



Legal Protection for Literary Titles

A MARXIST CASE STUDY

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1946 WAS A GREAT YEAR for the motion picture industry in the United States and for movie goers. With the repeal of the wartime excess profits tax, total net industry profits after taxes soared from \$89 million in 1945 to \$190 million in 1946. Equally impressive, 4.7 billion movie tickets were sold in the United States, making 1946 Hollywood's all-time peak attendance year.¹ And, although some might be tempted to attribute these increases to the expansion of the movie-going public with the return of soldiers, sailors and marines from overseas, the more likely reason is simply the phenomenal quality of movie offerings in 1946.

Two films released in 1946 – Frank Capra's Christmas classic, *It's A Wonderful Life*, and William Wyler's drama of war veterans adjusting to civilian life, *The Best Years Of*

Our Lives – are on the American Film Institute's list of the 100 Greatest Movies. But at least ten more films from 1946 would be recognized by critics and film-goers of today as classics, still well worth viewing.² These include:

- ♦ Alfred Hitchcock's *Notorious*, starring Cary Grant and Ingrid Bergman;
- ♦ John Ford's *My Darling Clementine*, starring Henry Fonda;
- ♦ Charles Vidor's *Gilda*, starring Rita Hayworth and Glenn Ford;
- ♦ Tay Garnett's *The Postman Always Rings Twice*, starring Lana Turner and John Garfield;
- ♦ Clarence Brown's *The Yearling*, starring Gregory Peck and Jane Wyman;
- ♦ King Vidor's *Duel in the Sun*, starring Joseph Cotton, Gregory Peck and Lionel Barrymore;

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- 1 At the time, the total population of the United States was only approximately 140 million. By way of contrast, in 2004, with a total population of more than 293 million, only 1.5 billion movie tickets were sold in the United States.
- 2 In contrast, 1945 saw the release of arguably only a single memorable film – Billy Wilder's *The Lost Weekend*, starring Ray Milland and Jane Wyman in a story of an alcoholic's mental collapse. Although some might add *National Velvet*, starring Elizabeth Taylor, and *The Bells of Saint Mary's*, starring Bing Crosby and Ingrid Bergman, to this list.

- ◇ Howard Hawk's *The Big Sleep*, starring Humphrey Bogart and Lauren Bacall;
- ◇ Robert Siodmak's *The Spiral Staircase*, starring Dorothy McGuire and George Brew;
- ◇ Michael Powell's *A Matter of Life and Death*, starring David Niven and Kim Hunter; and
- ◇ Walt Disney's partially animated *Song of the South*.

1946 also saw the return to Hollywood of the Marx Brothers. They had been absent from the silver screen since their very forgettable "farewell" movie, *The Big Store*, in 1941. Chico's gambling debts, however, had become so large that he implored Groucho and Harpo to agree to a reunion as the only way to generate enough money to pay off his card losses.³ They agreed and *A Night in Casablanca* was the result.

A Night in Casablanca takes place in North Africa at the Hotel Casablanca just after the surrender of Germany to the Allies in World War II. Escaped Nazi war criminal Heinrich Stubel has hidden looted jewels and art treasures in a secret room in the hotel, and he must reclaim them before fleeing to South America. The only way Stubel can do this without notice, however, is to take control of the hotel. Groucho, playing Ronald Kornblow, is hired as the new hotel manager after Stubel kills the two previous managers and no one else is willing to take the job. Chico, playing Corbacchio, owner of the

Yellow Camel Company, and Harpo, playing Stubel's mute valet, help Kornblow to thwart the Nazis and recover the stolen property. As a parody of wartime melodramas, *A Night in Casablanca* fails miserably. Indeed, with the exception of the song "Who's Sorry Now?," several sight gags by Harpo and the immortal line, "Play it again, Sam," the film is merely a pale imitation of the Marx Brothers' classics from the 1930s.⁴

Setting aside the artistic merits of the film, however, *A Night in Casablanca* does open a window on one of the great anomalies of intellectual property law – literary titles.⁵ For, as it turned out, the Marx Brothers' selection of *A Night in Casablanca* as the name of their reunion film was not without controversy. And that controversy serves as an excellent case study of legal protection for literary titles.

