

# Entertainment & Media Law Signal | Episode 17 – Trademarks

## SPEAKERS

David Steinberg, Meredith Bacal

### **David Steinberg** 00:04

After an extended hiatus, we'd like to welcome you back to the Entertainment and Media Law Signal podcast series, brought to you by Dentons. I'm David Steinberg, a partner in the Media and Entertainment group in Dentons. Toronto office. Joining me is Meredith Bacal, partner in the firm's intellectual property, and litigation and dispute resolution groups. Meredith has extensive experience litigating media, entertainment, defamation, and technology disputes. Today we're talking trademarks in the media and entertainment industry, that how trademarks differ from copyrights. Stay tuned.

### **Meredith Bacal** 00:43

Thanks so much for having me, David. Glad to be episode one back from the hiatus. Hopefully, this increase the viewers and doesn't turn them away?

### **David Steinberg** 00:55

Hard--, hardly, I think everyone's going to want to hear what you have to say so I'm just going to jump right into it. Meredith, trademarks are an interesting area within the entertainment space, mostly because there's a lot of misunderstanding and confusion as to when one should register if one should register or even attempt to do so. And it's kind of interesting, because we have so much intellectual property, obviously that flows through our industry. But trademarks kind of stand alone. And one thing I wanted to ask you, right off the bat is the difference between a trademark and a copyright, because I think a lot of people in our industry assume that they're sort of treated the same way.

### **Meredith Bacal** 01:50

Okay, so great question. They are two different branches of intellectual property, that are designed to protect different things, and also have different rights associated with them. So copyright is something that is free that is created automatically, when a person authors an original literary, dramatic, musical or artistic work. So you know, you make, you write a song, or tune, a movie, or book, a painting, just by virtue of its creation, you have copyright in it, there are benefits to registering it. In Canada, it's very inexpensive, and it's very fast, and there's no examination, but you don't need a registration. And the term of copyright in Canada is not forever, you have it for the life of the author, plus 70 years after they die. And once you die, the value of it goes to the estate of the of the creator. You know, that's all subject to assigning it to some company or some other person. Trademarks, on the other hand, seek to protect at its core branding. And it's supposed to signal to consumers a source of who created manufactured this particular good or service. And so, you know, you see, a particular logo can be a word mark, it could be a design mark, it could be a hologram of sound, a scent, it can be many things,

but if you come across as a consumer, this sign, or indicia, you know that it originates from a particular source and with it. certain qualities associated with it, you know, I like this brand. They make things ethically they make things that are of good quality, they make things that I think are delicious. So I know that if it has this symbol on it, I'm going to get it of a certain quality. The benefit of trademarks is if you apply to register the mark, you can have it forever if you are--, if you're using it, if it's not challenged, it's registered every 10 years from registration, you can renew it indefinitely so it can have a real benefit in that respect. Trademarks, you can have unregistered trademark, so I have common law rights. Meaning, you know, if I--, a third party can't copy or use that brand, or you can apply to register with the Canadian Intellectual Property Office. And so the benefit of doing that is that there's a mark on the register, on the Public Register that everyone knows, belongs to this owner. And so before they create their brand, they might come across it and say, 'Oh, no, David Steinberg has this mark already. And so I'm not going to go out and use this brand in connection with him with, in connection with similar goods, or services that are listed in his application for registration, because I don't want to get sued for trademark infringement.' Similarly, the benefit is if-- if you have a third party is infringing your your mark, or riding your coattails or creating some consumer confusion, then, if you have a registered mark, it's much easier to stop third parties. Now there's an assumed goodwill throughout all of Canada that you have with it, or any other countries that need file protection and connection in connection with your trademark. So you have a mark in China, the US, the UK, EU, Australia, wherever, then you have that protection extended in all those places.

**David Steinberg** 06:09

Okay, so there's a lot to unpack in there. So let's just, you know, drill down on a couple of points. Number one, you mentioned that copyrights are easy to register, and, and can be done quite cheaply, et cetera. Is that the same with trademark applications and registrations?

