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LEGAL ISSUES

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Legally Speaking

Protection of Literary Titles © 1998

by Lloyd L. Rich <rich@csn.net>

Introduction

When a book is published, the publisher expects the copyright law to protect its creative expression for the length of time provided for by the Copyright Act. But is the literary title that the publisher and author have spent substantial time selecting and in which the publisher has invested monies to make the public recognize also protected?

Title protection for publishers is important for a number of reasons and include (1) recognition by the public that particular publications originate from a specific publisher, and (2) the additional good will and value that is added to the publisher's balance sheet. Publishers should, therefore, be aware of the type of protection that may be available for the literary titles they publish. Many publishers are under the misconception that the titles of their publications cannot be protected. Generally, the reason for such misconception is that publishers only rely upon their knowledge of the Copyright Act which does not treat a title as protectable subject matter, while not realizing that trademark and unfair competition laws under certain circumstances will provide protection.

Intellectual property law does not protect titles as easily or as comprehensively as it protects the contents of a literary work. Single titles — the title of a particular work — are not protected by copyright law and may only be protected by unfair competition law and possibly trademark law if the publisher can demonstrate that the title has acquired *secondary meaning*. Secondary meaning, with regard to literary titles, is only found when in the minds of the

public, the particular title is associated with a single source of the literary work. Although blatant attempts to pass off another publisher's title as one's own may be protected by unfair competition law, it generally is not an easy process to

protect a single title. It is much easier for a publisher to protect a *series title* under unfair competition and federal trademark law; in fact, federal trademark law permits the registration of a series title.

Copyright Law Protection

While the copyright law will generally protect the contents of a book, the title of that particular book will not be protected. The purpose of the copyright law is to protect the author's creative *expression*. Although nothing in the Copyright Act specifically precludes protection for titles, Copyright Office Regulations and judicial decisions have made it clear that titles are only the equivalent of short slogans and, therefore, a title does not contain sufficient expression to be worthy of copyright protection. At least one reason that courts are hesitant to grant titles copyright protection is because they fear that by doing so they will prevent the title's use by others for whom that particular title may be equally appropriate.

Trademark and Unfair Competition Law Protection

Introduction

Titles can be protected under the common law of unregistered marks, statutory trademark law and unfair competition law. An important factor in determining the applicability of such protection depends upon whether protection is sought for a single title or a series title. The objective of title protection is to ensure that another publisher does not use a specific title in a manner that will create a likelihood of confusion regarding the source of the publication in the minds of the purchasing public.

Unfair competition law is the body of federal and state law whose primary purpose is to prevent false representations concerning the source of goods. Individual states under the common law of unfair competition have provided protection to literary titles under the *passing off* and *misappropriation* doctrines. Misappropriation has been defined by one court as the "taking and use of another's property for the sole purpose of capitalizing un-

fairly on the good will and reputation of the property owner."¹ Passing off is a doctrine that prevents a competitor from using a duplicate or similar title and thereby creating a likelihood of confusion regarding the source of that title. Courts sometimes utilize unfair competition law when "all else fails" to preserve the integrity of business or commercial relations or to prevent "dirty dealings." Thus, while certain activities may technically be allowed by copyright and trademark law, unfair competition law may prohibit them if someone has "unfairly" used them to his or her advantage.

Trademarks have two primary purposes: (1) to enable consumers to distinguish the goods of one producer from those of another and (2) to allow producers of goods to trade on the good will of their products. Trademark law is designed to prevent what courts call a likelihood of confusion between two marks. Therefore, when a court finds trademark infringement, it finds that the trademark process has broken down, that a *likelihood of confusion* has been created such that consumers cannot correctly distinguish between the goods of two producers, and producers cannot rely on their product's good will to convince consumers to purchase that good. Consequently, a consumer might purchase one product, relying on its good name, but instead end up with a product produced by someone other than the trademark owner.

A publisher cannot obtain federal trademark registration for a single title, but a *series title may be federally registered*. The benefits of federal registration to the publisher, especially preventing the use of that title by another publisher on competing titles, could make the effort and cost of obtaining the federal trademark registration very worthwhile.

