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Developments in the Law: Title Protection

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DEVELOPMENTS IN THE LAW:

TITLE PROTECTION

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PART I: TITLE PROTECTION AND USE IN THE MOTION PICTURE
AND TELEVISION INDUSTRIES—THE NATURE OF THE
PROBLEM

I. INTRODUCTION

If an entertainment producer wants a specific title for his production, and wants to avoid a lawsuit over that title, an awareness of the melange of statutory and common law which can loosely be referred to as "title law" is essential. Title law attempts to balance the legitimate interests of those who claim some sort of exclusive rights to a literary title or name against the equally legitimate needs of those who must have titles and names for their works and products. The pool of potential plaintiffs includes authors of books, periodicals, television series, newspapers, plays, and musical recordings. Also included are those in the commercial arena who name products or invent advertising slogans for their products. Understanding how titles acquire protected status may help producers and others involved in naming entertainment productions to avoid litigation.

II. SOURCES OF LAW APPLICABLE TO TITLE PROTECTION AND USE

No single body of law exists which an author or owner of a "single literary title" can look to for title protection. The term "single literary title" refers to the title of a one-time, non-serial work, as opposed to a television series or a periodical publication.¹ Copyright law is available for titles of series works² and gives an author of a work the exclusive privilege to the publication, production, or sale of that literary, musical or artistic work for certain express periods of time.³ Copyright law is not available for single literary titles. Although regulations promulgated by the Copyright Office clearly state that "words and short phrases such as names, titles, and slogans" are not subject to federal copyright protection,⁴ there does not appear to be any statutory or constitutional reason for the prohibition.⁵ Reinforcing these regulations, American courts have uniformly held that the title of a single literary work cannot be

1. Perry, *Protecting Literary Titles*, 12 NEW MATTER 1 (1987) [hereinafter Perry]. The title of a book which is not a single, one-shot work, but is the title of a book series, such as "*The Hardy Boys*," would not be considered a "single literary title."

2. 37 C.F.R. § 202.1(a) (1989); Copyright Office Regulation 202.1(a) (1989); *Trademark Manual of Examining Procedure*, §§ 1301.09, 1301.10.

3. BLACK'S LAW DICTIONARY 304 (5th ed. 1979).

4. 37 C.F.R. § 202.1(a) (1989).

5. 1 J. T. MCCARTHY, TRADEMARKS AND UNFAIR COMPETITION § 10:9, at 352 (2d ed. 1984) [hereinafter MCCARTHY].

protected by either statutory copyright law,⁶ or state common law copyright.⁷

Subject to certain conditions, however, protection against unauthorized use of an author's title can be obtained under different forms of the common law doctrine of unfair competition.⁸ At the federal level, this protection is embodied in the federal trademark statute known as the Lanham Act;⁹ at the state level, the protection takes the form of common law unfair competition doctrines and anti-dilution statutes.

An examination of the case law discloses that a majority of title infringement cases are tried in either California or New York, the entertainment capitals of the United States.¹⁰ Additionally, an analysis of decisions in California and New York discloses a dichotomy in the attitudes toward the legal protection currently available for literary titles.¹¹ This article focuses on the current state of the law, distinctions between jurisdictions, and causes of action available in California, New York and their corresponding federal circuits.

A. *State Unfair Competition Law*

The foundation of title protection law is the theory of unfair competition. The unfair competition action began as an English common law doctrine developed by the English Courts of Merchant in the early 1700's.¹² The doctrine sought to correct acts of unfairness, dishonesty, misrepresentation, and passing or palming off¹³ (the use of another's reputation to sell one's own goods).¹⁴ Today, the unfair competition action consists of two theories upon which relief may be granted—passing off and misappropriation.

Passing off is defined as "making a false representation to a third party which is likely to induce that person to believe the defendant's

6. MCCARTHY, *supra* note 5, § 10:10, at 352; Angel, *Legal Protection for Titles in the Entertainment Industry*, 52 SO. CAL. L. REV. 279, 307 n.153 (1979) [hereinafter Angel] ("Cases since 1909 have been unanimous in their denial of statutory copyright protection for titles.").

7. Angel, *supra* note 6, at 308 & n.157.

8. Anthony & Finkelstein, *Protecting Against Unauthorized Use of Song Titles As Motion Picture Titles*, 82 PAT. & TRADEMARK REV. 145 (1984) [hereinafter Anthony & Finkelstein].

9. 15 U.S.C. §§ 1051, 1053-72, 1091-96, 1111-21, 1123-27 (1989).

10. Angel, *supra* note 6, at 301.

11. *Id.*

12. See Burdick, *General Survey, V 3 Select Essays in Anglo-American Law (1909); Reports of the Court of Common Pleas of England 1622-1625* at 24.

13. Angel, *supra* note 6, at 280.

14. *Id.*

products are those of the plaintiff."¹⁵ Generally, to receive protection under the passing off theory, the plaintiff or injured party must establish three elements. First, the plaintiff must establish that secondary meaning exists.¹⁶ Secondary meaning refers to the "association formed in the mind of the consumer which links an individual product with its manufacturer or distributor."¹⁷ Regarding literary titles, secondary meaning will be found where, "in the minds of a significant number of people, the title in question is associated with a single source of the literary work."¹⁸ Second, the plaintiff must establish that the defendant used the plaintiff's title for the defendant's own work in a way that was meant to confuse the public into thinking that the defendant's work and the plaintiff's work were somehow related. Finally, the plaintiff must show that because of this confusion, the plaintiff has been damaged.¹⁹

The other unfair competition cause of action, misappropriation, is defined as the "taking and use of another's property for the sole purpose of capitalizing unfairly on the good will²⁰ and reputation of the property owner."²¹ Protection under the misappropriation theory is generally found where (1) there has been a substantial investment of time, effort and money made by the plaintiff in the thing created such that the court can characterize that "thing" as a type of property right; (2) the defendant appropriated the "thing" at little or no cost; and (3) the plaintiff is thereby injured.²²

Although the courts often confuse and interchange the passing off and misappropriation doctrines, they are different. The passing off theory is specifically directed at preventing confusion as to the source of the goods,²³ while the misappropriation doctrine attempts to protect a more

15. *Smith v. Montero*, 648 F.2d 602, 604 (9th Cir. 1981).

16. For an in-depth discussion of secondary meaning, see *infra* notes 149-342 and accompanying text.

17. *J. Josephson, Inc. v. General Tire & Rubber Co.*, 357 F. Supp. 1047, 1048 (S.D.N.Y. 1972).

18. MCCARTHY, *supra* note 5, § 10:4, at 332; *but see infra* notes 64-93 for a discussion of New York unfair competition law where secondary meaning is not a prerequisite. For an in-depth discussion of secondary meaning, see *infra* notes 149-342 and accompanying text.

19. *Curtis v. Twentieth Century-Fox Film Corp.*, 140 Cal. App. 2d 461, 468, 295 P.2d 62, 67 (1956).

20. The term "good will" has been defined as "[t]he favorable consideration shown by the purchasing public to goods known to emanate from a particular source." *White Tower Sys. v. White Castle Sys. of Eating Houses Corp.*, 90 F.2d 67, 69 (6th Cir. 1937), *cert. denied*, 302 U.S. 720 (1937).

21. *Pocket Books, Inc. v. Dell Publishing Co.*, 49 Misc. 2d 252, 256, 267 N.Y.S.2d 269, 272 (1966).

22. MCCARTHY, *supra* note 5, § 10:25, at 396.

23. *Id.*

general "quasi-property right."²⁴ Because of this difference, the misappropriation doctrine generally embraces a wider scope of equitable wrongs than the passing off theory.²⁵ Therefore, a court could find that there has been no passing off where the parties involved are not in close competition, and yet the misappropriation doctrine may be applicable because the defendant has traded on the good will of the plaintiff in adopting the title or tradename of plaintiff's literary work for a non-competing market.²⁶

While most courts allow an injured plaintiff some sort of relief under the passing off theory,²⁷ the misappropriation doctrine has not been uniformly adopted by the courts.²⁸ This is due, in large part, to the Supreme Court decisions in *Sears Roebuck & Co. v. Stiffel Co.*²⁹ and *Compco Corp. v. Day Brite Lighting*,³⁰ often referred to as the *Sears-Compco* cases. In this pair of cases, the United States Supreme Court held that a state could not, through its unfair competition laws, prohibit the copying of an article that failed to qualify for protection under federal patent and copyright statutes, even though that article might have acquired a secondary meaning.³¹

While the Court's rulings clearly prohibit states from protecting articles that were already covered by patent and copyright law, many courts, including those in California,³² interpreted the *Sears-Compco* decisions to mean that state protection for titles had been preempted. These state courts relied in large part on the Court's statement:

[W]hen an article is unprotected by a patent or a copyright, state law may not forbid others to copy that article. To forbid copying would interfere with the federal policy, found in art. I, section 8, cl. 8, of the Constitution and in the implementing federal statutes, of allowing free access to copy whatever the federal patent and copyright laws leave in the public domain.³³

The Supreme Court later clarified the reach of the *Sears-Compco* decisions in *Goldstein v. California*.³⁴ In that case, Goldstein and other

24. *International News Service v. Associated Press*, 248 U.S. 215, 242 (1918).

25. MCCARTHY, *supra* note 5, § 10:26, at 398.

26. Angel, *supra* note 6, at 302-03.

27. See *infra* notes 43-49 and accompanying text.

28. MCCARTHY, *supra* note 5, § 10:26, at 398.

29. 376 U.S. 225, *reh'g denied*, 376 U.S. 973 (1964).

30. 376 U.S. 234, *reh'g denied*, 377 U.S. 913 (1964).

31. Angel, *supra* note 6, at 282.

32. See *infra* notes 43-49 and accompanying text.

33. *Compco*, 376 U.S. at 237.

34. 412 U.S. 546 (1972), *reh'g denied*, 414 U.S. 883 (1973).

appellants were convicted of ten counts of record piracy under section 653h of the California Penal Code.³⁵ The appellants allegedly bought commercially produced recordings of major musical artists and, without any authorization or license, reproduced those recordings on blank tapes.³⁶ The tapes were labelled with information identical to that of the original recordings and distributed to retail outlets for sale to the public.³⁷ On appeal, appellants argued that the California penal statute conflicted with the *Sears-Compco* holdings—that since the musical recordings were not protected under the federal copyright law, Congress intended to allow them to be copied. Rejecting the appellants' argument, the Supreme Court held that the states share with Congress the power to grant copyright protection, and that *Sears-Compco* was not a federal preemption of state protection for categories of writings where no protection is granted under federal statutory copyright.³⁸ Thus, *Goldstein* stands for the proposition that the states can utilize common law remedies and the *Sears-Compco* doctrine is restricted to works protected under federal patent and copyright laws.

Section 301(b) of the Copyright Revision Act of 1976,³⁹ adopted three years after *Goldstein*, reinforces *Goldstein* by specifically allowing states to utilize common law remedies,⁴⁰ such as passing off and misappropriation. That section provides that “[n]othing in this title annuls or limits any rights or remedies under the common law or statutes of any state with respect to . . . activities violating legal or equitable rights that are not equivalent to any of the exclusive rights within the general scope of copyright as specified by section 106.”⁴¹ While unfair competition law is therefore a viable means of protection, the amount of legal protection currently available to literary titles differs greatly depending upon the jurisdiction in which the plaintiff pleads his case.⁴²

35. *Id.* at 549.

36. *Id.*

37. *Id.* at 550.

38. *Id.* at 558.

39. 17 U.S.C. §§ 101-914 (1989).

40. 17 U.S.C. § 301(b) (1989).

41. 17 U.S.C. § 301(b)(3) (1989).

42. During the legislation process, misappropriation was specifically named in the Senate version of § 301(b)(3) as a right not subject to federal preemption. It was later deleted, however, at the Department of Justice's behest and this has been construed by some states as a prohibition by Congress to allow state protection. "A reading of the legislative hearings on misappropriation, however, would tend to negate any presumption one way or the other." Angel, *supra* note 6, at 283. For a detailed summary of these hearings see MCCARTHY, *supra* note 5, § 10:30, at 411-16.

1. California

While many jurisdictions embrace the misappropriation doctrine, California does not.⁴³ In California, therefore, an unfair competition action must be based on the passing off theory.⁴⁴ California courts, both before and after the *Goldstein* decision,⁴⁵ hold that "the misappropriation theory of state protection . . . retains no vitality."⁴⁶ As the court explained in *Allied Artists Pictures Corp. v. Friedman*,⁴⁷ "the state's power to protect literary titles, which are not afforded protection by federal copyright laws, cannot be based on any theory of appropriation of a property right."⁴⁸ The court further explained that an action must be based on the passing off theory of unfair competition because "[a] title of a literary product is, like a label on other types of products, simply a means of identifying a product."⁴⁹

In California, protection under the passing off theory will be granted only upon a showing of secondary meaning,⁵⁰ likelihood of confusion,⁵¹ and injury.⁵² The key to the passing off cause of action is the title's attaining a secondary meaning in the mind of the public.⁵³ The plaintiff's establishment of secondary meaning in his title is "a sine qua non of protection of titles on a theory of unfair competition."⁵⁴

For example, in *Allied*, the plaintiff, Allied Artists, acquired United States distribution rights to the French film *Histoire d'O*.⁵⁵ The film was based on the well-known erotic French novel of the same name.⁵⁶ When Friedman used the title "The Journey of O" for a film, Allied Artists brought an unfair competition action claiming that its title, "The Story of

43. Angel, *supra* note 6, at 281, n.8.

44. *Id.*

45. *Tomlin v. Walt Disney Prods.*, 18 Cal. App. 3d 226, 96 Cal. Rptr. 118 (1971), was decided before *Goldstein*, while *Allied Artists Pictures Corp. v. Friedman*, 68 Cal. App. 3d 127, 137 Cal. Rptr. 94 (1977), and *Lutz v. De Laurentiis*, 211 Cal. App. 3d 1317, 260 Cal. Rptr. 106 (1989), were decided after *Goldstein*.

46. *Tomlin*, 18 Cal. App. 3d at 234, 96 Cal. Rptr. at 122.

47. 68 Cal. App. 3d 127, 137 Cal. Rptr. 94 (1977).

48. *Id.* at 133, 137 Cal. Rptr. at 97.

49. *Id.*

50. *Tomlin*, 18 Cal. App. 3d at 230, 96 Cal. Rptr. at 120.

51. *Id.* at 235, 96 Cal. Rptr. at 123.

52. *Id.*

53. *Anthony & Finkelstein*, *supra* note 8, at 146. The term "public," "does not mean all the people, nor most of the people, nor very many of the people of a place, but so many as contradistinguishes them from a few." *Mary Pickford Co. v. Bayly Bros.*, 12 Cal. 2d 501, 514, 86 P.2d 102, 108 (1939).

54. *Gordon v. Warner Bros. Pictures, Inc.*, 269 Cal. App. 2d 31, 35, 74 Cal. Rptr. 499, 501-02 (1969).

55. Anglicization: "The Story of O."

56. *Allied*, 68 Cal. App. 3d at 131, 137 Cal. Rptr. at 96.

O," had acquired the requisite secondary meaning through the distribution of the book "Histoire d'O" in the United States.⁵⁷ The California Court of Appeal held that Allied's title, "The Story of O" had indeed acquired secondary meaning in the United States with respect to the book and with "that element of the United States society that reads such material associated with the title 'The Story of O' with the English translation of 'Histoire d'O.'"⁵⁸

California's reluctance to grant common law protection to single literary titles is evident in the remedy fashioned by the California Court of Appeal in *Allied Artists*. Typically, courts grant an injunction prohibiting the use of any title which unfairly competes with a plaintiff's title. The *Allied Artists* court, however, felt constrained by precedent to limit its remedy to requiring the defendant to take reasonable steps to dispel the likelihood of confusion by including disclaimers in its national advertising, stating that "[t]he available protection in the area of titles is 'limited, however, to a narrowly drawn injunction requiring appropriate precautions to prevent public confusion'"⁵⁹ The *Allied Artists* decision severely restricts the passing off theory in California.⁶⁰ Thus, a plaintiff who can demonstrate that another court—state or federal—has jurisdiction to hear his unfair competition claim may be well advised to pursue that other venue. The reason for filing elsewhere is that, while the causes of action available to a plaintiff in California are so few (one), the burden of proof so demanding (secondary meaning a prerequisite), and the remedy so narrow (implementation of a disclaimer), other jurisdictions, such as New York, provide a plaintiff with a variety of theories upon which to base his unfair competition claim.

2. New York

In New York, literary titles can be protected against unfair competition under both the passing off and misappropriation theories,⁶¹ as well as a dilution theory.⁶² The addition of the misappropriation cause of action allows a plaintiff to protect his title in cases where the defendant is trading on the plaintiff's good will by adopting the title of plaintiff's literary work, but the use occurs in a non-competing market, rendering the

57. *Id.* at 132, 137 Cal. Rptr. at 96-97.

58. *Id.* at 136, 137 Cal. Rptr. at 99.

59. *Id.* (quoting *Tomlin v. Walt Disney Prods.*, 18 Cal. App. 3d at 226, 235, 96 Cal. Rptr. 118, 123 (1971)).

60. Angel, *supra* note 6, at 304.

61. *Id.* at 281, n.8.

62. *Id.* at 305-06.

passing off action unavailable.⁶³

The most notable difference between California and New York in unfair competition cases is that California requires that the plaintiff establish secondary meaning in order to gain title protection,⁶⁴ while in New York a plaintiff is not required to do so.⁶⁵ This is not to say, however, that proof of secondary meaning is not important in an unfair competition cause of action in New York. In many unfair competition cases, the establishment of secondary meaning plays a major role in a court's determination that passing off exists.⁶⁶ However, where a plaintiff can establish that the defendant acted in a manner that seeks to exploit or injure the plaintiff, the secondary meaning element of an unfair competition claim is not required.⁶⁷

As the court stated in *J. Josephson, Inc. v. General Tire & Rubber Co.*,⁶⁸ "[a]bsent secondary meaning, [the] plaintiff may prove that [the] defendant was engaged in one of a number of predatory practices which, per se, amount to unfair competition. These include palming off, actual deception, appropriation of plaintiff's property, and interference with plaintiff's contractual rights."⁶⁹ This difference appears to allow a plaintiff to point to the defendant's actions and, if found to rise to the level of "predatory practices," the court will not require the plaintiff to undergo the more arduous task of proving secondary meaning.⁷⁰

A third theory for relief available in New York is an anti-dilution cause of action codified as General Business Law section 368-d.⁷¹ The

63. *Id.* at 305.

64. *Id.* at 302.

65. *National Lampoon, Inc. v. American Broadcasting Cos., Inc.*, 376 F. Supp. 733, 747 (S.D.N.Y.), *aff'd*, 497 F.2d 1343 (2d Cir. 1974).

66. Angel, *supra* note 6, at 302.

67. *J. Josephson, Inc. v. General Tire & Rubber Co.*, 357 F. Supp. 1047, 1048 (S.D.N.Y. 1972).

68. 357 F. Supp. 1047 (S.D.N.Y. 1972).

69. *Id.* at 1048; *Norwich Pharmacal Co. v. Sterling Drug, Inc.*, 271 F.2d 569 (2d Cir. 1959), *cert. denied*, 362 U.S. 919 (1960).

70. For a discussion of how secondary meaning may be proven, see *infra* notes 152-154 and accompanying text.

71. § 368-d states:

Likelihood of injury to business reputation or of dilution of the distinctive quality of a mark or trade name shall be a ground for injunctive relief in cases of infringement of a mark registered or not registered or in cases of unfair competition, notwithstanding the absence of competition between the parties or the absence of confusion as to the source of goods or services.

While California has an anti-dilution statute which is almost identical to New York's § 368-d (California Business and Professions Code § 14330), it has yet to be applied by California state courts as a cause of action for literary title cases. THE UNITED STATES TRADEMARK ASSOC., STATE TRADEMARK AND UNFAIR COMPETITION LAW, § B.10, at CA-5 (1989).

concept of dilution is:

most applicable where [a] subsequent user use[s] the trademark of [a] prior user for a product so dissimilar from the product of the prior user and there is no likelihood of confusion of the products or sources, but where the use of the trademark by the subsequent user will lessen [the] uniqueness of the prior user's mark with the possible future result that a strong mark may become a weak mark.⁷²

The gravamen of the dilution cause of action is that a defendant's continual use of a mark similar to the plaintiff's title will "inexorably have an adverse effect upon the value of the plaintiff's mark, and that, if he is powerless to prevent such use, the plaintiff's mark will eventually be deprived of all distinctiveness."⁷³

In applying the anti-dilution statute to literary cases, New York courts hold that to plead a successful cause of action under section 368-d, the plaintiff must prove: (1) notice to defendants that there will be dilution of the mark or title that will have a detrimental effect;⁷⁴ (2) that the name or title to be protected possesses a distinctive quality or has acquired secondary meaning;⁷⁵ and (3) that the name or title is capable of dilution.⁷⁶ A dilution statute is not meant to replace the common law of unfair competition,⁷⁷ but instead should be seen as a supplement to common law rights.⁷⁸

The dilution cause of action is distinguishable from the passing off cause of action in that the injuries sustained under each differ.⁷⁹ The injury suffered by a plaintiff in a situation involving passing off is a fairly immediate loss of sales due to diversion of patronage from the plaintiff to the defendant,⁸⁰ whereas "dilution is a cancer which, if allowed to spread, will slowly but inevitably destroy the advertising value of the mark."⁸¹ On the other hand, the dilution and misappropriation causes of

72. *Holiday Inns, Inc. v. Holiday Out in America*, C.A. Fla., 481 F.2d 445, 450 (5th Cir. 1973).

73. *King Research, Inc. v. Shulton, Inc.*, 324 F. Supp. 631, 638 (S.D.N.Y. 1971).

74. *Angel*, *supra* note 6, at 306.

75. *Allied Maintenance Corp. v. Allied Mechanical Trades, Inc.*, 42 N.Y.2d 538, 545, 399 N.Y.S.2d 628, 632, 369 N.E.2d 1162, 1166 (1977).

76. *Id.*

77. R. CALLMANN, *UNFAIR COMPETITION AND TRADE-MARKS*, § 84.2, at 1646 (2d ed. 1950) [hereinafter *CALLMAN*].

78. *Massachusetts Mut. Life Ins. Co. v. Massachusetts Life Ins. Co.*, 351 Mass. 283, 218 N.E.2d 564 (Sup. Jud. Ct. 1966).

79. *CALLMANN*, *supra* note 77, § 84.2, at 1643.

80. *Id.*

81. *Id.* (citing *Polaroid Corp. v. Polaroid, Inc.*, 319 F.2d 830 (7th Cir. 1963)).

action may be seen as mutually dependent. A showing of dilution will facilitate the establishment of a misappropriation cause of action by fulfilling the injury requirement.⁸² At the same time, establishment of misappropriation will bolster the plaintiff's argument that his title has thereby been diluted.

In *National Lampoon, Inc. v. American Broadcasting Cos.*,⁸³ the plaintiff, National Lampoon, utilized passing off, the misappropriation doctrine, and dilution theories, as well as section 43(a) of the Lanham Act⁸⁴ to prevent its namesake from being used by American Broadcasting Companies ("ABC") for its own television series.⁸⁵ ABC entered into negotiations with National Lampoon to determine whether National Lampoon's particularly virulent brand of humor could be converted into a television series.⁸⁶ Without reaching an agreement with the plaintiffs, ABC decided to develop its own program to be entitled "Lampoon" or "ABC Lampoon" using the same type of humor for which National Lampoon was known.⁸⁷ National Lampoon sued to enjoin ABC's use of such title claiming that the National Lampoon name would be harmed by ABC's use.⁸⁸ The district court found evidence that National Lampoon was entitled to relief under state unfair competition theories, dilution of trademark, and section 43(a) of the Lanham Act.⁸⁹

Addressing the issue of secondary meaning, the court stated that while there was strong evidence of secondary meaning,⁹⁰ the law of unfair competition no longer required that plaintiff's item acquire a secondary meaning.⁹¹ Instead, the court found that under New York case law, the likelihood of damage through dilution of a mark was enough.⁹²

The district court's holding in *National Lampoon* appears to mean that, while a plaintiff must still prove that he possesses a distinctive mark, he need only prove likelihood of dilution to receive title protection,

82. See *supra* notes 20-22 and accompanying text for a discussion of the elements of a misappropriation cause of action.

83. 376 F. Supp. 733 (S.D.N.Y.), *aff'd*, 497 F.2d 1343 (2d Cir. 1974).

84. *Id.* at 746-47. See *infra* notes 113-18 and accompanying text for discussion of the § 43(a) claim in *National Lampoon*.

85. *National Lampoon*, 376 F. Supp. at 736.

86. *Id.* at 740-42.

87. *Id.* at 744.

88. *Id.* at 736.

89. *Id.* at 746-47. See *infra* notes 113-18 and accompanying text for discussion of the § 43(a) claim in *National Lampoon*.

90. *National Lampoon*, 376 F. Supp. at 747.

91. *Id.* (citing *Santa's Workshop, Inc. v. Sterling*, 282 App. Div. 328, 329-30, 122 N.Y.S.2d 488, 489 (1953)).

92. *Id.* at 747 (citing *Renofab Process Corp. v. Renotex Corp.*, 158 N.Y.S.2d 70, 77 (1956)).

and need not prove that his mark has already established a secondary meaning.⁹³ All in all, the New York courts' acceptance of all three unfair competition theories, as well as their move away from the secondary meaning standard, affords plaintiffs a better opportunity to protect their literary titles than that accorded plaintiffs in California. Regardless of whether a state's unfair competition laws are favorable, a plaintiff may still have the option of pleading his action in federal court.

B. Federal Protection

Literary titles are protected by the federal trademark law known as the Lanham Act⁹⁴ ("the Act"). Titles of serial works, such as radio and television programs, which are protected under copyright law, are also protected under section 45 of the Lanham Act.⁹⁵ Single literary titles, which do not fall under the provisions of section 45 and do not receive copyright protection, can be protected by applying section 43(a) of the Act. "Construed broadly, this statute may be found to incorporate both the misappropriation and misrepresentation [passing off] aspects of the unfair competition claims"⁹⁶ Section 43(a) grants a cause of action to persons engaged in interstate commerce to protect themselves against the misleading or deceptive use of common law trademarks and the similar misuse of such words, names, or symbols used by a competitor to identify his goods or services.⁹⁷ Section 43(a) reads:

Any person who shall affix, apply, or annex, or use in connection with any goods or services, or any container or containers for goods, *a false designation of origin, or any false description or representation, including words or other symbols tending falsely to describe or represent the same*, and shall cause such goods or services to enter into commerce, and any person who shall with knowledge of the falsity of such designation of origin or description or representation cause or procure the same to be transported or used in commerce or deliver the same to any

93. While there is a line of federal cases which hold that likelihood of confusion must be shown, they have been overruled. *THE UNITED STATES TRADEMARK ASSOC., STATE TRADEMARK AND UNFAIR COMPETITION LAW*, § N.Y.4, at B-5 (1989); *Sally Gee, Inc. v. Myra Hogan, Inc.*, 699 F.2d 621, 624 (2d Cir. 1983).

