



FICPI 22nd Open Forum

Madrid

25-28 September 2024



FICPI Goes to the movies!

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Introduction

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Outline of session



- The importance of the use of brands in films and tv series
- Recent case law developments in the USA and potential international implications
- How to be an “audiovisual friendly trade mark”
- Clearance strategies
- Challenges and benefits arising from the business models of companies such as Netflix and Disney
- Top tips



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Trademarks and the Movies – USA

Megan Bannigan
Debevoise & Plimpton, USA



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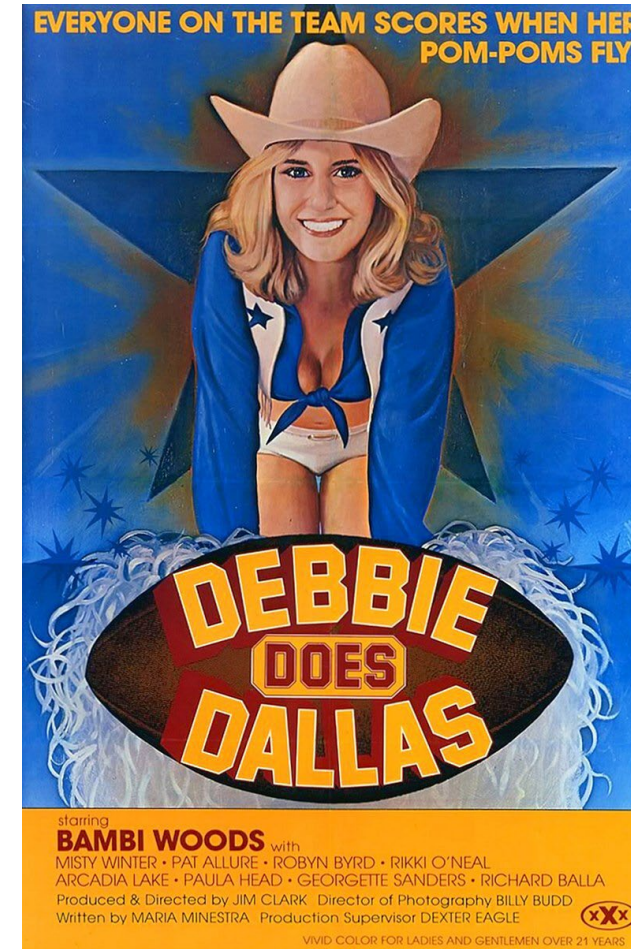


How Does U.S. Law Apply to Trademarks in Movies?

- **Basic Principles:**
 - **Trademark** law aims to prevent likelihood of consumer confusion
 - **The First Amendment** to the U.S. Constitution protects artistic expression, including movies, which overrides trademark law when the principles conflict
- How do courts balance these principles?



Debbie Does Dallas – Other Ways to Express the Idea?



*Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.,
604 F.2d 200 (2d Cir. 1979)*

Ginger and Fred – The “*Rogers Test*” for Balancing Freedom of Expression and Trademark Rights