Trademarks for literary titles for the most part are not treated any differently than the trademarks of any other commercial goods. Trademark law only protects an *inherently distinctive* term, and will not provide protection to a *descriptive* term — a mark that tells something about the product — unless the descriptive term has acquired secondary meaning. Secondary meaning will only be acquired once the purchasing public learns to associate a specific descriptive term with a single source for the product or service. Therefore, secondary meaning can only be established following a period of use of the mark, sales of the product containing the mark, and advertising/marketing expenses promoting the sale of the product.

Protection of Single Titles

Even though a single title cannot be registered under federal trademark law the common law of unregistered marks has been in-

continued on page 57

terpreted by the courts to protect single book titles from a likelihood of confusion. The term "single title" refers to a particular book title, such as *Gone With The Wind*, rather than a "series title", such as *The Hardy Boys*. This does not mean that consumers have to be confused that one book is, indeed, written by another author. It can also mean that consumers are confused about the sponsorship, affiliation, or connection between one work and another. For example, if a second publisher used the title *Gone With The Wind* in a cookbook title, the public might be confused about whether the book was affiliated with or endorsed by the publisher of *Gone With The Wind* or its author, Margaret Mitchell.

When trademarks do not involve literary titles they are immediately protected if the marks are *arbitrary* or *fanciful* (marks that have nothing to do with the product or its characteristics) or *suggestive* (marks that only suggest a product or its characteristics); they do not require proof of secondary meaning. In contrast, trademarks that are *descriptive* require proof of secondary meaning. Secondary meaning is required under trademark law to prevent monopolies over terms that are necessary to describe products in the marketplace.

However, with literary titles of single works the courts basically assume that the titles are descriptive of the content of the work. Therefore, even if a book title seems arbitrary and fanciful, such as *Stars and Stripes* to describe a novel about a farm in Kansas, a publisher must still show that the title has acquired secondary meaning in order for the title to be protected by the common law of trademarks and/or unfair competition laws.

There are many commentators who wonder why such a distinction should have arisen; e.g., requiring the mark of literary titles of single works, which may be inherently distinctive to prove secondary meaning while, marks for other commercial goods or services do not need to surpass this hurdle. "The theory apparently is that any such work is single and unique, not in competition with any other work and its title is not inherently distinctive." To many in the publishing and entertainment field this rule requiring secondary meaning for any single title for a work is a strange reality; however, regardless of reality the rule remains fixed. "The courts view each literary work as a specific, separate and unique commercial item and not as one product among many competing products." Such reasoning is based upon the assumption that any one literary work is an economic market in and of itself, and thus that literary work does not compete with any other similar literary works. "That is, each literary title is regarded as a term used to describe the product itself, rather than a mark used to designate a single source among many sources of literary works."²

Even though this issue appears to be il-

logical, courts have indicated that there is no rule prohibiting trademark protection for literary titles. "No one has asserted that a word may not be used as a trademark for books or that there cannot be trademarks for books, in the form of a word or otherwise, or that trademarks for books cannot be registered under the Lanham Act. ... But before there can be registration there must be a trademark and a trademark exists only where there has been trademark use." *Trademark use* means the mark identifies and distinguishes the goods or services of one particular seller, and is not used only to describe the qualities or function as the name of the product or service itself.³

The reasons the courts always require proof of secondary meaning for all single titles are somewhat unclear. However, some commentators have suggested that it is due to the somewhat romantic notion courts have of books. Courts do not view book titles as mechanisms used by authors and publishers to compete for the sale of books; they view each book as unique by itself. Therefore, courts see book titles as descriptive of the contents of the book, not actually as an element of the book that enables it to compete with other books.

In addition, some courts believe that, when purchasing a book, book buyers rely more on the author of a book than they do a title. While this may be true when book buyers enter a bookstore looking for a particular book, it is probably not true that book buyers, like buyers of other goods, do not make impulse purchases based on a catchy title. As unrealistic as this may sound, courts continue to require proof of secondary meaning regardless of the nature of the title. Regardless of the realities of the marketplace, publishers must show a title has acquired secondary meaning before the title may receive protection.

