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COPYRIGHT AND TRADE-MARK PROTECTION OF FICTIONAL PRODUCTS: WHY CAN'T I SELL YOU A NICE COLD MUG OF DUFF BEER?

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In the renowned world of *The Simpsons*, Moe's Tavern serves its loyal patrons cold mugs of Duff Beer. The local ale is wildly popular in the fictitious town of Springfield and has also achieved significant notoriety in the real world.

Given that *The Simpsons* universe is entirely owned by Twentieth Century Fox ("Fox"), certain intellectual property issues can arise when real-world brewing companies decide, without authorization from *The Simpsons*' right holders, to manufacture fictitious products like Duff Beer.

This is currently the case in Europe, most notably in Germany and Belgium, where Fox is embroiled in litigation involving intellectual property against Duff Beer UG, the German distributor of the "Legendary Duff Beer", which uses the Duff Beer logo as it appears in *The Simpsons* [Duff Beer v OHIM – Twentieth Century Fox Film (Duff), Case T-87/12;]. The battle has mostly been fought on the ground of trademark law. The common law right of passing off has also been used successfully by Fox in an Australian matter involving real-life Duff Beer. This scenario has also been the subject of discussion in the United States, under both trademark and copyright law. But what about Canada?

In Canada, Fox has successfully registered a trademark for "Duff Beer Design" for promotional items such as drinking glasses, T-shirts, shirts, underwear, sweatshirts, hats, and caps "[Duff Beer Design", Twentieth Century Fox Film Corporation, Can No TMA758507 (1 Feb 2010) live]. However, this trademark may not allow Fox to allege trademark infringement regarding a real-life Duff Beer, since the mark is simply registered for promotional items, and not for alcoholic beverages. As such, Fox may not be able to defend its right to Duff Beer [Twentieth Century Fox v South Australian Brewing Co Ltd, [1996] 66 FCR 451] with trademark law as it did in Australia. Fox may nevertheless have a claim in Canada, under copyright law [Benjamin M Arrow, "Real-Life Protection for Fictional Trademarks" IPLG (2011) online: http://iplj.net/blog/wp-content/uploads/2010/11/C04_Arrow_011111_Final.pdf].

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Under Canadian copyright law, the owner of the copyright has the exclusive right to produce or reproduce the “work” or a substantial part of that “work”, in this case the Duff Beer logo. A substantial part is not measured by the quantity of the work reproduced, but by the quality and the nature of what was reproduced [Edufile Inc v Automobile Protection Assn, [2000] 4 FC 195 at para 22].. This stands true in the new Copyright Act as it did in the Old Act [RSC, 1985, c C-42 [“Copyright”]]. Therefore, considering the importance of Duff Beer’s popular nature as the show’s sole alcoholic beverage and Homer Simpson’s everyday companion, Duff Beer as an artistic work is a substantial part of The Simpsons universe. Moreover, the exception at paragraph 64(2) (Non-infringement of certain designs) does not apply in this case since this situation is within the parameters of subparagraph 64(3)(a), which states that copyright subsists in a “graphic or photographic representation that is applied to the face of an article” such a beer bottle or can Copyright Act, s. 64(2); Import-Export René Derhy (Canada) inc c. Magasins Greenberg ltée, [2004] 37 CPR (4th) 305, JE 2004-749 at para 50]. As such, Fox would be better suited to bring a copyright claim, rather than a trademark claim if Duff Beer litigation were to ensue in Canada.

When a real-world brewing company introduces a Duff Beer product into the market without proper authorization, it is clear that such a brewery would be banking on the goodwill and the original work established by *The Simpsons* and Fox. In order to avoid copyright or trade-mark issues, it is recommended to treat fictitious marks as any other intellectual property asset, and people seeking to exploit them should do so under the guidelines of a licensing agreement. It is safe to state that the best way to enjoy a nice cold mug of Duff Beer is when it is served in Moe’s Tavern by Twentieth Century Fox.



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