**Meredith Bacal** 06:33

Unfortunately not. So when the Canadian Intellectual Property Office picks up an application for a copyright registration, they're not examining it, they're not seeing whether or not it hit certain criteria, there's an online form you fill out so long as you answer the questions you felt you give the money, you're going to get that registration. Trademarks, on the other hand, can take years from when you file your application to when you get the registration, depending on a number of factors. But even if it's smooth sailing, nothing, no issues, we're looking at at least two years, on the-- on the-- on the-- on the quick as in Canada. And that would be very fast, at least at least two years, probably closer to three. Given the backlogs in the trademark office. Right now, though I have somewhere it's been four or five years to process through. The cost can be generally around \$2000-\$2500, at least, if you add more goods and services to the application, that costs can increase as well. If a third party wants to oppose the registration and your mark, or the trademark office says, 'No, no, David, there's an issue with your trademark application, there's this other mark on the register that we think is confusing, or it's not distinctive, or you know, you-- you say that you describe the goods and services in your application as follows. But we don't know what that means.' All of those things can increase the costs in getting that mark registered because you have to engage with the Trademark Office if you're using a lawyer, or maybe pay some fees if there's an opposition. So all those things really can add up both in time and in money.

**David Steinberg** 08:26

Right. So that that would give someone a little bit more pause in terms of proceeding - the cost, the time involved. And I guess part of the rubric here is that technically, you're acquiring a monopoly over those words in respect of those wares or services, so it's scrutinized heavily. It's not like a copyright where you've created it. And like you say, copyright emerges immediately upon creation, trademark, you sort of have to fight a little bit to get it, for lack of a better term. And that-- that leads me to my next question, which we get asked a lot. And we get asked this question in the context of companies that are emerging, film and television projects, and recording artists. They will often contact us and ask, 'Should I have a trademark? Do I really need to have one?'. And after educating them along the lines of where you've just gone you know the differences between trademark and copyright etcetera, they have a decision to make. So I'm curious as to when you think it's necessary for a company, a recording artist, a producer of a project, should apply for a trademark or not bother.

**Meredith Bacal** 10:02

I would say if the person wants to be able to prevent third parties from using that mark in connection with similar goods and services, then you should absolutely file an application for registration. So if you are a TV producer, you're about to exploit this work, you've invested a ton of money in it, you're going to go all over the world, it's going to be syndicated, or you think it might be, and you want to have the same brand, the same show name in every single jurisdiction, you're going to want to file in-- in those various countries, because it would be, it could be very bad for your entire brand strategy, and perhaps far more expensive than the cost of filing trademarks in each one of those countries if someone went out and filed a trademark application, it could be done in good faith by the third party. Or they might say, 'Oh, wow, look at this media darling in Canada, I bet this is gonna get picked up in the UK, I bet this is gonna get you know, this is going to be quite popular in China'. And, you know, there are many cases of nefarious individuals, seeing this and filing in different countries and holding these trademarks sort of somewhat hostage, forcing brands to rename projects in different countries. But you don't want to you don't want to just limit your consideration to the project at hand. You also want to think about merchandise. What else might you do or do you plan on doing in connection with this brand? Do I want to have t-shirts with the name of it or a key slogan from the show? Do I want to have mugs, beer glasses, sunglasses, or something connected to the show, if you have a show, you know about men, they wear very iconic sunglasses, perhaps you want, you're thinking about having a merch a licensing deal with a particular sunglasses brand. You might want to proactively file in connection with sunglasses so that way you have that protection, and nobody can get in your way.

**David Steinberg** 12:26

So you're really talking about the protection of the title or the name as against third parties who might come in, in good faith or even in bad faith to use it. But also in respect of a merchandising program where the trademark is going to appear on various items not even limited to the original thing. So you know, a rock band, for instance, that's, that's got a distinctive name, it's going to have merchandise, obviously, there's a merchandising program built around it. I can tell you that on film and television, I've noticed one very interesting thing lately, which is the same titles of films and TV series used by multiple producers and productions, that has become a more common issue. And I think part of it is because the the name may not be distinctive enough to get a trademark registration. For instance, there are a number of films that are called *Deception*, that one word.