Literary titles have traditionally been the orphans of intellectual property law. It is a long-standing rule of copyright law that protection is unavailable for literary titles. For example, in *Osgood v. Allen*,⁶ the court, in a dispute over a magazine title, observed that "no case can be found, either in England or this country, in which, under the law of copyright, courts have protected the title alone, separate from the book which it is used to designate." The court concluded that the title "is a mere appendage, which only identifies ... the literary composition."⁷ Accordingly, the court held that literary titles were not copy-

3 Chico was addicted to poker for much of his life. One of many anecdotes about Chico's gambling is that a large check of his was found in the wallet of mobster Bugsy Siegel at the time of his murder in 1947. When the police questioned him about the check, Chico told them that it was for repayment of gambling debts.

4 The line, "Play it again, Sam," was never spoken in *Casablanca*, although it is frequently misattributed to that movie.

5 The term "literary title" is used in the law "to encompass the titles of books, periodicals, newspapers, plays, motion pictures, television series, songs, phonographs, records, cartoon features and the like." J. Thomas McCarthy, 2 *McCarthy on Trademarks and Unfair Competition* § 10:1 at p. 10-4 to 10-5 (2005).

6 18 F. Cas. 871 (D. Me. 1872).

7 *Osgood* is the oldest reported decision from a federal court in the United States I have found that actually held a literary title not to be entitled to copyright protection. In the much earlier case of *Jollie*

rightable. In *Black v. Ehrich*,⁸ the rationale for this rule was explained more fulsomely in language frequently cited in subsequent early decisions.⁹

Neither the author nor proprietor of a literary work has any property in its name. It is a term of description, which serves to identify the work; but any person can with impunity adopt it, and apply it to any other work, or to any trade commodity, provided he does not use it as a false token, to induce the public to believe that the thing to which it is applied is the identical thing which it originally designated.

As a result of "the absence of copyright protection on the title itself and the expense and delays of litigation to establish usage rights," the Motion Picture Association of America (the "MPAA") (known before September 1945 as the Motion Picture Producers and Distributors of America) initiated in 1925 a Title Registration Bureau which allowed member companies and independent producers to reserve specific film titles for their exclusive use.¹⁰ This self-regulatory service was intended to prevent duplication of titles and the likely accompanying confusion in the marketplace.¹¹

The MPAA intended that its Title Registration Bureau operate as a clearinghouse for film titles. Each participating company received a daily report of all title registrations. If a participating company noted a new registration that was arguably similar to

a previously registered title, it could file an objection with the Title Registration Bureau. The company registering the new title could then withdraw the registration or negotiate a resolution of the title dispute directly with the objecting company.¹² If negotiations between the disputing companies did not produce a resolution, the title dispute could then be taken to binding arbitration.¹³

Use of MPAA's Title Registration Bureau was a condition of membership for member companies of the MPAA. Other production companies could use it on a voluntary basis by becoming a party to the Bureau's title registration agreement. By entering into the title registration agreement, each participating company undertook to refrain from using a previously registered title. In exchange, a participating company's registered title was protected against use by any other participating company. Of course, in the event of the use of a registered title by a non-participating company, a lawsuit for trademark infringement was available.

When producer David L. Loew registered the title, *A Night in Casablanca*, in the spring of 1945 with the Title Registration Bureau, Warner Brothers noted the registration and filed a formal objection with the MPAA. Warner Brothers argued that registration of its 1942 *Casablanca* pre-empted the Marx Brothers' ability to use *A Night in Casablanca* as a title. The MPAA would have informed Loew of this objection and declined to register the title.

v. Jacques, 13 F. Cas. 910 (S.D.N.Y. 1850), Justice Nelson intimated that literary titles were not copyrightable, but ultimately declined to reach the question.

8 44 F. 793 (S.D.N.Y. 1891).

9 E.g., *Atlas Mfg. Co. v. Street & Smith*, 204 F. 398, 403 (8th Cir. 1913); *Wilson v. Hecht*, 44 App. D.C. 33, 36-37 (App. D.C. 1915).

10 *The 1946 Film Daily Year Book of Motion Pictures* 839 (Jack Alicoate, ed. 1946).

11 *Id.*

12 *Id.* ("Differences of opinion on similarities and other title controversies are adjusted first by direct negotiation between the registrants involved.")

