“To protect or not to protect? The eligibility of commercially-used short verbal texts for copyright and trade mark protection”

Jennifer Davis & Alan Durant
Wolfson College, Cambridge
Middlesex University Business School, London

Paper based on:

1. Discussion at CIPIL annual interdisciplinary seminar

Issues we explore: legal and linguistic

How well are ‘short verbal texts used in commerce’ (SVTs) accommodated in the legal reasoning associated with established categories of IP protection?

- What are the potentially available forms of protection for SVTs against unauthorised third-party use?
- How have the courts approached such possible protection?
- Are there specific, countervailing interests to be considered?

Section One

‘Short verbal texts used in a commercial setting’
What are we considering as our class of ‘short verbal texts used in a commercial setting’?

• Cluster of possibilities: one-word and phrasal names for companies, products and services; headlines, etc.

• We look in particular at:
  - Titles (books, films, CDs, etc.)
  - Slogans (promotional taglines)

The language of short verbal texts: forms, functions, and situations of use

• **Form**: word, short phrase, short sentence (somewhere between a single word and a ‘literary work’)

• **Function**: name, description, expletive or exclamation, promotional message, elliptical expression of a thought, etc.

• **Situation of use**: in what setting or context
**Why are such short texts complicated at all?**

- rather than being ‘simple because short’

- Short verbal texts are often ‘imagistic’: condensed, polysemous, and/or fragmentary suggestions of longer utterances.

- *Ergo*: assessing labour and creativity that goes into such texts, and meanings and effects that come out of them, calls for acts of *inference* (for which evidence is difficult to produce).

- *Ergo*: potentially difficult to articulate clear and consistent relationship between treatment of such texts and IP categories under which they may be considered eligible.
Main avenues for IP protection

• Words don’t come tagged for IP categories: no property in a word or phrase as such – only insofar as an expression serves a claimed function

• No necessary singularity of function: might simultaneously indicate source, encourage purchases, evoke associations, constitute a literary work, etc.

• Main possible forms of protection:
  - Copyright (as an original literary work, or substantial part of one)
  - As verbal trade mark (distinctive word-sign capable of distinguishing commercial origin of associated merchandise)

  Or potentially:
  • No protection at all, on either count
  • Both kinds: dual protection (not favoured by UK courts)

Section Two: the law and short verbal texts
Policy considerations: different rationales for copyright and TM protection

<table>
<thead>
<tr>
<th>COPYRIGHT</th>
<th>TRADE MARKS</th>
</tr>
</thead>
<tbody>
<tr>
<td>• creativity embodied in a work entitles creator to fruits of his/her creation</td>
<td>• benefit to consumers in preventing confusion and reducing search costs where mark acts as badge of origin</td>
</tr>
<tr>
<td>• utilitarian arguments about benefits to society of a supply of creative works</td>
<td>• need to protect financial investment in nurturing a mark and prevent free-riding (incl. where protection must extend to the mark’s ‘attractiveness’ or advertising function)</td>
</tr>
<tr>
<td>• from law and economics perspective, need to prevent market failure, given the nature of copyright works as ‘public goods’</td>
<td></td>
</tr>
</tbody>
</table>

Should there be an assumption in favour of protecting short or fragmentary commercial texts, based on stated rationales? Do they show...

• investment of labour, strategic calculation and craft in choosing word or words?
• investment of money?
• proven function?

Traditional cues to possible IP protection, either for an individual author, a manufacturing company, or an advertising agency, etc.
Section Three: copyright

19c authorities in SVT copyright cases

Earliest decisions concerned titles, and made under 1842 Copyright Act (which gave protection to books but not, as in later Acts, to literary creations as such)

Decisions during the period affected by changes in legal reasoning, especially:

• Judicial attitudes

• Public interest concerns cited
Maxwell v Hogg [1867]

- H intended to publish a literary magazine with the title, ‘Belgravia’
- No copyright infringement
- Cairns LJ (at 314-5) concluded that there was no property in a word as such. The public interest in communicating a work to the public for their benefit was not fulfilled by a single word.

Kelly v Byles [1878]

- Leaves open the possibility of copyright in a title in principle
- High Court minded to give protection. Bacon VC (at 488):
  ‘authors of all literary works should have exclusive enjoyment and profit from their literary labours…. It comprehends all productions which assume a literary form from works of the highest genius in poetry, science or art, down to the humblest productions of intellectual industry; all are placed upon the same footing and in the eye of the law are entitled to equal protection provided they are original in the sense of first made public by their respective authors.’
- In Court of Appeal, James LJ (at 192): claimant’s claim not ‘analogous to copyright’ but an ‘extravagant extension of the right to a trade mark’ (which failed because the words ‘Post Office’ were merely descriptive)
**Dicks v Yates [1879]**

- Possibility that there could be copyright in a title left open...

