

Copyright or Trademark? Can One Boy Wizard Prevent Film Title Duplication?

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I. INTRODUCTION

In 1989, the United States Court of Appeals for the Second Circuit stated, “the title of a movie may be both an integral element of the filmmaker’s expression as well as a significant means of marketing the film to the public.”¹ But similar film titles can cause movie-goers confusion.² To less educated film-goers, the movie *Hari Puttar: A Comedy of Terrors* might be confused with the J.K. Rowling stories of *Harry Potter*. At least, that is what Warner Brothers (WB) asserted when it claimed that Mirchi Movies’ film title infringed on the Harry Potter brand.³ With the globalization of the entertainment industry, there is a higher probability that movies are released with substantially similar titles, causing confusion among film-goers.⁴ First, this comment will examine the various approaches that India, the United Kingdom, and the United States take in dealing with film title disputes. Second, this comment will discuss a case brought by Warner Brothers regarding a Harry Potter film title dispute in India and how the outcome of the case affects title infringement issues.

1. Rogers v. Grimaldi, 875 F.2d 994, 998 (2d Cir. 1989).

2. *Name of the Bollywood Game: Titles Trigger Disputes*, YAHOO! INDIA MOVIES, June 14, 2007, http://in.movies.yahoo.com/news-detail-print.html?news_id=27281.

3. Randeep Ramesh, *Harry Potter: Hollywood Takes on Bollywood with Lawsuit Against Hari Puttar*, THE GUARDIAN, Sept. 18, 2008, International, at 25, available at <http://www.guardian.co.uk/film/2008/sep/16/harrypotter.harrypotter>.

4. Jan Klink, *Titles in Europe: Trade Names, Copyright Works or Title Marks*, 26 EUR. INTELL. PROP. REV. 291 (2004).

Many are confused about whether trademark or copyright law governs the title of a creative work.⁵ Should countries use copyright laws in addition to trademark laws to govern the registration of movie titles? Third, this comment will argue that countries should use a combination of copyright and trademark law to govern titles of creative film works so as to provide the maximum intellectual property protection for film titles. Finally, the comment will discuss a possible loophole in current trademark regulations regarding film titles that will support the argument that countries should use both copyright and trademark law to minimize the release of film titles that are similar or identical to those already on the market.

II. LAWS GOVERNING FILM TITLE RIGHTS IN THE UNITED STATES, INDIA, AND THE UNITED KINGDOM

A. *United States*

In the United States, trademark law governs literary titles.⁶ Film titles, specifically, qualify as service marks.⁷ Under the Lanham Act, a service mark includes “any word, name, symbol, or device, or any combination thereof” that is used in commerce to distinguish services from other similar services and to identify the source of the services.⁸ The statute specifically states that titles of radio or television programs may be registered as service marks.⁹ Film titles are likely to fall under the same category.

Film titles are analogous to book titles with respect to trademark and copyright law.¹⁰ A book series can be trademarked, but a single creative

5. Amrithesh Mishra, *Disputes Regarding The Title of Films and Books*, LEGAL SERVICEINDIA, Dec. 6, 2007, <http://www.legalserviceindia.com/article/print.asp?id=126>.

6. 2 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION §10:1 (4th ed. 2008); *see also* Warner Bros. Pictures v. Majestic Pictures Corp., 70 F.2d 310, 312 (2d Cir. 1934) (stating that the title of a copyrighted work does not enjoy absolute protection against use by others).

7. Harun Kazmi, *How to Register a Movie Title as a Mark: U.S. and U.K.*, 12 J. CONTEMP. LEGAL ISSUES 428, 429 (2001).

8. Lanham Act § 45, 15 U.S.C. § 1127 (2006).

9. *Id.* (“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.”)

10. *See* MCCARTHY, *supra* note 6 (“The term ‘literary title’ is used here to encompass titles of books . . . motion pictures, television series. In general, such titles are protected according to the fundamental tenets of trademark and unfair competition law.”)

work cannot.¹¹ For example, the Harry Potter books may be trademarked as a series, but the individual books comprising the series may not. The rationale is that because each book has its own title, the name for a series of books is not descriptive of each book individually.¹² Such is the holding in *In re Cooper*, which is still followed by lower U.S. courts.¹³ The opinion further states that the public does not associate a literary title of a single work with its publisher or printer,¹⁴ and because a name is merely a descriptor, titles of single creative works are not registrable as trademarks.¹⁵ Under the Lanham Act, a trademark is not registrable if the mark is “merely descriptive or deceptively misdescriptive.”¹⁶ However, literary titles, over time, can receive common law protection due to the acquisition of secondary meaning.¹⁷ Secondary meaning, as applied to film titles, occurs when the public associates the film with the goodwill that the film has garnered through public distribution and advertising.¹⁸

In the United States, trademark infringement hinges on the likelihood of consumer confusion.¹⁹ For a plaintiff to be successful on a trademark infringement claim, the plaintiff must show that he has a valid mark entitled to protection under the Lanham Act,²⁰ and that the defendant used the plaintiff’s mark in commerce in association with the plaintiff’s goods or services without plaintiff’s consent.²¹ U.S. courts use a variety of factors to decide whether a likelihood of confusion exists between related goods: (1) the strength of the mark; (2) how closely related the

That is, such titles cannot be used by a junior user in such a way as to create a likelihood of confusion of source, affiliation, sponsorship or connection in the minds of potential buyers. For these purposes, titles of literary and entertainment creations and works are treated in much the same way as the trademarks of other commercial commodities.”); UNITED STATES COPYRIGHT OFFICE, COPYRIGHT BASICS 3 (2008) *available at* <http://www.copyright.gov/circs/circ01.pdf> (titles, names, and short phrases are not eligible for U.S. copyright protection).

11. *Id.* at §§ 10:4, 10:6.

12. *In re Cooper*, 254 F.2d 611, 615–16 (C.C.P.A. 1958).

13. *See Herbko Int’l Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1162 (Fed. Cir. 2002).

14. *In re Cooper*, 254 F.2d at 615–16.

15. *Id.*

16. Lanham Act § 2, 15 U.S.C. § 1052 (2006).

17. *Brandon v. Regents of Univ. of Cal.*, 441 F. Supp. 1086, 1091 (D. Mass. 1977) (stating that a movie title may gain common law protection over time once it acquires secondary meaning).

18. *Id.* (citing *National Picture Theatres, Inc. v. Foundation Film Corp.*, 266 F. 208, 210–11 (2d Cir. 1920)).

19. ARTHUR R. MILLER & MICHAEL H. DAVIS, *INTELLECTUAL PROPERTY* 263–64 (4th ed. 2007).

20. For purposes of this Comment, only the federal trademark system is considered. However, trademarks can also be acquired under common law and state law. *See id.* at 159, 201.

21. *1-800 Contacts, Inc. v. WhenU.com, Inc.*, 414 F.3d 400, 406–07 (2d Cir. 2005).

goods are; (3) the similarity of the marks; (4) evidence of actual confusion; (5) the marketing channels used; (6) the type of goods and the degree of care the purchaser is likely to exercise; (7) the defendant's intent in choosing that particular mark; and (8) the likelihood of expanding the product.²² Issues such as passing off and initial interest confusion also help determine the likelihood of confusion. Passing off occurs when the defendant subjectively and knowingly intends to confuse buyers and pass off the defendant's product for the plaintiff's.²³ In other words, passing off refers to the likelihood that the public will mistake the defendant's product for that of the plaintiff. Additionally, initial interest confusion occurs when a competitor initially lures customers by passing off his goods as another's, even though the consumer realizes the product is not the product he originally intended to get at the time of the sale.²⁴ Such acts affect consumer decision-making and cause producers of goods to suffer by losing business to those who successfully trade on consumer confusion.

1. U.S. Efforts to Prevent Title Similarity

To prevent the release of films with similar titles, the Motion Picture Association of America (MPAA)²⁵ created the Title Registration Bureau (TRB)²⁶ in 1925.²⁷ Signatories of the TRB include seven major studios,²⁸

22. *Visible System Corp. v Unisys Corp.*, 551 F.3d 65, 73 (1st Cir. 2008); *Abercrombie & Fitch Co. v. Moose Creek, Inc.*, 486 F.3d 629, 633 (9th Cir. 2007); *Beacon Mut. Ins. Co. v. OneBeacon Ins. Group*, 376 F.3d 8, 15 (1st Cir. 2004).

23. ROGER E. SCHECHTER & JOHN R. THOMAS, *INTELLECTUAL PROPERTY THE LAW OF COPYRIGHTS, PATENTS AND TRADEMARKS* 675–76 (2003).

24. *Dorr-Oliver, Inc. v. Fluid-Quip, Inc.*, 94 F.3d 376, 382 (7th Cir. 1996).

25. The MPAA is a trade association to which many of the major film studios, as well as independent producers, belong. KELLY C. CRABB, *THE MOVIE BUSINESS* 282 (2005).

26. Jill Hunter Pellettieri, *Double Trouble*, SLATE, May 12, 2005, <http://www.slate.com/id/2118602>.

27. Matthew Beloni, *Studios, Lawyers Play Name Game with Film Titles*, REUTERS, Nov. 11, 2008, <http://www.reuters.com/article/entertainmentNews/idUSTRE4AB0D220081112?pageNumber=1&virtualBrandChannel=0>. See also Sumner Smith, *Registration of Titles: It's a Never-Ending Job*, BOXOFFICE, Dec. 29, 1956, http://issuu.com/boxoffice/docs/boxoffice_122956/22?zoomed=&zoomPercent=&zoomX=&zoomY=¬eText=¬eX=¬eY=&viewMode=magazine.

28. Pellettieri, *supra* note 26. The seven major studios are Paramount, Buena Vista, MGM, Sony, 20th Century Fox, Universal, and Warner Brothers. *Id.*

as well as a number of independent production companies.²⁹ Members pay a subscription rate to the TRB and are sent listings of every new film title registered.³⁰ However, there are additional charges to actually register a title.³¹ Once a title is registered, other subscribers can contest any registered title,³² which then spurs arbitration, over which the MPAA presides,³³ unless the companies can negotiate an agreement among themselves.³⁴ If two movies with similar content and titles will likely confuse the public if the movies are released in the market at the same time, the MPAA will not allow the production companies to use the similar titles for their respective films.³⁵ This process is appealable.³⁶

The protection the TRB offers, however, is limited. The members of the TRB contractually agree not to infringe on registered film titles.³⁷ Therefore the contract applies only to signatories.³⁸ Those who are not bound to the TRB agreement are therefore eligible to sue members of the TRB for trademark infringement or unfair competition.³⁹ For this reason, some attorneys advise their clients against registering their film titles with the MPAA because there is little point in participating in a system that only gives limited protection.⁴⁰

2. U.S. Copyright Law

In the United States, film titles are exclusively governed by the principles of trademark law, especially because short phrases and titles

29. Matthew Heller, *What's in a Name: Film Title Disputes Raise Legal, Business Questions*, Feb. 14, 2007, <http://www.allbusiness.com/services/legal-services/4468289-1.html>.

30. *Id.*

31. *Id.*

32. Pellettieri, *supra* note 26.

33. *Id.*

34. Heller, *supra* note 29 (“Some registrations are permanent—that is, the registrant gets exclusive rights to the title, which it can license to another. A subscriber is entitled to register up to 500 titles permanently that are based on an original screenplay; the MPAA allows unlimited permanent registrations of titles based on underlying works. Only the titles of movies that have been theatrically released in the U.S. are entitled to permanent protection. Titles of unreleased movies can be registered for a year and renewed if the film is not made.”).

35. *Id.*

36. Pellettieri, *supra* note 26.

37. Mark Litwak, Mark Litwak’s Entertainment Law Resources, Frequently Asked Questions Archive, <http://www.marklitwak.com/faq/titles.html> (last visited Oct. 21, 2009).

38. *Id.*

39. *See generally* Erica Gimenes, ‘Driven’ into Court, HOLLYWOOD.COM, May 2, 2001, http://www.hollywood.com/news/Driven_into_court/414557.

40. Heller, *supra* note 29. Mark Litwak of Litwak & Associates in Beverly Hills states, “I usually advise (independent producer) clients not to participate in the MPAA system You don’t have much protection when you can still be sued (by a nonsubscriber) for trademark infringement or unfair competition.” *Id.*

cannot be copyrighted as literary works under the 1976 Copyright Act.⁴¹ Furthermore, film titles are names, essentially descriptive of the content of the work.⁴² The Copyright Act states that copyright protection applies only to “original works of authorship.”⁴³ Works of authorship include (1) literary works; (2) musical works; (3) dramatic works; (4) pantomimes and choreographic works; (5) pictorial, graphic, and sculptural works; (6) motion pictures and other audiovisual works; (7) sound recordings; and (8) architectural works.⁴⁴ However, the U.S. Copyright Office states that names, titles, and other short phrases do not exhibit “a certain minimum amount of authorship” in one of the above enumerated works of authorship.⁴⁵ The Office implies that names, titles, and other short phrases are either unoriginal or constitute ideas and concepts that cannot be copyrighted.⁴⁶ However, the Copyright Clause in the Constitution and the Copyright Act are both silent on the issue of whether names, titles, and other short phrases are copyrightable.⁴⁷ Nonetheless, the statutory construction by courts⁴⁸ and the Copyright Office⁴⁹ have stated that titles, and the like, cannot enjoy statutory copyright protection.⁵⁰

41. U.S. COPYRIGHT OFFICE, COPYRIGHT PROTECTION NOT AVAILABLE FOR NAMES, TITLES, OR SHORT PHRASES 1 (2006), <http://www.copyright.gov/circs/circ34.pdf>. See *Alberto-Culver Co. v. Andrea Dumon, Inc.*, 466 F.2d 705, 710 (7th Cir. 1972).