13 *Id.* (If negotiation "fails to adjust the dispute it is then referred to arbitration for a final decision.")

Groucho, however, had no intention of giving up the title without a fight. Apparently without benefit of counsel, Groucho wrote a three-page response to what he described as Warner Brothers' "long, ominous legal document warning us not to use the name 'Casablanca.'"¹⁴ Without any opening pleasantries, Groucho got right to the heart of the matter writing that "up to the time we contemplated making this picture, I had no idea that the City of Casablanca belonged exclusively to Warner Brothers." After some speculation as to whether Jack and Harry Warner's great-great-grandfather had founded Casablanca "while looking for a shortcut to the City of Burbank," Groucho went on the offensive.

You claim you own Casablanca and that no one else can use that name without their [sic] permission. What about 'Warner Brothers' – do you own that too? You probably have the right to use the name Warner, but what about Brothers? Professionally, we were brothers long before you were. When Vitaphone¹⁵ was still a gleam in the inventor's eye, we were touring the sticks as the Marx Brothers, and even before us there had been other brothers – the Smith Brothers, the Brothers Karamazov; Dan Brouthers, an outfielder with Detroit; and 'Brother, Can You Spare A Dime?' ...

The younger Warner calls himself Jack. Does he claim that, too? It's not an original name – it was used long before he was born. Offhand, I can think of two Jacks – there was Jack of 'Jack and the Beanstalk,' and Jack the Ripper, who cut quite a figure in his day. As for Harry, the older brother, he probably signs his checks, sure in the belief that he is

the first Harry of all time and that all other Harrys are imposters. I can think of two Harrys that preceded him. There was Lighthorse Harry of Revolutionary Fame and a Harry Appelbaum who lived on the corner of 93rd and Lexington. ...

This all seems to add up to a pretty bitter tirade, but I don't mean it to. I love Warners – some of my best friends are Warner Brothers. It is even possible that I am doing them an injustice and that they themselves know nothing about this dog-in-the-Wanger attitude. It wouldn't surprise me at all to discover that the heads of Warners' legal department know nothing about this dispute for I am acquainted with many of them and they are fine fellows with curly black hair, double-breasted suits and a love of their fellow man that out-Saroyans 'Dr. Gillespie.' I have a hunch that this attempt to prevent us from using the title is the scheme of some ferret-faced shyster, serving an apprenticeship in their legal department. I know the type well – hot out of law school, hungry for success and too ambitious to follow the natural laws of promotion, this bar sinister probably needled Warners' attorneys, most of whom are fine fellows with curly black hair, double-breasted suits, etc., in attempting to enjoin us.

Well, he won't get away with it! We'll fight him to the highest court! No pasty-faced legal adventurer is going to cause bad blood between the Warners and the Marxes. We are all brothers under the skin and we'll remain friends till the last reel of 'A Night in Casablanca' goes tumbling over the spool.

In response, the legal department of War-

14 Having played lawyer J. Cheever Loophole in *At the Circus* (1939), Groucho probably believed he was perfectly competent to handle the matter himself.

15 Vitaphone was a sound-film process invented by AT&T and used by Warner Brothers from 1926 to 1930 in which a recording on disc was played in synchronization with the projection of film. It was largely replaced in 1930 by processes used to record sound directly onto film.

ner Brothers offered to negotiate a compromise, as the rules of the MPAA's Title Registration Bureau contemplated, and asked for information about the story line for *A Night in Casablanca*. Groucho replied as follows:

In case you haven't heard, we are doing a picture called *A Night in Casablanca*, Warner Brothers permitting. There isn't much I can tell you about the story. In it I play a Doctor of Divinity who ministers to the natives and, as a side-line, hawks can openers and pea jackets along the African Gold Coast. When I first meet Chico, he is working in a saloon, selling sponges to bar-flies who are unable to carry their liquor. Harpo is an Arabian caddy who lives in a small Grecian urn on the outskirts of the city. As the picture opens, Porridge, a mealy-mouthed native girl is sharpening some arrows for the hunt. Paul Hangover, our hero, is constantly lighting two cigarettes simultaneously. He, apparently, is unaware of the cigarette shortage. There are many scenes of splendor, fierce antagonisms and Color, an Abyssinian messenger boy, runs Riot. Riot, in case you have never been there, is a small night club on the edge of town. There's a lot more I could tell, but I don't want to spoil it for you. All this has been okayed by the Hays Office, Good Housekeeping and the survivors of the Haymarket Riots and, if the times are ripe, this can be the opening gun in a new world-wide disaster.