**Meredith Bacal 13:36**

For sure. And part of that we were talking about filing and protecting but what you may also be wanting to do, and this is searching what else is on the register or searching what else is not on the register and doing a common law search and seeing what else is out there. Because if you do want to stop third parties from using your trademark, then you'll want to make sure it's distinctive. The Canadian Trademark Office will not permit the registration of marks that are not distinctive. They're taking quite an aggressive stance on this most recently. And if there are all these other marks, if even if you were able to get that registration, they would come back and say, 'Well, what are you talking about? Here are the 15 other *Deception* films, they're all different. There's no issue.' But if your motivator is, I want to stop third parties, then you're going to using something similar you're going to want to make sure that that is distinctive. And so if you do a search before or you see that okay, *Deception*, let's say dis- *Descruption* that is distinctive, okay, great. But there but you're planning on coming out with you really want to come up come out with coffee tumblers because the movies about a caffeinated axe murderer, ok, a highly caffeinated axe murderer who works at a popular cafe. Well, if there is a large coffee brand that has all sorts of coffee merchandise that with a trademark, then that might be a real problem for you. And they might come after you and say, well, you're tarnishing our brand. And we are going to make sure that you cannot and under any circumstances come up with your coffee tumblers as you propose to do so in your trademark application. So looking at the mark, both in terms of an enforcement perspective, a distinctiveness perspective, but also a defensive perspective, am I gonna get sued for using this brand? Because certainly, you don't want to have that cloud hanging over you when you're trying to exploit your work.

**David Steinberg 15:46**

Okay, so where things get very interesting to me, and what I've seen over my career, at various times, are more challenging and complex situations. For instance, if I were to take The Beatles as an example, they've obviously got trademark registrations everywhere, they've got them associated with any number of wares and services, etc, to protect their mark. But if I found that The Beatles had not registered, let's say, for the purposes of opening shoe stores, or coffee shops, and I wanted to open a coffee shop called The Beetles, The Beetles Coffee, or the Beetles Shoe Store, am I gonna have a problem?

**Meredith Bacal 16:34**

Well, two, two questions is how litigious have The Beatles and their management group been in enforcing and protecting their their trademarks. So regardless of the merits, if we're talking about an entity that is super defensive, and ensuring that nobody is even coming close to their space, that would be a consideration. Because you don't want to buy yourself litigation when you're branding. If The Beatles have a song about shoes - Maxwell's Silver Hammer was Maxwell Silver Mules or Heels, then they would have a much better argument to say you're trying to ride our coattails. That being said, if they have nothing in connection with shoes on any of their trademarks, they've never sold any merchandise, you'd have a pretty good defense to say, Listen, The Beatles, they're bugs. They don't own shoes. If you use the exact same spelling as The Beatles, and you were trying to ride their coattails, you might have an issue. And it will be and it would require the merits would really depend on whether or not they have any sort of connection to shoes, have they entered into licensing agreements

with third parties and that they actually do have acquired use in connection with shoes. But what I would, while we're not giving legal advice, and we'll provide some disclaimer at the end, yeah, um, follow a smell test. If you think you're trying to be clever, and you're riding on the coattails of another famous brand, chances are a judge will think that you're riding on the coattails of another famous brand and not like that. Famous brands in trademark law have a much broader protection than just the goods and services that are that they have been using, because they are so famous that any use in connection with this very distinctive mark is associated by consumers as coming from the source.

**David Steinberg** 18:45

Well, it's interesting, I just chose The Beatles off the top of my head. But as I'm thinking about it, the-- The Beatles had Apple Records, which was their independent record label and in the 60s, and and continued to exist thereafter. And Apple Computers, they had a litigation between the two, because I think that The Beatles saw that there was overlap, because Apple was getting into the music, business, etc. What about the concept of passing off, about, you know, in that example, the trademark owner saying you're trying to somehow mislead the public into thinking that we're associated with this when we are clearly not. Is that is that a helpful argument?

**Meredith Bacal** 19:34

That would be a very helpful argument for the Beatles in this scenario. So, passing off for the non-legal nerds listening to this, whoever you may be, is a cause of action that's effectively trademark infringement when you don't have a registered mark. So in order to establish passing off you need to have one, a trademark not-- not necessarily registered, but-- but some sort of signal indicia that we've talked about earlier, there needs to be a confusion in the marketplace, by consumers. And the third is that there needs to be damages or even a likelihood of damages. So sorry, damages or likelihood of damages caused by that confusion. So I see in your scenario, if consumers are mistakenly led to believe that the source of this product is The Beatles, the band, and they have nothing to do with it. And let's say that the product isn't great, it's not up to snuff. Or the The Beatles are getting calls without the shoes, they're out of stock, etc, then that is damaged their brand, their goodwill, then they'd have a very good passing off claim to say, 'We have a very good brand, and they're riding on our coattails. And it's damaging us.' Or maybe, 'We have a shoe work deal in the works'. So again, they this would be a good argument for them to say that you you're caught, you're causing this tort of passing off.