94. 15 U.S.C. §§ 1051, 1053-72, 1091-96, 1111-21, 1123-27 (1989).

95. "Titles, character names and other distinctive features of radio or television programs may be registered as service marks notwithstanding that they, or the programs, may advertise the goods of the sponsor." Lanham Act § 45, 15 U.S.C. § 1127 (Supp. 1989).

96. *Ideal Toy Corp. v. Kenner Prods. Division of General Mills Fun Group, Inc.*, 443 F. Supp. 291, 309 (S.D.N.Y. 1977).

97. *Federal-Mogul-Bower Bearings, Inc. v. Azoff*, 313 F.2d 405, 409 (6th Cir. 1963).

carrier to be transported or used, shall be liable to a civil action by any person doing business in the locality falsely indicated as that of origin or in the region in which said locality is situated, or by any person who believes that he is or is likely to be damaged by the use of any such false description or representation.⁹⁸

To obtain an injunction, prohibiting use of a title under the Lanham Act, three general requirements must be proven: (1) the goods or services are involved in interstate commerce; (2) the defendant has misrepresented his or her product;⁹⁹ and (3) this misrepresentation is likely to cause public confusion.¹⁰⁰ In order to obtain damages, however, it is necessary that the plaintiff prove actual confusion.¹⁰¹ If the plaintiff can show that the defendant deliberately misappropriated the plaintiff's title or mark, the courts will infer that the public confusion requirement of this cause of action has been satisfied.¹⁰²

1. Ninth Circuit/California

All three requirements must be met in order to state a cause of action under section 43(a).¹⁰³ However, some district courts, including those in California, have held the misrepresentation requirement to mean that the plaintiff must prove passing off.¹⁰⁴ Since California requires a showing of secondary meaning in order to successfully plead a cause of action in passing off, a plaintiff seeking title protection under section 43(a) in a California district court has a more difficult task than his New York counterpart because the New York state law does not require a showing of secondary meaning in order to prove an unfair competition claim.¹⁰⁵ This was made clear in *Chamberlain v. Columbia Pictures Corp.*¹⁰⁶

In *Chamberlain*, the trustees of the estate of Samuel Clemens (better known as Mark Twain), brought an unfair competition suit against Columbia Pictures for releasing its motion picture entitled *Best Man Wins*.

98. Lanham Trademark Act § 43(a), 15 U.S.C. § 1125(a) (1989) (emphasis added).

99. Misrepresentation need not be intentional. *Parkway Baking Co., Inc. v. Freihofer Baking Co.*, 255 F.2d 641, 648 (3d Cir. 1968).

100. *Anthony & Finkelstein*, *supra* note 8, at 153.

101. *Hesmer Foods, Inc. v. Campbell Soup Co.*, 346 F.2d 356, 359 (7th Cir.), *cert. denied*, 382 U.S. 839 (1965). For discussion of damages, see *infra* notes 636-70 and accompanying text.

102. *Hesmer Foods*, 346 F.2d at 359.

103. For full text of § 43(a), see *supra* note 98 and accompanying text.

104. *Chamberlain v. Columbia Pictures Corp.*, 186 F.2d 923 (9th Cir. 1951).

105. See *supra* notes 65-70 and accompanying text.

106. 186 F.2d 923 (9th Cir. 1951).

Best Man Wins was loosely based on Mark Twain's "The Celebrated Jumping Frog of Calaveras County." Although the plaintiffs did not own the copyright to "The Celebrated Jumping Frog of Calaveras County"—the work having entered the public domain¹⁰⁷—they claimed unfair competition and violation of the estate's trademark rights.¹⁰⁸ Plaintiffs alleged that the defendants advertised *Best Man Wins* in such a way as to give the impression that Samuel Clemens was the author of the story.¹⁰⁹ The advertisements included such statements as "Mark Twain's Favorite Story," "A Story Only Mark Twain Could Tell," and "Mark Twain's Tale of a Gamble in Hearts."¹¹⁰ The Ninth Circuit Court of Appeals held that while the plaintiffs' allegations "fit snugly into the provisions of [section 43(a)],"¹¹¹ the court did not think they were sufficient to sustain a cause of action under the Lanham Act:

[W]e do not think said section [43(a)] changes the fundamental requirements necessary to sustain a suit for unfair competition, *one such requirement being* a direct injury to the property rights of a complainant by *passing off* the particular goods or services misrepresented as those of the complainant. Deceiving the public by fraudulent means, while an important factor in such a suit, does not give the right of action unless it results in the sale of the goods as those of the complainant.¹¹²

2. Second Circuit/New York

In *National Lampoon, Inc. v. American Broadcasting Cos.*,¹¹³ the plaintiffs were successful, under section 43(a), in preventing the defendant's use of their namesake. The court stated that a cause of action arises under section 43(a) when a name or trademark is used in interstate commerce in such a way that it is likely to cause confusion or deceive purchasers as to the source of origin.¹¹⁴ Because *National Lampoon's* magazine and ABC's television program were in completely different media fields, the court addressed the issue of whether *National Lampoon*

107. While anyone has the right to use a title that has entered the public domain, that title may not be used to deceive the public so that if a work has acquired a secondary meaning, a court may require subsequent users to distinguish their particular versions. See, *G. & C. Merriam Co. v. Syndicate Publishing Co.*, 237 U.S. 618, 622-23 (1914).

108. *Chamberlain*, 186 F.2d at 923-24.

109. *Id.*

110. *Id.* at 924.

111. *Id.* at 925.

112. *Id.* (emphasis added).

113. 376 F. Supp. 733 (S.D.N.Y.), *aff'd*, 497 F.2d 1343 (2d Cir. 1974).

114. *Id.* at 746 (citing *Geisel v. Poynter Prods. Inc.*, 283 F. Supp. 261, 266-68 (S.D.N.Y. 1968)).

had standing to sue. The contention was that because the titles were to be used in different media fields, National Lampoon would not be damaged by the defendant's use of the term "Lampoon."¹¹⁵ The district court declared:

Standing to sue exists in anyone who "is or is likely to be damaged" by the defendant's use of the disputed mark, and the parties need not be direct competitors.

Although plaintiff has not yet produced a television program for national broadcast, it has begun production of programs for closed-circuit television and is negotiating for production of a special program which it hopes to sell to one of the large networks. Network television is within the plaintiff's area of natural expansion; it is now making efforts to expand into that area. As we have already pointed out, broadcast of defendants' program will effectively cut off such expansion.¹¹⁶

The District Court for the Southern District of New York found that two programs with similar names would indeed cause confusion and therefore injury.¹¹⁷ The court concluded that ABC's conduct showed a deliberate intent to trade upon the reputation and national acceptance built up by National Lampoon and to pass off "Lampoon" or "ABC Lampoon" as a National Lampoon product.¹¹⁸

While section 43(a) provides plaintiffs with the advantages of an alternative forum and an additional cause of action in jurisdictions such as New York, the benefits to a plaintiff in a California federal court appear to be more imaginary than real. By equating the likelihood of confusion requirement¹¹⁹ in section 43(a) with establishment of secondary meaning, there is little reason—except maybe a shorter docket backlog—to seek protection in California federal court as opposed to California state court. Practically, the section 43(a) alternative is no alternative at all. As long as California federal courts require plaintiffs to prove secondary meaning, section 43(a) will be little more than a federal version of California's passing off law and the impetus to forum shop will remain.

III. MOTION PICTURE ASSOCIATION OF AMERICA

With title protection playing such an important role in the econom-

115. *National Lampoon*, 376 F. Supp. at 746.

116. *Id.*

117. *Id.*

118. *Id.*

119. See *supra* notes 98-102 and accompanying text for discussion of the elements of a § 43(a) cause of action.

ics of the film industry, the Motion Picture Association of America ("MPAA") has attempted to accomplish through self-help a degree of protection for titles not available from the law.¹²⁰ The MPAA operates a Title Registration Bureau through which more than five thousand titles are registered per year.¹²¹ The members of the MPAA, which include "those individuals or companies engaged in the production or distribution of theatrical motion pictures for release in the United States[,] . . ." ¹²² contractually agree to "register the title of each and every one of their United States theatrical motion pictures with the Title Registration Bureau."¹²³ These registration regulations state that the first member "to submit a particular title shall be given the priority registration position by the Title Registration Bureau."¹²⁴ Registration gives that member prior rights to the title for a certain period of time.¹²⁵ Besides facilitating the policing of previously registered titles, the Title Registration Bureau also handles title "conflicts" that may arise among its members.

The MPAA defines a title "conflict" as "the harmful similarity of titles which may cause public confusion as to the identity or origin of a theatrical motion picture."¹²⁶ Once a member complains that a conflict exists, the protested title cannot be used by the would-be registrant until usage rights are determined.¹²⁷ Determination of usage rights may be resolved either by direct negotiations between the two members or, should that fail, through arbitration.¹²⁸

To prove that a "conflict" exists, the protesting member must show (1) similarity of titles and (2) likelihood of harm.¹²⁹ If the arbitration board, which consists of three disinterested members of the Title Registration Bureau's Title Committee, finds that a harmful similarity exists, that title becomes unavailable for use by the would-be registrant.¹³⁰ The Title Committee's finding, subject to the right of appeal,¹³¹ is binding on

120. *Netterville & Hirsch, Privacy and Privilege in Literary Titles*, 32 *SO. CAL. L. REV.* 101, 104 (1959).

121. *MCCARTHY*, *supra* note 5, § 10:13, at 359.

122. Article I, § (a) of the April 1, 1986, Memorandum of the Title Committee of the Motion Picture Association of America, Inc. [hereinafter the MPAA Memorandum].

123. Article II, § (a) of the MPAA Memorandum.

124. Article II, § (b) of the MPAA Memorandum.

125. Article II, § (b) of the MPAA Memorandum.

126. Article III, § (a) of the MPAA Memorandum.

127. Article III, § (b) of the MPAA Memorandum.

128. Article III, § (c) of the MPAA Memorandum.

129. Article III, § (a) of the MPAA Memorandum.

130. Article III, § (c) of the MPAA Memorandum.

131. Article III, § (e) of the MPAA Memorandum.

the parties to the arbitration.¹³² The arbitration procedure not only determines whether or not a member's use of a title is authorized, but may carry with it sanctions for unauthorized use of a title.¹³³ Sanctions range from an award of \$2,500 liquidated damages, to the attorneys' fees and costs sustained in order to enforce the Title Committee's findings,¹³⁴ to termination of registration privileges of the member.¹³⁵

Contractually, members are bound to the arbitration results. However, in at least one case, this contractual arrangement has not hindered the members from filing further suit in state or federal courts. In *Gordon v. Warner Bros. Pictures, Inc.*,¹³⁶ the California Court of Appeal appeared to give little or no weight to the Title Registration Bureau's decision that defendant's use of the title "The FBI Story" was not a violation of plaintiff's rights. The court noted that both parties had registered the title "The FBI Story" with the Title Registration Bureau within one week of each other, but refused to find that the plaintiff's use of the title was protected by unfair competition law.¹³⁷ In remanding the case, the court of appeal held that, upon a showing of secondary meaning, plaintiff would be entitled to protection.¹³⁸ Since the updated 1986 Title Registration Bureau Memorandum explicitly provides that arbitration is binding on all parties involved, cases such as *Gordon* are not likely to occur in the future.

IV. SUMMARY

Substantial capital, time and energy is often invested in making the public aware of a literary title.¹³⁹ As the law currently exists, however, this investment does not necessarily result in protection. In order to protect a literary title, it has been suggested that one should select a more fanciful title.¹⁴⁰ This, it is hoped, will cut down on the number of prior uses of the identical or similar title. Preventative measures, such as a title search, conducted through the Copyright Office at a cost of \$10 per

132. Article III, § (c) of the MPAA Memorandum.

133. Article IV, § (c) of the MPAA Memorandum.

134. Article IV, § (c) of the MPAA Memorandum.

135. Article V, § (d) of the MPAA Memorandum.

136. 269 Cal. App. 2d 31, 74 Cal. Rptr. 499 (1969).

137. *Id.* at 39-40, 74 Cal. Rptr. at 504.

138. *Id.* at 38-39, 74 Cal. Rptr. at 503-04.

139. Angel, *supra* note 6, at 280.

140. Perry, *supra* note 1, at 8. A name or title is considered fanciful when it does not, by its usual and ordinary meaning, denote or describe the production or work to which it is applied. *Skinner Mfg. Co. v. General Foods Sales Co.*, 52 F. Supp. 432, 445 (D. Neb. 1943). For a more in-depth discussion of fanciful titles, see *infra* notes 183-98 and accompanying text.

hour,¹⁴¹ will give the proposed user an idea of whether or not a conflict exists with an earlier user.¹⁴²

Once a title is decided upon, protection is furthered by building up the title's secondary meaning.¹⁴³ Pre-release publicity is probably advantageous in that the sooner the public associates the title with the particular work, the sooner secondary meaning will be established. Whether or not the jurisdiction requires a showing of secondary meaning, it is always helpful in pleading an action in unfair competition.

Correspondingly, if the work is a radio or television series, the user should have the title federally registered under section 45 of the Lanham Act as the title of a series.¹⁴⁴ If, however, a single literary title is used, the title, character names and program features should be used on collateral products, such as those that are often used to promote movies.¹⁴⁵ Such products include buttons, posters and T-shirts.¹⁴⁶ The title may be registered as a trademark for these products¹⁴⁷ and, as a consequence, the single literary title will be protected. Some have proposed that a Federal Literary Title Statute be adopted to specifically protect literary titles.¹⁴⁸ However, until a statute which addresses the intricacies of title law is adopted, the use of publicity, distinctive title selection and collateral product trademarking should be employed as early as possible to ensure protection.

Whitney Hartford Conant

PART II: SECONDARY MEANING

I. INTRODUCTION

Although federal law allows registration of a title for a series of literary works, the problem facing a plaintiff who has a single literary title is that the title cannot be registered.¹⁴⁹ The producer can only get protec-

141. Perry, *supra* note 1, at 8.

142. *Id.*

143. *Id.*

144. *Id.* For a discussion of § 45 of the Lanham Act, see *supra* note 95 and accompanying text.

145. Perry, *supra* note 1, at 8.

146. *Id.*

147. *Id.*

148. See Angel, *supra* note 6, at 312-14.

149. If a work is considered a series it has a trademark function and as such can be federally

tion for his or her single literary title if the title has acquired secondary meaning.¹⁵⁰ Secondary meaning is defined as the meaning "that attaches to descriptive words 'that have been used so long and so exclusively by one producer with reference to his article that, in that trade and to that branch of the purchasing public, the word or phrase has come to mean that the article was his product.'" ¹⁵¹ Secondary meaning can protect one producer's title from usurpation by another producer who wishes to use the same title. On the other hand, if a producer can show that a previously used title has not yet acquired secondary meaning, he or she may be free to use it. This section will point out how a producer can prove secondary meaning and also, by implication, what is needed to refute the acquisition of secondary meaning.

The general test for secondary meaning is whether in the minds of a substantial number of people the title can be associated with a single source.¹⁵² The question of whether a title has acquired secondary meaning is a question of fact.¹⁵³ But once secondary meaning is established,

registered without having to show secondary meaning. *Application of Cooper*, 254 F.2d 611, 615 (C.C.P.A.), *cert. denied*, 358 U.S. 840 (1958). A series is defined as not being descriptive of any one work and each work within the series having its own individual title. *Motown Prods., Inc. v. Cacomm, Inc.*, 668 F. Supp. 285, 288 (S.D.N.Y. 1987) *rev'd on other grounds*, 849 F.2d 781 (2d Cir. 1988).

In *Application of Cooper*, the Court of Customs and Patent Appeal did not find that the title "Teeny Big" was registrable as a trademark for books since it was the title of a single work. *Cooper*, 254 F.2d at 616. The court stated that the name for a series could function as a trademark, indicating that each work within the series comes from a single source; however, a book title only identifies a specific work and as such is not associated in the public mind with a single source (i.e., the publisher). *Id.* at 615.

In *Motown Productions, Inc. v. Cacomm, Inc.*, the Second Circuit reached a similar decision that neither of the parties' television shows could be deemed a series since the individual shows did not have individual names or titles. *Motown*, 668 F. Supp. at 288. The court said that the name "Nightlife" describes each show, as well as each series as a whole. *Id.* Thus, according to *Cooper* and *Motown*, a television series such as *The Twilight Zone*, which has individual titles for each of its segments, may be entitled to protection without having to go through the rigors of proving secondary meaning (assuming "The Twilight Zone" is distinctive).

150. "A sine qua non of protection of titles on a theory of unfair competition is the establishment by the plaintiff of a secondary meaning in his title." *Gordon v. Warner Bros. Pictures, Inc.*, 269 Cal. App. 2d 31, 35, 74 Cal. Rptr. 499, 501 (1969). See also *Jackson v. Universal Int'l Pictures*, 36 Cal. 2d 116, 121, 222 P.2d 433, 436 (1950); *Allied Artists Pictures Corp. v. Friedman*, 68 Cal. App. 3d 127, 134, 137 Cal. Rptr. 94, 98 (1977); *Cowles Magazines and Broadcasting, Inc. v. Elysium, Inc.*, 255 Cal. App. 2d 731, 733, 63 Cal. Rptr. 507, 509 (1967).

151. *McGraw-Hill Book Co. v. Random House, Inc.*, 32 Misc. 2d 704, 709, 225 N.Y.S.2d 646, 652 (1962) (quoting *G. & C. Merriam Co. v. Saalfeld Pub. Co.*, 198 F. 369 (6th Cir. 1912), *modified and aff'd*, 238 F. 1, *cert. denied*, 243 U.S. 651 (1917)).

152. 1 J.T. MCCARTHY, TRADEMARKS AND UNFAIR COMPETITION § 10:4, at 331-32 (2d ed. 1984) [hereinafter MCCARTHY].

153. *Jackson v. Universal Int'l Pictures, Inc.*, 36 Cal. 2d 116, 121, 222 P.2d 433, 437 (1950);

the title may be protected throughout the United States.¹⁵⁴

A. *Type of Title: Effect on Secondary Meaning*

In the protection of *registerable* trademarks, the classification of the mark is extremely important. If the mark is generic it can never function as a trademark,¹⁵⁵ yet if the mark is suggestive, arbitrary, or fanciful it will be afforded protection without having to show secondary meaning.¹⁵⁶ Distinctive marks¹⁵⁷ are protected immediately upon adoption and use.¹⁵⁸ This is where the requirement for priority of use becomes important—if two people have the same or similar marks, the prior user will be protected.¹⁵⁹

In affording protection to a *literary title*, courts examine the title itself to see if it is merely generic or descriptive, which is a “weak mark,” or if it is arbitrary, fanciful, or suggestive, which is a “strong mark.” Unlike ordinary trademarks, protection of literary titles generally re-

Allied Artists Pictures Corp. v. Friedman, 68 Cal. App. 3d 127, 134, 137 Cal. Rptr. 94, 98 (1977); Metro-Goldwyn-Mayer, Inc. v. Lee, 212 Cal. App. 2d 23, 30, 27 Cal. Rptr. 833, 837 (1963); Cowles Magazines and Broadcasting, Inc. v. Elysium, Inc., 255 Cal. App. 2d 731, 735, 63 Cal. Rptr. 507, 510 (1967); Johnston v. Twentieth Century-Fox Film Corp., 82 Cal. App. 2d 796, 813, 187 P.2d 474, 484 (1947); International Film Serv. Co. v. Associated Prod., Inc., 273 F. 585, 587 (D.C.N.Y. 1921).

154. “The title of a play produced only in New York may acquire a secondary meaning which entitles it to protection throughout the United States.” Jackson v. Universal Int’l Pictures, 36 Cal. 2d 116, 122, 222 P.2d 433, 437 (1950) (citing Hemingway v. Film Alliance of the United States, Inc., 174 Misc. 725, 726, 21 N.Y.S.2d 827, 828 (1940); Frohman v. Payton, 34 Misc. 275, 276, 68 N.Y.S. 849 (1901); Aronson v. Fleckenstein, 28 F. 75, 78 (1886)).

155. MCCARTHY, *supra* note 152, § 15:1, at 658. See also Reese Pub. Co. v. Hampton Int’l Communications, Inc., 620 F.2d 7, 12 (2d Cir. 1980); CES Pub. Corp. v. St. Regis Pubs., Inc., 531 F.2d 11, 15 (2d Cir. 1975); National Lampoon, Inc. v. American Broadcasting Cos., 376 F. Supp. 733, 748 (S.D.N.Y.), *aff’d*, 497 F.2d 1343 (2d Cir. 1974).

In *CES Publishing*, the plaintiff, who published a magazine entitled *Consumer Electronics Monthly*, sought to enjoin the defendant from publishing his magazine entitled *Consumer Electronics Product News*. The Second Circuit found that the use of the words “consumer electronics” described the “class of trade magazines within that industry” and, as such, the title was generic and not entitled to registration. *CES Publishing*, 531 F.2d at 14. In holding that generic terms cannot be rescued as trademarks by proof of secondary meaning, the court stated that “[t]o allow trademark protection for generic terms, i.e., names which describe the genus of goods being sold, even when these [terms] have become identified with a first user, would grant the owner of the mark a monopoly, since a competitor could not describe his goods as what they are.” *Id.* at 13.

156. MCCARTHY, *supra* note 152, § 11:2, at 435. See Playboy Enterprises, Inc. v. Chuckleberry Pub., Inc., 687 F.2d 563 (2d Cir. 1982). The Second Circuit stated, “the ‘Playboy’ mark is suggestive rather than descriptive and as such is entitled to protection without proof of secondary meaning.” *Playboy*, 687 F.2d at 566 (citing McGregor-Doniger, Inc. v. Drizzle, Inc., 599 F.2d 1126, 1137 (2d Cir. 1979)).

157. “Distinctive marks” are those that are referred to as suggestive, arbitrary or fanciful.

158. MCCARTHY, *supra* note 152, § 11:2, at 435.

159. *Id.*

quires proof of secondary meaning.¹⁶⁰ Determining which class the title falls within is essential because the categorization determines how much proof of secondary meaning is required, whether the title may be protected at all, and the extent of relief the court will afford the title. Proof of secondary meaning is required for even the most distinctive of titles because titles are per se descriptive of the literary works themselves.¹⁶¹ Each title is a term used to describe the product, as opposed to a mark which is used to designate a single source.¹⁶²

1. Generic

A "generic" term is defined as a term that refers "to the genus of which the particular product is a species."¹⁶³ A word is generic when it becomes the name used for a particular product, for example "Aspirin" for acetyl salicylic acid.¹⁶⁴

New York courts afford protection to generic terms, but to receive such protection, the plaintiff must prove that the mark has acquired secondary meaning. In *McGraw-Hill Book Co. v. Random House, Inc.*,¹⁶⁵ the plaintiff whose book title was "PT-109: John F. Kennedy in World War II," tried to prevent the defendant from using the title "John F. Kennedy and PT-109." The court stated that "[w]ords or phrases which have been in common use, which are descriptive or generic, or which constitute the true and generally accepted name by which an article or thing is called, may not be appropriated by anyone to his exclusive use."¹⁶⁶ However, the court qualified its statement by holding that if the title had acquired secondary meaning, the rules of unfair competition would prevent the use of the same title by another.¹⁶⁷ The court found

160. *Id.* § 10:2, at 323. *But see supra* text accompanying notes 64-93 for a discussion of unfair competition in New York where proof of secondary meaning is not always required.

161. *MCCARTHY, supra* note 152, § 10:2, at 326. *See* Application of Cooper, 254 F.2d 611 (C.C.P.A.), *cert. denied*, 358 U.S. 840 (1958). The court in *Cooper* gives a wonderful explanation of the reasoning for denying registration for a single literary title even if the title is "distinctive." The court explained, "[b]ut however arbitrary, novel or nondescriptive of [the book's] contents the name of a book—its title—may be, it nevertheless describes the book." *Id.* at 615 (emphasis in original).

162. *MCCARTHY, supra* note 152, § 10:2, at 324.

163. *Reese Pub. Co. v. Hampton Int'l Communications, Inc.*, 620 F.2d 7, 10 (2d Cir. 1980) (citing *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9 (2d Cir. 1976)).

164. *Bayer Co. v. United Drug Co.*, 272 F. 505 (D.C.N.Y. 1921).

165. 32 Misc. 2d 704, 225 N.Y.S.2d 646 (1962).

166. *Id.* at 708, 225 N.Y.S.2d at 651. *See also* Litwin v. Maddux, 7 Misc. 2d 750, 164 N.Y.S.2d 489 (1957). The New York court stated, "[g]eneric and descriptive words will not ordinarily be protected by injunction, particularly where no fraud or deception in the use of a similar title by another was intended . . ." *Id.* at 757, 164 N.Y.S.2d at 496-97.

167. *McGraw-Hill*, 32 Misc. 2d at 708, 225 N.Y.S.2d at 651.

that, even assuming the plaintiff's work had established secondary meaning, this did not mean that the defendant was competing unfairly with the plaintiff.¹⁶⁸

California courts likewise allow protection to generic titles upon a showing of secondary meaning. For example, in *West v. Lind*,¹⁶⁹ the plaintiff, Mae West, sought to enjoin the defendant from using the name "Diamond Lil" as her stage name. The court held that "while generic terms . . . are not subject to exclusive appropriation, if a plaintiff proves that such a name or word has been so exclusively identified with his goods or business as to have acquired a secondary meaning . . . he is entitled to relief against another's deceptive use of such terms."¹⁷⁰ However, the court found against Mae West, stating that there would be no likelihood of confusion between the plaintiff's use of the name and the defendant's use.¹⁷¹

2. Descriptive

A "descriptive" term is illustrative of the nature of the product it identifies, for example, "Bufferin" for buffered aspirin.¹⁷² Although courts consider *all* single literary titles to be descriptive, titles are protected upon a showing of secondary meaning. For example, in the Second Circuit case of *Orion Pictures Co. v. Dell Publishing Co.*,¹⁷³ the title "A Little Romance" was deemed descriptive of the contents of plaintiff's film, yet was protected because the title had acquired secondary meaning.¹⁷⁴ The court held that "an inference of secondary meaning, properly supported, seems to be enough" to allow the claimant protection when one is dealing with a descriptive term.¹⁷⁵ The court found that an inference of secondary meaning had been supported in *Orion* because of the extensive pre-release publicity of the film and, accordingly, protected the

168. *Id.* at 709, 225 N.Y.S.2d at 652. See *infra* text accompanying notes 343-519 for a discussion of "Likelihood of Confusion."