42. *In re Cooper*, 254 F.2d 611, 615–16 (C.C.P.A. 1958).

43. 17 U.S.C. § 102(a) (2006).

44. 17 U.S.C. § 102(a) (2006).

45. U.S. COPYRIGHT OFFICE, *supra* note 41.

46. *Id.*; 17 U.S.C. § 102(b).

47. 1 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 2.16 (2008).

48. *Duff v. Kansas City Star Co.*, 299 F.2d 320 (8th Cir. 1962); *Becker v. Loew's, Inc.*, 133 F.2d 889 (7th Cir. 1943); *Warner Bros. Pictures v. Majestic Pictures Corp.*, 70 F.2d 310 (2d Cir. 1934).

49. 37 C.F.R. § 202.1(a) (1959).

50. *But see* NIMMER, *supra* note 47, § 2.16 (2008) (“Often the primary commercial value in a copyrighted work will lie in its title. For instance, a great deal of money may be expended in purchasing motion picture rights in a copyrighted work which is itself based upon public domain materials where substantially the only value acquired is the use of a well known and publicly accepted title, since the remainder of the motion picture will borrow from the public domain materials, but not from the copyrighted work. It is rather surprising, then, that for the most part, copyright may not be claimed in a title As a matter of first impression, it might well be argued that fanciful original titles should be regarded as a form of literary expression, protectable under the copyright laws.”) Nonetheless, Nimmer states that titles are not eligible for statutory copyright protection. *Id.*

B. India

Bollywood, India's Hollywood equivalent, produces 800 films a year, and is the world's leader in the film industry.⁵¹ By 2010, India's movie and entertainment industry is expected to earn \$19 billion.⁵² Therefore, intellectual property rights are, and will continue to be, an important factor to Bollywood's success.⁵³

In India, film titles are protected under Indian trademark law.⁵⁴ Under the Trade Marks Act (1999), a mark is defined as "a device, brand, heading, label, ticket, name, signature, word, letter, numeral, shape of goods, packaging or combination of colours or any combination thereof."⁵⁵ In *Kanungo Media Ltd. v. RGV Film Factory*, a Delhi High Court case, the plaintiff sought an injunction against a film production company for title misappropriation.⁵⁶ In his opinion, Judge Sikri stated that trademark and unfair competition laws afford literary titles legal protection.⁵⁷ The term "literary titles" refers to titles of books, periodicals, newspapers, plays, motion pictures, television series, songs, etc.⁵⁸ Thus, trademarks of literary titles are treated as if they are trademarks of commercial goods; potential buyers should not be confused as to the affiliation or source of the film.⁵⁹ The Court made a distinction between types of works and stated that the rules differ, however, depending on whether the disputed title is a title of a single literary work or titles of a series of literary works.⁶⁰ Titles of a literary series of works are registrable under trademark law, but titles of single literary works are not.⁶¹

Furthermore, legal actions differ for a registered trademark, as opposed to an unregistered trademark. A registered trademark is infringed when any person "uses in the course of trade a mark which is identical to, or deceptively similar with, the trade mark in relation to any goods for

51. SHERRI L. BURR, ENTERTAINMENT LAW 318 (2d. ed. 2007).

52. *Id.*

53. Navdeep Kaur Tucker, *Musical Copyright Infringement in Bollywood Music*, 26 ENT. & SPORTS LAW. 18, 18–19 (2008).

54. *See Kanungo Media Ltd. v. RGV Film Factory*, IA No. 1979/2007 in CS(OS) No.324/2007, para. 13 (Feb. 21, 2007) (India), <http://indiankanoon.org/doc/225324/>.

55. The Trade Marks Act § 2(m), No. 47 of 1999; India Code (1999), available at <http://indiacode.nic.in/> (select "Short Title"; then search for "The Trade Marks Act"; then select "Download full act").

56. *Kanungo*, para. 1.

57. *Id.* para. 13.

58. *Id.* para. 11 (citing 1 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION (3rd ed. 2008)).

59. *See id.* para. 13.

60. *Id.* paras. 14, 15, 18.

61. *Id.* para. 15 (stating that single literary works enjoy trademark protection if there is a showing of secondary meaning and consumer recognition).

which the said trade mark is registered.”⁶² For unregistered trademarks, a plaintiff can bring a common law action of passing off,⁶³ which is described in section 134(c) of the Trade Marks Act (1999) as “arising out of the use by the defendant of any trade mark which is identical with or deceptively similar to the plaintiff’s trade mark.”⁶⁴

Passing off is a form of unfair competition where one product mimics another product for the purpose of being mistaken for the original product.⁶⁵ Essentially, plaintiffs who bring suit for literary title misappropriation claim that the defendant is passing off.⁶⁶ To be successful on a passing off claim, the plaintiff must prove that the plaintiff has used a valid trademark in commerce, the trademark is recognizable in relation to the plaintiff’s goods or business, and the defendant’s use of an identical or similar mark creates confusion among members of the public such that the public believes the plaintiff’s goods are somehow connected to those of the defendant.⁶⁷

Confusion and reputation in the market are important to a passing off claim and are thus important in the success of film title appropriation cases.⁶⁸ To establish confusion, the plaintiff must also prove that the literary title has garnered a secondary meaning.⁶⁹ To show that a title has gained secondary meaning, the plaintiff must show that the consumer public will associate the disputed title with the efforts of the plaintiff’s literary work.⁷⁰

62. DIANA SHARPE, *PROTECTING INTELLECTUAL PROPERTY IN ASIA-PACIFIC* 61 (2d ed. 1989).

63. *Id.* at 62.

64. The Trade Marks Act § 134(c), No. 47 of 1999; India Code (1999), available at <http://indiacode.nic.in/> (select “Short Title”; then search for “The Trade Marks Act”; then select “Download full act”).

65. I MCCARTHY, *supra* note 6, at § 1:12. See The Trade Marks Act § 27(2); Kanungo Media Ltd. v. RGV Film Factory, IA No. 1979/2007 in CS(OS) No.324/2007, para. 37 (Feb. 21, 2007), <http://indiankanoon.org/doc/225324/>.

66. See Kanungo Media Ltd. v. RGV Film Factory, IA No. 1979/2007 in CS (OS) No.324/2007, para. 1 (Feb. 21, 2007) (India), available at <http://indiankanoon.org/doc/225324/>. See also Warner Bros. Entm’t v. Kohli, IA No.9600/2008 in CS(OS) 1607/2008, para. 1 (India Sept. 22, 2008), available at <http://indiankanoon.org/doc/395839/>.

67. Pravin Anand, *India: Trademarks*, in *INTERNATIONAL INTELLECTUAL PROPERTY LAW: GLOBAL JURISDICTIONS* 82 (Dennis Campbell & Susan Cotter eds., 1996).

68. See Klink, *supra* note 4, at 292–93.

69. Kanungo Media Ltd. v. RGV Film Factory, IA No. 1979/2007 in CS (OS) No.324/2007, para. 18 (Feb. 21, 2007) (India), available at <http://indiankanoon.org/doc/225324/>.

70. *Id.* para. 19.

1. Indian Efforts to Reduce Title Similarity

In an attempt to prevent the release of films with very similar titles, Indian film trade associations have put a registration system in place. Bollywood filmmakers register their titles with the Title Registration Committee of the Indian Motion Picture Producers' Association (IMPPA), the Film and Television Producers' Guild of India, or the Association of Motion Pictures and Television Programme Producers (AMPTPP).⁷¹ However, advocates note that filmmakers should also register their film titles with the Copyright Board,⁷² even though registration under the Indian Copyright Act is optional.⁷³ Advocate Atul Mankame believes that registering Bollywood titles with the Copyright Board proves "ownership of [the] work and title and all rights envisaged in the work, for enforcing legal remedies in case of infringement of rights, to claim rights of ownership, for protection and acknowledgement in 136 countries and to enforce moral rights."⁷⁴ But as of September 2008, no film titles had been registered with the Indian Copyright Board,⁷⁵ perhaps because film titles are not protected under the Indian Copyright Act.

2. Indian Copyright Law

The Indian Copyright Act (1957) protects "original literary, dramatic, musical and artistic works."⁷⁶ A copyright under the Indian Copyright Act gives the owner the exclusive right to reproduce, distribute, publicly perform or communicate, translate, or adapt their work, which includes making any cinematograph film or sound recording of the work.⁷⁷

71. *Bollywood Titles Must be Registered with Copyright Board: Expert*, THE ECONOMIC TIMES, Sept. 18, 2008 [hereinafter *Bollywood Titles*], <http://economictimes.indiatimes.com/rssarticleshow/msid-3498519,prtpage-1.cms>.

72. *Id.* It is unclear whether Mankame is lumping the title of a film with the contents of the film. The article speaks of intellectual property rights in the title and contents of the work in general, and often uses or confuses the contents of a work with a film title. *Id.*

73. SHARPE, *supra* note 62, at 54.

74. *Bollywood Titles*, *supra* note 71.

75. *Id.* Furthermore, Indian courts have stated that trademark law, rather than copyright law, governs film titles. *Kanungo Media Ltd. v. RGV Film Factory*, IA No. 1979/2007 in CS (OS) No.324/2007, para. 13 (Feb. 21, 2007) (India), *available at* <http://indiankanoon.org/doc/225324/>.

76. *Intellectual Property Rights in India*, Embassy of India, http://www.indianembassy.org/policy/ipr/ipr_2000.htm.

77. The Copyright Act, ch. III, § 14, No. 14 of 1957; India Code (1993), *available at* <http://indiacode.nic.in/> (select "Short Title"; then search for "The Copyright Act"; then select "Download full act").

Therefore the owner of a copyright has the exclusive right in India⁷⁸ to either “communicate [a film title] to the public” or “to reproduce the work in any material form.”⁷⁹ Infringement on a copyrighted work occurs when the protected work is communicated to the public, reproduced without the owner’s consent, or any other exclusive right that the Act bestows upon the owner of the copyright.⁸⁰ The Indian Copyright Act defines “communication to the public” as making the work available to the public by display or dissemination regardless of whether the public actually sees or hears the work.⁸¹ Any display of a copyrighted work can be infringement under the Indian Copyright Act. Thus, a film title, if promoted by use of posters, advertisements, etc., could be a product of a communication to the public. Section 44 of the Copyright Act describes the information that is listed on a registered copyright: (1) the name or title of the work; and (2) the names and addresses of the authors, publishers and registered owners of the copyright.⁸² Nonetheless, Indian copyright law does not apply to the title of films.⁸³ The Indian Copyright Act states that literary works are protectable; however, the Act fails to address the protection of *titles*. Rather, the Act refers to titles only as an identifier of a body of work.⁸⁴ Regardless, the IMPPA and other film trade bodies are encouraging people to register their creative works, as well as their titles, with the Indian Copyright Board.⁸⁵

C. United Kingdom

1. U.K. Trademark Law

The United Kingdom treats titles of works as trade names and applies the common law principles of passing off to title misappropriation

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78. The Copyright Act, ch. IV § 19(6) (India).
 79. The Copyright Act, ch. III § 14 (India).
 80. The Copyright Act, ch. XI § 51(a)(i) (India).
 81. The Copyright Act, ch. II § 2(e)(ff) (India).
 82. Mishra, *supra* note 5.
 83. Kanungo Media Ltd. v. RGV Film Factory, IA No. 1979/2007 in CS(OS) No.324/2007, para. 12 (Feb. 21, 2007), <http://indiankanoon.org/doc/225324/>; *but see Bollywood Titles*, *supra* note 71.
 84. *See* The Copyright Act, ch. XI § 52(g), (i) (India).
 85. *Bollywood Titles*, *supra* note 71.

cases.⁸⁶ For a plaintiff to be successful in a case for passing off a title, the plaintiff must show that the title has acquired goodwill, that the allegedly infringing title is so similar to the plaintiff's title that it causes confusion to members of the ordinary public, and that the confusion is likely to cause damage to the plaintiff.⁸⁷ But it may take a long time for a title, especially a film title, to build up enough goodwill or reputation sufficient to prevail in a trade name infringement dispute. Scholar Jan Klink surmises that the goodwill and reputation requirement is a high standard that makes it very difficult to acquire rights in a title if the title is not converted into a trade name.⁸⁸

In general, literary titles may not be registered as trademarks.⁸⁹ In *Mothercare U.K. Ltd. v. Penguin Books Ltd.*, a U.K. Court of Appeal stated that literary titles are inherently descriptive of the contents of the work,⁹⁰ and a trademark cannot be registered if it is merely descriptive of the goods or services the producer provides.⁹¹ However, the Trade Marks Registry has adopted the Penguin Practice,⁹² which allows registration of descriptive trademarks. But these trademarks are limited and exclude protection of goods related to the object the trademark describes.⁹³ For example, the Trade Marks Registry registered the mark "Chariots of War," but limited trademark protection by stating that the mark did not include "goods relating to cars or carriages adapted for use in warfare."⁹⁴

86. Klink, *supra* note 4, at 291–92 (explaining that titles are too descriptive of the content of the work and do not identify the source of the publishing house or film studio responsible for the work's distribution).

