Kluwer Trademark Blog

Somebody put Lionsgate in a Corner

Kai Schmidt-Hern (Lubberger Lehment) · Monday, March 20th, 2017

Lionsgate and *Dirty Dancing*

Lionsgate Entertainment Inc. owns the rights to the film *Dirty Dancing*, released in 1987. The film is iconic for its dance scenes and its message of love conquering everything. It has earned hundreds of millions from box office and DVD sales. Lionsgate and their licensees have released many other works, products and services derived from the film, including a TV series and a successful West End and Broadway show. Each milestone anniversary of its release has generated re-releases and special editions to meet the unbroken demand of the public (and creating wonderment at how time flies).

With an application filed in 2015, Lionsgate sought to register the word mark DIRTY DANCING for ”entertainment; cultural activities” and several subcategories in class 41 as a Union Mark. Somehow counter-intuitively, the Office refused the application and the Fourth Board of Appeal decided on 1 December 2016 that the Office had rightly done so:

Entertained by DIRTY DANCING

As to inherent registrability, the Office found that the English-speaking public perceives ”Dirty Dancing” to be the generic description of a sexually provocative style of dancing. The Office relied on lexical entries that refer to the film *Dirty Dancing* as the origin of that term and thus made Lionsgate the victim of their success. The Board of Appeals added that, even if there hadn’t been sufficient lexical evidence of that meaning, both ”dirty” – in the sexual sense – and ”dancing” were descriptive for entertainment and cultural activities and, when combined, did not add up to anything non-descriptive (see ECJ ”Biomild”).

Artistic Origin and Commercial Origin

The Board of Appeal confirmed the Office’s finding that DIRTY DANCING, despite the extensive use in relation to the film and the play, had not acquired distinctiveness. This was mainly for two reasons: First, DIRTY DANCING was not perceived as a sign of commercial origin of the film, but merely as a sign of its “artistic origin”. Second, the use as a title for the film was not a use for “entertainment services” in class 41. In that respect, the Board of Appeal added that the mark was not applied for “cinematographic films” (which would fall under class 9), without suggesting whether that would have helped. Further, Lionsgate had not shown use of the mark in relation to other films or plays than *Dirty Dancing*.

Note

The case deals with the problem of trademarks for media products or services. Unless a mark is a fanciful term like “Mordor”, any word can describe the possible content of a media product or service according to Art. 7(1)(c) EUTMR. A careful conclusion drawn from the Office’s decision may be that, with regard to “entertainment services”, the Office looks at whether the mark describes a means of entertainment in the narrow sense like “dancing”, “singing” or “performing” as opposed to things or actions without a connection to entertainment in a narrow sense like “Star Wars” or “Lion King” – registered trademarks expressly mentioned by the Office. With regard to acquired distinctiveness, the Office’s distinction between a use merely communicating the “artistic origin” as opposed to “commercial origin” is worth discussing. The counter-argument would be that the public naturally assumes a certain commercial origin behind a famous film title like *Dirty Dancing*. At least in this case, that argument will not be discussed, as the applicant apparently hasn’t taken the matter to Luxembourg.

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