**David Steinberg** 21:15

I see. So I would say that, you know, in many cases, people are not registered, the trademarks are not registered, either in film and TV or--, or recording artists, I think recording artists, it's somewhat rare, unless they have a major record contract. And, you know, at that point, it's more likely that there are trademark registrations, but for bands that are touring around, and you know, making records and trying to establish themselves, they often don't have registered trademarks. If you have what you refer to earlier, as common law trademark rights. In other words, you've been using the mark, and correct me if I'm wrong, Meredith, but you've been using the mark, you've built up a degree of a market around that mark, people know it's you, they associate it with you. And now we're sort of growing, we're getting bigger, and somebody comes along and registers or applies for a trademark. If we were to, let's say, oppose the registration of that market came to our attention that a competing band was trying to apply for a trademark, which was our band name that we've been using for seven years. Again, without

getting into the legal advice, just in general terms, would they have a fighting chance of successfully opposing the registration of that mark?

**Meredith Bacal** 22:55

Yeah, if the client is this band that has been, you know, building up its reputation for years, gets wind of it, they would have, they would have a fighting chance to say 'No, no, we were using it first. It's our mark, we want to oppose it'. There's a few things you want to consider, though. One, by the time it comes to your client's attention, how long have these two bands been coexisting in the marketplace without any confusion. So if you're waiting until the mark gets opposed, it may be too late. because there hasn't been any confusion. One's an opera band singer, another's heavy metal, never the two shall meet. And you know, it's not that distinctive, or it's a person's name, and it wouldn't even be registerable to begin with. But also, the cost of an opposition proceeding, you know, which is when you go to the trademark office and say, 'Hey, this mark shouldn't be registered, you know, because it was filed in bad faith' or it's 'We're--, we're the ones who were entitled to register it, not the other party'. That's an expensive fight. If the band had filed the trademark application first, the trademark office would have handled all this for you to say, 'No, no, these guys were here first, sorry. Sorry, he who fought he or she even files first sort of wins in our eyes, and you can duke it out at an opposition'. So it's something you'll want to be monitoring and when you start taking off, then you might now have the resources. You didn't have the resources to file before but maybe you want to file now. Another benefit of filing and having that registration is that it can take a lot of the cost in enforcing your brand away, and what I mean by that is a lot of online retailers will pay a lot of heed to an IP complaint filed through their portal. So if you have a registered trademark, and somebody is selling something on an online marketplace, you can file in most cases, or in many cases, you can file a complaint through the IP portal and Many and many of these retailers have them or social media platforms have these types of things where you can say this is an IP dispute. And then you can say, well, this is trademark infringement, and then you can provide the details of your trademark registration. And then in many cases, assuming that you meet the criteria of those platforms, they will remove the infringing content for you. You don't need to pay for a lawyer to go to court. I mean, you still can and you can try to collect damages. But if your motivation here is to get the infringing content off, by virtue of having that registration, many of these platforms will just remove the the infringing content outright for you.

**David Steinberg** 25:57

I see. I've noticed that when people have a trademark, or even I don't even know if they do, but beside their name, you will see a little r in a circle or sometimes TM you know in letters, capital letters TM, is there a difference there? What—what--, what are they trying to signify?

**Meredith Bacal** 26:20

It's a great question that comes up a lot. And they do have similar overlapping meanings, but with a very important distinction. So an 'R' with a circle around it means that I have the right beside a word means or design means I have a registered trademark, not an application, but the trademark office has reviewed the entire trademark application, published it for opposition and then said you are entitled to this registered mark. And that tells the world that if you use this trademark, you may be liable for trademark infringement based on this registration. A TM beside a word says that provider of this good or service is using that word or design as a trademark. So, they may have a trademark application, they

may have a registration. They may not-- they may not have an application or registration, but they want to tell the world hey, this is a trademark. This isn't a descriptor, this is- this is a brand and public you should be aware that, you know, we are treating it as such, so don't infringe our trademark, please.