Obviously, this response was less than satisfactory to Warner Brothers. The company was not yet ready, however, to proceed to arbitration under the MPAA. Rather, it took another run at learning the storyline by reporting to Groucho that it still did not understand what *A Night in Casablanca* would be about and requesting more detail about the plot. Groucho thereupon sent the following note:

About our picture: There's not much to tell you at the moment. It's called *A Night in Casablanca* and in it, I play Bordello, the sweetheart of Humphrey Bogart. Harpo and Chico are itinerant rug peddlers, who are weary of laying rugs and enter a monastery just for a lark. This is a good joke on them as there hasn't been a lark in the place for fifteen years. Across from this monastery, hard by a jetty, is a water-front hotel, chock-full of apple-cheeked damsels, most of whom have been barred by the Hays Office for very obvious reasons. In the fifth reel, Gladstone makes a speech that sets the House of Commons in an uproar and the king promptly asks for his resignation. In the last reel, there's a tremendous amount of regeneration. Harpo marries a hotel detective; Chico operates an ostrich farm and Humphrey Bogart's girl Bordello spends her last years in a Bacall house. This, as you can see, is a very skimpy outline. The only thing that can save us is a continuation of the film shortage.

Shortly after this last missive, on May 11, 1945, syndicated Hollywood gossip columnist Hedda Hopper carried an item in her column predicting that Warner Brothers would "sue" the Marx Brothers over this title dispute. Thereupon, the *Los Angeles Times* picked up on the title dispute, running an article captioned, "Night in Casablanca Stirs Hot Title Row," on page A2 of its May 16, 1945 edition. And, on May 20, 1945, the *New York Times* ran a short piece about the dispute on the front page of Section 2. With the title dispute starting to gather momentum, Warner Brothers apparently decided that the adverse publicity from being seen as a stumbling block to a Marx Brothers reunion was not worth it and relented. The MPAA's Title Registration Bureau then cleared *A Night in Casablanca* for use as the title for the new film.

But Groucho knew a good public relations opportunity when he saw one and he began feeding friendly journalists inflammatory information about the title dispute. For example, Hedda Hopper's June 22, 1945 column announced, "Since the Marx Brothers cleared the title to 'A Night in Casablanca,' they'll try to name two characters in it Humphrey Bogus and Loand Behold." And, later that fall with shooting on the film set to begin, Groucho leaked his first letter to Warner Brothers to several journalists, generating a new round of stories about the title dispute, such as Leonard Lyons' September 12, 1945 syndicated "Broadway Bulletins" column, which reported that "the Marxes will sue to restrain the Warners from calling themselves 'Brothers.'"

At about this same time, Groucho Marx's physician, Dr. Samuel Salinger, wrote to him, concerned about the press accounts of the title dispute. Groucho reassured Dr. Salinger that *A Night in Casablanca* would be the title of the film and informed him about the origins of the recent press accounts.

We spread the story that Warners objected to this title purely for publicity reasons. They may eventually actually object to it, but I don't think so. Not being the giant legal mind that you are, I wouldn't venture a decisive opinion but my hunch is that any court would throw out such an absurd one. It seems to me that no one can forbid one from using the name of a city. There have been a number of pictures with Paris, Burma, Tokyo, etc., etc. used in the title. At any rate, the publicity has been wonderful on it and it was a happy idea. I wish they would sue, but as it is, we've had reams in the paper.

On May 10, 1946, *A Night in Casablanca* premiered in Los Angeles. Reviews were not kind. The *New York Times* perhaps said it best, concluding that "the spark seems to

have gone from the madcap Marxes." Fans, however, seemed willing to set aside the film's many inadequacies as *A Night in Casablanca* did a respectable box office – sufficient to bail Chico out from his gambling debts, at least for a few years.