- ... But in this case no copyright. Title ‘Splendid Misery’ only ‘hackneyed’, lacking in both originality and intellectual effort

- Jessel MR (at 89): a title deserving copyright protection would probably be ‘a whole page of title or something of that kind requiring invention’.

- Lush LJ (at 92): if copyright were to subsist in a shorter title, it would need to ‘be original, it must be a composition of the author, something which has grown up in his mind, the product of something which if it were applied to patent law would be called an invention.’

- Question of whether titles generally were sufficiently substantial to constitute a copyright work not decided

---

**Copyright and short verbal texts:**

*some more recent cases*
**Francis Day and Hunter v Twentieth Century Fox [1940]**

- **No copyright** in the title of the song: ‘The Man Who Broke the Bank at Monte Carlo’

- In Privy Council, Lord Wright agreed that copyright claim failed:
  
  ‘The copying which is complained of is the use of the title, and that is too insubstantial in the facts of this case to constitute infringement.’

- Titles should not, in general, be protected by copyright – though there might be exceptions (at 123):
  
  ‘In the present case the title was originally applied to a musical composition, whereas it has been applied by the respondents to a motion picture or a film. The argument of the appellant company would be the same, it seems, if the application of the title complained of had been to a picture or a statue.’

  ‘As a rule a title does not involve literary composition and is not sufficiently substantial to justify a claim to protection. The statement does not mean that in particular cases a title may not be on so extensive a scale and of so important a character, as to be a proper subject of protection against being copied.’

**Exxon Corporation v Exxon Insurance Consultants International Ltd [1981]**

- **No copyright** protection under 1956 Copyright Act (s2 protected an ‘original literary work’ but did not delineate parameters of such a work)

- Exxon argued: ‘considerable time and labour’ expended on arriving at name ‘Exxon’ qualified the word as an ‘original literary work’; actual size of work attracting protection immaterial

- Defendants asserted: a word, even if invented, could not be considered an original literary work, if the phrase ‘literary work’ were to be given its ordinary English meaning

- Graham J: ‘Exxon’ not an original literary work within meaning of s2 of 1956 act. A single word *might* be protected by copyright. But ‘Exxon’

  ‘has no meaning and suggests nothing in itself. To give it substance or meaning, it must be accompanied by other words or used in a particular context or juxtaposition.’
Exxon (cont.)

• In the Court of Appeal, Stephenson took the view that a literary work should ‘afford information and instruction, or pleasure...’

Citing Hollinrake v Truswell (1894)

• In Hollinrake, justification for protection was to encourage the production of literary works ‘of lasting benefit to the world.’

Infopaq International A/S v Danske Dagblades Forening [2009]

• Infopaq decision not from UK copyright law but Information Society Directive. Key question concerned interpretation of art 2: authors have exclusive rights to authorize or prohibit reproduction in whole or in part of their works

• CJEU: parts of a work are protected as copyright works ‘provided they contain elements which are the expression of the intellectual creation of the author of the work.’ Left to national courts to decide if this is the case

• Infopaq a media monitoring and analysis business; summarized selected articles from Danish newspapers and emailed to customers, after scanning and digitizing. Search word identifies five words before and after ‘captured’ word; rest of file deleted.

• Dispute therefore concerned taking of eleven words. CJEU asked to decide whether these could constitute a work or part of a work for purposes of art2. Yes, copyright. CJEU concluded they could

Key justification: to enable authors ‘to receive an appropriate reward for the use of their works.'
**Newspaper Licensing Agency Ltd (NLA) v Meltwater Holdings [2011]**

- In CA, Lord Chancellor accepted reasoning of Mrs. J Proudman in High Court: *Infopaq* decision had not qualified ‘longstanding’ test developed by English courts for what constitutes an original literary work: the work has to originate from the author and reflect author’s own skill, judgment and effort.

- **Yes, copyright.** Case concerned unauthorized reproduction of newspaper headlines and short extracts. Court concluded that newspaper headline may constitute a ‘free-standing copyright work’ as well as a substantial part of a literary work: ‘the effect of *Infopaq* is that even a very small part of the original may be protected by copyright if it demonstrates the stamp of individuality reflective of the creation of the author or authors of the article.’