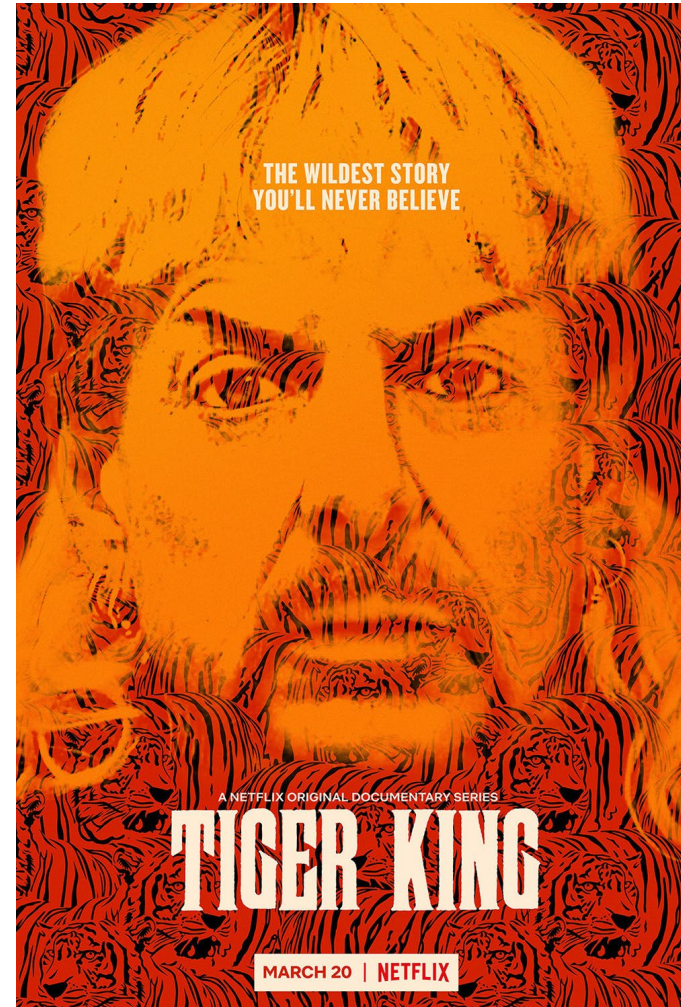


Rogers v. Grimaldi, 875 F.2d 994 (2d Cir. 1989)

