Titles in Europe: Trade Names, Copyright Works or Title Marks?

JAN KLINK
Jan Klink, Edwards Geldard,

Titles, it appears, are ambiguous items, identifying works they form part of as well as their sources. Furthermore, titles often describe the content of the work, advertising it to the reader, and always run the risk of coming too close to other titles. Choosing the right title must be a difficult task, though. Publishing simultaneously in various jurisdictions—daily practice in the film, music, publishing and software industries—complicates the task still further. It multiplies the risks of both infringement of existing title rights and misappropriation of one's own successful title. In the absence of harmonised European legislation, however, determining free titles or fast legal action against free-riders may easily become an all-at-sea adventure in a colourful but tangled landscape of various national rights. The outcome of legal action in three major European markets—the United Kingdom, France and Germany—against a competitor who, for example, picks a title such as "Dangerous Liaisons" to embellish one of his own publications, will vary to an appreciable extent. While under English law there might not be any right to such a title, a French court may award copyright for life plus 70 years whereas in Germany, trade mark like rights can extend even to anti-dilution protection. Such a remarkable range of responses must be due to different perceptions of what the essence of the concept "title" really is about. Different understandings of what a title is will undoubtedly not only affect the scope of protection but moreover have a powerful impact on the legal basis that title rights rest on. Stressing the function of titles as indications of the sources of works, *e.g.* newspaper titles which also identify publishing houses, may lead to protection along concepts developed for traditional trade names—essentially the approach in the United Kingdom. Focusing on titles as integral parts of the underlying and often copyrighted works may lead to copyright protection for the titles themselves—the predominant notion in France. The function of distinguishing one work from another, finally, brings to mind the terrain of trade marks—paralleling title and trade mark rights is the principal approach in Germany. Title protection in other European jurisdictions oscillates between these poles, sometimes leaning more towards copyright, sometimes rather towards anti-confusion concepts. Those who exploit works and titles across Europe will by no means encounter a homogeneous playing field.

The United Kingdom: Titles as Trade Names

Britain's extensive publishing tradition has become famous for good reasons. It prospered over several hundred years and set standards in many regards. While early cases of inevitably resulting disputes over titles can be tracked back to the year 1867,[1] perhaps surprisingly English law never developed a separate right to a title. Generally,[2] copyright does not subsist in titles.[3] English courts, as a rule, do not consider the formation of several ordinary words into a title as creating an original literary work.[4] Skill, labour and judgment[5] may have been invested in finding titles that are original in denoting the work but titles *per se* are considered to be simply too short to be original or to afford information, instruction or pleasure.[6] Even if a title were regarded as a part of a copyright work, in most cases copying would not amount to the taking of a substantial part.[7] The nature of titles as descriptions of the content of the work will also often hinder trade mark registrations.[8] Even if titles achieve registration, they are often too descriptive

1 *Maxwell v Hogg* [1867] L.R. 2 Ch. 307, CA; *Ward v Beeton* [1874] L.R. 19 Eq. 207.

2 For exceptionally long titles see: *Dicks v Yates* (1881) 18 Ch. D. 76; *Francis Day and Hunter v Twentieth Century Fox Corp* [1940] A.C. 112 at 123; *Ladbroke (Football) v William Hill (Football)* [1964] 1 W.L.R. 273 at 286.

3 Some early decisions suggested that titles of literary works would also be subject to copyright: *Weldon v Dicks* (1878) 10 Ch. D. 247 and *Mack v Petter* [1872] L.R. 14 Eq. 431, but were overruled, at least with regard to short titles: *Dicks v Yates*, n.2 above; *Licensed Victuallers' Newspaper Co v Bingham* (1888) 38 Ch. D. 139; *Miss World (Jersey) v James Street Productions* [1981] F.S.R. 300; *Exxon Corp v Exxon Insurance Consultants International Ltd* [1982] R.P.C. 69. See for song titles *Francis Day & Hunter v Twentieth-Century Fox* [1939] All E.R. 192, PC.

4 *Copinger and Skone James on Copyright* (1999), p.970 and s.1(1)(a) of the UK Copyright, Designs and Patents Act 1988.

5 The test for originality in the United Kingdom. See *University of London Press v University Tutorial Press* (1916) 3 Ch. 601 and *Walter v Lane* [1900] A.C. 539; *Martin v Polyglass Manufacturers* [1969] N.Z.L.R. 1046.

6 In *Exxon Corp v Exxon Insurance Consultants International Ltd* [1982] R.P.C. 69 it was held that, while a single word may be invented and original, it would always lack the quality of affording information, instruction or pleasure; see as well *Holinrake v Truswell* (1895) 3 Ch. D. 420. The same would apply to short titles.

7 s.16(3)(a) of the UK Copyright, Designs and Patents Act 1988 and *Francis Day and Hunter v Twentieth Century Fox Corp*, n.2 above; *Ladbroke (Football) v William Hill (Football)*, n.2 above.

8 *Yorkshire Copper Works, Tarzan Trade Mark Application* (1954) 71 R.P.C. 150; *Science and Health Trade Mark Application* [1968] F.S.R. 344. See for more examples Colleen Donavan and Steven Jennings, "Trade Marks and Book Titles" [1994] Ent.L.R. 38; however, see *Associated Newspapers, Daily Mail and General Trust Plc v Express Newspapers* (2003) WL 21236549 (Ch. D.) at 10 where the words "mail" and "the mail" (and respective trade marks) were held not to be descriptive if used for newspapers but to have a pronounced trade mark significance.

to trigger trade mark infringement[9] or are not used in a trade mark sense.[10]

English judges rather look at the goodwill contained in a title and apply rules which have been developed for the protection of goodwill in other trade names such as business names or trade marks. Accordingly, the general principles of the common law tort of passing off are applied. The classic definition of the tort, made by Lord Halsbury in 1896, was that "nobody has any right to represent his goods as the goods of somebody else".[11] Based on that definition, a successful claim of passing off usually[12] requires the trinity of goodwill/reputation, confusion, and damages.[13] In a title case, a successful plaintiff must establish (1) that he has acquired goodwill/reputation in the title; (2) that the defendants, by using the same title for the same kind of work, have represented that their work is the plaintiff's in such a way as to cause confusion among ordinary, sensible members of the public; and (3) that such confusion is likely to cause the plaintiff damage.[14] In practice, however, some of these elements do not function particularly well with the subject matter of titles.

Goodwill in titles

Essential to any claim of passing off is that the title in question, like other trade names, has acquired sufficient goodwill or reputation in the market. Titles, like trade names, must have become distinctive to some part of the public for the goods, services or businesses they identify.[15] An immediate effect is that title protection will not commence before publication and long-term investment in titles of more sophisticated works, *i.e.* films or novels, remains at risk until goodwill/reputation has finally been built up. It has been held that the mere intention or declaration of intention to publish a work with a particular title will not create any rights as to the title.[16] While in appropriate cases a court may accept substantial pre-launch advertising or publicity,[17] title protection will still only commence after additional substantial investment has been made in such advertising. This counts in particular against lesser-known titles which have not, and maybe never will, entered the mass market,[18] have decreased in fame,[19] or are known only in a particular area[20] or outside the territory of the United Kingdom.[21] The general view that goodwill is confined to national territories[22] is particularly unfortunate in the light of globalisation, progressing European market integration and the industry practice of testing

9 The registered trade mark *Bach Flower Remedie*s would not prevent a similar title: [1992] R.P.C. 439. Other typical cases include *Mothercare UK v Penguin Books* [1988] R.P.C. 113 where the trade mark *Mothercare* could not prevent the book title *Mother Care/Other Care* or *Bravado Merchandising v Mainstream Publishing* [1996] F.S.R. 205, where the book title *Wet Wet Wet* was held to be descriptive as the book was in fact about the pop band using that name. See also *Science and Health Trade Mark Application*, n.8 above; *Games Workshop v Transworld Publishers* [1993] F.S.R. 705 and for famous trade marks *Baywatch Production Co v The Home Video Channel* [1997] F.S.R. 22.

10 ECJ, Case C–2/00—*Hölterhoff*; and *Arsenal v Reed* [2001] 2 C.M.L.R. 23. In any case, careful drafting of the list of goods and services for which the title mark should be registered is required as demonstrated in *Minerva Trade Mark Application* [2000] F.S.R. 734: use on "printed matter" need not cover use on "literary printed matter".

11 *Reddaway v Banham* [1896] A.C. 199 at 204.

