



## TITLE AND TRADEMARK CLEARANCE

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It is now common practice for media distributors and insurers to require producers to provide a title and trademark search report and legal opinion in addition to other production deliverables. Title clearance is one of many clearance procedures now required by E&O insurance carriers to minimize the risk of litigation involving the insured production. The requirements for title and trademark clearance are typically included as a routine part of the production contract between producer and distributor. Title clearance is typically the producer's responsibility. Discovery Communications' standard production contract, for example, requires producers to prepare a title and trademark legal opinion before commencing post-production and to provide a copy of the title and trademark clearance report and legal opinion as part of the programs' deliverables.

Many producers are unfamiliar with the requirement for title and trademark clearance. It is often an overlooked production cost which comes as an unwelcomed surprise at the end of the production cycle. There are still producers who scramble to secure title clearance in the final days before broadcast – treating title clearance either as an afterthought or an annoyance which only needs to be addressed after post-production is complete. This can create serious problems. Not only can title problems cause broadcast delays but they can also result in added costs if the title needs to be changed. These problems can easily be avoided with a proper understanding of title and trademark search and legal opinion requirements. Properly performed, a title and trademark search report and legal opinion can determine whether a particular title is available for use in connection with a production, and can identify potential copyright and trademark infringement and related claims before they arise.

Titles are not protected by copyright as such. However, the use of an identical or highly similar title can be evidence of the substantial similarity between two works as a whole. Under certain circumstances, a title can also function as a trademark and as such may be entitled to protection under trademark laws. In order for a word or phrase to qualify as a trademark, it must function as a trademark – that is, it must be used to identify and distinguish the user's goods or services from that offered by others. This is often true in the case of a television series where the title is being used in connection with more than one episode of a program. A title may also function as a trademark when used in connection with derivative and ancillary products related to the production. For example, "Monster Garage" is the title of a popular television show aired on the Discovery Channel. The words "Monster Garage" also function as a trademark both as the name of an ongoing television series and as a trademark identifying toys and games sold by Discovery Communications through its Discovery Store retail outlets.

Trademarks need not be registered with the US Patent and Trademark Office to be protected, although registration may be advisable for a number of reasons. Use of a mark that is the same or substantially similar to a trademark that is already in use in connection with the same or substantially similar goods or services, may subject the user to liability for injunctive or monetary damages in the event that the owner of the senior mark takes legal action. Even where the goods or services identified by the mark are very different, a proposed mark that is the same or substantially similar to a distinctive, well-known mark may be subject to a claim under trademark anti-dilution laws.

Choosing a title often requires the input or approval of the distributor. In pure acquisitions, however, the title may be selected solely by the producer. In selecting a title, a producer should do a preliminary search using the free, public copyright and trademark databases. These are available on-line at [www.copyright.gov](http://www.copyright.gov) and [www.uspto.gov](http://www.uspto.gov) respectively. This initial review helps to eliminate obviously problematic titles before any significant search or legal costs are incurred.

Once a title is selected, a producer should retain legal counsel experienced in the preparation of title and trademark opinions. Either the lawyer or producer will then order the appropriate search report from a firm that maintains a comprehensive proprietary copyright and trademark database. ThomsonCompumark is one such service, but there are others as well.



The scope of the search will depend mainly on the specific requirements of the distributor or the insurer. If the production is a one-off and the distributor does not specifically require a trademark search, a title search may suffice. However, if there is clearly potential for ancillary products and merchandizing opportunities, a trademark search may also be advisable. Keep in mind that once a title is selected and used for programming and marketing, it can be difficult and expensive to change.

After the search report is received, the lawyer will carefully review the report and prepare a legal opinion letter analyzing its findings. A thorough legal opinion will specifically identify those titles or marks in the report which the lawyer believes may pose a potential for copyright or trademark infringement or related claims and attempt to quantify the risk they present. Often this is an objective analysis which requires the lawyer to weigh a variety of factors relevant to copyright and trademark law. The legal opinion letter should provide recommendations regarding the use of the title as a title and as a trademark, as well as the advisability of attempting to register the mark.

A standard title availability search report may cost US\$500 or more. A trademark search may run an additional US\$500 or more. Thomson Compumark ([www.compumark.thomson.com](http://www.compumark.thomson.com)) offers a combined title and trademark search called an Entertainment Availability Search (EAS) which costs about US\$900. Lawyers' fees for preparing legal opinions vary widely and price is rarely an indication of quality. Some firms provide flat fees for these services, while others simply bill by the hour for their time. The legal work involved is fairly predictable and an experienced attorney should be able to provide a fairly accurate estimate of what will be involved. In my experience, reviewing a title report and preparing a title opinion letter typically takes one to two hours of legal time, while preparing a combined title and trademark opinion letter usually takes between two and three hours. In light of this, I recommend that producers budget US\$1500-\$2000 for title and trademark clearance.

Failing to provide for title and trademark clearance may cause a producer to run afoul of their distributors' delivery requirements and the clearance procedures of its E&O insurance carrier. Also, since the producer usually represents and warrants to the distributor that the materials delivered to it will be free and clear and not infringe on the rights of others, the producer may find itself defending a poorly chosen title against infringement or related legal claims. At best, a producer may be forced to change titles retroactively. At worst, the producer may find itself spending limited resources on defending against claims that could easily have been avoided by following standard clearance procedures.