Warner Brothers' retreat from the title battle may have been more than merely a wise decision to avoid a public relations black eye. It may also have been the product of good lawyering. Groucho's instincts were correct: Warner Brothers almost certainly would have lost any MPAA arbitration given the law relating to literary titles. In 1946, as now, movie producers had to rely upon trademark law for legal protection from those seeking to exploit a title without authorization. Yet the law has refused to treat literary titles on a par with trademarks used to identify other goods or services.

In general, the law accords protection to a trademark based on the "strength" of the mark – that is to say the distinctiveness of the mark in identifying goods or services in commerce. Thus, a generic trademark (e.g., "Milk" as the trademark for a milk product) is entitled to no protection. A descriptive trademark (e.g., "Dairy Mart" as the trademark for a place to buy dairy products) will receive protection *only* if it has acquired "secondary meaning" – the mark has become identified with a specific producer of goods or services in the mind of the public. A suggestive mark (e.g., "Golden Pastures" for a producer of dairy products) will receive protection without any showing of secondary meaning. And, an arbitrary or fanciful trademark (e.g., "Exxon" or "Unisys") will receive the most protection.

Trademark law, however, has refused to follow this well-established hierarchy in determining whether to accord protection to literary titles. Literary titles will only be protected as trademarks upon a showing that the title has acquired secondary mean-

ing in the minds of the public, even though the title might not be generic or descriptive of the underlying work. Even if a literary title is suggestive (e.g., "A Bridge Too Far") or fanciful (e.g., "Godzilla"), secondary meaning must still be shown to obtain trademark protection. As a result, a plaintiff who has used a title in connection with a single work will almost never be able to obtain relief under trademark law against a defendant who markets a competing work under the same title in the same medium.

Moreover, because the particular mark Warner Brothers sought to protect was a geographic designation, obtaining trademark protection would have been particularly difficult. Generally, geographic names cannot be appropriated when used only to describe the location itself. Thus, Groucho was correct in asserting that many books and movies had used names of the same cities in their titles.

Warner Brothers may have considered taking advantage of the one exception to these general rules on trademark protection. The law has been more generous in according protection to literary titles used for a series of works.¹⁶ Unlike a single work, the title of a series is presumed to have acquired secondary meaning, identifying the trademark owner as the source of the series. In effect, the title is not descriptive of any *one* book or movie, but of the series. Thus, each individual title in the *Star Wars* series of movies would be entitled to trademark protection.¹⁷

Warner Brothers would have been well aware of this "series exception" because it had invoked the exception more than a decade earlier in the famous case of *Warner Brothers Pictures v. Majestic Pictures Corp.*¹⁸ That case

had involved rights in the literary title, *The Gold Diggers*. *The Gold Diggers* was originally the title of a play by Avery Hopwood that was first performed in 1919 on Broadway. Warner Brothers acquired the motion picture rights to the play and produced a silent motion picture entitled *The Gold Diggers* in 1923 and a talking motion picture entitled *The Gold Diggers of Broadway* in 1929. In 1933, however, the defendants produced the movie, *Gold Diggers of Paris*, without authorization from Warner Brothers to use "Gold Diggers" in the title. The Second Circuit reversed the district court's denial of a preliminary injunction against the defendants' use of "Gold Diggers." Judge Augustus Hand, writing for the court, noted that "Gold Diggers" are "words of general description and ordinarily would not be subject to preemption." Here, however, "the public, by the exhibition of complainant's pictures throughout the United States, has been educated to regard 'Gold Diggers,' when used in connection with a motion picture, as meaning one of [Warner Brothers'] pictures based on Hopwood's play." Thus, the Second Circuit concluded, "it may be said that the title 'Gold Diggers' through wide publicity and long use has come to mean a motion picture of the general type we have described produced by Warner Bros. Pictures, Inc., and that it is unfair for the defendants to use these words in connection with another motion picture play of the same general type."

Of course, Warner Brothers had not yet released a sequel to *Casablanca*, although its phenomenal success (\$10 million gross on a budget of less than \$1 million) must have led to some consideration being given to a

16 As it turned out, this would prove to be a very valuable exception to Hollywood after 1975, as sequels came to dominate the market – e.g., *Rocky I-V*, *Nightmare on Elm Street I-VII*, *Rambo I-III*.

