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Leslie Alan Glick

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PROTECTION OF LITERARY AND ARTISTIC TITLES: A COMPARATIVE ANALYSIS OF UNITED STATES AND FOREIGN LAW

It is the purpose of this note to review the protection available for titles in selected foreign jurisdictions. A discussion of United States law and practice is also included, but it is not intended to give an exhaustive account of title protection in the United States. This topic has received adequate comment¹ and is not in itself a particularly fruitful topic for additional investigation. This is not to say that U.S. practice is exemplary and could not be the subject of considerable change. On the contrary, it is assumed that a thorough review of foreign practice will point out how inadequate the protection of titles is in this country.

The protection of titles covers three areas of law—copyright, trademark, and unfair competition. Each area will be covered so far as it is applicable to a particular country. In countries where the law is complex, a separate section will be devoted to each area.

The choice of countries, while not arbitrary, does not follow a particular geographical plan. Countries were selected in which, in the writer's opinion, an author might most reasonably anticipate that his title might be expropriated, and, therefore, in which he would most likely desire protection. A number of Latin American and Far Eastern countries were omitted due to limitations of space.

Titles, as referred to in this note, include both literary and artistic titles as applied to books, periodicals, newspapers, poems, songs, paintings, and other creative works. Where the law of a state provides differential protection for one form of title, this will be appropriately noted. Otherwise the discussion of "titles" covers all types of titles used in the various media.

¹ See H. BALL, *LAW OF COPYRIGHT AND LITERARY PROPERTY* §§ 55, 229, 232 (1944); H. HOWELL, *COPYRIGHT LAW* 41-43 (rev. ed. 1962); M. NIMMER, *NIMMER ON COPYRIGHT* § 8.4 (1963); S. ROTHENBERG, *COPYRIGHT LAW* 81 (1956); John, *Literary Titles—Copyrightable or Trademarkable*, 57 *TRADEMARK REP.* 151 (1967); Klein, *Is Unauthorized Use of Titles of Artistic Works in Unrelated Fields Actionable Piracy?*, 28 *BROOKLYN L. REV.* 59 (1961); Netterville & Hirsch, *Piracy and Privilege in Literary Titles*, 32 *SO. CAL. L. REV.* 101 (1959); Tannenbaum, *Copyright Law: Titles in the Entertainment Field*, 45 *A.B.A.J.* 459 (1959).

I

NORTH AMERICA

A. *United States*1. *Copyright*

It is abundantly clear that titles will not be accepted for registration by the United States Copyright Office.² However, the underlying reasons for this policy are far from clear and do not necessarily justify the exclusion. A brief look at the various factors influencing U.S. copyright practice provides some insight into the reasons for the current policy.

a. *Protection of Titles as a Separate Entity.* There are four sources of authority as to what is and what is not capable of copyright protection in the United States. These are the copyright clause of the Constitution,³ the Copyright Acts,⁴ the regulations and circulars of the Copyright Office,⁵ and the federal courts. Neither the copyright clause of the Constitution nor the Copyright Acts prohibit the registration of titles. However, the crucial question is not whether a given form of work is denied protection but rather whether it is capable of inclusion. This leads to a determination of whether a given form of intellectual property is a "writing" within the meaning of the copyright clause and the Copyright Acts.⁶

The first important judicial definition of "writing" appeared in the *Trademark Cases*,⁷ where the Supreme Court narrowly construed "writing" as consisting only of original works that resulted from considerable intellectual labor. Although titles were not referred to in the opinion, the Supreme Court's decision that words serving merely to label and designate, such as trademarks, do not meet the test of intellectual labor has obvious applicability to titles. Unfortunately, the Court did not see fit to provide exceptions for such words that,

² See, e.g., 37 C.F.R. § 202.1 (1967): "The following are examples of works not subject to copyright and applications for registration of such works cannot be entertained: (a) . . . titles."

³ Congress has the power "To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries." U.S. CONST. art. I, § 8, cl. 8.

⁴ See generally 17 U.S.C. §§ 1-216 (1964), as amended (Supp. IV, 1969).

⁵ 37 C.F.R. §§ 201-202.18 (1967). These rules are promulgated under the authority granted in 17 U.S.C. § 207 (1964).

⁶ See 37 C.F.R. § 202.1 (1967) (stating what material is not subject to copyright).

⁷ *United States v. Steffans*, 100 U.S. 82 (1879).

although principally labels or designations, are the result of considerable creativity and ingenuity.⁸ If such an exception had been made in relation to trademarks, it is likely that there would be little difficulty in obtaining registrations for titles.

The *Trademark Cases* have been more or less conclusive as to whether a title is a writing,⁹ but the rule has been criticized by some authorities.¹⁰

b. *Protection of Titles as Part of Copyrighted Works.* Aside from the question of whether a title in itself is capable of copyright protection is the related problem of whether a title might be protected under the copyright of the entire work. Although some early decisions indicated that such protection was possible,¹¹ the weight of authority and the current view is to the contrary.¹²

c. *Protection of Titles on a "Droit Moral" Theory.* Although the United States statute does not officially recognize the continental concept of *droit moral*, courts in this country have protected titles from alteration on this theory. For example, an author has a right to have his work known by the title which he gave it and such a title may not be changed without his consent.¹³ This might not apply when a work is in the public domain.

2. Trademark

Titles to individual works have generally been denied trademark protection on the theory that they are simply descriptive and therefore do not distinguish the goods to which they apply, as required by the

⁸ Consider, for example, the recent title "The Persecution and Assassination of Jean Paul Marat as Performed by the Inmates of the Asylum at Chartendon under the Direction of the Marquis de Sade."

⁹ The *Trademark Cases* were not solely responsible for the subsequent exclusion of titles from copyright protection. Some 29 years before, in 1850, a lower federal court in *Jollie v. Jaques*, 13 F. Cas. 910 (No. 7,437) (C.C.S.D.N.Y. 1850), held that a title for a piece of music was not capable of separate copyright protection. This has been continuously followed. See, e.g., *Arnstein v. Porter*, 154 F.2d 464, 474 (2d Cir. 1946).

