. *Id.*

166. *Toho Co. v. Sears, Roebuck & Co.*, 645 F.2d 788, 791 n.2 (9th Cir. 1981).

JAWS court erred when it assumed that an intent to 'capitalize' was enough. In order to raise an inference of likelihood of confusion, the plaintiff must show that the defendant intended to profit by *confusing consumers*.<sup>167</sup> Thus, although courts unanimously require a plaintiff to show both entitlement to protection and likelihood of confusion, they often disagree as to the definition of these requirements.

### B. *The Comparison*

Is there a conflict in the protection afforded by these two different forums? Like the courts, Bureau arbitration panels possess great latitude in determining "conflict," which leads to an analysis of law comparable to the courts' varying analyses of likelihood of confusion. The Committee defines "conflict" as "the harmful similarity of titles which may cause public confusion as to the identity or origin of a theatrical motion picture."<sup>168</sup> The courts, in attempting to determine likelihood of confusion, are similarly looking for harmful similarities that may cause public confusion as to identity or origin.<sup>169</sup> The Title Committee additionally provides a list of factors which may be used in determining conflict;<sup>170</sup> however, similar to the governments "digits of confusion," no one Committee factor is determinative, and the arbitrators are not limited by the list.<sup>171</sup> Similarly, both forums allow the respective fact-finders broad power to balance the equities as they choose.

Additionally, both sets of law, albeit different in substance and procedure, are admittedly operating for the same purpose. The Bureau "operates to make sure there is no confusion in the general public,"<sup>172</sup> and "the purpose of providing trademark protection . . . is to protect the public from confusion with respect to the origin of products or services."<sup>173</sup> Although these two sets of laws have different sources, perhaps they are not absolutely irreconcilable.

To determine whether they conflict, it is valuable to examine the variances in existing remedies under these laws. Both the private law of the MPAA and the judicial law of the courts have respective advantages and disadvantages with respect to available remedies. As stated, the Bureau arbitration panels have broad power in awarding damages.<sup>174</sup>

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167. *Id.*

168. See Title Committee Memorandum, *supra* note 11, at 7.

169. See *Universal City Studios*, 207 U.S.P.Q. at 857.

170. See Title Committee Memorandum, *supra* note 11, at 12.

171. *Id.*

172. Telephone Interview with Mitchell Schwartz, *supra* note 10.

173. *Parmount Pictures Corp. v. Dorney Park Coaster Co.*, 698 F. Supp. 1274, 1277 (E.D. Pa. 1988).

174. See Title Committee Memorandum, *supra* note 11, at 13 ("[A]rbitrators are free to

Similarly, courts have great leeway in determining both actual<sup>175</sup> and statutory damages.<sup>176</sup> Courts, however, have the additional power to freeze the assets of the infringer,<sup>177</sup> whereas the MPAA's private arbitration panels have no stated power to freeze assets.<sup>178</sup>

Likewise, a conflict may exist in recovery of attorneys' fees. Under the Bureau, arbitrators may impose costs and reasonable attorneys' fees on the losing party.<sup>179</sup> Courts can also award attorneys' fees under government created laws, but only in "exceptional cases."<sup>180</sup> A closer examination of the operating rules of the Committee suggests that these forums are not completely dissimilar in awarding attorneys' fees. The Title Committee states that, "the arbitrators are free to consider all the relevant circumstances, including, but not limited to, whether the position taken by the losing party was frivolous."<sup>181</sup> This could lead to results similar to the courts' "exceptional cases" standard.<sup>182</sup>

Lastly, an examination of these laws would be incomplete without a discussion of the contrasting policies regarding the defendant's use of infringing titles. Under the MPAA's private law, an absolute bar from using the potentially conflicting title exists from the instant a complaint is registered until the respective rights of the parties are determined.<sup>183</sup> As evidence of the seriousness of this rule, the Bureau's arbitration panel fined Miramax heavily for its unauthorized use of the title *Scream*.<sup>184</sup> In contrast, if a Subscriber sues in court, the defendant can still exploit the infringing title during the course of litigation. The court

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consider all of the relevant circumstances, including, but not limited to, the nature of the violation, whether it was willful and whether the violation caused actual injury to the prevailing party.").

175. See Mark S. Lee, *supra* note 36, at 19 (stating that courts may award actual damages, the defendant's wrongful profit, and if the infringement of the mark is intentional, an order trebling the actual damages).

176. See *id.* (stating that the court will determine the amount of statutory damages from a low of \$500 for an innocent infringement to a high of \$1 million for a willful infringement).