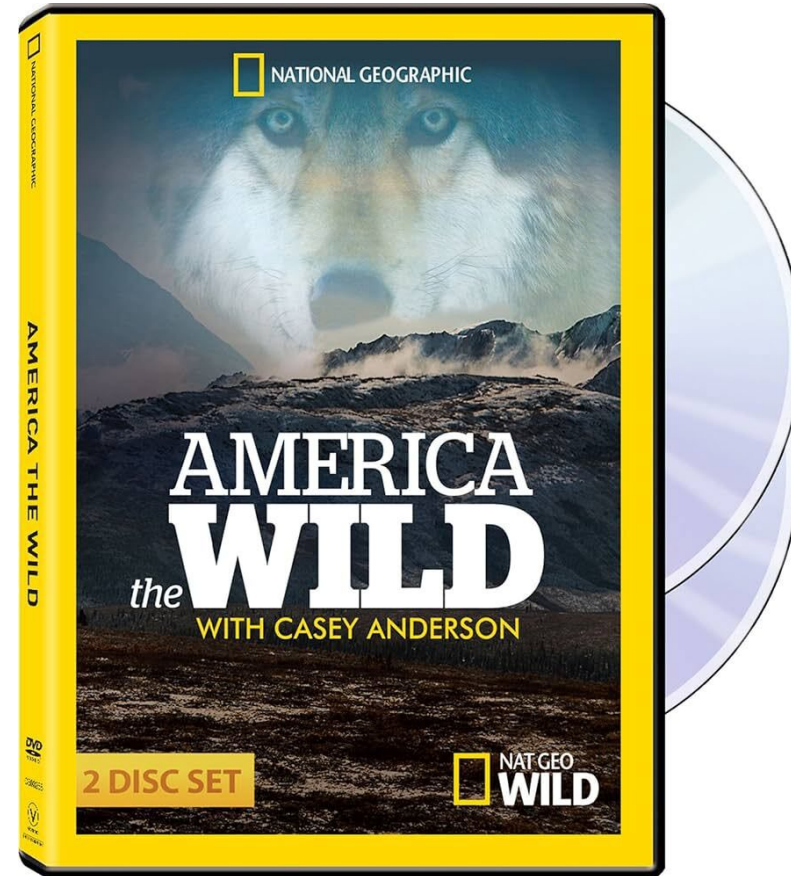
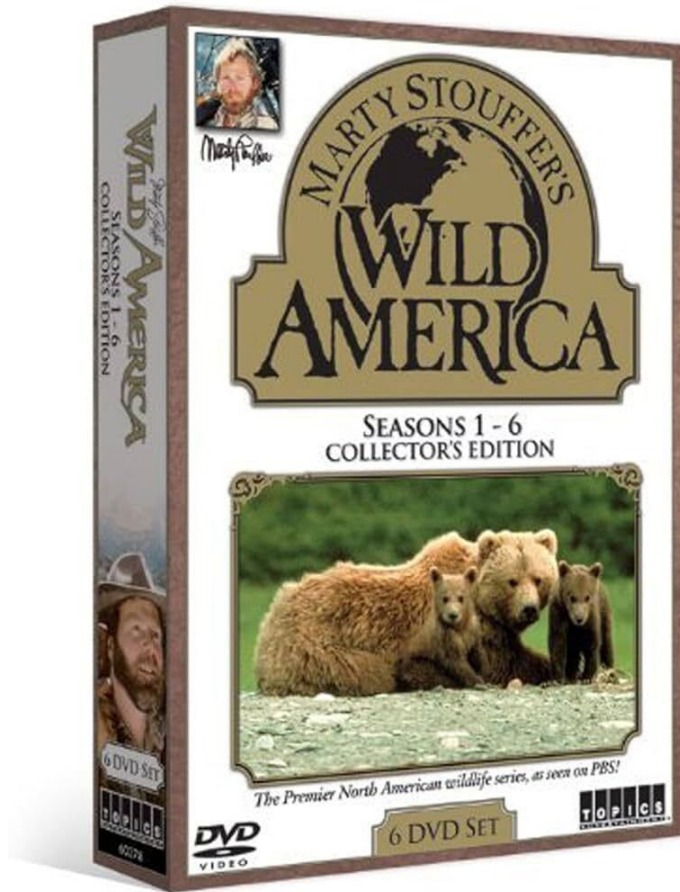


