

INTELLECTUAL PROPERTY BULLETIN

November 2005

WYRDER AND WEIRDER – CHOOSING AND PROTECTING A NAME

You may have read about the recent \$40 million lawsuit launched by the Canadian band *The Wyrdr Sisters* against Warner Bros. for the alleged use of their name *The Wyrdr Sisters* as the name of a band in the new film *Harry Potter and the Goblet of Fire*.¹ The real life band has been around for 15 years and is claiming that the publicity that has been generated by the use of their name in the film (even prior to the film's release) has created an unwanted association between their band and the film. As a result, they claim that people are going to be confused between the real band and the fictitious movie band. In addition to damages, the group is seeking an injunction to delay the release of the movie in Canada pending the resolution of this matter.

The facts of this case present a good opportunity to review how you should go about choosing and protecting a name, slogan or logo for your business or other venture, to ensure that you do not infringe the rights of others and that you have the best possible protection for your name. The *Harry Potter* situation is being used to illustrate these points and this bulletin is not meant as a comment on the case itself.

CLEARANCE

Before you choose and start using a name, slogan or logo for your business, you should ensure that it is available for you to use. This means doing the proper searches to determine whether anyone else has already secured the rights to that name. This is the case whether you intend to use the name as a trade-mark, a business name, the name of a legal entity or the title of a book or movie. In conducting the searches, you will want to find out whether anyone else is using the exact same name, or one that is confusingly similar. For instance, in the case of the original novel, the name used by J.K. Rowling for the band was *The Weird Sisters*, but the spelling of the name was changed in the film to *The Wyrdr Sisters*. However, it is doubtful that the band would have taken less offence at the use of their name just because the spelling was a little different, as the name would still have looked substantially similar and would have sounded the same.

In addition, because rights to a name arise territorially, it is necessary to clear the name in the countries in which you intend to use it. In some cases names are cleared for countries such as the US and the UK, but Canada is overlooked as not being a large enough market. This could have been what occurred in the *Harry Potter* case. The costs for searches do add up but you ignore any particular market at your peril, as can be seen in this instance.

Another point to consider in conducting the clearance searches is defining the use that will be made of the name or logo. In the *Harry Potter* case, if they had been using the name for a *Quidditch* team, the Canadian band may not have worried about it because people are less likely to consider that a sports team and a musical band are related. But because it was being used in association with a band, albeit fictitious, the potential for confusion was increased. Therefore, when you are clearing a name,

¹ "Legal Challenge Could Block Potter Film Release", ctv.ca, Oct. 26, 2005

you do not have to ensure that no-one else is using it for anything, but merely that it is not being used in association with wares or services that are similar enough to yours that the public would assume that there is some relation between you and the owner of the other name or that the wares and services are being produced by the same person.

PROTECTION

Once you have cleared your name, you should take steps to protect it. The best way to achieve this is to register the name as a trade-mark. If *The Wyrld Sisters* had registered their name as a trade-mark in Canada (as other bands such as *The Rolling Stones* and *U2* have done), then perhaps their name might have come to the attention of Warner Bros. before the production of the movie had progressed to this point. A trade-mark registration means that your name is listed on the Federal Trade-marks Register which is the first place one normally starts with any name clearance search. Warner Bros. have registered a number of names from the *Harry Potter* books as trade-marks in Canada including the titles of the books, the names of the main characters, and other names such as *Quidditch*, *Hogwarts* and *Diagon Alley*. Therefore they recognize the value of a trade-mark registration and also were obviously reviewing the Trade-marks Register in preparation for this film.

In addition to providing notice to others of your rights, a Canadian trade-mark registration gives you the exclusive right to use that trade-mark across Canada, in association with the wares and services for which it is registered. It also provides prima facie proof of your rights to the name, for your wares and services, which the other party then has to rebut. If someone else uses the same or a similar name for similar wares and services, then the owner of a trade-mark registration can sue for trade-mark infringement, depreciation of goodwill and passing off. However, in order to successfully demonstrate trade-mark infringement you need to show that the infringer was using the name as a trade-mark, to distinguish its goods or services from those of others. In the *Harry Potter* case, since the name was not actually being used by Warner Bros. as the name of a real band, then arguably it was not being used as a trade-mark so even if *The Wyrld Sisters* had registered their trade-mark they probably would not have had a strong case for trade-mark infringement. But in a normal case, where two parties are attempting to use similar names in the marketplace for similar wares and services, a trade-mark registration gives the owner a much greater ability to take on an infringer.

Trade-marks should also be protected in the countries in which the name is going to be used. So in this case, *The Wyrld Sisters* should consider registering their name as a trade-mark in the countries that are good markets for their music.

CONCLUSION

It will be interesting to see how *The Wyrld Sisters* lawsuit plays out, and my children are certainly hoping that the dispute does not delay the scheduled release date for the movie! But in the meantime it can provide a valuable lesson to others to take care before choosing and using names, logos or slogans and to protect them well once they are chosen, or you may wish you had a few magic spells to assist you with the resulting difficulties!

Written by Sharon Groom

For further information, please contact your McMillan Binch Mendelsohn LLP lawyer or one of the Practice Leaders of our Intellectual Property Group listed below:

Sharon E. Groom 416.865.7152 sharon.groom@mcmbm.com

Richard Uditsky 514.987.5015 richard.uditsky@mcmbm.com

The foregoing provides only an overview. Readers are cautioned against making any decisions based on this material alone. Rather, a qualified lawyer should be consulted.

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MCMILLAN BINCH MENDELSON

TORONTO | TEL: 416.865.7000 | FAX: 416.865.7048
MONTREAL | TEL: 514.987.5000 | FAX: 514.987.1213
www.mcmbm.com