Once the title for a book has been selected, the publisher can deliberately begin to build up the secondary meaning in that title. This may be accomplished through pre-release publicity that begins to create in the public's mind a specific association with the particular book. Once the book has been published, secondary meaning may be enhanced by ongoing advertising and promotion of the book and if feasible through the development of ancillary products that make use of the title and characters from the book. If the title is used with ancillary products the title could be further protected through federal trademark registration of those products.

When a single title succeeds in acquiring secondary meaning, the inference is that the public no longer recognizes only the title's literal meaning, but associates that title with a single source. This means that even if consumers do not know who that source is, or even if that source is anonymous, the courts will recognize that the title has acquired secondary meaning. Different jurisdictions vary, however, in their interpretations of source identification as some require the public to be able to identify the work as originating from a specific identifiable source, while others per-

mit anonymous source identification just so long as the public knows the work comes from a single source.

In determining whether secondary meaning has been acquired the courts will look at several factors that include (1) the length and continuity of the use of the title; (2) the extent of and amount of money spent on advertising and promotion; (3) sales results of the title; (4) a second publisher's attempt to use the title; (5) consumer studies that demonstrate the public is aware of the source; and (6) unsolicited publicity by the media of the title. If this test seems to favor larger publishers with more hefty advertising budgets, that is most likely the case. Much like it is more difficult for a title from a small press to attract a large audience, it is also more difficult for a title from a small press to acquire secondary meaning.

Protection of Series Titles

Series titles are eligible for federal trademark registration and may be registered with the **United States Patent and Trademark Office** ("PTO"). Furthermore, titles of a series of books, periodicals or newspapers may be protected without proof of secondary meaning. The reasoning for not requiring secondary meaning for series titles of literary works is that such series title functions as a trademark because it indicates that each individual work in the series originates from the same source as any other work in that series. This is because the series title is not descriptive of any one specific work in the series and because any particular work in the series also has its own individual title. Judicial interpretations, however, are not consistent on whether secondary meaning must be acquired in order that the mark is recognized as inherently distinctive of the literary series.

Despite this inconsistency, even those courts that do not require proof of secondary meaning for some series titles may require them for those series titles that are more descriptive in nature. For example, it probably will be far more difficult to register the series title *Garden Books* than it would be to register *Flowers And Shovels* for a series of books on gardening. The first title is clearly more descriptive, while the second title is more suggestive.

Therefore, the publisher must still cross a number of threshold issues to protect the series title, such as (1) Is the title for the literary series inherently distinctive? If yes, does the mark require proof of secondary meaning? (2) Is the title for the series descriptive? If yes, can secondary meaning be proved?

Series titles are entitled to the same protection as any other trademark. Therefore, book, magazine, newspaper, encyclopedia, dictionary, CD-ROM, software and other print and electronic literary series title trademarks function in the same manner as the trademark for any other product or service in that the series title indicates to the purchasing public the source of the series. Courts apparently view series titles as not being unique in them-

continued on page 60

Questions and Answers — Copyright Column

by **Laura N. Gasaway** (Director of the Law Library & Professor of Law, CB # 3385, University of North Carolina, Chapel Hill, NC 27599; phone: 919-962-1049; fax: 919-962-1193) <laura_gasaway@unc.edu>

Libraries are often confused about the difference in the copyright implications of in-house copying for users and interlibrary loan. The following questions are samples of some I have received in the past few months dealing with this issue.

Question: *A hospital library is uncertain what restrictions apply when the library owns the journal and copies for in-house library patrons. Does it make a difference if it charges the patron for such copies?*

Answer: In-house copying is basically what sections 108(d) and (e) of the Copyright Act permit. Think of this provision as the one governing copying for an end user even if the library ultimately will have to obtain the copy from interlibrary loan. However, the library must first meet the requirements of section 108(a): (1) the library is open to the public or to researchers doing research in the same or a similar field, (2) there is no direct or indirect commercial advantage to the library from such copying activities and (3) each copy reproduced contains a notice of copyright. Further, the library must give the user the warning specified in sections 108(d)-(e), i.e., the Register's warning, prior to making the copy for the user. Whether the library charges the user for making the copy is not the issue; cost recovery or making a profit is what matters. If the library makes a profit on that copy by what it charges the user, then the library has received a direct commercial advantage. If instead the library simply covers its cost in reproducing the copy for the user, then there is no direct or indirect commercial advantage.