The “*Rogers Test*” for Balancing Trademark Rights and First Amendment Rights

- When a defendant’s **expressive work** is at issue, the general likelihood of confusion test does not apply.
- Instead, no violation of the Lanham Act unless the plaintiff can show that defendant’s use of plaintiff’s mark is either:
 - (1) **not artistically relevant** to defendant’s work; or
 - (2) **explicitly misleads** consumers as to the source or content of the defendant’s work
- If either (1) or (2) is shown, then proceed to standard likelihood of confusion test.



Jackson v. Netflix, Inc., 506 F. Supp. 3d 1007 (C.D. Cal. 2020)



Stouffer v. National Geographic Partners, LLC,
460 F. Supp. 3d 1133 (D. Colo. 2020)

Dairy Queens (*Drop Dead Gorgeous*): But Not Always!



Am. Dairy Queen Corp. v. New Line Prods., Inc.,
35 F. Supp. 2d 727 (D. Minn. 1998)

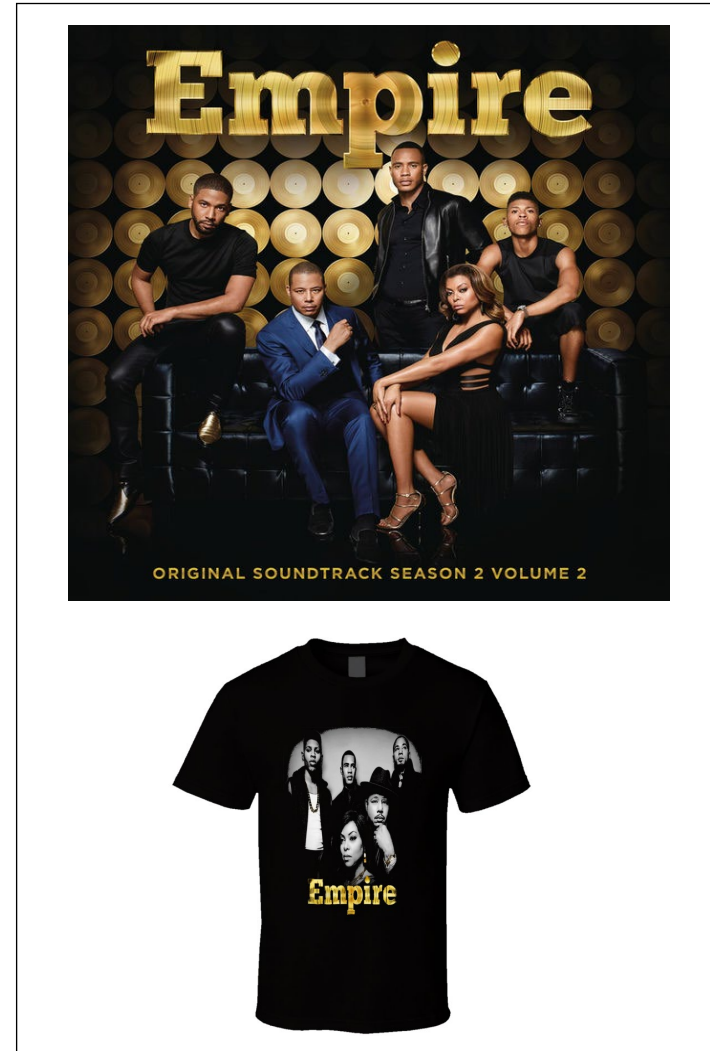


The Hangover Pt. II – Protecting Trademarks on Screen



*Louis Vuitton Malletier S.A. v. Warner Bros. Ent. Inc.,
868 F. Supp. 2d 172 (S.D.N.Y. 2012)*

Empire TV Show – Protecting Merchandise



*Twentieth Century Fox Television v. Empire Distr., Inc.,
875 F.3d 1192 (9th Cir. 2017)*