87. *Id.*

88. *Id.* at 293.

89. See Bach Flower Remedies Trademark, [1992] R.P.C. 439, 452 (stating "legitimate use in titles of books and publications of words in everyday use which happen to constitute a trade mark can be distinguished from use of the same words by proprietors for whom those words on their own have become distinctive trade marks, and may have been registered as such."). *But see* Kazmi, *supra* note 7, at 431 (explaining that the registration of movie titles in the U.K. is less problematic than in the U.S.).

90. See *Mothercare U.K. Ltd. v. Penguin Books Ltd.*, [1988] 6 R.P.C. 113, 119 (Court of Appeal) (stating that words in the title of a book merely describe what the book is about).

91. Colleen Donovan & Steven Jennings, *Trade Marks and Book Titles*, 5 ENT. L.R. 1994 38, 38–39 ("As a matter of ordinary English usage, therefore, a book title is fundamentally a description of the nature or contents of the book to which it relates, even if the descriptive nature of the title is not immediately apparent to someone with no knowledge of the contents of the book.").

92. *Id.* at 39. Penguin Practice is a term derived from a 1939 trademark application from Penguin Books to register the trademark "Penguin" for books and publications. *Id.*

93. *Id.* By adopting the Penguin Practice, the Trade Marks Registry acknowledges that the public may purchase products based on the subject matter, author and title, rather than the trademark. *Id.*

94. *Id.*

2. Movie Title Registration in the U.K.

Unlike the U.S., the U.K. seems more willing to register film titles as trademarks.⁹⁵ The United States Patent and Trademark Office will not register the title of a single literary work, such as the title of a book, movie, video game, etc. as a trademark.⁹⁶ The United Kingdom may register film titles of single works, rather than a series of works, as trademarks once the title has achieved secondary meaning through use of the title as a mark.⁹⁷ Furthermore, scholarly authorities conjecture that the Penguin Practice may also be applicable to the registration of film titles as trademarks.⁹⁸ If a film title has “descriptive connotation,”⁹⁹ then the film title is not objectionable under § 3(1) of the Trade Marks Act 1994.¹⁰⁰

3. U.K. Copyright Law

Copyright law does not govern titles in the U.K.¹⁰¹ In *Maxwell v. Hogg*, the Court of Appeal in Chancery ruled that neither Maxwell nor Hogg had a copyright in the magazine title “Belgravia” even though they both attempted to register the title with the government.¹⁰² Instead, the

95. Kazmi, *supra* note 7. Unlike the Lanham Act (U.S.), the U.K. Trade Marks Act of 1994 does not distinguish between service marks and trademarks. Section 1 states, “In this Act a ‘trade mark’ means any sign capable of being represented graphically which is capable of distinguishing goods or services of one undertaking from those of other undertakings”

96. 2 MCCARTHY, *supra* note 6, § 10:4.

97. Kazmi, *supra* note 7, at 431–32. Unlike the U.S., the U.K. is willing to register the title of a single movie once the title has achieved secondary meaning. *Id.* Like the U.S., the U.K. will register trademarks that have not yet been used in U.K. commerce. Yet, it seems that movie titles of single works can only acquire secondary meaning through use and must therefore be used in commerce before the U.K. Trade Marks Registry will be willing to register the film title as a trademark. *Id.*

98. *See id.* at footnote 20. “The U.K. equivalent of the U.S. Trademark Manual of Examining Procedure states: ‘The names of books, films and shows and the like may be distinctive trade marks. Where objections under [Trade Marks Act 1994] Section 3(1)(b) and (c) arise because of descriptive connotations and the like, they can normally be overcome by way of an appropriate exclusion.’” *Id.* at 431.

99. *Id.* Descriptive connotation seems to be the U.K. equivalent to secondary meaning.

100. Trade Marks Act, 1994, § 3(1) (U.K.).

101. *Dicks v. Yates*, (18881) 18 L.R. ch. D. 76, 80. *See also Exxon Corp. v. Exxon Ins. Consultants*, [1982] R.P.C. 69, 69–70 (holding that a literary work must provide either information and instruction or pleasure in the form of literary enjoyment and that the title Exxon, although original, was not a literary work and therefore did not enjoy copyright protection).

102. *See Maxwell v. Hogg*, (1867) 2 L.R. 307, 314–15 (Ch. App.).

Court implied that trademark law applied to titles because the property right the parties vied for in the title would only come to fruition if the magazine were sold in commerce.¹⁰³

If film titles were to be protected under the Copyright, Designs and Patents Act (1988) (CDPA), they would most likely fall under the “literary works” classification.¹⁰⁴ Under the 1988 Act, a literary work is any work that is written, spoken, or sung, but not a dramatic or musical work.¹⁰⁵ According to the High Chancery Court case, *JHP Ltd v. BBC Worldwide Ltd*, copyright protects *original* literary works.¹⁰⁶ The term “original” means that the work originates with the author who put the effort into creating the copyrighted work.¹⁰⁷

An owner of a valid copyright under U.K. law has similar rights to those of a U.S. copyright holder. Section 16 of the Copyright, Designs and Patents Act provides the copyright holder with the right to copy, issue copies to the public, perform or display the work in public, broadcast the work, and make an adaptation of the work.¹⁰⁸ Section 16 goes on to state that infringement occurs when a person, against the copyright holder’s wishes, commits acts specifically reserved for the copyright holder¹⁰⁹ in relation to the work as a whole or a substantial part of the protected work.¹¹⁰

Significantly, the United Kingdom protects the moral rights of an author of a copyrighted work.¹¹¹ Under the CDPA, the moral right is a separate right from the copyright.¹¹² Generally, moral rights entitle the author to prevent the distortion, modification, or mutilation of a copyrighted work.¹¹³ The CDPA affords the author of a copyrighted

103. *Id.* at 313 (“What applies to the case of trade marks upon goods, will, as it seems to me, equally well apply to the present case.”) (Sir G. J. Turner, L.J.) Sir H.M. Cairns, L.J. further stated that neither the plaintiff nor the defendant owned a trademark in the title “Belgravia” because “property in the word could not be acquired until the vendible article was put upon the market.” *Id.* at 314.

104. *See Exxon Corp. v. Exxon Ins. Consultants*, [1982] 3 R.P.C. 69, 75 (discussing whether or not the single word Exxon as a title qualified as an “original literary work.”).

105. Copyright, Designs and Patents Act, 1988, c. I, §3(1) (U.K.).

106. *JHP Ltd v. BBC Worldwide Ltd*, (2008) F.S.R. 29, 732 (Ch.) (emphasis added).

107. *Id.*

108. Copyright, Designs and Patents Act, 1988, c. II, § 16(1) (U.K.).

109. *Id.* at §§ 17–21 (stating that infringement occurs when a person copies, distributes copies, publicly displays or performs, broadcasts, or makes adaptations of the copyrighted work against the copyright owner’s wishes).

110. *Id.* § 16(2)–(3).

111. Copyright, Designs and Patents Act, 1988, c. IV (U.K.).

112. Irini A. Stamatoudi, *Moral Rights of Authors in England: The Missing Emphasis on the Role of Creators*, 1 I.P.Q. 478, 489 (1997).

113. Agustin Waisman, *Rethinking the Moral Right to Integrity*, I.P.Q. 2008, 3, 268–85.

work a paternity right¹¹⁴ to be identified as the author of the copyrighted work.¹¹⁵ But, the author must assert his right in writing before the right takes effect.¹¹⁶ Authors also have the right to object to the offensive treatment of their works.¹¹⁷ Furthermore, the CDPA establishes a right against false attribution where a person has the right not to have a work falsely attributed to him nor can the author falsely claim someone else's work as his own.¹¹⁸

III. USING COPYRIGHTED CHARACTER NAMES IN TITLES—IP IMPLICATIONS

All three jurisdictions discussed within this comment treat film title rights with trademark law principles. If trademark law applies, can authors use copyright laws to circumvent the trademark laws that govern movie titles? Can intellectual property owners argue that certain characters are copyrighted material that cannot be used in the titles of movies not affiliated with the owner? For example, regarding the *Hari Puttar* case, can Warner Brothers¹¹⁹ stop anyone from using the Harry Potter name in any title by virtue of holding the copyright to the Harry Potter character?

Even though trademark law principles govern in India, the U.K. and the U.S., copyrights should still be enforceable within film titles. Copyrights and trademarks are treated as separate bodies of law, so the existence of a copyright within a title that is to be trademarked presents a trademark question and a copyright question, both of which should be given equal attention. If the name of a copyrighted character is used within a literary title, the rights regarding the copyrighted character are still upheld regardless of whether or not the trademark for the title can be registered or enforced. Because copyright and trademark are separate legal regimes that provide different types of protection, film titles should enjoy protection under both copyright and trademark laws.

114. Stamatoudi, *supra* note 112.

115. Copyright, Designs and Patents Act, 1988, c. IV, § 77 (U.K.).

116. Copyright, Designs and Patents Act § 78; Stamatoudi, *supra* note 112.

117. Copyright, Designs and Patents Act § 80.

118. *Id.* §§ 84(1)(a)–(b).

119. Stephanie Grunier, *Warner Bros. Claims Harry Potter Sites*, ZDNET.COM, Dec. 21, 2000, http://news.zdnet.com/2100-9595_22-96323.html (stating Warner Brothers holds the film and merchandising rights to J.K. Rowling's *Harry Potter* series and that Warner Brothers also owns the trademarks and copyrights to the characters within the *Harry Potter* books).

A. Can Fictional Characters Be Copyrighted?

In the United States, well developed characters may be copyrighted.¹²⁰ Judge Learned Hand implied as such in *Nichols v. Universal Pictures Corporation*: “The less developed the characters, the less they can be copyrighted; that is the penalty an author must bear for marking them too indistinctly.”¹²¹ Thus, should anyone copy a copyrighted character against the wishes of the copyright holder, infringement occurs.¹²²

Because fictional characters can be copyrighted,¹²³ traditional trademark laws may be circumvented by the use of copyright laws. Within a film title, people may be excluded from using words that are deceptively similar to a copyrighted character’s name, regardless of whether or not the title as a whole cannot be trademarked, simply because a title is merely descriptive of the work’s content. Therefore, Warner Brothers has the exclusive right under the respective copyright acts of India, the U.K., and the U.S. to exclude others from using the Harry Potter character in any medium. Just because Warner Brothers’ rights to *Harry Potter* derive from the characters within the Harry Potter books, WB’s rights are still prevalent with respect to *films*. Regardless of the medium, if one of the exclusive rights of copyright owners is violated, namely the right of reproduction,¹²⁴ the violator is liable for copyright infringement.¹²⁵

Additionally, trademarks are protected across media lines if there is a likelihood of confusion, even though the publishing and film industries do not directly compete with each other.¹²⁶ Therefore, if a person uses

120. See Heijo E. Ruijsenaars, *The World of Fictional Characters: A Journey of Fantasy*, 6 ENT. L.R. 182, 182–83 (1993) (arguing for uniform copyright protection for fictional characters, regardless of the type of character being protected, i.e. comic book characters, literary characters, puppets, performers, etc.); 2 WILLIAM F. PATRY, PATRY ON COPYRIGHT § 3.164 (2009) (stating that literary characters must have a core of constant traits that specifically delineates that character as a particular character, unique from others within the same genre).

121. *Nichols v. Universal Pictures Corp.*, 45 F.2d 119, 121 (2d Cir. 1930) (stating that drawing ideas from undeveloped, general characters in copyrighted works is not copyright infringement).

122. See The Copyright Act, ch. XI, § 51(a)(i), No. 14 of 1957; India Code (1993), available at <http://indiacode.nic.in/> (select “Short Title”; then search for “The Copyright Act”; then select “Download full act”); Copyright, Designs and Patents Act, 1988, c. II, § 17 (U.K.); 17 U.S.C. § 501(a) (2006).