17 *Star Wars: Episode IV – A New Hope* (the first movie released in the series) became eligible for trademark protection no later than the release of *Star Wars: Episode V – The Empire Strikes Back*.

18 70 F.2d 310 (2d Cir. 1934).

sequel.¹⁹ But, even if Warner Brothers had planned a sequel, it would not have been entitled to trademark protection on *Casablanca* until it had released the sequel. The Marx Brothers' inevitable prior release of *A Night in Casablanca*, however, would have preserved their rights to that name even after release of a *Casablanca* sequel. Thus, even under the series exception, it is unlikely that Warner Brothers could have prevailed in arbitration against the Marx Brothers, over the title *A Night in Casablanca*. Thus, the difficult legal terrain facing any effort to protect a literary title may have played as much a part as the likelihood of negative publicity in deterring Warner Brothers from pushing its dispute with the Marx Brothers to arbitration.

Even if Warner Brothers did not succeed in protecting *Casablanca* from use by the Marx Brothers, it might have still prevailed. In its original conception, *A Night in Casablanca* was intended to be a parody of *Casablanca* with Groucho playing a character called "Humphrey Bogus." Warner Brothers' repeated inquiries about the plot of *A Night in Casablanca* apparently had the effect of chilling this approach. Instead, the Marx Brothers turned their reunion movie into a more generalized spoof of wartime melodramas. Unfortunately, this more general approach did not play very well – a frequent

problem with parodies that are not limited to burlesquing a specific work.²⁰ Thus, Warner Brothers' aggressive assertion of rights in the literary title to *Casablanca* left generations of Marx Brothers' fans wondering what might have been with their last film together.²¹

As for the law of literary titles, not much has changed since 1946. The United States Patent and Trademark Office ("PTO") will not register the title of a single creative work.²² Indeed, the United States Court of Appeals for the Federal Circuit in *Herbko Int'l, Inc. v. Kappa Books, Inc.*,²³ held as a matter of law that "the publication of a single book cannot create ... an association between the book's title (the alleged mark) and the source of the book (the publisher)." As one commentator has argued, this view, in effect, means that all literary titles are *per se* generic.²⁴

Both the PTO and the Federal Circuit, however, continue to evince a willingness to accord trademark protection to the title of a series. But even with respect to a series, current law is very constraining. In the *Herbko Int'l* case, the Federal Circuit held that a series of books did not exist until the publication of a second volume. And, "the proprietary rights for the series title date back to the first volume of the series *only* if the second volume is published within a reasonable time with a requisite association in the public

19 Indeed, Frederick Stephani, director and co-writer of *Flash Gordon* (1936), pitched a sequel to Hal Wallis with the working title, *Brazzaville*, a reference to Claude Rains' line in the final scene of the film: "There's a free French garrison over at Brazzaville. I could be induced to arrange a passage." Nothing ever came of this proposal. A synopsis of the proposed script can be found at www.vincasa.com/indexcasa-sequel.html.

20 *Compare Airplane!*, a splendid parody of *Airport* and its sequels, with the not-so-hot *Hot Shots, Part Deux*, a more general parody of military/adventure movies.

21 The Marx Brothers did appear together again in *Love Happy* (1947), but this was primarily a vehicle for Harpo and Chico. Groucho was added as an afterthought to provide voice-over narration; he never appears in a scene with his brothers. He does appear, however, in one memorable scene with a very young Marilyn Monroe.

22 *Trademark Manual of Examining Procedure* § 1202.08 (3d ed. 2002) ("The title of a single creative work is not registrable. ... Examples of 'single creative works' include books, videotapes, films and theatrical performances.").

23 308 F.3d 1156 (Fed. Cir. 2002).

24 J. Thomas McCarthy, 2 *McCarthy on Trademarks and Unfair Competition* § 10:4 at p. 10–10 (2005).

mind.”²⁵ Although there is no reported decision on point, it must be presumed that this same rule would apply to movie titles.