¹⁰ See NIMMER, *supra* note 1, at § 8.4, stating that "titles by the very nature of their use may be regarded as requiring a qualitatively higher sort of intellectual labor than that called for by a trademark."

¹¹ Cf. *Harper v. Ranous*, 67 F. 904, 905 (C.C.S.D.N.Y. 1895) (title of novel is not protected where text of novel is not used).

¹² *Warner Bros. Pictures v. Majestic Picture Corp.*, 70 F.2d 310 (2d Cir. 1934); *Lone Ranger, Inc. v. Cox*, 39 F. Supp. 487, 489 (W.D.S.C. 1943) (copyright statute protects the property in the literary composition, not the title given to it). See also *Corbett v. Purdy*, 80 F. 901 (C.C.S.D.N.Y. 1897).

¹³ See *Packard v. Fox Film Corp.*, 207 App. Div. 311, 202 N.Y.S. 164 (1st Dep't 1923).

Lanham Act.¹⁴ The principal case on this issue is *In re Cooper*,¹⁵ which held that a title cannot be anything more than descriptive regardless of its originality. The courts have also indicated that a descriptive word is not entitled to registration *even* where secondary meaning is shown.¹⁶ However, titles of newspapers and periodicals have often been registered as trademarks (*e.g.*, "The Wall Street Journal") despite their descriptive character.

3. *Unfair Competition*

Unfair competition has traditionally been the only effective theory upon which titles have been protected in the United States. While some early decisions insisted that there be provable competition between two works before such protection could be invoked,¹⁷ most courts today will enjoin use of a title where secondary meaning has been established, regardless of whether the works compete.¹⁸ Moreover, even without proof of secondary meaning relief will be granted where there is a likelihood of confusion as to the origin of the two works.¹⁹

The recent decisions in the *Sears*²⁰ and *Compco*²¹ cases create a great deal of uncertainty as to what is protectable under state unfair competition laws. The *Sears-Compco* cases take as their premise that the absence of federal protection is evidence of a congressional policy not to provide protection; for a state to provide relief contravenes an expressed federal policy and is therefore unconstitutional. However, the cases are limited to the issue of whether unpatentable, non-

¹⁴ 15 U.S.C. § 1052(e) (1964). See *In re National Council Books, Inc.*, 121 U.S.P.Q. 198 (POTM App. Bd. 1959); *In re Commonwealth Eng'r Co.*, 120 U.S.P.Q. 415 (POTM App. Bd. 1959).

¹⁵ 254 F.2d 611 (C.C.P.A. 1958); *cf.* *Anderson v. National Broadcasting Co.*, 178 F. Supp. 762 (S.D.N.Y. 1959).

¹⁶ See *Weiss Noodle Co. v. Golden Cracknel & Specialty Co.*, 290 F.2d 845, 847-48 (C.C.P.A. 1961).

¹⁷ *Atlas Mfg. Co. v. Street & Smith*, 204 F. 398 (8th Cir.), *appeal dismissed*, 231 U.S. 348 (1913) ("Nick Carter" for books versus "Nick Carter, the Great American Detective Solving the \$100,000 Jewel Mystery" as a movie title).

¹⁸ *Colvig v. KSFO*, 224 Cal. App. 2d 357, 36 Cal. Rptr. 701 (1st Dist. 1964); *Metro-Goldwyn-Mayer, Inc. v. Lee*, 212 Cal. App. 2d 23, 27 Cal. Rptr. 833 (2d Dist. 1963) ("The Wonderful World of the Brothers Grimm" protected against "A Wonderful World of the Grimm Brothers"); *Jubilee Indus., Inc. v. Roulette Records, Inc.*, 153 U.S.P.Q. 431 (N.Y. Sup. Ct. 1967) (protection granted to record title, "Keep the Faith, Baby"); *Cinepix, Inc. v. Triple F. Prod.*, 150 U.S.P.Q. 134 (N.Y. Sup. Ct. 1966); *Hemingway v. Film Alliance of the United States*, 174 Misc. 725, 21 N.Y.S.2d 827 (N.Y. Sup. Ct. 1940) ("Fifth Column" as a play title held to have secondary meaning).

¹⁹ *Avon Periodicals, Inc. v. Ziff-Davis Publishing Co.*, 282 App. Div. 200, 122 N.Y.S.2d 92 (1st Dep't 1953).

²⁰ *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225 (1964).

²¹ *Compco Corp. v. Day-Brite Lighting, Inc.*, 376 U.S. 234 (1964).

functional features should be afforded unfair competition protection. The question, then, is whether to extend the underlying premise, in which case titles would clearly be unprotectable, or to limit it to the facts of the two cases.

The Supreme Court has not indicated that it intends to expand the *Sears-Compco* doctrine and it is not at all certain that the Court would follow the cases in an adjudication involving titles. Some courts, both state and federal, have indicated that this rule need not be applied to cases involving intentional "passing off."²² Furthermore, the misappropriation of a title is quite similar to mislabeling, and a 1964 decision of a federal court of appeals holds that *Sears-Compco* does not abolish the cause of action for palming off and mislabeling.²³

4. Contractual Agreements

The United States is one of the few countries where a systematic contractual system for the protection of titles has developed. This is undoubtedly due to the uncertain protection afforded to titles by statutory law. This system, which covers only motion picture titles, is operated by the Motion Picture Association of America. Participating producers deposit titles at a central registry and agree not to use a title deposited by another member without his consent.

B. Canada

1. Copyright

A title that is original and distinctive may be protected as part of a copyrighted work.²⁴ This does not mean that a title can generally receive separate protection.²⁵ However, there are cases where a title alone has been protected when it was of sufficient length to be considered a literary composition.²⁶ Canadian law thus differs from that of the United States in two important respects. First, a distinction is drawn between original and distinctive titles and those that are com-

²² See *Spangler Candy Co. v. Crystal Pure Candy Co.*, 353 F.2d 641 (7th Cir. 1965); *American Broadcasting Co. v. Button World Mfg., Inc.*, 151 U.S.P.Q. 361 (N.Y. Snp. Ct. 1966).

²³ *Cable Vision, Inc. v. KUTV, Inc.*, 335 F.2d 348, 351 (9th Cir. 1964).