12 Passing off has been defined in different ways in order to adopt it to specific situations. Lord Diplock, for example, defined passing off in the *Advocaat* case, *Erven Warnink v J. Townend & Sons (Hull) Ltd* [1980] R.P.C. 31, HL, at 93 as "(1) a misrepresentation, (2) made by a trader in the course of trade, (3) to prospective customers of his or ultimate customers of goods and services supplied by him, (4) which is calculated to injure the business or goodwill of another trader . . . and (5) which causes actual damage to a business or . . . will probably do so". See in addition *Bollinger v Costa Brava Wine* [1960] R.P.C. 16 (Champagne) and *Vin Products v Mackenzie* [1969] R.P.C. 1 (Sherry) or the *Chocosuisse* case [1999] R.P.C. 826.

13 According to Lord Oliver in the *Jif Lemon* case, *Reckitt & Colman v Borden* [1999] R.P.C. 340, HL, at 499, a plaintiff must typically demonstrate the following: "First, he must establish a goodwill or reputation attached to the goods or services which he supplies in the mind of the purchasing public by association with the identifying 'get-up' (whether it consists simply of a brand name or a trade description, or the individual feature of labelling or packaging) under which his particular goods or services are offered to the public, such that the get-up is recognised by the public as distinctive specifically of the plaintiff's goods or services. Secondly, he must demonstrate a misrepresentation by the defendant to the public (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by him are the goods or services of the plaintiff . . . Thirdly, he must demonstrate that he suffers, or in a *quia timet* action, that he is likely to suffer damages by reason of erroneous belief engendered by the defendant's misrepresentation that the source of the defendant's goods or services is the same as the source of those offered by the plaintiff."

14 *County Sound Plc v Ocean Sound Ltd* [1991] F.S.R. 367 at 372.

15 *Kerly's Law of Trade Marks and Trade Names* (13th ed., 2001), pp.419, 420.

16 See already *Maxwell v Hogg*, n.1 above.

17 See *Labyrinth Media v Brave World* [1995] E.M.L.R. 38 at 47, where sufficient pre-launch publicity was denied in the end. See also *Marcus Publishing v Hutton-Wild Communications* [1990] R.P.C. 576 at 580, 581, 583.

18 In *Licensed Victuallers' Newspaper Co v Bingham*, n.3 above, the plaintiff was on the market but had sold not enough copies to enjoy sufficient reputation.

19 In *Kark (Norman) Publications v Oldhams Press* [1962] R.P.C. 163 where the magazine title *Today* had been out of use for several years. See also *O'Gorman v Paramount Film Service* [1937] 3 All E.R. 113. This might cause particular difficulties if such titles are revived and re-enter the public domain as with a play title subsequently used in a film, *Raleigh v Kinematograph Trading Co* (1914) 31 R.P.C. 143 or *Houghton v Film Booking Offices* (1931) 48 R.P.C. 329; see as well *Loews v Littler* (1955) 72 R.P.C. 166.

20 *In Ridgeway Co v Amalgamated Press* [1911] R.P.C. 130 for example and in *Ridgeway Co v Hutchinson* (1923) 40 R.P.C. 335, limited circulation was the decisive element for failure of the claim. See as well *Walter v Emmot* (1885) 53 L.T. 437, CA; *Thomson v Kent Messenger* [1975] R.P.C. 191; *Marcus Publishing v Hutton-Wild*, n.17 above; *Advance Magazine Publishing v Redwood Publishing* [1993] F.S.R. 449; *Local Sunday Newspapers v Johnston Press* [2001] WL 825694 (Ch. D.); *George Outram & Co v London Evening Newspapers Co* (1911) 28 R.P.C. 308.

21 See generally *Anheuser-Busch v Budejovicky Budvar* [1984] F.S.R. 413, CA; *Alain Bernadin v Pavilion Properties* [1967] R.P.C. 581; and Ongley J. in *Greene v Broadcasting Corp of New Zealand*, High Court Wellington, December 22, 1983, A662/79 (first instance).

22 The principal authority is *Erven Warnink v Townend & Sons (Hull)* [1979] A.C. 731 at 775. Note the moderate application in *Jian Tools for Sales v Roderick Manhattan Grou*p [1995] F.S.R. 924.

films, music or books in one national market and, if successful, releasing them country by country.[23]

The resulting number of titles not enjoying sufficient goodwill in the market provokes the question whether the goodwill/reputation requirement is at all an appropriate concept for titles. The title *Moby Dick*, for example, identifies a story about a white whale rather than the product "book" or the publishing house issuing it. The situation becomes particularly clear in respect of film titles: who identifies a particular distribution or production company by looking at titles such as *Star Wars*, *The Empire Strikes Back* or *James Bond*?[24] The adventures of Luke Skywalker and 007, by contrast, spring to mind immediately. Even English courts, denying—notably—trade mark protection, held that the word "Tarzan" would identify a film about "a man of great strength and ability" and not the source of the film.[25] In this regard, the practice of many publishing houses of affixing their business names and/or trade marks next to the book title does not come as a surprise. Only under certain circumstances, it appears, such as with newspapers[26] or serial books,[27] are titles capable of resembling trade origin and also of indicating the source of a work. Against that background, it seems that the goodwill/reputation test, measuring the relation between a trader and his customers[28]—*i.e.* essentially trade origin—developed for trade marks and business names which indeed indicate trade origin, is not fully compliant with titles that only rarely fulfil such a task. In a way, passing off appears only to protect titles that have been converted into trade names. In other words, the goodwill/reputation requirement disregards the important function of titles as identifiers of nothing more than a work, or, more radically, it prevents English law from giving any rights to titles *per se*.

Confusion

The second requirement of passing off is confusion and English courts take this seriously. Confusion means truly mistaking the works or their origin and any relaxed views about potential confusion or wider concepts, for example, confusion as to commercial connections between undertakings, appear not to be welcomed.[29] Anything that can be brought forward against confusion such as descriptiveness of titles, factual circumstances, and differences between works or their sources is scrutinised.

Part of the dilemma with titles in passing-off actions is their very nature to describe the works they denote. Descriptive titles lack inherent distinctiveness and that, naturally, reduces the scope of protection. Purely descriptive titles, typically book titles,[30] are not protected at all[31] and relatively small differences suffice to distinguish less descriptive titles from others.[32] The general view is that English law "is reluctant to allow ordinary descriptive words in the English language to be fenced off so as to become the private preserve of one particular publisher".[33] Among the many cases which have failed on that ground[34] are vast numbers of periodicals fighting desperate battles over terms such as "Morning" versus "Evening",[35] "Morning" versus "Daily"[36] or "Weekly" versus "Monthly".[37] Small differences such as the inclusion of additional words usually bar any finding of confusion[38] as for example in *Tamworth Herald* versus *Tamworth Herald and Post*[39] or *Sunday Post* versus *South East Sunday Post*.[40] Apart from newspaper titles, it is to be noted that naturally descriptive titles, such as for books, may encounter immense difficulties in acquiring goodwill. It has been held that "use, however long continued, of one of such titles cannot of itself prove the acquisition of a secondary meaning whereby the words initially used to identify the title of a book come to be regarded in the different sense of identifying not the work itself but the trade origin from which the physical embodiment of the work comes".[41] Here, we see the weaknesses of the goodwill/reputation test measuring trade origin surface again.

Being serious about confusion, English courts take into account a vast number of criteria such as appearance,[42] presentation,[43] content,[44] price,[45] readership or

23 Reuben Stone, "Titles, Character Names and Catch-Phrases in the Film and Television Industry: Protection under the Law of Passing Off" [1996] Ent.L.R. 263 at p.266.

24 According to Reuben Stone, *ibid.* at p.264, surveys in the United States show that only 6 per cent and 7 per cent of the public respectively in the United States can.

25 *Yorkshire Cooper Works Trade Mark Application* (1954) 71 R.P.C. 150.

26 See the newpaper cases discussed below.

27 *Games Workshop v Transworld Publishers*, n.9 above; *Morgan-Grampian v Training Personnel* [1992] F.S.R. 267*; The Pet Library v Ellason* [1968] F.S.R. 359.

28 In *IRC v Muller's Margarine* [1901] A.C. 217 at 223, goodwill has been described as "the attractive force which brings in custom".

29 See *Tamworth Herald Co v Thomson Free Newspapers* [1991] F.S.R. 337 and *Local Sunday Newspapers v Johnston Press*, n.20 above.

30 In *Mathiesen v Sir Isaac Pitman* (1930) 47 R.P.C. 541, the book *How to Appeal Against Your Rates* was held to be descriptive and without having acquired secondary meaning could not enjoy protection; similarly the title *Science and Health* in *Science and Health Trade Mark Application*, n. 8 above, at 345–346.