123. PATRY, *supra* note 120. Although characters are not separately protected in the U.S. copyright statute, and therefore not separately registerable, the formality does not affect copyrightability as long as the characters are original. *Id.*

124. See 17 U.S.C. § 106(1) (2006).

125. See 17 U.S.C. § 501(a) (2006) (stating that anyone who “violates any of the exclusive rights of the copyright owner as provided by sections 106 through 121” is liable for copyright infringement).

126. See 2 MCCARTHY, *supra* note 6, § 10:16.

the title of a series of works to confuse the public and pass off his work as being associated with a famous brand—for example the trademarked Harry Potter series¹²⁷—the trademark owner, in this case, Warner Brothers, has the exclusive right to the Harry Potter brand regardless of whether the brand name is used in a movie or book title. Consequently, if a film title utilizes a trademarked or copyrighted character, the title infringes on the owner's rights by first, passing off the film as being associated with the production company or studio responsible for the original, famous character, and second, for copying the character's likeness.

In a film title, however, it is difficult to portray the unique characteristics of a copyrighted character. To bring a successful copyright infringement action, the plaintiff has to prove that the defendant copied plaintiff's copyrighted work and that the copying amounted to improper appropriation.¹²⁸ When examining a film title independent of the film's content or advertising, only a character's name can conceivably be copied; looking at the title alone, one can only discern that the copied material is the character's name, as opposed to the personality of the character. The actual characterization of the character, the basis for copyright protection, has to be copied, not just the character's name. Such is hard to do in a title alone. Because names, titles, and short phrases are not eligible for copyright, the mere copying of a character's name does not constitute copyright infringement,¹²⁹ but rather trademark infringement and unfair competition.¹³⁰ Copying a character's name, or using a deceptively similar name, in a film title, along with a visual likeness of the disputed character, say in a movie trailer or poster, is

127. UKTM 2235034 (the U.K. trademark registration for the Harry Potter stylized letters belong to Warner Brothers). The trademark is registered in a variety of classes, including education and entertainment services, advertising and business services, and toys and sporting goods. *Id.*

128. *Arnstein v. Porter*, 154 F.2d 464, 468 (2d Cir. 1946) (stating the elements for a successful copyright infringement suit, as well as defining misappropriation as illicit copying).

129. Reuben Stone, *Titles, Character Names and Catch-phrases in the Film and Television Industry: Protection Under the Trade Marks Act 1994 and Alternative Registration Systems*, 8 ENT. L.R. 34, 34–35 (1997) (explaining that words portrayed by themselves, rather than within an artistic work, may not achieve copyright protection, thus implying the impossibility of copyright infringement).

130. ROBERT P. MERGES, PETER S. MENELL & MARK A. LEMLEY, *INTELLECTUAL PROPERTY IN THE NEW TECHNOLOGICAL AGE* 437 (4th ed. 2006) (citing 37 C.F.R. § 202.1).

better evidence of copying.¹³¹ Such visual¹³² clues better enable the trier of fact to determine the factual question of whether copying actually occurred.¹³³ Without additional evidence of copying, namely, advertising or analyzing the content of the film, an actual occurrence of copying a character by virtue of a similar name in a title is hard to determine.¹³⁴

Nonetheless, it is common practice for companies or authors to use both copyright and trademark protection to afford maximum intellectual property rights.¹³⁵ For example, when the copyright on the Beatrix Potter books expired at the end of 1993, publishers attempted to register the books under U.K. trademark laws to continue to benefit from the commercial value of such publications after the expiration of the copyright, most likely to capitalize on the ability to perpetuate the monopoly on the work.¹³⁶ Registering for copyright protection also affords jurisdictional advantages: “It is usual in India to register logos, wrappers, labels, etc. that are intended to be used as trade marks under the Copyright Act, as the copyright claim confers the jurisdictional advantage that the plaintiff can sue at the place where he carries on business or resides.”¹³⁷

One way to enjoy both trademark and copyright protection under current laws is to incorporate the film title into a design to make the title fall under the artistic work category protected by copyright law.¹³⁸

131. Using a visual depiction of a copyrighted character without authorization would probably constitute copyright infringement whether or not the character’s name was also used because a visual depiction would violate the reproduction or display rights. See The Copyright Act, ch. XI, § 51(a)(i), No. 14 of 1957; India Code (1993), available at <http://indiacode.nic.in/> (select “Short Title”; then search for “The Copyright Act”; then select “Download full act”); Copyright, Designs and Patents Act, 1988, c. II, § 17 (U.K.); 17 U.S.C. § 501(a) (2006).

132. See *Anderson v. Stallone*, No. 87-0592 WDKGX, 1989 WL 206431 at *6 (C.D.Cal. Apr. 25, 1989) (stating that visually depicted characters can be granted copyright protection, presumably because a visual depiction adds to the specificity of the character).

133. See *Arnstein v. Porter*, 154 F.2d 464, 468 (2d Cir. 1946).

134. But see *Klink*, *supra* note 4, at 295 (explaining that titles in France are governed by copyright law and that the French Code de la Propriété Intellectuelle 1992 explicitly awards copyright protection to titles).

135. Joseph Menn, *Whose Mouse is it Anyway?*, L.A. TIMES, Aug. 22, 2008, at 1, available at <http://articles.latimes.com/2008/aug/22/business/fi-mickey22> (stating Disney owns the trademark to the Mickey Mouse character, as well as the copyright). Although the article discusses the possibility that Disney’s copyright to Mickey Mouse may be faulty, the article demonstrates that companies still claim protection under both copyright and trademark laws. *Id.*

136. *Donovan & Jennings*, *supra* note 91, at 38.

137. SHARPE, *supra* note 62, at 54.

138. See Copyright, Designs and Patents Act, 1988, c. I, § 1(1)(a), § 4 (U.K.). Copyright law affords protection to artistic works, which are defined as graphic works, such as drawings, diagrams, etc. irrespective of artistic merit. See also 17 U.S.C. §§ 101–02 (2006). An artistic work for a single movie title is distinguishable from a logo,

Scholar Reuben Stone conjectures that a specially designed film title could be copyrighted as an artistic work.¹³⁹ Should such a stylized title be copied, it would be hard to argue that a substantial part of the design was not taken.¹⁴⁰ Take for example, the design of the Harry Potter title, which has a lightning bolt serving as the stem of the letter P for Potter, as well as stylized lettering.¹⁴¹ Should anyone mimic such an intricately designed title, copyright protection would kick in, excluding anyone from using the Harry Potter name or associated design.

Because of the difficulties in determining whether or not actual copying has occurred when using a fictional character's name within a film title, it is arguably illogical to apply copyright law to film titles in copyright infringement cases regarding the use of a character's name in a title. Yet, where the U.S., the U.K., and India do not protect characters' names,¹⁴² France protects short phrases and titles under copyright law.¹⁴³ Author Heijo Ruijsenaars argues that in countries that protect titles under copyright law, a character's name is the equivalent to a creative title and can therefore be protected as a separate copyrighted work.¹⁴⁴ In these cases, proving copyright infringement for merely using a character's name within a film title would be more feasible. However, as copyright law stands in India, the U.K., and the U.S., copyright protection of the use of a character's name in a creative title, without more, does not give additional protection to film titles.

But copyright protection may not be needed given Reuben Stone's suggestion that all film titles, even descriptive ones, are capable of attaining secondary meaning.¹⁴⁵ Stone cites an English court decision

which is considered a company symbol. ANNE GILSON LALANDE, *GILSON ON TRADEMARKS* § 1.02 (2008).

139. Reuben Stone, *Copyright Protection for Titles, Character Names and Catch-Phrases in the Film and Television Industry*, 7 ENT. L.R. 178, 186 (1996).

140. *Id.*

141. See UKTM 2235034 (the U.K. trademark registration for the Harry Potter stylized letters), <http://www.ipo.gov.uk/types/tm/t-os/t-find/t-findnumber?detailsrequested=c&trademark=2235034>.

142. *But see* Universal City Studios, Inc. v. Kamar Industries, Inc., No. H-82-2377, 1982 WL 1278 at *4 (S.D. Tex. Sept. 20, 1982) (stating that the character name E.T. is copyright protected).

143. Ruijsenaars, *supra* note 120, at 183 n.9, 10 (explaining that countries like France protect titles under copyright, but such titles require originality).

144. *Id.*

145. Reuben Stone, *Titles, Character Names and Catch-Phrases in the Film and Television Industry: Protection under the Law of Passing Off*, 7 ENT. L.R. 263, 263 (1996).

where the presiding judge suggested dividing literary titles into three categories:¹⁴⁶ (1) titles that might be arbitrary and therefore distinctive; (2) titles that are descriptive, but capable of gaining secondary meaning over time; and (3) titles that are so inherently descriptive they could never acquire secondary meaning.¹⁴⁷ For example, the well-known American film, *Chariots of Fire*, has a title falling under category one, while the title *Four Weddings and a Funeral* falls under category two.¹⁴⁸ Stone comments that it is difficult to think of film titles that fall under category three, implying even descriptive film titles have the ability of attaining secondary meaning given enough time.¹⁴⁹ Stone's suggestion, however, does not grant protection upon initial use of the intended mark; therefore, the film title does not acquire protection until secondary meaning has attached.

IV. A COMBINATION OF TRADEMARK LAW AND COPYRIGHT LAW WILL AFFORD FILM TITLES GREATER PROTECTION

A. *Why Trademark Law is Not Enough*

A combination of trademark and copyright law governing literary titles will not only encourage creativity, but will also afford greater protection, thus reducing the number of similar film titles. Trademark and unfair competition laws do not provide enough protection for film titles, as evidenced by the numerous instances of titles that are either duplicated or substantially similar.¹⁵⁰ Furthermore, the policy reasons

146. *Id.* (citing *Mathieson v. Sir Isaac Pitman & Sons Ltd.*, [1928–1935] MacGillivray's Copyright Cases 163, 172–174).

147. *Id.*

148. *Id.*

149. *Id.*

150. *See Kanungo Media Ltd. v. RGV Film Factory*, IA No.1979/2007 in CS (OS) No.324/2007 (Feb. 21, 2007) (India), available at <http://indiankanoon.org/doc/225324/> (presiding over a passing off claim in which the court discusses two titles in dispute, *Nisshabd* and *Nishabd*); Matthew Beloni, *Studios, lawyers play name game with film titles*, REUTERS, <http://www.reuters.com/article/entertainmentNews/idUSTRE4AB0D220081112?pageNumber=1&virtualBrandChannel=0> (last visited Mar. 6, 2009) (naming various instances of title disputes i.e. “The Day the Earth Stood Still” vs. “The Day the Earth Stopped,” “Snakes on a Train” vs. “Snakes on a Plane,” “Street Racer” vs. “Speed Racer,” “A Night in Casablanca” vs. “Casablanca,” and one studio had to change their title from “Avatar” to “The Last Airbender” because another studio claimed rights to the title “Avatar”); Indiaabroad, *Name of the Bollywood Game: Titles Trigger Disputes*, YAHOO!INDIA MOVIES, June 14, 2007, http://in.movies.yahoo.com/news-detail-print.html?news_id=27281 (describing the title dispute between Bollywood producers over *Thoda Pyaar Thoda Magic* and *Thoda Life Thodi Magic*.); *Ramu's Sholay turns into Aag*, THE TIMES OF INDIA, July 17, 2007, <http://timesofindia.indiatimes.com/articleshow/msid-2208664.prtpage-1.cms>. (describing title controversy over *Sholay* and *Ram Gopal Varma Ke Sholay*.); *Charlie Chaplin's Title Registration Problem*, Hollywood Renegades Archive,

behind trademark law are not intended to stimulate creativity for the public good, but rather to avoid consumer confusion¹⁵¹ and protect producer goodwill and reputation.¹⁵² Incorporating copyright law into film title governance will encourage authors to think outside the box and create unique, original titles. Thus, these titles could quite possibly be inherently distinctive and afforded trademark registration, which, in itself, generates greater protection.

Consequently, encouraging fanciful¹⁵³ titles for films could launch titles into a category that would allow for trademark registration instead of waiting for titles to acquire secondary meaning. When a title achieves secondary meaning, the title may benefit from common law protection¹⁵⁴ or protection as a registered trademark.¹⁵⁵ But protection is uncertain. First, acquisition of secondary meaning could take a long time; second, protection under law is at the discretion of courts or the countries'

2005, http://www.cobbles.com/simpp_archive/charlie-chaplin_title-registration.htm (stating that once Charlie Chaplin received opposition to registering the title, *The Dictator*, Chaplin decided to change the title to *The Great Dictator* to avoid paying to transfer the title rights); Jill Hunter Pellettieri, *Double Trouble*, SLATE, May 12, 2005, <http://www.slate.com/id/2118602/> (describing the duplicate title problem between the Will Ferrell movie *Kicking & Screaming* and the Noah Baumbach movie *Kicking and Screaming*); Stephen M. Silverman, *James Bond's New Enemy: Austin Powers*, PEOPLE.COM, Jan. 29, 2002, <http://www.people.com/people/article/0,623445,00.html> (describing the dispute over the title *Austin Powers in Goldmember* and that it might be confused with the James Bond movie *Goldfinger*); *Bollywood Titles*, *supra* note 71 (stating there is a title dispute between companies over the title "Kushti"); Mark Pollard, *'Yip Man' Biopics Settle Title Dispute*, KUNGFUCINEMA, <http://www.kungfucinema.com/yip-man-biopics-settle-title-conflicts-2240> (last visited Mar. 6, 2009) (dispute over film title "Grandmaster Yip Man").

