

Bad wedding time for trademarks and movies?

Difficulties in opposing a trademark which is also a film title or character have emerged from the Community practice. On March 19, 2009, the Fourth Board of Appeal dismissed the opposition lodged by Zorro Production Inc. against a Community word trademark application for ZORRO in class 34. The opponent indeed submitted evidence of a license agreement but failed to provide with samples of the licensed goods in class 34. For the other earlier trademarks for ZORRO argued as well-known, the Board took the view that whereas the character of ZORRO and the *Zorro films* were well known, this reputation was not automatically transferred to any of the products bearing the word ZORRO. Said character and *Zorro films* were regarded only as titles of literary and other artistic productions.

On June 30, 2009, the Court of First Instance dismissed the opposition brought by Danjaq LLC against Community word trademark application for Dr. No in classes 9, 12, 18, 25 and 32. The opposition was in particular based on the well-know trademarks for Dr. No. and Dr. NO. The Court upheld that use as a title was not sufficient to establish trademark rights in the sign, even if it was well-known. Earlier signs Dr. No. and Dr. NO were considered as not indicating the commercial origin of the films but rather their artistic origin. They indeed only helped to distinguish that particular film from the other of the “James Bond” series. The commercial origin of the company producing the films was rather shown through signs such as “007” or “James Bond” displayed on video cassettes or DVD.

On August 6, 2009, Danjaq LLC faced another negative decision. The OHIM rejected its opposition lodged against the word and device Community trademark for “From Russia with love” in class 14. The grounds were likelihood of confusion between its earlier registered trademark “From Russia with love” in class 9 and its earlier well-known trademark. The Opposition Division ruled again that “From Russia with love” was used as the title of the second film of the “James Bond” series and not as a trademark indicating the commercial origin of the goods involved. The OHIM added that use of that sign under license for watches, make-up, posters, music-recordings and books could not be considered as use as a trademark but only as a reference which was descriptive of the goods at hands because indicating that they related to the film “From Russia with love”.

Under Community practice filling as trademark a film title or character is consequently of limited to no efficiency when it comes to enforcing trademark rights before the OHIM against dissimilar products or services. Use of the mark cannot be demonstrated through license and reaching the reputation level proves to be hard task. Before the OHIM, preference should consequently rather be to oppose the film title under copyright protection as long as the specific requirements relating thereto are fulfilled.

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