169. 186 Cal. App. 2d 563, 9 Cal. Rptr. 288 (1960).

170. *Id.* at 567, 9 Cal. Rptr. at 291. See also *Cowles Magazines and Broadcasting, Inc. v. Elysium, Inc.*, 255 Cal. App. 2d 731, 63 Cal. Rptr. 507 (1967), where the generic term "look" (the name of plaintiff's magazine) was not capable of being used exclusively by the plaintiff unless it had acquired a secondary meaning. *Id.* at 735, 63 Cal. Rptr. at 510. The court stated that the secondary meaning that had attached to *Look* would reach no further than is necessary to prevent public confusion. *Id.* at 736, 63 Cal. Rptr. at 510.

171. *West*, 186 Cal. App. 2d at 567, 9 Cal. Rptr. at 291. See *infra* text accompanying notes 343-519 for a discussion of what constitutes "confusion."

172. *Wise v. Bristol-Myers Co.*, 107 F. Supp. 800 (D.C.N.Y. 1952).

173. 471 F. Supp. 392 (S.D.N.Y. 1979).

174. *Id.* at 396.

175. *Id.* (citing *W.E. Bassett Co. v. Revlon, Inc.*, 435 F.2d 656, 661 (2d Cir. 1970)).

plaintiff's title.¹⁷⁶

In the Ninth Circuit case of *Fishler v. Twentieth Century-Fox Film Corp.*,¹⁷⁷ the plaintiffs failed to show that secondary meaning had attached to their use of the descriptive title "Virgin Queen."¹⁷⁸ The plaintiffs' play had never been performed and had very little publicity. The only evidence plaintiffs had of secondary meaning, was an informational letter sent by them to motion picture studios stating that they had written a play entitled "Virgin Queen."¹⁷⁹ The court stated that "[t]he title . . . is so well known independently of either production that it is commonly associated . . . with the history of the particular Queen who is the subject of both plays."¹⁸⁰ However, the court conceded that a well-known group of words could nonetheless acquire secondary meaning.¹⁸¹ In *Fishler*, the court found that no one associated the title with the plaintiffs' play except the plaintiffs and therefore denied them relief.¹⁸²

3. Suggestive, Arbitrary, and Fanciful Marks

A "suggestive" mark is one that suggests what the product is without actually describing it (i.e., Q-Tips¹⁸³), while an "arbitrary" term neither suggests nor describes any characteristic of the product it names¹⁸⁴ (i.e., Tab for sugar-free soda). A "fanciful" mark, on the other hand, is the most distinctive of all because the mark or name is invented solely for use as a trademark¹⁸⁵ (i.e., Kodak for camera equipment and services¹⁸⁶), but it may be a word that is related to another word or a word that has now become obsolete.

In the Second Circuit, suggestive, arbitrary, or fanciful marks are afforded much protection as shown in *WGBH Educational Foundation, Inc. v. Penthouse International Ltd.*¹⁸⁷ In that case, the plaintiff sought to protect the name "Nova," which it used for a television science program, against use of the name by the defendant for its magazine devoted

176. *Id.* at 396.

177. 159 F. Supp. 215 (S.D. Cal. 1958).

178. *Id.* at 218.

179. *Id.* at 216.

180. *Id.* at 217.

181. *Id.*

182. *Fishler*, 159 F. Supp. at 218.

183. *Q-Tips, Inc. v. Johnson & Johnson*, 206 F.2d 144, 146 (3d Cir.), *cert. denied*, 346 U.S. 867 (1953).

184. MCCARTHY, *supra* note 152, § 11:4, at 439.

185. *Id.*, § 11:2, at 436.

186. *Eastman Kodak Co. v. Weil*, 137 Misc. 506, 243 N.Y.S. 319 (1930).

187. 453 F. Supp. 1347 (S.D.N.Y. 1978).

to fantasy and the occult.¹⁸⁸ The court protected the plaintiff's title because it was arbitrary, fanciful and nondescriptive as applied to a television program and as such, was a strong mark.¹⁸⁹ Because "Nova" was a strong mark, the court granted the plaintiff an injunction against the defendant's use of the name in the publishing field.¹⁹⁰

In California, a fanciful word is considered a very strong mark and as such is afforded the greatest trademark protection.¹⁹¹ In *Johnston v. Twentieth Century-Fox Film Corp.*,¹⁹² the title "Queen of the Flat Tops" was deemed an "arbitrary, fictitious, fanciful, artificial, distinctive and nondescriptive combination of words"¹⁹³ as applied to an aircraft carrier. Because the title was nondescriptive, the court determined that it was a product of the mind and thus the plaintiffs were the owners of the title and had the right to its exclusive use.¹⁹⁴ As a result the plaintiffs' title was entitled to protection in the motion picture, radio, drama, and television areas.¹⁹⁵ The court in *Gordon v. Warner Bros. Pictures, Inc.*,¹⁹⁶ pointed out that the holding in *Johnston*, implying that a fanciful title may acquire protection *without* proof of secondary meaning, was dicta¹⁹⁷ and clearly not the law of California.¹⁹⁸

In examining all of the cases, it seems that no matter how fanciful a title may be, it still must acquire secondary meaning in order to be protected. However, the classification of the title as generic, descriptive, or suggestive, arbitrary and fanciful is still important because it may affect the amount of proof of secondary meaning required. As a general rule, it is probably more advantageous to the producer if his or her title is a fanciful combination of words as opposed to words which are generic.

188. *Id.* at 1348-49.

189. *Id.* at 1350.

190. *Id.* at 1352.

191. *Time, Inc. v. T.I.M.E., Inc.*, 123 F. Supp. 446 (S.D. Cal. 1954). "[T]he fanciful or coined word is deemed 'strong' and is more broadly protected as a trade-mark or trade name, even as to non-competing goods; while the general or descriptive word is considered 'weak' as a trade name or trade-mark, and is accorded but narrow protection." *Id.* at 454-55. In *Time*, the court held that the word "time" as used by the plaintiff was both ordinary and descriptive as opposed to coined and fanciful, and thus the protection was limited to the area of news communication where plaintiff had established some secondary meaning. *Id.* at 455.

192. 82 Cal. App. 2d 796, 187 P.2d 474 (1947).

193. *Id.* at 809, 187 P.2d at 482.

194. *Id.*

195. *Id.* at 813, 187 P.2d at 485.

196. 269 Cal. App. 2d 31, 74 Cal. Rptr. 499 (1969).

197. It was dicta since the plaintiff had proven secondary meaning.

198. 269 Cal. App. 2d at 34 n.1, 74 Cal. Rptr. at 501.

B. Source Requirement: *Specific Producer v. Single Source*

The result, or goal, of achieving secondary meaning is the association of the literary title with its source.¹⁹⁹ This is what the producer must achieve in order to protect his or her title. Jurisdictions differ when confronted with the issue of source identification. Some require that the public has to identify the work as coming from a specific identifiable source, while others hold that it is enough that the public knows that the work comes from a single, yet anonymous, source.

1. New York/Second Circuit

New York state courts require that the public associate the work with its producer in order for the title to achieve secondary meaning.²⁰⁰ For example, in *Litwin v. Maddux*,²⁰¹ the plaintiff, who published a novel entitled "The Green Kingdom," failed to establish that the public associated the title of his work with him as the author. The court, in denying the plaintiff relief, held that the title of a work would not be protected unless it could be identified with its source.²⁰²

The Second Circuit, which follows the New York position, applied the rule to film titles. The plaintiff in *DC Comics, Inc. v. Powers*,²⁰³ succeeded in establishing that the public identified the "Daily Planet" with DC Comics as the producer of goods relating to that name. The identification was made because the plaintiff was the creator of the comic book character "Superman" and had used the name the "Daily Planet" in connection with the *Superman* comic strip for over thirty years.²⁰⁴ The plaintiff was thus able to enjoin the defendant from using "Daily Planet" as the name for its news publication, and therefore prevented the defend-

199. The Lanham Act defines "trademark" as a word, name, or symbol used by a person to identify his or her goods from those of others, "and to indicate the source of the goods, even if that source is unknown." 15 U.S.C. § 1127 (1989).

200. "In order to establish a trade-mark, it must be shown that 'the primary significance of the term in the minds of the consuming public is not the product, but the producer.'" *Dell Pub. Co. v. Stanley Pubs., Inc.*, 211 N.Y.S.2d 393, 402, 9 N.Y.2d 126, 137 (Ct. App. 1961) (emphasis omitted) (quoting *Brown & Bigelow v. Remembrance Adv. Prods., Inc.*, 279 A.D. 410, 413, 110 N.Y.S.2d 441, 444 (N.Y. App. Div. 1952) *aff'd*, 304 N.Y. 909, 110 N.E.2d 736 (N.Y. 1953); *Kellogg Co. v. National Biscuit Co.*, 305 U.S. 111, 118 (1938)). In *Dell*, the court stated that if the public was interested in a romance story written by the plaintiff it would have no problem in finding the Dell symbol on the corner of the magazine cover. *Dell*, 211 N.Y.S.2d at 402, 9 N.Y.2d at 137.

201. 7 Misc. 2d 750, 164 N.Y.S.2d 489 (1957).

202. *Id.* at 757, 164 N.Y.S.2d at 497 (citing *Gotham Music Service, Inc. v. Denton & Haskins Music Pub. Co.*, 259 N.Y. 86, 90, 181 N.E. 57, 58 (N.Y. 1932); *Underhill v. Schenck*, 238 N.Y. 7, 20, 143 N.E. 773, 778 (N.Y. 1924)).

203. 465 F. Supp. 843 (S.D.N.Y. 1978).

204. *Id.* at 845-46.

ant from capitalizing on the release of plaintiff's upcoming film.²⁰⁵ The court held that, "the primary significance of the mark in the hands of the consuming public is not to identify the product, but rather, to identify its producer."²⁰⁶

2. California/Ninth Circuit

Unlike New York courts, California courts do not require that the title of the work be associated with its author. Rather, secondary meaning can attach to the title itself—absent recognition of the author or producer of the work.²⁰⁷ Secondary meaning may therefore exist between a title and a producer who is unknown to the audience.²⁰⁸

In *Allied Artists Pictures Corp. v. Friedman*,²⁰⁹ the plaintiff was distributing a French film, *The Story of O*,²¹⁰ based on the book "Histoire d'O." The title "Histoire d'O" had acquired secondary meaning in France because of its identification in the public mind with the book. The defendant mistakenly claimed that the title had to be associated with its producer or distributor.²¹¹ The court held that the necessary identification in the public mind was with, "the literary work, the film, and not with Allied [the motion picture company] as the distributor."²¹² The court found that the segment of society that read such literature associated the title with the book and as such the title had acquired secondary meaning.²¹³

The California view in this area is logical, while the New York requirement seems unrealistic. Most people do not know the producer of a movie or television show, yet are quite familiar with the work itself.²¹⁴

205. *Id.* at 850.

206. *Id.* at 846.

207. *Jackson v. Universal Int'l Pictures, Inc.*, 36 Cal. 2d 116, 123, 222 P.2d 433, 438 (1950).

208. *Jackson*, 36 Cal. 2d 116, 222 P.2d 433. "Secondary meaning may exist between a name and the manufacturer or seller whose identity is not known to the buyer. . . . He [the buyer] does not know its [the manufacturer's] name, or its location, or whether it is a corporation or an individual." *Id.* at 123, 222 P.2d at 438 (alterations and omissions in original) (citing 1 NIMS, UNFAIR COMPETITION AND TRADE MARKS § 42, at 169-70 (4th ed. 1947)).

209. 68 Cal. App. 3d 127, 137 Cal. Rptr. 94 (1977).

210. *Id.* at 134, 137 Cal. Rptr. at 98. The title "The Story of O" is merely the English translation of "Histoire d'O."

211. *Id.*

212. *Id.*

213. *Id.*

214. The court in *Jackson v. Universal Int'l Pictures, Inc.*, 36 Cal. 2d 116, 222 P.2d 433 (1950), in acknowledging that advertising is concentrated upon the title and the actors, rather than the author or producer, stated that there was "no logical basis for holding that a public well acquainted with the title and the play could not confer secondary meaning upon that title merely because of unfamiliarity with the author's name." *Id.* at 123, 222 P.2d at 438.

The New York rule may derive from strict trademark law where the function of a trademark is to denote the product's source rather than the product itself.²¹⁵ However, the basic assumption underlying the protection of literary titles is that each title describes the literary work, rather than denoting the producer.²¹⁶ The California approach seems to recognize this assumption and does not require that the producer go through the rigors of proving that the public recognizes him or her as the source of the work; instead, the producer must simply prove that the public associates the title with the product it identifies.

C. Secondary Meaning Factors—What the Court Considers

Courts consider a wide variety of factors when determining whether a producer has established secondary meaning for his title. In *Motown Productions, Inc. v. Cacomm, Inc.*,²¹⁷ the Second Circuit established the key factors for determining whether a producer has established secondary meaning. The factors are: (1) the advertising expenditures of the plaintiff, (2) consumer studies linking the name to its source, (3) the sales success of the work, (4) unsolicited media coverage, (5) the defendant's attempt to plagiarize plaintiff's mark, and (6) the length and exclusivity of the use by the plaintiff.²¹⁸

Motown involved a dispute concerning the use of the name "Night-life" for a television show. The plaintiffs were producers of a nationwide nightly television program, while the defendant was the producer of a local cable television talk show.²¹⁹ The court found that secondary meaning had not attached to defendant Cacomm's title, and thus held

215. 15 U.S.C. § 1127 (1989).

216. MCCARTHY, *supra* note 152, § 10:2, at 324. See *infra* text accompanying notes 152-62.

217. 668 F. Supp. 285 (S.D.N.Y. 1987), *rev'd on other grounds*, 849 F.2d 781 (2d Cir. 1988).

218. *Motown*, 668 F. Supp. at 289. The lower court in reaching its decision used the factors outlined in *Thompson Medical Co. v. Pfizer Inc.*, 753 F.2d 208, 217 (2d Cir. 1985), *cited with approval in*, *Allen v. Men's World Outlet, Inc.*, 679 F. Supp. 360, 366 (S.D.N.Y. 1988). See also *National Lampoon, Inc. v. American Broadcasting Cos.*, 376 F. Supp. 733 (S.D.N.Y.), *aff'd*, 497 F.2d 1343 (2d Cir. 1974). The *National Lampoon* court found both evidence of secondary meaning and likelihood of confusion and thus permanently enjoined the defendants from using the words "National Lampoon" or "Lampoon" as a title for their television show. In finding strong evidence of secondary meaning the court considered the following facts: (1) the plaintiff's magazine was distributed throughout North America by 70,000 news dealers and sold by subscription, (2) the magazine's circulation was 167,000 in 1970 and 100,000 in 1973, (3) plaintiff's revenue from all of its endeavors in 1973 was \$6,800,000, (4) the plaintiff's revue (based on the magazine) was on a national tour and seen by 100,000 people in New York alone, and by an additional 100,000 people over the country, (5) in November of 1973 plaintiff had a radio hour broadcast over 156 stations, (6) plaintiff had produced three records, and (7) plaintiff was presently producing and taping the revue for broadcast over close circuit television. *Id.* at 738-40.

219. *Motown*, 668 F. Supp. at 287.

that the defendant had no exclusive right to the name "Nightlife." The court based its decision on evidence that (1) the defendant's company had only spent \$14,000 on advertising over a one and a half year period, (2) the defendant had not undertaken a consumer survey which would indicate the public perception of the program and its source, (3) the defendant performed no survey to show the size of its audience and had no sales of its show for over one year, (4) the defendant did not offer any evidence of unsolicited media coverage, (5) the plaintiff's adoption of the name was not intentional, and finally (6) the length and exclusivity of defendant's use of the mark was insubstantial since it had sporadically used the mark for only seven months in 1984 and four months in 1985.²²⁰

In *Cowles Magazines and Broadcasting, Inc. v. Elysium, Inc.*,²²¹ a California court considered the following factors in determining whether the magazine title *Look* had achieved secondary meaning: (1) the duration and continuity of use of the plaintiff's title, (2) the extent of advertising and promotion of the title and the sums spent therefore, (3) the sales figures showing the number of people who have purchased plaintiff's product (proven by the circulation figures of the magazine), and (4) the identification of the respective markets or marketing area.²²² The plaintiff had used the name of his magazine, *Look*, continuously since 1936, had spent over \$49,000,000 in advertising and promotion over a five year period,²²³ and the circulation of the magazine increased from 5.5 million copies in 1959 to 7.5 million copies in 1964.²²⁴ Although the court found that secondary meaning had attached to the title, it did not afford the plaintiff relief because it found that there would be no likelihood of confusion between plaintiff's magazine and the defendant's magazine entitled *Nude Look*.²²⁵

D. Actual Use of the Title and Priority in Time

A crucial factor in determining whether a title is entitled to trademark protection is whether or not the title has been "used."²²⁶ The ra-

220. *Id.* at 289-90.

221. 255 Cal. App. 2d 731, 63 Cal. Rptr. 507 (1967).

222. *Id.* at 735, 63 Cal. Rptr. at 510.

223. In a single promotional campaign the plaintiff spent between \$1,500,000 and \$2,000,000 in advertising *Look* in various news media throughout the country. *Id.* at 734, 63 Cal. Rptr. at 509.

224. *Id.*

225. *Id.* at 738, 63 Cal. Rptr. at 512. See *infra* text accompanying notes 344-53 for a discussion of the elements necessary to prove likelihood of confusion and thus entitle the claimant to relief.

226. MCCARTHY, *supra* note 152, § 16:1, at 720.

tionale for the requirement of use derives from the nature of trademarks—the value of a trademark is based on the product that it symbolizes; if there is no use, then nothing is symbolized, and therefore nothing requires legal protection.²²⁷ The need to prove use came from federal trademark law which requires that the mark be used in interstate commerce in order to be registered under federal law.²²⁸ Common law protection has incorporated the requirement for use in determining whether a mark is entitled to trademark protection. However, rather than use in “interstate commerce,”²²⁹ the use must be “public.”²³⁰

The majority of cases indicate that it is not the *exclusiveness* of the producer's use that is important,²³¹ but rather the acquisition of secondary meaning.²³² The *length* of time the producer uses the title is used solely as evidence in establishing secondary meaning.²³³ As will be seen, even a short period of use may be sufficient.²³⁴ *Priority* in time of the use of the title is also taken into consideration by courts, probably because of

227. B. PATTISHALL & D. HILLIARD, TRADEMARKS § 2.02, at 31 (1987).

228. 15 U.S.C. § 1051(a)(1)(A) (1989). On November 16, 1989 the Trademark Law Revision Act of 1988 took effect. The previous rule was that trademark protection of a mark was acquired only if it had been used prior to application for registration. *Id.* Now, application for registration can be made *prior* to actual use of the mark by filing an application based upon a “bona fide intention” to use the mark. 15 U.S.C. § 1051(b) (1989). However, there is a limitation to this provision: the reservation period is limited to six months with extensions up to three years in certain circumstances. 15 U.S.C. 1063(b)(2)(A) (1989). Because the law just became effective, cases interpreting these dramatic changes have not yet reached the courts.

229. 15 U.S.C. § 1051(a)(1)(A) (1989).

230. *Walt Disney Prods. v. Kusan, Inc.*, 204 U.S.P.Q. (BNA) 284, 287 (C.D. Cal. 1979). In defining what constitutes public use, the *Disney* court used the First Circuit test adopted in *New West Corp. v. NYM Co. of Calif., Inc.*, 595 F.2d 1194 (9th Cir. 1979). The First Circuit test for determining what constitutes sufficient use of a trademark in order to confer ownership rights originated in *New England Duplicating Co. v. Mendes*, 190 F.2d 415, 418 (1st Cir. 1951):

[T]he question of use adequate to establish appropriation remains one to be decided on the facts of each case, and that evidence showing, first, adoption, and second, use in a way sufficiently public to identify or distinguish the marked goods in an appropriate segment of the public mind as those of the adopter of the mark, is competent to establish ownership, even without evidence of actual sales.

New West, 595 F.2d at 1200 (emphasis omitted) (citing *New England Duplicating Co. v. Mendes*, 190 F.2d 415, 418 (1st Cir. 1951)). The *New West* court found that the totality of the plaintiff's acts met the “public identification” requirement of the First Circuit rule and thus gave the plaintiff the right to use the name “New West” for the title of its magazine. *Id.* at 1200-01.

231. *But see* the federal Lanham Act which allows as prima facie evidence of secondary meaning the exclusive and continuous use of a mark for five years preceding an offer of proof by the applicant. 15 U.S.C. § 1052(f) (1989).

232. MCCARTHY, *supra* note 152, § 15:9, at 682.

233. *Id.*, § 15:20, at 701.

234. *See infra* text accompanying notes 263-67.

its certainty and predictability.²³⁵ Courts, however, are divided as to whether priority of use is a requirement for establishing ownership of a mark.²³⁶ Some courts apply the priority of use rule strictly, while others consider the equities involved.²³⁷

1. New York/Second Circuit

The New York position on the amount of use required is enunciated in *DC Comics, Inc. v. Powers*.²³⁸

In order to claim ownership of a mark, a party must demonstrate that his use of the mark has been of *such a quality and for such a duration* that it has come to identify goods bearing it as originating from that party. In short, the mark must have developed a secondary meaning.²³⁹

In *DC Comics*, the plaintiffs and their predecessors had used the title, "Daily Planet" in connection with their "Superman" character since 1938.²⁴⁰ The "Daily Planet" played a key role in the development of both the "Superman" story and of the "Superman" character.²⁴¹ The title was used both as the name of the newspaper which employed Clark Kent and also as the title of a promotional news column appearing within the *Superman* comic books.²⁴² The defendants, on the other hand, used the title "The Daily Planet" in connection with their local underground newspaper which was published only irregularly during the years 1969 through 1973.²⁴³ After 1973, the defendants ceased production of the newspaper until it learned of the plaintiff's upcoming release of the *Superman* motion picture.²⁴⁴ The court found that the plaintiff's use of the title was of such a duration and consistency that ownership

235. B. PATTISHALL & D. HILLIARD, TRADEMARKS § 2.03, at 40 (1987). *See also supra* text accompanying notes 226-30 for a discussion of the importance of priority of use in regard to traditional trademarks.

236. *Compare* Allied Artists Pictures Corp. v. Friedman, 68 Cal. App. 3d 127, 135, 137 Cal. Rptr. 94, 98 (1977), with Walt Disney Prods. v. Kusan, Inc., 204 U.S.P.Q. (BNA) 284, 286 (C.D. Cal. 1979).

237. *See* B. PATTISHALL & D. HILLIARD, TRADEMARKS § 2.03, at 42 (1987).

238. 465 F. Supp. 843 (S.D.N.Y. 1978).

239. *Id.* at 846 (emphasis added). *See also* Sterling Prods. Corp. v. Sterling Prods., Inc., 45 F. Supp. 960 (S.D.N.Y. 1942) where the court held that in order to acquire secondary meaning, the "[p]laintiff must demonstrate that these words have been used exclusively for many years and to such an extent that they are commonly associated with the plaintiff and plaintiff's business." *Id.* at 961.

240. *DC Comics*, 465 F. Supp. at 845.

241. *Id.* at 847.

242. *Id.* at 845.

243. *Id.*

244. *Id.* at 847.

had been established.²⁴⁵ The defendants' use, however, showed an intent to abandon and thus the defendants did not own the title.²⁴⁶

a. Priority in Time

The general rule in New York is that acquisition of secondary meaning, rather than priority of use, is a necessary condition for protection against title infringement.²⁴⁷ In *Frohman v. William Morris, Inc.*,²⁴⁸ the defendant argued that it owned the title "Chanticlair" because its burlesque was produced prior to the production of plaintiffs' play, "Chantecler."²⁴⁹ However, the fact that Rostand had written the plaintiff's play²⁵⁰ and was about to produce it in Europe was well known to the public for years prior to defendant's production.²⁵¹ The court stated that, "it should [not] be held that the one who was prior in time of actually producing something . . . is stronger in right. In equity the right belongs to the eminent author whose talent and reputation created the extraordinary interest of which the defendants . . . have sought to reap the benefit."²⁵²

Another example of this rule can be found in the Second Circuit case of *Motown Productions, Inc. v. Cacomm, Inc.*,²⁵³ where the defendant, Cacomm, argued that it had the exclusive right to use the name "Nightlife" for its television show since it was the prior user of the

245. *DC Comics*, 465 F. Supp. at 847.

246. *Id.* at 848. See *infra* text accompanying notes 466-88 for a discussion of what constitutes abandonment of a title.

247. *Schwartz v. Hampton*, 30 Misc. 2d 837, 839, 219 N.Y.S.2d 106, 108 (1961), *aff'd*, 16 A.D.2d 915, 230 N.Y.S.2d 666 (1962); *Litwin v. Maddux*, 7 Misc. 2d 750, 761, 164 N.Y.S.2d 489, 500 (1957) (citing *Underhill v. Schenck*, 114 Misc. 520, 524, 187 N.Y.S. 589, 592, *modified and aff'd*, 201 A.D. 46, 193 N.Y.S. 745 (1921); *Frohman v. William Morris, Inc.*, 68 Misc. 461, 465, 123 N.Y.S. 1090, 1093 (1910)).

248. 68 Misc. 461, 123 N.Y.S. 1090 (1910).

249. Defendant acquired the United States rights to its burlesque from persons in Europe. *Id.* at 463, 123 N.Y.S. at 1091.

250. Plaintiff had acquired the right from Rostand to produce the play in English in the United States. *Id.* at 462, 123 N.Y.S. at 1090.

251. *Id.* at 465, 123 N.Y.S. at 1092.