**David Steinberg** 27:34

I see. So that's the distinction. And when we see those, that's really what's going on. It's the concept of we're claiming that it's a mark or we're operating with it as a mark, as opposed to it actually having been registered. What about a situation with something like, let's say Coca Cola, where it's a word, but it's also a design? Is that-- is the trademark covering both of those things? Or do you have to register separately for the words versus the design? Or can you do it as one?

**Meredith Bacal** 28:11

You can do one, you can do both. And it depends on how much of the design is just text versus an image and what you really want to protect. And you know, big brand companies like to have families of marks, meaning I have lots of marks, I have a word mark, I have a design mark and the font in which we write it because we don't want anybody to use the font, something similar because that's extra protection. Plus we have another image and everything that's sort of Coca Cola-related has this big protection because we have so many trademarks that are similar but slightly different. And we use them all that it's telling the world 'Don't come close to us. We will come after you for an identical mark, similar mark, etc'. So, to come back to your initial question, you can file for a word mark, you can file for a design mark, you can file multiple, you might start out as just a trademark just in connection with CDs and the provision of music online streaming etc. But then you say well, we want to branch into merchandise. Now we want to we want to have a clothing line. And maybe we're going to have a vodka deal with a with a vodka supplier. So we also want a trademark application for vodka and baseball caps. And then five years later, you get a merchandise deal for cowboy boots. So then you file for cowboy boots and then over time, you can have this family of marks but you may also have put that all together in one application. So, just depends on what you filed in connection with, but you can have, it's called what we call family of marks or overlapping marks.

**David Steinberg** 30:07

Okay. All right, my last question, I want to have a little bit of fun. And I want to ask you something that may very well not have an answer or a definitive answer, but I just want to see how you react to it. In the context of documentary films, most of our clients who produce documentaries will ask that anyone that they're interviewing, not wear any clothing that has a trademark on it, or a character design. In other words, they don't want to interview somebody sitting there wearing a Simpsons t-shirt, or Coca Cola, or Pepsi or whatever brand. And in most cases, people comply with that, and they're wearing plain colored clothes without a trademark on it. But in certain cases, a person being interviewed may very well have a t-shirt or a baseball cap with a trademark. And I'm wondering if in the context of a documentary film, you feel that that would be a problem where someone, a trademark owner specifically, could make a successful claim that the trademark is being used and that there's an infringement without consent.

**Meredith Bacal** 31:34

So I think it really depends on what the documentary is about what the--, the context in which this person is wearing it. So let, I think the clearest example of this would be, I'm making a documentary where I am trashing big oil. And it's all about the environment and how terrible big oil is alleged to be in this context. I'm now interviewing a key witness-- witness or, I guess, expert in the field, and they are just saying all sorts of terrible things about one particular supplier. If they are wearing the--, or they don't name it by name, and they're being very cagey about it. But they're, they're being very cute, they're wearing a hat, they're wearing a t-shirt with this brand. In this case, that oil manufacturer might come after that, the documentarian to say 'You're depreciating the goodwill of our brand, what you said was false. And it's clear based on the use of this trademark, and design mark, that you are speaking about us in this context', and they would have a straight face case to make. I don't know how the court would rule, really depends on the facts of the case, and which judge you get, but that's, you know, you're you're going up big oil as against a documentarian, a documentary filmmaker, and we're talking about very different resource levels and litigation spend. And regardless of the merits, this entity might say, 'I want to send a message that if you do this, we are going to sue the pants off you'. And knowing that documentary filmmakers often are limited in their budget, it's it can just be a safer thing to say, please just don't wear a brand, let's not give ammunition to these brands to say that we've infringed or we've depreciated the goodwill and the brand, which is a standalone cause of action in Canada, so better to just avoid it altogether. And instead of the conversation being about the brand, let's make the conversation be about the documentary.

**David Steinberg** 34:08

Understood, that all makes sense. Well, thank you so much, Meredith. This was all incredibly helpful and wonderfully educational. And as usual, I learned a lot when I talked to you so very, very much appreciate it.

**Meredith Bacal** 34:27

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