Given the limited protection for literary titles under Federal law, state unfair competition law has developed as an alternative source of protection. For example, California law allows protection of a single literary title under a “passing off” theory of unfair competition. If a plaintiff can establish secondary meaning, likelihood of confusion and injury, it may obtain an injunction against competing use of a literary title.²⁶ Such an injunction is typically limited, however, to the use of disclaimers in advertising of the junior title.²⁷

The MPAA continues to maintain its Title Registration Bureau, with more than 5,000 movie titles being registered each year. The current title registration system continues to be mandatory for MPAA members, but voluntary for all other producers. It is governed by an April 1, 1992 “Memorandum of the Title Committee of the Motion Picture Association of America, Inc.”²⁸

The Memorandum provides that the first participating company to register a particular title shall be given priority registration position. Such registration conveys “rights” to the title for a period of time. The Memo-

randum also governs registration conflicts. Upon filing of a formal objection by a participating company, the objectionable title cannot be used until usage rights are determined. Usage rights may be determined by voluntary negotiation or arbitration. Arbitration is conducted by three disinterested members of the Title Registration Bureau’s Title Committee. The participating company that objected to the proposed title must prove in the arbitration that the proposed title is similar to a prior-registered title and that there is a likelihood of harm from allowing use of the proposed title. The arbitration finding is binding upon the parties to the arbitration.²⁹

Many commentators have railed against the anomalous treatment accorded literary titles by trademark law. Most frequently, these criticisms center on the lack of any distinction between how titles are used to trademark entertainment products and how brands are used to trademark common goods and services. As Justice Frankfurter stated in *Mishawaka Mfg. Co. v. Kresge Co.*, “The protection of trademarks is the law’s recognition of the psychological function of symbols. If it is true that we live by symbols, it is no less true that we purchase goods by them.”³⁰ Certainly, in the world of commercial entertain-

25 308 F.3d at 1163 (emphasis in original). Under this rule, the popular boys’ detective series, *The Hardy Boys*, could not have been trademarked upon publication of the first in the series, *The Hardy Boys: The Tower Treasure* in 1926. Only at publication of *The Hardy Boys: The House on the Cliff* in 1927 did a series exist, allowing for registration of *The Hardy Boys* as a trademark.

26 E.g., *Allied Artists Pictures Corp. v. Friedman*, 68 Cal. App. 3d 127, 137 Cal. Rptr. 94, 96–99 (Cal. Ct. App. 1977).

27 *Id.* at 99.

28 See generally “How Important is a Title? An Examination of the Private Law Created by The Motion Picture Association of America,” 56 U. Miami L. Rev. 1071 (2001–2002).

29 Participating companies are contractually bound to accept the results of arbitration. In *Gordon v. Warner Brothers Pictures, Inc.*, 269 Cal. App. 2d 31, 74 Cal. Rptr. 499 (Cal. Ct. App. 1969), however, the California Court of Appeal refused to recognize the MPAA’s arbitral ruling as binding. But at that time, the Memorandum only stated that an arbitration decision was “final.” The 1992 Memorandum explicitly states that arbitration is binding on all parties and a failure to abide by such a decision may result in termination of registration privileges.

30 316 U.S. 203, 205 (1941).

ment, consumers also live by symbols and an important symbol is the title given to a creative work.³¹ Why then should literary titles be treated differently?

One answer to this question is to be found in the interplay between copyright and trademark law. While trademarks can endure in perpetuity so long as the mark continues to be used in commerce, copyrights exist for a limited time. Thus, once a copyright expires and the work passes into the public domain, anyone may reproduce and distribute the work without restriction. If, however, the title of that work were trademarked, the work – now in the public domain – could only be used under a new title. Such a result would

wholly undermine the public policy of unrestricted use of public domain works. And, in order to avoid such a result, the law strictly limits the availability of trademark protection for literary titles.

This answer to the differential treatment of literary titles under trademark law is quite persuasive. Besides, the availability of the MPAA Title Registration Bureau does provide some amelioration of the seeming harshness of the rule. Given the foregoing and the long history of differential treatment for literary titles, it is unlikely that the law of literary titles will change any time soon. No doubt, Groucho would be pleased that his arguments have stood the test of time.



31 E.g., Patrick Goldstein, "Hey, Let's Play the Movie Title Game! The Crucial Search for a Perfect Grabber Can Be a Long, Complicated and Expensive Process," *Los Angeles Times*, Aug. 20, 1997 (recounting significance of particular title to success of movie).