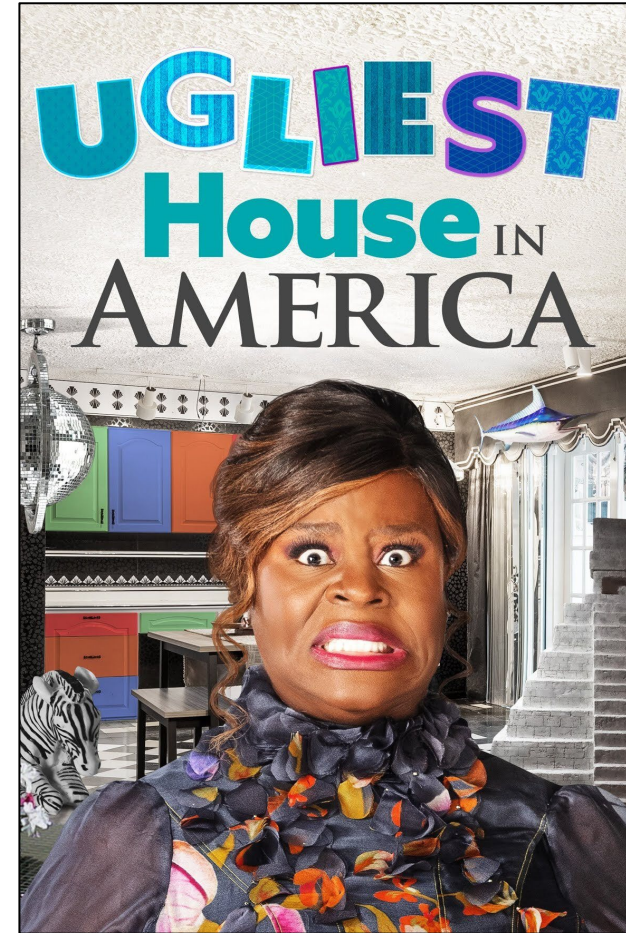


Jack Daniels v. VIP Products – But the Test Is in Flux

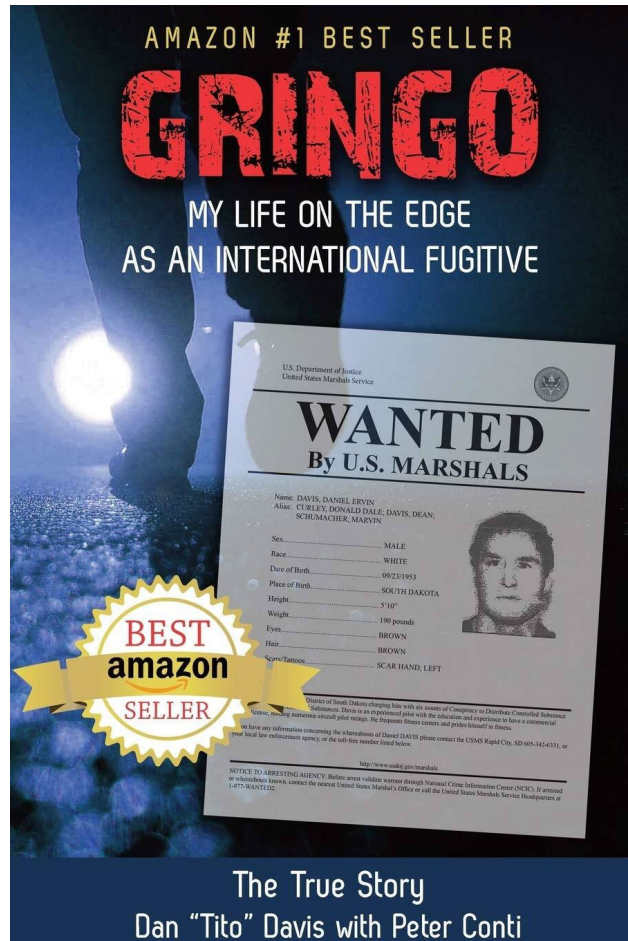


- The use of a trademark is **not protected** by the First Amendment if it is used as a trademark—i.e., **if it communicates source**.

Jack Daniel's Properties, Inc. v. VIP Products LLC,
599 U.S. 140 (2023)



HomeVestors of Am., Inc. v. Warner Bros. Discovery,
No. CV 22-1583-RGA, 2023 WL 6880341 (D. Del. Oct. 18, 2023)



Davis v. Amazon.com, Inc., No. 21-cv-02090,
2023 WL 8113299 (C.D. Cal. Nov. 2, 2023) (on appeal)

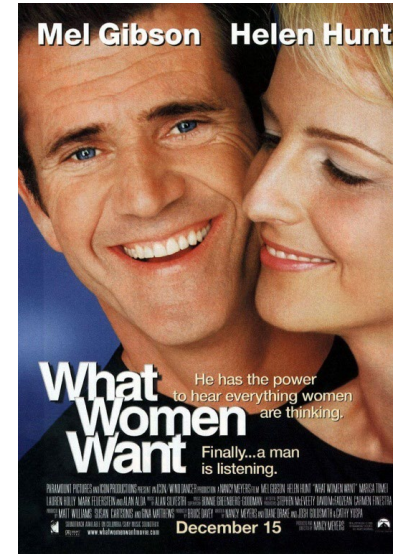


We Don't Always Need the First Amendment

- Not all cases involving trademarks in movies require a First Amendment analysis at all.
- In cases involving a trademark on screen, courts sometimes just apply the standard **likelihood-of-confusion analysis** for trademark infringement or the analysis for **trademark dilution**, without consideration of the First Amendment.



Hormel Foods Corp. v. Jim Henson Prods., Inc.,
73 F.3d 497 (2d Cir. 1996)



Gottlieb Development Corp. v. Paramount Pictures,
590 F. Supp.2d 625 (S.D.N.Y. 2008)