252. *Id.* at 465, 123 N.Y.S. at 1093. See also *Children's Television Workshop v. Sesame Nursery Centers, Inc.*, 171 U.S.P.Q. (BNA) 105 (N.Y. Sup. Ct. 1970). The plaintiff in *Children's Television Workshop*, produced the television series *Sesame Street*. The producer sought a temporary injunction against the defendants' further use of the name "Sesame" for their day care services (the defendants intended on franchising their operation based upon the commercial success of plaintiff's television show). The defendants claimed that they were the prior user of "Sesame" in connection with pre-school education and day care services. The court decided, however, that even if defendants had used the name prior to plaintiff, defendants' use was limited and thus did not give defendants the right "to expand their operations into new fields and areas on plaintiff's coattails." *Id.* at 105.

253. 668 F. Supp. 285 (S.D.N.Y. 1987).

name.²⁵⁴ Cacomm first produced its show in January 1984, while the plaintiff's, Motown's, show premiered in September 1986. The court stated that, "[p]rior use of a trademark does not automatically entitle the first user to bar its use by others,"²⁵⁵ and held for the plaintiff. The court further stated that it must not look solely to the age of the marks in question, but also to other factors.²⁵⁶

Although *Thomas Nelson, Inc. v. Cherish Books Ltd.*²⁵⁷ implies that by virtue of a party's first use of a mark in commerce it is the owner of the trademark,²⁵⁸ it cannot be read as meaning that one who is prior in time is automatically prior in right. In *Thomas Nelson*, the plaintiff, who published a series of Christian romance novels under the name "Cherish Romances," sought to enjoin the defendant from publishing its series of romance novels under the title "Cherish Romance." The defendant conceived the name "Cherish Romance" and began soliciting orders for its novels in September 1983. By December 1983, defendant received an order for 150,000 volumes and in March 1984 the first printing of the novels commenced. In April 1984, defendant filed an application with the United States Patent and Trademark Office for registration of its mark. By the end of July 1984, over 240,000 novels were distributed throughout the United States and sold to the public by major retail stores. As well, defendant spent over \$150,000 in the publication and marketing of its books.²⁵⁹

The plaintiff also conceived of its name "Cherish Romances" in September 1983, and in October 1983 it conducted a search to determine if the mark was available. In November 1983, plaintiff announced, in a company newsletter, its adoption of the name for a series of novels. In April 1984 plaintiff commenced pre-publication sales of its books and in

254. See *supra* text accompanying notes 217-20 for a more extensive discussion of the facts of the case.

255. *Motown*, 668 F. Supp. at 290 (citing *Mushroom Makers, Inc. v. R.G. Barry Corp.*, 580 F.2d 44, 48 (2d Cir. 1978), cert. denied, 439 U.S. 1116 (1979)). See also *American Footwear Corp. v. General Footwear Co.*, 609 F.2d 655 (2d Cir. 1979). In reversing the injunction granted by the district court, the Second Circuit in *American Footwear* stated that, "mere fact of seniority alone does not entitle the first user of trademark to injunctive relief. The determination is to be made on the basis of the equities involved, and thereby requires an evaluation of the legitimate interest of the senior user, the junior user and the consuming public." *Id.* at 664.

256. *Motown*, 668 F. Supp. at 290 (citing *Mushroom Makers, Inc. v. R.G. Barry Corp.*, 580 F.2d 44, 47 (2d Cir. 1978), cert. denied, 439 U.S. 1116 (1979)). See *supra* text accompanying notes 217-20 for a discussion of the "other factors" to which the court was referring.

257. 595 F. Supp. 989 (S.D.N.Y. 1984).

258. *Id.* at 991. See also *WGBH Educ. Found., Inc. v. Penthouse Int'l Ltd.*, 453 F. Supp. 1347, 1349 (S.D.N.Y. 1978) (since the plaintiff was the prior user of the mark it would ordinarily be entitled to the protection that it sought).

259. *Thomas Nelson*, 595 F. Supp. at 990.

July 1984 began to distribute the first novel of its series. Over 60,000 copies were sold as of the date of trial (October 1984).²⁶⁰

The court found that the defendant was the owner of the mark since its first use in commerce was in March of 1984 when it printed the novels, and plaintiff's first use was not until July of 1984 when it distributed the first novel of its series.²⁶¹ Although the *Thomas Nelson* decision seems contrary to the rule stated in *Motown*, it can be reconciled. The *Thomas Nelson* court, in reaching its decision, impliedly considered facts relating to the defendant's use of the title, other than the mere priority of use, and in balancing the equities, the court found that the defendant should prevail.²⁶²

2. California/Ninth Circuit

The general rule in California is exemplified in *Jackson v. Universal International Pictures, Inc.*,²⁶³ where the plaintiff's play, "Slightly Scandalous," was rehearsed in Los Angeles, had a two week run in Philadelphia consisting of fifteen performances, and was performed in New York only seven times.²⁶⁴ Although the duration of the use of the title was not extensive, the court found that secondary meaning had attached to the play's title. The court indicated that an accurate test to measure the duration of use required to create secondary meaning did not exist,²⁶⁵ but that no particular time period of use of the title was required.²⁶⁶ The court further pointed out that, although prior decisions indicated that the title must be used long and exclusively by one producer with reference to his work, "the essence of the acquisition of secondary meaning is the impact upon the public mind."²⁶⁷

Comparing *DC Comics*²⁶⁸ with *Jackson*, there does not seem to be

260. *Id.* at 991.

261. *Id.*

262. The other factors that the court considered were the advertising expenditures of the defendant, the extent of the distribution of defendant's novel, and the amount of novels sold. *Id.* at 990-91.

263. 36 Cal. 2d 116, 222 P.2d 433 (1950).

264. *Id.* at 118-19, 222 P.2d at 434-35.

265. *Id.* at 123, 222 P.2d at 437 (citing 1 NIMS, UNFAIR COMPETITION AND TRADEMARKS § 38a, at 162 (4th ed. 1947)).

266. *Id.* at 122, 222 P.2d at 437.

267. *Id.* at 123, 222 P.2d at 437 (citing 1 NIMS, UNFAIR COMPETITION AND TRADEMARKS § 38a, at 162 (4th ed. 1947)). See also *Colvig v. KSFO*, 224 Cal. App. 2d 357, 36 Cal. Rptr. 701 (1964) where the court stated that, "[a] name or designation has a secondary meaning when it has been used so long or in such a way that the public has come to associate it with the person using it . . ." *Id.* at 368, 36 Cal. Rptr. at 708.

268. 465 F. Supp. 843 (S.D.N.Y. 1978). See *supra* text accompanying notes 240-46 for a discussion of this case.

any difference in what is required for use in New York as compared to California. Both jurisdictions require an amount of use sufficient for the title to acquire secondary meaning. Although the plaintiff in *DC Comics* used its title much more extensively than the plaintiff in *Jackson*, in appropriate cases, New York courts similarly have found that two months is an adequate period of use to acquire secondary meaning.²⁶⁹

a. Priority in Time

California courts reach different results when confronted with "priority of use"—state courts consider other factors involved, while the Ninth Circuit applies the rule strictly. In the California state court case of *Allied Artists Pictures Corp. v. Friedman*,²⁷⁰ the defendant's film, *The Journey of O*, was released in the United States in August 1975, prior to the release of the plaintiff's film, *The Story of O*, in November 1975.²⁷¹ However, in ruling that "[p]riority of use of a title does not of itself create a secondary meaning,"²⁷² the court did not find for the defendant. The court concluded that the plaintiff had acquired secondary meaning in its title²⁷³ and accordingly granted it relief.

269. *Hemingway v. Film Alliance of the United States*, 174 Misc. 725, 21 N.Y.S.2d 827 (1940) (Plaintiff's play was performed from March 5th to May 18th).

270. 68 Cal. App. 3d 127, 137 Cal. Rptr. 94 (1977).

271. However the activities from those whom the plaintiff acquired his rights occurred prior to the actions of the defendant: the novel "Histoire d'O" was published in France in the early 1950's, the English translation of the novel, "The Story of O," had been widely distributed in the United States since 1965, and the movie based on the novel was released in France in early 1975. *Id.* at 131, 137 Cal. Rptr. at 96. It may thus be said that the plaintiff's use was prior in time to the defendant's if one counted the activities of plaintiff's predecessors in interest.

272. *Allied Artists*, 68 Cal. App. 3d at 135, 137 Cal. Rptr. at 98 (citing *Gordon v. Warner Bros. Pictures, Inc.*, 269 Cal. App. 2d 31, 37-38, 74 Cal. Rptr. 499, 503 (1969)). In *Gordon*, the court found that the lower court's failure to instruct the jury that "mere priority of use does not create secondary meaning" was prejudicial error. *Gordon*, 269 Cal. App. 2d at 37-38, 74 Cal. Rptr. at 503. See also *Tomlin v. Walt Disney Prods.*, 18 Cal. App. 3d 226, 96 Cal. Rptr. 118 (1971) where the court stated that "[m]ere priority of use does not create or establish a 'secondary meaning' for a title." *Id.* at 237, 96 Cal. Rptr. at 124.

273. "It is unimportant that the secondary meaning resulted from the activities of persons other than Allied. The critical question is whether the secondary meaning had been established in the public mind and not the precise manner in which it was created." *Allied Artists*, 68 Cal. App. 3d at 135, 137 Cal. Rptr. at 98 (citing *Jackson v. Universal Int'l Pictures, Inc.*, 36 Cal. 2d 116, 123, 222 P.2d 433, 437 (1950); *Metro-Goldwyn-Mayer, Inc. v. Lee*, 212 Cal. App. 2d 23, 30, 27 Cal. Rptr. 833, 837 (1963); *United Artists Corp. v. Exodus Motion Picture Corp.*, 26 Misc. 2d 807, 808, 207 N.Y.S.2d 465, 466 (1960)). The *Allied Artists* court found secondary meaning in that the French version of the movie was widely advertised, reviewed and distributed in France; the English version of the book was widely distributed in the United States; the plaintiff had paid \$400,000 for the distribution rights to the movie which was well received and attended; and the plaintiff had spent \$250,000 in advertising and planned to spend another \$1,500,000 for future advertising. *Id.* at 131-32, 137 Cal. Rptr. at 96-97.

The Ninth Circuit reaches a markedly different result than California state courts. In *Walt Disney Productions v. Kusan, Inc.*,²⁷⁴ the plaintiff acquired the trademark and rights associated with a board game entitled "The Black Hole" to be used as part of its merchandising plan in connection with the release of its film of the same title.²⁷⁵ Disney's predecessor in interest had previously shipped the game all over the United States in September 1978.²⁷⁶ The plaintiff's film, *The Black Hole*, was heavily advertised from October 1978 until its release date of December 1979. Defendant, who owned a board game called "Black Hole in Space," shipped a prototype of its game in interstate commerce to its representatives in April 1978.²⁷⁷ In both September and October 1978, defendant was put on notice of plaintiff's intended use of the name for its board game.²⁷⁸ In April 1979, after receiving plaintiff's March 1979 cease and desist letter, the defendant shipped its game in interstate commerce to establish priority of use.²⁷⁹

Although defendant's use of the name "Black Hole in Space" for its board game was seemingly prior to plaintiff's, the court held that the defendant's use of the name was not public and therefore was not prior to the plaintiff's first public use of its name.²⁸⁰ The court stated that a "first user of trademark has a prior legal right in that mark and may therefore prevent subsequent users from employing a similar mark which is likely to cause public confusion."²⁸¹ The court further qualified this rule by stating that substantially greater use does not entitle the party to an injunction if its use was not prior in time.²⁸²

Comparing New York and the Second Circuit with California and the Ninth Circuit, it is almost impossible to reconcile the cases, or establish a clear rule. As was previously stated,²⁸³ courts are split—not necessarily by jurisdiction—as to whether priority of use is a requirement. It may be that courts use the rule merely to bolster the acquisition of second-

274. 204 U.S.P.Q. (BNA) 284 (C.D. Cal. 1979).

275. *Id.* at 285.

276. *Id.*

277. *Id.*

278. *Id.* at 286. There was an article in *Playthings* magazine announcing the forthcoming availability of the Disney game, as well as a *Los Angeles Times* newspaper clipping concerning the plaintiff's movie. *Disney*, 204 U.S.P.Q. (BNA) at 286.

279. *Id.* at 286.

280. *Id.* at 287. See *supra* note 230 for a discussion of what constitutes "public use."

281. *Id.* at 286. See also *New West Corp. v. NYM Co. of Cal.*, 595 F.2d 1194, 1201 (9th Cir. 1979) where the court stated that the defendant had the right to use the trademark because of its prior use of the mark in interstate commerce.

282. *Disney*, 204 U.S.P.Q. (BNA) at 288.

283. See *supra* text accompanying notes 231-37.

dary meaning in an already strong case;²⁸⁴ or, priority of use may simply be a way to establish who owns a title when both parties have established secondary meaning in their titles through other factors.

E. Advertising

Advertising serves a dual function in the establishment of secondary meaning. First, it is a factor that the court considers in evaluating whether a title has acquired secondary meaning²⁸⁵—it is a vehicle by which the producer creates an impression in the public mind that the title belongs to him. Second, advertising can create the use necessary for protection of one's mark. Evidence of the *amount of money* spent by the producer in advertising his or her title is relevant, yet not conclusive, in determining secondary meaning.²⁸⁶ If one has spent a lot of money, courts may infer that the title of the work has become associated in the public mind with its source, yet this is not always true.²⁸⁷ The *nature and extent* of advertising is important because a nationwide advertising campaign will expose a greater number of people to the title, while a local advertisement may attract only a few people.²⁸⁸

1. New York/Second Circuit

In *Brown v. Lyle Stuart, Inc.*,²⁸⁹ the court enjoined the defendants from using the title "Sex and the Single Man" as the title to their movie, because the plaintiffs had embarked on an extensive and costly advertising and promotional campaign publicizing their movie, *Sex and the Single Girl*, based on their book of the same name.²⁹⁰ The court, however,

284. See generally *Thomas Nelson, Inc. v. Cherish Books Ltd.*, 595 F. Supp. 989 (S.D.N.Y. 1984).

285. See generally *Atlantic Monthly Co. v. Frederick Ungar Pub. Co.*, 197 F. Supp. 524 (S.D.N.Y. 1961) where the plaintiff had spent over \$6,000,000 in advertising its magazine *Atlantic Monthly* between 1927 and 1960, and from 1950 to date, the annual amount spent in advertising averaged \$250,000. In *Patten v. Superior Talking Pictures, Inc.*, 8 F. Supp. 196 (S.D.N.Y. 1934) the title "Frank Merriwell" had acquired secondary meaning, in part because of the wide advertisement of the name, costing in total \$500,000, by means of circulars, booklets, display pictures and prize contests. Likewise, in *Klaw v. General Film Co.*, 154 N.Y.S. 988 (N.Y. Sup. Ct.), 156 N.Y.S. 1128 (Sup. Ct. App. Div. 1915), the court found secondary meaning because of more than four years of extensive advertising in association with the plaintiff's play "A Fool There Was."

286. MCCARTHY, *supra* note 152, § 15:19, at 699.

287. *Id.*,

288. *Id.*,

289. 42 Misc. 2d 909, 249 N.Y.S.2d 370 (1964).

290. See generally *Amusement Sec. Corp. v. Academy Pictures Distrib. Corp.*, 162 Misc. 608, 294 N.Y.S. 279 (1936), *modified & aff'd*, 251 A.D. 227, 295 N.Y.S. 436 (N.Y. App. Div. 1937) (the title "Zombie" acquired secondary meaning because large sums of money spent by

denied plaintiffs' request for an injunction against publication of defendants' book with that title for two reasons: (1) the defendants had also spent large sums of money in publishing and advertising their book and (2) the court determined that the plaintiffs had already benefitted from sales of the book "Sex and the Single Girl."²⁹¹

Although advertising helps to establish secondary meaning, the court in *Litwin v. Maddux*²⁹² reached a different result. The plaintiff in *Litwin* spent time and money to advertise his book, "The Green Kingdom," yet the court stated that

[a] secondary meaning comes gradually and the Court does not think that it can be acquired overnight by intensive advertising, and mere advertising over a period of time is insufficient to show that a secondary meaning had been acquired, since the criterion is the achievement of a result rather than the effort expended to achieve the result.²⁹³

Plaintiff was not granted an injunction because the court doubted that the title, "The Green Kingdom," was adequately advertised over an appropriate period of time to associate it, in the public mind, with the plaintiff's book.²⁹⁴ Because this case was decided when the methods of advertising were not as sophisticated as they are today, it cannot be given much weight in this regard. In today's society, where it may only take days or weeks of advertising to saturate the public mind with the title of the work, secondary meaning may come more quickly than is indicated in *Litwin*.

a. *Pre-release Advertising*

The Second Circuit held that even *pre-release* advertising may be sufficient to give a title secondary meaning.²⁹⁵ In *Orion Pictures Co. v.*

plaintiff in advertising and promoting the picture caused it to be a big box office and financial success).

291. *Brown*, 42 Misc. 2d at 912, 249 N.Y.S.2d at 374.

292. 7 Misc. 2d 750, 164 N.Y.S.2d 489 (1957).

293. *Id.* at 761, 164 N.Y.S.2d at 500 (citing *DuPont Cellophane Co. v. Waxed Prods. Co.*, 85 F.2d 75 (2d Cir.), *cert. denied*, 299 U.S. 601 (1936)).

294. *Id.* at 761, 164 N.Y.S.2d at 500.

295. "[E]ven if the work has not been released, a sufficient amount of pre[-]release publicity of the title may cause the title to acquire recognition sufficient for protection." *Orion Pictures Co. v. Dell Pub. Co.*, 471 F. Supp. 392, 396 (S.D.N.Y. 1979) (citing 1 J.T. MCCARTHY, TRADEMARKS AND UNFAIR COMPETITION § 10:4, at 277 (1973)). *But see*, *Walt Disney Prods., Inc. v. Souvaine Selective Pictures, Inc.*, 98 F. Supp. 774 (S.D.N.Y.), *aff'd*, 192 F.2d 856 (2d Cir. 1951) where the court implied that the expenditure of great sums of money in production and advertising was not sufficient to give a title secondary meaning and thus gave producers no right to enjoin a movie under the same title which was produced by the defend-

Dell Publishing Co.,²⁹⁶ the plaintiff embarked on an extensive pre-release campaign, total expenditures estimated at \$4,000,000, to give the movie title *A Little Romance* secondary meaning. The defendant acquired the English translation and publication rights to the French book upon which the plaintiff's movie was based. The book was originally titled "*E=MC², Mon Amour*," however the defendant changed the title to "A Little Romance" after learning that the plaintiff intended to release its film under this name.²⁹⁷ The plaintiff and defendant attempted to arrange a tie-in agreement between the release of the book and the movie, yet were unsuccessful because plaintiff's screenplay was no longer similar to the book due to rewriting and alterations in the storyline of the film.²⁹⁸ Defendant, nonetheless, continued with its use of the title, "A Little Romance," and even stated on the cover of the novel, "NOW A MAJOR MOTION PICTURE."²⁹⁹

The court enjoined the defendant from further use of the title or other representations which stated a greater relationship between the plaintiff's movie and the defendant's book than actually existed.³⁰⁰ The court also found that even if secondary meaning had not been firmly established, this would not prevent relief because "secondary meaning 'in the making' should be protected, at least to the extent of preventing intentional attempts . . . to capitalize on the efforts and goodwill of others."³⁰¹ Although this concept of "secondary meaning in the making" does not seem consistent with the rule that secondary meaning must be established prior to protection, it may be dismissed as merely dictum because the court in *Orion* noted that the plaintiff's title had, in fact, acquired secondary meaning.³⁰²

ants at less expense and which was less widely advertised. *Walt Disney*, 98 F. Supp. at 775. The court seemingly based this decision on the fact that the copyright to the book "Alice in Wonderland" had expired and therefore the work was in the public domain and could not acquire secondary meaning. The Court of Appeal affirmed the decision, even with the assumption that words in the public domain could acquire secondary meaning, because the plaintiffs had failed to prove secondary meaning had attached to their work. *Walt Disney*, 192 F.2d at 857-58.

296. 471 F. Supp. 392 (S.D.N.Y. 1979).

297. *Id.* at 393.

298. *Id.*

299. *Id.* at 394.

300. *Id.* at 397.

301. *Orion*, 471 F. Supp. at 396.

302. MCCARTHY, *supra* note 152, § 15:21, at 704-06. The Seventh Circuit specifically disapproved of the idea of "secondary meaning in the making" in *G. Heileman Brewing Co. v. Anheuser-Busch, Inc.*, 873 F.2d 985, 999 (7th Cir. 1989). *But see Jolly Good Indus., Inc. v. Elegra Inc.*, 690 F. Supp. 227, 231 (S.D.N.Y. 1988); *Metro Kane Imports, Ltd. v. Federated Dep't Stores, Inc.*, 625 F. Supp. 313, 316 (S.D.N.Y. 1985), *aff'd sub nom. Metro Kane Imports, Ltd. v. Rowoco, Inc.*, 800 F.2d 1128 (2d Cir. 1986) where the courts noted the approval

In *Willpat Productions, Inc. v. Sigma III Corp.*,³⁰³ a different decision was reached. The plaintiff in *Willpat* advertised the title to its movie, *Thundering Wheels*, only during the filming of the movie at Atlanta International Raceway in late 1962. The movie was scheduled for release in the spring of 1964, after the issue of secondary meaning was determined at trial. The court found that this pre-release advertising was insufficient to create secondary meaning.³⁰⁴ The court did not hold that pre-release advertising in general was insufficient to create secondary meaning, only that the plaintiff in this case had failed to establish the necessary association in the public mind by reason of its meager advertising.

2. California/Ninth Circuit

The California court in *Johnston v. Twentieth Century-Fox Film Corp.*,³⁰⁵ relied heavily on advertising as a factor in the development of secondary meaning in a title.³⁰⁶ In that case, the plaintiff spent \$14,669.71 during a two year period advertising the title to his book, "Queen of the Flat Tops."³⁰⁷ The court, citing a long list of cases that considered advertising as a method of proving secondary meaning,³⁰⁸ found that the plaintiff's title had acquired secondary meaning.³⁰⁹

a. Pre-release Advertising

In *Metro-Goldwyn-Mayer, Inc. v. Lee*,³¹⁰ the plaintiffs were producers of a movie entitled *The Wonderful World of the Brothers Grimm*. The defendants were using this title as an element of their advertising campaign for their movie, *Grimm's Fairy Tales*. The plaintiffs' title was widely advertised in newspapers, magazines, and trade journals throughout the United States.³¹¹ The court found that, because of plaintiffs' extensive pre-release advertising campaign, the film title, *The Wonderful World of the Brothers Grimm*, had acquired secondary meaning even

the doctrine has received by other Second Circuit courts. If a court would even consider this doctrine, it must be noted that the plaintiff will have to prove that the defendant's actions were intentional in order to have a chance of being afforded relief when there is "secondary meaning in the making."

303. 227 F. Supp. 354 (S.D.N.Y. 1964).

304. *Id.* at 356.

305. 82 Cal. App. 2d 796, 187 P.2d 474 (1947).

306. *Id.* at 811, 187 P.2d at 483.

307. *Id.* at 800, 187 P.2d at 477.

308. *Id.* at 811, 187 P.2d at 483.

309. *Id.* at 813, 187 P.2d at 485.

310. 212 Cal. App. 2d 23, 27 Cal. Rptr. 833 (1963).

311. *Id.* at 26, 27 Cal. Rptr. at 834.

though the film itself was not yet completed.³¹² The court stated that "[u]se of another's advertising and publicity developments in a misleading manner is no less unfair than adopting a title or trademark which has come to be associated with its first user or his product, and accordingly is afforded protection within the law of unfair competition."³¹³

There are no apparent inconsistencies between New York and California in the courts' treatment of advertising and its effect on secondary meaning. A producer should advertise his or her title both prior to release of the work, and while it is being shown either in the theaters or on television. As most are quite aware, in today's society we are inundated with advertisements for movies which have scheduled releases months in advance. The advertisement for the movie *Back to the Future II* illustrates this concept perfectly: for months prior to the film's release, the campaign featured a billboard on Sunset Boulevard in Los Angeles which had a digital clock counting down the hours, minutes, and seconds until the film's opening, thus capturing the public's attention and securing the title in the public's mind.

F. Publicity—Unsolicited Media Coverage

Courts consider unsolicited media coverage as another factor in determining whether a title has become associated in the public mind with its source.³¹⁴ Unsolicited media coverage is an important factor because it indicates that the title is getting some recognition, though the efforts are not directly attributable to the producer.

1. New York/Second Circuit

In *Walker v. Time Life Films, Inc.*,³¹⁵ the court found that the amount of unsolicited media coverage presented was insufficient to find consumer association of the title, "Fort Apache," with the plaintiff as author.³¹⁶ The plaintiff wrote an autobiographical book entitled "Fort Apache" concerning his experiences patrolling the streets of the South

312. *Id.* at 30, 27 Cal. Rptr. at 837.

313. *Id.*

314. See generally *Allied Artists Pictures Corp. v. Friedman*, 68 Cal. App. 3d 127, 137 Cal. Rptr. 94 (1977) where the court found because of the publicity that the French film had received in France and the United States (reviewed in major publications) and the massive advertising campaign that the plaintiff had embarked on (\$250,000 spent in advertising to date and \$1,500,000 for future advertising) that the title "The Story of O" had acquired secondary meaning. *Id.* at 132, 137 Cal. Rptr. at 97.

315. 615 F. Supp. 430 (S.D.N.Y. 1985), *aff'd*, 784 F.2d 44, *cert. denied*, 476 U.S. 1159 (1986).

316. *Walker*, 615 F. Supp. at 440.

Bronx. The defendants produced a film entitled *Fort Apache, the Bronx* which was a fictional account of a police officer's search for the killer of two other members of his precinct. As evidence of unsolicited media coverage, the plaintiff offered three isolated, insignificant, and in one case unrelated, newspaper articles which credited him as the author of both the book and the film.³¹⁷

A like result was reached in *Motown Productions, Inc. v. Cacomm, Inc.*,³¹⁸ where the court considered, as one of the factors in determining secondary meaning, the unsolicited media coverage of the defendant's title, "Nightlife." However, the court found that the evidence presented—three items which were the result of a press release put out on defendant's behalf—occurring twenty-one months prior to the airing of plaintiff's television show, was inadequate to show that secondary meaning was acquired.³¹⁹

2. California/Ninth Circuit

In *Jackson v. Universal International Pictures, Inc.*,³²⁰ the California Supreme Court recognized that even negative publicity could create secondary meaning in a title.³²¹ In addition to the publicity in large circulation magazines and newspapers, which was the result of efforts by plaintiff's press agent, the play, "Slightly Scandalous," received unfavorable reviews by drama critics.³²² For example, in New York, the play was publicized in ten newspapers, and was criticized by all. Agreeing with the plaintiff's assertion that although a play is unpopular or disliked by the critics, the title can become imbedded in the minds of the public due to the unfavorable comments it has received,³²³ the court found that the title had obtained secondary meaning.³²⁴ The court stated that a literary title need not be popular to acquire secondary meaning, "because notoriety and adverse discussion may bring about widespread identification of the play by its title and may pique the public interest."³²⁵

In a Ninth Circuit case, *Columbia Pictures Industries, Inc. v. Embassy Pictures*,³²⁶ the plaintiff, owner of the copyright to the movie *Blue*

317. *Id.*

318. 668 F. Supp. 285 (S.D.N.Y. 1987), *rev'd on other grounds*, 849 F.2d 781 (2d Cir. 1988).