- Court’s judgment as to what constitutes that stamp based on traditional test: whether ‘substantial skill and labour’ has gone into creation of the original work, or whether the work reflects ‘the intellectual creation of the author’, or whether the headlines (together with the opening text) are ‘significant and striking’. But no examples in the case analysed.

---

**Implications of recent cases?**

Have the courts lowered threshold as regards when copyright may apply to short verbal texts?

In *Meltwater*, CA did not address implications of its decision as regards copyright protection of single words, though issue alluded to in *Infopaq*. In *Infopaq*, CJEU held (echoing Graham J. in *Exxon*) that words

> ‘considered in isolation, are not as such the intellectual creation of the author who employs them. It is only through the choice, sequence and combination of those words that the author may express his creativity in an original manner and achieve a result which is an intellectual creation'. (para. 45)
Section Four: trade mark protection

General reference points

Registration endows a monopoly, but a clearly delimited one:

• Only protects mark if used in course of trade

• Only protects mark if it functions as badge of origin

• A number of exceptions (Art 6, TMD 2008) to such protection (esp. descriptive use)
(A) Trade mark protection: titles

If used as titles of a creative work, signs are held to be descriptive – but in two different senses of descriptive:

1) they tell the consumer something about the nature or content of the work

2) they denote or label (in this sense, ‘describe’) the work as being something published under the title, rather than indicating the trade origin of the work (e.g. it’s a book published by Penguin)

Mothercare U.K. Ltd v Penguin Books Ltd [1988]

Leading case before 1994 Act: alleged trademark infringement and passing off

Claimant’s action failed on both counts:

• defendant not using mark in trade mark sense; use was purely descriptive

• no misrepresentation for purposes of passing off: customers would not assume book issued or sponsored by Mothercare

Claimant well-known retailer of children’s clothes. Also sold books, including ‘Complete Mothercare Manual’, offering advice to mothers; ‘Mothercare’ registered as trade mark, including for printed matter. Defendant published ‘controversial’ book titled, ‘Mother Care/Other Care’, examining childcare arrangements of working mothers
Implications of *Mothercare*

In finding defendant had *not* infringed, Bingham LJ accentuated issues at stake:

‘To conclude otherwise would be to hold (where a trademark consists of an English word or words) that Parliament intended to grant the proprietor of the trademark what would in effect be commercial copyright in that word or those words.’

---

*R v Johnstone* [2003]

Case concerned whether use of TM as title for CDs would be descriptive and hence non-infringing use

HL, citing Mothercare, agreed *not TM use*. Differentiated between title acting as indication of trade origin and title that is descriptive of content of a work

- Defendant had made and distributed CDs containing bootleg recordings of prominent artists, including Bon Jovi; names of the bands registered trade marks for range of merchandise including CDs. Defendant argued he was using the names to indicate the content of the discs, rather than as indication of origin
- Lord Nicholls differentiated use of name ‘Bon Jovi’ made by defendant from that of ‘a brand name’. If only connection indicated by defendant’s use of marks was that the names were the names of the performers on the disc, then such use would be simply descriptive of the contents of the disc, and not infringing
## Issues in *Johnstone* [2003] (1)

According to Lord Walker (at 76):

“It is easy to recognise those cases which fall squarely on one side or other of the line [separating proper from improper use of a TM]. The difficulty arises, I think, because between cases which are clearly at the opposite extremes of “distinctiveness” and “descriptiveness” there is something of a no man’s land of debatable cases, and the problem of analysis varies with the character of the mark and the character of the goods to which it is affixed. Disputes about books, and scarves, and compact discs, cannot easily be resolved by a single test. Most people would have an intuitive feeling that to label a compact disc with the words “Rolling Stones” is less purely descriptive than entitling a biography “Wet Wet Wet”. That is no doubt because a group of musicians are in some sense the authors (or at least the performers) of what is on the disc, but are not the authors of an unauthorised book about themselves. But in that case is not their real grievance infringement of their copyright or their performing rights, rather than of their trade mark?

## Issues in *Johnstone* [2003] (2)

*Re* Wet, Wet, Wet comment, Lord Walker referring to *Bravado Merchandise Services Ltd v Mainstream Publishing (Edinburgh) Ltd* [1996]. Respondents in that case held not to have infringed, as they had defence of descriptive use under s11(2)(b) TMA 1994.

