

L E G A L E Y E

by Michael Bergman

Marked

The lengthy revision of Canada's copyright laws may interest the reader in copyright's complement, trademarks. Trademark is another form of intellectual property; that is to say, a legal interest in the expression of an idea. The idea in this case is the distinctive name or logo of an object or entity. Its appeal rises from the human desire to identify things by distinctive titles which do not necessarily reflect the object's generic origin and from the need of our commercial and consumer society to imprint catchy I.D. tags in the users' minds. The economic value of knowing brand X can be enormous. How many people still call Xeroxing

photocopying? Who asks for tissue paper instead of Kleenex?

In filmmaking, trademarks have several applications. They help to identify and advertise the filmmaker and they associate him with secondary or spin-off products to the film.

The process known as trademark is really the obtaining of its registration. All distinctive marks which are original to an identifiable product or entity are, in fact, trademarks. The user of these marks does have certain rights of protection to prevent others from using or appropriating such marks without permission. Unregistered trademarks, though like unregistered copyrights,

are a poor idea. The abuser of an unregistered trademark may defend himself by claiming that the mark is not original to the product or that it has been used before in association with a similar product and therefore has fallen into the public domain. These kinds of defences make prosecution more difficult. A lawsuit for what is known in most provinces as the tort of passing off involves the plaintiff proving the originality of the mark, its application to a distinct product and the plaintiff's entitlement to use the mark. Trademark legislation is designed to afford the original or licenced user of the mark both a degree of protection and a facility of prosecution in the event of trademark violation. The statute does so by a process of registration. Unlike copyright registration though it is a much more onerous and difficult process.

The statute safeguards existing trademark registrations by forbidding subsequent regis-

trations of trademarks which are not distinct or may be confused with existing trademarks.

Applications to register trademarks require careful thought. Their completion is contingent on a number of factors. It must be determined what the exact trademark is, whether it is a word, phrase or graphic design. If it is a design, colouration may be an aspect of further specification.

Trademarks do not exist *a priori*; they must be fixed in time as to their first use or "making known" in Canada. This date establishes a system of priorities between conflicting applicants for the same or similar trademarks. Obviously the one earlier in time will have the advantage. The trademark must refer to a specific classification of wares or services; no mark is universal. The definition of the class of wares or services defines the owner's right to protection. It is, in fact, possible to have a trademark which applies to filmmaking and a similar trademark which applies to shoes.

Unlike copyright, trademarks are strictly national; their registration in one country does not imply registration in another. Consequently it would be necessary to register trademarks in every country where their use would be appropriate; otherwise useful trademarks may fall into the hands of competitors in foreign markets. The effect of trademark registration is restricted as to time. On the expiration of the prescribed time-limit, the filing of a renewal will be necessary.

There is some considerable traffic in the granting of licences from registered trademark owners to licencees. It would be normal for example for the distributor of film spin-off products to be accorded a licence over the mark that represents these products. This licence should be registered with the Trademarks Office to accord the licencee the status of a registered user. This registration process confirms the licencee's right as against the trademark owner and in turn

provides the licencee with certain rights as against any infringement by others.

As the trademark application is more complex, it follows that the process of registration is much longer. The Trademarks Office will research the mark to try to identify competing or conflicting claims or existing registrations. Upon being researched the application will be advertised in the little-known and little-read *Trademarks Journal* to determine if anyone wishes to oppose the application. If no opposition is forthcoming, the registration will normally be granted. This whole process can take six months to one year. During this time the trademark owner's use and protection awaits the outcome of registration. Normally trademark users cannot await the completion of the trademark process before using their mark. During this waiting period trademark users would fend off infringement through the more difficult ordinary legal remedies noted above. Quite often major companies will register a whole slew of trademarks long before they are to be sued in order to keep for themselves commercially interesting slogans which may apply to yet to be invented products.

The trademark process is considerably more expensive than copyright registration. It is generally necessary to use a trademark agent who is usually a lawyer. The government exacts certain fees, such as a \$150 application fee. Given the time, effort and expense of trademarks, they are generally considered in the Canadian film industry for established film corporations or when the possibility is quite imminent. No doubt with the maturing of the industry, many more applications for trademarks will be forthcoming, a sign of the industry's increasing commercial viability.

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