²⁴ Copyright Act § 2(v), CAN. REV. STAT. c. 55 (1952).

²⁵ *Francis Day & Hunter, Ltd. v. Twentieth Century Fox Corp.* [1939] 4 All E.R. 192, 198 (movie entitled, "The Man Who Broke The Bank at Monte Carlo" held not to be an infringement of a song with similar name). Lord Wright interpreted § 2(v) of the Copyright Act as not meaning that "the title of a work is to be deemed to be a separate and independent 'work.' . . . [T]o copy the title constitutes infringement only when what is copied is a substantial part of the work." *Id.* at 199.

²⁶ *McIndoo v. Musson Book Co.*, 26 D.L.R. 550 (1916).

mon and uncreative, much like our own practice in trademark cases. Second, a lengthy title²⁷ may be considered a literary work comparable to the United States concept of a "writing." Despite the above provisions, unfair competition, rather than copyright infringement, appears to be the principal remedy for the protection of titles in Canada.

2. *Trademark*

Titles of artistic and literary works may be registered as trademarks, and printed publications are considered "wares" capable of trademark protection.²⁸ Titles of magazines and periodicals have also been protected as trademarks under the Unfair Competition Act²⁹ and are also protected at common law.³⁰

3. *Unfair Competition*

Canadian unfair competition practice generally follows the British common law.³¹ It is therefore unnecessary to discuss recent case law in this section in any great detail. It is clear that a "passing off" action may be brought when use of another's title results in deception of the public.³² However, such protection does not apply to a title that is descriptive unless secondary meaning is established.³³

II

WESTERN EUROPE

A. *Austria*

Titles of literary and artistic works are specifically protected in the Copyright Act.³⁴ This protection applies regardless of whether a work itself is copyrighted.³⁵ Although the provisions of the Act do not refer to song titles, in practice they are also protected.³⁶

²⁷ See note 8 *supra*.

²⁸ Trade Marks Act, § 2(w), in 52 PATENT & TRADEMARK REV. 315 (1953).

²⁹ See *Fawcett Publications, Inc. v. Pastime Publications, Ltd.*, [1950] 10 Fox Pat. C. 226.

³⁰ *Rose v. McLean Publishing Co.*, 27 Ont. 325, 24 Ont. App. Rep. 240 (1897).

³¹ See the section on Great Britain at pp. 461-62 *infra*.

³² *Gage v. Canada Publishing Co.*, 6 Ont. 68, 11 Ont. App. Rep. 402 (1883).

³³ *International Press, Ltd. v. Tunnell* [1938] 1 D.L.R. 383.

³⁴ Federal Act on Copyright in Works of Literature and Art and on Related Rights, § 80(1), at Austria: Item 1—page 18, in UNESCO, COPYRIGHT LAWS & TREATIES OF THE WORLD (1968) [hereinafter cited as UNESCO].

³⁵ *Id.* § 80(2).

³⁶ Correspondence with Walter Hamburger, Vienna, Austria, March 10, 1969 [all correspondence cited is on file at the *Cornell Law Review*].

There is some question as to whether this protection is available to foreign authors. Section 100(1) of the Act extends protection to foreigners only insofar as reciprocal protection is granted to Austrian nationals.³⁷ This would, of course, exclude American authors. However, section 100(3) of the Act states that foreigners shall be entitled to protect their titles even where the requirements of section 100(1) are not fulfilled.³⁸ Since section 100(3) negates section 100(1) and presumably reflects a more recent legislative intent, it can be assumed that section 100(1) does not bar such protection.

Titles also may receive trademark protection where they are suited to distinguish products and goods.³⁹ For example, "My Fair Lady" was registered by Columbia Broadcasting Company despite a pre-existing registration for "Fair Lady."⁴⁰

Article nine of the Unfair Competition Law also applies to titles and could be invoked where there is a demonstrable likelihood of confusion. Injunctive relief is provided.⁴¹

B. *Belgium*

Although there is no provision in the copyright statute,⁴² copyright protection may be afforded to titles of literary works of sufficient originality.⁴³ Protection is based on the theory that titles are an integral part of the work, and no special formalities are needed. Song titles as well as literary titles are considered protectable property.⁴⁴

As a rule, when infringement of the whole work, including the title, takes place, an action under the copyright law is most appropriate; when the title alone is imitated, protection generally is dependent on the principles of unfair competition.⁴⁵

Unfair competition actions are usually limited to cases involving a possibility of confusion between two works. Where the works involved

³⁷ Federal Act, *supra* note 34, at § 100(1).

³⁸ *Id.* § 100(3), at 23.

³⁹ Trade Marks Law of 1928, in 27 PATENT & TRADEMARK REV. 279 (1929).

⁴⁰ Registration No. 61,353, goods in classes 9b, 22, 34, & 35.

⁴¹ See II H. PINNER, WORLD UNFAIR COMPETITION LAW 882 (1965).

⁴² Law on Copyright, in UNESCO, at Belgium: Item I.

⁴³ See Trib. Civil, Brussels, decision of May 28, 1921, *Journal de Tribunaux* at 405.

One of the best-known cases on the question of originality involved the title "Ap-passionata" as used for a dramatic work. It was held that this title, previously used by Beethoven to identify a sonata, did not meet the necessary standards of creativity and originality.

⁴⁴ See Correspondence with Cabinet Bede, Brussels, Belgium, March 18, 1969. "A song is an integral work. [I]t is not legal to . . . imitate a title." (author's translation).

⁴⁵ S.A. Desclée De Brouwer v. S.A. Usines Brépols, (Ghent App. Court, June 26, 1959), 49 REVUE DE DROIT INTELLECTUEL 270 (1959).

are in different media, it is often held that no such confusion is present.⁴⁶

Since titles are protected, a manufacturer could not use a title for trademark without the copyright owner's consent.⁴⁷ The copyright owner himself may receive trademark protection, although it is not clear whether this has ever been done.

C. *Scandinavia*

There is a great deal of similarity between the copyright and trademark laws of the Scandinavian countries. This is due to inter-governmental cooperation and collaboration in drafting these laws. The differences are not sufficiently great to warrant lengthy treatment of each country. Therefore, in this section Danish law will be discussed in detail, and the other Scandinavian countries will be briefly discussed, emphasizing the differences, if any, from Danish law.