151. MERGES, INTELLECTUAL PROPERTY IN THE NEW TECHNOLOGICAL AGE 635 (4th ed. 2007) ("[T]rademark . . . may prevent junior (subsequent) users from employing the same or a similar mark, where there is a 'likelihood of confusion' between the two marks Traditionally, there has been nothing in trademark law analogous to the desire to encourage invention or creation that underlies (at least in part) patent and copyright law."); 2 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION §2:1 (4th ed. 2008).

152. MERGES, *supra* note 151, at 638.

153. *Id.* at 640 (stating that fanciful marks are words or phrases that have no relationship to the product it represents. Fanciful marks are the strongest marks under the classification regime of trademarks); *Zatarain's, Inc. v. Oak Grove Smokehouse, Inc.*, 698 F.2d 786, 791 (5th Cir. 1983) ("[F]anciful terms are protectable without proof of secondary meaning.").

154. *Brandon v. Regents of Univ. of Cal.*, 441 F. Supp. 1086, 1091 (D. Mass. 1977) (stating that a movie title may gain common law protection over time once it acquires secondary meaning).

155. *Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1162 at n.2 (Fed. Cir. 2002) ("While titles of single works are not registrable, they may be protected under section 43(a) of the Lanham Act upon a showing of secondary meaning.").

respective trademark office. Because there is no immediate title protection without secondary meaning under trademark law, film titles are vulnerable until the title acquires secondary meaning.

Many film titles are not even registrable under many trademark acts.¹⁵⁶ Even though a title may intrinsically describe the contents of a film, owners could get around such an objection using the Penguin Practice, which would exclude trademark owners from prohibiting the use of the mark in a purely descriptive way.

Trademark owners are required to monitor the use of their marks.¹⁵⁷ Legislatures require reasonable monitoring of marks to prevent misleading uses of the mark and ensure quality of the mark.¹⁵⁸ The Indian and U.K. trademark acts refer to an owner's lack of monitoring as acquiescence.¹⁵⁹ Even though film titles may not be registrable as trademarks, courts have historically applied trademark principles to film titles.¹⁶⁰ Therefore, it is logical to conclude that authors of film titles must also monitor the use of their film titles to prevent the dilution of the goodwill or reputation that may be associated with the title. Such monitoring can be costly and nearly impossible for authors, especially for independent studios or other entities operating on low budgets. With the globalization of the movie industry, it will be hard for people to monitor the use of their film titles by unauthorized persons in other countries, thereby threatening the author's rights to the film title in dispute. Copyright protection, on the other hand, exists at the moment of creation.¹⁶¹ Furthermore, under copyright law, there is no need to monitor the copyright in order to preserve the right.¹⁶² Thus, if copyright law applied to film titles, the author of a film title would not only have rights against infringement immediately upon creation of his title, but he

156. Trade Marks Act, 1994 § 3 (U.K.) (grounds for refusal of registration).

157. *Dawn Donut Co. v. Hart's Food Stores, Inc.*, 267 F.2d 358, 366 (2d Cir. 1959); Trade Marks Act § 48 (U.K.); The Trade Marks Act § 33, No. 47 of 1999; India Code (1999), available at <http://indiacode.nic.in/> (select "Short Title"; then search for "The Trade Marks Act"; then select "Download full act").

158. *Dawn Donut Co.*, 267 F.2d at 366.

159. Trade Marks Act § 48 (U.K.); The Trade Marks Act § 33 (India).

160. See *Klink*, *supra* note 4, at 292; *Kanungo Media Ltd. v. RGV Film Factory*, IA No. 1979/2007 in CS(OS) No.324/2007, para. 13 (Feb. 21, 2007) (India), available at <http://indiankanoon.org/doc/225324/>.

161. 17 U.S.C. § 201(a) (2006); Copyright, Designs and Patents Act, 1998 c. I, § 11 (U.K.); The Copyright Act, ch. IV, § 1, No. 14 of 1957; India Code (1993), available at <http://indiacode.nic.in/> (select "Short Title"; then search for "The Copyright Act"; then select "Download full act").

162. Authors are still subject to the durational limits under the countries' respective copyright acts. See generally *Sonny Bono Copyright Term Extension Act* sec. 102 (1998); Copyright, Designs and Patents Act, 1998 c. I, §§ 12–15 (U.K.); The Copyright Act, ch. V, § 22 (India).

would not have to monitor the use of his film title in order to keep or hold intellectual property protection.

Additionally, a trademark holder cannot exert the same rights as a copyright holder under the same circumstances.¹⁶³ Copyright holders have the exclusive right to reproduce and distribute copies as well as prepare derivative works, and publicly perform or display the copyrighted work.¹⁶⁴ Comparatively, trademark holders are only entitled to regulate the misuse of their marks and obtain injunctions to stop such use to prevent harm to the goodwill associated with the mark.¹⁶⁵ Unlike copyrights, the alienation of trademark rights is subject to considerable legal restriction, at least in the U.S.¹⁶⁶ Therefore copyright law, in combination with trademark law, is necessary to protect film titles.

B. Why Copyright Law Should Apply

Unlike trademark law, the purpose of copyright law is to encourage creativity.¹⁶⁷ Film titles are products of such creativity and are expressions of what the author wants to convey about the film. A screenwriter or production company puts thought into a title so as to woo audiences into theater seats. The author has put the time and energy into creating the title and choosing the exact combination of words to affect the intended meaning. Without the exact juxtaposition of words, the expression the title conveys could be entirely different. For example, if the title of *Star Wars* had instead been *War Stars*, the idea implanted within the minds of moviegoers would be a radically different association than the one *Star Wars* conjures up today. Admittedly, the movie's acquired secondary meaning is the source of the associations that the title *Star Wars* summons, which is the result years of enduring success; all the more reason for both trademark and copyright law to govern film titles. Irrespective of secondary meaning, to the ignorant moviegoer, *War Stars* invokes an entirely different idea about what the movie is about. The

163. Stone, *supra* note 139, at 180.

164. 17 U.S.C. § 106 (2006).

165. MERGES, INTELLECTUAL PROPERTY IN THE NEW TECHNOLOGICAL AGE 837 (4th ed. 2007).

166. *Id.* at 446, 838 (In the U.S., the sale or license of a trademark is restricted by the government); The Copyright Act, ch. IV, § 18 (India); Copyright, Designs, Patent Act, 1988, c. V, § 90 (U.K.); Trade Marks Act, 1994, § 24 (U.K.) (In the U.K., trademarks can be assigned or transmitted, but the statute does not indicate how difficult such a transaction might be).

167. *Id.* at 635.

title is everything, and therefore, the author should have the right to do as he pleases with his creation.

Moral rights are another important consideration to the creation of film titles. The U.K. acknowledges the author's moral right to his work,¹⁶⁸ as does the Berne Convention, which states that "even after the transfer of [copyrighted works], the author shall have the right to claim authorship of the work, and to object to any distortion, mutilation or other modification of, or other derogatory action in relation to the said work, which would be prejudicial to his honor or reputation."¹⁶⁹ India, the U.K., and the U.S. are all signatories to the Berne Convention,¹⁷⁰ and require moral rights protection in their respective copyright acts.¹⁷¹ Therefore, authors should be able to prevent others from changing their work without authorization. Other countries recognize copyright as protecting "the expression of the personal, individual intellectual effort of the author."¹⁷² Thus, under a moral rights theory, copyright protects the integrity of the work. By the same logic, film titles, deserve copyright protection as well.

Although many countries do not apply copyright law to film titles, it does not mean doing so is impractical. Countries such as France,¹⁷³ Canada,¹⁷⁴ and Argentina¹⁷⁵ use copyright law to govern titles. Therefore, it is feasible for the U.S., India, and the U.K. to incorporate similar provisions into their respective copyright acts to protect film titles. As with any other copyright system, the copyright systems in countries that do recognize protection in literary titles may encounter problems. However, if the title is original enough, why should the title be

168. Copyright, Designs and Patents Act, 1998, c. IV, § 77 (U.K.) (stating that the author of a copyrighted work has the right to be identified as the creator of the work).

169. Berne Convention for the Protection of Literary and Artistic Works, art. 6bis(1) (July 24, 1979).

170. Contracting Parties, World Intellectual Property Organization, http://www.wipo.int/treaties/en/ShowResults.jsp?country_id=ALL&start_year=ANY&end_year=ANY&search_what=C&treaty_id=15 (last visited Feb. 6, 2009).

171. The United States does not give any moral rights except in a very limited way under the Visual Artists Rights Act of 1990. 17 U.S.C. § 106A(d)(3) (2006).

172. Megan Richardson, *Copyright in Trademarks? On Understanding Trademark Dilution*, 4 I.P.Q. 66, 66 (2000).

173. *Id.* at 73. French courts have held that book titles are entitled to copyright protection. *Id.* "Under the French standard courts have been prepared to find originality in new meanings attached to old words. So in one case 'Le Chardon' as the title of a book was held to yield copyright protection although already in the general language as the name of a plant." *Id.*

174. Copyright Act, R.S.C., ch.42, § 2 (2005) (Canada) (stating that a "work" includes the title thereof when such title is original and distinctive.), *available at* <http://laws.justice.gc.ca/PDF/Statute/C/C-42.pdf>.

175. Law No. 11723, Sept. 28, 1933 B.O. (indicating that Argentina's copyright law protects against the fraudulent use of titles of works), *available at* http://www.wipo.int/lea/en/text_html.jsp?lang=en&id=82.

vulnerable to infringement without remedy while other creative works are not?

C. *Impact of Reform*

The statutory definitions of the term “literary titles” do not specifically state that names, short phrases, etc. are not copyrightable.¹⁷⁶ In the U.S., however, the Copyright Office regulations are the rules imposing the ban against copyrighting names and short phrases. The countries’ respective legislatures can amend the statutory language to include short phrases or names, limiting copyright protection only to titles of creative works, thereby sufficiently limiting protection to what needs protecting—literary titles. Furthermore, legislatures could decrease the duration for which copyright protection for literary titles would last. Thus, literary titles enjoy immediate protection upon use, but also have time to acquire secondary meaning so as to enjoy trademark protection once the duration of copyright protection expires. Such a practice is already commonplace with regard to merchandise and publications, so why not to creative literary titles as well?

D. *Berne Convention*

If the U.S., India, and the U.K. were to recognize copyright protection for literary titles, the statutory language of the Berne Convention would not need to be changed. The Berne Convention, of which the U.S., India, and the U.K. are all signatories,¹⁷⁷ is an international treaty governing the protection of literary and artistic works.¹⁷⁸ Currently, the term “literary and artistic works” is defined to “include every production in the literary, scientific and artistic domain, whatever may be the mode or form of its expression.”¹⁷⁹ Thus, the definition could be widely

176. 17 U.S.C. § 101 (2006). *See also* Copyright, Designs and Patents Act, 1998, c. I, § 3(1) (U.K.).

177. Contracting Parties: Berne Convention, World Intellectual Property Organization, http://www.wipo.int/treaties/en/ShowResults.jsp?country_id=ALL&start_year=ANY&end_year=ANY&search_what=C&treaty_all=ALL&treaty_id=1&treaty_id=15. The U.S. signed the Berne Convention on March 1, 1989. *Id.* The U.K. became a party on Dec. 5, 1887. *Id.* And India signed the treaty on Apr. 1, 1928. *Id.*

178. Berne Convention for the Protection of Literary and Artistic Works, art. 2(1), Sept. 9, 1886 (as amended Sept. 28, 1979), 828 U.N.T.S. 221 [hereinafter Berne Convention].

179. *Id.*

interpreted by the World Intellectual Property Organization (WIPO)¹⁸⁰ to include literary titles. The language is intentionally broad, using words like “every” and “whatever,” so such language already accommodates a broad interpretation of the meaning of “literary and artistic works.” The form of artistic and literary expression simply takes the form of a title, which can satisfy the “other writings” example, specifically stated within the treaty terms.¹⁸¹

E. Treaty on the International Registration of Audiovisual Works

Currently, WIPO is in the works of getting countries to sign the Treaty on the International Registration of Audiovisual Works, also known as the Film Register Treaty.¹⁸² The treaty only governs the rights associated with the exploitation of audiovisual works,¹⁸³ but the changes proposed in this comment could also be included within the Film Register Treaty to govern the titles accompanying the protected audiovisual works. Thus, the title would not be considered a separate copyright, but rather an extension of the audiovisual work itself. The film title, however, would not receive the benefits of copyright protection on the international scene, but the title, because it is an extension of the audiovisual work, would be protected against infringement in other member countries.¹⁸⁴ The author would still, however, enjoy copyright protection for his film title under domestic copyright law under the

180. WIPO is an agency of the United Nations dedicated to providing an international intellectual property system. WIPO.int, What is WIPO?, <http://www.wipo.int/about-wipo/en/what/>.