The pop group Wet, Wet, Wet had complained of an unauthorized biography, entitled ‘Wet, Wet, Wet’ (where ‘Wet, Wet, Wet’ was registered TM including for printed matter and books)

Lord McCluskey (at 216):

‘It would be a bizarre result of trade marks legislation the primary purpose of which is ‘to guarantee the trade mark as an indication of origin’, if it could be used to prevent publishers from using the protected name in the title of a book about the company or product.’
**Animated Music Ltd's Trade Mark: Application for Revocation by Dash Music Co. Ltd [2004]**

TMR held no trade mark use by respondents; trade mark should be revoked (s46 TMA 1994: non-use for five years)

- Applicant was copyright holder in the song, ‘Nellie the Elephant’, which they licensed to respondent for use in series of cartoons

- Defendant subsequently obtained registration for ‘Nellie the Elephant’ for variety of services, including audio and video recording services

- TMR cited OHIM judgment in *Francis Fitzpatrick v Disney Enterprises*, also relating to a title: ‘Winnie the Pooh’, a trade mark owned by the Disney Corporation...

**Francis Fitzpatrick v Disney Enterprises [2001]**

OHIM took view in this case that the public would understand the trade source of the relevant books and videos to be Disney Corporation.

‘The fact that characters which the opponent claims are trade marks might appear in books, videos etc. or as items of decoration on stationary does not indicate that they are being used or will be perceived as trade marks. The opponent has shown many titles of works that include e.g. Winnie the Pooh, however it is a great leap of faith that is made far more difficult as use of the characters’ names is always in relation to their appearance in the videos, books etc. So what the opponent effectively proves is that the characters are well known as characters, not as trade marks. A different scenario would occur if the characters’ names are used in relation to goods which do not relate to them... In relation to publications, whether recorded or in print the public is well used to discriminating between e.g. the publisher and the title of the book.’
**Danjaq, LLC/OHIM (Dr. No/Dr. NO) [2009]**

OHIM held (in course of deciding whether sign was well-known trade mark in a Member State, Art 8(2) CTMR) that

- ‘Dr. No’, used on video cassettes and DVDs (as well as in comic books and sound recordings), was **not use as a trade mark** but descriptive use

  ‘The signs Dr. No and Dr. NO do not indicate the commercial origin of the films, but rather their artistic origin. For the average consumer, the signs in question, affixed to the covers of the video cassettes or to the DVDs, help to distinguish that film from other films in the ‘James Bond’ series. The commercial origin of the film is indicated by other signs, such as ‘007’ or ‘James Bond’, which are affixed to the covers of the video cassettes or to the DVDs, and which show that its commercial origin is the company producing the films in the ‘James Bond’ series....’

**Issues/implications raised in Danjaq [2009]**

‘[...] The distinction between title and trade mark is not ‘unrealistic and artificial’. The same sign may be protected as an original creative work by copyright and as an indicator of commercial origin by trade mark law. It is therefore a matter of different exclusive rights based on distinct qualities, that is to say the original nature of a creation, on the one hand, and the ability of a sign to distinguish the commercial origin of the goods and services, on the other.’ [at 26]

- no problem with newspaper/magazine proprietors registering names of their publications as trade marks (e.g. ‘The Economist’, ‘The Times’); public views publications under particular name as originating from same source

- possible to register titles of works intended for use on range of merchandise, not merely on work itself; in that situation, average consumer views title as badge of origin
(B) Trade mark protection: slogans

- Do slogans meet standard of distinctiveness?
- Is promotional function of slogans laudatory, hence not TM use?
- Can a slogan be *simultaneously* a promotional message and also a source-indicator?

HAVE A BREAK TM [1993]

- First used in conjunction with ‘Kit Kat’ on chocolate bars, but on its own since 1980s
- Decision made under 1938 trade mark act: No trade mark protection
- Whitford J:
  - Because of 'the inclusion of the word “break” the slogan was a mark that other traders might want to use...”. Not inherently distinctive
  - If mark were registered would: ‘bring about a significant erosion of a manufacturer’s freedom to point out the aptness of his product for consumption during breaks.’
**Audi AG v OHIM [2010]**

- 2001: Audi applied to register ‘Vorsprung durch Technik’ as CTM for Nice class 12 (motor vehicles and components). **Successful**, on proof of acquired distinctiveness

- 2003: Audi sought to extend registration to approx. ten further classes. **Application refused:** words lacking in essential characteristic of distinctiveness

- General Court dismissed appeal

- **CJEU overturned GC outcome:** even without proof of acquired distinctiveness, slogan could be *both* laudatory *and* distinctive, so entitled to TM protection

---

**Why Audi v OHIM interesting**

Appears to suggest change of course in TM thinking

- Pre-1994, public interest in leaving slogans / laudatory signs available for others to use; under TMD descriptive signs registrable on proof of acquired distinctiveness

- Acknowledgement in *Audi* of multiple, simultaneous functions of sign that may have a bearing on registrability *ab initio*

- Complexity of demonstrating, and disentangling, different capabilities of sign in absence of repute or evidence from use
Section Five: why single words and short phrases may be problematic in IP law

‘Vorsprung durch Technik’

1. As distinctive sign eligible for trade mark protection?

2. Hypothetically: as original literary work, eligible for copyright protection?
‘Vorsprung durch Technik’

As distinctive sign eligible for trade mark protection?