31 *Box Television v Haymarket Magazines* [1997] WL 1102580; *The Times*, March 3, 1997; *County Sound v Ocean Sound*, n.14 above; *Bailis & Co v Darlenko* [1974] R.P.C. 284.

32 See for example *Jian Tools for Sales v Roderick Manhattan Group*, n.22 above, at 938.

33 *Marcus Publishing v Hutton-Wild Communications*, n.17 above, at 579.

34 See the list in Christopher Wadlow, *The Law of Passing Off* (2nd ed., 1995), pp.417–419.

35 *Borthwick v Evening Post* (1888) 37 Ch. D. 449, CA.

36 *Morning Star Co-operative Society v Express Newspapers* [1979] F.S.R. 113.

37 *World Athletics and Sporting Publications v A.C.M. Webb* [1981] F.S.R. 27, CA.

38 However, in *Management Publications v Blenheim Exhibition Group* [1991] F.S.R. 550 at 555, confusion was established between the titles *Management Today* and *Security Management Today* because similar format and type-face were used.

39 *Tamworth Herald Co v Thomson Free Newspapers*, n.29 above.

40 *D.C. Thomson v Kent Messenger* [1975] F.S.R. 485.

41 *Science and Health Trade Mark Application*, n.8 above, at 345–346.

42 The size of the publication was distinguishing in *World Athletics and Sporting Publications v A.C.M. Webb* [1981] F.S.R. 27, CA, at 30 and in *Morning Star v Express Newspapers*, n.36 above, at 117.

43 *Tamworth Herald Co v Thomson Free Newspapers*, n.29 above, at 30; *Local Sunday Newspapers v Johnston Press*, n.20 above.

44 *World Athletics and Sporting Publications v A.C.M. Webb*, n.37 above.

45 *ibid.* at 30; *Bradbury v Beeton* (1869) 39 L.J. Ch. 348 referred to in *Kark (Norman) Publications Ltd v Odhams Press Ltd*, n.19 above.

method of sale.[46] Applying this approach, which has been developed and to some extent is justified for newspaper titles, to titles of other works without appropriate adoption may not, however, lead to convincing results. In respect of book or film titles for example, the content criterion is not of much significance because consumers usually make their buying decision before having read the book or seen the film but after having based their decision to buy on a confusingly similar title. The same applies to software. Also the method of sales criterion may have lost its significance in times of diversified entertainment outlets, internet and distance selling.

Traditionally, a successful passing-off claim also required that the businesses concerned share a common field of activity.[47] The comparison of businesses, once again, does not sit too comfortably with the subject-matter of titles which usually do not identify businesses. As a result, courts in practice appear rather to emphasise an analysis of the genres of the works, which is carried out without much flexibility. Apart from uses within identical categories such as book titles for books or video titles for videos,[48] a common field would not extend to more than novels,[49] plays[50] or sketches[51] and films made thereof. Confusion between song and film titles has been denied[52]; similarly confusion between magazine titles and titles of TV programmes.[53] *Vice versa*, titles of television series are not protected against uses on books[54] or magazines.[55] Any claims against uses of titles as trade marks on products,[56] as business names,[57] for events,[58] exhibitions[59] or for slightly different categories of works[60] will hardly succeed. Such an approach may not live up to the requirements of current practices of exploiting works and their titles across a wide range of products. Chart hits, books and magazines regularly accompany films and TV series, and films—apart from often being based on novels—are translated into video games and *vice versa*; the use of book and film titles on merchandise articles is the rule rather than the exception.

Finally, the confusion requirement is not a means capable of preventing dilution in the forms of tarnishing, blurring or otherwise taking unfair advantage of the good reputation of a title. Consequently, in the *Baywatch* case,[61] where the defendants used the title "Babewatch" for a sex series copying the setting and many features of the famous family series *Baywatch*, the court did not consider dilution and as for the rest denied passing off because no one would confuse both series as, first, they would be of very different content; secondly the sex series would be shown on an adult channel; thirdly, it would be shown in the early hours of the morning; and fourthly, it would be encrypted.[62]

Damages

The essential requirement of damages traditionally occurs in the form of loss of sales as a result of diverted customers, which can be assumed if the defendant passes off his goods as those of the claimant.[63] While more difficulties may arise if products are different, once goodwill/reputation and confusion have been established, courts seem to be, as a rule, more relaxed towards a finding of loss of prospective sales,[64] licensing revenues[65] or other types of damages, if such appear to be of sufficient substance.[66]

In conclusion, British courts apply traditional trade name concepts to titles without taking their different nature and functions into consideration. Disregarding

46 *Morning Star v Express Newspapers*, n.36 above; see *Management Publications v Blenheim Exhibition Group*, n.38 above. Another frequent argument in respect of periodicals is that the reader buys his newspaper or magazine regularly and knows it well enough to distinguish it even from identical or closely similar titles.

47 *Harrods v Harrodian School* [1996] R.P.C. 697, CA; *Stringfellow v McCain Foods (GB)* [1984] R.P.C. 501; see also *Lego Systems v Lego M Lemelstrich* [1983] F.S.R. 687.

48 *Labyrinth Media v Brave World* [1995] E.M.L.R. 38.

49 *Cheyney v Rialto Productions* (1936–1945) in *MacGillivray's Copyright Cases* at p.386, cited by Reuben Stone, n.23 above, at fn.67.

50 *Raleigh v Kinematograph Trading*, n.19 above. In *Twentieth Century Fox v Gala Film Distributors* [1957] R.P.C. 105 confusion was considered.

51 *Samuelson v Producers* (1931) 48 R.P.C. 447.

52 *Francis Day & Hunter v Twentieth-Century Fox*, n.3 above.

53 *Newsweek v BBC* [1979] R.P.C. 441. In this case, however, a common field of activity was accepted at 443 in the form of "news provision services". Hong Kong courts (*Television Broadcasts v Home Guide Publication* [1982] F.S.R. 505) and Australian courts (*Hexagon v Australian Broadcasting Commission* [1976] R.P.C. 628) are one step ahead and apply passing off in respect of magazines copying TV programme titles or TV series using a film title. In *Nicholas v Borg* [1987] A.I.P.C. 90–366 the Supreme Court of South Australia prevented the promotion of wines using the title of the Melbourne Cup yacht race.

54 In *Grundy Television Pty Ltd v Startrain Ltd* [1988] F.S.R. 581 a "Neighbours Who's Who" accompanying the TV soap opera *Neighbours* could not be prevented; in *BBC v Celebrity Centre Productions* (1988) 15 I.P.R. 333, the "A-Z of Eastenders" could not be prevented by the creators of the TV series *Eastenders*.

55 *Television Broadcast v Home Guide Publication* [1982] F.S.R. 505.

56 *Nicholas v Borg*, n.53 above.

57 An example is provided by *Henry Blacklock & Co v Bradshaws Publishing Company* [1926] R.P.C. 97.

58 *Morecambe & Heysham v Mecca* [1962] R.P.C. 145 and [1966] R.P.C. 423; *Miss World (Jersey) v James St Productions* [1981] F.S.R 309, CA; *Hulton Press v White Eagle Youth Holiday Camp* [1951] R.P.C. 126.

59 *Associated Newspaper v Lew Barclay Exhibitions* (1955) 72 R.P.C. 278; *Technical Productions v Contemporary Exhibitions* [1961] R.P.C. 242.

60 Titles of plays used for films, as in *Twentieth Century Fox Film Corporation v Gala Film Distributors*, n.50 above, or film titles used for TV series, as in *Hexagon v Australian Broadcasting Commission*, n.53 above, or TV series titles used for books, as in *Grundy Television v Startrain*, n.54 above, or magazines, as in *Television Broadcast v Home Guide Publication*, n.55 above and *vice versa*, magazine titles for TV series, as in *Newsweek v BBC*, n.53 above.

61 *Baywatch Production Co v The Home Video Channel*, n.9 above.

62 *ibid.* at 28 and 31.

63 *Kerly's Law of Trade Marks and Trade Names*, n.15 above, at 14_30; see in respect of titles *Labyrinth Media v Brave World*, n.48 above.

64 *Alan Kenneth McKenzie Clark v Associated Newspapers* [1998] R.P.C. 261.

65 *Mirage Studios v Counter-Feat Clothing* [1991] F.S.R. 145.

