

Legião Urbana: Trademark or Copyright

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The decease of Renato Russo, lead singer of the band Legião Urbana, initiated a long dispute involving the intellectual property rights of the group between his heir and the other members of the band: Marcelo Bonfá and Dado Villa-Lobos. As the sole shareholder of the company holder of the trademark "Legião Urbana" before the Brazilian PTO, Renato Russo's son intended to prevent the use of the band's name by the other members, who ended up filing a lawsuit before the State Court of Rio de Janeiro ("TJRJ") in 2013, aiming to obtain a judicial declaration that they could also use the trademark.[1] Bonfá and Dado ended up winning the litigation as the Judge in charge recognized that they could use the trademark "Legião Urbana" in their professional practice stating, however, that Renato Russo's heir has the right to curb any excesses.[2]

In this scenario, another lawsuit was filed in 2016 against Dado and Bonfá,[3] through which the company Legião Urbana Produções Artísticas Ltda, owner of the trademark before the Brazilian PTO, aimed to receive royalties arising from the use of said trademark on a show tour realized by Dado and Bonfá. According to the company, the TJRJ created a kind of compulsory license and the company should therefore receive one third of the values earned by the musicians as a result of the presentations made on the show tour.

As so, an interesting discussion was inaugurated concerning "Legião Urbana" trademark and the cumulativeness of rights that, in many cases, occurs in the scope of Intellectual Property. When contesting the company's requests, Dado and Bonfá claimed not to have used "Legião Urbana" as a trademark, but rather as the title of an artistic work, protected by Copyright. According to them, in addition to being a trademark registered before the Brazilian PTO, "Legião Urbana" is the title of the band's first album and the show tour in question had the purpose of celebrating the 30 years of its release.

In fact, the Brazilian Copyright Law ("LDA") provides that the protection of the artistic work also falls under its title (as per article 10), provided that it is original and unmistakable with other work of the same genre. Dado and Bonfá claim that the expression is linked to the patrimony of the band that was also built by them, furthermore, that they have created the title together with Renato Russo, and may also enjoy and dispose of it, in light of the article 28 of the LDA.

The arguments of the musicians did not convince the 9th Civil Chamber of the TJRJ, that ruled for the need of the musicians to pay to the company one third of income arising from the show tour due to the use of Legião Urbana's trademark. However, the Superior Court of Justice ("STJ"), when analyzing the appeal filed by Dado and Bonfá, annulled the decision rendered by the TJRJ since the argument raised by the appellants in relation to the protection of "Legião Urbana" as Copyright was not analyzed. The STJ understood that the outcome of the TJRJ decision could have been different if the court considered the Copyright argument in its analysis.

NOTES:

¹ Declaratory Action No. 0239202-41.2013.8.19.0001, distributed before the 7th Business Court of the TJRJ.

² It is important to note that Legião Urbana Produções Artísticas Ltda filed a termination action aiming to extinguish the final ruling of the Declaratory Action (lawsuit No. 0012488-26.2016.8.19.0000) that was dismissed by the 5th Civil Chamber of the TJRJ. When of the preparation of this report, the judgment of the motion for clarification filed against the decision of the Superior Court of Justice that, by majority of votes, dismissed the Special Appeal filed by the company with the purpose of reversing the decision of the TJRJ was pending.

³ Lawsuit No. 0200044-71.2016.8.19.0001, distributed before the 4th Business Court of the TJRJ.

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