181. Berne Convention, *supra* note 178, art. 2(1). (“The expression ‘literary and artistic works’ shall include every production in the literary, scientific and artistic domain, whatever may be the mode or form of its expression, such as books, pamphlets and *other writings*; lectures, addresses, sermons and other works of the same nature.”) (emphasis added).

182. Treaty on the International Registration of Audiovisual Works, *adopted on* Apr. 20, 1989, *registered by the World Intellectual Property Organization* Mar. 25, 1991, *available at* http://www.wipo.int/treaties/en/ip/frt/trtdocs_wo004.html#P54_1888 [hereinafter Treaty on Int’l Registration].

183. *Id.* art. 2 (“any work that consists of a series of fixed related images, with or without accompanying sound, susceptible of being made visible and, where accompanied by sound, susceptible of being made audible.”).

184. *See generally id.* arts. 4, 12. The United States and India signed the Film Register Treaty on Apr. 20, 1989. WIPO.int, IRAW Notification: No. 1 Treaty on the International Registration of Audiovisual Works, http://www.wipo.int/edocs/notdocs/en/frt/treaty_frt_1.html (last visited Sept. 25, 2009). However, the treaty is not in force in the two countries. WIPO.int, World Intellectual Property Organization (WIPO): Copyright, Film Register Treaty, <http://www.wipo.int/clea/en/details.jsp?id=4022> (last visited Sept. 25, 2009). And, the United Kingdom has not signed this treaty. WIPO.int, IRAW Notification No. 1: Treaty on the International Registration of Audiovisual Works, http://www.wipo.int/edocs/notdocs/en/frt/treaty_frt_1.html (last visited Sept. 25, 2009).

“literary works” provision because Article 4, Section 2 of the Film Register Treaty states that none of the provisions within the treaty affect copyright law in the member country.¹⁸⁵

F. Inherent Limitations

Even though intellectual property rights would be bolstered by the application of both trademark and copyright laws to literary titles, such rights would still be subject to the same current limitations, such as statutory exclusions and defenses. As long as the legislature merely changes the definitions of “literary works” within their respective copyright acts and the trademark registry regimes incorporate the Penguin Practice into the trademark registry rules, legislatures can acquire the needed balance between intellectual property protection and inherent limitations.

The Penguin Practice in and of itself is a striking balance between protection and limitation. The practice allows for the trademark registration of essentially descriptive marks, but limits the trademark right to applications where the mark is used to recognize the source of goods or services. The Penguin Practice does not allow the trademark holder exclusive right over the contents of the mark when it is used purely in a descriptive sense.

G. Fair Use Defense

Similarly, the fair use defense inherently limits the breadth of trademark¹⁸⁶ and copyright protection.¹⁸⁷ The defense allows the use of

185. Treaty on Int'l Registration, *supra* note 182, art. 4, § 2.

186. 15 U.S.C. § 1125(c)(3) (2006). Fair use is a defense to dilution claims in trademark infringement cases. “Any fair use, including a nominative or descriptive fair use, or facilitation of such fair use, of a famous mark by another person other than as a designation of source for the person’s own goods or services, including use in connection with—

- (i) advertising or promotion that permits consumers to compare goods or services; or
- (ii) identifying and parodying, criticizing, or commenting upon the famous mark owner or the goods or services of the famous mark owner.”

Id.

187. 17 U.S.C. § 107 (2006). *Compare with* Copyright, Designs and Patents Act, 1988, c. III, §§ 29–76 (U.K.) outlining non-infringing actions, which is the equivalent to fair use in the U.S. *Also compare* The Copyright Act § 52, No. 14 of 1957; India Code (1993), *available at* <http://indiacode.nic.in/> (select “Short Title”; then search for “The

a copyrighted work only if the use is fair. The Indian and U.K. copyright acts specifically state acts that are fair,¹⁸⁸ and the U.S. Copyright Act applies a test using four factors, which are stated in 17 U.S.C. § 107 of the Copyright Act.¹⁸⁹ Currently in the United States, and similarly in the U.K. and India, use of copyrighted works for purposes of education, criticism, news reporting, etc. may be considered fair use and therefore non-infringing acts.¹⁹⁰

Changes to the copyright acts of the U.S., India, and the U.K. would not change the applicability of the fair use defense to copyright law. Instead, the test might have to be interpreted slightly differently by the courts. For example, the intent of the alleged infringer would have to be analyzed using the fair use factor that considers the purpose and character of the use. But this is already something that U.S. courts do. U.S. case law indicates that when considering the purpose and nature of the use of a copyrighted work under the fair use doctrine, courts should consider whether the alleged infringer copied in good faith for public benefit, or rather, for private commercial gain.¹⁹¹

The effect of the use in the potential market of the original copyrighted work will also be an important factor regarding the fair use of film titles. But such an analysis, at least by U.S. courts, is not new.¹⁹² The U.S. Supreme Court in *Harper & Row, Publications v. Nation*

Copyright Act”; then select “Download full act”), the Indian equivalent to U.S. fair use doctrine.

188. The United Kingdom specifically states types of fair uses of copyrighted works, such as education, libraries and archives, public administration, designs, typefaces, works in electronic form, miscellaneous: literary, dramatic, musical and artistic works, miscellaneous sound recordings, films and computer programs, miscellaneous broadcast and cable programs, and adaptations. Copyright, Designs and Patents Act, c. III, §§ 29–76. Similarly, the Indian Copyright Act outlines specific instances of fair use, rather than a test using factors. Such examples include private use, private research, criticism, back-ups, reporting current events, use in a judicial or political proceeding, education, etc. The Copyright Act § 52 (India).

189. The four factors of fair use are: (1) the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes; (2) the nature of the copyrighted work; (3) the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and (4) the effect of the use upon the potential market for or value of the copyrighted work. 17 U.S.C. § 107.

190. *Id. Compare with* Copyright, Designs and Patents Act, c. III, §§ 29–76 (outlining non-infringing actions, which is the equivalent to fair use in the U.S). *Also compare* The Copyright Act § 52 (India), the Indian equivalent to U.S. fair use doctrine.

191. *See* *Rogers v. Koons*, 960 F.2d 301, 309 (2d Cir. 1992) (“The first factor, purpose and character of the use, asks whether the original was copied in good faith to benefit the public or primarily for the commercial interests of the infringer.”). *See also* *MCA, Inc. v. Wilson*, 677 F.2d 180, 182 (2d Cir. 1981) (“the court may consider whether the alleged infringing use was primarily for public benefit or for private commercial gain.”).

192. *See* *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569 (1994); *Sony Corp. of America v. Universal City Studios, Inc.*, 464 U.S. 417, 450 (1984); *American Geophysical Union v. Texaco Inc.*, 60 F.3d 913, 926 (2d Cir. 1994).

Enterprises took the analysis even further and stated that courts should also take into account the harm in the market for derivative works.¹⁹³

Should the U.K. and India use copyright law to govern film titles, the fair use analysis would be helpful for the U.K. and Indian courts to apply in determining whether or not the film titles and the exact words within the title, were used merely descriptively, or with the intent to take advantage of someone else's intellectual efforts and creativity. The U.K. and Indian copyright acts would need to be amended to include factors similar to the ones outlined in section 107 of the U.S. Copyright Act, or U.K. and Indian courts could incorporate the use of similar factors in their common law decisions.

H. Originality

Courts will still have to interpret copyright statutes and determine whether or not the title is original enough for copyright protection. Such a standard would not change should countries choose to use copyright law to govern literary titles. Courts will still have the discretion to grant copyright protection to titles that exhibit sufficient originality so as to reward the author for his intellectual pursuits.¹⁹⁴

Furthermore, the originality requirement under copyright law will also raise the standard for trademarks and their registration. Originality will encourage more suggestive titles.¹⁹⁵ Increased creativity will avoid substantially similar film titles and result in a broader array of film titles in the market. More suggestive literary titles will also avoid the problem film titles encounter when they are too descriptive, having to wait years to acquire secondary meaning after spending what is most likely millions in advertising to build goodwill and a reputation among the public.

193. *Harper & Row, Publishers, Inc. v. Nation Enterprises*, 471 U.S. 539, 568 (1985) (“inquiry must take account not only of harm to the original but also of harm to the market for derivative works.”).

194. Alfred C. Yen, *Restoring the Natural Law: Copyright as Labor and Possession*, 51 OHIO ST. L.J. 517, 523 (1990) (asserting a rationale for copyright law that states a person who mixes her labor with an unowned object is morally entitled to property rights in that object).

195. Stone, *supra* note 145, at 264 (citing *J. Friendly in Abercrombie & Fitch Co. v. Hunting World Inc.*, 537 F.2d 4, 9 (1976), which states the varying degrees of distinctive trademarks in order of increasing distinctiveness: generic, descriptive, suggestive, arbitrary or fanciful).

V. FORESEEABLE PROBLEMS

If legislatures decide to apply copyright law to film titles, there may be a problem in the application of one of the fair use factors. The factor that considers the substantiality of the portion of the copyrighted work used¹⁹⁶ could result in always counting against the defendant; copying a character's name is essentially copying the work as a whole. Thus, courts may decide that copying a copyrighted character's name will always hurt the defendant in a fair use analysis.

Some argue that more intellectual property protection stifles creativity. Patry quotes Richard Posner, who states, “[t]he more extensive is copyright protection, the more inhibited . . . the literary imagination. This is not a good reason for abolishing copyright, but it is a reason possibly for narrowing it, and more clearly for not broadening it.”¹⁹⁷ But the numerous instances of films with similar titles indicate that such is not the case, at least with respect to literary titles. As current intellectual property laws stand in India, the U.K., and the U.S., there is no incentive for literary imagination in the absence of copyright law with regard to literary titles.

A. Monopolies in Words of Titles Themselves

If titles are given copyright protection, will words be taken out of circulation for public use? Essentially, a monopoly on all words within a literary title can be avoided by using an exception similar to the Penguin Practice. A copyright holder will have rights in the title of a work, but will not have an exclusive right to the juxtaposition of those words in everyday use. For example, the copyright holder of the title *Harry Potter and the Chamber of Secrets* has exclusive rights to the title. But the Penguin Practice-like exception would only grant rights for the use of the title, or a substantially similar title, in other mediums outlined in the various copyright acts. For example, the Indian Copyright Act specifically lists certain mediums like broadcasts, photographs, architecture, cinematograph films, sound recordings, and original literary,

196. *Harper & Row*, 471 U.S. at 560–61 (explaining the factors used to determine whether use is fair: (1) the purpose and character of the use; (2) the nature of the copyrighted work; (3) the substantiality of the portion used in relation to the copyrighted work as a whole; (4) the effect on the potential market for or value of the copyrighted work).

197. PATRY, *supra* note 120, § 3.31 (quoting RICHARD POSNER, *LAW AND LITERATURE* 403 (Rev. ed. 1998)).

dramatic, musical and artistic works.¹⁹⁸ Therefore, the copyright holder in India would have exclusive rights to his title in the use of any of the specifically mentioned mediums within the Indian Copyright Act. However, if the title were used for educational purposes, or Person A merely recommended the title to Person B as a good movie to watch, such uses would not be considered infringement, and instead, would be considered fair use. Allowing the copyright holder to have a monopoly in the words of a title would defeat the basic policy reasons behind copyright law. The public would not benefit from such a monopoly and every such case of an “infringing” use would tie the copyright holder in litigation. The copyright holder would not benefit from his intellectual pursuits, nor would he be protecting his work from derogatory treatment.

Any questionable exertion of a right can be combated using the fair use defense. For example, if a website wanted to market a Harry Potter movie on its website as a product for sale, the website would either have a license to sell the work associated with the copyrighted title or have a fair use defense. In the U.S., the general purpose of copyright is “to promote the Progress of Science and useful Arts.”¹⁹⁹ The purpose of putting the book for sale on the internet is for public benefit; the public acquires easier access to the book, and the effect on the market if the book were sold actually benefits the copyright holder as well as the website. Courts will likely agree that such a use of a copyrighted work, whether it is a title or a traditionally protected form, is fair use.²⁰⁰

B. If Film Titles, Why Not Short Phrases?

If movie titles received copyright protection, short phrases and names would not be automatically entitled to copyright protection. A significant difference between film titles and short phrases is the association the title has with the film it identifies. Film titles are vital to the success of the film. Tom Sherak, chairman of the 20th Century Fox domestic film group states: “A movie starts to breathe with a title—it’s the first thing about a film that audiences are exposed to And when you’re

198. The Copyright Act §§ 2, 13, No. 14 of 1957; India Code (1993), available at <http://indiacode.nic.in/> (select “Short Title”; then search for “The Copyright Act”; then select “Download full act”).