177. See *Brandon v. Univ. of Cal.* 441 F. Supp. 1086, 1091 (D. Mass. 1977) (awarding an accounting of all of the defendant's gross income from the sale and rental of the infringing film); see also *Reebok Int'l v. Marnatech Enter.* 970 F.2d 552, 562 (9th Cir. 1992).

178. See generally Title Committee Memorandum, *supra* note 11, at 12-13. (stating possible remedies such as costs, attorneys' fees, and damages, but no mention of freezing assets).

179. Title Committee Memorandum, *supra* note 11, at 13; see also Goldstein, *supra* note 1 (noting that the arbitration panel forced Miramax to pay attorneys' fees and costs for the unauthorized use of the title *Scream*).

180. See 15 U.S.C. § 1117 (a)-(b) (2000); see also *Tri-Star Pictures, Inc. v. Leisure Time Prods.*, 14 F. Supp. 2d 339, 364 (S.D.N.Y. 1998) (awarding attorneys' fees in willful infringement cases interpreted as "exceptional cases").

181. See Title Committee Memorandum, *supra* note 11, at 13.

182. See *Brandon*, 441 F. Supp. at 1090 (D. Mass. 1977) (awarding reasonable attorneys' fees in an "exceptional case" because of the deliberate actions and frivolous claims of the defendant).

183. See Title Committee Memorandum, *supra* note 11, at 13; see also *supra* text accompanying note 97.

184. See Linda Lee, *supra* note 62.

does not strip the defendant of that right until the conclusion of the case.<sup>185</sup> While a court could take years to decide a case, a plaintiff's movie title could suffer "irreparable harm"<sup>186</sup> as it becomes diluted of its goodwill.<sup>187</sup> This does not occur under the MPAA's procedure. Once a conflict is reported to the Bureau, the defendant is immediately enjoined from using the conflicting title.<sup>188</sup>

Can this difference be reconciled? Under government law, if a producer truly seeks to protect the goodwill in his title, he can seek a preliminary injunction.<sup>189</sup> If granted, a preliminary injunction mandates that the defendant stop its use of the possibly infringing title until the court determines the rights of the respective parties.<sup>190</sup> A court's power to grant a preliminary injunction is most analogous to the Title Committee's absolute ban on unauthorized use. An absolute ban ensures the plaintiff's protection from unfair use throughout the trial. Before obtaining a preliminary injunction, however, the plaintiff movie producer must show "probability of success."<sup>191</sup>

In the judicial system, the moving plaintiff has the burden of proving the existence of a probability of its ultimate success on the merits, or a court must deny the preliminary injunction.<sup>192</sup> In application, a movie producer plaintiff would at the very least be required to make a clear, strong showing of "distinctiveness," "secondary meaning," and "likelihood of confusion."<sup>193</sup> Many courts additionally require the plaintiff to establish irreparable harm in the absence of a preliminary injunction and to establish that the preliminary injunction is in the public interest.<sup>194</sup> A

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185. See *Tri-Star*, 14 F. Supp. 2d 339 (S.D.N.Y. 1998).

186. See *Paramount Pictures Corp. v. Dorney Park Coaster Co.*, 698 F. Supp. 1273, 1283 (E.D. Pa. 1988) (stating that courts have consistently concluded that irreparable harm follows from the unauthorized use of a mark, because the plaintiff has an inability to exercise control over the products to which the unauthorized user will attach plaintiff's mark).

187. See *Tristar*, 14 F. Supp. 2d at 363 (defining dilution as the blurring of the title's identification power or the tarnishment of the affirmative associations the title conveys); see also *Donovan*, *supra* note 122, at 175 (defining dilution as the likelihood to lesson the strength of a famous mark).

188. See Title Committee Memorandum, *supra* note 11, at 13.

189. See 15 U.S.C. § 1116 (2000); see also *McCarthy*, *supra* note 121, §30:45 at 30-85; see also *Lee*, *supra* note 36, at 19; *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, 604 F.2d 200 (2d Cir. 1979) (affirming a preliminary injunction granted for the infringement of an unregistered mark).