66 *Local Sunday Newspapers v Johnston Press*, n.20 above, at 3.

differences between titles primarily identifying works and trade names which, in turn, primarily identify trade origin, however, leads to a minimised scope of protection, leaving many titles open to copying. British courts, applying passing off as narrowly as it was once defined, preserve a characteristically nineteenth-century approach[67] and run the risk of producing higher and higher heaps of rejected claims[68]—many already failing at the interlocutory stage—which at the same time discourages future actions and further perpetuates stagnation as the permanent feature in this area of law.

France: Copyright in Titles[69]

Turning the position in the United Kingdom upside down, in France titles are perceived as integral parts of their designated works and, in sharp contrast to the strict denial of title copyright in English law, the French Code de la Propriété Intellectuelle 1992[70] explicitly awards copyright to titles. The first sentence of Art.L.112-4 protects titles "in the same way as the work itself where it is original in character"; the second sentence provides complementary anti-confusion protection for non-original titles.[71] Distinctive titles may also become trade marks.[72] It has been held, however, that titles identify works of the mind rather than products.[73] Use of a trade mark as a title may therefore not infringe the mark because identifiers of works and identifiers of products are unlikely to be confused[74]—a necessary consequence maybe of the notion that titles are integral parts of their designated works or, as the court put it, a trade mark "n'est pas de même du titre qui, l'identifiant en tant qu' 'oeuvre de l'esprit par excellence', procède de son essence et fait partie intégrante de sa personnalité",[75] which is an interesting contrast, however, to English law awarding protection to titles only if they display trade mark significance.

Original titles: imprints of the author's personality

Copyright subsists in titles which are original. This means the title, just as any other work, must bear the imprint of the author's personality—"l'empreinte de la personnalité de son auteur".[76] The work must be an expression of the author's personality, his talent and creative-intellectual power[77] which indeed shines through all great pieces of art such as Monet's water lilies, Voltaire's writing or Bizet's compositions—high art, the principal subject-matter of French copyright law. It is, however, as in the United Kingdom, more challenging to detect an author's talent and creative-intellectual power in a couple of ordinary words which form a title. Taking these difficulties into account, French courts allow for a less demanding standard of originality with respect to titles than that which would apply to the designated work itself.[78] This permits protection of short but somehow fanciful titles, for example *Les liaisons dangereuses*[79] or *Vol de nuit*,[80] as original literary creations. Volume *per se* shall not limit legal protection of artistic achievements.[81] Accordingly, copyright may subsist in the shortest of titles such as *Hors Ligne*[82] or *Le Chardon*.[83] However, parallels with the reluctance of awarding copyright to short titles or even single words such as under English law may play a role when single word titles such as *Rififi*[84] or *Essentiel*[85] are rejected. A certain degree of unease and scepticism[86] seems to prevail in respect to the proposition of having sufficient traces of an author's personality in short fragments or single words.[87]

67 Christopher Wadlow, *The Law of Passing Off* (2nd ed., 1995), p.417.
68 See an overview in Christopher Wadlow, *ibid.* at pp.417–426 and *Kerly's Law of Trade Marks and Trade Names*, n.15 above, at pp.500–503.
69 See generally Valancogne in *Le titre de roman, de journal, de film: sa protection* (1963).
70 In the following all references to Art.L.112-4 mean the Article of the French Code de la Propriété Intellectuelle.
71 Art.L.112-4 states: "Le titre d'une oeuvre de l'esprit, dès lors qu'il présente un caractère original, est protégé comme l'oeuvre elle-même. Nul ne peut, même si l'oeuvre n'est plus protégée dans les termes des articles L.123-1 à L.123-3, utiliser ce titre pour individualiser une oeuvre du même genre, dans des conditions susceptibles de provoquer une confusion." That means, translated by WIPO: "The title of a work of the mind shall be protected in the same way as the work itself where it is original in character. Such title may not be used, even if the work is no longer protected under Articles L.123-1 to 123-3, to distinguish a work of the same kind if such use is liable to create confusion."
72 In respect of European law it is, however, as in the United Kingdom, doubtful whether use of a trade mark as a title constitutes trade mark use and infringes; see ECJ, Case C–2/00 *Hölterhoff;* and *Arsenal v Reed*, n.10 above.
73 Court of Appeal (Cour d'Appel, in the following: "CA") Paris, 4e ch. 2 oct. 1996: RIDA 2/1997, p.280.
74 *ibid.* at 285.
75 "It is not the same as the title which, identifying the work *par excellence*, realises its essence and is part of its character." *ibid*.
76 Regional Court (Tribunale de Grande Instance, in the following: "TGI") Paris, 4e ch., 20 nov. 1996: RIDA 1997, n.173, p.321, obs. Kéréver; TGI Paris, 4e ch., 1 mars 1993: RIDA 1993, n. 157, p.335; TGI Nanterre, 10 mars 1993: RIDA 1993, n.157, p.343; and see comments in the Code de la Propriété Intellectuelle, L.112-4, pp.101–102 for further examples.
77 See Comments to the Code de la Propriété Intellectuelle, L112-4, p.102 with extensive quotations of judgments.
78 TGI Paris, 27 janv. 1984: D. 1984, inf.rap. p.285, obs. Colombet, cited in the Comments to the Code de la Propriété Intellectuelle, L112-4, p.104.
79 English equivalent: Dangerous Liaisons; CA Paris, 1e ch., 4 avr. 1960: JCP G 1960,II, 11659, concl. Combaldieu; D.1960, p.535, note Desbois cited in Lucas and Lucas, *Propriété Littéraire et Artistique* (2001), p.102.
80 English equivalent: Night flight; TGI Nanterre, 28 avr. 1998: PIBD 1998, 658, III, 385 cited in Code de la Propriété Intellectuelle 1992, p.104.
81 Lucas and Lucas, n.79 above, at p.102.
82 English equivalent: Out of the Line; CA Paris, 4e ch., 20 sept.1994: RIDA 2/1995, p.362.
83 English equivalent: The Thistle; CA Paris, 1e ch.,25 sept. 1989: RIDA 2/1990, p.207.
84 French Supreme Court (Court de Cassation, in the following: "Cass"), 1er civ., 15 nov. 1989: Juris-Data n.003524.
85 CA Paris, 1er ch., A, 25 janv. 1993: D. 1993, inf.rap., p.129.
86 See for the word "blues", TGI Paris, 7 mars 1990: Juris-Data n.042841.
87 See Lucas and Lucas, n.79 above, at p.102 and TGI Paris, 13 juill. 1989: Juris-Data n.042828 for "*bide centenaire*", English equivalent: Flop of the century.

Descriptive titles provide us with another problem area. Traces of an author's personality imprinted on titles such as *Paris pas cher*,[88] *Les saisons de la danse*,[89] *Aujourd'hui Madame*[90] or in *Dictionnaire de l'Académie francaise*[91] are not obvious to everyone and it is in respect of such less fanciful, short and descriptive titles that the decision practice of the courts in France becomes diffuse. The title *Ces chers disparus*,[92] for example, has not been held original but rather banal, being an ordinary expression which has been in common use for years.[93] Similarly, the title *La Gagne*[94] has been deemed banal rather than original because it is a popular expression and the claimant would not have given it any particular meaning apart from the one that is commonly known.[95] No original character has been found in the title *Doucement les basses*, a common expression in Parisian argot at that time[96] or in titles such as *Gueule d'amour*,[97] *Education anglaise*,[98] *Les maîtres du temps*[99] and *Les brigades du tigre*.[1] By way of direct comparison however, it is difficult to understand what separates these banal titles from their original counterparts such as *Paris pas cher*,[2] *Les saisons de la danse*,[3] *Val Infos*,[4] *Charlie Hebdo*[5] and *Express Documents*.[6] A good example of the ambivalence towards descriptive titles is represented by the case of *Microfor v Le Monde*[7] where Microfor listed in an index titles of French newspapers, including "le monde" and "le monde diplomatique", and titles of individual articles. While the Court of Appeal held that said periodical titles but also titles of individual articles such as "M. Chirac présente à M. Mitterrand la liste de son gouvernement"[8] or "Sri-Lanka: 7000 morts en trois ans",[9] were "sober, compressed and nevertheless explicit"[10] and therefore original, the Advocate General expressed some reservation,[11] and the Supreme Court finally avoided the question and held that even if such titles were protected, reproduction for the purpose of designating the original publications would not impair the exploitation right and therefore be outside the scope of the title right.[12]

In summary, living up to a strict understanding of titles as integral parts of works and, as a result, expressly awarding copyright to titles may cause inconsistencies in respect of short and descriptive titles and facilitate the award of copyright where an author's personality —if at all—is imprinted only faintly. After all, titles in France, as everywhere else, are often short, banal and descriptive. Such titles may indeed not be the material in which even smallest imprints of an author's personality can be engraved. Easy access to hard copyright may, compared to other works, result in unjustified overprotection.