1. *Denmark*

The Danish copyright statute⁴⁸ provides that a literary or artistic work may not be made available to the public under a title that is capable of causing confusion with an earlier work.⁴⁹ However, this protection does not apply when the two works are disseminated⁵⁰ within three months of one another, unless it can be shown that the latter work intentionally expropriated the title of the former. Additional protection is provided in section nine of the Unfair Competition Act; however, the remedies are not as desirable as those afforded in the copyright statute.⁵¹

The Trade Marks Act⁵² prohibits the registration of "matter which is likely to be construed as the distinctive title of the protected literary or artistic work" by a party other than the copyright owner.

⁴⁶ See REVUE DE DROIT PENAL 620 (1929) ("Fifitse" for book held not to infringe on "Phi-Phi" as title of operetta).

⁴⁷ Correspondence with Cabinet Bede, Brussels, Belgium, March 18, 1969.

⁴⁸ Law No. 158 of 1961 on Copyright in Literary and Artistic Works, in UNESCO, at Denmark: Item 1.

⁴⁹ *Id.* § 51, at page 7.

⁵⁰ The Danish statute draws a distinction between "disseminated" and "published." *Id.* at § 8, at page 2. "A work is considered disseminated when it is lawfully made available to the public. It is considered published when copies of the work have been lawfully placed on sale or otherwise distributed to the public."

⁵¹ *Id.* § 56, at page 8. This section provides for damages even in cases of an infringement in good faith and permits recovery for mental suffering and other injuries in certain cases.

⁵² Danish Trade Marks Act of June 11, 1959, § 14(5), in 60 PATENT & TRADEMARK REV. 23, 26 (1961).

Any registration must, of course, comply with the general requirements of the Act as to distinctiveness.⁵³

2. Finland

The provisions of Finnish law, as to both copyright and trademark protection, are practically identical to those of Norway.⁵⁴

3. Norway

The key difference between the Norwegian copyright law⁵⁵ and the Danish law is that the former does not provide an exception for works disseminated within three months of one another. The Norwegian Trade Marks Act⁵⁶ is practically identical to the Danish Act. The law is strictly interpreted and the Patent Office will prevent anyone from registering a title as a trademark, even if the title is unoriginal and was in use before the copyright owner protected it (*e.g.*, "sunshine").⁵⁷ One recent case involved the attempted registration of the word "Limelight" as a trademark for records.⁵⁸ The Patent Office held that this infringed the title of the well-known Chaplin film by the same name and refused to register it.

4. Sweden

The copyright law is practically identical to the Norwegian law but differs from the Danish law in respect to the exception for works published within three months of each other.⁵⁹ The Trade Marks Act⁶⁰ follows the other Scandinavian Acts. A recent case worthy of note involved the title of a well-known poem, "Svarte Rudolf" (Swarthy Rudolf), which later became a popular song. A party having no copyright interest in either the song or the poem was forbidden from registering the title as a trademark. Another case currently being contested before the Registrar involves an attempt to register the Swedish equivalent of "Batman" over the opposition of the American copyright

⁵³ *Id.* § 13; Correspondence with Charles Hude, Copenhagen, Denmark, March 17, 1969.

⁵⁴ Finnish Copyright Act, art. 51, in UNESCO, at Finland: Item 1—page 7; Trade Marks Act, in 63 PATENT & TRADEMARK REV. 23 (1965).

⁵⁵ Act Relating to Property Rights in Literary, Scientific and Artistic Works, May 12, 1961, art. 46, in UNESCO, at Norway: Item 1—Page 8.

⁵⁶ Trade Marks Act of March 3, 1961, in 61 PATENT & TRADEMARK REV. 247 (1963).

⁵⁷ Correspondence with Fridtjot Knudsen, Bergen, Norway, March 11, 1969.

⁵⁸ Mercury Records, Application No. 85,770. See Correspondence, *supra* note 57.

⁵⁹ Law No. 729 of 1960 on Copyright in Literary and Artistic Works, § 50, in UNESCO, at Sweden: Item 1—page 7.

⁶⁰ Swedish Trade Marks Act of 1960, in 59 PATENT & TRADEMARK REV. 164 (1961).

owner.⁶¹ Protection is also provided in the Unfair Competition Law, but it is not substantially greater than the protection in the copyright law.⁶²

D. France

1. Copyright

Titles are specifically covered in section five of the 1957 copyright law.⁶³ The law provides that an original title may be protected in the same way as an entire work. The protection of a title may even outlive the copyrighted work that it identifies, when its use by another author would create a likelihood of confusion.

Before the new law, no specific protection for titles was provided. Nevertheless, the courts developed some remedies for misappropriation. For example, in 1938 the Cour de Cassation provided for an infringement remedy in the case of original titles, and an unfair competition remedy to be applied where a possibility of confusion existed, regardless of originality.⁶⁴ However, with a few exceptions,⁶⁵ French courts have been unwilling to find titles sufficiently original to be protected on an infringement theory.⁶⁶

Under the new law protection is provided on the basis of possible confusion as well as on the basis of originality.⁶⁷ The courts have thus been able to provide protection to many titles despite the strict test of originality that prevails.⁶⁸

2. Trademark

Titles are capable of registration as trademarks and have actually been registered for various classes of goods.⁶⁹ However, the title must

⁶¹ Correspondence with Lars Holmqvist, Malmo, Sweden, March 12, 1969.

⁶² Unfair Competition Act of 1931, art. 9(2), as amended through May 22, 1942. See Correspondence, *supra* note 61. See also PINNER, *supra* note 41, at 893.

⁶³ Law No. 57-296, art. 5 (March 11, 1957), in UNESCO, at France: Item 1—page 1.

⁶⁴ See I Droit Penal 97 (1938).

⁶⁵ In *Liasons Dangereuses* [1960] J.C.P. II, No. 11569 (Cour d'appel, Paris), the Paris Court of Appeals upheld the title as sufficiently original to preclude its use on a film that did not accurately portray the original novel.