190. See generally *McCarthy*, *supra* note 121, § 30:45.

191. See *id.*

192. See *id.*

193. See *id.*; see also *Paramount Pictures Corp. v. Dorney Park Coaster Co.*, 698 F. Supp. 1274, 1276 (E.D. Pa. 1988).

194. See *Paramount*, 698 F. Supp. at 1286 (granting a preliminary injunction because the title *Top Gun* was descriptive and had a strong secondary meaning, a strong likelihood of confusion and plaintiff showed irreparable harm); see also *Eagle Snacks, Inc. v. Nabisco Brands, Inc.*, 625 F. Supp. 571 (D.N.J. 1985).

court may also require the court to balance these two requirements against the harm to the defendant if the plaintiff's motion is granted.<sup>195</sup> Thus, when American Dairy Queen Corporation brought a trademark suit seeking a preliminary injunction against the producer of a 1999 movie for the title *Dairy Queens*,<sup>196</sup> the court applied the four-part test: irreparable harm, balancing the interest, the probability of success on the merits, and the public interest.<sup>197</sup> The court granted Dairy Queen's preliminary injunction because: (1) irreparable harm was likely to result from the off-color humor and content contained in a movie with a similar name; (2) the harm caused by forcing the defendant to change his title was highly conjectural; (3) the plaintiff was likely to succeed on all claims; and (4) it was in the public interest to avoid consumer confusion.<sup>198</sup>

The courts do provide a means for movie producers to protect their title from unfair use without a full trial on the merits; however, even the most lenient of jurisdictions still require the movie producer to establish a "better than negligible chance of succeeding at trial."<sup>199</sup> Thus, courts have once again imposed a burden of proof on the movie producer plaintiff which the private law of the MPAA does not require. Perhaps these court imposed evidentiary burdens prompted studio giants within the MPAA to create their own law through private arbitration. Should any group, like the MPAA, be able to create its own private forum, thereby removing itself from the jurisdiction of the courts? To examine this question, it is helpful to evaluate the results of the MPAA's privatization of law.

## V. CONCLUSION

What has the MPAA done? It has created an arbitration procedure "by which disputes concerning titles recorded with its Title Arbitration Bureau may be quickly resolved."<sup>200</sup> Subscribers to the Bureau contractually agree to comply with such determinations, and the determinations are enforceable by the courts.<sup>201</sup> In effect, the MPAA has created its

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195. *Id.*

196. *Am. Dairy Queen Corp. v. New Line Prods., Inc.*, 35 F. Supp. 2d 727, 728 (D. Minn. 1998) (stating that *Dairy Queens* was a New Line production "mockumentary," satirizing beauty contests in dairy producing rural Minnesota).

197. *Id.* at 729.

198. *See generally id.*

199. *See McCarthy*, *supra* note 121, § 30:45, at 30-87 (citing *A.J. Canfield Co. v. Vess Beverages, Inc.*, 796 F.2d 903 (7th Cir. 1986)).

200. *See Lee*, *supra* note 36, at 21.

201. *See Telephone Interview with Mitchell Schwartz*, *supra* note 10.

own private law, but has this privatization of law served any beneficial purpose?

The Bureau director states that the function of the bureau is to resolve disputes quickly and efficiently between Subscribers, avoiding any confusion of the viewing public.<sup>202</sup> The Bureau has achieved quickness and efficiency. It inarguably settles disputes quicker than courts. If the MPAA's title registration process was not in place, the procedure for selecting a movie title would be even longer and more expensive than the current procedure.<sup>203</sup> Presently, if one wishes to avoid a potentially expensive lawsuit, it is crucial to ensure that a same or similar title is not in use before finalizing a title choice.<sup>204</sup> Outside of the Bureau, this is a painstaking process. One must contract with a professional search company, which can cost anywhere from \$400 and upward.<sup>205</sup> Although it is possible to search the USPTO over the Internet at [www.uspto.com](http://www.uspto.com), the search will not provide access to unregistered common law trademark uses such as movie titles.<sup>206</sup> Thus, one must still contract a professional search agency in order to receive a search report.<sup>207</sup> Subscribers to the Bureau, on the other hand, simply read the daily Title Registration Report that the Bureau distributes to inform Subscribers of the conflicting movie titles registered with the Bureau.<sup>208</sup>

To make the process more efficient, the Bureau explicitly states in its operating rules that its policy is either to negotiate directly or to arbitrate.<sup>209</sup> Because Subscribers to the Bureau settle over ninety-nine percent of their title conflicts through direct negotiation, the parties save invaluable time and money by avoiding arbitration.<sup>210</sup> Furthermore, even if the dispute reaches arbitration, the process is still swifter than litigating a case in court because the Bureau explicitly states that the arbitration hearing "shall be conducted informally and . . . no trial-type or extraordinary procedures shall be imposed . . ." <sup>211</sup> Moreover, it is likely that the MPAA panel, consisting of experts in the motion picture production field, may be more efficient than the courts at resolving these disputes because each case in the judicial forum requires educating the court as to the intricacies of the motion picture production field.