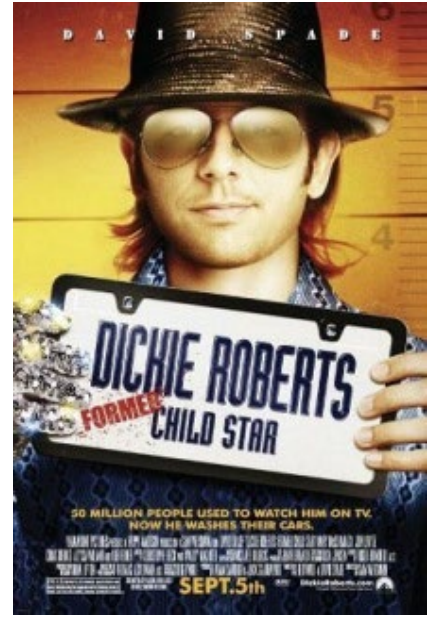
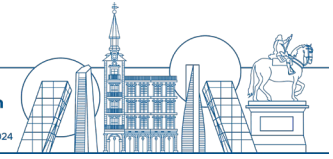
George of the Jungle II: Unflattering Depiction of Mark



*Caterpillar Inc. v. Walt Disney Co.,
287 F. Supp. 2d 913 (C.D. Ill. 2003)*



Dickie Roberts – Unflattering Depiction of Mark



Wham-O, Inc. v. Paramount Pictures Corp., 286 F. Supp. 2d 1254 (N.D. Cal. 2003)



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Trademarks and the Movies - Spain

Mabel Klimt Yusti
Elzaburu, Spain



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TRADEMARKS & AUDIOVISUAL

..a love story



A photograph of a large audience in a theater, seen from behind, sitting in rows of red seats. The audience is looking towards a stage area where red curtains are visible. The ceiling has a grid of lights. A white rectangular box is overlaid in the center of the image, containing text.

CLEARANCE PROCESS

What? Why? How?

HOW TO MAKE
YOUR
TRADEMARK
AUDIOVISUAL
FRIENDLY?





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Trademarks and the Movies – South Korea

Jordan Kim

Y.P. Lee, Mock & Partners, Republic of Korea



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“Squid Game”





“Squid Game” in Numbers

111

Million

Viewers in 28 days

90

Countries

No. 1 in viewers

2nd

Global Top 10

1st

In 14 Countries

6

Awards

In Emmy

U\$900

Million

Value for Netflix



“Squid Game” - fair in profit sharing?



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U\$21,000,000
Production cost
including...



U\$2 MIL for Commission



Controversy raised in South Korea

Unfair?	Fair?
Too little profit share to the Creators (0.2%)	Creators' own decision out of alternatives
Creators are foundation of the success	Creators benefited affluent budget leaving the risk to N
Poorer legal protection for creators than other countries	Under Principle of freedom of contract
KR become mere sub-con subservient to OTT	Guaranteed margin boosts further creation



OTT: Blessing or curse to Korean Film business??

- Moneywise;

- ✓ Blessed: enough investment with guaranteed commission
- ✓ Cursed: no profit shared

- Non-moneywise:

- ✓ Blessed: high reputation in K-movie & drama
- ✓ Cursed: 1) down graded self-identity (subordinated subcon?)
2) Movie theater business getting down



New laws suggested

- Adoption of “Remuneration Right” of the creators in Copyright Law possibly motivated by in 2020-23
 - ✓ EU: Principle of proper/prorated remuneration
 - ✓ France: Prorated Remuneration
 - ✓ Germany: Right to fair Remuneration, Right to *ex post* amendment
 - ✓ Spain: Right to *ex post* amendment of agreement
- Not yet legalized



Tips for counseling clients in South Korea



Do not fully trust client's story

Prepare your own check list

Interrogation-like pre-interview

Good understanding of KR film industry

Attention to agencies

Future is risk. Risk sharing is ZERO-SUM game

Good sense of power balancing of those engaged.

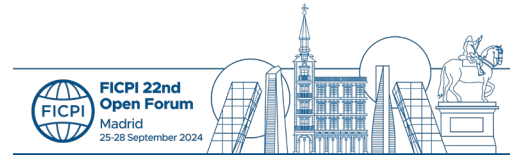


Questions?