⁶⁶ *Smythe v. Société des Artistes Associes*, [1938] (Cour d'appel, Paris) ("Le Printemps Change" held not sufficiently original); *Barbusse v. Leguilleux*, [1928] (Tribunal Civil de la Seine), in 42 LE DROIT D'AUTEUR 93 (1929) (warrant injunction against film entitled "Le Feu 1914-1928").

⁶⁷ Law No. 57-296, art. 5, *supra* note 63, provides "[e]ven if the work is no longer protected under the terms of articles 21 and 22, no one may utilize a title in order to distinguish a work of the same kind under conditions capable of creating confusion."

⁶⁸ See, e.g., *Massenet v. Société Alcina*, [1952] (Cour d'appel, Paris) ("Mannon"); *Editions Payot v. Librairie Gilbert Jeune*, [1952] (Tribunal Civil de la Seine) ("Les Hauts de Hurlevent," i.e., "Howling Wind Heights," as a translation of "Wuthering Heights").

⁶⁹ Correspondence with Langner, Parry, Card & Langner, Paris, France, March 12, 1969.

be distinctive in respect to the goods claimed or it will probably be rejected by the Trademark Office. If the title is capable of copyright protection under section five of the copyright law, no one except the copyright owner can use it as a trademark. If a title is not capable of copyright protection, possibly anyone could register it as a trademark.

3. *Unfair Competition*

Since the protection provided in section five, paragraph two, of the new copyright law encompasses the principles of unfair competition, it has superseded any remedy that previously existed for unfair competition.

4. *The Protection of Titles and the Droit Moral*

Unauthorized use of a title can easily injure the reputation of an author and subject him to possible ridicule and humiliation. In such a case the author has a right of action on the theory of *droit-moral*⁷⁰ in addition to any other theory on which he may proceed. Such an action can arise in at least two ways: first, when the title of a work is used to identify an inferior or scandalous work; and second, when a title is used as a trademark identifying some unattractive product.

In the first case, to establish a claim on the basis of *droit moral*, the author must prove the requisite injury to his reputation by showing the superiority of his own work and the inferiority of the infringing work. Except in cases where the first work is famous and clearly a literary or artistic masterpiece,⁷¹ the burden of proof in such a case is difficult to sustain, and the court is placed in the undesired role of literary critic. In the second instance, plaintiff must prove that the use of his well-known title, in connection with the particular goods involved, is demeaning and injurious to his reputation. Again this may be difficult to prove except in the most extreme cases. A notable advantage of bringing an action on the basis of the *droit moral* is that it is applicable even to a work not copyrighted or to one in the public domain.

5. *Contractual Protection*

In respect to titles of motion pictures, France has developed a system of protection by contractual agreement similar to the one used in the United States. Under this system a title is deposited at a cen-

⁷⁰ Law No. 57-296, *supra* note 63.

⁷¹ See, e.g., the *Liaisons Dangereuses* case where the court based its decision partially on the *droit moral*.

tral registry, and member producers agree not to use any title previously deposited, without the consent of the proprietor.⁷²

E. *West Germany*

1. *Copyright*

A limited form of protection is provided in both the German copyright laws: in article nine of the statute covering literary and musical works⁷³ and article twelve of the statute relating to art, photography, and motion pictures.⁷⁴ Both articles are limited to protecting a title from alteration by a transferee. As such they are concerned more with the *droit moral* than with piracy, but some German lower courts have held that a title may be protected as part of the work itself.⁷⁵

2. *Unfair Competition*

In general titles are protected from expropriation and piracy by the Unfair Competition Law⁷⁶ rather than by the copyright laws. Most titles can be protected through unfair competition when there is a possibility of confusion between two works.⁷⁷ However, this does not cover generic terms⁷⁸ unless they have acquired secondary meaning (*e.g.*, "Funk-Illustrierte"—Radio Illustrated).⁷⁹

It is traditional in Germany to publish a preliminary announcement of intended use of a title. Such an announcement does not result in any official protection, and it is not considered evidence of use. Nevertheless it is desirable, inasmuch as a party who publishes an announcement can establish his priority over any later user of the same title, provided that the title is actually used on a work within a reasonable period of time. Thus an author who is first beginning a work may publicly announce his title in order to acquire priority, for unfair competition purposes, over another author who might later decide to use the same title.

⁷² See Tannenbaum, *supra* note 1, at 527.

⁷³ An Act dealing with Copyright and Related Rights, art. 39 (1965), in UNESCO, at German Federal Republic: Item 1—page 6, provides: "In the absence of any contrary agreement, a licensee may not alter the work, its title or the designation of the author."

⁷⁴ An Act concerning Copyright in Works of Art and Photography § 12, *as amended* through May 12, 1940 *Id.* at Item 2—page 2.

⁷⁵ See decisions of the Kammergericht, 1926 INT'L GRUR 441. See also Copyright Law of 1901, § 9; S. P. LADAS, THE INTERNATIONAL PROTECTION OF LITERARY AND ARTISTIC PROPERTY § 112, at 244 (1938).

⁷⁶ Unfair Competition Law of 1909, art. 16.

⁷⁷ See Weichert v. Weise, 104 R.G.Z. 88 (1922).

⁷⁸ See 1954 INT'L GRUR 56.

⁷⁹ 21 BGH 85 (1956).

3. *Trademark*

Although there is nothing in German law preventing registration of a title,⁸⁰ the Patent Office has been reluctant to accept such registrations on the theory that a title merely describes the contents of the work. In certain instances titles of periodicals and newspapers have been registered on the basis of extensive use that has led to acquired distinctiveness.