Dear Warner Brothers!

Apparently there is more than one way of conquering a city and holding it as your own. For example, up to the time that we contemplated making a picture, I had no idea that the City of Casablanca belonged to Warner Brothers.

However, it was only a few days after our announcement appeared that we received a long, ominous legal document, warning us not to use the name "Casablanca".

It seems that in 1471, Ferdinand Balboa Warner, the great-great grandfather of Harry and Jack, while looking for a short cut to the city of Burbank, had stumbled on the shores of Africa and, raising his alpenstock, which he later turned in for a hundred shares of the common, he named it Casablanca.

I just can't understand ^{your} ~~Warner Brothers'~~ attitude. Even if they plan on re-releasing the picture, I am sure that the average movie fan could learn to distinguish between Ingrid Bergman and Harpo. I don't know whether I could, but I certainly would like to try.

^{You claim you} ~~So they say that they~~ own Casablanca and that no one else can use that name without their permission. What about Warner Brothers -- ^{you} do ~~they~~ own that, too? ^{you} ~~They~~ probably have the right to use the name Warner, but what about Brothers? Professionally, we were brothers long before ^{you} ~~they~~ were. When Vitaphone was still a gleam in the inventor's eye, we were touring the sticks as the Marx Brothers and even before us, there had been other brothers -- the Smith Brothers; the Brothers Karamazoff; Dan Brouthers, an outfielder with Detroit, and "Brother, can you spare a dime?" This was originally "Brothers, can you spare a dime" but this was spreading a dime pretty thin so they threw out one brother, gave all the money to the other brother and whittled it down to "Brother,

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can you spare a dime?"

The younger Warner Brother calls himself Jack. Does he claim that, too? It's not an original name -- it was used long before he was born. Offhand, I can think of two Jacks -- there was Jack of "Jack and the Beanstalk", and Jack, the Ripper, who cut quite a figure in his day. As for Harry, the older brother, he probably signs his checks, sure in the belief that he is the first Harry of all time and that all other Harrys are impostors. Offhand, I can think of two Harrys that preceded him. There was Light-horse Harry of Revolutionary fame and a Harry Appelbaum who lived on the corner of Ninety-third Street and Lexington Avenue. Appelbaum wasn't very well known -- I've almost forgotten what he looked like -- the last I heard of him, he was selling neckties at Weber and Heilbronner; but I'll never forget his mother, she made the best apple strudel in Yorkville.

We now come to the Burbank Studio. This is what the Warner Brothers call their place. Old man Burbank is gone. Perhaps you remember him -- he was a great man in a garden, he was the wizard who crossed all those fruits and vegetables until he had the poor plants in such a confused and nervous state, that they never were sure whether they were supposed to come in on the meat platter or the dessert dish.

This is just conjecture, of course, but, who knows -- perhaps Burbank survivors aren't too happy over the fact that a plant that grinds out pictures settled in their town, appropriated Burbank's name and uses it as a front for their films.

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It is even possible that the Burbank family is prouder of the potato produced by the old man than they are of the fact that from this town emerged "Casablanca" or even "Gold Diggers of 1931".

This all seems to add up to a pretty bitter tirade but I don't mean it to. I love Warners -- some of my best friends are Warner Brothers. It is even possible that I am doing them an injustice and that they themselves know nothing at all about this dog-in-the-Wanger attitude. It wouldn't surprise me at all to discover that the heads of Warners' legal department know nothing about this dispute for I am acquainted with many of them and they are fine fellows with curly black hair, double-breasted suits and a love for their fellow man that out-Saroyans "Dr. Gillespie". I have a hunch that this attempt to prevent us from using the title is the scheme of some ferret-faced shyster serving an apprenticeship in their legal department. I know the type -- hot out of law school, hungry for success and too ambitious to follow the natural laws of promotion, this bar sinister probably needled Warners' attorneys, most of whom are fine fellows with curly black hair, double-breasted suits, etc., in attempting to enjoin us.

Well, he won't get away with it! We'll fight him to the highest court! No pasty-faced legal adventurer is going to cause bad blood between the Warners and the Marxes. We are all brothers under the skin and we'll remain friends till the last reel of "A Night in Casablanca" goes tumbling over the spool.