319. *Motown*, 668 F. Supp. at 289.

320. 36 Cal. 2d 116, 222 P.2d 433 (1950).

321. *Id.* at 122, 222 P.2d at 437.

322. *Id.* at 119, 222 P.2d at 435.

323. *Id.* at 121, 222 P.2d at 436.

324. *Id.* at 122, 222 P.2d at 437.

325. *Jackson*, 36 Cal. 2d at 122, 222 P.2d at 437.

326. 218 U.S.P.Q. (BNA) 497 (C.D. Cal. 1982).

Lagoon, sought to enjoin the advertising of defendant's film *Paradise*.³²⁷ The court found that reviews by movie critics, commenting on the similarity of the advertising for the two films, were insufficient to prove that plaintiff's print advertisement had achieved secondary meaning.³²⁸

Both California and New York courts recognize that secondary meaning can be achieved, in part, because of unsolicited media coverage of the work, or its title. As a general rule, the exposure must not be sought out by the producer—it must be “unsolicited.” The issue is how much coverage is required. According to *Walker, Motown*, and *Columbia Pictures*, a few reviews, or comments made in newspapers or magazines, are probably not sufficient. However, the reviews need not be favorable, as was demonstrated by *Jackson*. Thus, a producer should present evidence of *any* unsolicited press coverage in his or her attempt to prove that the title has acquired an identification with its source in the public mind.

G. Segment of the Population—Does Size Matter?

The segment of the population familiar with the producer's title is an important factor in determining secondary meaning. The *public's* familiarity with the title—and not that of people in the entertainment industry—is considered.³²⁹ The size of the segment of the public that must recognize the work as that of the claimant has not been precisely defined. Generally, courts consider the branch of the purchasing public familiar with the plaintiff's trade.³³⁰

1. New York/Second Circuit

In *Hemingway v. Film Alliance of the United States, Inc.*,³³¹ the plaintiffs succeeded in preventing the defendants from using “Fifth Column Squad” as the title for their movie. The plaintiffs' play, “The Fifth Column,” only played in New York for two months. Nonetheless, the court found that the title had acquired secondary meaning.³³² The court identified the requisite segment of the population that must be familiar with the plaintiffs' play title as the “theatre-going public.”³³³ Thus, it

327. *Id.* at 497. The plaintiff's claims were based on copyright infringement, trademark dilution, and unfair competition. *Id.*

328. *Id.* at 500.

329. Angel, *Legal Protection for Titles in the Entertainment Industry*, 52 S. CAL. L. REV. 279, 289 (1979).

330. *Id.* at 289.

331. 174 Misc. 725, 21 N.Y.S.2d 827 (1940).

332. *Id.* at 726, 21 N.Y.S.2d at 828.

333. *Id.*

was only necessary for those people who went to the theater to identify the title with the plaintiff's work, such that this group would believe that a motion picture with a similar title was based on the play.³³⁴

2. California/Ninth Circuit

*Jackson v. Universal International Pictures, Inc.*³³⁵ is a California Supreme Court case in which secondary meaning was proven, although only a small number of people actually saw the plaintiff's work. In *Jackson*, only about 3,750 people saw the plaintiff's play. Yet, the court found this small segment of the public sufficient in determining whether the title, "Slightly Scandalous," had acquired secondary meaning.³³⁶ The court stated that "[t]he precise size of this segment of the public . . . does not determine whether the title has acquired a secondary meaning."³³⁷ The court further refined the phrase "segment of the population" by stating that in using the word "public" the court did not mean all or most of the people of a place, but as many which would distinguish them from a few.³³⁸

As long as a producer can show that there is an audience who associates the title with its source, he or she has satisfied the "segment of the population" requirement. This audience must consist of members of the public who attend the movies or watch television.³³⁹

II. SUMMARY OF SECONDARY MEANING

The New York/Second Circuit requirements for protection of a single literary title can be summarized as: (1) the public must associate the work with its producer, (2) the use of the title must be continuous, (3) priority of the use of the title is not important, (4) a sufficient amount of pre-release advertising can create secondary meaning, (5) unsolicited me-

334. *Id.*

335. 36 Cal. 2d 116, 222 P.2d 433 (1950).

336. *Id.* at 122, 222 P.2d at 437. The court also noted that although only this amount of people saw the play, this did not necessarily account for those who saw the advertising and read the reviews. *Id.*

337. *Id.*, cited with approval in *Metro-Goldwyn-Mayer, Inc., v. Lee*, 212 Cal. App. 2d 23, 27 Cal. Rptr. 833 (1963).

338. *Id.* at 122, 222 P.2d at 437 (citing *Mary Pickford Co. v. Bayley Bros., Inc.*, 12 Cal. 2d 501, 514, 86 P.2d 102, 108 (1939)). See also *Allied Artists Pictures Corp. v. Friedman*, 68 Cal. App. 3d 127, 137 Cal. Rptr. 94 (1977) where the segment of the population that needed to associate "The Story of O" with the book it entitled was "[t]hat element of United States society that reads such material." *Id.* at 134, 137 Cal. Rptr. at 98.

339. See *Fishler v. Twentieth Century-Fox Film Corp.*, 159 F. Supp. 215, 218 (S.D. Cal. 1958). Only people who associated the title "Virgin Queen" with plaintiff's play were the plaintiffs and their agents. *Id.*

dia coverage of the title can be used as evidence of secondary meaning, and (6) the segment of the population that must identify the work with its producer is that group which is familiar with the producer's trade.

The general requirements for protection of a single literary title in California/Ninth Circuit are: (1) the public must identify the title with the work it names, (2) the duration of use of the title need only be sufficient for the title to acquire secondary meaning, (3) priority of use of the title is not a requirement in state courts, yet is a necessity in federal courts, (4) pre-release advertising of the title can be used as evidence of secondary meaning, (5) negative publicity can create secondary meaning, and (6) the segment of the population that must associate the title with the work can be relatively small.

Although secondary meaning and likelihood of confusion³⁴⁰ are separate issues, courts often consider them together. If the public is confused as to the source of the title, it must follow that the title has acquired secondary meaning.³⁴¹ The converse is also true—there would be no confusion if there was no secondary meaning because the public would not be familiar with the source of the title in the first place. Thus, it is possible that one could use proof of public confusion as to source as evidence of secondary meaning.³⁴² The next section discusses how one can prove "likelihood of confusion" and thus prevent another producer from using a title that is protected—or contrarily, how a producer can show that there is no confusion and thus be able to use a title similar to one already in existence.

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340. See *infra* text accompanying notes 520-34 for a discussion of what is needed to prove infringement of a protected title.

341. MCCARTHY, *supra* note 152, § 15:3, at 666.

342. An example of how courts combine the two issues can be seen in their treatment of the intent of the "wrongdoer." Most courts consider the intent of the alleged infringer in regard to likelihood of confusion, but the court in *National Lampoon, Inc. v. American Broadcasting Cos.*, 376 F. Supp. 733 (S.D.N.Y.), *aff'd*, 497 F.2d 1343 (2d Cir. 1974) stated that "[d]eliberate 'passing off' is not only evidence of likelihood of confusion, but of secondary meaning as well." *National Lampoon*, 376 F. Supp. at 747 (citing *Mortellito v. Nina of California, Inc.*, 335 F. Supp. 1288, 1295 (S.D.N.Y. 1972)), *cited with approval in*, *Orion Pictures Co. v. Dell Pub. Co.*, 471 F. Supp. 392 (S.D.N.Y. 1979). The *Orion* court stated that "it is clear from the defendant's own . . . advertising . . . that the defendant was counting on the plaintiff's publicity as the primary means by which to promote the sale of the book." *Orion Pictures*, 471 F. Supp. at 396.

PART III: LIKELIHOOD OF CONFUSION

I. INTRODUCTION

Unfair competition has been called "the child of confusion."³⁴³ It earned this epithet because likelihood of confusion plays an important role in determining the outcome of an action based on unfair competition. Courts repeatedly recognize the interdependence between the elements of likelihood of confusion and secondary meaning, which the plaintiff must prove to get relief in most jurisdictions.³⁴⁴

Although likelihood of confusion and secondary meaning may be difficult to distinguish, they are two separate legal issues.³⁴⁵ Likelihood of confusion refers to a situation where "the public will be misled into believing that defendants' work originated or is associated with or sponsored by plaintiff because both works bear the same title."³⁴⁶ Titles which are similar, although not identical may cause confusion and have also received protection.³⁴⁷ When a title acquires secondary meaning, confusion is more likely to exist.³⁴⁸ "Secondary meaning is a shorthand phrase which describes the existence of conditions from which public confusion will flow if the defendant is permitted to pursue his deceptive scheme."³⁴⁹

As will be illustrated, likelihood of confusion is essential to a claim for unfair competition. The Restatement of Torts lists the following factors to consider in determining if likelihood of confusion exists:

- (a) the degree of similarity between the product of the plaintiff and the defendant in
 - i) appearance;
 - ii) pronunciation of words used;
 - iii) verbal translation or pictures [] involved;
 - iv) suggestion;
- (b) the intent of the actor in adopting the designation;
- (c) the relation in use and manner of marketing between the

343. *Charcoal Steak House of Charlotte, Inc. v. Staley*, 263 N.C. 199, 203, 139 S.E.2d 185, 188 (N.C. Sup. Ct. 1964).

344. *See Metro-Goldwyn-Mayer, Inc. v. Lee*, 212 Cal. App. 2d 23, 30, 27 Cal. Rptr. 833, 837 (1963).

345. *Levi Strauss & Co. v. Blue Bell, Inc.*, 632 F.2d 817, 821 (9th Cir. 1980).

346. *Davis v. United Artists, Inc.*, 547 F. Supp. 722, 728 (S.D.N.Y. 1982).

347. *See generally Allied Artists Pictures Corp. v. Friedman*, 68 Cal. App. 3d 127, 137 Cal. Rptr. 94 (1977); *Brown v. Lyle Stuart, Inc.*, 249 N.Y.S. 2d 370, 42 Misc. 2d 909 (1964).

348. *Metro-Goldwyn Mayer, Inc. v. Lee*, 212 Cal. App. 2d at 30, 27 Cal. Rptr. at 837.

349. *Id.*

goods or services marketed by the actor and those marketed by the other; [and]

(d) the degree of care likely to be exercised by purchasers.³⁵⁰

The factors listed in the Restatement of Torts have been tailored for application to literary title protection. While courts place varying importance on specific "likelihood of confusion" factors when determining whether a competing title is likely to cause confusion, certain guidelines are available to the producer when choosing a title for his movie. In order to establish likelihood of confusion, the producer must look to the familiarity of the public with a specific title, not that of experts in his field.³⁵¹ To obtain damages, a producer must show that consumers have actually been confused by the defendant's use of the title. However, to obtain equitable relief a producer must simply show likelihood of confusion or deception;³⁵² he does not have to show that consumers have in fact been confused by defendant's choice of title.³⁵³

A. Actual Confusion

Actual confusion refers to incidents whereby the public is unable to distinguish between the products of the plaintiff and of the defendant.³⁵⁴ When the public associates a film title with a particular work, the use of the same or a similar title in connection with a different work may make it difficult to differentiate the two works. When one work is *in fact* mistaken for the other, there is actual confusion.

1. The Second Circuit/New York

In the 1980 case, *DC Comics, Inc. v. Filmation Associates*,³⁵⁵ the Second Circuit affirmed its longstanding rule that when the plaintiff seeks damages he must be able to show actual confusion between his product and defendant's. In that case, the court held that a "plaintiff cannot recover damages without proof that consumers who wished to buy plaintiff's product were actually misled into buying defendant's, or at least that consumers were actually confused as to the origin of the

350. THE RESTATEMENT OF TORTS § 729 (1938).

351. *See Ideal Toy Corp. v. Kenner Prods. Div. of Gen. Mills Fun Group, Inc.*, 443 F. Supp. 291, 306 (S.D.N.Y. 1977).

352. *Warner Bros., Inc. v. Gay Toys, Inc.*, 658 F.2d 76, 79 (2d Cir. 1981).

353. *Id.*

354. *See generally Amusement Sec. Corp. v. Academy Pictures Distrib. Corp.*, 294 N.Y.S. 279 (1936); *Allied Artists Pictures Corp. v. Friedman*, 68 Cal. App. 3d 144, 137 Cal. Rptr. 94 (1977).

355. 486 F. Supp. 1273 (S.D.N.Y. 1980).

products.”³⁵⁶

In *DC Comics*, the defendant created an animated television series featuring characters similar to characters marketed by the plaintiff in its own comic books—*Aquaman* and *Plastic Man*. Although the plaintiff proved likelihood of consumer confusion, actual confusion was not proved.³⁵⁷ The plaintiff testified that a woman told him that her children enjoyed watching his new show, indicating her confused belief that plaintiff produced defendant’s show. However, the court stated that a single isolated incident was not enough to show actual confusion of the viewing public in general, or of the audience for comic books.³⁵⁸ The fact that the plaintiff was trying to obtain damages as opposed to equitable relief was an important consideration in the outcome of this case. When a plaintiff seeks equitable relief, his chances for attaining a favorable judgment may increase where an incident of actual confusion is shown.³⁵⁹

In *Amusement Securities Corp. v. Academy Pictures Distributing Corp.*,³⁶⁰ the plaintiff produced a film entitled *White Zombie* and sought an injunction against the defendants’ exhibition of their film entitled *Revolt of the Zombies*. The court held that the presence of the word “Zombie” in both titles was likely to cause confusion.³⁶¹ In support of its holding, the court noted, among other things,³⁶² an instance of actual confusion.³⁶³ “In fact, one newspaper commentator actually referred to defendants’ picture as ‘White Zombie’ ”³⁶⁴ instead of “Revolt of the Zombies.” Although this was only an isolated instance, the actual confusion supported the claim for likelihood of confusion. Because the plaintiff was seeking equitable relief, rather than damages, the decision does not conflict with *DC Comics*.³⁶⁵

356. *Id.* at 1279 (citing *Perfect Fit Indus., Inc. v. Acme Quilting Co.*, 618 F.2d 950, 955 (2d Cir. 1980)).

357. *Id.*

358. *Id.* at 1280.

359. See *infra* text accompanying notes 360-65 for a discussion of *Amusement Sec. Corp. v. Academy Pictures Distrib. Corp.*

360. 294 N.Y.S. 279, 162 Misc. 608 (1936).

361. *Id.* at 294.

362. See *infra* text accompanying notes 379-83 for a discussion of *Amusement Securities Corp. v. Academy Pictures Distrib. Corp.*

363. *Amusement Sec. Corp. v. Academy Pictures Distrib. Corp.*, 294 N.Y.S. 279 at 294, 162 Misc. 608 at 622.

364. *Id.*

365. See *supra* note 344 and accompanying text.

2. The Ninth Circuit/California

In *Allied Artists Pictures Corp. v. Friedman*,³⁶⁶ the California Court of Appeal looked to an instance of actual confusion to support a claim for likelihood of confusion, in order to grant the plaintiff relief. In *Allied Artists*, damages were not at issue, but proof of actual confusion was used to bolster the claim for equitable relief.³⁶⁷

Although the Ninth Circuit has not spoken to the issue of whether actual confusion is required before damages are available, the other courts are in accord concerning the element of actual confusion. When a plaintiff seeks damages, a showing of actual confusion is required. In contrast, if an equitable remedy is sought, a showing of likelihood of consumer confusion will be enough to obtain relief.

B. Intent of Defendant—Misuse of Titles/Advertising

Another factor courts consider is a defendant's purpose for using a particular title or advertising scheme. When a defendant chooses a title, or markets his film, knowing that consumers are likely to be confused, the courts may equate this knowledge with bad faith or misuse.³⁶⁸ When a title is associated with a particular work, a defendant's subsequent use of that title to capitalize on its prior successes, is evidence of defendant's intent or misuse.

1. The Second Circuit/New York

In *Orion Pictures Co. v. Dell Publishing Co.*,³⁶⁹ the Second Circuit focused on the defendant's bad faith as a means of determining relief. In that case, the plaintiff decided to produce and distribute a film based upon the popular European book "E=MC², Mon Amour."³⁷⁰ During production and pre-release, the motion picture, which was to be retitled *A Little Romance*, received a lot of attention in the trade papers.³⁷¹ Subsequently, the defendant, who knew of the upcoming Orion film, acquired the paperback publication rights to the book.³⁷² Initial negotiations regarding a proposed tie-in agreement between the film and

366. 68 Cal. App. 3d 127, 137 Cal. Rptr. 94 (1977). See *infra* text accompanying notes 412-18 for discussion of facts.

367. 368 Cal. App. 3d at 136, 137 Cal. Rptr. at 99 (1977).

368. *HMH Pub. Co. v. Brincat*, 504 F.2d 713, 720 (9th Cir. 1974) (citing *Fleishman Distilling Corp. v. Maier Brewing Co.*, 314 F.2d 149, 158 (9th Cir. 1963)).

369. 471 F. Supp. 392 (S.D.N.Y. 1979).

370. *Id.* at 393.

371. *Id.*

372. *Id.*

the paperback fell through because the plaintiff felt that the screenplay strayed considerably from the original book. Nonetheless, the defendant chose not to use the novel's original title on the paperback version, but instead used the plaintiff's title "A Little Romance," without the plaintiff's permission.³⁷³

The court found that the defendant published the paperback version of the book to exploit the publicity and interest generated by the plaintiff's film.³⁷⁴ Additionally, the defendant explicitly advertised its novel as the same work as the plaintiff's film. The inscription on the book read "NOW A MAJOR MOTION PICTURE."³⁷⁵ Furthermore, the art on the jacket of the paperback resembled the stars of the film. The court found that a purchaser would assume that the book closely resembled the film.³⁷⁶ "The defendant's book, by virtue of its title and inscription, gives the impression that it is the 'official' novel version of the film, and therefore highly similar in content to it."³⁷⁷ By promoting that impression the defendant increased the likelihood of confusion and misled the public.³⁷⁸

Likewise, the court in *Amusement Securities Corp. v. Academy Pictures Distributing Corp.*,³⁷⁹ held that the presence of the word "Zombie" in the defendants' title "Revolt of the Zombies" was likely to cause confusion with the plaintiff's title "White Zombie." Additionally, the court found defendants' advertising scheme was unconscionable.³⁸⁰ The defendants virtually reproduced the advertising material used for "White Zombie."³⁸¹ Although the two films were not linked by their stories or characters, the defendants' advertised their film as a "sequel" to "White Zombie."³⁸² The court stated that the defendants, "under a colorable imitation of plaintiff's title[,] will appropriate the good will inherent in that name."³⁸³

2. The Ninth Circuit/California

The Ninth Circuit also considers the defendant's intent to deceive the public when evaluating the likelihood of confusion.³⁸⁴ Although a

373. *Id.* at 394.

374. 471 F. Supp. at 396.

375. *Orion*, 471 F. Supp. at 394.

376. *Id.* at 397.

377. *Id.*

378. *Id.*

379. 294 N.Y.S. 279, 162 Misc. 608 (1936).

380. *Id.* at 294-95, 162 Misc. at 622.

381. *Id.* at 295, 162 Misc. at 622.

382. *Id.*

383. *Id.* at 294, 162 Misc. at 622.

384. *See* *HMH Pub. Co., Inc. v. Brincat*, 504 F.2d 713 (9th Cir. 1974).

plaintiff need not prove defendant's intent to mislead the public, to obtain relief, "where such intent has been shown, the 'inference of likelihood of confusion is readily drawn'. . . ." ³⁸⁵

In *Metro-Goldwyn-Mayer, Inc. v. Lee*, ³⁸⁶ the California court held that the defendants' advertising slogan was likely to cause confusion with the plaintiffs' film. The plaintiffs produced a film entitled *The Wonderful World of the Brothers Grimm*, which was based on the lives of the Grimm brothers, who are public domain characters. ³⁸⁷ The plaintiffs publicized the title of their soon-to-be released film and chose their title hoping to distinguish their film from other works derived from the same source.

The defendants intended to release a film entitled *Grimms Fairy Tales*, which was also based on the life of the Grimm brothers. To advertise their film the defendants placed an ad in *The Hollywood Reporter*, which read, "A WONDERFUL WORLD OF THE GRIMM BROTHERS is depicted in Grimm Brothers 'GRIMMS FAIRY TALES'" ³⁸⁸ The court analogized defendants' misuse of advertising to the misuse of titles and stated that "[u]se of another's advertising and publicity developments in a misleading manner is no less unfair than adopting a title . . . which has come to be associated with its first user or his product" ³⁸⁹

The state and federal courts in New York and California agree that when bad intent on the part of the defendant can be demonstrated, there will be a greater likelihood of confusion. The courts are particularly sensitive to a plaintiff's claim of likelihood of confusion, when a defendant intentionally misleads the public. Through his deceit, defendant creates a presumption of confusion.

C. Competing Markets and Media

Often the title of a film is borrowed from a work in another media, for example, a song, book, or play. Early cases held that claims of unfair competition could not be upheld in the face of non-competing markets. ³⁹⁰ The rationale was that the general public would not be misled into buying a movie ticket, simply because the movie had the same title

385. *Id.* at 720 (citing *Fleischmann Distilling Corp. v. Maier Brewing Co.*, 314 F.2d 149, 158 (9th Cir. 1963)).

386. 212 Cal. App. 2d 23, 27 Cal. Rptr. 833 (1963).

387. *See infra* text accompanying notes 495-519.

388. *Metro-Goldwyn-Mayer*, 212 Cal. App. 2d at 26, 27 Cal. Rptr. at 835.

389. *Id.* at 30, 27 Cal. Rptr. at 837.

390. *Altas Mfg. Co. v. Street & Smith*, 204 F. 398, 402 (8th Cir.), *cert. denied*, 231 U.S. 755 (1913); *Underhill v. Schenck*, 238 N.Y. 7, 21, 143 N.E. 773, 778 (1924).

as a book.³⁹¹ However, the early decisions did not contemplate that the public might go to see a movie because they believed it was based on a book with the same title.³⁹² In response to this problem many courts now grant protection to a motion picture title when it is based on a book of the same title, against a competing motion picture with the same or a similar title.³⁹³ In contrast, courts have been less apt to grant protection for competing books.³⁹⁴ The rationale for the dichotomy in protection is the belief that book buyers generally purchase books based on their authors, not their titles.³⁹⁵

1. The Second Circuit/New York

The Second Circuit addressed the similarity of markets in *Motown Productions, Inc. v. Cacomm, Inc.*³⁹⁶ The court found that in non-competing markets, the likelihood of confusion is diminished.³⁹⁷

In *Brown v. Lyle Stuart, Inc.*,³⁹⁸ the plaintiffs, who owned the motion picture rights to their book "Sex and the Single Girl" sought to prevent the defendants from using the title "Sex and the Single Man" for a book or movie.³⁹⁹ The court enjoined the defendants from using their title for a motion picture, but allowed them to retain it for the book.⁴⁰⁰

Plaintiffs argued that the public had become familiar with their book and the emergence of a book or motion picture under defendants' title would confuse the purchaser or moviegoer.⁴⁰¹ To determine likelihood of public confusion, the court asked whether "the two titles [are] so similar that the public will be confused and thus defendants will reap the benefit of plaintiffs' labor and large expenditures in advertising the book and motion picture?"⁴⁰² The court determined that the books were sufficiently different to avoid public confusion.⁴⁰³ However, the court did

391. E.L., Perry, *Protecting Literary Titles*, 12 NEW MATTER 1, 7 (1987) [hereinafter Perry].

392. *Id.*

393. *Id.*

394. *Brown v. Lyle Stuart, Inc.*, 249 N.Y.S.2d 370, 374, 42 Misc. 2d 909, 911 (1964).

395. *Id.* at 374, 42 Misc. 2d at 911, (citing S.P., LADAS, *THE INTERNATIONAL PROTECTION OF LITERARY AND ARTISTIC PROPERTY*, 738 (1938)).

396. 668 F. Supp. 285 (S.D.N.Y. 1987), 849 F.2d 781 (2nd Cir. 1988) (court heard issue of sanctions imposed on counsel); See also *infra* note 438 for a discussion of *Motown Prods., Inc. v. Cacomm, Inc.*

397. *Motown*, 668 F. Supp. 285 at 290-91.

398. 249 N.Y.S. 2d 370, 42 Misc. 2d 909 (Sup. Ct. 1964).

399. *Id.* at 372, 42 Misc. 2d at 910.

400. *Id.* at 374, 42 Misc. 2d at 912.

401. *Id.* at 372, 42 Misc. 2d at 910.

402. *Id.* at 373, 42 Misc. 2d at 911.

403. *Brown*, 249 N.Y.S. 2d at 373, 42 Misc. 2d at 911.

enjoin the defendants from using their title for a motion picture. In making that determination, the court took into account the amount of time and money expended by the plaintiffs, for production and promotion of its upcoming film.⁴⁰⁴ Additionally, the court viewed the book purchaser and moviegoer in a different light.