199. U.S. CONST. art. I, § 8, cl. 8.

200. Similarly, courts would most likely consider movie reviews fair use, as it is a criticism of a work. See 17 U.S.C. § 107 (2006); Copyright, Designs and Patents Act, 1988, c. III, § 30 (U.K.); The Copyright Act § 52(1)(a)(ii) (India).

going up against dozens of other films, it's important to make a good first impression."²⁰¹ How is this different from the purpose of trademark law? Films generally last forever. Even if the movie studio no longer produces prints of the film, the film is immortalized via the internet and DVDs. Essentially, the film title is always in use. Goods associated with trademarks, on the other hand, are finite. Should the source of the goods cease manufacturing, the product will eventually no longer exist. For example, if a movie is posted to YouTube, it arguably lasts forever. Other sites can link to or embed the film in their respective websites. Comparatively, with respect to goods, for example, once Oakley²⁰² decides to stop making sunglasses, there will be a finite number of existing sunglasses. Once the existing glasses no longer exist, the trademark is no longer in use, or even useful. Even if people decide to collect the Oakley sunglasses, Oakley itself no longer uses the trademark and there is no need to protect the Oakley entity. Thus, there is no longer a need for the trademark. The respective trademark acts of the U.S., India, and the U.K. support the idea of cancelling trademarks if the trademark has been abandoned.²⁰³ Therefore, film titles are distinguishable from short phrases because films have the potential to exist forever in one form or another.

Moreover, film titles are associated with a creative work whereas short phrases are not. Although a certain amount of originality is required to create film titles and short phrases, short phrases are associated with goods, rather than creative works. Books and films identify creative works, whereas taglines identify goods like sunglasses. Titles are already associated with the creative works copyright law aims to protect, distinguishing titles from short phrases.

C. Economics

Economically, title searches to avoid copyright and trademark infringement will drive up movie-making prices. However, such costs will most likely be minimal compared to future litigation costs should similar film titles be discovered at a later date. Even if litigation can be avoided, settlement costs will be exponentially more than the overhead cost of performing a title search or belonging to associations such as the

201. Patrick Goldstein, *Hey! Let's Play the Movie Title Game!* LA TIMES, Aug. 20, 1997, at F1, available at <http://articles.latimes.com/p/1997/aug/20/entertainment/ca-24037>.

202. A sunglasses vendor and manufacturer.

203. Lanham Act § 45, 15 U.S.C. § 1127 (2006); Trade Marks Act, 1994 § 48 (U.K.); The Trade Marks Act § 33, No. 47 of 1999; India Code (1999), available at <http://indiacode.nic.in/> (select "Short Title"; then search for "The Trade Marks Act"; then select "Download full act").

MPAA who register film titles and keep track of instances where similar film titles are released. Finally, if the two sides of a duplicative film title dispute cannot find common ground and settle, one side will likely decide to forego any further financial costs and simply come up with a new film title. Yet, the incalculable cost of time and effort has also been wasted, a cost that could have been avoided had a proper title search been performed and a different, more creative film title been fashioned in the first place.

Peripherally, the combination of copyright and trademark laws regarding film titles will expand the industry for title searches, also creating a new industry within the entertainment business. Granted, title searches exist in the current regime under trademark law, but again, the occurrences where films with similar titles are released illustrate that such a regime is not working. A combination of trademark and copyright law with respect to literary titles promotes efficiency, bypassing legal disputes and other costs, while at the same time increasing intellectual property protection. In performing more title searches, the benefits will outweigh the comparatively minimal up-front costs for title searches.

VI. HOW SHOULD THE DELHI HIGH COURT HAVE RULED ON THE *HARI PUTTAR* CASE?

Recently, Warner Brothers sued Mirchi Movies over the title *Hari Puttar: A Comedy of Terrors* because the Bollywood²⁰⁴ movie title is too similar to the name of J.K. Rowling's Harry Potter character.²⁰⁵ WB sought an injunction to stop the release of *Hari Puttar* under that title.²⁰⁶ The Delhi High Court²⁰⁷ in India dismissed Warner Brothers' plea because the targeted audience of the Harry Potter film franchise would

204. Rachana Desai, *Copyright Infringement in the Indian Film Industry*, 7 VAND. J. ENT. L. & PRAC. 259 (2005) (describing Bollywood as the largest film industry in India, which focuses on Hindi language cinema).

205. Rhys Blakely, *Hari Puttar? Wizard Idea, but Hollywood Claims It's a Rip Off*, THE TIMES, Aug. 26, 2008, at A11, available at http://entertainment.timesonline.co.uk/tol/arts_and_entertainment/film/bollywood/article4608340.ece.

206. Warner Bros. Entm't v. Kohli, IA No.9600/2008 in CS(OS) 1607/2008, para. 1 (India Sept. 22, 2008), <http://indiankanoon.org/doc/395839>.

207. The Delhi High Court governs the Union Territory of Delhi in India. Delhi High Court, *History*, <http://delhihighcourt.nic.in/history.htm>. High Courts are the head of the state's judicial administration and subordinate only to the Indian Supreme Court. India Finance & Investment Guide, *Judicial System*, http://finance.indiamart.com/government_india/judicial.html.

not be misled by the phonetically similar film titles. Furthermore, the court found that an audience would know the difference between a Harry Potter book or movie and a Punjabi comedy.²⁰⁸

WB is worried that the release of *Hari Puttar* will cause trademark infringement and goodwill dilution,²⁰⁹ which will ultimately affect profits because the Harry Potter trademark, which WB has invested much of its reputation, could be mistaken for an inferior product.²¹⁰ The Harry Potter brand has a long, profitable history.²¹¹ Since 1998, Scholastic, the American publisher of the Harry Potter series, earned \$600 million in revenue from the first Harry Potter book.²¹² The latest Harry Potter book, *Harry Potter and the Deathly Hallows*, sold over 2 million copies in its first twenty four hours in the United Kingdom.²¹³ The Harry Potter book franchise is also well-known worldwide having sold over 350 million copies in sixty five languages,²¹⁴ the films have earned \$4,485,466,623 worldwide, with the latest installment, *Harry Potter and the Order of the Phoenix* grossing \$938,468,886 worldwide.²¹⁵ Furthermore, the Harry Potter brand has expanded its franchise, producing video games,²¹⁶ toys, clothes, jewelry, etc.²¹⁷ The concerns over goodwill dilution are legitimate, especially with such high revenues at stake. Thus, to afford greater protection for intellectual property rights, countries should apply both copyright and trademark law to film titles.

The Delhi High court dismissed the trademark infringement suit against Mirchi movies.²¹⁸ However, Justice Khetrpal did not focus on the substantive trademark law governing literary titles disputes with

208. Warner Bros. Entm't v. Kohli, IA No.9600/2008 in CS(OS) 1607/2008, para. 33 (India Sept. 22, 2008), <http://indiankanoon.org/doc/395839>.

209. *Id.* para.7.

210. See ARTHUR R. MILLER & MICHAEL H. DAVIS, INTELLECTUAL PROPERTY: PATENTS, TRADEMARKS, AND COPYRIGHT IN A NUTSHELL 191-93 (4th ed. 2007).

211. See generally *Harry Potter and the Publishing Record*, CNNMONEY, July 11, 2005, <http://money.cnn.com/2005/03/30/news/newsmakers/harrypotter/index.htm>.

212. Tomas Kellner, *Harry Potter And The Vanishing Brand Magic*, FORBES, July 14, 2005, http://www.forbes.com/2005/07/14/scholastic-potter-earnings-cz_tk_0714scholastic.html.

213. Michelle Pauli, *Harry Potter Goes Soft*, THE GUARDIAN, Dec. 11, 2007, <http://www.guardian.co.uk/books/2007/dec/11/harrypotter.harrypotter>.

214. *Id.*

215. The-Numbers.com, Box Office History for Harry Potter Movies, <http://www.the-numbers.com/movies/series/HarryPotter.php> (last visited Aug. 28, 2009).

216. See "*Harry Potter*" game was going to bring in \$120 million, \$41 million profits, VARIETY, Sept. 8, 2008, http://weblogs.variety.com/the_cut_scene/2008/09/harry-potter-ga.html?query=harry+potter.

217. See generally The Official Warner Bros. Harry Potter Shop, <http://harrypotter.wbshop.com/> (last visited Aug. 28, 2009).

218. Warner Bros. Entm't v. Kohli, IA No.9600/2008 in CS(OS) 1607/2008, para. 37 (India Sept. 22, 2008), <http://indiankanoon.org/doc/395839>.

regard to the facts of the case;²¹⁹ instead, Justice Khetrpal discussed the ramification of WB's delay in filing suit and its attempt to suppress material facts.²²⁰ In paragraph 30 of her opinion, Justice Khetrpal rebukes the plaintiff for sitting on the suit against the *Hari Puttar* production for so long:

If, according to the plaintiffs, the defendants had dishonestly adopted a title or mark akin to that of plaintiffs, it was imperative upon the plaintiffs to have nipped the evil in the bud by forwarding to the defendants a legal notice of CEASE AND DESIST or "carry at your own peril and risk." Instead, the plaintiff sat by, a course of conduct inconsistent with the claim for exclusive rights in a trademark, trade name, etc. Needless to say that delay by itself may not necessarily be a ground for refusing injunction, but delay would be relevant in adjudging a change in the subject matter in an action brought about by a situation in which the plaintiff sat on the fence, watching the defendant enrich its trade by investment of money and labour and involving third party rights in the same.²²¹

However, there are decisions from Indian courts stating the delay does not automatically preempt a granting of an interim injunction from using the disputed trademark.²²² Furthermore, Justice Khetrpal thoroughly discusses the plaintiff's attempts to suppress material facts:

It is settled position both in law and in equity that a deliberate suppression of material facts, viewed singularly or coupled with blatantly false assertions, so far as the grant of equitable relief of injunction is concerned, is fatal. The plaintiffs in the instant action have attempted to lightly brush off their intentional non-disclosure by feigning oversight, contending that they had nothing to gain from the aforesaid non-disclosure.²²³

Unfortunately, the Delhi High Court opinion does not discuss the substance of the trademark infringement case, but rather the procedural semantics. The opinion even goes so far as to say that the case is not even about consumer goods or products at all.²²⁴ Yet, there is substantial common law support for Justice Khetrpal's decision to dismiss WB's suit based on the finding that WB suppressed material facts and delayed in filing the suit.²²⁵

219. *See generally id.*

220. Spicy IP, Warner Loses the Hari Puttar Plot, <http://spicyipindia.blogspot.com/2008/09/warner-loses-hari-puttar-plot.html> (last visited Oct. 5, 2008).

221. Warner Bros. Entm't v. Kohli, IA No.9600/2008 in CS(OS) 1607/2008, para. 30 (India Sept. 22, 2008), available at <http://indiankanoon.org/doc/395839>.

222. Anand, *supra* note 67, at 85.

223. *Warner Bros.* para. 29.

224. *Id.* para. 33.

225. *See id.* paras. 29, 35.

The Court dismissed WB's initial interest confusion argument, which argues that Mirchi Movies is liable for trademark infringement because the similarity in film titles generates initial consumer interest, even though the consumer ultimately realizes there is a difference between Harry Potter and *Hari Puttar* before the consumer purchases a movie ticket to *Hari Puttar*.²²⁶ Moreover, Justice Khetrpal gives little credence to the possibility that the titles do in fact cause confusion among consumers. She writes:

I am of the view that even assuming there is any structural or phonetic similarity in the words "Harry Potter" and "Hari Puttar," what has to be borne in mind is that the Harry Potter films are targeted to meet the entertainment needs of an elite and exclusive audience -the cognoscenti- an audience able to discern the difference between a film based on a Harry Potter book on the one hand and a film which is a Punjabi comedy on the other, the chief protagonist of which is Hari Prasad Dhoonda [T]he possibility of an unlettered audience viewing a HARRY POTTER movie are remote, to say the least. To put it differently, an illiterate or semi-literate movie viewer, in case he ventures to see a film by the name of Hari Puttar, would never be able to relate the same with a Harry Potter film or book.²²⁷

It is interesting Justice Khetrpal chose to concentrate on the cognoscenti, those that have considerable experience with Harry Potter. Originally the target audience was comprised of preteens and young children, but Harry Potter has grown to be appreciated by adult audiences.²²⁸ However, even if the most Harry Potter-literate consumer would not be confused by the *Hari Puttar* movie title, it is foreseeable that the illiterate, or even semi-literate, movie viewer would likely be confused, at least initially. Regardless of whether or not someone new to the Harry Potter franchise could "never be able to relate the same with" *Hari Puttar* on a cinematic, or even visceral level, the initial confusion to the Harry Potter-illiterate is present. According to section 29(1) of the Indian Trade Marks Act, infringement of registered trade marks occurs when an unauthorized person uses an identical or deceptively similar mark in commerce in a manner that is taken to be used as a trademark.²²⁹

226. See International Trademark Association, Initial Interest Confusion, <http://inta.org/index.php?option=comcontent&task=view&id=1438&Itemid=153&getcontent=3> (last visited Oct. 20, 2009).