FICPI // Events 2025



FICPI Korean Symposium
2-5 April 2025
Jeju Island, Republic of Korea



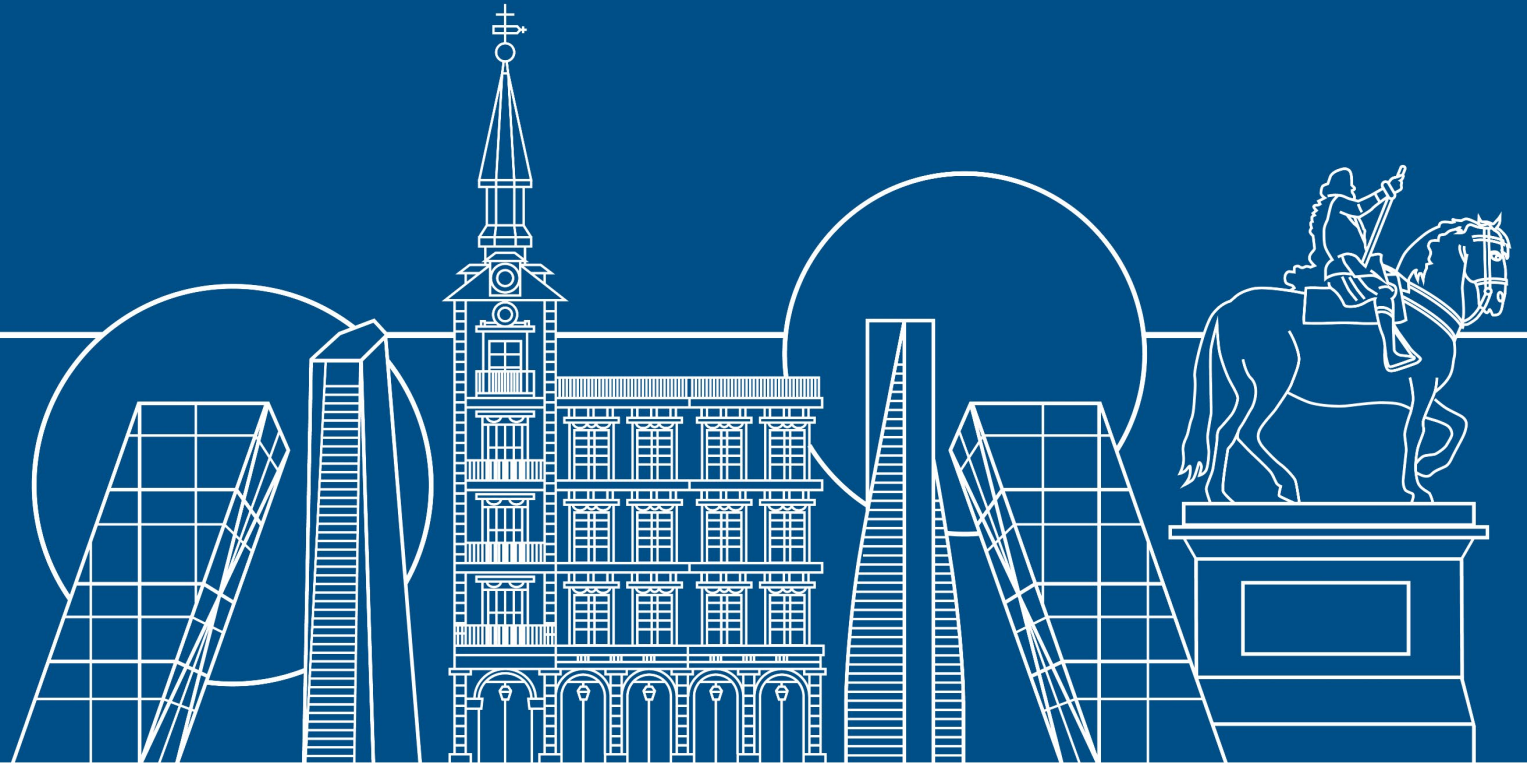
FICPI World Congress & ExCo Meeting
12-18 October 2025
Naples, Italy

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advance information and updates





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