Non-original titles: confusion within the same genre

Complementary anti-confusion protection evolved from unfair competition law[13] and has been cast in the second sentence of Art.L.112-4. It covers non-original titles which distinguish a work of the same genre if such use is liable to create confusion. While determining similarity of titles appears not to cause major headaches,[14] the application of the expression "same genre" is not without difficulty as it is colourful and has no clear contours. From many judgments it appears that it is the content of a work which defines its genre. In the *Le Chardon* case the court did not encounter difficulty in finding that two political publications were within the same genre.[15] In *Les liaisons dangereuses* it was held that a film and a novel, despite the different artistic formats, may still belong to the same genre, if the pictures, dialogues, and scenes of the film illustrate the same text, the same thought and the same plot as contained in the novel.[16] In *Doucement les basses*, the court denied that a police novel could share the genre with a film representing a "burlesque" comedy.[17] *Vice versa*, the absence of

88 English equivalent: Paris not expensive; TGI Paris, 3e ch., 7 mai 1987: Cah.dr.auteur, janv.1988, p.15.
89 English equivalent: Dance Seasons; CA Paris, 4e ch.B, 15 déc. 1995 : Juris-Data n.025032.
90 English equivalent: Today Madam; CA Paris, 4e ch.A, 13 févr. 1991: Juris-Data n.021393.
91 English Equivalent: Dictionary of the French Academy; Cass. 28 floréal an XII: cited in D. Jurisprudence générale, T.38, 1857, V° Propriété littéraire, n.106, cited in the Comments to the Code de la Propriété Intellectuelle, L112-4, p.104.
92 English equivalent: The Deceased Loved Ones.
93 CA Paris, 4e ch., 2 oct. 1996: RIDA 2/1997, pp.280–283.
94 English equivalent: The Gain.
95 TGI Paris, 3e ch., 6 mai 1987: RIDA 4/1997, pp.213–215.
96 TGI Paris, 3e ch., 15 juin 1973: RIDA 1/1973, pp.151–152.
97 English equivalent: Loving Face; Cass.civ., 2 févr. 1937: DP 1938, 1, p.97, note Desbois.
98 English equivalent: English Education; CA Paris, 4e ch.A, 23 janv. 1995: Juris-Data n.020042.
99 English equivalent: The Masters of the Times; TGI Nanterre, 28 juin 1995: RD propr.intell., déc. 1995, p.52 cited in Lucas and Lucas, n.79 above, at p.102.
1 English equivalent: The Tiger Brigades; TGI Paris, 1e ch., 11 déc. 1996: Juris-Data n.046941.
2 TGI Paris, 3e ch., 7 mai 1987: Cah.dr.auteur, janv. 1988, p.15 cited in Lucas and Lucas, n.79 above, at p.102.
3 CA Paris, 4e ch.B., 15 déc.1995: Juris-Data n.025032.
4 CA Paris, 4e ch. 24 oct. 1994: RD propr.intell., juin 1995, p.47 cited in Lucas and Lucas, n.79 above, at p.102.
5 CA Paris, 4e ch., 25 oct 1995: Legipresse 1995, III, p.149 cited in Lucas and Lucas, n.79 above, at p.102.
6 CA Paris 1e ch.A., 30 juin 1999, Juris-Data n.107160.
7 Cass.ass.plén., 30 oct. 1987: RIDA 1/1988, p.78.
8 English equivalent: Mr Chirac presents the list of his government to Mr Mitterrand.
9 English equivalent: Sri-Lanka: 7,000 dead in three years.
10 "Sobres, condensés et néanmoins explicites", cited in Cass.ass.plén., 30 oct. 1987: RIDA 1/1988, p.78 at p.82.
11 Cass.ass.plén., 30 oct. 1987: RIDA 1/1988, p.78 at pp.81–82.
12 *ibid.* at 93.
13 Art.L.112-4 evolved from unfair competition law concepts formerly contained in Art.5 of the Law of March 11, 1957 (la loi du 11 mars 1997). The second sentence of Art.L.112-4, the *sui generis* right against confusion, often absorbs a complimentary application of Art.1382 of the French Civil Code and unfair competition concepts ("concurrence déloyale")—see for example TGI Paris, 3e ch.,15 juin 1972: RIDA 1/1973, p.151.
14 The Comments to the Code de la Propriété Intellectuelle, L112-4, p.105 provide as an example for a typical infringement the "Guide First des Magasins d'Usine" versus "Guide France des Magasins d'Usine".
15 CA Paris, 1e ch.,25 sept. 1989: RIDA 2/1990, pp.207–210.
16 CA Paris, 1er ch., 4 avr. 1960: JCP G 60, II, 11659, concl. Combaldieu; D. 1960, p.535, note Desbois.
17 TGI Paris, 3e ch., 15 juin 1973: RIDA 1/1973, pp.151–152.

common aspects between the content of a novel and a theatre play was a considerable aspect for denying a common genre in the *La Gagne* case.[18] The more recent *Débandade* decision states that works from different arts, *i.e.* film and essay, may still belong to the same genre unless their content, here fiction and sociological science, "appeals to different 'registers'".[19] Examining thoroughly the content of the works in question, French judges share with their British colleagues the disadvantages of this criterion, which is disregard of the fact that confusion usually takes place before the consumer is in a position to absorb the content of the work.[20] A consumer with an intimate knowledge of the works in question will hardly be confused.

More interesting, however, is the nature of the anti-confusion provision. Although not clearly spelled out, three basic elements can be identified: the use of (1) similar titles for (2) works of the same genre if such use is (3) liable to create confusion. In a way, these requirements mirror concepts developed for trade marks,[21] for example in Art.5 of the Trade Marks Directive[22] which prevents the use of a sign where, because of (1) similarity of the signs and (2) similarity of the goods there exists (3) a likelihood of confusion. The obvious difference is the replacement of the similarity of goods test by a same-genre test. Remarkably, in France the shortfalls of copyright laws give way to trade-mark-like concepts that arose from a general unfair competition law basis.

Germany: The Title Mark

As in France, German unfair competition law has long recognised anti-confusion protection of titles.[23] German law, however, has been developed one step further and a *sui generis* right to a title which is shaped along typical trade mark concepts has been introduced.[24] Consequently, it is to be found in §§5, 15 of the German Trade Marks Act 1994[25] rather than in a copyright statute. Titles are understood basically as identifiers of works[26] compared to identifiers of trade origin or copyright works. Paralleling trade mark rights, distinctive titles enjoy protection against direct and indirect confusion, and well-known titles are further protected against dilution.

The close relationship between titles and works, however, is not denied as categorically as under English law. In principle, German law recognises that copyright, as in France, may subsist in titles. Like any other copyright work, however, titles must be individual intellectual creations,[27] which means they must, as in the United Kingdom, at least afford some information[28] and, as in France, bear the stamp of the author's individuality.[29] The information requirement, however, is not used as a doctrine to bar short titles *per se*, as in the United Kingdom, and the requirement for imprints of the author's individuality is not blurred by particularly low standards for titles, as in France. The result is that, in practice, despite the theory of copyright in titles, these demanding requirements are rarely met.[30] Usually, titles are held to be too short or too descriptive to express independent intellectual content or the individuality of an author.[31]

18 TGI Paris, 3e ch., 6 mai 1987: RIDA 4/1997, pp.213–215.

19 TGI Paris, 3e ch., 30 juin 2000, RIDA 2/2000, p.311.

20 See also Lucas and Lucas, *Propriété Littéraire & Artistique* (1994), p.114.

21 *ibid.*

22 First Council Directive 89/104 of December 21, 1988 to approximate the laws of the Member States relating to trade marks.

23 Before 1994 titles of publications were protected by §16 of the German Unfair Competition Act. Additional protection against unfair uses of titles in the course of business is provided in §§1, 3 of the current German Unfair Competition Act and in exceptional circumstances the general name right in §12 of the German Civil Code (*Bürgerliches Gesetzbuch* or BGB), tort law under §§823, 826 BGB, or provisions concerning business names, contained in § 30 of the Commercial Code (*Handelsgesetzbuch* or HGB), may apply.