F. *Great Britain*

1. *Copyright*

Both the Copyright Law of 1956 and that of 1911 are silent concerning the treatment of titles. However, the issue has been repeatedly litigated at common law, and most cases hold that a title may not be protected on a copyright theory.⁸¹ The proposition that titles are not subject to copyright is often said to originate with the case of *Dicks v. Yates*.⁸² In fact the case did not really establish any such rule but merely held that a particular title was not sufficiently original to be protected.⁸³ In any event it is clear that titles are not generally copyrightable today.⁸⁴

2. *Unfair Competition*

When a title is used with the intent to deceive the public or to create confusion with an earlier work, it is clear that such use can be enjoined on the basis of unfair competition.⁸⁵ However, it may be necessary to prove that one's title is well-known and well-established in the public's mind before recovery can be had for "passing off."⁸⁶

3. *Trademark*

Most titles are not registrable as trademarks and are protected only on unfair competition principles. However, titles of periodicals have been accepted for registration when the applicant can prove continuous use, generally for a period of at least one year. The Reg-

⁸⁰ See German Patent Law, Utility Model Law, and Trademark Law (1961), in 63 PATENT & TRADEMARK REV. 119 (1965).

⁸¹ See, e.g., *Francis Day & Hunter, Ltd. v. Twentieth Century Fox Corp.*, [1940] A.C. 112 (Can. 1939); *Licensed Victuallers' Newspaper Co. v. Bingham*, 38 Ch. D. 139 (1888).

⁸² 18 Ch. D. 76 (1881).

⁸³ See Master of Rolls's opinion: "I do not say that there could not be copyright in a title, as, for instance, in a whole page of title or something of that kind requiring invention." *Id.* at 89.

⁸⁴ W. COPINGER & F. SKONE JAMES, COPYRIGHT § 232 (10th ed. 1965).

⁸⁵ *Id.* See also *Ridgeway Co. v. Hutchison*, 40 Pat. Cas. 335 (Ch. D. 1923).

⁸⁶ See *Mathieson v. Sir Isaac Pitman & Sons, Ltd.*, 47 Pat. Cas. 541 (Ch. D. 1930).

istrar is not favorably disposed towards such registrations and often objects on a number of grounds. Recent applications for "Barron's," "The Wall Street Journal," and "The National Observer" met with multiple objections from the Registrar.⁸⁷

G. Italy

The Italian copyright law is quite specific concerning the nature and scope of protection for titles. The basic provision is that a title of a work, if it uniquely identifies the work, cannot be used in connection with any other work without the consent of the author.⁸⁸ Inasmuch as the provision stresses uniqueness of identification rather than originality, it appears to be based on a trademark rationale. Another paragraph of the same section provides additional protection in terms of unfair competition. This paragraph limits protection to cases where the works are sufficiently similar to cause possible confusion.⁸⁹ Protection is also provided for "headings" that appear in periodicals where they provide unique identification. This would cover titles of columns, features, and articles.⁹⁰ Finally, the law prohibits the use of newspaper and magazine titles on other works of the same kind or character until two years after publication has ceased.⁹¹ This prevents monopolization of a title that is no longer being used.

Titles stand a good chance of registration as trademarks since the Italian Registrar does not generally raise objections on the grounds of descriptiveness; this is the objection to title registrations most frequently raised. Consequently, such titles as "The Wall Street Journal" have been registered.⁹²

⁸⁷ Applications are currently pending for the titles "Barron's" (No. 930,441), "The National Observer" (No. 932,668), and "The Wall Street Journal" (No. 930,444) in the name of Dow Jones and Co. covering class 16. These marks were objected to by the Registrar on the following grounds: "Barron's" because it was not distinctive under § 9, incapable of distinguishing the goods under § 10, and that it was a possessive form of a surname; "The National Observer" on the grounds that it was descriptive and possibly confusing with the London paper "The Observer"; and "The Wall Street Journal" on the grounds that it was merely descriptive and was incapable of distinguishing the goods.

⁸⁸ Law No. 633 for the Protection of Copyright and other Rights, Connected with the Exercise Thereof, ch. VIII, art. 100 (April 22, 1941), as amended, Law No. 82 (Aug. 23, 1946), in UNESCO, at Italy: Item 1—page 16.

⁸⁹ *Id.*

⁹⁰ *Id.* Headings are also protected in article 102 of the Act dealing with unfair competition.

⁹¹ *Id.* See also decision of the Cour de Cassation, May 4, 1953, in 1953 IL DIRITTO DE AUTORE 506.

⁹² See, e.g., "The Wall Street Journal" registration No. 231,101 covering goods in classes 16 and 38 (granted Sept. 24, 1969, with an extension to France).

H. *The Netherlands*

The only Netherlands provision on the subject prohibits alteration of a title without the author's consent.⁹³ Titles have been afforded copyright protection by the courts in cases where they constitute a literary work;⁹⁴ the title of a work is not automatically protected under the copyright of the work itself.⁹⁵

Trademark registration is possible in Holland, and even a party with no property interest in a title may register it as a trademark. For example, the title "April in Paris" was registered as a trademark for cosmetics, despite an existing copyright covering the song.⁹⁶ Some other titles that are registered trademarks include "Free as Air," "Moonlight," and "Rosamunde."

If use of a title causes confusion, a cause of action for unfair competition may arise under section 1401 of the Civil Code. However, the courts have not always followed this provision and there is some indication that there must be a very strong likelihood of confusion before the courts will intervene.⁹⁷

I. *Portugal*

Portugal is one of the few states that explicitly provides for the registration of titles in its copyright statute.⁹⁸ Many of the problems that have been the cause of considerable litigation in other countries are avoided through specific reference in the statute.

The basic provision, article six, provides that titles of literary, scientific, or artistic works, when new and original in form and conception, may be registered for copyright protection. The article also states that such a title must not be subject to confusion with a pre-existing title.

⁹³ Law concerning the New Regulation of Copyright, art. 25 (1912), as amended through May 22, 1958, in UNESCO, at Netherlands: Item 1—page 4.

⁹⁴ See E. HIRSCH BALLIN, AUTEURSRECHT-IN-WORDING 27 (1947), in II PINNER, *supra* note 41, at 892.

⁹⁵ In a recent case it was held that the title to popular song "Hello Mr. Owl" could be used on a similar satirical version of the song since the songs had a different text and were on a different level. Correspondence with Octrooibureau Polak and Charlouis, The Haag, Holland, March 11, 1969.