The cases decided in the United States indicate that the Courts are more ready to protect titles of plays and motion picture films under the law of unfair competition than titles of books. . . . The reason for this is that deception is easier in these cases, whereas in the case of books, stories, etc., the public gives greater attention to the name of the author than to the title of the work.⁴⁰⁵

2. The Ninth Circuit/California

In *Tomlin v. Walt Disney Productions*,⁴⁰⁶ the court focused on the dissimilarity of markets. In *Tomlin*, the plaintiff wrote and performed a copyrighted song, entitled *The Love Bug Will Bite You (If You Don't Watch Out)*.⁴⁰⁷ Plaintiff later entered into a standard contract with a publisher, assigning his rights to the piece, in exchange for royalties.⁴⁰⁸ A few years later, the defendant released a film entitled *The Love Bug*, which featured a Volkswagen "bug" with human characteristics.⁴⁰⁹ The court found that the litigants were not engaged in the same or competing businesses and that the plaintiff failed to present special circumstances from which confusion would result.⁴¹⁰ Additionally, the plaintiff failed to establish evidence of the defendant's intent to mislead or confuse the public.⁴¹¹

In *Allied Artists Pictures Corp. v. Friedman*,⁴¹² the court found the defendant's movie title sufficiently similar to the plaintiff's movie title to cause public confusion.⁴¹³ The plaintiff acquired the distribution rights to the French film *Histoire d'O*, which was based on the book of the same title. The plaintiff released the film in the United States under the angli-

404. *Id.* at 374, 42 Misc. 2d at 912.

405. *Id.*

406. 18 Cal. App. 3d 226, 96 Cal. Rptr. 118 (1971).

407. *Id.* at 229, 96 Cal. Rptr. at 119.

408. *Id.*

409. *Id.*

410. *Id.* at 238, 96 Cal. Rptr. at 125.

411. 18 Cal. App. 3d 226, 238, 96 Cal. Rptr. 118, 125 (1971).

412. 68 Cal. App. 3d 127, 137 Cal. Rptr. 94 (1977).

413. *Id.* at 136, 137 Cal. Rptr. at 99.

cized title *The Story of O*.⁴¹⁴ In the same year, the defendant acquired distribution rights to a low budget film entitled *The Journey of O*. This film was not based on the French book and the only similarity between the two was the sexual motif and the name of the main character, "O."⁴¹⁵ The plaintiff contended that viewers of the defendant's film would be confused by the similar titles.⁴¹⁶ One instance of actual confusion occurred where the trade paper, *Daily Variety* reported *The Journey of O's* earnings as those of *The Story of O's*.⁴¹⁷ Although defendant's film, *The Journey of O* was released first and was not based on the French book, the trial court required the "defendant to take reasonable steps to dispel the likelihood of confusion by including disclaimers in its advertising."⁴¹⁸ Thus, public confusion may arise from the use of similar as well as identical titles. Although not explicitly stated in the court's opinion, the fact that the similar titles were to be used in the same market probably weighed heavily in favor of granting the plaintiff relief.

There are no Ninth Circuit cases which address competing markets directly. However, it appears that the Ninth Circuit would agree with the other courts that relief will usually be granted when works with identical titles are used in competing markets. Relief may also be granted when similar titles are apt to cause confusion because the products are in competing markets. Relief is less likely to be granted when the markets are dissimilar, because the likelihood of confusion is reduced considerably. However, if a plaintiff can show pecuniary damage because of defendant's use of plaintiff's title, relief may be granted in non-competing markets.⁴¹⁹

D. Confusion as to Sponsorship

Confusion of sponsorship exists where the public knows that the plaintiff did not manufacture the defendant's product, but, the public may erroneously believe that the plaintiff sponsored the defendant's product. In other words a consumer may be misled into believing that the defendant's product is endorsed by the plaintiff. In these cases, the confusion which may develop is based on confusion of sponsorship rather than confusion of the source.⁴²⁰

414. *Id.* at 131, 137 Cal. Rptr. at 96.

415. *Id.*

416. *Id.* at 132, 137 Cal. Rptr. at 96.

417. 68 Cal. App. 3d 127, 136, 137 Cal. Rptr. 94, 99.

418. See *infra* text accompanying notes 629-35 for a discussion of disclaimers.

419. See *supra* note 410 and accompanying text.

420. Perry, *supra* note 391.

1. The Second Circuit/New York

In *Wyatt Earp Enterprises, Inc. v. Sackman, Inc.*,⁴²¹ the defendant's use of the name "Wyatt Earp" in association with its play clothes created a likelihood that the public would believe, erroneously, that its playsuits were authorized by the plaintiff, the producer of the successful television series entitled *The Life and Legend of Wyatt Earp*.⁴²² The program was televised across the nation by the American Broadcasting Company.⁴²³ The defendant manufactured children's play clothes, and at one time had a license agreement with the plaintiff to use "the name and likeness of Hugh O'Brian [the star of the series] in the characterization of Wyatt Earp."⁴²⁴ Upon expiration of that agreement, the defendant continued to manufacture its play clothes under the name of "Wyatt Earp."⁴²⁵ Although defendant did not use O'Brian's name or likeness, the reference to its product as the "official outfit" on the outfit's packaging implied sponsorship by the plaintiff.

The court held that use of a name, even upon non-competing goods, could be enjoined because consumer confusion as to sponsorship was established.⁴²⁶ The court was also swayed by the fact that the plaintiff entered into an agreement with another manufacturer to produce play clothes on a royalty basis, and therefore any purchases which defendant diverted from plaintiff's licensee had a direct pecuniary impact on plaintiff.⁴²⁷

In *Dallas Cowboys Cheerleaders v. Pussycat Cinema, Ltd.*,⁴²⁸ the plaintiff successfully enjoined a film company from distributing or exhibiting its X-rated motion picture *Debbie Does Dallas*, which depicted a young woman in the Dallas Cowboys Cheerleaders uniform.⁴²⁹ The Second Circuit held that likelihood of confusion was established because anyone who saw the film could not disassociate it from the actual Dallas Cowboys Cheerleaders.⁴³⁰ This association would cause confusion as well as injury to plaintiffs' reputation.⁴³¹ "In order to be confused, a consumer need not believe that the owner of the mark actually produced

421. 157 F. Supp. 621 (S.D.N.Y. 1958).

422. *Id.* at 625.

423. *Id.* at 623.

424. *Id.*

425. *Id.*

426. *Wyatt Earp*, 157 F. Supp. at 626.

427. *Id.*

428. 604 F.2d 200 (2d Cir. 1979).

429. *Id.* at 203.

430. *Id.* at 205.

431. *Id.*

the item and placed it on the market. The public's belief that the [Dallas Cowboys Cheerleaders] . . . sponsored or otherwise approved the use of the trademark satisfies the confusion requirement."⁴³²

2. The Ninth Circuit/California

In *Edgar Rice Burroughs, Inc. v. Manns Theatres*,⁴³³ the Ninth Circuit protected the plaintiff's trademark in the character "Tarzan" against defendants' use of a substantially similar mark in the title of its motion picture.⁴³⁴ The court found that defendants' use of the title "Tarz & Jane & Boy & Cheeta" was likely to cause public confusion. In reaching that conclusion the court looked to the following factors: (1) plaintiff and defendants directed their advertising to the same class of the purchasing public;⁴³⁵ (2) the character "Tarz" was substantially similar to the character "Tarzan" contained in copyrighted works owned by plaintiff; (3) the title of defendants' film contained a mark which was substantially similar to the registered trademarks owned by plaintiff; (4) the value of plaintiff's mark would be diluted since defendants' film was an X-rated film over which plaintiff had no control; and finally (5) that the use of the mark "Tarz" within defendants' film was likely to confuse viewers who may believe the film is produced or authorized by plaintiff.⁴³⁶

In both *Dallas Cowboys Cheerleaders*⁴³⁷ and *Edgar Rice Burroughs*, the court seemed to pay special attention to the plaintiff's reputation, which would be damaged if the public believed that plaintiff sponsored the X-rated film. Thus, both the Second and Ninth Circuits are more likely to find confusion as to sponsorship when there is a possibility of harm to the plaintiff's reputation.

E. Tests for Likelihood of Confusion

In addition to actual confusion, the intent of defendant, competing markets, and confusion as to sponsorship the courts have applied specific tests to determine whether there is a likelihood of public confusion. These tests include the "Polaroid test" and the "reasonable person standard."

432. *Id.* at 204-05 (citations omitted).

433. 195 U.S.P.Q. (BNA) 159 (C.D. Cal, 1976).

434. *Id.* at 162.

435. In other words, the defendants' advertising targeted the same group of people to whom plaintiff's advertising was directed.

436. *Edgar Rice Burroughs*, 195 U.S.P.Q. (BNA) at 161.

437. 604 F.2d 200 (2d Cir. 1979).

1. The Polaroid Test

In *Motown Productions, Inc. v. Cacomm, Inc.*,⁴³⁸ the plaintiff, who broadcast a television series entitled *Nightlife* sought a declaratory judgment to determine that the defendant, who was broadcasting a cable program entitled *Nightlife*, had no exclusive right to use of that title.⁴³⁹ The court followed the test outlined in *Polaroid Corp. v. Polarad Electronics Corp.*⁴⁴⁰ The "Polaroid test" consists of eight factors: (1) the weakness of defendant's mark; (2) the dissimilarity of the marks as used; (3) bridging the gap; (4) actual confusion; (5) good faith of the second user; (6) difference of quality in the products; (7) sophistication of the purchaser; and (8) the balance of hardships of granting the relief sought versus denying the relief.

Reviewing the eight elements, the *Motown* court found that use of both titles would not cause public confusion.⁴⁴¹ The court found that the defendant's mark was weak because the distribution of defendant's program was limited.⁴⁴² Moreover, there was no evidence that the public ever associated the title "Nightlife" with defendant's show.⁴⁴³

Under the second factor, the court found that the plaintiff had widely used the title "Nightlife" with a distinctive logo, while defendant had no logo.⁴⁴⁴ The court also noted that the difference in media was a significant factor.⁴⁴⁵ Defendant's program aired on a local cable station, while plaintiff's program was broadcast coast to coast by major networks.⁴⁴⁶

The court found no merit in defendant's argument, under the third factor, that it had always planned to carry its *Nightlife* into any available market.⁴⁴⁷ There was little likelihood that defendant would bridge the gap by entering the market occupied by plaintiff. As a result, the litigants were not in competing markets.⁴⁴⁸ As to the fourth factor, defendant conceded that there were no incidents of actual confusion.⁴⁴⁹

The plaintiff produced evidence that a title search was done to see if

438. 668 F. Supp. 285 (S.D.N.Y. 1987), *rev'd on other grounds*, 849 F.2d 781 (2d Cir. 1988)(Court heard issue of sanctions imposed on counsel).

439. *Motown*, 668 F. Supp. at 287.

440. 287 F.2d 492, 495 (2d Cir.), *cert. denied*, 368 U.S. 820 (1961).

441. *Motown*, 668 F. Supp. at 290-92.

442. *Id.* at 290.

443. *Id.*

444. *Id.* at 290-91.

445. *Id.*

446. *Motown*, 668 F. Supp. at 290-91.

447. *Id.* at 291.

448. *Id.*

449. *Id.*

the title "Nightlife" was available. Additionally, the plaintiffs were advised by three attorneys that their proposed title was in the public domain.⁴⁵⁰ According to the court, this demonstration of good faith was an important factor for plaintiff's case.⁴⁵¹

The defendant did not dispute the fact that the plaintiff's product was vastly superior to its own.⁴⁵² Therefore, under the sixth factor, the court found that defendant's reputation could not be tarnished by plaintiff's program.⁴⁵³

Another factor considered under the "Polaroid test" is the sophistication of the targeted consumers.⁴⁵⁴ The court found that an unsophisticated buyer would find it easy to distinguish plaintiff's expensive program from defendant's low budget program, especially in light of the fact that defendant's program was off the air for the thirteen months prior to the premiere of the plaintiff's show.⁴⁵⁵

Finally, the court balanced the hardships and determined that the scale weighed heavily in favor of the plaintiff, who had invested substantial amounts of time and money to produce its program.⁴⁵⁶ The court found that no concrete benefit would be conferred on the defendant if it were granted exclusive use of the title "Nightlife," while the burden to the plaintiff would be enormous.⁴⁵⁷ In sum, the court found that each of the *Polaroid* factors negated the conclusion that prudent purchasers were likely to be misled or confused as to the source of the programs.⁴⁵⁸

2. The Reasonable Person Standard

In *Shaw v. Time-Life Records*,⁴⁵⁹ the New York Court of Appeals applied a reasonable person standard. The court stated that the test of whether the public is confused as to identity is "whether persons exercising 'reasonable intelligence and discrimination' would be taken in by the similarity."⁴⁶⁰

In conclusion, courts look to a variety of factors, none of which are determinative, to find likelihood of confusion. The courts rely on their

450. *Id.*

451. *Motown*, 668 F. Supp. at 291.

452. *Id.*

453. *Id.*

454. *Id.* at 291-92.

455. *Id.*

456. *Motown*, 668 F. Supp. at 292.

457. *Id.*

458. *Id.*

459. 38 N.Y.2d 201, 379 N.Y.S.2d 390 (Ct. App. 1975).

460. *Id.* at 206, 379 N.Y.S.2d at 395.

tailored versions of particular elements outlined in the Restatement of Torts, for the starting point of their analyses. Evidence of actual confusion will inevitably lead to a determination that the public is likely to be confused, because there is proof that they have already been confused. If a defendant exhibits a bad faith intention in its choice of a title, the courts will follow defendant's lead. In other words, if a potential defendant chooses a title in hopes of capitalizing on the success of plaintiff's prior use of that title, the court will usually determine that defendant's intention to mislead the public will suffice to show a likelihood of confusion. When similar or identical titles are used in competing markets rather than non-competing markets, the courts are more likely to grant protection. If there is confusion as to sponsorship and the public is likely to believe that the plaintiff sponsored defendant's work, the courts are likely to provide plaintiff with relief. Confusion as to sponsorship is most common when the product produced by the defendant will have a negative impact on the plaintiff's reputation, as in the case of pornographic films.

There are no hard and fast rules which can be applied to guarantee protection to a literary title. However, it is clear that the courts will scrutinize the presence or absence of the above factors.

II. ABANDONMENT

Literary titles may be used under circumstances where they have previously acquired a secondary meaning.⁴⁶¹ A title may be associated with a particular work at one point in time, and may subsequently lose that association.⁴⁶² Ongoing use of a title with a literary work establishes the association between the title and the work in the public's mind and it is this recognition that maintains the right in the "mark."⁴⁶³ If the strength of the mark is diluted by non-use or third party use, the result may be abandonment.⁴⁶⁴ Abandonment is determined by a jury, based on evidence as to whether the secondary meaning in a title ceased to

461. See *Golenpaul v. Rosett*, 18 N.Y.S.2d 889, 174 Misc. 114 (Sup. Ct. 1940); *Curtis v. Twentieth Century Fox Film Corp.*, 140 Cal. App. 2d 461, 295 P.2d 62 (Ct. App. 1956); *Kirkland v. Nat'l Broadcasting Co.*, 425 F. Supp. 1111 (E.D. Penn. 1976), *aff'd*, 565 F.2d 152 (3d Cir. 1977).

462. *Golenpaul v. Rosett*, 18 N.Y.S.2d at 892, 174 Misc. at 114.

463. See *Golenpaul v. Rosett*, 18 N.Y.S.2d 889, 174 Misc. 116-17 (Sup. Ct. 1940); *Curtis v. Twentieth Century Fox Film Corp.*, 140 Cal. App. 2d 461, 295 P.2d 62 (Ct. App. 1956); *Kirkland v. Nat'l Broadcasting Co.*, 425 F. Supp. 1111 (E.D. Penn. 1976), *aff'd*, 565 F.2d 152 (3d Cir. 1977).

464. See *infra* text accompanying notes 466-94.

exist.⁴⁶⁵

A. Abandonment Through Non-Use and Intent Not to Resume Use

The use of the title as a "trademark" may be lost if it is not used for an extended period of time, and the public no longer associates the title with the work.⁴⁶⁶ "Abandonment of trade identity rights occurs when nonuse is coupled with the absence of an intention to continue or resume the use of a previously used name or mark."⁴⁶⁷ When abandonment is proved, the rights, once privately owned, will be forfeited to the public domain.⁴⁶⁸

On the federal level, the Lanham Act⁴⁶⁹ provides that two years of nonuse of a registered mark constitutes prima facie abandonment, but this presumption can be rebutted merely by a *convincing* demonstration of a state of mind to resume use.⁴⁷⁰ Conversely, where appropriate, courts will imply intent to abandon through non-use of a title.⁴⁷¹ Abandonment will be found "where an objective analysis of the situation furnishes ample evidence to warrant the inference of abandonment."⁴⁷²

If the right to exclusive use of a title could be upheld on subjective intent alone, a claim of abandonment would be easily blocked. Furthermore, if a party could hold a monopoly on words, the world of literary titles would be severely limited, a result never intended.⁴⁷³ If a title is no longer associated in the minds of the public with a particular work and subsequent use of that title would not cause public confusion, the elements which established the secondary meaning in the first place no longer exist. When that is the case, abandonment may be confirmed regardless of intent.

As early as 1940, in *Golenpaul v. Rosett*,⁴⁷⁴ a New York court looked beyond the subjective intent of the title user to find abandonment. Defendants published two issues of a magazine entitled *Information Please*,⁴⁷⁵ and then discontinued publication because of lack of funds.

465. *Jackson v. Universal Int'l Pictures, Inc.*, 36 Cal. 2d 116, 123-24, 222 P.2d 433, 438 (1950).

466. *Kirkland*, 425 F. Supp. at 1118.

467. B. PATTISHALL & D. HILLIARD, TRADEMARKS 120 (1987).

468. See *infra* text accompanying notes 495-519 on Public Domain.

469. 15 U.S.C. § 1127 (1982).

470. *Id.*

471. *American Photographic Pub. Co. v. Ziff-Davis Pub. Co.*, 135 F.2d 569, 573 (7th Cir. 1943).

472. *Id.* (citations omitted).

473. See *Golenpaul v. Rosett*, 18 N.Y.S.2d at 893, 174 Misc. at 117-18.

474. 18 N.Y.S.2d 889, 174 Misc. 114.

475. *Id.* at 891, 174 Misc. at 115-16.

Subsequently, plaintiffs developed a radio program also entitled *Information Please*.⁴⁷⁶ Defendants then sought to resume publication of their magazine under the same name.⁴⁷⁷

The court found that even if secondary meaning was established at one time, the defendants' right to the name had been abandoned.⁴⁷⁸ The court believed that defendants were only able to resume publication because plaintiffs had given *Information Please* popularity sufficient to establish public recognition.

[W]hen the business itself actually ceases for such a length of time and under such circumstances that the mark or name actually no longer signifies that business in the mind of the public the right to the mark or name is lost, despite the existence of a purely subjective intent on the part of the user⁴⁷⁹

Thus, it is not enough for a user to say that he intended to use the title again if there has been a significant period of non-use.⁴⁸⁰

In *Kirkland v. National Broadcasting Co.*,⁴⁸¹ the plaintiff created a story entitled "Land of the Lost,"⁴⁸² which was originally broadcast as a radio show. The success of the show generated a book, a record album, cartoons, and comic books. The controversy in the case stemmed from defendant's television program entitled *Land of the Lost*, which was not televised until twenty years after plaintiff had used her title in the commercial world.⁴⁸³ The court found that even if plaintiff's work had a secondary meaning at one point, the secondary meaning was lost during the plaintiff's extended period of non-use. Furthermore, plaintiff's hope of someday using the title again was not enough to prevent others from utilizing it.⁴⁸⁴

Recently, in *Silverman v. CBS, Inc.*,⁴⁸⁵ the Second Circuit affirmed the rule that abandonment could be found through non-use coupled with an intent not to resume use. In *Silverman*, a playwright sought declaratory judgment that the *Amos 'n' Andy* radio and television programs were in the public domain, and therefore could be used in his Broadway

476. *Id.* at 890, 174 Misc. at 114.

477. *Id.* at 892, 174 Misc. at 117.

478. *Id.* at 893, 174 Misc. at 118.

479. *Golenpaul*, 18 N.Y.S.2d at 893, 174 Misc. at 118.

480. *Id.*

481. 425 F. Supp. 1111 (E.D. Penn. 1976).

482. *Id.*

483. *Id.* at 1118.

484. *Id.*

485. 870 F.2d 40 (2d Cir. 1989).

musical.⁴⁸⁶ Finding that the marks had been abandoned, the court relied on the fact that defendant had not used the "Amos 'n' Andy" marks for twenty-one years.⁴⁸⁷ In accord with other courts, the Second Circuit inferred intent not to resume use from actual non-use, regardless of defendant's subjective intent.⁴⁸⁸

B. Third Party Use Destroying Secondary Meaning

The Restatement of Torts provides that a potential claimant whose title has acquired a secondary meaning, but has not been in use, must bring an action against an infringer, before the infringer's use of that title also acquires a secondary meaning. If a producer fails to protect his rights, they may be lost.⁴⁸⁹ Again, the subjective intent of the original user is not dispositive.

In *International Film Service Co. v. Associated Producers, Inc.*,⁴⁹⁰ the plaintiff published a story entitled "Broken Doll" in *Cosmopolitan* magazine. Fifteen years later, both the plaintiff and the defendant were planning releases of films, both entitled *Broken Doll*. Finding for the defendant, the court took into consideration the fact that plaintiff's story was only published once, fifteen years earlier. Another important factor was that the title was used two other times by third parties in that fifteen year period.⁴⁹¹ Judge Learned Hand held that the facts weighed heavily against finding a secondary meaning, and that due to third party use, the likelihood that the public associated "Broken Doll" specifically with plaintiff's original story was slim.⁴⁹² Therefore, the public was not likely to mistake one "Broken Doll" for the other.

Similarly, in *Curtis v. Twentieth Century Fox-Film Corp.*,⁴⁹³ the plaintiff published a book entitled "Hey Mac! You're in the Navy Now." Subsequently, defendant released a movie entitled *You're in the Navy Now*. The court found that the plaintiff had essentially abandoned his title. The court emphasized the fact that prior to publication of the plaintiff's book, several other works had used titles with similar phrases.⁴⁹⁴

486. *Id.* at 43.

487. *Id.* at 46.

488. *Id.*

489. RESTATEMENT OF TORTS § 752 (1938).

490. 273 F. 585 (S.D.N.Y. 1921).

491. *Id.* at 587.

492. *Id.* at 588.

493. 140 Cal. App. 2d 461, 295 P.2d 62 (1956).

494. Paramount produced a film 18 years earlier entitled *We're in the Navy Now* (Paramount 1926). *Id.* at 466, 295 P.2d at 67.

When third parties use a title in association with their work, and no steps are taken by the putative owner to prevent that use, the secondary meaning in the putative owner's title will be diluted, because in time, the title will signify more than one work. Additionally, producers should be aware of all infringing uses, not just the obvious copying of their titles. It is the responsibility of the titleholder to take reasonable precautionary steps to insure that he is not sleeping on his rights.

III. WORKS IN THE PUBLIC DOMAIN

"A work can be in the public domain for copyright purposes if it was published and was never federally copyrighted or if the original copyright has expired with age."⁴⁹⁵ It is assumed that the title of a literary piece is "descriptive" of the work.⁴⁹⁶ Therefore, courts reason that if a public domain work can be copied, its title can also be used to describe the work which has been copied.⁴⁹⁷ Courts hold that when a copyright expires, the title descriptive of that work passes with it into the public domain.⁴⁹⁸ However, there is a caveat to use of titles in the public domain. If the title has acquired and maintained a secondary meaning, subsequent users have a duty not to confuse the public.⁴⁹⁹ In *Gotham Music Service v. Denton & Haskins Music Publishing Co.*,⁵⁰⁰ the court held that "[i]n the absence of the use of the name in such a way as to create a likelihood that people will be misled, the name is *publici juris* [of public right], and may be used by all."⁵⁰¹

Likewise, the name and biography of a public figure is considered to be in the public domain.⁵⁰² In *Osgood v. Allen*,⁵⁰³ the court stated that "[b]y publishing . . . a book under the title of the life of any distinguished statesman, jurist or author, the publisher could not prevent any other author from publishing an entirely different and original biography under the same title."⁵⁰⁴

Affirming that principle, the court, in *Sherwood v. Twentieth Century-Fox Film Corp.*,⁵⁰⁵ found that plaintiffs could not prevent defendant

495. J. MCCARTHY, TRADEMARK AND UNFAIR COMPETITION § 10.12, at 356 (2d ed. 1984).

496. See *supra* text accompanying notes 172-82 for discussion of descriptive titles.

497. *Id.*

498. See *G & C Merriam Co. v. Syndicate Pub. Co.*, 237 U.S. 618, 628 (1915).

499. *Id.*

500. 259 N.Y. 86, 181 N.E. 57 (Ct. App. 1932).

501. *Id.* at 90, 181 N.E. at 58.

502. *Osgood v. Allen*, 18 F. Cas. 871 (C.C.D. Maine 1872).

503. *Id.*

504. *Id.* at 875.

505. 44 U.S.P.Q. (BNA) 550 (N.Y. Sup. Ct. 1940).

from producing a motion picture depicting the same period and events of Abraham Lincoln's life as those depicted by plaintiffs' play.⁵⁰⁶ The court held that because the material belongs to the public domain,

no exclusive right to the use thereof can be acquired even though [plaintiffs] were the first to discover its value as a medium to awaken public interest. The use of such material is absolute in the public and no one can exclude even though by use thereof actual competition is incurred with the pioneer in the particular realm of history or literature.⁵⁰⁷

The court stated that the plaintiffs could sustain a claim for unfair competition only if they showed that defendant "by fraud and imposture sought to mislead the public into believing that its motion picture was based on [plaintiffs'] drama."⁵⁰⁸

In *Walt Disney Productions, Inc. v. Souvaine Selective Pictures*,⁵⁰⁹ the Second Circuit upheld the general rule that works in the public domain could not be granted exclusive use of a title. Although Walt Disney had spent large sums of money advertising its film *Alice in Wonderland*, the court held that it could not prevent the simultaneous release of another motion picture under the same title.⁵¹⁰ The court stated that "Alice in Wonderland" is no longer subject to copyright and is as much in the public domain as are Shakespeare's plays.⁵¹¹ Therefore, unless used in a deceptive manner, a defendant will be permitted to use titles which fall into the public domain.

In *Brondfield v. Paramount Pictures Corp.*,⁵¹² a New York court held that although plaintiff's story—"That's My Boy"—was copyrighted, that copyright did not protect the title.⁵¹³ The title "That's My Boy," was held to be an expression belonging to the public domain, therefore, plaintiff could not prevent defendant from using it. Furthermore, the title was used more than sixteen times before and after plaintiff's story was published.⁵¹⁴

The Ninth Circuit and California state courts are in accord. In *Chamberlain v. Columbia Pictures Corp.*,⁵¹⁵ the Ninth Circuit held that

506. *Id.* at 551.

507. *Id.* at 550.

508. *Id.* at 551.

509. 98 F. Supp. 774 (S.D.N.Y. 1951), *aff'd*, 192 F.2d 856 (2d Cir. 1951).