24 Compare for example the similar structures of §§14 and 15 of the German Trade Marks Act 1994.

25 In the following all references to Articles are made to Articles of the German Trade Marks Act 1994. §5(1) and (3), translated by the World Intellectual Property Organization ("WIPO"), state: "*Commercial Designations:*(1) Company symbols and titles of works shall be protected as commercial designations.(3) Titles of works are the names or special designations of printed publications, cinematographic works, musical works, dramatic works or other comparable works." §15, translated by WIPO, states: "*Exclusive Right of the Proprietor of a Commercial Designation; Injunctive Relief; Damages:* (1) The acquisition of protection for a commercial designation shall confer on its proprietor an exclusive right. (2) Third parties shall be prohibited from using in the course of trade, without authorization, the commercial designation or a similar sign in a manner capable of causing confusion with the protected designation. (3) Where the commercial designation has a reputation in this country, third parties shall also be prohibited from using the commercial designation or a similar sign in the course of trade if there is no risk of confusion within the meaning of subsection (2), where the use of that sign without due cause takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the commercial designation. (4) Any person who uses a commercial designation or a similar sign in breach of subsections (2) or (3) may be sued by the proprietor of the commercial designation to enjoin such use. (5) Any person who undertakes such infringing action intentionally or negligently shall be liable for compensation to the proprietor of the commercial designation for damage suffered therefrom. (6) Section 14(7) shall apply *mutatis mutandis*."

26 As defined in §5(3).

27 §2 of the German Copyright Act 1965;

28 See the German Federal Supreme Court (Bundesgerichtshof, in the following "BGH") in BGHZ 18, 175/177—*Werbeidee*; BGHZ 39, 306/308—*Rechenschieber*; and Schricker, *Urheberrecht* (1999), §2 n.19.

29 See for example BGH in GRUR 1992, 382, 385—*Leitsätze*; BGH in GRUR 1991, 449, 451—*Betriebssystem*; BGH, GRUR 1977, 543—*Der 7. Sinn*; and Schricker, n.28 (2nd ser.) above, at §2, nn.23–40.

30 German Reichsgericht (in the following "RG") in RGZ, 123, 120—*Brücke zum Jenseits*; BGH, GRUR 1960, 346—*Naher Osten*; *Der 7. Sinn*, n.29 (2nd ser.) above; Regional Court (Landgericht, in the following "LG") Cologne, AfP 1973, 489—*Das verwaltete Elend unserer Städte: Obdachlosigkeit*; Court of Appeal in Berlin (Kammergericht, in the following "KG") Berlin, UFITA 10 (1937) 182—*Krach um Jolanthe*. A rare exemption is the decision under the old law of Court of Appeal (Oberlandesgericht, in the following "OLG") Cologne, GRUR 1962, 534—*Der Mensch lebt nicht vom Lohn allein*.

31 Schricker, n.28 (2nd ser.) above, at §2:70. Fezer, *Markenrecht* (2001), §15:179. This might be different for the graphical design of the letters of titles or for picture or sound titles; see Schricker, n.28 (2nd ser.) above, at §2:71. As in France and the United Kingdom, the German Reichsgericht considered in GRUR 1937, 953—*Leichte Kavalerie*, and the BGH in BGHZ 26, 52, 60—*Sherlock Holmes* that titles may be protected as parts of the copyright work.

Parallel to the practice in the United Kingdom, trade mark registrations—apart from newspaper,[32] magazine[33] or serial titles[34] which clearly express trade mark significance—for single book or film titles have been rejected as being merely descriptions of the work's content.[35] While under the new trade mark regime it may become easier to obtain registration for single titles,[36] the main resort of protection remains the comprehensive title right in §§5, 15.

Definition of titles and works

§5(3) defines titles as "names or special designations of printed publications, cinematographic works, musical works, dramatic works or other comparable works". The function of identifying works and distinguishing them from others[37] requires that titles, just like trade marks, are distinctive in respect to the work identified. It is not necessary, however, that titles, as required under English law, also indicate trade origin such as the source of the work or the author.[38] As a result, German courts, just as their French counterparts, are comfortable with separate rights in subtitles[39] and titles of newspaper articles.[40] Furthermore, the term "works" is not confined to copyright works[41] but covers any intangible result of intellectual activity.[42] Products, however, for example the colourful front side of an Easter calendar, are not the result of such an intellectual activity.[43] As in France, there appears a fine line between identifiers of products, trade marks, and identifiers of works, titles. The distinction however is not an easy one. While games such as bridge, Monopoly or computer games have been cited as examples for works capable of bearing titles,[44] title protection has been refused in the case of a simple magnetic fishing game like Go-Fisch.[45] Software, on the other hand, has been recognised as a work.[46] Identifiers of events such as trade fairs may be both titles[47] and/or ordinary business names[48] while designations of concerts have been considered for title protection.[49]

Just like trade marks, titles enjoy priority, as is defined in §6 similarly for both. The priority date is the day of first use or, in the case of descriptive titles, the date secondary meaning has been acquired. Moreover, an established and legally recognised[50] trade practice secures investments in works in process even prior to first use. All an author or publishing company must do is to publish the title and the prospective kind of work on which it will be used in the foreseeable future in a journal called the *Title Gazette*.[51] If the title is indeed used within the envisaged time frame, such publication will establish priority from the date of publication in the *Title Gazette*.[52] The foreseeable future means in practice approximately six months for printed matter and up to two years for films.[53] Substantial investment in long-term projects and their titles, for example in respect to cost-intensive film production, will, unlike in the United Kingdom, not be at risk.

Likelihood of confusion

Likelihood of confusion in respect of titles is very much determined as it is for trade marks. It depends on three interdependent factors: (1) the degree of distinctiveness of the prior title; (2) the similarity of titles; and (3) the similarity of works.[54] As with trade marks, lack of distinctiveness reduces the scope of the right and, *vice versa*, a high degree of distinctiveness boosts it.[55] In respect of the very character of titles, being descriptions of works, even the slightest degree of distinctiveness may suffice to bring titles within the scope of protection. Newspaper titles such as *German Newspaper*,[56] *Berlin Newspaper*,[57] or *Morning Post*,[58] magazine titles such as *Wheels Magazine*,[59] *Szene*[60] or *Facts*[61] and non-fiction book titles such as *Pizza&Pasta*[62] enjoy protection—a rather relaxed approach which English courts might not necessarily want to adopt. As in the United Kingdom,

32 BGH, GRUR 1956, 376, 377—*Berliner Illustrierte Zeitung*; German Federal Patent Court (Bundespatentgericht, in the following "BPatG") in GRUR 1996, 980—*Berliner Allgemeine*.
33 BGH, GRUR 1957, 29—*Spiegel*; BGH, GRUR 1961, 232, 233—*Hobby*; BPatG, GRUR 1998, 718—*Luftfahrtwoche*; BpatG in BPatGE 28, 44, 48—*Business Week*.
34 BpatG, GRUR 1998, 51—BGHZ; BGH, GRUR 1988, 377—*Apropos Film I*; BGH, GRUR 1993, 769—*Radio Stuttgart*; BGH, GRUR 1994, 908—*Wir im Südwesten*; BGH, GRUR 1982, 431—*Point*.
35 BGH, GRUR 1958, 354—*Sherlock Holmes*; BGH, GRUR 1958, 500—*Mecki Igel*; OLG Dresden, JW 1926, 1242—*Struwwelpeter*.
36 See BpatG, GRUR 1997, 832—*Bücher für eine bessere Welt*; BpatG, GRUR 1998, 51—BGHZ; BpatG, GRUR 1998, 145—*Klassentreffen*; Deutsch and Mittas, *Titelschutz* (1999), p.81.
37 Deutsch and Mittas, n.36 (2nd ser.) above, at p.3; defined under the old law in BGH, GRUR 1990, 218, 219—*Verschenktexte I*; *Sherlock Holmes*, n.35 (2nd ser.) above; BGH, GRUR 1959, 45, 46—*Deutsche Illustrierte*.
38 Fezer, n.31 (2nd ser.) above at §15₁57m.
39 BGH, GRUR 1990, 218—*Verschenktexte*; see RGZ in RGZ 133,189, 190—*Kunstseiden-Kurier* and BGH, GRUR 1970, 141—*Europharm*.
40 OLG Hamburg, WRP 1977, 649 and BGH, GRUR 1979, 566—*Metall Zeitung*.
41 *Der 7. Sinn*, n.29 (2nd ser.) above.
42 BGH, GRUR 1993, 767—*Zappel-Fisch*.
43 OLG Düsseldorf, GRUR 1992, 327—*Osterkalender*.
44 *Zappel-Fisch*, n.42 (2nd ser.) above.
45 *ibid.*
46 BGH in BGHZ 135, 278—*PowerPoint*; BGH, WRP 1998, 877—*WINCAD*; BGH, GRUR 1997, 902—*FTOS*.
47 LG Düsseldorf, WRP 1996, 156—*Paracelsus Messe*.
48 BGH, GRUR 1988, 560—*Christopherus Stiftung*; KG Berlin, WRP 1980, 409—*Intercity*.
49 BGH, GRUR 1989, 626—*Festival Europäischer Musik*.
50 BGH, GRUR, 1989, 760—*Titelschutzanzeiger*.
51 Titelschutzanzeiger; *www.titelschutzanzeiger.de*.
52 *Titelschutzanzeiger*, n.50 (2nd ser.) above.
53 See OLG Munich, GRUR 1955, 436—*An der schönen blauen Donau*.
54 BGH, judgment of March 1 2002, I ZR 205/98 and I ZR 211/98—*Tagesschau*; *Der 7. Sinn*, n.29 (2nd ser.) above, at 546; BGH, GRUR 1957, 29, 31—*Der Spiegel*.
55 *Der 7. Sinn*, n.29 (2nd ser.) above, at 546; *Der Spiegel*, n.54 (2nd ser.) above, at 31.
56 BGH, GRUR 1963, 378—*Deutsche Zeitung*.
57 BGH, GRUR 1997, 661—*Berliner Zeitung*.
58 BGH, GRUR 1992, 547—*Morgenpost*.
59 BGH, GRUR 1999, 235—*Wheels Magazine*.
60 BGH, GRUR 2000, 71—*Szene*.
61 BGH, GRUR 2000, 504—*Facts*.
62 For example *Pizza&Pasta* for a cookery book in BGH, GRUR 1991, 153—*Pizza&Pasta*.