⁹⁶ The Trade Mark Office rejected a registration for "Goldfinger" on the grounds that it was the title of a copyrighted work. The case was not appealed to the courts and probably would not have been upheld. *Id.*

⁹⁷ *E.g.*, the newspaper title "Algemeen Ochtenblad Het Vrige Volk" was held not confusing with "Algemeen Dagblad," the only possible confusion being the word "Algemeen" (General), Arrondissement-Rechtbank, Nov. 10, 1960, Nederlands Jurisprudentie, 1961 (No. 8).

⁹⁸ Copyright Statute, art. 6, in UNESCO, at Portugal: Item 1—page 2.

No formalities are required to receive protection since the statute provides that registration of the work itself includes registration of the title.⁹⁹ The same regulations and remedies that are applicable to copyrights in general also apply to titles.¹⁰⁰

Generic terms are specifically excluded from protection in one section of the law,¹⁰¹ and such titles as "History of Portugal" or "Commercial Law" would be clearly unregistrable. Additional protection, based on the *droit moral*, is provided in article fifty-five, which prohibits alteration or modification of a title by an assignee, translator, or transferee.

One notable effect of the Portuguese law is that it provides that all of the statutory remedies for copyright infringement may be invoked against a title infringer. The author may have all copies of the work seized and then require the infringer to pay the retail value of all copies printed and sold.¹⁰² The infringer is also liable to a fine of at least 500 escudos and imprisonment for a minimum of six months.

The protection of the Portuguese law is specifically extended to foreign authors, independent of reciprocity.¹⁰³ Perhaps as a result of this comprehensive copyright protection, titles are not subject to trademark registration.¹⁰⁴ Unfair competition would be an inferior remedy in view of the many forms of relief available under the copyright law.

J. Spain

No provision of the Spanish copyright law¹⁰⁵ provides for the separate registration of titles. However, article sixty-four does provide that the author of a work has a property right in the title, and use of such a title by another party constitutes fraud.¹⁰⁶ A person who falsifies a title is subject to the same penalties that apply to other copyright infringers.¹⁰⁷ This protection does not apply to generic titles.

Despite the provisions of article sixty-four, until quite recently it was difficult to protect titles adequately in Spain. This was because

⁹⁹ *Id.* art. 6(1).

¹⁰⁰ *Id.* art. 6(4).

¹⁰¹ *Id.* art. 6(2).

¹⁰² Correspondence with Prof. A. Goncalves Pereira, Lisbon, Portugal, March 31, 1969.

¹⁰³ *Id.*

¹⁰⁴ *Id.*

¹⁰⁵ Copyright Statute, Jan. 10, 1879, in UNESCO, at Spain: Item 1.

¹⁰⁶ Regulations for the Application of the Law of January 10, 1879 concerning Intellectual Property, art. 64, Sept. 3, 1880, as amended through Oct. 7, 1919, in UNESCO, at Spain: Item 2—page 8.

¹⁰⁷ Copyright Statute, *supra* note 105, at page 5.

the General Registry of Intellectual Property kept an index only according to authors' names, rather than according to titles. Thus it was impossible to determine what titles were subject to protection. The old system led to many abuses, and indeed to cases of outright blackmail, especially in regard to cinematographic works. For example, a person would read in a newspaper about a film that was going to be made. He would ascertain the proposed title for the film and then quickly register a phony or hastily prepared work under the same title. After the shooting of the film began, and especially after it was almost completed, the pirate would file a complaint against the producers of the movie under section sixty-four. In most cases, especially when the producer was an American, the pirate was able to obtain a sizable "settlement."

The problem has been solved by the initiation of a title index whereby any producer can ascertain whether a registration for a particular title exists and where he may publish his title to discourage piracy. The practice of the Registry is to deny registration to a work with the same title as a previously registered work if both works are of the same genre. This does not prevent a book from being registered because its title was previously used on a song.

Trademark protection appears to be limited to titles of periodicals and is available only when such titles are capable of distinguishing the work.

K. *Switzerland*

There are no provisions in the Swiss law relating to copyright protection for titles. The Swiss federal courts are not prone to grant such protection unless a title has unique value in terms of thought or idea. The question is apparently decided on a case-by-case basis. Some authorities maintain that titles are inherently incapable of copyright.¹⁰⁸

Titles are registrable as trademarks provided that they are capable of distinguishing the product involved.¹⁰⁹ The Trade Mark Office will not reject such marks on the basis of presumed copyright, since such copyright protection rarely exists. A recent decision on this point granted registration for the word "Sheila" as a trademark for perfume, despite the claim that it was the title of a famous song.¹¹⁰

¹⁰⁸ See M. KUMMER, *DAS URHEBERRECHTLICH SCHUTZBARE WERK* 84 FF.

¹⁰⁹ For example, a preliminary objection was lodged against "Wall Street Journal" as non-distinctive under § 14(1)(2).

¹¹⁰ See *Sachen Chancel v. S.A. Clermont et Fouet*, BGE 92 II 305 FF (1966). The case also involved the issue of whether "Sheila" was a name in which exclusive rights could vest.

III

INTERNATIONAL CONVENTIONS

A. *The Berne Convention*

No reference is made to titles in the convention.¹¹¹ It is conceivable, however, that titles could be considered "writings" under article 2(1) if they were sufficiently lengthy and thus came within the specific protection of the Convention.¹¹² A more important problem is whether the Convention requires one Berne country to protect a title when the author is a national of a member country that does not grant comparable protection to its own nationals or to nationals of the other country. The language of articles four and five, which is concerned with the concept of "national treatment," indicates that the foreign author is to stand on the same ground as a native author and is to be treated as a native author, regardless of reciprocity. Article five, however, applies only when first publication occurs in the state where protection is desired.

Article nineteen of the Convention makes it abundantly clear that the Convention is not intended to limit an author's protection but rather to allow him the full benefit of any greater protection that "may be granted by legislation in a country of the Union." Thus there is no reason to deny an author protection for his title on the theory that he cannot protect it in his native country. This means that even American authors who obtain Berne protection through the "back door"—publication in a Berne country—can protect the titles of their works in any member country that provides such protection.¹¹³

B. *The Washington Copyright Convention*

The Washington Copyright Convention¹¹⁴ is the only multilateral treaty that specifically incorporates the protection of titles. Article fourteen prohibits the expropriation of titles of "internationally famous" works, where such titles have acquired "such a distinctive

¹¹¹ Berne Convention for the Protection of Literary and Artistic Works, signed Sept. 9, 1886, as revised through July 14, 1967, by the Stockholm Act, in UNESCO, at Multilateral Conventions.