227. Warner Bros. Entm't v. Kohli, IA No.9600/2008 in CS(OS) 1607/2008, para. 33 (India Sept. 22, 2008), available at <http://indiankanoon.org/doc/395839>.

228. Mira Serrill-Robins, *Still Hog-Wild Over Hogwarts*, BUSINESSWEEK, July 18, 2005, at 78, available at http://www.businessweek.com/magazine/content/05_29/b3943085_mz016.htm.

229. The Trade Marks Act § 29(1), No. 47 of 1999; India Code (1999), available at <http://indiacode.nic.in/> (select "Short Title"; then search for "The Trade Marks Act"; then select "Download full act") ("A registered trade mark is infringed by a person who, not being a registered proprietor or a person using by way of permitted use, uses in the course of trade, a mark which is identical with, or deceptively similar to, the trade mark

According to section 29(1), the title, *Hari Puttar* infringes on the Harry Potter mark because the title is “deceptively similar” to the registered Harry Potter trademark, especially to the Harry Potter-illiterate. The *Hari Puttar* name is similar to Harry Potter, and is being used in the same trade as the Harry Potter name—in this case, the movies.

According to Pravin Anand, when determining trademark infringement, Indian courts generally take into account a variety of factors such as: (1) whether the marks are similar in sight, sound, and meaning; (2) the similarity of goods; (3) the strength of the mark, whether it is descriptive or very unique; (4) the sophistication of the buyer; (5) the defendant’s intention; (6) whether or not the mark is used widely by others so that it is in the public domain; (7) instances of actual confusion; and (8) the fame of the mark, determined by length of use, volume of sale, and advertising.²³⁰ The pronunciation of the two film titles is very similar. Furthermore, there is some evidence that the name Hari Puttar is the Indian reference to Harry Potter.²³¹ Mirchi Movies even released a press release clarifying the difference between Harry Potter, and their movie, *Hari Puttar*.²³² Why would the defendant feel the need to clarify between their movie and the plaintiff’s mark if the probability of confusion were not likely?

Even Indian case law recognizes that phonetic similarities in titles create confusion. In another Delhi High Court case, *Polygram India Ltd. v. Super Cassette Industries Ltd.*, C.M. Nayar J., granted an interim injunction to stop the defendant from using titles similar to those that plaintiff used for devotional audio cassettes.²³³ Justice Nayar restrained the defendant from “using the titles Bhajan Yatra, Bhajan Sandhya and Bhajan Ganga, or any other title or titles which may be *deceptively similar* to the titles in respect of goods of the plaintiff.”²³⁴ The Indian Trade Marks Act states that a mark is deceptively similar to another “if it so nearly resembles that other mark as to be likely to deceive or cause

in relation to goods or services in respect of which the trade mark is registered and in such manner as to render the use of the mark likely to be taken as being used as a trade mark.”).

230. Anand, *supra* note 67, at 85.

231. Spicy IP, *supra* note 220.

232. Gaurav Malani, *India’s Reply to Harry Potter*, INDIA TIMES, Mar. 6, 2008, <http://movies.indiatimes.com/articleshow/2840453.cms>.

233. Chander M. Lall, *India: Passing Off—Music—Use of Confusing Titles in the Music Industry on Audio Cassettes and CDs*, 9 ENT. L.R. N90, N90 (1998).

234. *Id.* at N91 (emphasis added).

confusion.”²³⁵ In this case, the defendant’s audio cassettes operated under the same names the plaintiff originally used.²³⁶ However, in this case, defendant copied every form of plaintiff’s cassette tapes, including hiring the same singer, using the exact same songs, and using similar artwork for the cassette cases.²³⁷ In the *Warner Bros.* case, plaintiff did not allege exact copying of the Harry Potter trademark,²³⁸ thereby making the case fall within less clear cut standards.

Even more practically, the release of *Hari Puttar: A Comedy of Terrors* in other countries could create confusion, especially with respect to the pronunciation by non-native Indians when pronouncing the movie title. In the United States, it is completely conceivable that the pronunciation of the title *Hari Puttar* would be very similar to Harry Potter, and would cause confusion to consumers. Granted, the Delhi High Court only has jurisdiction in India, it is only fair and prudent to determine the phonetic similarities with regard to domestic likelihoods. It will be up to courts in other jurisdictions to determine whether the pronunciation of *Hari Puttar* will likely cause confusion among consumers.

In doing so, however, the Court should take into account the cultural coincidences. For example, the chief executive of Mirchi Movies, Munish Puri, stated that “Hari” is a popular name for boys in India and that “Puttar” means son in Punjabi.²³⁹ The court must have been aware of such cultural coincidences, seeing as the presiding court is within India, and presumably, better equipped to realize the cultural coincidences than American-based Warner Brothers. Yet, the court decided to hinge the case on procedural and bad faith grounds, rather than discussing the cultural coincidences and how such a coincidence factors into the case. A cultural coincidence, however, does not absolutely conclude in favor of Mirchi Movies in this case. Even though the translation of the title does resemble a portion of the movie’s plot, the phonetic similarity is likely to create confusion nonetheless, especially to those not privy to Punjabi cultural standards. Bollywood movies are often shown in other countries, namely the U.K., and even the U.S. It is quite possible that persons with no Indian ties, based on title alone, may confuse *Hari Puttar* for Harry Potter, or an affiliation therewith.

235. The Trade Marks Act § 2(h), No. 47 of 1999; India Code (1999), available at <http://indiacode.nic.in/> (select “Short Title”; then search for “The Trade Marks Act”; then select “Download full act”).

236. Lall, *supra* note 233.

237. *Id.*

238. See *Warner Bros. Entm’t v. Kohli*, IA No.9600/2008 in CS(OS) 1607/2008, para. 1–2 (India Sept. 22, 2008), <http://indiankanoon.org/doc/395839>.

239. Rhys Blakely, *Hari Puttar? It’s a Wizard Idea, but Hollywood Claims It’s a Rip Off*, THE TIMES, Aug. 25, 2008, http://entertainment.timesonline.co.uk/tol/arts_and_entertainment/film/bollywood/article4608340.ece.

Under the doctrine of foreign equivalents, foreign words are translated to English to determine whether or not the trademark is generic, descriptive, or similar in meaning to English marks.²⁴⁰ The test to determine confusion in such a case is whether “American buyers familiar with the foreign language . . . would denote its English equivalent.”²⁴¹ Therefore, under the doctrine of foreign equivalents, Americans, and probably Brits, would associate Hari Puttar with Harry Potter because Puttar is a Hindi derivative of Harry Potter, having used the Puttar name in translations of the Harry Potter books.²⁴²

WB argued that determining the similarity between the two movie titles should be subject to the “view of an ‘unwary purchaser of average intelligence and imperfect recollection.’”²⁴³ According to the Lanham Act, which governs trademark law in the United States, the test for confusion is whether the use of a trademark “is likely to cause confusion, or to cause mistake, or to deceive.”²⁴⁴ A showing of actual confusion would have greatly helped WB,²⁴⁵ but because WB was seeking an injunction against Mirchi Movies to prevent the premiere and distribution of *Hari Puttar: A Comedy of Terrors*, there was no opportunity to show actual confusion. However, a poll on the website Spicy IP, a blog regarding Indian intellectual property policy, stated that 68% of the website’s users were reminded of Harry Potter at the mention of *Hari Puttar*.²⁴⁶ Furthermore, *The Observer*, a United Kingdom newspaper reported that consumers were, in fact, confused by the similar title.²⁴⁷ Two consumers in their twenties thought they were going to see a movie about wizards and magic, but were instead unpleasantly surprised.²⁴⁸ “‘We thought there will be magic, but it has nothing to do with witchcraft and wizardry,’ said Dinesh Kumar, 22. His girlfriend, Archa Kapoor, was equally unhappy: ‘We came for Harry Potter, but it turned out to be Home Alone,’

240. 1 MCCARTHY, *supra* note, § 23:36.

241. *Id.*

242. Bollywood News, Hari Puttar Hindi Movie, <http://bollywoods-news.blogspot.com/2008/08/hari-puttar-hindi-movie.html>.

243. Warner Bros. Entm’t v. Kohli, IA No.9600/2008 in CS(OS) 1607/2008, para. 16 (India Sept. 22, 2008), *available at* <http://indiankanoon.org/doc/395839>.

244. Lanham Act §32, 15 U.S.C. § 1114(1)(b) (2006).

245. *See* Anand, *supra* note 67, at 85.

246. Spicy IP, *supra* note 220.

247. Gethin Chamberlain, *Hari Puttar Fails to Conjure Potter Magic*, THE OBSERVER, (Sept. 28, 2008), at 40, *available at* <http://www.guardian.co.uk/film/2008/sep/28/india.hari.puttar>.

248. *Id.*

she complained.”²⁴⁹ There have been other instances of actual confusion. Various media outlets have mistaken the *Hari Puttar* title for a parody on Harry Potter.²⁵⁰

Even though the WB owns the registered trademark of the Harry Potter brand in India,²⁵¹ it is helpful to examine the *Warner Bros.* case in terms of passing off. Harry Potter is a valid trademark and world-wide famous brand with much associated financial wealth. Examining the title alone, a case for passing off is likely to succeed. Phonetically, the *Hari Puttar* name trades on the reputation of Harry Potter. The similarities conjure up boy wizards and magic. Confusion is likely; furthermore, consumers have actually been confused by the similar titles. However, examining the title in conjunction with promotional materials, the iconic boy wizard is nowhere to be found. Daniel Radcliffe, the actor who portrays Harry Potter in the WB movies, is not pictured on any promotional materials. Instead, a young, sunny-faced Indian boy is placed prominently on movie posters promoting *Hari Puttar*. It is unlikely that any literate Harry Potter fan would mistake an Indian boy on a *Hari Puttar* poster for the boy wizard sporting glasses and a lightning shaped scar on his head; most of the world is at least semi-literate with regards to Harry Potter.

Mirchi Movies lucked out by having the case dismissed on procedural grounds. More likely than not, the court would have ruled in favor of Warner Brothers on the trademark infringement claim. But the fact that huge production studios such as Warner Brothers are so ardent in their endeavor to protect their literary works shows that there is a need for greater protection of literary titles. A copyright and trademark law regime governing literary titles would afford authors greater protection of their literary titles.

Copyright law could have afforded the Warner Brothers title with more protection, even though the Harry Potter character is not protected in titles because of the lack of specificity associating the character with the mere words “Harry Potter.” If the titles of the Harry Potter films were copyrightable, the substantially similar sounding “Hari Puttar” would likely be found infringing on the exclusive right to copying.²⁵²

249. *Id.*

250. Rediff India Abroad, First Look: Hari Puttar, <http://www.rediff.com/movies/2008/apr/24hari.htm> (last visited July 16, 2009); *See also Shamita to Shake Leg with Kids in Hari Puttar*, THE SIASAT DAILY, July 28, 2008.

251. Warner Bros. Entm’t v. Kohli, IA No.9600/2008 in CS(OS) 1607/2008, para. 2 (India Sept. 22, 2008), *available at* <http://indiankanoon.org/doc/395839>.

252. The Copyright Act, ch. III, § 14(a)(i), No. 14 of 1957; India Code (1993), *available at* <http://indiacode.nic.in/> (select “Short Title”; then search for “The Copyright Act”; then select “Download full act”) (stating that infringement of a copyright occurs if a reproduction of any substantial part of copyrighted work occurs).

And the display of the title on movie posters, advertisements, as well as the distribution of the movie would also infringe on the copyright of the film title.²⁵³ Thus, Warner Brothers would have had more arguments for its case against Mirchi Movies—so much so that the Delhi High Court would have been highly likely to rule in Warner Brothers' favor. Furthermore, such a ruling would have given Mirchi Movies more incentive to create a wholly different title, one that did not conjure the allusion to a famous boy wizard.

VII. CONCLUSION

There is a need to ensure the integrity of the marketplace and protect both consumers and movie producers from confusion and brand dilution, respectively. Moreover, the entertainment industry needs a regime that encourages creativity and innovation in the film title arena not only to put more moviegoers in theater seats, but to prevent further costly litigation over similar film titles. Were both trademark and copyright laws to govern film titles in the United States, India, and the United Kingdom, innovation and economic growth would occur within the most influential film industries of the world. A combination of trademark law and copyright law in the use of film titles affords increased intellectual property protections without eliminating the safeguards against such increased protections, such as fair use. A combination of such legislation regarding film titles not only affords authors the right to the expression in which they exert intellectual effort, but benefits the public by reducing instances where audiences are confused by too similar film titles.

253. *Id.* § 14(a)(ii) and (iii).