purely descriptive titles[63] remain unprotected, such as *European Classics* for music CDs containing European classic music,[64] but, having regard to the title *Pizza-&Pasta* for a cookery book, it is not always clear where the line is drawn.[65] If slightly descriptive titles are covered by the title right, the scope of protection enjoyed will, however, be—in accordance with the practice of English courts—rather narrow and, as across the Channel, the slightest differences in appearance, get-up and sales methods can suffice to bar confusion.[66]

What provides more comfort under German law is the fact that inherently distinctive titles or titles that have acquired distinctiveness through use enjoy much broader protection against similar titles than judges in the United Kingdom would be prepared to accept. First of all and differently from the approach in the United Kingdom[67] and in France,[68] the content of the works in question is irrelevant for determining confusion.[69] §15 protects the title and not the work. The city magazine *Blitz*, distributed free of charge in four cities, for example, has been held to cause confusion with a national yellow press magazine of a broadcasting company.[70] Furthermore, titles that have acquired a reputation and therefore also identify the source of the work enjoy additional protection of a kind that is not available under English law. Such titles are not only protected against confusion in the narrow sense of mistaking one work or business for another, but also against confusion in a wider sense which means any assumption that the businesses issuing the works would be connected by licences, co-operation agreements or otherwise.[71]

Similar or identical titles for works of the same genre will usually, as in France, constitute a likelihood of confusion. In contrast to French and English law, however, title protection can extend further and also cover works in different genres such as different film genres, for example educational or feature films.[72] Accordingly, French cases such as *Débandade*[73] or *Doucement les basses*[74] might have been decided differently in Germany. Arguably also the *Newsweek* case in the United Kingdom[75] would have been decided differently in Germany where similar titles for TV programmes and magazines[76] can be confused just as can similar titles of TV programmes and films,[77] books,[78] music records[79] or games.[80] Confusion has been found between titles of books and films,[81] books and radio programmes,[82] magazines and radio programmes,[83] novels and plays[84] or between plays and films.[85] Moreover, and once again in contrast to English law, the use of titles on products or for businesses may constitute infringement. The Federal Supreme Court prevented the title "The Seventh Sense" for a television programme dealing with road safety being used for a traffic game of dice. The radio programme title "Point" could not be used for a discotheque.[86] *Vice versa*, a company name may be infringed by a title.[87] The far-reaching approach towards confusion ends, if no indication whatsoever of any commercial connections between the parties is present.[88] Examples are the word "Max" for a fashion magazine and shoes[89] or "Brigitte" for a magazine and a partner agency.[90]

Dilution

As a consequence of the envisaged parallel structure of title and trade mark rights, anti-dilution provisions have been introduced also for titles. The optional protection for well-known trade marks under Art.5(3) of the Trade

63 BGH, GRUR 1993, 488—*Verschenktexte II*.
64 OLG Cologne, NJWE-WettbR 2000, 93—*European Classics*.
65 See the exhaustive list of distinctive and non-distinctive titles in Deutsch and Mittas, n.36 (2nd ser.) above, at pp.43–45 and note that older decisions were generally less relaxed; see OLG Stuttgart, GRUR 1951, 38—*Das Auto*; OLG Oldenburg, GRUR 1987, 127—*Sonntagsblatt*; KG Berlin, GRUR 1988, 158—*Who's who*.
66 BGH, GRUR 1975, 604—*Effecten-Spiegel*; *Morgenpost*, n.58 (2nd ser.) above; *Facts*, n.61 (2nd ser.) above; *Pizza&Pasta*, n.62 (2nd ser.) above. Similarly the addition or change in a word counts against confusion such as in "Star Revue" versus "Revue" in BGH, GRUR 1957, 275—*Star Revue* or "German General Newspaper" versus "German Newspaper" in BGH, GRUR 1963, 378—*Deutsche Zeitung/Deutsche Allgemeine Zeitung*.
67 See *World Athletics and Sporting Publications v A.C.M. Webb*, n.37 (1st ser.) above.
68 See TGI Paris, 3e ch., 30 juin 2000, RIDA 2/2000, p.311. CA Paris, 1e ch.,25 sept. 1989: RIDA 2/1990, p.207/210; CA Paris, 1er ch., 4 avr. 1960: JCP G 60, II, 11659, concl. Combaldieu; D. 1960, p.535, note Desbois ; TGI Paris, 3e ch., 15 juin 1973: RIDA 1/1973, p.151/152 ; TGI Paris, 3e ch., 6 mai 1987: RIDA 4/1997, pp.213–215.
69 BGH, GRUR 1959, 182, 184—*Quick*; BGH, GRUR 1959, 360—*Elektrotechnik*; *Hobby*, n.33 (2nd ser.) above.
70 OLG Hamburg, MarkenR 1999, 99—*Blitz Magazin*.
71 For example the assumption that the title belongs to a serious of titles of a competing publishing house; see *Wheels Magazine*, n.59 (2nd ser.) above
72 KG Berlin, UFITA 2 (1929), 470—*Menschenleben in Gefahr*.
73 TGI Paris, 3e ch., 30 juin 2000, RIDA 2/2000, p.311.
74 TGI Paris, 3e ch., 15 juin 1973: RIDA 1/1973, p.151.
75 *Newsweek Inc v British Broadcasting Corporation*, n.53 (1st ser.) above.
76 LG Mainz, AfP 1992, 390, 391—*Ran*.
77 OLG Hamburg, UFITA 27 (1959)—*Kleine Leute—Große Reise*; OLG Hamburg, UFITA 50 (1969) 270—*Gangster bitte zur Kasse*; LG Hamburg, UFITA 38 (1962) 81—*Im Stahlnetz des Dr. Mabuse*.
78 OLG Munich, ZUM 1985, 218, 220—*Jetzt red i*; LG Munich I, AfP 1986, 255—*Das gab's nur einmal*.
79 OLG Munich, UFITA 50 (1967) 266, 269—*A weni kurz, a weni lang*.
80 *Der 7. Sinn*, n.29 (2nd ser.) above, at 546.
81 RGZ in RGZ 112,117, 118—*Liebesleben in der Natur*; *Sherlock Holmes*, n.35 (2nd ser.) above; OLG Munich, UFITA 23 (1957) 217—*Bis der Tod Euch scheidet*; OLG Munich, UFITA 21 (1956) 81—*Am Brunnen vor dem Tore*.
82 KG Berlin, FuR 1984, 529, 532—*Zu wahr um schön zu sein*.
83 LG Munich I, GRUR 1993, 500—*Super*.
84 LG Berlin, UFITA 3 (1930) 266, 269—*Der Kaiser von Amerika*.
85 OLG Munich, UFITA 22 (1956) 235, 237—*Der Herscher*; RGZ in 135, 209, 215—*Der Brand im Opernhaus*.
86 BGH, GRUR 1982, 431, 423—*Point*.
87 See the company name "Medical Publishing Company General" and the title "Medical General" in BGH, GRUR 1991, 331, 332—*Ärtzliche Allgemeine Verlagsgesellschaft/Ärtztliche Allgemeine*.
88 See BGH in BGHZ, 120, 228, 232—*Guldenburg*: no confusion between a television soap opera and drinks, foodstuffs and jewellery.
89 BGH, GRUR 1999, 581, 583—*Max*.
90 OLG Frankfurt, WRP 1004, 191—*Brigitte*.