¹¹² See I LADAS, *supra* note 75, § 112, at 242.

¹¹³ *Id.* § 82, at 191-92.

¹¹⁴ Inter-American Convention on the Rights of the Author in Literary, Scientific, and Artistic Works, June 22, 1946, in UNESCO, at Multilateral Conventions. The convention was signed by the U.S. delegate but never ratified by the Senate and therefore the U.S. is not a member. Members are Argentina, Bolivia, Brazil, Costa Rica, Cuba, Dominican Republic, Ecuador, Guatemala, Haiti, Honduras, Mexico, Nicaragua, and Paraguay.

character as to become identified with that work alone."¹¹⁵ The principal limitation on this protection is that it does not apply to a title that is used on a work "so different in kind or character as to preclude any possible confusion."¹¹⁶

Unfortunately, it appears that the Washington Convention may be a dead letter as a result of the subsequent enactment of the Universal Copyright Convention (UCC),¹¹⁷ discussed below. If so, article fourteen governs only relations between those states that are parties to the Washington Convention but not to the UCC.

C. *Universal Copyright Convention (UCC)*

The UCC itself makes no reference to the protection of titles. However, there is a strong possibility that the Convention destroys the protection afforded to titles by the Washington Convention of 1946. The language of the UCC is somewhat unclear as to its effect on the Washington Convention. Article XVIII begins with a statement that seems to indicate that the UCC does not abrogate any multilateral copyright conventions in effect between American states. However, the second sentence of the same article states that any "differences" between any other convention and the UCC should be decided in favor of "the convention or arrangement most recently formulated."¹¹⁸ Since the UCC was formulated some six years after the Washington Convention, it appears that a state that is party to both conventions must follow the UCC in any area where it differs from the Washington Convention.

Whether this affects title protection depends on the interpretation given to the word "difference."¹¹⁹ A strict interpretation would hold that a "difference" exists whenever the application of one of the agreements to a given work would lead to a different result than the application of the other. In other words, if a title is not protectable under the UCC and is protectable under the Washington Convention, there is a "difference" and the UCC must control.

A more liberal interpretation would be that a "difference" occurs

¹¹⁵ *Id.* art. 14.

¹¹⁶ *Id.*

¹¹⁷ Universal Copyright Convention (UCC), Sept. 6, 1952, in UNESCO, at Multilateral Conventions.

¹¹⁸ *Id.* art. XVIII. Date of formulation is the date the original parties adopted the agreement. The date of ratification is irrelevant in this respect. See *Report of the Rapporteur-General*, in A. BOGSCH, *THE LAW OF COPYRIGHT UNDER THE UNIVERSAL COPYRIGHT CONVENTION* 180, 197 (1964).

¹¹⁹ The Spanish and French texts use the word "divergence." See BOGSCH, *supra* note 118, at 167, 176.

only when it is for the benefit of the author. This means that the UCC would not prevail over an earlier convention if it were less favorable to the author. Under this view titles would continue to be protected in those states that are parties to both conventions.

Although there is some support for the liberal view in the introduction to the UCC¹²⁰ and, in the writer's opinion, the liberal view is more desirable, the strict interpretation is probably more in keeping with the intent of the draftsmen of the UCC. It is logical to assume that the original parties to the Convention would have specifically stated that only differences favorable to an author would be controlled by the UCC if that had been their intention. This was done in the Berne Convention,¹²¹ and the authors of the UCC could have followed that model had they so desired. Moreover, it is fair to assume that the interests of authors were not the sole consideration in drafting the UCC and that the interests of users were also considered.¹²²

As to the possible contradiction between the "non-abrogation" clause in article XVIII and the "differences" clause that follows it, it is not necessary to consider them as inconsistent. Abrogate means "[t]o annul, repeal or destroy"¹²³ and the precedence of one convention in the event of differences need not amount to abrogation.¹²⁴

CONCLUSION

A number of conclusions can be drawn from the preceding discussion:

(1) All countries surveyed recognize some form of protection for titles of literary and artistic works.

(2) Many countries, particularly those following the common law system, do not provide copyright protection for titles but do protect them on unfair competition principles.

(3) Countries having a civil law system tend to rely more on copyright protection and to incorporate such protection into their statutes.

(4) Few countries, even those granting statutory protection, actu-

¹²⁰ The introduction states that the UCC is a system of protection "additional to" and not one "impairing international systems already in force." See BOGSCH, *supra* note 118, at 157.

¹²¹ The Stockholm Act (a revision of the Berne Convention), article 20, provides that existing arrangements which "grant to authors more extensive rights than those granted by the Convention" shall remain applicable.

¹²² See BOGSCH, *supra* note 118, at 157.

¹²³ BLACK'S LAW DICTIONARY 21 (rev. 4th ed. 1968).

¹²⁴ Cf. BOGSCH, *supra* note 118, at 163-64.

ally protect titles on a pure copyright theory (*i.e.*, as an original literary creation). Many states provide protection in their copyright laws for titles as if they were trademarks (*i.e.*, on the basis of their ability to distinguish the product on which they appear) or on the theory of unfair competition (*i.e.*, to avoid the possibility of confusion).

(5) Protection in the United States is inadequate in comparison with most other countries surveyed. Protection is effectively limited to unfair competition, and the decisions in *Sears* and *Compco* have left a great deal of uncertainty as to the nature and scope of this protection.

(6) The most comprehensive protection for titles is provided by the countries of continental Europe, notably Portugal, Spain, France, and Italy.

(7) Protection in Scandinavian countries is limited to circumstances where a possibility of confusion exists. Nevertheless, the copyright owner has the exclusive right to use his title as a trademark, even if it is not original.

(8) Only one international convention encompasses the protection of titles, and it is likely that this protection is no longer in effect if article XVIII of the Universal Copyright Convention is narrowly construed.

*Leslie Alan Glick**

* Member of the third-year class, Cornell Law School.