The MPAA has inarguably created a faster and more efficient pro-

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202. *Id.*

203. *See* Donovan, *supra* note 122, at 180-81.

204. *Id.*

205. *Id.*

206. *Id.*

207. *Id.*

208. *See* Title Committee Memorandum, *supra* note 11, at 2-6.

209. *Id.* at 8.

210. *See* Telephone Interview with Mitchell Schwartz, *supra* note 10.

211. *See* Title Committee Memorandum, *supra* note 11, at 8.

cess while effectively limiting public confusion. As previously discussed, the courts as well as the MPAA arbitration panels have the power to enjoin an offending party from using conflicting titles. The MPAA, however, has gone one step further. The Bureau's process almost assures that the public will never see conflicting titles in the marketplace<sup>212</sup> because the instant a Subscriber registers a complaint with the Bureau, there is an absolute bar from using the potentially conflicting title until an arbitration panel determines the respective rights of the parties.<sup>213</sup> This is proof of the Bureau's accomplishment of its foremost objective: preventing consumer confusion regarding the identity and origin of motion pictures.<sup>214</sup> Moreover, the Bureau seems to have accomplished its goal more efficiently and effectively than the courts.

Still, how balanced is the enforcement of rights under these two different forums? Critics of the MPAA claim that panel decisions infringe on Subscriber creativity and right to freedom of speech because studio executives/arbitrators place a high value on the protection of Subscriber intellectual property rights in already registered titles.<sup>215</sup> Perhaps this is a valid argument, as there appear to be conflicting policies between the two forums. Courts limit the protection a title receives in order to promote creativity and free speech, whereas the Bureau places a higher value on protecting Subscribers' intellectual property rights. Although the distinction appears to be theoretically reasonable, it fails in its application.

History demonstrates that the Bureau's private law has been enforced in a manner similar to judicial law.<sup>216</sup> Arbitration panels have promoted creativity and freedom of speech by allowing Sony to use both *Bram Stoker's Dracula* and *Marie Shelly's Frankenstein*, even though Universal Studios had registered the original titles of *Dracula* and *Frankenstein*.<sup>217</sup> Likewise, the panels allowed New Line's *Austin Powers—The Spy Who Shagged Me* to parody MGM's *The Spy Who Loved Me*.<sup>218</sup> Similarly, courts have promoted intellectual property rights by finding a likelihood of confusion between the original motion picture,

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212. See Lee, *supra* note 62 (discussing the harsh results that Miramax suffered due to public confusion created by the use of a conflicting title before the arbitration panel determined the parties' respective rights).

213. See Title Committee Memorandum, *supra* note 11, at 13; *supra* text accompanying note 97.

214. See Telephone Interview with Mitchell Schwartz, *supra* note 10.

215. See *supra* note 88.

216. See Telephone Interview with Mitchell Schwartz, *supra* note 10.

217. Goldstein, *supra* note 1.

218. See *Austin Powers 3* at MOVIES.COM-News, *supra* note 92 (stating the panel's recent decision objecting to New Line's use of *Goldmember* may have been based on New Line's procedural infractions in title registration).



*Bridge on the River Kwai*, and the subsequent motion picture, *Return from the River Kwai*,<sup>219</sup> and by finding secondary meaning in the film title *The Wonderful Life of the Brother's Grimm*, even though the film itself was incomplete at the time.<sup>220</sup> Moreover, different forums within the judicial system itself weigh some equities more heavily than others. Still, there is no bright-line policy separating the two forums' respective line of decisions.

In sum, the MPAA has privatized public law, and has effectively done so for over seventy-five years. Its process allows motion picture studios to contract out of the judicial system by signing arbitration agreements, while creating an efficient arbitration process that applies a set of rules consistent with trademark law. The MPAA arbitration process is the paradigmatic example of privatization of law. It defies the old maxim, "don't take the law into your own hands." For over seventy-five years the MPAA has taken the law into its own hands, and has come out a winner.

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219. See *Tri-Star Pictures, Inc. v. Unger*, 14 F. Supp. 2d 339 (S.D.N.Y. 1998).

220. See *Metro-Goldwyn-Mayer, Inc. v. Lee*, 27 Cal. Rptr. 833 (Cal. App. 2d 1963).

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