Marks Directive[91] and its implementations in the United Kingdom,[92] France[93] and Germany[94] have been translated into the title provision of §15(3). As with trade marks, the right provides protection for well-known titles against uses that without due course take unfair advantage of, or are detrimental to, the distinctive character or the repute of the title. Anti-dilution protection subsists independently from any likelihood of confusion. The Munich Court of Appeal, for example, held that adopting and displaying the name "Dr. Sommer"—taken from the famous subtitle "Declare yourself to the Dr. Sommer Team", heading a famous agony column in a teenage magazine[95]—on merchandise articles of a punk rock band would constitute infringement.[96] Independently of any likelihood of confusion, the band would take unfair advantage of the repute of that well-known part of the title. Such broad protection is found neither in English nor in French law. The *Baywatch* case[97] in Britain, however, demonstrates its necessity. A German judge probably would have stopped the use of "Babewatch".

In order to come under dilution protection, titles, just like trade marks, must reach the echelon of a well-known sign. Taking the parallel structure of the rights into account, it is appropriate to interpret the term "well-known" in accordance with the guidelines given for well-known trade marks.[98] The European Court of Justice held that a trade mark which is known by a notable part of the public would be well-known.[99] German courts, more specifically, usually demand that 50 per cent of the relevant public know the trade mark.[1] In respect of titles, sales of 37,000 copies per month did not suffice in the case of a city magazine[2] and sales of one million copies over eight years did not suffice in the case of a cookery book.[3] Purely descriptive titles cannot be monopolised[4] and even very famous titles such as *News of the day*,[5] the flagship news programme of German television channel ARD, remain unprotected against uses of similar titles such as *Report of the day*[6] or *Picture of the day*.[7] In these cases, the Supreme Court held that television channels, which for a long time have been state monopolies, could not use their inherited market position to monopolise descriptive titles and deprive subsequent broadcasters of such descriptive but also very useful titles.[8] The news programme cases, however, may have turned on their particular set of facts. In principle, anti-dilution protection, independent from any confusion requirements, remains available to well-known titles.

Other European Countries

The legal position in other European jurisdictions oscillates between the poles laid out by the examples of English, French and German law. Independent copyright for titles, as in France, is explicitly recognised in the Copyright Act of Switzerland,[9] whereas Portugal[10] and Spain[11] recognise copyright in titles as parts of the designated works. Additional anti-confusion rights, independent of copyright, have been introduced in the Copyright Acts of Austria[12] and Italy.[13] The latter also contains a very convincing provision on titles of periodicals which are protected *per se* against reproduction in similar publications for the fixed term of two years; a

91 89/104.
92 s.10(3) of the UK Trade Marks Act 1994.
93 Art.L.713-5 of the French Code de la Propriété Intellectuelle.
94 §14(2) No.3 of the German Trade Marks Act 1994.
95 The German title: "Sprich Dich aus beim Dr. Sommer-Team".
96 OLG Munich, NJWE-WettbR 1999, 257—*Dr. Sommer*.
97 *Baywatch Production Co v The Home Video Channel*, n.9 (1st ser.) above
98 Eichmann, GRUR 1998, 201, 213; Fezer, n.31 (2nd ser.) above, at §15$_1$78a.
99 ECJ, Case C–375/97, GRUR Int 2000, 73—*Chevy*.
1 Fezer, n.31 (2nd ser.) above, at §15$_4$20; sometimes even 30 per cent or less are acceptable; see LG Frankfurt, NJWE-WettbR 2000, 294—*Fisherman's Friend* and BGH in BGHZ 93, 96—*Dimple* or OLG Hamburg, GRUR 1999, 339, 341—*Yves Rocher*.
2 *Szene*, n.60 (2nd ser.) above, at p.73.
3 OLG Cologne, NJWE-WettbR 2000, 214—*Blitzrezepte*.
4 See for descriptive uses §23 of the German Trade Marks Act 1994.
5 In German: "Tagesschau"; the title is familiar to around 95 per cent of the general public.
6 In German: "Tagesreport"; BGH, Judgment of March 1, 2002, I ZR 205/98—*Tagesschau*.
7 In German: "Tagesbild"; BGH, Judgment of March 1, 2002, I ZR 211/98—*Tagesschau*.
8 *ibid.* at pp.16–18.
9 Art.2.4 of the Swiss Copyright Act, translated by UNESCO, provides: "Protection shall also subsist in drafts, titles and parts of works on condition that they are creations of the mind with an individual nature."
10 Art.4 of the Portuguese Copyright Act, translated by UNESCO, provides: "(1) The protection granted to a work shall extend to its title, whether or not it is registered, provided that it is original and that it cannot be confused with the title of any other work of the same nature by another author which has previously been disclosed or published. (2) Such protection shall not apply to the following: *(a)* titles consisting of the generic, necessary or habitual designation of the subject matter of works of a certain kind; *(b)* titles consisting solely of the names of historical, historico-dramatic or literary and mythological personages, or of the names of living persons. (3) The title of a work not disclosed nor published shall be protected if it fulfils the conditions set out in this Article and if it has been registered jointly with the work."
11 Art.10 of the Spanish Copyright Act, translated by UNESCO, provides: "The title of a work shall be protected as part of the work when it is original."
12 §80 of the Austrian Copyright Act, translated by UNESCO, provides: "*Protection of Titles:* § 80. (1) For purposes of trade, the title or other designation of a work of literature or art or the format of copies thereof may not be used for another work in a manner that is capable of causing confusion. (2) Paragraph (1) shall also apply to works of literature and art which do not enjoy copyright protection under this Act."
13 Art.100 of the Italian Copyright Act 1941, translated by UNESCO, provides: "The title of a work, when it uniquely identifies the work, may not be reproduced in connection with any other work without the consent of the author. This prohibition shall not extend to works which are of a kind or character so far removed as to exclude all possibility of confusion. The reproduction of headings used in periodical publications to give unique identification to the normal and characteristic features appearing thereunder shall also be prohibited, subject to the same conditions.The title of a newspaper, magazine or other periodical publication may not be reproduced in other works of the same kind or character until two years have elapsed since cessation of its publication."

similar mechanism is contained in Art.5 of the Portuguese Copyright Act.[14]

Conclusion

The structure and practice of title rights in Europe reflect different perceptions of titles and these perceptions translate into different ways and scopes of protection. While English passing-off law stresses the function of titles as trade names, French law accentuates copyright in titles whereas German law focuses on titles as trade-mark-like identifiers of works. Title protection in other European jurisdictions lies in between this triangle of options. From different legal bases different scopes of protection must evolve. Leaving titles unprotected that have not acquired trade name significance, as in the United Kingdom, contrasts fundamentally with the award of copyright for life plus 70 years, as in France. A middle position can be found in German law, which limits protection to the life cycle of the work but includes, as with trade marks, a comprehensive right against dilution, moving title protection to a point even beyond confusion.

Acknowledging that, albeit substantially different, each approach contains some truth, a European harmonisation effort may be well advised to include each aspect of a title adequately. Titles that function as business names or trade marks—albeit only few in number—should indeed, as in the United Kingdom, enjoy the protection that is available to such trade names. The small portion of truly original titles on the other hand, should, as in France, have access to copyright protection. This leaves the substantial number of titles which possess neither trade mark significance nor originality but still must not remain unprotected or protected with only some diffuse unfair competition law concepts. While any title functions at least as an identifier of a work, why not fill in the gap with a comprehensive *sui generis* right such as in Germany?

14 Art.5 of the Portuguese Copyright Act, translated by UNESCO, provides: (1) Titles of newspapers or other periodicals shall be protected, provided that the latter are published regularly, subject to due registration in the relevant section of the register of the governmental department responsible for social communications. (2) The title protected may be used for a similar publication one year after expiry of the right to publication, communicated in any manner whatsoever, or three years after cessation of publication."