

Dear Fashion Santa, Let Me Explain...

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by Jake Holt



We only want one thing for Christmas this year: clear and unambiguous terms for ownership of intellectual property. We know you'll understand after the year you've been having.

Related Capabilities

- Trademark, Copyright + Advertising
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#FashionSanta was the social media sensation of the 2015 holiday season. Children and adults alike (including Canada's own Justin Bieber) lined up for selfies with the sexy and stylish Fashion Santa at Yorkdale Mall in Toronto. The exciting, new spin on Father Christmas was created by long-time fashion model Paul Mason after he discovered his ability to grow a glorious, long, white beard. This Canadian Père Noël won't be caught in an over-sized jacket of tacky faux fur – Fashion Santa is a man of exquisite taste, with a predilection for designer labels. He prefers a burgundy leather biker jacket or a bespoke crimson suit. And everything seemed holly jolly until Mason and the mall fell out over ownership of the intellectual property – now the mall has a new model to play Fashion Santa for Christmas 2016.



Fashion Santa bedecked in Dolce & Gabanna, Salvatore Ferragamo, and John Varvatos.

Precisely what kind of intellectual property exists in Fashion Santa is an open question. Mason filed a copyright application in Canada for a literary work entitled “Fashion Santa,” claiming a publication date of September 23, 2014. It is uncertain what the now registered copyright protects. While copyright cannot protect short words and phrases like the name Fashion Santa, it is well recognized that copyright can exist in literary characters. To qualify for protection, a character must be original and well-developed, rather than a simple stock character type. Judge Learned Hand provides an analogy to Shakespeare: “If Twelfth Night were copyrighted, it is quite possible that a second comer might so closely imitate Sir Toby Belch or Malvolio as to infringe, but it would not be enough that for one of his characters he cast a riotous knight who kept wassail to the discomfort of the household, or a vain and foppish steward who became amorous of his mistress.” *Nichols v. Universal Pictures Corp.*, 45 F.2d 119, 121 (2d Cir. 1930). Where on this spectrum does Fashion Santa fall? It isn’t all that clear.

The mall took a different route, filing a Canadian trademark application for the words FASHION SANTA on December 8, 2015. Mason filed for the same two weeks later. The application filed by the mall primarily covers advertising and promotional services. But is a word mark really the thing to protect here and, if so, how strong is the FASHION SANTA mark? Surely SANTA is a generic term for old Saint Nick and FASHION is highly descriptive. While the Canadian examination documents are not publicly available, the USPTO database shows the Examiners requested disclaimer of the term FASHION in both the parallel US applications; as well as SANTA in Mason’s application. Perhaps instead of a word mark, the trademark is in the character itself (something like an exceedingly dapper breakfast cereal mascot). If trademark protection is otherwise limited to the name, a competitor would be free to introduce Kris Kringle Couture.

It is not exactly surprising that Mason saw his creation as a work of art, while the mall saw it as a brand – but all this humbug could have been avoided if the parties had negotiated an appropriate agreement before Fashion Santa started posing for selfies with the Biebs. That’s why we’re asking for better contract terms around IP ownership. We promise we’ve been very good this year and hardly sued anyone.