Question: *Does it make a difference if the library is in a for-profit entity?*

Answer: This is not absolutely clear. Certainly, the answer is easier if the library is in a nonprofit organization. The question of whether a library in the for-profit sector copies for commercial advantage has never been litigated. In **American Geophysical Union v. Texaco**, 37 F.3d 881 (2d Cir. 1994), the courts, especially the district court, seemed to say yes, although Texaco was a section 107 fair use case and not a section 108 library exemption case. The safest bet is to consult corporate counsel to assist the library in making the decision about whether and how Texaco applies to the particular corporation.

Question: *What restrictions apply as to how often a library may copy from the same journal title?*

Answer: There are no restrictions in section 108(d) except that only one article from a journal issue can be reproduced for a user. For section 108(e) larger portions can be reproduced for users but the library must first make a reasonable effort to purchase a copy for the user, and this includes even a used copy. Section 108(g)(1) states that libraries may even copy the same material on separate occasions. This means that if several users request the same article, each user is treated as an individual and the copy may be made.

Question: *Are there different rules that apply for interlibrary loan copying?*

Answer: Yes, although these are not truly rules but are in the nature of guidelines or suggestions. Under the CONTU interlibrary loan guidelines, each calendar year a library may request only five items from a periodical title going back over the most recent 60 months of that journal. The borrowing library is limited to a guideline of five each year and must main-

tain records on the number of times it borrows from the most recent 60 months of each periodical title. When the library makes the sixth request from that title, it should then seek permission, pay royalties to the publisher, purchase the article from an authorized document delivery service or pay royalties to the Copyright Clearance Center.

Question: *What happens when the user's request cannot be filled from the library's collection and the item must be obtained through interlibrary loan? How does all of this work together?*

Answer: The user is still bound to one article per periodical issue even if the library has to get the copy through interlibrary loan. In the interlibrary loan guidelines, the suggestion of five applies to the library and not to the individual user. So, the user could use up the library's five annual requests for articles from that journal title by requesting five articles from five separate issues of the journal. The library must administratively decide whether to honor such a request or then be prepared to pay royalties on subsequent requests from that journal title during the year. 🐾

Legally Speaking from page 57

selves but instead that they are in competition with other series.

Obtaining Federal Trademark Registration

In order to obtain a federal registered trademark for a series title, a publisher must file a trademark registration application with the PTO. If the series title is found to be non-descriptive by the PTO, the series title will be registered on the Principle Register. If, however, the series title is deemed to be descriptive by the PTO then registration will only be permitted on the Supplemental Register. Registration and the Supplemental Register does not provide the publisher with the full scope of protection provided by the Principal Register but it will probably preclude another publisher from using the registered series title for

their publications. Furthermore, the publisher of a series title that is registered on the Supplemental Register may at some later date demonstrate that the series title has acquired secondary meaning. If the publisher can prove the series title has acquired secondary meaning, the series title will be eligible for registration on the Principle Register.

Conclusion

Literary titles, whether a single title or a series title may be protected. Although the copyright law will not protect titles, trademark and unfair competition law may protect these valuable properties. Federal trademark law is particularly useful for publishers who wish to register series titles while trademark common law and unfair competition laws are most suitable for the protection of single titles. 🐾

Please note: This article is not legal advice. You should consult an attorney if

you have legal questions that relate to your specific publishing issues and projects.

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Endnotes

¹ Pocket Books, Inc. v. Dell Publishing Co., 267 N.Y.S.2d 269,272 (1966).

² J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition*, § 10.3 at 10-7 (Fourth Ed. 1997).

³ Id. § 10.3 at 10-7 to 10-8.