Although Vorsprung durch Technik can have a number of meanings, or constitute a play on words, or be perceived as imaginative, surprising and unexpected and, in that way, be easily remembered, this nevertheless does not make it distinctive: those various elements make the mark distinctive only if it is perceived immediately by the relevant public as an indication of commercial origin of the goods and services covered by that mark. However, in the case before it, the relevant public would perceive the mark, first and foremost, as a promotional formula [...] A mark can be perceived by the relevant public both as a promotional formula and as an indication of the commercial origin of goods or services. It follows that, insofar as the public perceives the mark as an indication of origin, the fact that the mark is at the same time understood -- perhaps even primarily understood -- as a promotional formula has no bearing on its distinctive character. [CJEU, H10-11]

‘Vorsprung durch Technik’ (as TM, cont.)

Marks can express an objective message and still be capable of indicating to the consumer the commercial origin of the goods or services in question,

in particular, where those marks are not merely an ordinary advertising message, but possess a certain originality or resonance, requiring little in the way of interpretation by the relevant public, or setting off a cognitive process in the minds of the public.’

(para 57)
‘Vorsprung durch Technik’ (as TM, cont.)

• Nature of linkage or association between verbal sign and source different from conventional ‘signature’ or ‘naming’ signs?

• Difficult to disentangle simultaneous possible meanings or effects? (e.g. how does memorability relate to distinctiveness?)

• Nature of link or association between slogan and source especially difficult to determine *ab initio*, at registration and ahead of any evidence from use or reputation?

• Extension of protection to communicated meanings, as well as inventiveness, of the sign?

‘Vorsprung durch Technik’ (2)

Hypothetically: As a literary work, eligible for copyright protection?
‘Vorsprung durch Technik’ (and copyright)

Copyright in short verbal expressions widely considered settled since 1982, following Exxon Corporation v Exxon Insurance. At first instance in that case, Graham J argued that that the word ‘Exxon’

‘has no meaning and suggests nothing in itself. To give it substance or meaning, it must be accompanied by other words or used in a particular context and juxtaposition.’

He did not rule out possibility of copyright subsisting in even a single word, however:

Such a word would, however, I think, have to have qualities or characteristics in itself, if such a thing is possible, which would justify its recognition as an original literary work rather than merely as an invented word.

‘Vorsprung durch Technik’ (and copyright)

Relation between ‘Exxon’ and ‘Vorsprung durch Technik’ not straightforward:

• Both expressions involve creative labour (attestable by audit trail of focus groups, etc.); but that was insufficient for copyright in Exxon

• ‘Exxon’ a limiting instance of textual minimalism: one-word name; neologism; conveys or implies no propositional meaning. ‘Vorsprung durch Technik’ not invented word but phrase; consists of commonly used words in idiomatic grammatical pattern; conveys at least one possible message (the slogan meaning, judicially stated in Audi v OHIM)

• ‘Vorsprung durch Technik’ involves acts of selection extended to successive combinations, which produce meaning (from ‘building blocks’)

Could these differences be sufficient to show ‘the author’s own intellectual creation’ in a short verbal text, even where ‘Exxon’ didn’t?
‘Vorsprung durch Technik’ (both rights)

• Phrase protected by CJEU as trademark, *ab initio*, for Nice categories other than those on proof of acquired distinctiveness shown for class 12
  
  - Could a plausible argument be made that perhaps it *shouldn’t* be?

• Phrase unlikely to be protected by UK copyright, as insufficient to constitute an original literary work
  
  - Could a plausible argument be made that perhaps it *should* be?

Is optimum balance currently achieved between proprietary and public interest?

• Where the courts believe such a balance should lie has changed over time, reflecting changes both in law and in commerce

• Different exceptions and exclusions apply in trademark law and in copyright law (e.g. descriptive or non-trademark use; fair dealing for purposes of criticism or review; reporting of current events)

• Hence, importance in how the two forms of protection intersect, gaps they leave, etc.