510. *Id.* at 775.

511. *Id.*

512. 107 N.Y.S.2d 698, 200 Misc. 883 (Sup. Ct. 1951).

513. *Id.* at 700, 200 Misc. at 885.

514. *Id.*

515. 186 F.2d 923 (9th Cir. 1951).

the right to use the name "Mark Twain" could not be granted to the plaintiffs exclusively.⁵¹⁶ The California Court of Appeal also held, in the 1977 case of *Guglielmi v. Spelling-Goldberg Productions*,⁵¹⁷ that a relative of Rudolph Valentino's could not stop defendants from portraying the late Valentino's life under the title the *Legend of Valentino: A Romantic Fiction*⁵¹⁸ in their television movie. Because the life story of a celebrity is in the public domain, the defendants were free to use the title.⁵¹⁹

Producers whose titles contain a property in the public domain should adorn their titles with words which will serve to distinguish them. Hopefully the titles will then be seen as descriptive and will be entitled to legal protection.

IV. SUMMARY OF LIKELIHOOD OF CONFUSION

When a producer can establish likelihood of consumer confusion between the use of his title and another's use of the same or similar title, he may bring an action for unfair competition. If the title is not in the public domain, and the original user has not abandoned his rights, the courts will award remedies based on their jurisdictional requirements. The next section discusses requirements for recovery in the context of litigation.

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PART IV: ELEMENTS OF LITIGATION: EVIDENCE AND REMEDIES

I. INTRODUCTION

In an action for unfair use of a title, the plaintiff must present evidence that the defendant wrongfully used his or her title. If the court finds for the plaintiff, it will award an injunction and/or damages. The plaintiff's burden of proof and the remedies available depend on the jurisdiction in which the case is brought.

516. *Id.* at 925.

517. 73 Cal. App. 3d 436, 140 Cal. Rptr. 775 (1977).

518. *Id.* at 443, 140 Cal. Rptr. at 779.

519. *Id.* at 441, 140 Cal. Rptr. at 778.

A. *The Split Between The Jurisdictions*

1. California

In *Sears, Roebuck & Co. v. Stiffel Co.*⁵²⁰ and *Compco Corp. v. Day-Brite Lighting, Inc.*,⁵²¹ ("Sears-Compco"), the United States Supreme Court held that states may not use unfair competition laws to protect articles which Congress has left unprotected.⁵²² Some jurisdictions, including California, interpret the *Sears-Compco* decisions as a limit on states' power to prohibit copying of entertainment titles.⁵²³ The rationale behind this interpretation is that if Congress had intended to protect titles, then titles would have been specifically covered by copyright or trademark laws.⁵²⁴

Under California's interpretation of *Sears-Compco*, a plaintiff must show three elements to state a cause of action for title infringement:⁵²⁵ that the title has gained secondary meaning, that the defendant did not take sufficient precautions to avoid confusion regarding the title, and that he or she was actually harmed by the defendant's use of the title.⁵²⁶ In other words, the mere copying of a title is insufficient to state a cause of action in California.⁵²⁷ This means that a defendant may copy a title, as long as he or she takes precautions to prevent consumer confusion regarding the titles.⁵²⁸

2. New York

Other jurisdictions, including New York, have not interpreted *Sears-Compco* as prohibiting state protection of titles. Therefore, these jurisdictions allow a cause of action for mere copying of a title.⁵²⁹ In

520. 376 U.S. 225 (1964).

521. 376 U.S. 234 (1964).

522. Anthony & Finkelstein, *Protecting Against Unauthorized Use of Song Titles as Motion Picture Titles* 82 PAT. & TRADEMARK R. 145, 146 (1984) [hereinafter Anthony & Finkelstein].

523. *Id.* See, e.g., *Tomlin v. Walt Disney Prods.*, 18 Cal. App. 3d 226, 96 Cal. Rptr. 168 (1971); *Allied Artists Pictures Corp. v. Friedman*, 68 Cal. App. 3d 144, 137 Cal. Rptr. 94 (1977).

524. Anthony & Finkelstein, *supra* note 522, at 146.

525. *Id.*

526. *Id.* See also, *Tomlin v. Walt Disney Prods.*, 18 Cal. App. 3d 226, 96 Cal. Rptr. 168 (1971); *Allied Artists Pictures Corp. v. Friedman*, 68 Cal. App. 3d 144, 137 Cal. Rptr. 94 (1977).

527. Anthony & Finkelstein, *supra* note 522, at 146.

528. *Id.* Confusion is best avoided by including a disclaimer with the title, stating that the title is not to be confused with the plaintiff's title. For further discussion, see *infra* text accompanying notes 629-35.

529. Angel, *Legal Protection for Titles in the Entertainment Industry*, 52 S. CAL. L. REV. 279, 301, 305-06 (1979) [hereinafter Angel].

New York, proving secondary meaning is not a prerequisite, as long as the infringement is shown to be unfair according to principles of equity.⁵³⁰ Additionally, a New York plaintiff need not show that he or she suffered actual harm resulting from defendant's use of the title.

B. Evidence To Be Presented

The evidence required in a title infringement action depends on the jurisdiction and the scope of relief sought. To prove unfair use of a title, the plaintiff must first show that he or she has rights to the title. These rights are established by actual use and/or advertising of the title.⁵³¹ Next, most jurisdictions require that a plaintiff prove that the title gained secondary meaning in the public mind,⁵³² and that there was a likelihood of public confusion over the plaintiff's and defendant's titles.⁵³³ Additionally, some courts require that the plaintiff show that he or she suffered actual harm as a result of the defendant's use of the title.⁵³⁴ These factors are most effectively proved through the use of witness testimony and/or public surveys.

1. Proving Use, Secondary Meaning and Likelihood Of Confusion

a. Witness Testimony

Though courts permit testimony of the purchasing public, retailers, salesmen and experts to establish whether a mark has gained secondary meaning and/or to offer proof of likelihood of confusion, such extrinsic evidence is seldom controlling.⁵³⁵ In *Premier-Pabst Corp. v. Elm City Brewing Co.*,⁵³⁶ Premier-Pabst offered witness testimony to prove that the defendant had infringed on Premier-Pabst's rights by adopting the name "Olde Maestro Brew" as the name of its beer.⁵³⁷ In the past, Premier-Pabst had extensively used a celebrity known as "the Old Maestro" to advertise its beer, and claimed the public now associated that name with its beer. Their witnesses at trial were consumers who claimed to

530. *National Lampoon, Inc. v. American Broadcasting Co.*, 376 F. Supp. 733 (S.D.N.Y.), *aff'd*, 497 F.2d 1343 (2d Cir. 1974) (court stated that plaintiff need not prove secondary meaning to be granted relief under New York law).

531. See generally *supra* text accompanying notes 226-37.

532. See *supra* text accompanying notes 149-342 for discussion of secondary meaning.

533. See *supra* text accompanying notes 343-519 for discussion of likelihood of confusion.

534. *Anthony & Finkelstein*, *supra* note 522, at 146 (citing *Curtis v. Twentieth Century-Fox Film Corp.*, 140 Cal. App. 2d 461, 295 P.2d 62 (1956) (All three elements are required in California)).

535. *Premier-Pabst Corp. v. Elm City Brewing Co.*, 9 F. Supp. 754, 760 (D. Conn. 1935).

536. 9 F. Supp. 754 (D. Conn. 1935).

537. *Id.* at 756.

have confused the plaintiff's and defendant's use of "Olde Maestro." The court gave little weight to the testimony:

[S]uch testimony . . . is evidence of slight weight, for the average individual is seldom a reliable interpreter of his own mental reactions and content. . . . [T]he testimony of such witnesses, especially if associated with either side, is particularly subject to suggestion and bias. Not only that, but in view of the fact that modern advertising reaches millions, the chancellor, though he hear a hundred witnesses, can never know whether he has been shown a representative picture.⁵³⁸

Courts usually require that the testifying witnesses be familiar with the mark through personal experience. In *Information Clearing House, Inc. v. Find Magazine*,⁵³⁹ the court's insightful analysis pointed out the inadequacies of both parties' witnesses.⁵⁴⁰ Information Clearing House ("ICH"), an information retrieval service, attempted to establish that its newsletter title "FINDOUT" had gained secondary meaning. ICH called five witnesses, all of whom were its customers or competitors.⁵⁴¹ Two of the witnesses had never used ICH's services;⁵⁴² two other witnesses had extensively used ICH's information retrieval services, but were not aware that the company published a newsletter called "FINDOUT."⁵⁴³ The fifth witness was familiar with ICH's publications, but only alluded to one publication which was not "FINDOUT."⁵⁴⁴ The defendants called two witnesses—their own circulation consultant and their own advertising sales representative. The court found that all of the witness testimony lacked probative value, because it was "result-oriented . . . self-serving, [and] uninformed."⁵⁴⁵ The court stated that such "opinion testimony" was entitled to little weight.⁵⁴⁶

Non-expert witnesses may be helpful in establishing that public confusion has actually occurred regarding the plaintiff's and defendant's titles. The parties may present "confused-purchaser" testimony, as well as evidence of misdirected complaints, mail and calls allegedly resulting from the defendant's use of the title. For example, in *Atlantic Monthly*

538. *Id.* at 760.

539. 492 F. Supp. 147 (S.D.N.Y. 1980).

540. *Id.* at 160.

541. *Id.* at 157.

542. *Id.*

543. *Id.*

544. *Information Clearing House*, 492 F. Supp. at 157.

545. *Id.* at 161.

546. *Id.*

Co. v. Fredrick Ungar Publishing Co.,⁵⁴⁷ Atlantic Monthly presented a letter from a college professor who confused Atlantic's name with defendant's use of the name.⁵⁴⁸ Atlantic Monthly also showed that a college had attempted to place an incorrect order after confusing the names.⁵⁴⁹ The court used this evidence in ruling that there was public confusion.⁵⁵⁰

A party may also offer evidence of media errors resulting from confusion over the plaintiff's and defendant's titles. In *Allied Artists Pictures Corp. v. Friedman*,⁵⁵¹ Allied Artists offered evidence that the trade paper, *Daily Variety*, confused Allied's movie title with that of the defendant.⁵⁵² Calling the *Daily Variety* a "highly respected trade publication,"⁵⁵³ the court used the error as evidence to establish that a likelihood of confusion existed between the titles.⁵⁵⁴

b. Surveys

A plaintiff should not rely solely on the testimony of witnesses to establish secondary meaning and/or likelihood of confusion. An additional method of presenting this evidence is through the use of public surveys. Properly conducted surveys may provide valid and persuasive evidence of potential or actual consumer reactions.⁵⁵⁵ However, because opposing counsel does not have the opportunity to cross-examine survey respondents, nor to observe the respondents' demeanor and credibility, surveys constitute hearsay evidence.⁵⁵⁶ Nevertheless, Federal Rule of Evidence 703 allows hearsay evidence in certain circumstances.⁵⁵⁷

Courts carefully scrutinize the trustworthiness and reliability of a survey before allowing it into evidence.⁵⁵⁸ There are certain criteria a survey must meet. First, it must be conducted in the proper "universe," or that segment of the population whose characteristics are relevant to the proposition in question. Also, the subjects of the survey must consti-

547. 197 F. Supp. 524 (S.D.N.Y. 1961).

548. *Id.* at 530.

549. *Id.* at 531.

550. *Id.* *But cf.* *Information Clearing House v. Find Magazine*, 492 F. Supp. 147 (S.D.N.Y. 1980) (stating that a few misdirected telephone calls are not enough evidence to prove actual confusion).

551. 68 Cal. App. 3d 127, 137 Cal. Rptr. 94 (1977).

552. *Id.* at 136, 137 Cal. Rptr. at 99.

553. *Id.*

554. *Id.*

555. B. PATTISHALL & D. HILLIARD, TRADEMARKS 208 (1987).

556. *Id.*

557. *Id.*

558. *Id.*

tute a fair and representative sample of that universe.⁵⁵⁹ For example, in *Ideal Toy Corp. v. Kenner Products*,⁵⁶⁰ the court rejected the defendant's survey for two reasons. First, the survey did not attempt to reach persons who were in the market for the defendant's product, and a cause of action for unfair competition requires that *purchasers* or *prospective purchasers* be misled.⁵⁶¹ Second, the survey failed to question people actually in the process of making a purchase. As the court explained: "If the interviewee is not in a buying mood but is just in a friendly mood answering a pollster, his degree of attention is quite different from what it would be had he his wallet in his hand."⁵⁶²

Surveys must meet other judicial criteria as well. The questions in the survey must be unbiased, as must the interviewers who actually do the survey.⁵⁶³ To ensure unbiased interviewers, the interviewers must not know who they represent. Additionally, the survey results must be properly tabulated and interpreted by an expert.⁵⁶⁴

II. REMEDIES

In an action for unfair use of a title, the remedy chosen depends on the strength of the plaintiff's case⁵⁶⁵ and each particular court's interpretation of unfair competition.⁵⁶⁶ In all jurisdictions, the remedies fall into three basic categories: injunctive relief, disclaimer, and damages.

A. Injunctive Relief

In unfair competition actions regarding titles, damages often cannot be measured and are not considered an adequate remedy at law.⁵⁶⁷ In the absence of an adequate remedy, many courts will grant an injunction. An injunction is a prohibitive, equitable remedy issued by a court which

559. *Id.*

560. 443 F. Supp. 291 (S.D.N.Y. 1977).

561. *Id.* at 308.

562. *Id.*

563. B. PATTISHALL & D. HILLIARD, TRADEMARKS 208 (1987).

564. *Id.* For further discussion of surveys, see generally *American Luggage Works, Inc. v. United States Trunk Co.*, 158 F. Supp. 50 (D. Mass. 1957); *The Scotch Whiskey Ass'n v. Consolidated Distilled Prods.*, 210 U.S.P.Q. (BNA) 639 (N.D. Ill. 1981); *Anheuser-Busch, Inc. v. Stroh Brewery Co.*, 750 F.2d 631 (8th Cir. 1984).

565. The strength of the plaintiff's case will depend on the evidence presented regarding secondary meaning, likelihood of confusion and/or actual damages suffered. See *supra* text accompanying notes 600-607.

566. For discussion of various interpretations of unfair competition, see *supra* text accompanying notes 520-530.

567. See, e.g., *Processed Plastic Co. v. Warner Communications, Inc.*, 675 F.2d 852, 858 (7th Cir. 1982) (damage to an entire licensing program and to a company's good will may not be measured in monetary terms).

forbids a defendant from doing some future act, or restrains the continuance of some act already committed.⁵⁶⁸ If granted in an unfair competition case, an injunction may either prevent the defendant from any further use of the plaintiff's title, or prohibit the defendant's use of the title without a disclaimer.⁵⁶⁹

Ordinarily, the terms of injunctive relief are tailored to the facts of each case, and may include qualified requirements such as geographical limitations.⁵⁷⁰ In a title infringement case, this would mean that the defendant could use the title in other jurisdictions. However, because motion pictures and television shows are often shown nationwide, geographical limitations on an entertainment title injunction would make the injunction almost meaningless.⁵⁷¹ In *Allied Artists Pictures Corp. v. Friedman*,⁵⁷² the court held that a state court had authority to issue "an injunction with extraterritorial impact,"⁵⁷³ as long as there was no evidence that the action would conflict with the laws of any other jurisdiction. That case involved two films, entitled *The Story of O* and *The Journey of O*, respectively. Because the films were both being promoted and released throughout the United States, and not just in California, the court concluded that the injunction issued against the distributors of *The Journey of O* could apply nationwide.⁵⁷⁴

Some courts will only grant a partial injunction against defendant's use of the title.⁵⁷⁵ As noted earlier, the Supreme Court decisions in *Sears-Compro* have shaped the doctrine of unfair competition relating to titles in some jurisdictions.⁵⁷⁶ Jurisdictions following the *Sears-Compro* reasoning hold that because titles are not protected under the federal trademark and copyright laws, a state may not create an "unfair competition" cause of action which would forbid the use of a particular title.⁵⁷⁷ The effect of *Sears-Compro* on remedies in these jurisdictions, including California, has been extreme.

568. BLACK'S LAW DICTIONARY 705 (5th ed. 1979).

569. For full explanation of disclaimers, see *infra* text accompanying notes 629-35.

570. B. PATTISHALL & D. HILLIARD, TRADEMARKS at 392-93.

571. Angel, *supra* note 529, at 301.

572. 68 Cal. App. 3d 127, 137 Cal. Rptr. 94 (1977).

573. *Id.* at 137, 137 Cal. Rptr. at 100.

574. *Id.* at 99. (The injunction issued in *Allied* did not prohibit defendant from using the title, but required a disclaimer which would prevent public confusion regarding the two films. *Id.* This is consistent with California's interpretation of *Sears-Compro*. See *supra* text accompanying notes 525-28).

575. See, e.g., *Tomlin v. Walt Disney Prods.*, 18 Cal. App. 3d 226, 96 Cal. Rptr. 118 (1971).

576. See *supra* text accompanying notes 520-30.

577. *Id.*

In the California case of *Tomlin v. Walt Disney Productions*,⁵⁷⁸ the plaintiff sought an injunction prohibiting Walt Disney from using *The Love Bug* as a motion picture title.⁵⁷⁹ The court refused to grant the injunction for several reasons, including a lack of secondary meaning in the plaintiff's title.⁵⁸⁰ However, the court stated that even if there had been secondary meaning, under its interpretation of *Sears-Compco*, relief was limited "to a narrowly drawn injunction requiring [only] appropriate precautions to prevent public confusion."⁵⁸¹ In other words, if a defendant takes reasonable precautions to see that the public does not confuse the defendant's work with the plaintiff's work of a same or similar title, then the defendant will not be enjoined from using the title. The most common way to prevent this confusion is to require a disclaimer in conjunction with defendant's use of the title.⁵⁸²

1. Granting A Preliminary Injunction

A preliminary injunction is an injunction granted at the institution of a suit, to restrain the defendant from doing or continuing some act.⁵⁸³ In unfair competition actions regarding titles, a delay in granting plaintiff's injunction may result in a denial of justice, because it may be impossible to undo the harm caused by defendant's use of the title in the interim.⁵⁸⁴ If the plaintiff's case is strong,⁵⁸⁵ the court will grant the preliminary injunction, which means that the defendant is prohibited from using the title while the case is pending.

Because a preliminary injunction is such a drastic remedy, the plaintiff must make a substantial showing before it will be granted.⁵⁸⁶ In unfair competition actions, there are three factors which comprise a substantial showing.⁵⁸⁷ First, the plaintiff must prove he may suffer irreparable harm if relief is not immediately granted. Second, the plaintiff

578. 18 Cal. App. 3d 226, 96 Cal. Rptr. 118 (1971).

579. *Id.*

580. *Id.* at 238, 96 Cal. Rptr. at 125.

581. *Id.* at 235, 96 Cal. Rptr. at 123.

582. For a discussion of disclaimers, see *infra* text accompanying notes 629-35. See also, *Allied Artists Pictures Corp. v. Friedman*, 68 Cal. App. 3d 127, 137, 137 Cal. Rptr. 94, 99-100 (1977) (defendant required to include disclaimer in advertisements of film with title similar to plaintiff's).

583. BLACK'S LAW DICTIONARY 705 (5th ed. 1979).

584. See *infra* text accompanying notes 588-99 for discussion of irreparable harms.

585. The court will use certain factors when considering whether the plaintiff's case is a strong one. See *infra* text accompanying notes 600-07.

586. *Willpat Prods., Inc. v. Sigma III Corp.*, 227 F. Supp. 354, 357 (S.D.N.Y. 1964).

587. *Walt Disney Prods., Inc. v. Kusan, Inc.*, 204 U.S.P.Q. (BNA) 284, 286 (1979) (citing *Kass v. Arden-Mayfair, Inc.*, 431 F. Supp. 1037, 1041 (C.D. Cal. 1977)).

must show a high likelihood of success at trial. Finally, the court balances the equities in determining whether the hardships to the defendant outweigh the benefits to the plaintiff, or vice versa.

a. Showing of Possible Irreparable Harm

In an action for unfair use of a title, a delay in granting relief may result in a denial of justice, because irreparable harm may be caused by the defendant's use of the title during the delay.⁵⁸⁸ An illustrative case of how irreparable harm could result if relief is not immediately granted is *Universal City Studios, Inc. v. J.A.R. Sales, Inc.*⁵⁸⁹ Although the case is not specifically concerned with a defendant's use of a plaintiff's title, the potential harms are analogous to those which could result from use of a title.

In *Universal*, Universal City Studios and Kamar owned all rights to the "E.T." character and marketed an "E.T." doll.⁵⁹⁰ Defendant J.A.R. began marketing a doll similar to the "E.T." doll already being marketed by Kamar.⁵⁹¹ The court issued a preliminary injunction against J.A.R., and cited lost sales, lost reputation and lost uniqueness of Kamar's mark as potential results of J.A.R.'s actions.⁵⁹² The court also discussed irreparable harm to plaintiff's marketing strategy, business relationships, good will and public relations if relief was not immediately granted:⁵⁹³

Universal will be hurt in its efforts to produce and distribute future motion pictures if it is unable to fully protect its . . . rights. Merchandising will suffer serious damage to its reputation with potential licensees . . . Kamar's relations with its customers and sales representatives will be irreparably harmed if Kamar is unable to protect itself against [similar inferior products]. The plaintiffs' control over the quality and presentation . . . will be destroyed, and the market thrown into confusion by the potential flood of defendants' [products] . . .⁵⁹⁴

Courts may also examine whether the plaintiff's lack of control over the nature and quality of services that are likely to be associated with plaintiff's mark would irreparably harm plaintiff's reputation and good

588. *Marvin Worth Prods. v. Superior Films Corp.*, 319 F. Supp. 1269, 1276 (S.D.N.Y. 1970).

589. 216 U.S.P.Q. (BNA) 679 (C.D. Cal. 1982).

590. *Id.* at 680.

591. *Id.*

592. *Id.* at 684.

593. *Id.* at 682-83.

594. *Universal City Studios*, 216 U.S.P.Q. (BNA) at 682-83.

will.⁵⁹⁵

The most corrosive and irreparable harm . . . is the inability of the victim to control the nature and quality of the defendant's goods. Even if the infringer's products are of high quality, the plaintiff can properly insist that its reputation should not be imperiled by the acts of another.⁵⁹⁶

For example, in *WGBH Educational Foundation Inc. v. Penthouse International Ltd.*,⁵⁹⁷ the defendant publishing company sought to use the science television show title "Nova" as the title of its new magazine. The court granted the preliminary injunction because the intended audience of the magazine was the same audience which read "girlie" magazines.⁵⁹⁸ The court reasoned that this posed "a threat to plaintiff's image of integrity and seriousness, and there [was] sufficient basis for plaintiff to be concerned that its Nova operation may lose both its funding and its audience."⁵⁹⁹

b. Plaintiff Shows High Likelihood of Success at Trial

A court will grant a preliminary injunction at the time the action is filed if the court believes that the plaintiff is likely to prevail on the merits.⁶⁰⁰ In cases of unfair competition regarding titles, the plaintiff should present evidence showing that his or her title has gained secondary meaning and that there is a likelihood of confusion between defendant's and plaintiff's titles.⁶⁰¹ The stronger this evidence, the more likely the court is to believe that the plaintiff will prevail; hence, the court is more likely to grant the preliminary injunction.

Even if the plaintiff cannot prove success at trial, a court may still grant the preliminary injunction if there are "sufficiently serious questions going to the merits to make them a fair ground for litigation [plus] a balance of hardships tipping decidedly toward the [plaintiff]. . . ."⁶⁰² In

595. See, e.g., *Universal City Studios, Inc. v. Montgomery Ward & Co.*, 207 U.S.P.Q. 852, 859 (N.D. Ill. 1980); *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, 604 F.2d 200, 205 (2d Cir. 1979).

596. *Processed Plastic Co. v. Warner Communications, Inc.*, 675 F.2d 852, 858 (7th Cir. 1982) (quoting 4 R. CALMANN UNFAIR COMPETITION, TRADEMARKS AND MONOPOLIES § 88.3(b) at 205 (3d ed. 1970)).

597. 453 F. Supp. 1347 (S.D.N.Y. 1978).

598. *Id.* at 1352.

599. *Id.*

600. *Warner Bros., Inc. v. Gay Toys, Inc.*, 658 F.2d 76, 79 (2d Cir. 1981).

601. For discussion on the factors needed to prove secondary meaning and likelihood of confusion, see *supra* text accompanying notes 217-25 and 350-53.

602. *Warner Bros., Inc. v. Gay Toys, Inc.* 658 F.2d 76, 78 (2d Cir. 1981) (citing Jackson

Warner Brothers, Inc. v. Gay Toys, Inc.,⁶⁰³ Gay Toys began manufacturing a toy automobile similar to the automobile in Warner Bros.' successful *Dukes of Hazzard* T.V. series.⁶⁰⁴ Although it was questionable whether Warner Bros. would actually prevail at trial, the court awarded Warner Bros. a preliminary injunction.⁶⁰⁵ The court found "sufficient grounds for litigation" since the defendant specifically attempted to exploit the market created by Warner Bros.⁶⁰⁶ Additionally, a balance of the hardships showed that if the relief were not granted, Warner Bros. would suffer substantial lost sales and damage to its licensing program.⁶⁰⁷ In summary, the court issued the preliminary injunction without requiring Warner Bros. to show that they were likely to prevail on the merits at trial.

c. Balancing of Hardships: Should The Preliminary Injunction Be Granted?

Courts balance the potential hardships to the plaintiff and defendant when determining whether to issue a preliminary injunction. If a court concludes that by granting relief, the hardship on one party would strongly outweigh the hardships to the other party, then the preliminary injunction will not be granted.⁶⁰⁸

The hardships and benefits are often measured by the financial effects on the parties. This may include potential lost profits and sales, or the loss of resources already expended in costs and advertising. In *Metro-Goldwyn-Mayer, Inc. v. Lee*,⁶⁰⁹ the court found that an inequitable financial burden would result if the defendant was allowed to use part of plaintiff's title in its advertising. In that case, MGM intended to release a film entitled *The Wonderful World Of The Brothers Grimm*, and the defendant intended to release a film entitled *Grimms Fairy Tales*. MGM

Dairy, Inc. v. H.P. Hood & Sons, 596 F.2d 70 (2d Cir. 1979)). For discussion of "balance of hardships," see *infra* text accompanying notes 608-16.

603. 658 F.2d 76 (2d Cir. 1981).

604. *Id.* at 77.

605. *Id.* at 80.

606. *Id.* at 78-79.

607. *Id.* See *infra* text accompanying notes 608-16 for discussion of the balance of the hardships in *Warner*.

608. *Metro-Goldwyn-Mayer, Inc. v. Lee*, 212 Cal. App. 2d 23, 31, 27 Cal. Rptr. 833, 838 (1963) (the court's discretion in issuing a preliminary injunction "is based upon a balancing of the respective interests of the parties with the objective of preventing injustice pending trial"); *Willpat Prods., Inc. v. Sigma III Corp.*, 227 F. Supp. 354, 356-57 (S.D.N.Y. 1964) (court denied plaintiff's preliminary injunction after weighing equities and finding that harm to defendant through disruption of defendant's distribution arrangements would be greater than benefit to plaintiff if injunction granted).

609. 212 Cal. App. 2d 23, 27 Cal. Rptr. 833 (1963).

widely publicized its title, and the defendant subsequently adopted the phrase "wonderful world" into its own advertising slogan. The court enjoined the defendant from using the phrase, finding that the potential diversion of trade from MGM's film to defendant's film resulted in an inequitable hardship to MGM and benefit to the defendant.⁶¹⁰

Other costs considered in balancing the equities are those already spent by the parties in costs and advertising. For example, in *Walt Disney Productions v. Kusan*,⁶¹¹ the defendant marketed a game called "Black Hole In Space" simultaneous with Walt Disney's release of a motion picture entitled *The Black Hole*. Although the court was "not insensitive to the tremendous burden that a[n] . . . injunction of any marketing of 'Black Hole In Space' would place on defendant,"⁶¹² it compared the huge marketing costs already expended by Walt Disney with the small amounts spent on advertising by the defendant. Finding Walt Disney's financial burden surpassed that of the defendant's, the court enjoined the defendant from further use of the title for its game.⁶¹³

Courts also take into account the intent of the defendant when balancing the hardships. The court in *Walt Disney* found clear evidence that the defendant had intentionally traded on Walt Disney's goodwill and business reputation.⁶¹⁴ Consequently, it disregarded the defendant's complaints as "hollow whimpers,"⁶¹⁵ and ruled that since the defendant could have avoided the hardships, the hardships were to be weighed in Walt Disney's favor.⁶¹⁶

In conclusion, a preliminary injunction will usually be granted only if the plaintiff shows irreparable harm, a high likelihood of success at trial, and a balance of the hardships in his or her favor. Courts often take into account such factors as financial burdens on the parties and the bad faith of the defendant when balancing the hardships.

2. Permanent Injunction

A permanent injunction often replaces the previously granted preliminary injunction at the conclusion of the trial. Although the courts have not articulated a common test for granting a permanent injunction,

610. *Id.* at 29, 27 Cal. Rptr. at 836.

611. 204 U.S.P.Q. (BNA) 284 (C.D. Cal. 1979).

612. *Id.* at 288.

613. *Id.*

614. *Id.*

615. *Id.*

616. *Willpat Prods., Inc. v. Sigma III Corp.*, 227 F. Supp. 354, 356 (S.D.N.Y. 1964) (citing *McGraw-Hill Cook Co. v. Random House, Inc.*, 32 Misc. 2d 704, 710, 225 N.Y.S.2d 646, 653 (1962)).

courts focus primarily on the strength of plaintiff's case regarding the same factors required for a preliminary injunction.⁶¹⁷ These factors include plaintiff's showing of irreparable harm and the relative hardships to the parties if the injunction is not granted. Courts are most likely to award a permanent injunction in cases where the plaintiff presents evidence of the defendant's intent to capitalize on the plaintiff's reputation and goodwill.⁶¹⁸

*Brandon v. Regents of the University of California*⁶¹⁹ illustrates how a defendant's intent may persuade a court to issue a permanent injunction. In *Brandon*, the plaintiff produced a successful educational film entitled *Anything You Want To Be*.⁶²⁰ The University of California wanted to purchase a copy of the film, but the plaintiff refused because the University intended to use the film for rental purposes. The University then produced a similar film and entitled it *Anything They Want To Be*.⁶²¹ At trial, the plaintiff showed that the University was aware of, and had attempted to purchase, plaintiff's film before producing its own film.⁶²² Calling the University's action "a brazen act of outright plagiarism"⁶²³ and "deliberate pirating of plaintiff's property,"⁶²⁴ the court issued a permanent injunction against the University's distribution of the film, and required the University to direct potential customers to the plaintiff.⁶²⁵

Once a permanent injunction is issued, the defendant has an increased duty not to infringe on the plaintiff's title. For example, in *Aurora Products Corp. v. Schisgall Enterprises, Inc.*,⁶²⁶ Aurora was the licensee of ABC's title "Monday Night Football." The defendant toy manufacturer attempted to use "Monday Night Football" as the name of its new game, but was enjoined from doing so. Defendant then at-

617. For discussion of factors needed for a preliminary injunction, *see supra*, text accompanying notes 586-616.

618. For examples of cases where plaintiff presented evidence of defendant's bad faith and was awarded a permanent injunction, *see Atlantic Monthly Co. v. Frederick Ungar Publishing Co.*, 197 F. Supp. 524 (S.D.N.Y. 1961) (defendant enjoined from using any form of the title "Atlantic" in its books); *Esquire, Inc. v. Maira*, 101 F. Supp. 398 (M.D. Pa. 1951) (injunction issued against clothing manufacturer using "Esquire," after he deliberately chose the name with knowledge of *Esquire* magazine's reputation).

619. 441 F. Supp. 1086 (D. Mass. 1977).

620. *Id.*

621. *Id.*

622. *Id.* at 1089 (plaintiff produced purchase orders from the University requesting copies of the film at trial).

623. *Id.*

624. *Brandon*, 441 F. Supp. at 1091 (D. Mass. 1977).

625. *Id.*

626. 176 U.S.P.Q. (BNA) 184 (S.D.N.Y. 1972).

tempted to adopt the name "SEI Night-Time Football" for the game. The court prohibited any variation on "night-time football," stating that there was no evidence of any other night-time broadcast of football other than ABC's *Monday Night Football*.⁶²⁷ The court also explained that "one who . . . has been enjoined by the court from use of the infringing mark must thereafter 'keep a safe distance' and will be held to a higher standard of conduct with respect to the adoption of a new mark than would have been applied in the first instance."⁶²⁸

Thus, as a result of a permanent injunction, the defendant's use of a similar title will be prohibited, even though the similar title could have been used prior to the original infringement.

B. Disclaimer

In some cases, justice is more properly served by requiring the defendant to include a disclaimer whenever he or she uses a title similar to plaintiff's.⁶²⁹ Through the disclaimer, the defendant disavows any association with the plaintiff's work of a same or similar title.⁶³⁰ Disclaimers are especially significant in California and other jurisdictions which interpret *Sears-Compco* as preempting states from protecting titles which are not protected under federal laws.⁶³¹ In these jurisdictions, the goal is not to insure that a title is used by only one party, but to avoid public confusion over which title is to be associated with which party: "The mere use of a substantially similar title, if not used in a manner to induce the public to believe that the work to which it is applied is the identical thing which it originally designated, does not constitute unfair competition."⁶³²

The court may set explicit guidelines for the defendant's disclaimer. In *Warner Brothers Pictures, Inc. v. Majestic Pictures Corp.*,⁶³³ the defendant wanted to produce a talking motion picture entitled *Gold Diggers of Paris*. Warner Bros. had already produced a silent motion picture entitled *The Gold Diggers*, and the court ordered the defendant to include a disclaimer in conjunction with its use of the title.⁶³⁴ In ordering the dis-

627. *Id.* at 188.

628. *Id.* (citations omitted).

629. *See, e.g., Tomlin v. Walt Disney Prods.*, 18 Cal. App. 3d 226, 96 Cal. Rptr. 118 (1971); *Allied Artists Pictures Corp. v. Friedman*, 68 Cal. App. 3d 127, 137 Cal. Rptr. 94 (1977).

630. Disclaimers are usually used in promotions and advertising where the title appears.

631. For discussion of *Sears-Compco*, see *supra* text accompanying notes 520-30.

632. *Curtis v. Twentieth Century-Fox Film Corp.*, 140 Cal. App. 2d 461, 469, 295 P.2d 62, 67 (1956).

633. 70 F.2d 310 (2d Cir. 1934).

634. *Id.* at 312.

claimer, the court explicitly required that: 1) the disclaimer be placed on every piece of advertising and on the motion picture itself, 2) the words be in type as large as the title itself, and 3) the words explicitly designate the film as a "production of Majestic Pictures Corporation, not based on Avery Hopwood's play or on the motion picture of Warner Bros. Pictures, Inc."⁶³⁵

In summary, a disclaimer is ordered by the court to prevent confusion over the plaintiff's and defendant's use of a same or similar title. The disclaimer will be added to advertising and any other place that the title is used. Courts will sometimes specify exactly what the disclaimer should say, as well as the size and location of the words.

C. Damages

Some courts award damages in addition to, or in place of, injunctive relief.⁶³⁶ If the plaintiff proves the defendant's use of a same or similar title has destroyed or decreased the value of the plaintiff's work, damages may be assessed.⁶³⁷ Courts usually consider the defendant's bad faith when awarding damages,⁶³⁸ and some jurisdictions, including California, require a showing of fraud to establish a damages claim.⁶³⁹ In other words, to be awarded damages, the plaintiff must prove that the defendant intended to deceive the public as to the source of the work.⁶⁴⁰

In the California case of *Tomlin v. Walt Disney Productions*,⁶⁴¹ the court ruled that a plaintiff's damages claim must be specially pleaded and proved. The court articulated three requirements which must be met.⁶⁴² First, the plaintiff has the burden of proving that the title gained secondary meaning.⁶⁴³ Second, the plaintiff must show that the defend-

635. *Id.*

636. However, many courts rule that damages in unfair competition cases are impossible to measure, and will award injunctive relief only. *See, e.g.,* Processed Plastic Co. v. Warner Communications, Inc., 675 F.2d 852, 858 (7th Cir. 1982) (damages are "by their very nature irreparable and not susceptible of adequate measurement for remedy at law" (citations omitted)).

637. Angel, *supra* note 529. *See also* Monsanto Chemical Co. v. Perfect Fit Prods. Mfg. Co., 349 F.2d 389, 391 (2d Cir. 1965), *cert. denied*, 383 U.S. 942 (1966) (damages are assessed subject to principles of equity).

638. *See, e.g.,* Monsanto Chemical Co. v. Perfect Fit Prods. Mfg. Co., 349 F.2d 389 (2d Cir. 1965), *cert. denied*, 383 U.S. 942 (1966); Brandon v. Regents of the Univ. of Cal., 441 F. Supp. 1086 (D. Mass. 1977).

639. *See, e.g.,* Tomlin v. Walt Disney Prods., 18 Cal. App. 3d 226, 96 Cal. Rptr. 118 (1971); Gordon v. Warner Bros. Pictures, Inc., 269 Cal. App. 2d 31, 74 Cal. Rptr. 499 (1969).

640. Anthony & Finkelstein, *supra* note 522.

641. 18 Cal. App. 3d 226, 96 Cal. Rptr. 118 (1971).

642. *Id.* at 235, 96 Cal. Rptr. at 123.

643. *Id.* *See also supra* text accompanying notes 149-342 for discussion of proving secondary meaning.

ant failed to take reasonable precautions to prevent public confusion regarding the mark.⁶⁴⁴ Third, the plaintiff must prove that the defendant actually intended to deceive the public.⁶⁴⁵ This intent factor is necessary because damages merely for copying are unconstitutional under California's interpretation of *Sears-Compco*.⁶⁴⁶ Once the court determines that damages are an appropriate award in a particular unfair competition case, there are three possibilities of recovery—defendant's profits, actual damages sustained by the plaintiff, and costs of the action.

1. Defendant's Profits

If the plaintiff prevails, the court may award him or her an accounting. An accounting entitles the plaintiff to recover all or part of the defendant's profits which resulted from the defendant's use of the plaintiff's title.⁶⁴⁷ In the case of a motion picture title, this means that the plaintiff could recover the defendant's gross income derived from sales and rentals of the infringing film.⁶⁴⁸

Courts award accountings on the basis that the public interest is served by deterring fraudulent sales practices.⁶⁴⁹ In *Brandon v. Regents of the University of California* ("*Brandon*"),⁶⁵⁰ the University of California deliberately pirated the title and subject matter of the plaintiff's film after plaintiff refused to sell a copy of the film to the University. At trial, the plaintiff presented evidence that the rentals, sales, and income from her film decreased substantially after the University began marketing the similar film.⁶⁵¹ The court found that the decrease "was the direct result of defendant's production and distribution of [the similar film],"⁶⁵² and awarded the plaintiff an accounting and damages.⁶⁵³ The University could have deducted its expenses from the amount awarded; however, the burden of proving these costs is on the defendant, and the University did not present evidence of its expenses at trial.⁶⁵⁴

Because of the difficulty in determining an equitable amount, courts usually award accountings only in extreme cases such as *Brandon*, where

644. *Id.*

645. *Id.*

646. For discussion of *Sears-Compco*, see *supra* text accompanying notes 520-28.

647. See BLACK'S LAW DICTIONARY 18 (5th ed. 1979).

648. See, e.g., *Brandon v. Regents of the Univ. of Cal.*, 441 F. Supp. 1086 (D. Mass. 1977).

649. *Monsanto Chemical Co. v. Perfect Fit Prods. Mfg. Co.*, 349 F.2d 389, 397 (2d Cir. 1965), *cert. denied*, 383 U.S. 942 (1966).

650. 441 F. Supp. 1086 (D. Mass. 1977).

651. *Id.* at 1090.

652. *Id.*

653. *Id.*

654. *Id.*

the defendant deliberately used the plaintiff's title to capitalize on the plaintiff's goodwill and reputation. As explained by one court: "[P]roof of damages in these kinds of cases is extremely difficult because . . . it requires an estimation of profits that did not come to fruition."⁶⁵⁵ If awarded, the amount of the accounting is based on the amount of profit that the court decides would have been earned by the plaintiff had the defendant not used the title. This amount is ascertained by the profits actually earned by the defendant, minus expenses.⁶⁵⁶

2. Actual Damages Sustained By Plaintiff

In a minority of jurisdictions, courts award damages proportional to the diminished value of the plaintiff's work resulting from the defendant's use of the plaintiff's title.⁶⁵⁷ In other words, the plaintiff is awarded the value of his or her work prior to the wrongful conduct of the defendant less the value of plaintiff's work after the wrongful conduct of the defendant.⁶⁵⁸ However, the majority view is that diminished value damages defy monetary measurement.⁶⁵⁹ In the minority are courts which attempt to measure these damages based on a "trade diverted" theory.⁶⁶⁰ In unfair competition cases regarding motion picture titles, this translates into the business diverted from the plaintiff's picture as a result of the defendant's use of the plaintiff's title. Such diversion of trade may occur because the audience is unaware that there are two separate films with the same title. This unawareness may potentially keep the public from seeing plaintiff's film.

In *Paramore v. Mack Sennett, Inc.*,⁶⁶¹ the plaintiff authored a literary production entitled "The Ballad of Yukon Jake,"⁶⁶² which he intended to make into a motion picture. The defendant then produced and distributed a motion picture entitled *Yukon Jake*. The court decided that the defendant's film affected the marketability of the plaintiff's film, and awarded damages because "there would no longer be the same demand

655. *DC Comics, Inc. v. Filiation Assocs.*, 486 F. Supp. 1273, 1282 (S.D.N.Y. 1980).

656. *Brandon v. the Regents of Univ. of Cal.*, 441 F. Supp. 1086, 1090 (D. Mass. 1977) (defendant must prove any expenses to be charged against its gross income).

657. *See Monsanto Chemical Co. v. Perfect Fit Prods. Mfg. Co.*, 349 F.2d 389, 391-93 (2d Cir. 1965), *cert. denied*, 383 U.S. 942 (1966).

658. *Angel*, *supra* note 529, at 301.

659. *See, e.g., Processed Plastic Co. v. Warner Communications, Inc.*, 675 F.2d 852, 858 (7th Cir. 1982), *DC Comics, Inc. v. Filiation Assocs.*, 486 F. Supp. 1273, 1282 (S.D.N.Y. 1980).

660. *Monsanto Chemical Co. v. Perfect Fit Prods. Mfg. Co.*, 349 F.2d 389, 391-93 (2d Cir. 1965), *cert. denied*, 383 U.S. 942 (1966).

661. 9 F.2d 66 (S.D. Cal. 1925).

662. *Id.* at 67.

for a second picture under [the] title . . . and the marketability of plaintiff's [picture] would thus be proportionately destroyed."⁶⁶³

Damages are awarded where injury has already occurred, and not in cases of mere possibility of injury.⁶⁶⁴ As explained by one court, damages are "merely a means of protecting a businessman from injury resulting from another's use of his [title]."⁶⁶⁵ In other words, the damages amount is a measure of the plaintiff's injury, not of the defendant's enrichment.

3. Costs Of The Action

Usually, attorneys' fees are not awarded in unfair competition cases.⁶⁶⁶ However, a court might award costs based on the strength of plaintiff's case, and a showing of bad faith on the part of the defendant.⁶⁶⁷ In *Monsanto Chemical Co. v. Perfect Fit Products Manufacturing Co.*,⁶⁶⁸ the court found that the defendant "deliberately infringed" upon the plaintiff's mark by selling inferior products falsely labelled with plaintiff's mark.⁶⁶⁹ The court upheld an award for legal fees and remanded the case for a determination of damages, stating that "a judgment limited to an injunction is clearly inadequate to deter those who deliberately engage in commercial piracy which defrauds thousands of consumers and injures a trade name built up at considerable cost by legitimate means."⁶⁷⁰

In conclusion, accountings, damages and/or costs are usually awarded only when the plaintiff suffers actual harm as a result of the defendant's use of his or her title. These awards are most often based on the bad faith of the defendant, and the defendant's intent to deliberately capitalize on the goodwill and reputation of the plaintiff.

D. Other Possible Remedies

Occasionally courts choose some other remedy in conjunction with

663. *Id.* at 68.

664. *Monsanto Chemical Co. v. Perfect Fit Prods. Mfg. Co.*, 349 F.2d 389, 392 (2d Cir. 1965), *cert. denied*, 383 U.S. 942 (1966) ("Injunctive relief may be warranted by the mere possibility of . . . injury, but a monetary award, whether in the form of damages or an accounting, is justified only to the extent that injury is shown already to have been suffered.").

665. *Id.*

666. *HMH Publishing Co. v. Brincat*, 504 F.2d 713, 721 (9th Cir. 1974).

667. *See, e.g., Brandon v. Regents of the Univ. of Cal.*, 441 F. Supp. 1086, 1091 (D. Mass. 1977); *Monsanto Chemical Co. v. Perfect Fit Prods. Mfg. Co.*, 349 F.2d 389, 391 (2d Cir. 1965), *cert. denied*, 383 U.S. 942 (1966).

668. 349 F.2d 389 (2d Cir. 1965).

669. *Id.* at 390.

670. *Id.* at 397.

injunctive relief, disclaimers and/or damages. For example, if one party registers a title, and that title is later found to infringe on another party's title, the court will require that the registration be withdrawn.⁶⁷¹ Another option is to actually recall the product associated with the title, although this remedy is rarely required because of the extreme hardship it places on the defendant.⁶⁷² Also, as seen in *Brandon v. Regents of the University of California*,⁶⁷³ the court may require the defendant to direct future business relating to the title back to the plaintiff, especially if the defendant intended in bad faith to divert business from the plaintiff.⁶⁷⁴

III. PROTECTING ONESELF

A. Title Registration

A title may be registered as a federal trademark or copyright. However, courts do not decide title infringement cases on the basis of a title's registration. Rather, the court uses federal registration as prima facie evidence that the party did, in fact, use the title.⁶⁷⁵

It is also possible to register a title with the Motion Picture Association of America ("MPAA").⁶⁷⁶ This means that all MPAA members receive notice when a title is being used, and may contest the usage through arbitration proceedings. Although this is an effective way to give notice of title usage, courts use MPAA registration as mere prima facie evidence in deciding title infringement cases.

B. Title Availability Report

Once a producer decides on a potential title, it is advisable to check the title for prior usage. Because registration of titles is not required, a search of registered trademark or copyrighted titles is inadequate. One alternative is to employ a title search company. These companies are equipped with both federal copyright and trademark records, and their own databases which contain records of non-registered titles. These records are compiled largely from the entertainment trade papers, espe-

671. *Dollcraft Co. v. Nancy Ann Storybook Dolls, Inc.*, 94 F. Supp. 1, 4-6 (S.D. Cal. 1950), *aff'd*, 197 F.2d 293 (9th Cir.), *cert. denied*, 344 U.S. 877 (1952) (registration merely raises rebuttable presumption over whether mark is protected; court ordered registrations cancelled).

672. *See, e.g., Walt Disney Prods. v. Kusan, Inc.*, 204 U.S.P.Q. (BNA) 284 (1979) (court did not require defendant to recall 73,000 games using plaintiff's title, especially since packaging was likely to be thrown away).

673. 441 F. Supp. 1086, 1091 (D. Mass. 1977).

674. *Id.* (Court directed defendant to give notice of plaintiff's film in all of its catalogues and in response to all inquiries about the film).

675. *See supra* text accompanying notes 94-102.

676. For discussion of MPAA registration, *see supra* text accompanying notes 120-38.

cially *The Hollywood Reporter*, *Weekly Variety* and *Daily Variety*. When a new title is mentioned in one of these papers, the companies add it to their database.⁶⁷⁷

A title report consists of a listing of all prior uses of a particular or similar title in the literary, motion picture, radio, television, music and trademark fields. Once the producer has received this information, it must be interpreted to see if the title may be legally used.⁶⁷⁸ This depends on that particular jurisdiction's interpretation of secondary meaning and likelihood of confusion.⁶⁷⁹ Usually the price of a title search is under \$500.00.⁶⁸⁰ The price varies, depending on the producer's need and any special requests, like foreign language searches.

C. Insurance

Distributors, television networks and financiers will often insist that a producer obtain producer's liability insurance for each production. This insurance is known as "Errors and Omissions Insurance" or "E & O Insurance." It may include protection against copyright infringement, defamation, invasion of privacy, misappropriation of right of publicity and title infringement.⁶⁸¹

It is difficult to specifically isolate the cost of title infringement protection because it is purchased as part of the E & O Insurance package.⁶⁸² However, an insurance company may refuse to insure a specific part of the production, including the title.⁶⁸³ In this case, the producer must go to another insurer, assume the liability, or modify the production so the insurance company will insure it.⁶⁸⁴

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677. Two major title availability services are Dennis Angel and Thomson and Thomson. Dennis Angel, 33 Lynwood Road, Scarsdale, New York, 10583 (914) 472-0820, or Robert Angel, 314 East Capitol Suite 503, Washington, D.C., 20003 (202) 547-6370. Thomson & Thomson, 500 Victory Road, North Quincy, MA, 02171 (800) 356-8630.

678. In the case of Dennis Angel, it is also possible to request that the report be accompanied by a legal opinion on the title's availability.

679. See *supra* text accompanying notes 520-30 for discussion of courts' interpretations of secondary meaning and likelihood of confusion.

680. Interview with Lionel Sobel, Professor, Loyola Law School, Los Angeles (Oct., 1989).

681. *Id.*

682. *Id.*

683. *Id.*

684. The four major companies which offer E&O Insurance are Fireman's Fund, Chubb/Pacific Indemnity, Transamerica and Lloyd's of London. In order to insure a title, these companies require a title availability report from a reputable company. See *supra* text accompanying note 677.

PART V: CONCLUSION

Single literary titles are protected under state unfair competition doctrines and section 43(a) of the federal Lanham Act. The protection afforded, however, differs drastically depending upon the jurisdiction in which the case is heard.

California offers a plaintiff only one cause of action—the passing-off theory. In order to receive this protection, the plaintiff must establish secondary meaning. The prevailing plaintiff, however, is left with the unsatisfactory knowledge that the defendant may still be permitted to use the same or similar title as long as the defendant includes a disclaimer. Plaintiffs in New York state courts, on the other hand, may avail themselves of the passing-off theory, the misappropriation doctrine, and an anti-dilution statute. While secondary meaning may assist plaintiffs in proving their claims in New York, they are not *required* to prove it.

Section 43(a) of the federal Lanham Act is not uniformly applied. State courts have construed the Lanham Act in a manner consistent with their respective attitudes towards title protection. Federal courts in California read a secondary meaning requirement into section 43(a), although this requirement is not explicitly stated in the language of the statute. Federal courts in New York appear to follow New York state courts' liberal bestowal of protection for titles in their interpretation of section 43(a).

To protect a single literary title in most jurisdictions, a producer must prove that his or her title has acquired secondary meaning. Although secondary meaning is not a requirement in New York, it still plays a prominent role in an unfair competition cause of action. To show secondary meaning, the producer must prove that, in the minds of a substantial number of people, the title has become associated with a single source. The general factors that the courts consider in determining whether a title has acquired secondary meaning are: (1) the advertising expenditures of the claimant, (2) consumer studies linking the name to its source, (3) the sales success of the work, (4) unsolicited media coverage, (5) the defendant's attempt to plagiarize the plaintiff's mark, and (6) the length and exclusivity of the use by the plaintiff.

Most jurisdictions also require a plaintiff to prove a likelihood of confusion between plaintiff's title and defendant's title. If it is difficult for the public to distinguish two works because of similarity of their titles, a claim for unfair competition may be on the horizon. The remedies available to the plaintiff depend on the strength of his or her claim.

If the plaintiff proves that actual confusion does exist, then likeli-

hood of confusion is established and damages may be available. When a plaintiff can show bad faith on the part of the defendant, the courts seem more willing to recognize likelihood of public confusion. Likewise, if a plaintiff can show that the public is likely to believe that he or she sponsored defendant's work, there is likelihood of confusion. A claim for likelihood of confusion in competing and non-competing markets is not as clear-cut. When the markets are in direct competition the courts are more apt to help the plaintiff. However, other factors, such as pecuniary interests, may weigh in favor of granting plaintiff the relief requested, even in non-competing markets.

Most entertainment title infringement cases are litigated in New York and California, but, as stated *supra*, the two jurisdictions have a surprisingly different attitude toward protecting entertainment titles. An analysis of recent decisions may help a party decide what elements to present to the court. However, one should realize that the outcome of a title infringement case will depend largely on what factors each particular court chooses to emphasize.

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